THE LAW OF PATENTS.

THE LAW OF PATENTS

FOR

USEFUL INVENTIONS.

BY

WILLIAM C. ROBINSON, LL.D.,

PROFESSOR OF LAW IN YALE UNIVERSITY.

IN THREE VOLUMES.

VOL. III.

Felix qui potuit rerum cognoscere causas. — VIRG. Georg. ii. 490.

BOSTON:

LITTLE, BROWN, AND COMPANY.

1890.

Tx
R658

Copyright, 1890,
BY WILLIAM C. ROBINSON.

JUL 17 1907

UNIVERSITY PRESS:
JOHN WILSON AND SON, CAMBRIDGE.

TABLE OF CONTENTS.

VOLUME III.

BOOK IV.

OF WRONGS AND REMEDIES.

		PAGE
§ 846.	Laws for the Protection and Vindication of the Rights of Owners of Patented Inventions Liberally Construed and Applied . . .	3
847.	Protection of the Rights of an Inventor in his Unpatented Invention	4
848.	Protection of the Rights of an Inventor in his Patented Invention	5
849.	Protection of the Contract Rights of the Inventor and his Transferees	5
850.	Protection of the Contract Rights of Assignors and Assignees . .	6
851.	Protection of the Contract Rights of Licensors and Licensees . .	6
852.	General Division of the Subject of Wrongs and Remedies . . .	7
853.	Remedies for Certain Wrongs Afforded by Federal Courts: for Other Wrongs by State Courts: this Distinction Preliminary .	7

CHAPTER I.

OF THE JURISDICTION OF THE FEDERAL AND STATE COURTS OVER ACTIONS WHICH RELATE TO PATENTED INVENTIONS.

§ 854.	Federal Jurisdiction where Parties are Citizens of Different States: this Jurisdiction not Exclusive	9
855.	Federal Jurisdiction Exclusive over all Cases Arising under the Patent Laws	9
856.	Cases Arising under the Patent Laws are Cases Affecting the Monopoly Created by such Laws	10
857.	Three Classes of Cases Affect the Monopoly	12
858.	Controversies Collateral to Cases not Embraced in one of these Three Classes are not Cases Affecting the Monopoly	14
859.	An Action to Repeal a Patent is a Case Affecting the Monopoly .	15

PAGE

§ 860. An Action to Annul an Interfering Patent is a Case Affecting the Monopoly 15
861. An Action for Infringement is a Case Affecting the Monopoly . . 16
862. Cases Affecting the Monopoly are within the Exclusive Jurisdiction of the Federal Courts though Involving Collateral Controversies not Arising under the Patent Laws 18
863. Cases Affecting the Monopoly not Brought within the Jurisdiction of State Courts by Consent of Parties 19
864. Actions for Breach of Contract, or for Tort to the Patented Article, are not Cases Affecting the Monopoly 20
865. Actions for Breach of Contract, and for Torts to the Patented Article, are within the Jurisdiction of State Courts 21
866. Original Jurisdiction over Cases Arising under the Patent Laws is Vested in the Circuit Courts, and other Courts having Circuit Court Powers 24

CHAPTER II.

OF WRONGS AGAINST UNPATENTED INVENTIONS.

§ 867. The Right of an Inventor to Preserve the Secret of his Invention Rests on Natural Law 26
868. Forcible or Fraudulent Discovery of a Secret Invention Violates the Inventor's Rights 26
869. Remedies for the Forcible or Fraudulent Discovery of the Inventor's Secret 27
870. The Right of an Inventor to the Preservation of his Secret by those to whom he has Confidentially Communicated it 28
871. The Disclosure or Misuse of an Inventor's Secret by those to whom it was Confidentially Communicated is a Breach of Trust and Actionable 28
872. Remedies for the Disclosure or Misuse of the Inventor's Secret . 29
873. The Right of an Inventor to his Secret Protected though the Secret Invention is not Patentable 30
874. The Right of an Inventor to his Unpatented Invention Forfeited by its Unrestricted Disclosure to Others unless Protected by Statute 31
875. The Right of an Inventor to his Unpatented Invention, notwithstanding its Unrestricted Disclosure to Others, Protected by Statute during, and for Two years Prior to, his Application for a Patent 31
876. Three Views of the Inventor's Right to his Disclosed Invention, under this Statute, During and Prior to his Application for a Patent 32
877. First View, — Temporary Abandonment and Resumption, — Untenable 32
878. Second View, — that Violations of this Right are Infringements for which an Action will lie after the Patent is Granted, — Objectionable 33

PAGE

§ 879. Third View, — that the Right of the Inventor under this Statute is a Continuation of his Natural Right and Entitled to the same Protection, — Probable 34
880. Third View Alone Consistent with the Other Rights of the Inventor in his Unpatented Invention 36
881. Third View Alone Consistent with the Contract Rights of the Inventor in Reference to his Unpatented Invention 36
882. Third View Indicates that the Inventor's Right, under this Statute, is Subject to the same Violations and Entitled to the Same Redress as his Right to his Secret Invention 37
883. Inventor's Right in his Unpatented Invention not Violat : by the Independent Inventive Acts of Others, nor by the Enjoyment of their Results 37

CHAPTER III.

OF WRONGS AGAINST PATENTEES.

§ 884. Wrongs against a Patentee are Violations of his Right in his Monopoly 39
885. Rights in a Monopoly Violated by Injuring the Reputation of the Patented Invention or by its Unauthorized Use 40

SECTION I.

OF SLANDER OR LIBEL AGAINST A PATENTED INVENTION.

§ 886. Nature of the Injury Inflicted by Slander or Libel against a Patented Invention 40
887. Slander or Libel against a Patented Invention by Denying its Patentability 41
888. Slander or Libel against a Patented Invention by Denying that the Patentee was the First and True Inventor 41
889. Remedy for Slander or Libel against a Patented Invention . . . 42

SECTION II.

OF INFRINGEMENT.

§ 890. Infringement Defined 43
891. No Infringement Exists unless the Invention Unlawfully Used is Identical with that Protected by the Patent 44
892. Identity, how Determined 45
893. Identity must be Identity in the Idea of Means 46
894. Identity in Ideas of Means, how Determined 47
895. Identity may Result from Use as well as from Original Construction 51

		PAGE
§ 806.	Identity not Controverted by the Issue of a Later Patent for the Infringing Invention	53
807.	Nature of the Act of Infringement	54
808.	No Act an Infringement unless it Affects the Pecuniary Interests of the Owner of the Patented Invention	55
809.	Infringement not Committed by Possessing, Exposing for Sale, Advertising, etc.	57
900.	Infringement not Committed by Use of Part of the Patented Invention	57
901.	Intention of Actual Infringer Immaterial: When Intention may Evidence Infringement	58
902.	Infringement through Ignorance of the Patent, how Prevented	59
903.	Infringement by Unlawful Making	60
904.	Infringement by Unlawful Using	62
905.	Infringement by Unlawful Selling	64
906.	Infringement a Single Tort though Embracing Acts of Making, Use, and Sale	66
907.	No Infringement can be Committed before the Issue of the Patent	67
908.	Infringement after the Patent has Expired	68
909.	Infringement can be Committed only Within the Area of the United States	71
910.	Infringement by the Government and its Officials	73
911.	Infringement by Public Corporations	75
912.	Infringement by Private Corporations: Liability of Officers and Stockholders	78
913.	Infringement by a Joint-Owner of the Patent	82
914.	Infringement by Assignors, Grantors, and Grantees	83
915.	Infringement by Licensees	84
916.	Infringement by a Licensee under an Express License	85
917.	Infringement by a Licensee under an Implied License	88
918.	Infringement by Common Carriers	91
919.	Infringement by Contractors	92
920.	Infringement by Agents and Workmen	93
921.	Infringement by Private Individuals	94
922.	Infringement of a Patent for a Combination	95
923.	Infringement of a Patent for a Combination: Unauthorized Use of its Elements and Sub-Combinations	98
924.	Infringement of a Patent for a Combination: Unauthorized Use of Part of the Combination	101
925.	Infringement of a Patent for an Art	103
926.	Infringement of a Patent for a Machine	105
927.	Infringement of a Patent for a Manufacture	107
928.	Infringement of a Patent for a Composition of Matter	108
929.	Infringement of a Patent for a Design	109
930.	Infringement of a Patent for an Improvement	110

SECTION III.

OF INFRINGEMENT: REMEDY AT LAW.

PAGE

§ 931. Remedy for Infringement at Law: Action on the Case 111
932. Remedy at Law Insufficient: Equitable Jurisdiction Established . 112
933. Jurisdiction over Actions for Infringement in General 115
934. Jurisdiction over Actions at Law Vests in the Court for the Circuit in which the Defendant Resides or is Found 117
935. Jurisdiction over Actions at Law against Domestic and Foreign Corporations 120
936. Jurisdiction over Actions at Law where a Circuit Embraces Two or More Districts 122
937. Plaintiff in Actions at Law Must be the Legal Owner of the Patent at the Date of the Infringement 122
938. Licensees and Owners of Equitable Interests cannot be Plaintiffs in Actions at Law 124
939. Patentee when Plaintiff in Actions at Law 127
940. Assignee when Plaintiff in Actions at Law 128
941. Grantee when Plaintiff in Actions at Law 129
942. Personal Representatives of Deceased Owner when Plaintiffs in Actions at Law 130
943. Assignee of Claim for Past Infringements when Plaintiff in Actions at Law 131
944. Plaintiff in Actions at Law must Sue in His Own Name 133
945. Non-joinder or Misjoinder of Plaintiffs in Actions at Law . . . 134
946. Defendant in Actions at Law must be the Person Guilty of the Act of Infringement 135
947. All Infringers Liable as Defendants in Actions at Law 135
948. Non-joinder and Misjoinder of Defendants in Actions at Law . . 136
949. Process in Actions at Law: The Declaration: Allegation of Inventive Act 137
950. The Declaration: Allegation of Grant of Letters-Patent 138
951. The Declaration: Allegation of Legal Title of the Plaintiff . . . 139
952. The Declaration: Allegation of Infringement 140
953. The Declaration: Allegation of Damages 141
954. The Declaration: Formal Requisites 142
955. The Declaration: Joinder of Several Patents where Violated by One Act of Infringement 143
956. Pleadings in Actions at Law: Pleas in Abatement 143
957. Demurrers in Actions at Law 145
958. Pleas in Bar in Actions at Law: The Defences Possible in Actions at Law 145
959. First Defence: Denial that the Patented Art or Instrument is the Result of an Inventive Act 147
960. Second Defence: Denial that the Patented Art or Instrument Resulted from the Inventive Act of its Alleged Inventor . . . 149
961. Third Defence: Denial that the Alleged Inventor was the First Inventor of the Patented Art or Instrument 150

PAGE

§ 962. Fourth Defence: Denial that the Patented Art or Instrument is within the Patentable Classes of Inventions 150
963. Fifth Defence: Denial of the Novelty of the Patented Art or Instrument 151
964. Sixth Defence: Denial of the Utility of the Patented Art or Instrument 158
965. Seventh Defence: Abandonment of the Invention to the Public . 154
966. Eighth Defence: Denial of the Grant of the Alleged Letters-Patent 156
967. Ninth Defence: Denial that the Letters-Patent were Issued in Conformity with Law 157
968. Tenth Defence: Denial that the Invention Covered by the Patent is Legally Patentable. 159
969. Eleventh Defence: Fraudulent Concealment or Misrepresentation in the Specification of the Patent 159
970. Twelfth Defence: Ambiguity in the Description of the Invention in the Patent. 160
971. Thirteenth Defence: Excessive Claims 164
972. Fourteenth Defence: Ambiguity in the Claims 166
973. Fifteenth Defence: Surrender of the Patent 167
974. Sixteenth Defence: Repeal of the Patent 167
975. Seventeenth Defence: Denial of a Legal Title in the Plaintiff . . 168
976. Eighteenth Defence: Denial that the Art or Instrument Employed by the Defendant is Covered by the Patent 169
977. Nineteenth Defence: Denial that the Acts of the Defendant were Infringing Acts 170
978. Twentieth Defence: Denial that the Alleged Acts of Infringement were Committed while the Patent was in Force 171
979. Twenty-First Defence: Co-ownership of the Patent, or License from its Lawful Owner. 172
980. Twenty-Second Defence: Statute of Limitations 173
981. Twenty-Third Defence: Estoppel 179
982. Twenty-Fourth Defence: Release 183
983. Twenty-Fifth Defence: Res Adjudicata 184
984. Defendant may Employ all his Defences unless Estopped . . . 186
985. Separate Defences Allowed against Each Patent and Each Claim in Controversy 189
986. Forms of Pleading Required for These Defences, a Matter of Dispute 190
987. Pleadings under the Act of 1790 191
988. Pleadings under the Act of 1793 196
989. Pleadings under the Act of 1836 198
990. Pleadings under the Act of 1870 and the Revised Statutes . . . 200
991. Summary of the Law concerning Pleadings in Actions for Infringement from 1790 to 1874 201
992. General Issue, with or without Notice, a Sufficient Plea in all Defences except the Statute of Limitations 201
993. General Issue: when Notice also Required 204
994. Notice Required where the Defence Rests on an Alleged Fraudulent Specification 204

PAGE

§ 995. Notice Required where the Defence Rests on the Allegation that the Patentee or his Assignor is not a True Inventor or was not the First Inventor 205
996. Notice Required where the Defence Rests on the Allegation of Prior Patent or Publication 208
997. Notice Required where the Defence Rests on the Allegation of Prior Use 209
998. Notice Required where the Defence Rests on an Allegation of Abandonment to the Public 210
999. Defences Available under the General Issue without Notice . . 211
1000. Form and Service of Notice 213
1001. Notice of Fraudulent Specification: its Requisites 215
1002. Notice that the Patentee or his Assignor, though a True Inventor, Surreptitiously Obtained the Patent for the Invention while a Prior Inventor was diligently Reducing to Practice 215
1003. Notice of Prior Patent or Publication: its Requisites 216
1004. Notice of Prior Use: its Requisites 217
1005. Notice of Abandonment to the Public: its Requisites 221
1006. Evidence as to the State of the Art Admissible without Notice . 222
1007. Evidence in Actions at Law for Infringement Governed by the Usual Rules 224
1008. Rules of Evidence in the Federal Courts Identical with Those in Force in the Local Courts 224
1009. Facts of which the Federal Courts in Actions at Law for Infringement Take Judicial Notice 225
1010. Competency of Witnesses 227
1011. Credibility of Witnesses 228
1012. Expert Witnesses 230
1013. Classes of Expert Witnesses: their Distinctions 233
1014. Expert Testimony: when Admissible 235
1015. Documentary Evidence in Actions at Law for Infringement . . 238
1016. The Patent as Evidence 241
1017. Records of Former Judgments as Evidence 244
1018. Burden of Proof 246
1019. Evidence Concerning the Nature of the Patented Invention Limited by the Interpretation given to the Patent by the Court . . 247
1020. Evidence Concerning the State of the Art at the Date of the Invention 249
1021. Evidence Excluded on the Ground of Estoppel 250
1022. Evidence under the First Defence: Origin of the Alleged Invention in an Inventive Act 251
1023. Evidence under the Second Defence: Performance of the Inventive Act by the Alleged Inventor 253
1024. Evidence under the Third Defence: Priority of the Inventive Act of the Alleged Inventor 255
1025. Evidence under the Fourth Defence: The Alleged Invention not within the Protected Classes 259
1026. Evidence under the Fifth Defence: Novelty of the Patented Invention: Prior Use 260
1027. Evidence under the Fifth Defence: Novelty of the Patented Invention: Prior Patent 274

PAGE

§ 1028. Evidence under the Fifth Defence: Novelty of the Patented Invention: Prior Publication 277
1029. Evidence under the Sixth Defence: Utility of the Patented Invention. 280
1030. Evidence under the Seventh Defence: Abandonment of the Patented Invention to the Public 282
1031. Evidence under the Eighth Defence: Non-Existence of the Letters-Patent 288
1032. Evidence under the Ninth Defence: Illegality of the Letters-Patent 288
1033. Evidence under the Tenth Defence: The Patented Invention not Embraced in the Protected Classes 295
1034. Evidence under the Eleventh Defence: Fraudulent Specification 295
1035. Evidence under the Twelfth Defence: Ambiguity of the Description 297
1036. Evidence under the Thirteenth Defence: Excessive Claims . . 297
1037. Evidence under the Fourteenth Defence: Ambiguity of the Claim 299
1038. Evidence under the Fifteenth Defence: Surrender of the Letters-Patent. 300
1039. Evidence under the Sixteenth Defence: Repeal of the Letters-Patent 300
1040. Evidence under the Seventeenth Defence: Want of Title in the Plaintiff 301
1041. Evidence under the Eighteenth Defence: Diversity of the Alleged Infringing Art or Article from the Invention Covered by the Patent 302
1042. Evidence under the Nineteenth Defence: Non-commission the Infringing Acts by the Defendant 307
1043. Evidence under the Twentieth Defence: Non-commission of the Infringing Acts during the Life of the Patent 309
1044. Evidence under the Twenty-First Defence: Co-ownership or License 311
1045. Evidence under the Twenty-Second Defence: Statute of Limitations. 313
1046. Evidence under the Twenty-Third Defence: Estoppel 314
1047. Evidence under the Twenty-Fourth Defence: Release 315
1048. Evidence under the Twenty-Fifth Defence: Res Adjudicata . . 315
1049. Evidence Concerning Damages 316
1050. Distinction between the Rule of Damages at Law and the Measure of Recovery in Equity 316
1051. Distinction between the Rule of Damages and the Rules of Evidence concerning Damages 319
1052. Rule of Nominal Damages 320
1053. Rule of Actual Damages 320
1054. Rules of Evidence Concerning Damages Vary with the Mode in which the Plaintiff takes the Benefit of His Monopoly . . . 323
1055. Evidence Concerning Damages: Two Modes in which the Plaintiff may Take the Benefit of His Monopoly 324
1056. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses 326

PAGE

§ 1057. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses: Evidence that the Plaintiff has Adopted that Mode of Enjoyment 327
1058. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses: Evidence that the Defendant's Acts are Identical with those Covered by such Licenses 330
1059. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses: License Fee the Measure of Damages for Wrongful Acts which are Identical with those Covered by such Licenses 333
1060. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Two Forms of Such Exclusive Practice and of Corresponding Injury 335
1061. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Direct Evidence of the Extent of Injury 339
1062. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Indirect Evidence of the Extent of Injury in Cases where the Owner of the Patented Invention Uses the Invention and Sells its Products 339
1063. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Indirect Evidence of the Extent of Injury when the Owner of the Patented Invention Makes and Sells it to the Public 351
1064. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Evidence of the Extent of Injury where the Infringing Acts Differ from those by which the Monopoly is Enjoyed 357
1065. Effect of Recovery of Damages upon the Future Rights of the Defendant 359
1066. Interest on Damages, when Recoverable 361
1067. Counsel Fees, etc., not Recoverable as Damages 362
1068. Nominal Damages, when Recoverable 363
1069. Increase of Damages by the Court 365
1070. Distribution of Damages Recovered among Different Plaintiffs . 367
1071. Burden of Proof on the Question of Damages 367
1072. Order in which Evidence is Produced in Court 369
1073. Nonsuit not Ordered in Federal Courts: Equivalent Procedure . 370
1074. Charge to the Jury: Requests: Exceptions 372
1075. Questions of Law: Questions of Fact 377
1076. Verdict 381
1077. Trial of Issues of Fact by the Court without a Jury 381
1078. New Trials 382
1079. Writ of Error 385
1080. Costs 387

SECTION IV.

OF INFRINGEMENT: REMEDY IN EQUITY.

		PAGE
§ 1081.	Origin of Equity Jurisdiction over Infringement Cases in England	390
1082.	Origin of Equity Jurisdiction over Infringement Cases in the United States	391
1083.	Difficulties in the Administration of Equitable Remedies before the Act of 1819: Object of the Act	392
1084.	Legal and Equitable Jurisdiction over Infringement Cases not Concurrent	393
1085.	Jurisdiction of Equity Complete whenever Any Form of Equitable Relief is Necessary	395
1086.	No Equity Jurisdiction where Adequate Remedy Exists at Law	396
1087.	Adequate Remedy Exists at Law in What Cases	397
1088.	No Adequate Remedy at Law against Future Infringements	400
1089.	No Adequate Remedy at Law where the Injured Party is not the Legal Owner of the Patent	401
1090.	No Adequate Remedy at Law where a Discovery is Necessary or the Defence Rests on Equitable Grounds	402
1091.	Whether Adequate Remedy Exists at Law when the Defendant's Gain from the Infringement Exceeds the Plaintiff's Loss	403
1092.	Whether Adequate Remedy Exists at Law when the Patent has Expired before Suit is Commenced	409
1093.	Whether Adequate Remedy Exists at Law where the Patent Expires Pending Suit	411
1094.	General Rules of Equity Jurisdiction	414
1095.	Equity Jurisdiction not Conferrable by Waiver or Agreement of Parties	415
1096.	Local Jurisdiction in Equity in General Identical with that at Law	415
1097.	Local Jurisdiction in Equity, wherein Different from that at Law	416
1098.	Parties Plaintiff in Equity	418
1099.	Joinder of Plaintiffs in Equity	420
1100.	Addition of New Plaintiffs Pending Suit	422
1101.	Plaintiffs in Equity Must Sue in their Own Names	423
1102.	Misjoinder of Plaintiffs	424
1103.	Effect of Conveyance pendente lite on the Rights of Parties: Collusive Suits	425
1104.	Parties Defendant in Equity	427
1105.	Non-joinder of Defendants	428
1106.	Averments of a Bill in Equity in Actions for Infringement	428
1107.	Prayers for Equitable Relief	433
1108.	Joinder of Different Causes of Action Based on Several Patents: Multifariousness	434
1109.	Process in Equity: Service: Appearance	438
1110.	Demurrer in Equity	438
1111.	Demurrer to Part of the Bill: Proceedings on Demurrer	440
1112.	Plea in Equity: When Proper	441

PAGE

§ 1113. Requisites of a Plea in Equity: Procedure Thereon 442
1114. Answer in Equity, when Proper: Defences Peculiar to Equity: Laches: Estoppel 444
1115. Scope of Answer: Joinder of Defences 446
1116. Statement of Special Defences in the Answer 448
1117. Denial of Plaintiff's Title or of Defendant's Infringement in the Answer 452
1118. Effect of Admissions in the Answer 454
1119. Answer, whether under Oath: Effect of Sworn Answer 456
1120. Answer Setting up Special Defences, when Filed: Joint Answers: Exceptions to Answer 457
1121. Cross-Bills 458
1122. Supplemental Bills 459
1123. Amendments to Bill or Answer 461
1124. Trial: Various Modes of 464
1125. Trial by Jury on Feigned Issues 465
1126. Effect of the Verdict on a Feigned Issue 468
1127. Evidence Admissible in Equity 470
1128. Method of Producing Evidence in Equity: Objections: Exceptions 472
1129. Practice and Procedure in Equity in Actions for Infringement . 476
1130. Decrees in Equity: Decrees Pro Confesso 477
1131. Interlocutory Decrees 480
1132. Final Decrees 482
1133. Rehearings 484
1134. Rehearing on the Ground of Newly Discovered Evidence . . . 485
1135. Rehearing on the Ground of Newly Discovered Defences . . . 488
1136. Profits in Equity Distinct from Profits at Law, both in Theory and in Mode of Computation 491
1137. Power of Equity to Compel an Infringer to Account for his Unlawful Gains 492
1138. Profits in Equity Defined: General Mode of Computation . . . 494
1139. Computation of Profits where the Infringement Consists in the Sale, or Manufacture and Sale, of the Patented Invention . . 496
1140. Computation of Profits where the Infringement Consists in Selling Articles in which the Patented Invention is Embraced and Adds to the Profits of Each Sale 502
1141. Computation of Profits where the Infringement Consists in Selling Articles in which the Patented Invention is Embraced and Increases the Number and Amount of Sales 505
1142. Computation of Profits where the Infringement Consists in Selling Articles which Embrace the Patented Invention, and thence Derive their Entire Market Value 505
1143. Burden of Proof concerning the Amount of Profits Resulting from Infringing Sales 508
1144. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention . . . 511
1145. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Receipts and Savings Taken as the Minuend 512

PAGE

§ 1146. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Actual Receipts and Savings Alone Regarded 515
1147. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Ascertainment of Receipts from the Unlawful Use of the Invention 517
1148. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Ascertainment of Receipts from the Sale of Products Made by the Unlawful Use of the Invention 518
1149. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Ascertainment of Savings 520
1150. Burden of Proof on the Plaintiff to Show the Amount of Receipts or Savings 522
1151. Computation of Profits from Subordinate Methods of Infringement: Commissions on Sales: Repairs, etc. 523
1152. Computation of Profits as Determined by the Duration of the Infringement: Interest 524
1153. Liability of Infringer to Account: Partial Liability of Several Infringers: Corporate Liability 526
1154. Damages in Equity 528
1155. Account Ordered if Infringement Proved: By Whom Taken . . 530
1156. Procedure in Taking an Account 533
1157. Evidence on the Accounting 534
1158. Exceptions to the Report of the Master concerning the Amount of Profits 537
1159. Recommittal of Report for Further Hearing or Amendment . . 540
1160. Acceptance of Report: Final Decree 541
1161. Appeal to the Supreme Court 542
1162. Costs in Equity: when Taxed and in Whose Favor 545
1163. Items of Taxable Costs 549
1164. Bill of Review 551
1165. Bill of Revivor 552
1166. Bill to Perpetuate Testimony 553
1167. Bill of Discovery 553

SECTION V.

OF INFRINGEMENT: INJUNCTIONS.

§ 1168. Value of Preventive Equitable Action in Cases of Expected Infringement 555
1169. Classes of Injunctions: Preliminary Injunctions and Perpetual Injunctions 556
1170. Preliminary Injunction: Discretion of the Court in Granting it Guided by Established Rules 557

PAGE

§ 1171. Preliminary Injunction: Grantable only to Prevent Prospective Injury where no other Adequate Remedy Exists 558
1172. Preliminary Injunction: Grant or Refusal not Subject to Appeal 558
1173. Preliminary Injunction: Granted only when the Patent is Valid, the Title is in the Plaintiff, and there is Danger of an Infringement by the Defendant 560
1174. Preliminary Injunction: Proof of Validity of Patent: Prior Judgment in its Favor: Public Acquiescence: Admissions of Defendant 561
1175. Preliminary Injunction: Prior Judgment as Evidence of Validity: Circumstances Determining the Weight of Prior Judgments . 564
1176. Preliminary Injunction: Prior Judgment as Evidence of Validity: Identity of Parties 566
1177. Preliminary Injunction: Prior Judgment as Evidence of Validity: Identity of Issues 567
1178. Preliminary Injunction: Prior Judgment as Evidence of Validity: Identity of Available Testimony 570
1179. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments between Different Parties 571
1180. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments of Supreme Court 573
1181. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments of Circuit Courts 575
1182. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments of Circuit Courts: Judgments on Hearings, by Consent, by Collusion, etc. 581
1183. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments in the Patent Office 584
1184. Preliminary Injunction: Summation of Rules Concerning Prior Judgments as Evidence of Validity 587
1185. Preliminary Injunction: Public Acquiescence as Evidence of Validity: Acquiescence Defined 589
1186. Preliminary Injunction: Public Acquiescence as Evidence of Validity: Weight of such Evidence how Measured 593
1187. Preliminary Injunction: Public Acquiescence as Evidence of Validity: Acquiescence, how Manifested 594
1188. Preliminary Injunction: Comparative Weight of Prior Judgments and Public Acquiescence as Evidence of Validity 596
1189. Preliminary Injunction: Admissions of Defendant as Evidence of Validity 597
1190. Preliminary Injunction: Proof of Plaintiff's Title 599
1191. Preliminary Injunction: Proof of Intended Infringement . . . 599
1192. Preliminary Injunction: May Be Granted on Other Proof or Withheld though the Foregoing Proof is Presented 602
1193. Preliminary Injunction: Grounds of Its Refusal: No Irreparable Injury 603
1194. Preliminary Injunction: Grounds of Its Refusal: Plaintiff's Laches or Acquiescence 604
1195. Preliminary Injunction: Grounds of Its Refusal: Estoppel . . 608
1196. Preliminary Injunction: Grounds for Its Refusal: Improper Purpose of Plaintiff in Requesting it 610

PAGE

§ 1197. Preliminary Injunction: Grounds of Its Refusal: Defendant's Good Faith 611
1198. Preliminary Injunction: Grounds of Its Refusal: Defendant's Patent 612
1199. Preliminary Injunction: Grounds of Its Refusal: Doubts of the Court as to the Existence of Proper Conditions 615
1200. Preliminary Injunction: Grounds of Its Refusal: Disastrous Consequences if Granted 618
1201. Preliminary Injunction: Granted without Reserve if the Plaintiff is Entitled to it 620
1202. Preliminary Injunction: Bond and Account ordered in Lieu Thereof 623
1203. Preliminary Injunction: Who may be Enjoined: Public Corporations: Private Corporations: Co-Partners 626
1204. Preliminary Injunction: Who may be Enjoined: Co-owners: Assignees: Licensees: Agents, etc. 627
1205. Preliminary Injunction: Who may be Enjoined: Defendant Ceasing to Infringe 629
1206. Preliminary Injunction: Form of Application 629
1207. Preliminary Injunction: Notice to Defendant of Application: Appearance: Answer 631
1208. Preliminary Injunction: Questions Arising on the Application . 632
1209. Preliminary Injunction: Hearing: Production of Evidence . . 633
1210. Preliminary Injunction: Ex Parte Hearings: Burden of Proof . 635
1211. Preliminary Injunction: Form and Scope of Injunction 636
1212. Preliminary Injunction: Effect of Injunction 638
1213. Preliminary Injunction: Dissolution of Injunction 640
1214. Preliminary Injunction: Obligation of Defendant to Obey . . . 642
1215. Preliminary Injunction: How Violated 643
1216. Preliminary Injunction: By Whom Violated 645
1217. Preliminary Injunction: Application for Attachment for Contempt 646
1218. Preliminary Injunction: Order of Attachment: when Issued . . 649
1219. Preliminary Injunction: Penalty for Contempt 650
1220. Perpetual Injunction: when Granted 653
1221. Perpetual Injunction: Duration: Suspension 654
1222. Perpetual Injunction by Consent 655
1223. Perpetual Injunction: Violation: Dissolution 656

CHAPTER IV.

OF WRONGS BETWEEN CONTRACTING PARTIES: AND THEIR REMEDIES.

§ 1224. Rights of Parties to Contracts concerning Patented Inventions Rest on the General Law of Contracts 657
1225. Wrongs against the Rights of the Parties to a Contract concerning Patented Inventions are Breaches of Contract, even where they Infringe the Patent 658

PAGE

§ 1226. As Contracting Parties, Assignors and Assignees and Grantors and Grantees Enjoy the Same Rights and are Subject to the Same Wrongs 659

SECTION I.

OF THE WRONGS COMMITTED BY ASSIGNORS AGAINST ASSIGNEES: AND THEIR REMEDIES.

§ 1227. Contract Rights of the Assignee against the Assignor 660
1228. Remedy of the Assignee when the Assignor Refuses to Convey the Patent 660
1229. Remedy of Assignee when the Title Derived by him from the Assignor Proves Defective 662
1230. Remedy of the Assignee when the Patent Proves to be Invalid . 663
1231. Remedy of the Assignee when the Assignor Procured the Assignment through Deceit 665
1232. Remedy of Assignee for Breach of Warranty 669

SECTION II.

OF WRONGS COMMITTED BY ASSIGNEES AGAINST ASSIGNORS: AND THEIR REMEDIES.

§ 1233. Rights of Assignor against Assignee 670
1234. Remedy of Assignor where the Assignee Refuses to Accept the Assignment. 670
1235. Remedy of Assignor for Breach of the Conditions in the Assignment. 671
1236. Remedy of the Assignor when the Assignee has Procured the Assignment by Fraud 672
1237. Remedy of Assignor when the Assignee Refuses to Pay the Purchase Money 672
1238. Defences of the Assignee against the Assignor's Action for the Purchase Money: Defective Title. 673
1239. Defences of the Assignee against the Assignor's Action for the Purchase Money: Patent Invalid 674
1240. Defences of the Assignee against the Assignor's Action for the Purchase Money: Fraud in the Sale 678
1241. Defences of the Assignee against the Assignor's Action for the Purchase Money: Breach of Warranty 679
1242. Defences of the Assignee against the Assignor's Action for the Purchase Money: Special Statutory Defences 679

SECTION III.

OF THE WRONGS COMMITTED BY LICENSORS AGAINST LICENSEES: AND THEIR REMEDIES.

§ 1243. Rights of the Licensee against the Licensor 682
1244. Remedies of the Licensee against the Licensor: Specific Performance. 683

PAGE

§ 1245. Remedies of the Licensee against the Licensor: Rescission of the License 684
1246. Remedies of the Licensee against the Licensor: Action for Breach of Contract 685
1247. Remedies of the Licensee against the Licensor: Action to Recover Back the Moneys already Paid. 686

SECTION IV.

OF THE WRONGS COMMITTED BY LICENSEES AGAINST LICENSORS: AND THEIR REMEDIES.

§ 1248. Rights of Licensor against Licensee 687
1249. Remedies of Licensor against Licensee: Rescission of License . 687
1250. Remedies of Licensor against Licensee: Action for Breach of Contract 688
1251. Remedies of the Licensor against the Licensee: Action for License Fees for the Use of the Invention 691
1252. Remedies of the Licensor against the Licensee: Action for Royalties on Sales 695

SECTION V.

OF THE WRONGS COMMITTED BY JOINT OWNERS AND OTHER CONTRACTING PARTIES AGAINST EACH OTHER: AND THEIR REMEDIES.

§ 1253. Rights of Co-owners against Each Other 700
1254. Reciprocal Rights of Co-owners who are also Partners 701
1255. Reciprocal Rights of Joint Licensees: Third Parties 702

SECTION VI.

OF THE COURTS HAVING JURISDICTION OVER WRONGS BETWEEN CONTRACTING PARTIES.

§ 1256. Jurisdiction of Federal Courts over Contract Actions. 703
1257. Jurisdiction of State Courts over Contract Actions. 704
1258. Jurisdiction of the Court of Claims 705

APPENDIX 709
INDEX 753

BOOK IV.

OF WRONGS AND REMEDIES.

TREATISE

ON

THE LAW OF PATENTS.

BOOK IV.

OF WRONGS AND REMEDIES.

PRELIMINARY ANALYSIS.

§ 846. Laws for the Protection and Vindication of the Rights of Owners of Patented Inventions Liberally Construed and Applied.

THE various rights created by the exercise of inventive skill, by the grant of letters-patent, and by the contract relations entered into between patentees and other parties, are subject to invasion by numerous wrongs, differing widely in their character and in the nature and application of the remedies by which they are redressed. The law aims to afford complete protection to those from whom the public receive such signal benefits as are conferred upon them by inventors; and where, from the intrinsic difficulties of the case, adequate protection cannot be secured, it endeavors to compensate them fully for the injuries they have sustained. In this department of remedial justice, therefore, is the liberal spirit of our modern jurisprudence toward inventors especially displayed. Not only are their rights clearly and minutely defined and each variety of wrong against them met by an appropriate remedy, but in administering these remedies the courts are uniformly governed by the principle that an inventor, having performed his part of his agreement with the public, is entitled to a perfect

vindication of his rights and to an exhaustive satisfaction for his wrongs. The operation of this principle is particularly apparent in the adjustment of protective measures to actual or threatened injuries, in the flexibility with which the rules of practice are adapted to the exigencies of each individual controversy, in the weight given to the presumptions in favor of the inventor, and in the methods by which damages are ascertained; but every detail of procedure is characterized by the same leaning toward the inventor and against those by whom his rights have been infringed. In that discussion of these various wrongs and remedies, which is to form this concluding portion of our treatise, it will be necessary to consider separately the rights arising from the exercise of inventive skill alone, the rights created by the grant of letters-patent, and the rights resulting from contracts between the owner of the patent and third persons, with the wrongs by which each is invaded, and the remedies by which those wrongs may be redressed.

§ 847. Protection of the Rights of an Inventor in his Unpatented Invention.

By the performance of an inventive act the inventor acquires a property in the invention which he thus creates, irrespective of its future protection by a patent. This property vests in him by the law of nature, and by the same law may be divested in any manner which places it in the possession of the public. Before the establishment of patent systems the knowledge of the public was equivalent to the possession of the public, and an inventor could retain the property in his invention only while he preserved his secret. Under the Patent Law he can disclose the nature and the mode of use of his invention without surrendering it until his patent has expired; and under our American law he can use it publicly for a certain period before applying for a patent without the risk of thereby forfeiting his exclusive rights. The property which thus vests in him by the law of nature, enlarged in its enjoyment by the provisions of our Patent Law, is recognized as entitled to the same protection as any other form of property; and whether attacked by force or

fraud his rights therein are vindicated by the courts, and the wrongs committed against them are adequately redressed.

§ 848. Protection of the Rights of an Inventor in his Patented Invention.

The issue of a patent confers on the inventor additional rights of extraordinary scope and value. Not only is he now empowered to use his invention in public, and to permit others to use it, without abandoning his own dominion over it, but he is clothed with an authority whereby he can prohibit the enjoyment of the invention to all persons whomsoever, even although they are original inventors like himself. The monopoly created by his patent prevails over all the rights which later inventors of the same invention would otherwise acquire by the exercise of their inventive skill, and renders their use of their own inventions, whether openly or in secret, equally an infringement of his rights as if they were mere imitators of his results. The patentee, under a valid patent, thus owns the invention as his exclusive property, whose value is capable of being lessened or destroyed by any act which impairs its commercial importance, or converts the proceeds of its enjoyment into other channels; and for any such injury, of whatever character, the law provides a remedy as ample and efficient as it is in the nature of human jurisprudence to afford.

§ 849. Protection of the Contract Rights of the Inventor and his Transferees.

An invention, whether patented or unpatented, being, like other property, subject to conveyance by its owner in such interests and upon such terms as he may deem expedient, various relations may arise between him and his transferees, to each of which attach certain rights and obligations, susceptible of violation in numerous modes and requiring protection and vindication according to the nature of the injuries threatened or received. These relations are divisible into two groups, — one characterized by a conveyance which transfers the monopoly as well as the invention, and embracing assignors and assignees and grantors and grantees; the other by a conveyance which operates upon the invention alone, leav-

ing the monopoly unaffected in the hands of its former owner except by an estoppel in favor of the transferee, and includes all such parties as are known by the general names of licensors and licensees. The rights and duties of the different members of each of these two groups are so far similar that they may be properly treated together with reference to the wrongs by which they are invaded and the remedies applied for their redress.

§ 850. Protection of the Contract Rights of Assignors and Assignees.

The rights of the assignor against the assignee and of the grantor against the grantee are few and simple. The principal one is the right to recover the price which the assignee or grantee has agreed to pay for the interests transferred to him. The others grow out of special stipulations contained in the conveyance, or from the general law which limits the enjoyment of the transferee to the precise privileges conferred upon him by the owner of the invention. The rights of the assignee against the assignor, and similarly of the grantee against the grantor, are more numerous and complex. He has a right to the transfer to him of the invention and the patent according to the terms of the contract made between them. Upon a total failure of the consideration moving toward him he has a right to recover back the purchase-money which he has already paid. If the conveyance contains covenants of warranty he is entitled to their fulfilment, or to damages for their breach, as well as that of the implied warranty of title which enters into all transfers of property. He has a right also to good faith and fair dealing on the part of his grantor or assignor, and to a remedy for any fraud that may be practised upon him.

§ 851. Protection of the Contract Rights of Licensors and Licensees.

The rights of the licensor against the licensee resemble those of assignors against their assignees. He is entitled to the license fee or royalties which the licensee agrees to pay for the enjoyment of his privilege, and to the compliance of

the licensee with those restrictions which the license or the law itself imposes on him. The licensee, under certain circumstances, has a right to repudiate the license and to recover back the license-fees which he has paid. He has a right to be defended by the licensor against infringers whose practice of the invention is injurious to his interests. He acquires rights also under the covenants in his license, whether express or implied, and to the estoppel by virtue of which he is protected against an assertion of the monopoly by the licensor in derogation of the privilege that his license has conferred. For a violation of any of these rights, and for any fraud or imposition of which the licensor is guilty in obtaining his submission to the patent, he has his remedy in an appropriate and effective form.

§ 852. General Division of the Subject of Wrongs and Remedies.

This outline of the rights connected with inventions indicates the topics to which a discussion of wrongs and remedies must relate and the order in which they must be pursued. Hence we shall consider in the following pages: —

I. Wrongs against the owners of unpatented inventions.
II. Wrongs against patentees.
III. *Wrongs between contracting parties.*

And in connection with each class of wrongs the remedies provided by the law for their redress.

§ 853. Remedies for Certain Wrongs Afforded by Federal Courts: for Other Wrongs by State Courts: this Distinction Preliminary.

Before entering upon this discussion a collateral topic, affecting to a certain extent the details of each of these main topics, must, however, be examined. In the United States every person resides under two different governments, and is subject to two different systems of jurisprudence. His rights are protected by two distinct bodies of law, and his wrongs are redressed in the courts of two independent sovereignties. In reference to every group of wrongs and remedies the question, therefore, arises whether the wrongs invade the rights

protected by the State or by the Federal law, and whether the remedies are to be applied by the Federal or by the local courts. This question is particularly important in connection with the rights in patented inventions, since some of these rights depend upon the laws of the United States, and others on the laws of individual States; and thus in instituting any action for a violation of these rights it must be first determined whether the cause is one of State or Federal jurisdiction. To avoid the discussion of this question in connection with each wrong and its remedy, the entire subject will be here considered in a preliminary chapter.

CHAPTER I.

OF THE JURISDICTION OF THE FEDERAL AND STATE COURTS OVER ACTIONS WHICH RELATE TO PATENTED INVENTIONS.

§ 854. Federal Jurisdiction where Parties are Citizens of Different States: this Jurisdiction not Exclusive.

Courts derive their jurisdiction over actions either from the residence of the parties or from the subject-matter of the controversy. The Federal courts having no jurisdiction other than that conferred upon them by the Acts of Congress in pursuance of the Constitution, the State courts retain sole cognizance of all actions not thus specifically placed under the jurisdiction of the Federal courts. Jurisdiction has been bestowed upon the Federal courts in certain cases, on the ground of the residence of the parties, if the plaintiff and defendant are citizens of different States. In such cases the nature of the subject-matter of the controversy is of no importance.[1] The rules which determine whether jurisdiction on this ground exists, being common to all wrongs and remedies, will not be here discussed, the reader having access to them in works particularly devoted to that subject. In the following examination of the other ground of jurisdiction it will be assumed that the citizenship of the parties to the controversy is the same.

§ 855. Federal Jurisdiction Exclusive over all Cases Arising under the Patent Laws.

Jurisdiction, on the ground of subject-matter, has been vested in the Federal courts over all cases arising under the

§ 854. [1] That where the parties on one side of the controversy differ in citizenship from the parties on the other side, the Federal courts have jurisdiction, see Campbell *v.* James (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354.

Patent Laws.[1] This jurisdiction is exclusive, and hence no suit arising under the Patent Laws, whatever may be the residence of the parties, can fall within the cognizance of any local court.[2] In any given case, therefore, the jurisdictional question is determined as soon as it is ascertained whether or not the case itself is included in the class above described. The line which divides this class from all that lie outside it is now clearly defined, both upon principle and by the concurrent decisions of the State and Federal courts.

§ 856. *Cases Arising under the Patent Laws are Cases Affecting the Monopoly Created by such Laws.*

The purpose and effect of the Patent Laws is to create and preserve a monopoly in the patented invention in favor of the patentee. They are not concerned with the invention as dis-

§ 855. [1] That the Federal courts have exclusive jurisdiction over all cases arising under the Patent Laws, see Willis *v.* McCollin (1886), 38 O. G. 1017; Brown *v.* Texas Cactus Hedge Co. (1885), 64 Tex. 396; Page *v.* Dickerson (1871), 28 Wis. 694; Slemmer's Appeal (1868), 58 Pa. St. 155.

That under the act of 1819 the jurisdiction of the Federal courts was not exclusive, see Burrall *v.* Jewett (1830), 2 Paige (N. Y.) 134; qualified by Gibson *v.* Woodworth, 8 Paige (N. Y.), 132.

[2] That the Federal courts have exclusive jurisdiction over any controversy as to the patent right without regard to the citizenship of the parties, see Duke *v.* Graham (1884), 19 Fed. Rep. 647; Campbell *v.* James (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354; Allen *v.* Blunt (1849), 1 Blatch. 480.

That where the subject-matter confers jurisdiction any issue as to citizenship is immaterial, see Fischer *v.* Neil (1881), 6 Fed. Rep. 89; 19 O. G. 603.

That the act of March 3, 1875, changed the law of 1789, and gave jurisdiction to the Circuit Court over all patent cases wherever the parties may reside, see Celluloid Mfg. Co. *v.* Goodyear Dental Vulcanite Co. (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

That the jurisdiction of the Federal courts over patent cases is not dependent on the amount involved, see St. Paul Plow Works *v.* Starling (1888), 127 U. S. 376; 43 O. G. 1350.

That under the act of March 3, 1887, the $2,000 limitation does not apply to jurisdiction over patent cases, see Miller Megee Co. *v.* Carpenter (1887), 43 O. G. 1118.

That the object of conferring jurisdiction over all patent cases on the Federal courts was to secure uniformity in the law on all points as to rights and remedies, see Read *v.* Miller (1867), 3 Fisher, 310; 2 Bissell, 12.

That the Supreme Court will not reverse a decree for want of jurisdiction in the court below, if the court had jurisdiction, though on narrow grounds, when the bill was filed, and the defendant did not then except, see Clark *v.* Wooster (1886), 119 U. S. 322; 37 O. G. 1477.

tinguished from the monopoly, nor with the mode and extent of the enjoyment of the privileges which the monopoly confers. They vest in the patentee an exclusive right to practise the invention and thereby forbid all other persons to employ it except with his consent; and while this right exists and remains uninvaded by the wrongful use of the invention their object is accomplished. The rights of the patentee in the patented invention considered as an article of property, and the obligations into which he enters with others as to its ownership or enjoyment, are matters collateral to the existence and continuance of the monopoly, dependent upon it indeed but not affecting it, and capable of assertion or repudiation without impairing the exclusive privilege which it bestows. Until, therefore, a controversy arises involving the existence or preservation of the monopoly, there can be no case under the Patent Laws.[1] All other controversies relate to property rights or contract rights which fall within the purview of the general laws, and are thus to be determined by the tribunals having ordinary jurisdiction over such subjects.[2]

§ 856. [1] That the Federal courts have no jurisdiction unless the rights of the patentee under the Patent Laws of the United States are directly in issue, see Teas *v.* Albright (1882), 22 O. G. 2069; 13 Fed. Rep. 406.

That a patent matter, conferring jurisdiction, is a matter regulated by the Patent Laws of the United States, see Blanchard *v.* Sprague (1859), 1 Clifford, 288.

That the Federal courts do not have jurisdiction over a suit merely because it may become necessary in it to attack or defend a patent, see Merserole *v.* Union Paper Collar Co. (1869), 3 Fisher, 483; 6 Blatch. 356.

That the existence and validity of the monopoly, as claimed under the patent, are the only questions arising under the Patent Laws, see Blakeney *v.* Goode (1876), 30 Ohio St. 350; Celluloid Mfg. Co. *v.* Goodyear Dental Vulcanite Co. (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

[2] That a question of contract concerning a patent-right or a patented invention is not a question under the Patent Laws, see Ingalls *v.* Tice (1882), 14 Fed. Rep. 352; Hartell *v.* Tilghman (1878), 99 U. S. 547; Tilghman *v.* Hartell (1876), 9 O. G. 886; 2 Bann. & A. 260; Hill *v.* Whitcomb (1874), 5 O. G. 430; 1 Bann. & A. 34; Holmes, 317; Green *v.* Wilson (1870), 6 C. E. Green, (N. J.) 211; Bloomer *v.* Gilpin (1859), 4 Fisher, 50; Goodyear *v.* Union Rubber Co. (1857), 4 Blatch. 63; Nesmith *v.* Calvert (1845), 1 W. & M. 34; 2 Robb, 311.

That a bill to subject a patent to an execution does not present a case under the Patent Laws, see Ryan *v.* Lee (1882), 10 Fed. Rep. 917.

§ 857. Three Classes of Cases Affect the Monopoly.

Controversies involving the existence and preservation of the monopoly may assume any one of three forms: (1) An *affirmation and denial as to the legal existence* of the monopoly in favor of any person; (2) An affirmation and denial as to the existence of the monopoly in favor of the patentee; (3) An affirmation and denial concerning the character of the matters embraced in the monopoly. In the first form, the patentability of the invention is the subject of dispute; in the second, the title of the patentee or his assignee; in the third, the scope of the monopoly, or in other words its existence as to certain instruments or operations claimed by the patentee to lie within it.[1] None of these controversies can be decided

§ 857. [1] That any issue concerning the validity of a patent, the title of the alleged owner of the patent, or the fact of infringement, involves the monopoly itself, and is consequently under the exclusive jurisdiction of the Federal courts, has been recognized in a multitude of cases, both Federal and State, of which the following are examples:—

As to validity:

Dale Tile Mfg. Co. *v.* Hyatt (1888), 125 U. S. 46; 43 O. G. 249; Brown *v.* Texas Cactus Hedge Co. (1885), 64 Tex. 396; Maurice *v.* Devol (1883), 23 W. Va. 247; Rawson *v.* Harger (1878), 48 Iowa, 269; Green *v.* Willard Improved Barrel Co. (1876), 1 Mo. Ap. 202; Page *v.* Dickerson (1871), 28 Wis. 694; Merserole *v.* Union Paper Collar Co. (1869), 3 Fisher, 483; 6 Blatch. 356; Tomlinson *v.* Battell (1857), 4 Abb. Pr. 266; Rich *v.* Atwater (1844), 16 Conn. 409.

As to title:

In Duke *v.* Graham (1884), 19 Fed. Rep. 647, Hill, J.: (648) "If this had been a transaction accruing after the issuance of the letters-patent, the parties both being citizens of this State, it is clear that this court would have no jurisdiction of the subject-matter of the suit; but it is a question involving the property rights, so to speak, of the defendant in the letters-patent themselves, and as between the co-partners themselves. The bill seeks to set aside the rights conferred upon defendant as one of the partners, and to vest the entire right in complainant. This, it seems to me, affects the patent, and also seeks to restrain the defendant from using in any way the rights conferred under the Swift patent, and which, by the understanding of the parties, was to become, in connection with complainant's improvement thereon, the joint property of complainant and defendant, — the rights secured by the letters-patent issued by the government Nov. 16, 1880,—and is essentially different from rights growing out of contracts between the patentees and third parties. I am of opinion that this court has jurisdiction to determine the question as to the right of the parties to the rights and benefits conferred by the patent issued to them by the government, and enforce their rights by a proper decree."

In Hyatt *v.* Ingalls (1883), 49 Sup. Ct. (N. Y.), 375, Freedman, J.: (378) "A grant to a patentee of an exclusive right to manufacture and vend an article described therein is a grant of property; and if the validity of the

without affecting the monopoly and enforcing, enlarging, or curtailing the rights created and bestowed under the Patent Laws; while if the patentability and scope of the invention and the title of the patentee are conceded, there can be no question in relation to the existence and continuance of the monopoly. Cases not presenting one or more of these three forms of controversy are, therefore, not cases arising under the *Patent Laws*.

patent is unquestioned, State courts will protect the owner of such property in the enjoyment thereof, by means of a decree of injunction, to the same extent as they would do were the subject-matter of the litigation of any other description. But where the validity of the plaintiff's patent is put in question by the pleadings in a State court, and the defendants present such proofs upon the trial as render it necessary for the court to examine and pass upon conflicting patents or claims of priority in invention, in order to determine whether the plaintiff has such a property in the subject-matter of the grant as entitles him to the exclusive and unmolested use of it, and an objection is taken to the jurisdiction of the court for that reason, the bill must be dismissed; for in such cases the jurisdiction is in the courts of the United States exclusively. (Hovey *v.* Rubber Tip Pencil Co., 33 Sup. Ct. 522; affirmed 57 N. Y. 119.)"

In Campbell *v.* James (1880), 18 O. G. 1111, Wheeler, J.: (1113) "It is quite obvious from this statement that all these questions are questions of title to the patent which arise under the Patent Laws. . . . It has never been doubted but that the Circuit courts have jurisdiction of all such questions, whatever the doubts and decisions may have been when neither the title itself nor any question as to whether there was an infringement was before the court. (Hartell *v.* Tilghman, 99 U. S. 547.)" 2 Fed. Rep. 338 (344); 18 Blatch. 92 (98); 5 Bann. & A. 354 (360).

That the Federal courts have jurisdiction over a controversy as to what patents are covered by the assignment of an invention before patent, see Puetz *v.* Bransford (1887), 41 O. G. 353; 32 Fed. Rep. 318.

As to infringement:

That the jurisdiction of the Federal courts over the question of infringement is exclusive, see Kayser *v.* Arnold (1886), 41 Hun, 275; Continental Store Service Co. *v.* Clark, (1885), 100 N. Y. 365: Kelly *v.* Kelly Scroll Mfg. Co. (1884), 15 Bradwell (Ill.), 547; Smith *v.* Standard Laundry Mach. Co. (1882), 22 O. G. 587; 20 Blatch. 360; 19 Fed. Rep. 825; Campbell *v.* James (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354; Satterthwait *v.* Marshall (1872), 4 Del. Ch. 337; Merserole *v.* Union Paper Collar Co. (1869), 3 Fisher, 483; 6 Blatch. 356; Bloomer *v.* Gilpin (1859), 4 Fisher, 50.

That actions under the Patent Laws are only for the purpose of protecting the patentee from infringements, see Celluloid Mfg. Co. *v.* Goodyear Dental Vulcanite Co. (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

That a proceeding to enforce a contract is totally different from an infringement suit, see Brown *v.* Shannon (1857), 20 How. 55.

§ 858. Controversies Collateral to Cases not Embraced in one of these Three Classes are not Cases Affecting the Monopoly.

Furthermore, a case or cause is a controversy in which the rights of the parties are judicially determined. The affirmations and denials constituting the controversy must result in one or more issues which by the judgment of the court are to be conclusively and permanently settled, so far as the parties and their privies are concerned. A controversy which arises collaterally to some other controversy, and whose decision enters into the adjudication of the latter only as a matter of evidence and not as an essential element in the judgment, is not a cause, nor is its decision binding even on the same parties when engaged in a different litigation. Subordinate controversies of this character constantly arise in the course of legal proceedings, such as the controversy as to title in actions *quare clausum*, or as to the truth of the publication in actions for slander, but they are no part of the cause itself, and the finding of the court concerning them is simply the determination of a fact which serves as the basis of an inference regarding some essential matter covered by the issue. The mere presence in the cause of a controversy relating to the patentability or the scope of an invention, or the title of the patentee, does not bring the case among those which arise under the Patent Laws. The existence or continuance of the monopoly must be put in issue, and submitted to the judgment of the court for permanent and conclusive settlement between the parties, and not as a subordinate or collateral matter whose decision paves the way to that of the real controversy.[1]

§ 858. [1] In Tomlinson *v.* Battell (1857), 4 Abb. Pr. 266, Duer, J.: (268) "It is not necessary to deny that when a question as to the construction, and, perhaps, as to the validity, of a patent arises, collaterally, in the progress and upon the trial of a cause, the necessity of its determination will not oust a State court of the jurisdiction which it derived from the nature of the action and the state of the pleadings. But here the existence and validity of a patent concerning the process, by which are produced the pictures to which alone the name of ambrotypes can properly be given, lie at the very foundation of the plaintiff's claim. They are facts constituting, in part, the cause of action; as such they are averred in the complaint, and as such are put at issue by the answer. It is upon an exclusive right secured by a patent that the action is founded. It is this exclusive right that the answer denies, and it is

§ 859. An Action to Repeal a Patent is a Case Affecting the Monopoly.

The principal, if not the only, cases in which the existence or continuance of the monopoly are directly in issue and determined by the judgment are actions brought to repeal a patent, actions to annul an interfering patent, and actions for infringement. An action to repeal a patent is instituted for the purpose of destroying the monopoly. It is an effort of the sovereign power to frustrate the creative act in which the monopoly originated, and to return the invention to its former unpatented condition. It puts in issue the right of the government to grant or of the patentee to receive the patent, and if successful terminates in a judgment which conclusively and permanently deprives the patentee of his exclusive rights. Such actions are, therefore, pre-eminently cases arising under the Patent Laws, and consequently are within the exclusive jurisdiction of the Federal courts.[1]

§ 860. An Action to Annul an Interfering Patent is a Case Affecting the Monopoly.

An action to annul an interfering patent does not aim at the entire destruction of all monopoly in the invention, but at the discontinuance of that created in favor of the defendant patentee. It can be instituted only between parties who concede the patentability of the invention and the right to a monopoly in some one as against the public, but each of whom claims for himself the right to that monopoly to the exclusion of the others. Before its institution at least two patents covering the same invention must have been granted to two inde-

this denial which raises a question that, when thus raised, neither this nor any other State court, in my judgment, has authority to determine, — a question which I have no right to determine, and must refuse to consider."

Further, that the Federal courts obtain jurisdiction, on the ground of the subject-matter of the controversy, only when validity, title, or infringement are put in issue by the pleadings and must enter into the judgment, see Teas *v.* Albright (1882), 22 O. G. 2069; 13 Fed. Rep. 406; Blakeney *v.* Goode (1876), 30 Ohio St. 350; Satterthwait *v.* Marshall (1872), 4 Del. Ch. 337; Green *v.* Wilson (1870), 6 C. E. Green (N. J.), 211; Rich *v.* Atwater (1844), 16 Conn. 409.

§ 859. [1] That a suit for the repeal of a patent is within the exclusive jurisdiction of the Federal courts, see Merserole *v.* Union Paper Collar Co. (1869), 3 Fisher, 483; 6 Blatch. 356.

pendent patentees, thereby apparently creating two distinct concurrent monopolies in the same art or article, one of which only can be valid, the prior inventor having the sole right to a patent protecting him in its exclusive use.[1] This proceeding, being intended to avoid the patents granted to his later rivals, denies the legal existence of the monopolies which they appear to have received, and seeks the cancellation of their letters-patent in order to deprive them of their *prima facie* title to the invention, and to remove the cloud which their possession of these patents casts upon his own. The fact in issue is the title of the patentee to his monopoly, and the judgment rendered, in accordance with the issue, conclusively confirms or destroys this monopoly as between the parties to the action. An action to annul a patent is thus a case arising under the Patent Laws, and hence is within the exclusive jurisdiction of the Federal courts.[2]

§ 861. An Action for Infringement is a Case Affecting the Monopoly.

An action for infringement, though an action of tort demanding compensation for the past invasion of the patentee's exclusive rights, nevertheless directly involves the existence or the scope of the monopoly or the title to the patent. An infringement can be committed only by the practice of the patented invention without the permission of the patentee. An allegation of infringement, therefore, includes an averment that the invention is the proper subject of a monopoly, an averment that the monopoly has been properly conferred upon the patentee as the first and true inventor, and an averment that the monopoly embraces the invention practised by the alleged infringer. A denial of infringement controverts the patentability of the invention, or the title of the patentee, or the scope of the monopoly, and thus puts in issue the exist-

§ 860. [1] As to the nature of an action to annul an interfering patent, &c., see §§ 721–724, and notes, *ante*.

[2] That the Federal courts have exclusive jurisdiction over actions to annul an interfering patent, see Rice *v.* Garnhart (1874), 34 Wis. 453; Gibson *v.* Woodworth (1840), 8 Paige (N. Y.), 132.

That the Federal courts have exclusive jurisdiction over all actions between adverse patentees as to infringement or priority, see Rice *v.* Garnhart (1874), 34 Wis. 453.

ence of the monopoly so far forth as the acts of the alleged infringer are concerned. A judgment on this issue determines, as between the parties, either that the monopoly does or does not legally exist at all; or does or does not legally exist in favor of the patentee; or does or does not legally exist as against the acts performed by the defendant; none of which questions can arise except under the Patent Laws, or be decided elsewhere than in the Federal courts.[1]

§ 861. [1] That the Federal courts have exclusive jurisdiction over all actions for infringement, see De Witt *v.* Elmira Nobles Mfg. Co. (1876), 66 N. Y. 459; Smith *v.* McClelland (1875), 11 Bush, 523; Rice *v.* Garnhart (1874), 34 Wis. 453; Stone *v.* Edwards (1872), 35 Tex. 556; Slemmer's Appeal (1868), 58 Pa. St. 155; Kendall *v.* Winsor (1860), 6 R. I. 453; Elmer *v.* Pennel (1855), 40 Me. 430; Dudley *v.* Mayhew (1849), 3 Comst. (N. Y.), 9; Burrall *v.* Jewett (1830), 2 Paige (N. Y.), 134; Parsons *v.* Barnard (1810), 7 Johns. 144; and cases cited in § 857, note 1, *ante*.

That one co-owner of a patent cannot sue for compensation for its use by an infringer in a State court, the cause of action not being contract but infringement, see De Witt *v.* Elmira Nobles Mfg. Co. (1876), 66 N. Y. 459.

That the purchaser of an exclusive right to sell must sue an infringer in the Federal courts, see Stone *v.* Edwards (1872), 35 Tex. 556.

That the Federal courts have jurisdiction over a suit for infringement by a licensor against his licensee though both are citizens of the same State, and the licensee denies that the license is terminated and that he infringes, see Smith *v.* Standard Laundry Mach. Co. (1882), 19 Fed. Rep. 825; 20 Blatch. 360; 22 O. G. 587.

That the Federal courts have jurisdiction over a suit for infringement brought by the licensee against the licensor, see Stanley Rule & Level Co. *v.* Bailey (1878), 14 Blatch. 510; 3 Bann. & A. 297.

That when a licensor annuls the license and obtains a decree for a rescission and an account to that date, a future use of the invention by the licensee will be an infringement of which only the Federal courts can take cognizance, see Hyatt *v.* Ingalls (1883), 49 Sup. Ct. N. Y. 375.

That a State Court cannot restrain a licensee from using the invention pending a suit by the patentee against him for royalties, see Hat Sweat Mfg. Co. *v.* Remochl (1886), 102 N. Y. 167.

That a State court cannot enjoin against a suit for infringement in the Federal courts, see Kendall *v.* Winsor (1860), 6 R. I. 453.

That a State statute cannot deprive a Federal court of jurisdiction by conferring power on local officers to adjust claims against their local governments, see May *v.* Saginaw Co. (1887), 32 Fed. Rep. 629.

That in a suit for infringement in the Federal courts the rights of the parties will be determined under the Patent Laws without regard to the decision of a State court in a suit concerning their contract relations, see Oliver *v.* Rumford Chemical Works (1883), 109 U. S. 75; 25 O. G. 784.

§ 862. Cases Affecting the Monopoly are within the Exclusive Jurisdiction of the Federal Courts though Involving Collateral Controversies not Arising under the Patent Laws.

The exclusive jurisdiction of the Federal courts over all cases which involve the existence or continuance of the monopoly is not affected by the complication of this question with others which, if presented independently, these courts would have *no* power to decide.[1] Claims of infringement growing out of contract relations between the parties are no less proper subject-matter for the Federal Courts than similar claims based on wanton and malicious interference with the patented invention. Where, for example, a co-owner, under an agreement to procure a re-issue in the names of all, accepts the title to the patent and fraudulently obtains a re-issue to himself, under the color of which he employs infringing articles, his breach of contract and of trust, though affording his co-owners other grounds of action, do not deprive them of their right to sue him for infringement in the Federal courts.[2] Or where a licensor, who should protect his licensee against infringement, himself becomes the infringer and consequently cannot vindicate the rights he has conferred, the licensee, although he has a remedy upon his contract, is not deprived of his right to have the infringer punished or restrained, and is permitted to proceed against him in his own name, *ex necessitate rei*, in the Federal tribunals.[3] Or again, where a

§ 862. [1] That the Federal courts have exclusive jurisdiction over all questions of validity, title, or infringement, though other matters are collaterally involved, see Teas *v.* Albright (1882), 22 O. G. 2069; 13 Fed. Rep. 406; Smith *v.* Standard Laundry Mach. Co. (1882), 22 O. G. 587; 20 Blatch. 360; 19 Fed. Rep. 825; Brooks *v.* Stolley (1845), 3 McLean, 523; 2 Robb, 281.

That the Federal courts have jurisdiction over a suit to prevent the violation of a patent though the defence may rest on a contract between the parties, see Seibert Cylinder Oil-Cup Co. *v.* Manning (1887), 32 Fed. Rep. 625.

[2] That the Federal courts have jurisdiction over a bill to enjoin a co-owner from using the invention, under an agreement to re-issue in their joint names as such co-owners, see Duke *v.* Graham (1884), 19 Fed. Rep. 647.

[3] In Stanley Rule & Level Co. *v.* Bailey (1878), 14 Blatch. 510, Shipman, J.: (511) "It is not necessary in this case, the patentee and legal owner of the patent being the alleged infringer, to determine whether, under the recited agreement, the plaintiff is the grantee of such an exclusive right

license has existed but has been annulled and the licensee continues to practise the invention, or where the licensor alleges that the license has expired and the licensee insists that it is still in force,[4] and in all other cases where the existence and scope of the monopoly are put in issue and decided, whatever may have been the circumstances out of which the alleged infringement has arisen and by whatever implications or agreements it may now be justified or excused, the controversy is a cause under the Patent Laws of the United States, and the exclusive jurisdiction of the Federal courts on this issue draws after it the power to decide all other matters which are necessary to its full determination.[5]

§ 863. Cases Affecting the Monopoly not Brought within the Jurisdiction of State Courts by Consent of Parties.

Where jurisdiction is exclusively conferred on one tribunal on the ground of subject-matter, no other tribunal can in any manner obtain cognizance thereof. Neither the convenience nor consent of the parties can bestow a power which the law has expressly or impliedly withheld, and though for want of this the interests of parties are imperilled, it is a defect in practical jurisprudence which the law itself and not the courts

that it can bring suit in its own name alone against strangers who are infringers, or is, as is claimed by the defendant, merely a licensee. In this case the patentee is the alleged infringer, and the Circuit Court has jurisdiction of the cause, whether the plaintiff is grantee or licensee. When the patentee has infringed his license, and, while holding the legal title to the patent in trust for his licensee, has been faithless to his trust, 'Courts of equity are always open to the relief of such a wrong. This wrong is an infringement. Its redress involves a suit, therefore, arising under the Patent Laws, and of that suit the Circuit Court has jurisdiction.' Littlefield *v.* Perry, 21 Wall. 205, 223." 3 Bann. & A. 297 (299).

[4] That when a licensee continues to practise the invention after his license is expired, claiming it to be still in force, the question is one for the Federal courts, being a question of infringement, see Smith *v.* Standard Laundry Mach. Co. (1882), 20 Blatch. 360; 22 O. G. 587; 19 Fed. Rep. 825.

That an action for royalties in which the validity of the patent and the fact of infringement are in issue and must be decided, is within the jurisdiction of the Federal courts, see St. Paul Plow Works *v.* Starling (1888), 127 U. S. 376; 43 O. G. 1350.

[5] That jurisdiction having been once acquired on the ground of infringement, the court may grant complete relief and settle all other matters, though they are not original grounds of jurisdiction, see Bloomer *v.* Gilpin (1859), 4 Fisher, 50; Brooks *v.* Stolley (1845), 3 McLean, 523; 2 Robb, 281.

must remedy.[1] Thus in regard to cases which arise under the Patent Laws, and over which exclusive jurisdiction has been vested in the Federal courts, no State court can under any circumstances assume to exercise its judicial powers. Under whatever guise an action may be brought, if in reality it is a case which puts in issue and requires a judgment upon the existence or continuance of the monopoly created by a patent, it is the duty of the local court to dismiss it or provide for its removal to the courts by whom alone such issues can be lawfully determined.

§ 864. Actions for Breach of Contract or for Tort to the Patented Article are not Cases Affecting the Monopoly.

The existence and scope of the monopoly conferred by letters-patent rest entirely upon the provisions of the Patent Law. Whether or not the invention possesses the several requisites for patentability, whether or not the patentee is the first and true inventor, and whether or not the monopoly embraces any given art or article are facts which no act of the patentee or other parties can in any manner change; and when the law acting in view of these facts has bestowed the monopoly and defined its limits, its existence and its scope are fixed beyond the power of individuals to alter. Hence no contract entered into between the patentee and other persons, either before or after the issue of the patent, can in any degree affect the nature or extent of the monopoly. No injury to the property of the patentee in the invention, other than its unauthorized appropriation in violation of the patent, is an invasion of the monopoly. Neither the breach of such a contract, nor the commission of such an injury, can, therefore, form the basis of an action arising under the Patent Laws, although the subject-matter of the one and the property affected by the other is a patented invention. The wrongs

§ 863. [1] That a defendant cannot waive an objection to the want of jurisdiction of a State court over an action for infringement, see Dudley *v.* Mayhew (1849), 3 Comst. (N. Y.), 9.

That a State court cannot assume jurisdiction on the ground that the parties can be witnesses under State laws, see Kendall *v.* Winsor (1860), 6 R. I. 453.

That no laches of the defendant can waive an objection to the jurisdiction over the subject-matter, see Creamer *v.* Bowers (1887), 30 Fed. Rep. 185.

are in both cases wrongs at common law, and are to be redressed in the tribunals and by the methods ordinarily provided for such injuries. Over these, therefore, the State courts have exclusive jurisdiction, unless a difference in the citizenship of the opposing litigants confers it also on the Federal courts.

§ 865. Actions for Breach of Contract, and for Torts to the Patented Article, are within the Jurisdiction of State Courts.

Citizenship being the same, the State courts have sole cognizance of all actions based on contracts between the parties, whether to compel their performance, to rescind them, or to award damages for their violation.[1] Actions for breach of warranty, for fraud, for royalties or purchase-money, and for

§ 865. [1] That an action to compel specific performance is within the exclusive jurisdiction of State courts unless the parties are of different citizenship, see Wren *v.* Annin (1888), 34 Fed. Rep. 435; Perry *v.* Littlefield (1879), 4 Bann. & A. 624; 17 O. G. 51; 17 Blatch. 272; Brown *v.* Shannon (1857), 20 How. 55.

That the fact that the subject-matter of the suit is a contract concerning a patent-right does not give the Federal courts jurisdiction, and that a bill for specific performance of such a contract must contain averments showing other grounds of jurisdiction, see Nesmith *v.* Calvert (1845), 1 W. & M. 34; 2 Robb, 311; Burr *v.* Gregory (1828), 2 Paine, 426.

That a breach of contract between assignor and assignee as to the mode of enjoying the patent is not within Federal jurisdiction, see Williams *v.* Star Sand Co. (1888), 35 Fed. Rep. 369.

That a suit to cancel or enforce a license is not within the jurisdiction of the Federal courts unless the parties reside in different States, and this must be alleged in the bill, see Merserole *v.* Union Paper Collar Co. (1869), 3 Fisher, 483; 6 Blatch. 356; Goodyear *v.* Union Rubber Co. (1857), 4 Blatch. 63.

That the Federal courts have no jurisdiction of a bill to enforce a contract as to the use of a patent where both of the parties are citizens of the same State, though they may protect the patentee from infringement by injunction, see Brooks *v.* Stolley (1845), 3 McLean, 523; 2 Robb, 281.

That Federal courts have no jurisdiction by virtue of the Patent Laws over a suit to enforce or rescind a license-contract, see Dale Tile Mfg. Co. *v.* Hyatt (1888), 125 U. S. 46; 43 O. G. 249; Hammacher *v.* Wilson (1886), 36 O. G. 233; 26 Fed. Rep. 239; Hartell *v.* Tilghman (1878), 99 U. S. 547.

That if a subsisting license is proved, and the parties are citizens of the same State, the Federal courts have no jurisdiction, see Jencks *v.* Langdon Mills (1886), 36 O. G. 347; 27 Fed. Rep. 622.

That the Federal courts may decide whether there is a subsisting license, or whether a license has been forfeited, but cannot enforce or avoid it where citizenship is the same, see Hammacher *v.* Wilson (1886), 36 O. G. 233; 26 Fed. Rep. 239.

the non-fulfilment of other collateral contracts, are also within their exclusive jurisdiction.[2] In such actions the validity of the patent, and consequently the existence of the monopoly, may be disputed and incidentally decided as preliminary to some point in issue, and thus the court may pass upon the same matters as are involved in cases arising under the Patent Laws; but upon these the judgment has no effect even between the parties, and the same questions are still open in any other litigation in which they may engage.[3] An action

[2] That where the validity of the patent and the use by the defendant are admitted, and all the rights are covered by contracts, the case does not arise under the Patent Laws, and the Federal courts have no jurisdiction unless the citizenship of the parties is different, see Ingalls *v.* Tice (1882), 14 Fed. Rep. 352; Hartell *v.* Tilghman (1878), 99 U. S. 547; Tilghman *v.* Hartell (1876), 9 O. G. 886; 2 Bann. & A. 260; Lockwood *v.* Lockwood (1871), 33 Iowa, 509; Green *v.* Wilson (1870), 6 C. E. Green (N. J.), 211; Bloomer *v.* Gilpin (1859), 4 Fisher, 50.

That Federal courts have no jurisdiction over suits for royalties, see Albright *v.* Teas (1883), 106 U. S. 613; 23 O. G. 829.

That the Federal courts have no jurisdiction over contracts between patentees and their licensees, see Willis *v.* McCollin (1886), 38 O. G. 1017; Hill *v.* Whitcomb (1874), 5 O. G. 430; Holmes, 317; 1 Bann. & A. 34.

That one holding an exclusive license may be protected against injuries by injunction in a State court, unless the patent is in question, see Hyatt *v.* Ingalls (1883), 49 Sup. Ct. N. Y. 375.

[3] In Hyatt *v.* Ingalls (1883), 49 Sup. Ct. N. Y. 375, Freedman, J.: (378) "There is, however, a class of cases in which the defendant cannot question the validity of the plaintiff's patent, because by his contract he has estopped himself from so doing, and of these a State court may take cognizance. In them the question concerning the validity of the patent is merely a question collateral to the main issue, and goes only to the question whether there is a consideration to support the promise to pay. A case arising on a contract to pay royalties, or, in other words, a case between patentee and licensee, falls generally within the class last referred to."

In Merserole *v.* Union Paper Collar Co. (1869), 3 Fisher, 483, Blatchford, J.: (487) "A State court has jurisdiction to decree the license and agreement to be void and inoperative for fraud, or any other adequate reason; and the fact that in the investigation the State court will be obliged to inquire whether there was anything new in the patents which could operate as a consideration for the license and the agreement, cannot deprive the State court of jurisdiction, or confer it on this court. It is true that a State court cannot take cognizance of a suit brought for the infringement of a patent, nor of a direct suit brought to decree a patent to be void. But, as is well said by Chief Justice Williams, in Rich *v.* Atwater, 16 Conn. 409, 414, 'That the validity of patent rights is a subject peculiarly within the jurisdiction of the courts of the United States is true; but it is equally true that when they come in question collaterally their validity must become a subject of inquiry in the State courts. Thus, in a suit upon a note, if

for the purchase-money of a patent right, for instance, may be defeated by proving that the patent was invalid and the con-

it is claimed that the note was given for a patent-right, and the patent is invalid, and so there was no consideration for the note, the State courts constantly exercise jurisdiction.' In Rich *v.* Atwater the plaintiff owned a patent for a machine which the defendant was infringing. The defendant, by a covenant, agreed not to use the infringing machine any longer, but nevertheless went on using it, and the plaintiff brought a suit founded on the agreement for an account and an injunction. The defendant offered to prove that the patent was invalid for want of novelty. The plaintiff objected to the evidence, and took the point before the full court, which held that the evidence was admissible. In Cross *v.* Huntley, 13 Wend. 385, the suit was brought on a note given on the sale of the patent for a machine. In defence it was proved that the machine was not new, and that the specification of the patent was so defective as to avoid the patent. Mr. Justice Nelson, in delivering the opinion of the court, says: "It is insisted by the defendant below that the patent is void, on the grounds (1), that the machine, for the making and vending of which the patent was granted, is not a new invention; and (2) if new in parts the patent is void, inasmuch as it is for the whole machine and not for the improvement. If either of these positions were sustained by the proof, the defendant was entitled to judgment in the court below, as in such case a failure of the consideration of the note was shown. From the evidence, there cannot be a doubt but that the patent, in both respects, is defective and void. . . . The patent being void, nothing passed to the plaintiff in error, and the note was given without consideration.' The case of Head *v.* Stevens, 19 Wend. 411, was one of the same character. It can make no difference whether the payee of the note, or the licensor in the license, brings the suit to enforce the note or the license, or whether the suit is brought by the maker of the note, or the licensee in the license, to cancel the instrument. The State court has jurisdiction in either case to inquire collaterally into the validity of the patent. It is true that a State court cannot entertain jurisdiction of a direct suit to repeal a patent. Every citizen has, abstractly, the same interest with every other citizen that a void patent shall not be in existence. Yet such interest is not sufficient to warrant the maintenance of a suit to repeal a patent. Such a suit cannot be brought in a State court." 6 Blatch. 356 (360).

Further, that validity, title, and infringement may be collaterally questioned in a State court, see Continental Store Service Co. *v.* Clark (1885), 100 N. Y. 365; Brown *v.* Texas Cactus Hedge Co. (1885), 64 Tex. 396; Keith *v.* Hobbs (1878), 69 Mo. 84; Green *v.* Wilson (1870), 6 C. E. Green (N. J.), 211; Slemmer's Appeal (1868), 58 Pa. St. 155; Billings *v.* Ames (1862), 32 Mo. 265; Lindsay *v.* Roraback (1858), 4 Jones Eq. (N. C.), 124; Tomlinson *v.* Battell (1857), 4 Abb. Pr. 266; Vannini *v.* Paine (1833), 1 Harr. (Del.) 65.

That a State court may collaterally inquire into identity of purpose and result, and into the utility of the invention, see Hunt *v.* Hoover (1868), 24 Iowa, 231.

That if the plaintiff must show the validity and existence of a patent in order to make out his case, the State courts have no jurisdiction, see Tomlinson *v.* Battell (1857), 4 Abb. Pr. 266; Rich *v.* Atwater (1844), 16 Conn. 409.

That a State court cannot go behind

tract therefore without consideration, but the judgment rendered affects only the contract, not the patent, and leaves the latter to stand or fall by the decision of the Federal courts.[4] The same rules apply to actions *ex delicto*, as for a libel on a patent, — whatever the defendant may deem it expedient to allege, in excuse or justification of his acts, concerning the patentability of the invention, or the title of the patentee, being but collateral matter belonging to the field of evidence rather than to that of pleading, and in no wise determined by the judgment in that cause.

§ 866. Original Jurisdiction over Cases Arising under the Patent Laws is Vested in the Circuit Courts, and other Courts having Circuit Court Powers.

The entire original jurisdiction of the Federal courts over cases arising under the Patent Laws is vested in the Circuit courts, in the Supreme Court of the District of Columbia, and in such District courts as are endowed with Circuit court powers.[1] The Supreme Court of the United States obtains its jurisdiction by appeal from the Circuit Court.[2] These courts

a patent to inquire into its validity, see Cowan *v.* Mitchell (1872), 11 Heisk. (Tenn.) 87.

That it is doubtful whether a State court can pass upon novelty, see Rawson *v.* Harger (1878), 48 Iowa, 269.

That it is doubtful whether State courts of equity have concurrent jurisdiction where the Patent Laws are collaterally questioned, or where the relief would not invalidate the patent, see Gibson *v.* Woodworth (1840), 8 Paige (N. Y.), 132; qualifying Burrall *v.* Jewett (1830), 2 Paige (N. Y.), 134.

That a State court may punish for contempt in interfering with the receiver of a corporation appointed by the court, though the interference consists in the purchase of a new license by a member of the corporation for the making of an article which the corporation had an exclusive right to make, and which the receiver is making under order of the court, and though such contempt is also an infringement, see *In re* Woven Tape Skirt Co. (1877), 12 Hun, 111.

[4] That actions for royalties or purchase-money are within the jurisdiction of State courts though the validity of the patent, and the consequent want of consideration for the contract, are denied, see note 3, *ante*, and § 1257 and notes, *post*. But see *contra*, St. Paul Plow Works *v.* Starling (1888), 127 U. S. 376; 43 O. G. 1350.

§ 866. [1] That the jurisdiction of the Circuit courts in patent cases is not changed by the Revised Statutes, see Cochrane *v.* Deener (1876), 94 U. S. 780; 11 O. G. 687.

That the Supreme Court of the District of Columbia has the same powers in patent cases as a Circuit court, see Cochrane *v.* Deener (1876), 94 U. S. 780; 11 O. G. 687.

[2] That the Supreme Court has no

will always consider the question of their jurisdiction, and a case improperly instituted will be dismissed or remanded to the appropriate tribunal.[3] Objections to jurisdiction must be taken before the pleadings are closed and the evidence published, or they will be waived as far as the parties have power to waive them; but the want of jurisdiction on the ground of subject-matter is incurable by any laches of the parties, and whenever it may be discovered the case will be dismissed.[4]

original jurisdiction over questions of fact, such as infringement, &c., see Wilson *v.* Barnum (1850), 8 How. 258.

That the Supreme Court of the United States has no jurisdiction over a bill to enforce a contract for a patent unless the amount is over two thousand dollars, see Brown *v.* Shannon (1857), 20 How. 55.

[3] That the Federal courts will always consider the question of their jurisdiction, see Spring *v.* Domestic Sewing Mach. Co. (1882), 22 O. G. 1445; 13 Fed. Rep. 446.

That a case erroneously brought from a State court will be remanded, on motion, where the want of jurisdiction appears, see Teas *v.* Albright (1882), 22 O. G. 2069; 13 Fed. Rep. 406.

[4] That an objection to jurisdiction should be taken before the pleadings are closed and the evidence is published, see Nesmith *v.* Calvert (1845), 1 W. & M. 34; 2 Robb, 311.

That when the court has no jurisdiction the cause will be dismissed, see Blanchard *v.* Sprague (1859), 1 Clifford, 288.

That laches of the defendant cannot confer jurisdiction over the subject-matter, see Creamer *v.* Bowers (1887), 30 Fed. Rep. 185.

CHAPTER II.

OF WRONGS AGAINST UNPATENTED INVENTIONS.

§ 867. The Right of an Inventor to Preserve the Secret of his Invention Rests on Natural Law.

Whatever rights an inventor may possess in his unpatented invention vest in him by virtue of his inventive act alone. The conception of an idea of means makes that idea the absolute and exclusive property of its conceiver until in some manner he communicates it to others.[1] Although he embodies it in tangible materials and reduces it to practical operation it still belongs to him, unless its embodiment or operation discloses its essential characteristics to his fellow-men. In this condition of affairs the security of the inventor's property depends upon his preservation of his secret. While he successfully conceals the principle of his invention it is incapable of imitation, and his exclusive enjoyment of the fruits of his inventive skill must be as perfect and as certain as if sheltered under the most rigorous provisions of positive law.

§ 868. Forcible or Fraudulent Discovery of a Secret Invention Violates the Inventor's Rights.

The only wrong which an inventor can sustain in respect to his entirely undisclosed inventions, is that by which his secret is wrested from him against his will. This wrong may be committed either by force or fraud. Through physical compulsion, in the form of violence or threats, he may be driven to divulge the idea which he would otherwise have concealed, and be thus deprived of that exclusive knowledge which rendered his property in this idea secure. Or by a

§ 867. [1] That an inventor preserving his secret has, under the law of nature, a right to its undisturbed enjoyment, see § 24 and notes, *ante*.

forcible invasion of his premises, or the asportation of the device in which his idea is embodied, the same result may be effected. Or by deceit and imposition he may be induced to yield the secret which he intended to preserve, and lose beyond recovery that dominion over it which, in the nature of things, was previously his.

§ 869. Remedies for the Forcible or Fraudulent Discovery of the Inventor's Secret.

The remedies for this wrong, in whatever way it may be committed, must be sought in the local courts having jurisdiction over the defendant, and in the ordinary forms of civil or equity procedure. The tort involved in either of its methods calls for compensation in damages, which are to be measured by the ordinary rules followed in other civil actions, and into which the violation of the inventor's secret may enter as a necessary element. The power which the wrong-doer has acquired to work him further injury through the possession and employment of his idea of means demands the interference of a court of equity, enjoining the defendant against the use of the invention and the communication of its principles to others. By these remedies, although the secret cannot be restored to the inventor nor the knowledge of it be obliterated from the memory of the wrong-doer, the disastrous consequences of the wrong to the inventor may be averted, and his practical enjoyment of his property be henceforth secured.[1]

§ 869. [1] Although direct authorities in support of these positions cannot be adduced, analogy and principle both require that this protection should be afforded to inventors who are not yet patentees. The case of an inventor whose process or device is wrongfully appropriated by another, without any prior contract between himself and the wrong-doer, so closely resembles that of an author whose productions are forcibly or fraudulently converted, that the rights and remedies of the latter may properly be predicated of the former. That the author has his remedies both at law and in equity is undoubted, see *Jeffreys v. Boosey* (1854), 4 H. L. 815, and other cases cited in Kerr on Injunctions, 182, &c. On principle, also, an inventor whose rights have been invaded by force or fraud without contract is certainly entitled to protection and redress, although courts of equity, in adherence to the ancient theories concerning their own jurisdiction in matters of tort, have formerly been inclined to refuse their assistance unless a trust relation of some character

§ 870. The Right of an Inventor to the Preservation of his Secret by those to whom he has Confidentially Communicated it.

Not every voluntary disclosure of his secret impairs the right of the inventor to an exclusive property in his unpatented invention. His confidential communication of it to others, through motives of friendship or of business, does not make it any less his secret or deliver it from his personal control.[1] It may be necessary to his practical enjoyment of its benefits that he should impart it to his co-partners or his employees, and if he does this under pledges of their secrecy, or with restrictions as to their power of using it or revealing it to others, he is entitled to have his confidence respected, and the limits he has fixed to the disclosure faithfully observed. An invention thus communicated does not cease to be a secret invention, however numerous the individuals may be on whom the knowledge of its essential characteristics is bestowed. They hold their knowledge in trust for the uses and purposes for which it was received, and are responsible to the inventor for their exact compliance with the conditions that he has imposed upon them.

§ 871. The Disclosure or Misuse of an Inventor's Secret by those to whom it was Confidentially Communicated is a Breach of Trust and Actionable.

The rights of an inventor in a secret invention, confidentially communicated to others, are capable of violation either on the part of those to whom it has never been disclosed by the inventor or on the part of those to whom he has entrusted it. With reference to the first class of persons it is still an entire secret, the knowledge of which they can obtain only by force or fraud. The wrongful acts by which they acquire possession of the secret are, therefore, as was stated in a preceding paragraph, torts to be compensated for in an action at

was discernible between the inventor and the defendant. See § 872 and notes, *post*.

§ 870. [1] That an inventor may communicate his secret to others, in confidence, without losing his exclusive rights therein, see Salomon *v.* Hertz (1886), 35 O. G. 1109; Peabody *v.* Norfolk (1868), 98 Mass. 452.

law for damages, while the practical enjoyment of the stolen secret is prevented by injunction.[1] With reference to the second class of persons the invention, though no longer secret, is known only for certain definite purposes, within the scope of which their employment of their knowledge must be confined. Any use of their knowledge for a different purpose, and any communication of it to others beyond the limits of the authority conferred upon them by the inventor, is a breach of trust, and an invasion of the rights expressly or impliedly reserved to him in the disclosure through which their own knowledge of the invention was obtained.

§ 872. Remedies for the Disclosure or Misuse of the Inventor's Secret.

The remedy for wrongs already committed against an inventor by persons entrusted with his secret is an action at law for damages in the State courts, or, where citizenship confers the necessary jurisdiction, in the Federal courts. This action has been variously regarded as one of tort based on the fraud involved in the breach of trust or as one of contract on the express or implied agreement to respect the reserved rights of the inventor, but in one form or the other adequate compensation is awarded for the injury sustained. Against a future and expected invasion of the inventor's rights equity will interpose an injunction, forbidding the unauthorized use of the knowledge of the defendant or his disclosure to others of the secret of the invention.[1] The latter remedy is open to the personal representatives of a deceased inventor, and to

§ 871. [1] See § 869, *ante*.

§ 872. [1] That equity will protect an inventor who preserves his secret against its fraudulent disclosure by another, see Peabody *v.* Norfolk (1868), 98 Mass. 452.

That the contract of a workman to preserve his employer's secret can be enforced in equity, see Peabody *v.* Norfolk (1868), 98 Mass. 452.

That an injunction will issue to prevent an employee from fraudulently disclosing the secret invention of his employer, see Salomon *v.* Hertz (1886), 35 O. G. 1109.

That whenever the disclosure of a secret invention involves a breach of trust or contract, equity will prevent it by injunction, see Morison *v.* Moat (1851), 9 Hare, 241; 21 L. J. Ch. 248; Green *v.* Folgham (1823), 1 S. & St. 398; Yovatt *v.* Winyard (1820), 1 J. & W. 394; Williams *v.* Williams (1817), 3 Mer. 157; Smith *v.* Dickenson (1804),

those whose fiduciary relations toward the defendant are derived from and identical with his.[2]

§ 873. The Right of an Inventor to his Secret Protected though the Secret Invention is not Patentable.

As the rights of an inventor to his secret invention, and to a remedy for the wrongs by which his property therein is injured, are not dependent upon the provisions of Patent Law, they exist equally whether the invention is or is not in its nature patentable. It must indeed be the product of inventive skill, for otherwise no title to it could vest in its inventor. But numerous products of inventive skill lie outside the field of those six classes of inventions which the Patent Law has undertaken to protect, and these are often as meritorious and valuable as those for which a patent can be legally granted. If the creator of these unpatentable inventions chooses to preserve his secret he has a right to do so, as also to communicate it confidentially under such restrictions as he deems expedient, and for an invasion of his rights he has the same redress as if the subject-matter of his invention were entitled to the protection of a patent.[1]

3 Bos. & Pul. 630; Kerr on Injunctions, 181; Coryton on Patents, 30; Phillips on Patents, 333–341; Godson on Patents, 170.

Contra, Newberry *v.* James (1817), 2 Mer. 446.

[2] That an executor may maintain a bill in equity to protect the secret of his decedent, see Peabody *v.* Norfolk (1868), 98 Mass. 452.

§ 873. [1] In Peabody *v.* Norfolk (1868), 98 Mass. 452, Gray, J.: (458) "If he invents or discovers, and keeps secret a process of manufacture, whether a proper subject for a patent or not, he has not indeed an exclusive right to it as against the public, or against those who in good faith acquire knowledge of it; but he has a property in it which a court of chancery will protect against one who, in violation of contract and breach of confidence, undertakes to apply it to his own use, or to disclose it to third persons. The jurisdiction in equity to interfere by injunction to prevent such a breach of trust, when the injury would be irreparable and the remedy at law inadequate, is well established by authority."

That a secret scientific invention improving a process may be protected by an injunction in the State courts, though it is not of a patentable nature, and persons who are intrusted with the secret may be enjoined from disclosing it, see Hammer *v.* Barnes (1863), 26 How. Pr. 174.

§ 874. The Right of an Inventor to his Unpatented Invention Forfeited by its Unrestricted Disclosure to Others unless Protected by Statute.

In the absence of any provision of positive law relating to the subject, the unrestricted disclosure of his secret by the inventor is destructive to his property therein. His idea of means then passes into the possession of mankind, becomes a portion of the common stock of knowledge, is open to the enjoyment of all who choose to use it, and thus escapes entirely from the ownership and control of the inventor.[1] It is immaterial whether such disclosure be made to one person or to many, since an unrestricted communication to a single individual gives him the right to disseminate his information without limit and thereby effectually and permanently deprives the inventor of his dominion over the invention. Nor is the method by which the disclosure is accomplished of any consequence provided that it be complete and voluntary. Verbal descriptions, drawings, models, the practical employment of the invention, the gift or sale of articles in which it is embodied, alike render it accessible to the general public and terminate the exclusive rights of its inventor.

§ 875. The Right of an Inventor to his Unpatented Invention, Notwithstanding its Unrestricted Disclosure to Others, Protected by Statute during, and for Two years Prior to, his Application for a Patent.

Under the laws of the United States, however, an exception to this general rule has been established. A patentable invention may be used openly by the inventor, and freely communicated by him to others, for the space of two years before his application for a patent as well as during the pendency of his application, without the dedication of his invention to the public, and consequently without forfeiting his right to its protection by a patent. Concerning the effect of this provision upon the right of the inventor to a patent and upon the completeness of the protection afforded him after the patent has been granted, there can be no question. In reference to these points, his situation is the same as if he had preserved

§ 874. [1] See §§ 24, 71, 345–360 and notes, *ante*.

his secret until his patent had been issued. But concerning the nature of his property in the invention during this period of open use before the patent, the mode by which his rights in it are vindicated, and the forum in which his remedies for their invasion must be sought, some doubts exist which only future decisions or legislation can resolve. Yet reason and analogy indicate, sufficiently to warrant their discussion, the principles upon which these doubts must be settled, and the results at which the legislatures and the courts must eventually arrive.

§ 876. Three Views of the Inventor's Right to his Disclosed Invention, under this Statute, During and Prior to his Application for a Patent.

As to the nature of the inventor's property in his unpatented invention during this period of unrestricted disclosure, three views are possible: (1) That such disclosure deprives him of his vindicable property in the invention until the patent issues, leaving it open meanwhile to the public use, without power on his part to prevent it or liability on theirs for its employment, and that the issue of the patent revests in him this property with all the other rights of the monopoly; (2) That such disclosure does not affect the property of the inventor nor confer upon the public the right to use the invention, but suspends his power to protect and vindicate it until his patent has been granted, the remedies then afforded relating back and covering the wrongs committed before the issue of the patent; (3) That notwithstanding such disclosure the invention still possesses all the attributes of a secret invention, remaining under the inventor's entire control and entitled to the same protection as if it continued undisclosed.

§ 877. First View, — Temporary Abandonment and Resumption, — Untenable.

The first of these views is evidently untenable. A temporary abandonment of the invention, followed by its resumption at the issue of the patent, is in opposition to the fundamental notion of abandonment, which consists in an irrevocable dedication to the public. It confers no important benefit on the

community at large to allow them to enjoy an invention of which they may, at any moment, be deprived, while it imposes an unnecessary and unreasonable burden on the inventor as the condition of his own privilege of public use and sale. It was, of course, within the power of Congress to separate, for the time being, the right to a patent from the property in the invention, and permit its disclosure to suspend the latter in favor of the public, though it preserved the former in full force against them. But nothing in the spirit of the law, or in the language or the object of this particular provision, is in harmony with this position. Before the insertion of this clause in the statutes the inventor was, as he still is, completely protected in his ownership of the invention, unless he voluntarily and without restrictions communicated it to others, in which case his invention was abandoned without the possibility of a recovery. This clause prevents the public from taking advantage of such unrestricted disclosure as an abandonment of the invention, except when it has continued beyond a certain period or was accompanied by other circumstances which established an intention to abandon; and though the principal relief expected was undoubtedly to be afforded by still permitting the inventor to obtain a patent, there is no indication that in other respects the invention was to lie at the mercy of the public. On the contrary, the whole doctrine of public use and sale, as expounded by the courts, regards the invention as within the dominion of the inventor, however freely he may part with his control over the articles in which it is embodied. Until, therefore, this first view has been explicitly adopted by competent authority as truly presenting the rights of the inventor during this period of unrestricted disclosure, it must be presumed to be erroneous and deserving of no serious attention.

§ 878. Second View, — that Violations of this Right are Infringements for which an Action will lie after the Patent is Granted, — Objectionable.

According to the second view, the property of the inventor is not affected by his disclosure, but his pursuit of a remedy for its invasion is postponed until his patent has been granted.

In support of this view certain reasons may be urged which are entitled to consideration. The first grows out of the uncertainty whether the inventor will procure, or even attempt to procure, a patent, and the injustice of allowing him to retain, for any period, his control over an invention which he has fully communicated to the public and for which he is unable, or does not purpose, to secure the exclusive privileges of a patentee. Opposed to this reason, however, is the rule that the presumption that the inventor does not intend to abandon his invention can be rebutted only by conclusive evidence that he has such an intention, that his disclosure unaccompanied by other acts within the period prescribed is not such evidence, and therefore that until this period has elapsed he must be regarded as expecting to obtain a patent and perpetuate his rights. Another reason rests upon the fact that his rights after disclosure subsist only by virtue of the positive provisions of the Patent Laws, under which he can have no remedy until the patent has been granted. This reason cannot prevail; first, because wherever the law creates or declares a right and does not provide a remedy, the owner of the right may have recourse to any appropriate existing remedy, — of which in this case there are several, both at law and equity; second, because although this right depends upon the Patent Law, it is not a right under or collateral to a patent, but the prolongation and enlargement of a natural right, which is capable of protection and vindication in the same manner as if no disclosure had been made. Other reasons of less weight than the foregoing might be suggested in support of this view, but to each of them the answer is so clear that in the absence of express decisions in its favor adherence to it as the true statement of the inventor's rights must be withheld.

§ 879. Third View, — that the Right of the Inventor under this Statute is a Continuation of his Natural Right and Entitled to the same Protection, — Probable.

According to the third view the inventor's property in his invention and his right to an immediate remedy in case of its actual or threatened invasion are not affected by its unrestricted disclosure, unless such disclosure is protracted

beyond the lawful period or is accompanied by other acts establishing his intention to abandon it. In other words, his invention, though universally known, has all the legal attributes of a secret invention until the lapse of time or other circumstances make it apparent that the inventor has dedicated it to the public. This view is the most simple, the most intelligible, and the most consistent with the liberal spirit of our laws toward the inventor. That it is also the correct one is shown by the purpose and character of this provision of the law itself, and by its agreement with the other rights which are already recognized as vesting in him. At the time of the introduction of this provision into our Patent Law, the inventor did not lose his property in his invention, nor his right to protect it by immediate remedies and to secure for it the ultimate protection of a patent, by any involuntary disclosure or by any voluntary disclosure in the confidence of business or of friendship. As this provision was evidently not intended to restrict the rights of the inventor it must have been intended to extend them, and to extend them in such directions as would relieve him from existing difficulties. His principal difficulties at that time were these: the difficulty of proving that a given disclosure was confidential or restricted by conditions; the difficulty of ascertaining whether his invention had sufficient commercial value to warrant him in patenting it, unless it could be, to some extent, subjected to the test of public use; and the difficulty of determining whether the instrument or operation produced by the inventor were original with him, and due to his inventive rather than his imitative skill, until it had been submitted to those acquainted with the art, among whom alone its prior existence and its patentable merit could be known. Congress removed these difficulties by fixing a period within which it should be immaterial whether the disclosure were confidential or unrestricted, and during which the commercial importance of the invention and its patentable merit could be fully ascertained. But it had no occasion to interfere with the property or the remedies already conferred on the inventor, or to introduce new theories of ownership, or to establish new relations between him and the public. The simple provision that two

years of unrestricted disclosure should be allowed to the inventor without affecting his rights in his invention was sufficient to accomplish all the objects for which this alteration in our law was then designed.

§ 880. Third View Alone Consistent with the Other Rights of the Inventor in his Unpatented Invention.

Moreover, the character of this provision itself indicates that this view is correct. It fixes a limit only to use or sale with the inventor's knowledge and consent. Under it an unauthorized use or sale for any period of time, however long, confers no rights upon the public and curtails no rights of the inventor.[1] Although a single instance of authorized use or sale may place the invention within the knowledge of the public, the possession of such knowledge does not empower them to employ it without the inventor's acquiescence or consent. The language of this provision thus contemplates a complete dominion of the inventor over the enjoyment of his invention except so far as he relinquishes it in favor of individual vendees or licensees, — a dominion which would be practically valueless were he not able to assert it by the immediate application of remedies for its invasion.

§ 881. Third View Alone Consistent with the Contract Rights of the Inventor in Reference to his Unpatented Invention.

Again, during this period of unrestricted disclosure, the law recognizes the contract rights of the inventor over his invention as unimpaired, and affords him ample and immediate remedies for their violation. He can assign it with or without the right to obtain a patent; he can license its employment in such a manner as to bind him as well after as before the patent has been granted; and the obligations growing out of these conveyances can be enforced irrespective of the issue of a patent. It would be indeed a strange anomaly in our law if property thus the subject of a contract were not also

§ 880. [1] It will be perceived that in this connection the author adheres to the view of public use and sale which was recognized in all our courts prior to the new departure discussed in § 357 and notes, *ante*.

regarded as liable to tortious injury, or if the remedies for the latter class of wrongs were suspended while the remedies for the former were applied. Analogy requires that the ownership of the inventor should be protected against invasion by the tort-feasor as well as against breaches of contract, and that his action for either injury should be at once available.

§ 882. Third View Indicates that the Inventor's Right, under this Statute, is Subject to the same Violations and Entitled to the Same Redress as his Right to his Secret Invention.

It may, therefore, be safely predicted that when the law on this point becomes settled, the third view of the inventor's rights will be the one adopted by the courts, and that pending this period of unrestricted disclosure his invention will be treated as within his own control as fully as while he still preserved his secret. In this event the wrongs by which his property in it may be violated, and the remedies by which those wrongs may be redressed, must be the same as those already discussed with reference to secret inventions. For its unauthorized employment an action for damages must lie at law, the damages being computed on the same general basis as if the suit were brought for the infringement of a patent. For a threatened infraction of his rights an injunction must be obtainable in equity.[1]

§ 883. Inventor's Right in his Unpatented Invention not Violated by the Independent Inventive Acts of Others, nor by the Enjoyment of their Results.

It is to be remembered that the wrongs considered in this chapter can be committed only by the unauthorized appropriation of the fruits of the inventor's own inventive skill. His property vests in him by virtue of his inventive act, and is invaded only when the results of that inventive act are

§ 882. [1] That an infringement after the patent has been applied for, and pending proceedings in the Patent Office, may be prevented by injunction, see Butler *v.* Ball (1886), 28 Fed. Rep. 754; 38 O. G. 420.

That an injunction will lie to prevent the unauthorized use of an uncopyrighted production, see Goldmark *v.* Kreling (1885), 25 Fed. Rep. 349; 11 Sawyer, 215; Kerr on Injunctions, 182.

forcibly or fraudulently converted to the use of others. An independent exercise of inventive skill by a different inventor, though developing and embodying the same idea of means, is not a violation of his rights, but on the contrary confers on that inventor the same property and privileges that he enjoys. Rival inventors in their use of their own inventions are, therefore, not tort-feasors as against each other, nor is the invader of the rights of one necessarily a transgressor against the other. To be liable to either, the wrong-doer must not only have appropriated the invention, but appropriated it from him. It is not until a patent has been granted that the question of priority of invention can be settled, and the first and true inventor can monopolize the invention against all mankind.

CHAPTER III.

OF WRONGS AGAINST PATENTEES.

§ 884. Wrongs against a Patentee are Violations of his Right in his Monopoly.

By the issue of letters-patent the inventor is endowed with a monopoly in the invention against all other persons, — rival inventors as well as mere imitators, — and is entitled to its uninterrupted enjoyment, without loss, diminution, or control, except by due process of law. Any act of others by which its value to him is wrongfully decreased is an injury to his rights as patentee for which the law, whereby these rights are created or declared, is bound to provide an ample and appropriate remedy. No act, however, constitutes a wrong against the patentee unless it embraces both elements of a tort, the *damnum* and *injuria*. A lawful act, such as the original invention of a superior art or instrument, may entirely destroy the commercial importance of his patent and render all his labor and expenditure in connection with it utterly unproductive. This is *damnum absque injuria*, for which of course no action lies. In order to invade his rights as patentee such acts must be directed against the monopoly conferred upon him by the patent, attacking the franchise which it purports to bestow, and destroying or curtailing the privileges which, by virtue of it, he alone is authorized to enjoy.[1]

§ 884. [1] Injuries to a patented article by force or negligence, and injuries to a patented art or instrument by acts or representations creating doubts as to its industrial value, are simple torts, not affecting the existence or title to the monopoly, and are remediable, if at all, under the provisions of the common law, in the courts having jurisdiction over the parties.

§ 885. Rights in a Monopoly Violated by Injuring the Reputation of the Patented Invention or by its Unauthorized Use.

The rights conferred by a patent are subject to two forms of injury. One is committed by maliciously and publicly injuring the reputation of the patented invention, and does not involve the use of the invention itself; the other consists in an unauthorized use of the invention in violation of the exclusive privilege granted by the patent, with or without a denial of its validity. The latter wrong, commonly called infringement, is by far the most important, and is the occasion of nearly all the actions brought by patentees in vindication of their rights. But the former is of not infrequent occurrence and is often sufficiently disastrous in its consequences to the patentee to warrant his pursuit of the remedies which, in such cases, the law affords. These two wrongs we shall now consider, giving attention first to slander or libel against a patented invention, and second, to infringement.

SECTION I.

OF SLANDER OR LIBEL AGAINST A PATENTED INVENTION.

§ 886. Nature of the Injury Inflicted by Slander or Libel against a Patented Invention.

The commercial value of his patent to the patentee depends, in a great degree, upon the opinion entertained by other men concerning its validity. A patent is valid when its subject-matter is patentable and when the patentee is the first and true inventor. An opinion that the subject-matter is not patentable tends to promote infringements of the patent and to deprive the patentee of that dominion over his invention which it is the purpose of the patent to secure. An opinion that the patentee is not the first and true inventor destroys that confidence in his power to confer indisputable titles on his assignees and licensees without which it is often impossible for him to profit by his own invention. The dissemination of either of these opinions is thus an injury to the patentee,

and if malicious and unlawful is a wrong for which he is entitled to receive redress.[1]

§ 887. Slander or Libel against a Patented Invention by Denying its Patentability.

The publication, verbal or in writing, of statements impugning the validity of a patent on the ground of the non-patentability of its subject-matter, are *prima facie* wrongful. The issue of a patent constitutes presumptive evidence that the invention comes in all respects within the purview of the law and is entitled to protection, and any private individual who publicly avers the contrary does so at his peril.[1] Like other slanders against business interests this is actionable only when it causes special damage, and it may be justified or excused by the defendant in the usual modes pertaining to this class of injuries.[2]

§ 888. Slander or Libel against a Patented Invention by Denying that the Patentee was the First and True Inventor.

Statements derogatory to the title of the patentee, as the first and true inventor, occupy a somewhat different position. When made by persons having no claim of right to the invention as the product of their own creative skill, they are slanders or libels for which a proper remedy may be obtained.[1]

§ 886. [1] That a libel or slander against a patent right is an injury for which the courts will afford an adequate redress, see Palmer *v.* Travers (1884), 20 Fed. Rep. 501; 22 Blatch. 185; Bell *v.* Singer Mfg. Co. (1880), 65 Ga. 452; Whitehead *v.* Kitson (1876), 119 Mass. 484.

That it is a libel to charge a man with infringing a patent, see Watson *v.* Trask (1834), 6 Ohio, 531.

That an infringer will not be protected against circulars warning the public, and the burden of proof as to his non-infringement is on him, see Barney *v.* United Telephone Co. (1884), L. R. 28 Ch. D. 394.

§ 887. [1] That a public denial of the title to a patented invention, if malicious, is actionable, see Bigelow Leading Cas. Torts, 42; 2 Addison on Torts, § 1137, p. 969, ed. 1876.

[2] That a libel or slander against the title to an invention is not actionable unless causing special damage, see 2 Addison on Torts, § 1137, p. 969, ed. 1876; 1 Hill. Torts, 342, *note*.

§ 888. [1] That the public denial that the patentee or his assignor was the first and true inventor, if malicious and causing special damage to the owner of the patent, is actionable, see Emack *v.* Kane (1888), 34 Fed. Rep. 46; Halsey *v.* Brotherhood (1879), L. R. 15 Ch. D. 514; 19 Ch. D. 386; Wren *v.* Weild (1869), L. R. 4 Q. B. 730.

But rival inventors, whether patentees or not, may protect their own interests and warn the public against infringing on their rights by giving notice of their claims and denying the validity of a rival patent.[2] Such notices, however, must be couched in moderate language, and having conferred upon the public the necessary information must refrain from superfluous adverse commentary on the existing patent.[3] Any excess, even in this case, becomes a libel for which the patentee may have redress.

§ 889. Remedy for Slander or Libel against a Patented Invention.

The remedy at law for slander against a patent is an action on the case praying damages according to the injury actually sustained. Whether equity affords relief by interfering to prevent the repetition of the wrongful publication has been variously held, — in some States the patentee being left to his legal remedy, in others being protected by injunction.[1] Where

[2] That a patentee may circulate notices warning the public not to buy the invention except from him, see Hovey *v.* Rubber Tip Pencil Co. (1871), 33 Sup. Ct. N. Y. 522.

That parties claiming rights under patents may publish their own claims and warn others, and if they act in good faith they will not be restrained, see Croft *v.* Richardson (1880), 59 How. Pr. 356.

That a circular forbidding persons to buy articles claimed to be infringements is not a libel calling for damages or injunction if in good faith, and the circulator's patent is apparently valid, see Société Anonyme *v.* Tilghman's Patent Sand Blast Co. (1883), L. R. 25 Ch. D. 1; Halsey *v.* Brotherhood (1879), L. R. 19 Ch. D. 386.

That a patentee will not be enjoined from circulating notices that his patent is infringed where the question of infringement had never been decided, and the patentee was guilty of no fraud, see Chase *v.* Tuttle (1886), 27 Fed. Rep. 110.

That it is doubtful whether the Circuit Court has power to enjoin the publishing of circulars warning the public against certain infringements, see Chase *v.* Tuttle (1886), 27 Fed. Rep. 110.

That equity cannot restrain a plaintiff from publishing the fact that the defendant has been enjoined, see Westinghouse Air Brake Co. *v.* Carpenter (1887), 32 Fed. Rep. 545.

[3] That in publishing the claims of patentees excessive language must not be used, beyond what is necessary to give the proper information, and any excess will be enjoined, see Croft *v.* Richardson (1880), 59 How. Pr. 356.

§ 889. [1] That equity will enjoin against a libel on a patent right, see Emack *v.* Kane (1888), 34 Fed. Rep. 46; Bell *v.* Singer Mfg. Co. (1880), 65 Ga. 452. *Contra*, Baltimore Car Wheel Co. *v.* Bemis (1886), 29 Fed. Rep. 95; 38

the alleged offender is a rival inventor, but not a patentee, good faith requires him to make a speedy application for a patent in order that the question of priority between himself and the subsisting patentee may be determined; and his failure so to do deprives him of the excuse for his attack upon the patent which a diligent protection of his interests would otherwise afford.[2] The forum in which these remedies of the patentee are to be sought is that of the State having jurisdiction of the defendant, the Federal courts having no cognizance of such actions except in cases between citizens of different States.[3]

SECTION II.

OF INFRINGEMENT.

§ 890. Infringement Defined.

The issue of a patent confers upon the patentee the exclusive right to make, use, and vend the patented invention, throughout the United States and the Territories thereof, during the period for which the patent has been granted. The infringement of a patent, being the invasion of this exclusive right, therefore consists in the manufacture, use, or sale of the invention protected by the patent within the area and time described in the patent, by any person not duly author-

O. G. 1132; Kidd *v.* Horry (1886), 28 Fed. Rep. 773.

That equity has no jurisdiction of libel or slander affecting the title to a patent right, and cannot interfere unless a repetition is threatened and preventive measures become necessary, the remedy for past injuries being at law, see Palmer *v.* Travers (1884), 20 Fed. Rep. 501; 22 Blatch. 185.

That equity has no jurisdiction over a libel or slander or false representations that the plaintiffs are infringing a patent, unless there is a breach of trust or contract, the remedy, if any, being at law, see Boston Diatite Co. *v.* Florence Mfg. Co. (1873), 114 Mass. 69.

That no injunction will issue against one who falsely represents that the patentee's invention is an infringement of his, and thus deters purchasers, see Whitehead *v.* Kitson (1876), 119 Mass. 484.

[2] That one who claims that a patented invention is in fact his own discovery, must apply for a patent, if entitled to one, in order to justify his claims, see § 722 and notes, *ante*.

[3] That the Federal courts have no jurisdiction over actions for libel or slander against patent rights where the parties are citizens of the same State, see Prime *v.* Brandon Mfg. Co. (1879), 16 Blatch. 453; 4 Bann. & A. 379.

ized to do so by the patentee.[1] As this is the principal wrong which an inventor is able to sustain, and as it forms the cause of action in by far the greater proportion of the suits to which the inventor is a party, it demands and will receive an extended consideration. In discussing it three topics require attention: (1) The invention whose manufacture, use, or sale constitutes the act of infringement; (2) The nature of the act of infringement, with the time when, the place where, the persons by whom, and the knowledge or intent with which it must be performed; (3) The application of the foregoing propositions to each of the six classes of inventions.

§ 891. No Infringement Exists unless the Invention Unlawfully Used is Identical with that Protected by the Patent.

The invention whose manufacture, use, or sale constitutes the infringement of a patent is the invention covered and protected by the patent.[1] The theory of the patentee as to the nature and scope of his invention is immaterial; its actual character as it exists practically in the arts is equally unimportant; the patent protects only the patentable subject-matter which it specifically claims, and is capable of infringement only by an invasion of the inventor's rights in that invention.[2] Hence, as no invention can be claimed in a patent unless it has been so described that any person skilled in the

§ 890. [1] That infringement is a question of mixed law and fact, see California Artificial Stone Paving Co. *v.* Molitor (1885), 113 U. S. 609; 31 O. G. 1044.

§ 891. [1] That an infringement is a copy made after and agreeing with the principle laid down in the patent, see Page *v.* Ferry (1857), 1 Fisher, 298.

That a device not covered by the patent does not infringe though it effects the same purpose as the patented invention, see Toohey *v.* Harding (1880), 1 Fed. Rep. 174; 4 Hughes, 253; 5 Bann. & A. 195.

That an article is not an infringement unless it is to be used as pointed out in the patent, see Campbell *v.* Kavanaugh (1882), 11 Fed. Rep. 83; 20 Blatch. 256.

That a person who licenses others to use certain improvements of his own does not infringe the original patent, see Hussey *v.* Bradley (1863), 2 Fisher, 362; 5 Blatch. 134.

[2] That the theory of the patentee as to his invention is of no consequence on the question of infringement, see Foss *v.* Herbert (1856), 2 Fisher, 31; 1 Bissell, 121.

That whether a device is an infringement is determined by the Claims of the patent, not by the actual invention, see Meissner *v.* Devoe Mfg. Co. (1872), 2 O. G. 545; 9 Blatch. 363; 5 Fisher, 285.

art could practise it without a further exercise of the inventive faculties, an invention which is not disclosed in the patent, or is only partially disclosed, although alluded to and indispensable to the enjoyment of the inventions properly claimed, is not susceptible of an infringement.[3] But every invention lawfully described and claimed is covered by the patent, and where a patent includes two or more inventions the wrongful manufacture, use, or sale of either one is an infringement of the patent.[4]

§ 892. Identity, how Determined.

The identity of the invention made, used, or sold by the alleged infringer with that described and claimed in the patent

That the use of one form of old devices is no infringement of a patent which claims only a new form of them, see Barker *v.* Todd (1882), 13 Fed. Rep. 473; 22 O. G. 1448.

That an invention which would not anticipate will not infringe, see Cook *v.* Sandusky Tool Co. (1884), 26 O. G. 1114. This can be true only where the scope of each invention is the same, not where the infringing device is merely included in the patented invention.

[3] In Page *v.* Ferry (1857), 1 Fisher, 298, Wilkins, J.: (309) "An infringement will not have taken place unless the invention can be practised completely by following the specifications. An infringement is a copy made *after*, and agreeing with the principle laid down in, the patent; and if the patent does not fully describe *everything* essential to the making of the thing patented, there will be no infringement by the fresh invention of processes which the patentee has withheld from the public."

That if the patented invention is not operative it cannot be infringed by one that is, see Royer *v.* Coupe (1886), 29 Fed. Rep. 358; 39 O. G. 239.

[4] In Lee *v.* Blandy (1860), 2 Fisher, 89, Lenvitt, J.: (92) "There can be no question but that there may be a claim for two inventions in the same patent, if they both relate to the same machine or structure; and an action can be sustained for the infringement of either one or the other of these separate inventions where claimed as separate and distinct in their character. There can be no doubt if one of these be infringed it is properly a subject for an action." 1 Bond, 361 (365).

See also Matthews *v.* Spangenberg (1883), 23 O. G. 1624; 15 Fed. Rep. 813; Singer *v.* Walmsley (1860), 1 Fisher, 558; Waterbury Brass Co. *v.* N. Y. & Brooklyn Brass Co. (1858), 3 Fisher, 43; Emerson *v.* Hogg (1845), 2 Blatch. 1; Moody *v.* Fiske (1820), 2 Mason, 112; 1 Robb, 312.

That two patents cannot supplement each other, but each by itself is the sole subject of infringement, see Blades *v.* Rand, McNally, & Co. (1886), 27 Fed. Rep. 93; 37 O. G. 99.

That one valid Claim in a re-issue may be infringed though the other Claims are not valid, see Cote *v.* Moffitt (1883), 15 Fed. Rep. 345; and § 684, note 5, *ante*.

is determined by the same tests which are applied in ascertaining the novelty of an invention when comparing it with things already known.[1] Novelty and infringement are not precisely the same questions, since an invention, however new, may include some patented instrument or operation and thus be an infringement.[2] But into both these questions that of identity enters as an essential factor, and in each it is settled by a reference to the same standards and in accordance with the same rules. As these have been discussed at great length in connection with the subject of novelty, a general review of them in this place will be sufficient.

§ 893. Identity must be Identity in the Idea of Means.

In the first place, the identity sought and found must reside in the idea of means embodied in each invention.[1] Whether the purpose intended, the effect produced, or the functions performed are the same is of no consequence, except that functions and effects which are essentially distinct indicate

§ 892. [1] That identity is determined by comparing the two inventions, see Fuller *v.* Yentzer (1876), 94 U. S. 288; 11 O. G. 551.

That inventions which are the same in fact are the same in law, see *Ex parte* Merrill (1874), 5 O. G. 120; 1 MacArthur, 301.

That expert evidence may aid in determining identity, see Page *v.* Ferry (1857), 1 Fisher, 298.

See also §§ 228–314 and notes, *ante*.

[2] That novelty and infringement are in some respects different questions so far as the relations of different inventions to each other are concerned, see Union Sugar Refinery Co. *v.* Matthiesson (1865), 2 Fisher, 600; 3 Clifford, 639; Judson *v.* Cope (1860), 1 Fisher, 615; 1 Bond, 327.

§ 893. [1] In Burr *v.* Cowperthwait (1858), 4 Blatch. 163, Ingersoll, J.: (167) "The end or result produced is not secured by the patent, but only the substantial means used and specified to produce the end or result, — these, and nothing more. The same end or result may be produced by means other than those substantially described in the specification without infringing the patent."

In American Pin Co. *v.* Oakville Co. (1854), 3 Blatch. 190, Ingersoll, J.: (192) "The rules thus laid down must govern this case. The patent does not secure to the patentee the result or effect produced, but only the means described by which such result or effect is produced. The means which he specifies to produce the result or effect are secured, and nothing more. And all other means to produce the same result or effect, and not patented to any one, are open to the public."

See also Dryfoos *v.* Wiese (1888), 42 O. G. 490; Dryfoos *v.* Wiese (1884), 26 O. G. 639; 22 Blatch. 19; 19 Fed. Rep. 315; Hall *v.* Stern (1882), 15 Fed. Rep. 463; 24 O. G. 206; Anilin *v.* Levinstein (1883), L. R. 24 Ch. D. 156.

essential differences in the means.[2] In comparing these ideas of means it must be borne in mind that identity, with reference to infringement, does not require that each idea shall be the exact counterpart of the other. The idea covered by the patent must be completely embraced in the idea expressed in the infringement, but the latter may be far more comprehensive than the former.[3] A familiar instance occurs where a patented invention is employed as an element in a later combination, — the combination being no less an infringement of the patent because it includes many other subordinate ideas of means. Identity exists, therefore, with reference to the question of infringement, if the idea of means protected by the patent is found, substantially existing, in the invention practised by the alleged infringer.[4]

§ 894. Identity in Ideas of Means, how Determined.

Identity in the ideas of means subsists where the compared inventions perform the same functions by the same modes of

[2] That where the same advantages are gained by substantially the same means there is an infringement, see Wallicks *v.* Cantrell (1882), 15 Phila. 446; 21 O. G. 1878; 12 Fed. Rep. 790; California Artificial Stone Paving Co. *v.* Perine (1881), 8 Fed. Rep. 821; 20 O. G. 813; 7 Sawyer, 190.

That if the principle of an invention is pirated there is an infringement, see Page *v.* Ferry (1857), 1 Fisher, 298.

That identity of ideas, though different in appearance, is infringement, see Smith *v.* Higgins (1859), 1 Fisher, 537.

[3] That a device employing an essential feature of the patented invention is an infringement, see Forehand *v.* Porter (1883), 15 Fed. Rep. 256.

That wherever the defendants' devices require the use of those patented there is an infringement, see Sayles *v.* Chicago & Northwestern R. R. Co. (1871), 4 Fisher, 584; 3 Bissell, 52.

That the test of infringement is whether the defendant uses anything which the plaintiff invented, see Crompton *v.* Knowles (1881), 7 Fed. Rep. 199; Crompton *v.* Knowles (1881), 7 Fed. Rep. 204.

That a device may be an infringement though it constitutes a new invention, see Zeun *v.* Kaldenberg (1883), 16 Fed. Rep. 539; 23 O. G. 2514.

[4] That the infringing art or article must embrace the substance of the patented invention, see Sessions *v.* Romadka (1884), 28 O. G. 721; 21 Fed. Rep. 124; Morgan Elevated R. R. Co. *v.* Pullman (1882), 14 Fed. Rep. 648; Henderson *v.* Cleveland Co-operative Stove Co. (1877), 12 O. G. 4; 2 Bann. & A. 604; Sewall *v.* Jones (1875), 91 U. S. 171; 9 O. G. 47; Converse *v.* Cannon (1873), 9 O. G. 105; 2 Woods, 7; McComb *v.* Brodie (1872), 2 O. G. 117; 5 Fisher, 384; 1 Woods, 153; Carter *v.* Baker (1871), 4 Fisher, 404; 1 Sawyer, 512; Smith *v.* Higgins (1859), 1 Fisher, 537; Smith *v.* Downing (1850), 1 Fisher, 64.

operation. If the effects produced are substantially different, there is no identity.[1] If the effects are the same and the functions are essentially distinct, there is no identity.[2] If the functions are the same and the modes of operation by which they are performed are radically unlike, there is no identity.[3] Contrariwise, where the effects are identical, the functions identical, and the modes of operation identical, the idens embodied in the two inventions must also be identical.[4] Identity being thus established, all variations in shape, size, capacity, arrangement, and materials become unimportant.[5] The sub-

§ 894. [1] That difference in the nature of the result shows that there is no infringement, see May *v.* County of Fond du Lac (1886), 27 Fed. Rep. 691.

That identity of result is *prima facie* evidence of identity of process where both are new, see Pickhardt *v.* Packard (1884), 30 O. G. 179; 22 Fed. Rep. 530; 23 Blatch. 23.

See also § 117 and notes, *ante*.

[2] That infringement does not exist unless there is identity of function as well as of parts, see Racine Seeder Co. *v.* Joliet Wire Check Rower Co. (1886), 27 Fed. Rep. 367; 37 O. G. 452; Pelham *v.* Demarest (1882), 12 Fed. Rep. 494; 22 O. G. 772.

That an article incapable of performing the functions of a patented device cannot be an infringement, see Railway Register Mfg. Co. *v.* Broadway & Seventh Ave. R. R. Co. (1887), 30 Fed. Rep. 238; 40 O. G. 1243.

See also § 235 and notes, *ante*.

[3] That identity in mode of operation is necessary to infringement, see Evory *v.* Burt (1883), 15 Fed. Rep. 112; 23 O. G. 2121; Lull *v.* Clark (1882), 13 Fed. Rep. 456; 22 O. G. 1535; 21 Blatch. 95.

See also §§ 235, 236, and notes, *ante*.

[4] That to obtain the same result by the same mode of operation is infringement, see Shaver *v.* Skinner Mfg. Co. (1887), 30 Fed. Rep. 68; 41 O. G. 232; Collignon *v.* Hayes (1881), 8 Fed. Rep. 912; 20 O. G. 447; Singer Mfg. Co. *v.* Stewart Mfg. Co. (1881), 8 Fed. Rep. 920; 20 O. G. 524.

[5] That an infringement is committed whenever the defendant avails himself of the patented invention without such variations as constitute a different invention, see May *v.* County of Fond du Lac (1886), 27 Fed. Rep. 691; Carter *v.* Baker (1871), 4 Fisher, 404; 1 Sawyer, 512.

That a mere formal change is infringement, see Strobridge *v.* Landers, Frary, & Clark (1881), 11 Fed. Rep. 880; 20 Blatch. 73; 21 O. G. 1027; McKesson *v.* Carnrick (1881), 9 Fed. Rep. 44; 19 Blatch. 158; 21 O. G. 137.

That variations in size, form, and degree, do not prevent infringement, see Asmus *v.* Alden (1886), 27 Fed. Rep. 684; 36 O. G. 231; Lull *v.* Clark (1882), 13 Fed. Rep. 456; 22 O. G. 1535; 21 Blatch. 95; Judson *v.* Cope (1860), 1 Fisher, 615; 1 Bond, 327.

That an invention limited to certain forms is infringed only by the use of those forms, see Wright *v.* Yuengling (1888), 42 O. G. 829; Dosh *v.* A. J. Medlar Co. (1887), 40 O. G. 1242; Toepfer *v.* Goetz (1887), 41 O. G. 933; 31 Fed. Rep. 913.

That a patent limiting the invention to certain materials is infringed only by

stitution of equivalents, whether greater or less in number than the discarded elements, and though performing additional functions;[6] the capability of fewer or more numerous uses by reason of its new connections;[7] the increase or dimi-

the use of such materials, see Western & Wells Mfg. Co. v. Rosenstock (1887), 30 Fed. Rep. 67; 41 O. G. 354.

That a change of arrangement may be infringement, see Belle Patent Button Fastener Co. v. Lucas (1887), 37 O. G. 1004; 28 Fed. Rep. 371.

That where the same result is accomplished, the same function performed, and the mode of operation is the same, a mere difference in the location of parts will not avoid infringement, see Kirk v. Du Bois (1887), 42 O. G. 297.

That a mere formal modification affecting only the quantity of the result does not avoid infringement, see Coupe v. Weatherhead (1883), 23 O. G. 1927; 16 Fed. Rep. 673.

That the function and mode of operation of the plaintiff's and defendant's devices being identical, the latter is an infringement, though the means of communicating power may differ, see Piper v. Shedd (1885), 26 Fed. Rep. 151; 35 O. G. 256.

See also as to formal diversities §§ 237–244, and notes, *ante*.

[6] That a device though employing equivalents may be an infringement, see Barnes v. Ruthenberg (1887), 40 O. G. 693; 32 Fed. Rep. 159; Kimball v. Hess (1883), 26 O. G. 107; 15 Fed. Rep. 393; Carter v. Baker (1871), 4 Fisher, 404; 1 Sawyer, 512.

That the substitution of one known device for another, though complex, is infringement, see Foster v. Moore (1852), 1 Curtis, 279.

That the use of part of a mechanical device, invented to produce a particular general effect, in connection with a substituted device to produce another part of the same effect, is a use of the patented invention, see Johnson v. Williamantic Linen Co. (1866), 33 Conn. 436.

That to make new devices which are equivalents of the patented device, but go beyond it and include more, is infringement, see Loercher v. Crandall (1881), 11 Fed. Rep. 872; 20 Blatch. 106; 21 O. G. 863.

That the use of an equivalent is not an infringement where the specification says it is not within the patent, see Byam v. Farr (1852), 1 Curtis, 260.

That there is no infringement when an essential element is omitted and another substituted accomplishing the same result in a different manner, see Schmidt v. Freese (1882), 12 Fed. Rep. 563; 21 O. G. 1876.

See also as to equivalents, §§ 245–258, and notes, *ante*.

[7] That a difference in the purpose for which the invention is used will not prevent an infringement, see Thompson v. Gildersleeve (1888), 43 O. G. 886; Stegner v. Blake (1888), 45 O. G. 126.

That a device may be an infringement though it can be used in a way in which the patented device cannot, see Yale Lock Mfg. Co. v. Norwich National Bank (1881), 6 Fed. Rep. 377; 19 Blatch. 123.

That a device so incorporated into the infringer's machine as to do more effective and better work, or even different work, is still an infringement, see Hartford Woven Wire Mattress Co. v. Peerless Wire Mattress Co. (1885), 23 Blatch. 227; 23 Fed. Rep. 587; Buerk v. Valentine (1872), 2 O. G. 295; 5 Fisher, 366; 9 Blatch. 479.

That a device may be an infringe-

nution of simplicity and expensiveness;[8] the separation of the invention into several parts or the consolidation of many parts in one;[9] the addition of new features, whether with or without improvement in the operation of the means;[10] all these are changes consistent with the preservation of the identity of the patented invention, and with its wrongful appropriation by the alleged infringer.

ment though it is less useful than the patented invention, see Sewall *v.* Jones (1875), 91 U. S. 171; 9 O. G. 47; Union Paper Bag Mach. Co. *v.* Binney (1871), 5 Fisher, 166.

That a device may be an infringement though it only accomplishes in part the result attained by using the patented invention, see Coupe *v.* Weatherhead (1883), 16 Fed. Rep. 673; 23 O. G. 1927; Sewall *v.* Jones (1875), 91 U. S. 171; 9 O. G. 47.

See also as to diversity of use §§ 259–271, and notes, *ante*.

[8] That a device affecting the same thing in the same way is an infringement though it be simpler and cheaper, see Evory *v.* Burt (1883), 15 Fed. Rep. 112; 23 O. G. 2121.

That a device though more expensively fitted up may be an infringement, see Brown *v.* Guild (1874), 23 Wall. 181; 6 O. G. 392.

That difference in degree may be infringement, see May *v.* County of Fond du Lac (1886), 27 Fed. Rep. 691.

[9] That to divide or consolidate parts does not prevent infringement, see Thompson *v.* Gildersleeve (1888), 43 O. G. 886; Wheeler *v.* Clipper Mower & Reaper Co. (1872), 2 O. G. 442; 10 Blatch. 181; 6 Fisher, 1; Baldwin *v.* Bernard (1872), 2 O. G. 320; 9 Blatch. 509, note; 5 Fisher, 442.

That if material parts of the patented invention are omitted there is no infringement, see Snow *v.* Lake Shore & Mich. Southern R. R. Co. (1883), 25 O. G. 1280; 18 Fed. Rep. 602.

[10] That an improvement may be an infringement, see Shaver *v.* Skinner Mfg. Co. (1887), 41 O. G. 232; 30 Fed. Rep. 68; Filley *v.* Littlefield Stove Co. (1887), 39 O. G. 1203; 30 Fed. Rep. 434; Wilson *v.* Cubley (1886), 35 O. G. 257; 26 Fed. Rep. 156; Iloff *v.* Iron Clad Mfg. Co. (1886), 35 O. G. 1230; 27 Fed. Rep. 307; 23 Blatch. 481; Reed *v.* Street (1885), 34 O. G. 339; Tate *v.* Thomas (1885), 35 O. G. 258; 27 Fed. Rep. 306; Filley *v.* Littlefield (1885), 25 Fed. Rep. 282; Bostock *v.* Goodrich (1884), 21 Fed. Rep. 316; 29 O. G. 278; Frost *v.* Marcus (1882), 13 Fed. Rep. 88; Union Stone Co. *v.* Allen (1882), 14 Fed. Rep. 353; Cross *v.* Mackinnon (1882), 22 O. G. 586; 11 Fed. Rep. 601; 20 Blatch. 395; Foye *v.* Nichols (1882), 13 Fed. Rep. 125; 22 O. G. 2243; 8 Sawyer, 201; Brainard *v.* Cramme (1882), 12 Fed. Rep. 621; 22 O. G. 769; 20 Blatch. 530; White *v.* Heath (1882), 10 Fed. Rep. 291; 22 O. G. 500; Star Salt Caster Co. *v.* Alden (1882), 10 Fed. Rep. 555; Maxheimer *v.* Meyer (1881), 20 Blatch. 17; 9 Fed. Rep. 460; 20 O. G. 1162; Pennington *v.* King (1881), 7 Fed. Rep. 462; 19 O. G. 1568; Turrell *v.* Spaeth (1878), 14 O. G. 377; 3 Bann. & A. 458; De Florez *v.* Raynolds (1878), 14 Blatch. 505; 3 Bann. & A. 292; Holbrook *v.* Small (1876), 10 O. G. 508; Jackson *v.* Allen (1876), 120 Mass. 64; Robertson *v.* Blake (1876), 94 U. S. 728; 11 O. G. 877; Carstaedt *v.* U. S. Corset Co. (1876), 10 O. G. 3; 13 Blatch. 371; 2 Bann. & A. 331; Richardson *v.* Noyes (1876), 10 O. G. 507; 2

§ 895. Identity may Result from Use as well as from Original Construction.

The identity of the alleged infringement with the patented invention is not to be determined by its condition merely at

Bann. & A. 398 ; Westinghouse *v.* Gardner & Ranson Air Brake Co. (1875), 9 O. G. 538 ; 2 Bann. & A. 55 ; La Baw *v.* Hawkins (1874), 6 O. G. 724 ; 1 Bann. & A. 428 ; Baldwin *v.* Bernard (1872), 2 O. G. 320 ; 5 Fisher, 442 ; 9 Blatch. 509, note ; Woodward *v.* Morrison (1872), 2 O. G. 120 ; 5 Fisher, 357 ; Holmes, 124 ; Goodyear Dental Vulcanite Co. *v.* Evans (1868), 3 Fisher, 390 ; 6 Blatch. 121 ; Roberts *v.* Harnden (1865), 2 Clifford, 500 ; Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 379 ; Howe *v.* Morton (1860), 1 Fisher, 586 ; Carr *v.* Rice (1856), 1 Fisher, 198 ; Pitts *v.* Wemple (1855), 6 McLean, 558 ; Woodworth *v.* Rogers (1847), 3 W. & M. 135 ; 2 Robb, 625 ; Gray *v.* James (1817), Peters C. C. 476 ; 1 Robb, 140.

That an improvement and its original are separate inventions, and the inventor of one infringes by the use of the other, see Royer *v.* Coupe (1886), 39 O. G. 239 ; 29 Fed. Rep. 358 ; American Bell Telephone Co. *v.* Dolbear (1883), 23 O. G. 535 ; 15 Fed. Rep. 448 ; Robertson *v.* Blake (1876), 94 U. S. 728 ; 11 O. G. 877 ; Fales *v.* Wentworth (1872), 2 O. G. 58 ; Holmes, 96 ; 5 Fisher, 302 ; Whipple *v.* Baldwin Mfg. Co. (1858), 4 Fisher, 29 ; Pitts *v.* Wemple (1855), 6 McLean, 558.

That where the patentee of the original invention and the patentee of the improvement make a contract allowing each to use both patents in a different way, if either uses them contrary to the agreement he infringes, see Star Salt Caster Co. *v.* Crossman (1878), 4 Clifford, 568 ; 3 Bann. & A. 281.

That a device may be an infringement though additional elements are employed increasing its utility, see Waterbury Brass Co. *v.* N. Y. & Brooklyn Brass Co. (1858), 3 Fisher, 43.

That an improver may infringe though his improvement gives to the invention all its value, see Gray *v.* James (1817), Peters C. C. 476 ; 1 Robb, 140.

That an improvement has supplanted the patented device in the trade does not prevent it from being an infringement, see Turrell *v.* Spaeth (1878), 14 O. G. 377 ; 3 Bann. & A. 458.

That evidence that the defendant's device is better than the plaintiff's is only admissible to show substantial difference, see Alden *v.* Dewey (1840), 1 Story, 336 ; 2 Robb, 17.

That if an alleged original invention is not operative, the improver does not infringe by embodying it in his own, see Royer *v.* Coupe (1886), 39 O. G. 239 ; 29 Fed. Rep. 358.

That a device may be an infringement though it works better than the patented invention, see Howes *v.* McNeal (1878), 15 O. G. 608 ; 15 Blatch. 103 ; 3 Bann. & A. 376 ; Odiorne *v.* Denney (1878), 13 O. G. 965 ; 3 Bann. & A. 287 ; Miller's Falls Co. *v.* Ives (1877), 14 O. G. 203 ; 14 Blatch. 169 ; 2 Bann. & A. 574 ; McComb *v.* Brodie (1872), 2 O. G. 117 ; 5 Fisher, 384 ; 1 Woods, 153 ; Carter *v.* Baker (1871), 4 Fisher, 404 ; 1 Sawyer, 512 ; Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 379 ; Cox *v.* Griggs (1861), 2 Fisher, 174 ; 1 Bissell, 362 ; Whipple *v.* Middlesex Co. (1859), 4 Fisher, 41 ; Foss *v.* Herbert (1856), 2 Fisher, 31 ; 1 Bissell, 121.

That an invention may be an infringement though it does more than

the time of its original construction. The cunning of infringers is not allowed to circumvent the provisions of the law for the protection of inventors. An instrument which in itself may not resemble the patented invention, even in its idea of means, may when employed in practice develop new features that perform the functions of the patented invention by the same mode of operation. If such a result is intended by the maker, user, or seller of the instrument, or follows necessarily from its employment, the instrument thereby becomes identical with the patented invention, and such identity, by virtue of the intention now accomplished, is imputed to the instrument in its original condition.[1] But the develop-

the patented invention, see Shaver *v.* Skinner Mfg. Co. (1887), 30 Fed. Rep. 68 ; 41 O. G. 232 ; Wilson *v.* Cubley (1886), 26 Fed. Rep. 156 ; 35 O. G. 257 ; Zeun *v.* Kaldenberg (1883), 16 Fed. Rep. 539 ; 23 O. G. 2514 ; Wilt *v.* Grier (1881), 19 O. G. 427 ; 5 Fed. Rep. 450 ; California Artificial Stone Paving Co. *v.* Perine (1881), 20 O. G. 813 ; 8 Fed. Rep. 821 ; 7 Sawyer, 190 ; Strobridge *v.* Lindsay (1880), 18 O. G. 62 ; 2 Fed. Rep. 692 ; 5 Bann. & A. 411 ; Williams *v.* Boston & Albany R. R. Co. (1879), 16 O. G. 906 ; 17 Blatch. 21 ; 4 Bann. & A. 441 ; Hart, Bliven, & Mead Mfg. Co. *v.* Sargent (1878), 14 O. G. 45 ; 3 Bann. & A. 263 ; Converse *v.* Cannon (1875), 9 O. G. 105 ; 2 Woods, 7 ; New York Rubber Co. *v.* Chaskel (1875), 9 O. G. 923 ; Foss *v.* Herbert (1856), 2 Fisher, 31 ; 1 Bissell, 121.

That one invention may include others and yet infringe the patent which protects them, see Cochrane *v.* Deener (1876), 94 U. S. 780 ; 11 O. G. 687.

That a device may be an infringement though used in connection with other devices not included in the patent, see Wirt *v.* Brown (1887), 30 Fed. Rep. 188 ; 41 O. G. 236 ; Tate *v.* Thomas (1885), 30 O. G. 345 ; 22 Fed. Rep. 660 ; Roemer *v.* Simon (1884), 20 Fed. Rep. 197 ; 28 O. G. 194 ; Andrews *v.* Eames (1883), 15 Fed. Rep. 109 ; 23 O. G. 1123 ; Union Stone Co. *v.* Allen (1882), 14 Fed. Rep. 353 ; Turrell *v.* Spaeth (1878), 14 O. G. 377 ; 3 Bann. & A. 458 ; Herring *v.* Nelson (1877), 12 O. G. 753 ; 14 Blatch. 293 ; 3 Bann. & A. 55 ; Jackson *v.* Allen (1876), 120 Mass. 64 ; Cochrane *v.* Deener (1876), 94 U. S. 780 ; 11 O. G. 687 ; McComb *v.* Brodie (1872), 2 O. G. 117 ; 5 Fisher, 384 ; 1 Woods, 153 ; Chicago Fruit House Co. *v.* Busch (1871), 2 Bissell, 472 ; 4 Fisher, 395 ; Imlay *v.* Norwich & Worcester R. R. Co. (1858), 1 Fisher, 340 ; 4 Blatch. 227 ; Johnson *v.* Root (1858), 1 Fisher, 351 ; Carr *v.* Rice (1856), 1 Fisher, 198 ; Pitts *v.* Wemple (1855), 6 McLean, 558.

That a device may be an infringement though connected with useless additional parts, see Poppenhusen *v.* Falke (1862), 2 Fisher, 213 ; 5 Blatch. 46 ; Poppenhusen *v.* Falke (1861), 2 Fisher, 181 ; 4 Blatch. 493 ; Waterbury Brass Co. *v.* N. Y. & Brooklyn Brass Co. (1858), 3 Fisher, 43.

§ 895. [1] That where a device is intentionally so constructed as in use to become the patented invention, it is identical therewith and an infringement, see Page *v.* Ferry (1857), 1 Fisher, 298.

See also § 903 and note 7, *post.*

ment of such new features without the intention of the alleged infringer, as by accident or wear and tear, does not produce an identity which can be regarded on the question of infringement.[2]

§ 896. Identity not Controverted by the Issue of a Later Patent for the Infringing Invention.

The fact that the invention made, used, or sold by the alleged infringer is itself the subject of a later patent does not conclusively establish the absence of identity.[1] Every patent is *prima facie* evidence of the novelty of the invention which it claims, and every patented invention is thus presumed to be essentially different from every other until the contrary appears.[2]

[2] That an article which is not an infringement when constructed cannot become such by accident, or wear and tear, or usage, unless so intended, see Page *v.* Ferry (1857), 1 Fisher, 298.

That a device which may be forced to operate like the plaintiff's device is not an infringement if such use was not an object of its construction, see Buzzell *v.* Andrews (1885), 25 Fed. Rep. 822; 34 O. G. 830.

See also § 903 and note 7, *post.*

§ 896. [1] That a patented invention may infringe a prior patent, see Holliday *v.* Pickhardt (1882), 12 Fed. Rep. 147; 22 O. G. 420; Brainard *v.* Cramme (1882), 12 Fed. Rep. 621; 20 Blatch. 530; 22 O. G. 769; Star Salt Caster Co. *v.* Alden (1882), 10 Fed. Rep. 555; Pennington *v.* King (1881), 7 Fed. Rep. 462; 19 O. G. 1568; Maxheimer *v.* Meyer (1881), 20 Blatch. 17; 20 O. G. 1162; 9 Fed. Rep. 460; Holly *v.* Vergennes Mach. Co. (1880), 4 Fed. Rep. 74; 18 O. G. 1177; 18 Blatch. 327; Nathan *v.* N. Y. Elevated R. R. Co. (1880), 2 Fed. Rep. 225; 5 Bann. & A. 280; Robertson *v.* Blake (1876), 94 U. S. 728; 11 O. G. 877; Cochrane *v.* Deener (1876), 94 U. S. 780; 11 O. G. 687; Converse *v.* Cannon (1875), 9 O. G. 105; 2 Woods, 7; Goodyear Dental Vulcanite Co. *v.* Gardiner (1871), 3 Clifford, 408; 4 Fisher, 224; Goodyear Dental Vulcanite Co. *v.* Evans (1868), 3 Fisher, 390; 6 Blatch. 121; Smith *v.* Pearce (1840), 2 McLean, 176; 2 Robb, 13.

That where a later patent includes the subject-matter of a prior patent neither patentee can use the other's invention without his consent, see Cantrell *v.* Wallick (1886), 117 U. S. 689; 35 O. G. 871.

That where a later patent includes an earlier, a stranger cannot defend against the second patent by setting up the first, see Cantrell *v.* Wallick (1886), 117 U. S. 689; 35 O. G. 871.

[2] That it is presumed that use under one patent does not infringe another, see Smith *v.* Woodruff (1874), 4 O. G. 635; 6 Fisher, 476; 1 MacArthur, 459.

That the grant of a second patent is *prima facie* evidence that the inventions are different, and that the later patented invention is not an infringement of the former, see La Baw *v.* Hawkins (1874), 6 O. G. 724; 1 Bann. & A. 428; American Pin Co. *v.* Oakville Co. (1854), 3 Blatch. 190.

Where two patents apparently describe and claim the same art or article the question of identity is open for examination, with the presumption in favor of their diversity; but when this presumption has been overcome, through the application of the tests by which identity must in all cases be finally determined, the later patent affords no protection to its patentee in the practice of the invention, and does not in any degree relieve him from liability for infringement to the owner of the only valid patent.

§ 897. Nature of the Act of Infringement.

The nature of the act of infringement is indicated by that of the exclusive right which it invades. Hence an infringement may be committed either by making, using, or selling the patented invention.[1] These words, however, are interpreted as comprehending every method by which the invention can be made available for the benefit of the infringer, and any person who participates in any wrongful appropriation of the invention becomes thereby a violator of the rights protected by the patent.[2] Such participation may be direct or indirect; it is sufficient if it promotes in any degree the

§ 897. [1] In Haselden *v.* Ogden (1868), 3 Fisher, 378, Sherman, J.: (330) "An infringement is a copy made after and agreeing substantially and in principle with the article described in the letters-patent. The act of Congress confers upon the patentee and his assigns the exclusive right to make, to use, or to sell to others to be used, the article patented. It is, therefore, an infringement to make or manufacture a patented article though it is never used by the maker. It is likewise an infringement to use a patented article though made by another. It is also an infringement to sell to others the article when it is manufactured by another. The law vests the exclusive right to do all these three things in the patentee, and hence for another to do one or all of them is an infringement." See also Tuttle *v.* Matthews (1886), 28 Fed. Rep. 98; 36 O. G. 694; Slessinger *v.* Buckingham (1883), 17 Fed. Rep. 454; 8 Sawyer, 469; Allis *v.* Stowell (1881), 19 O. G. 727; Carter *v.* Baker (1871), 4 Fisher, 404; 1 Sawyer, 512; Waterbury Brass Co. *v.* N. Y. & Brooklyn Brass Co. (1858), 3 Fisher, 43; Boyd *v.* Brown (1843), 3 McLean, 295; 2 Robb, 203.

[2] That any party making profits by an infringement is a wrongdoer, and is liable to the patentee, see Vaughn *v.* East Tennessee, Virginia, & Georgia R. R. Co. (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

That to share in the fruits of an infringement is such complicity as renders the parties jointly liable, see Wells *v.* Jaques (1874), 5 O. G. 364; 1 Bann. & A. 60.

unauthorized manufacture, use, or sale of the invention.[3] Thus when a patented invention is inseparably annexed to other property without permission of the patentee, any one who owns or uses or buys or sells or leases such property, either as principal or agent, is guilty of infringement.[4] But if the interest of the alleged participant is not dependent on the invention, though casually enhanced by its wrongful use, the enjoyment of such interest is not infringement. Thus where a landlord in consideration of the occupation of his premises by manufacturers, who employ infringing devices in their business, receives part of the profits of their business in addition to the sums paid to him as rent, he is not *ipso facto* an infringer, although he would infringe were this arrangement a mere cover for his participation in the operations of his tenants.[5] For while the law does not impose unwarrantable burdens on the public by holding every one who derives a benefit from the prohibited manufacture, use, or sale of an invention responsible as an infringer of the patent, it does not permit any one, under any color or pretence, to employ the patented invention as a means of advancing his own interest, except in due subordination to the wishes of the patentee.

§ 898. No Act an Infringement unless it Affects the Pecuniary Interests of the Owner of the Patented Invention.

Moreover, the interest to be promoted by the wrongful employment of the invention must be hostile to the interest of

[3] That no one can infringe unless he has some interest in the making, selling, or using the invention, see United Nickel Co. *v.* Worthington (1882), 13 Fed. Rep. 392; 23 O. G. 939.

[4] That persons owning, renting, or occupying premises on which an infringing well is used, or buying or letting such premises without occupying them, are infringers, and liable to injunction and account, see Green *v.* Gardner (1882), 22 O. G. 683.

[5] That one who leases to persons who infringe by making tools for their own use, and who pay him rent and part profits of their business, is not an infringer, see Starrett *v.* Athol Machine Co. (1883), 14 Fed. Rep. 910; 23 O. G. 1729.

That where several parties infringe, some by making, others by selling, the infringing articles, the infringement is joint and several, and judgment may be rendered against each, though only one satisfaction can be had, see Jennings *v.* Dolan (1887), 29 Fed. Rep. 861; 38 O. G. 1018.

the patentee. The interest of the patentee is represented by the emoluments which he does or might receive from the practice of the invention by himself or others. These, though not always taking the shape of money, are of a pecuniary character, and their value is capable of estimation like other property. Hence acts of infringement must attack the right of the patentee to these emoluments, and either turn them aside into other channels or prevent them from accruing in favor of any one. An unauthorized sale of the invention is always such an act. But the manufacture or the use of the invention may be intended only for other purposes, and produce no pecuniary result. Thus where it is made or used as an experiment, whether for the gratification of scientific tastes, or for curiosity, or for amusement, the interests of the patentee are not antagonized, the sole effect being of an intellectual character in the promotion of the employer's knowledge or the relaxation afforded to his mind.[1] But if the products of the experiment are sold, or used for the convenience of the experimentor, or if the experiments are conducted with a view to the adaptation of the invention to the experimentor's business, the acts of making or of use are violations of the rights of the inventor and infringements of his patent.[2] In reference to

§ 898. [1] That to experiment with a patented article to gratify scientific tastes, or for curiosity or amusement, is not infringement, see Poppenhusen *v.* Falke (1861), 2 Fisher, 181; 4 Blatch. 493; Sawin *v.* Guild (1813), 1 Gallison, 485; 1 Robb, 47.

That to make and exhibit at a fair, but not for use or sale, is not an infringement, see Standard Measuring Machine Co. *v.* Teague (1883), 15 Fed. Rep. 390.

That to make a patented article in order to experiment with it as a basis for proposed improvements by the maker is not an infringement, see Frearson *v.* Loe (1878), L. R. 9 Ch. D. 48.

That to use for the experimental instruction of pupils may be an infringement, see United Telephone Co. *v.* Sharples (1885), L. R. 29 Ch. D. 164.

[2] In Poppenhusen *v.* New York Gutta Percha Comb Co. (1858), 2 Fisher, 62, Ingersoll, J.: (72) "The next question, gentlemen, is, Has there been a violation or infringement? It is said, gentlemen, that there has not been, for the reason that whatever use was made of it was an experimental use, — a use merely for experiment, and not with a view to profit; and when there has been no profit and no sale, it will not make a party liable, because the patentee would not be injured by it. But where, gentlemen, it is done as a matter of business, where the product of that experiment has been thrown into the market to compete with the products of the plaintiff, although he

such employments of a patented invention the law is diligent to protect the patentee, and even experimental uses will be sometimes enjoined though no injury may have resulted admitting of positive redress.[8]

§ 899. Infringement not Committed by Possessing, Exposing for Sale, Advertising, &c.

A further distinction is to be made between acts which, in themselves or constructively, are acts of making, use, or sale, and acts which though collateral to these are after all only evidence that these acts have been performed. Among the latter are the mere possession of the patented invention when such possession does not constitute its use, its exposure for sale, its exhibition to others as meritorious and effective, advertising it, and the like; none of which, taken alone, disturb the enjoyment of his property by the patentee, however strong a presumption they may raise of its invasion by acts of real infringement.[1]

§ 900. Infringement not Committed by Use of Part of the Patented Invention.

The acts of manufacture, use, and sale must, of course, relate to the precise invention claimed in the patent. To

may call it an experiment, yet, if it is a matter of business, and thrown into the market for the purpose of being sold, and is sold with his other products, why, that will be such a use as will make the party liable."

See also Poppenhusen *v.* Falke (1861), 2 Fisher, 181; 4 Blatch. 493; Frearson *v.* Loe (1878), L. R. 9 Ch. D. 48.

[8] That experimental making and use is an infringement and may be restrained by injunction, though no account will be ordered, see Albright *v.* Celluloid Harness Trimming Co. (1877), 12 O. G. 227; 2 Bann. & A. 629.

That to make for use in order to see whether the use will be profitable, and using for that purpose, is an act demanding compensation to the patentee, see Palmer *v.* United States (1885), 20 Ct. of Claims, 432.

§ 899. [1] That the possession of infringing articles by a defendant who bought them for use, but has not yet used them, is an infringement, see United Telephone Co. *v.* London & Globe Telephone Co. (1884), L. R. 26 Ch. D. 766; Adair *v.* Young (1879), L. R. 11 Ch. D. 136; 12 Ch. D. 13.

That exposure for sale is not infringement, see Minter *v.* Williams (1835), 4 A. & E. 251; 1 Web. 135.

That advertising the invention is not infringement, see Allis *v.* Stowell (1881), 19 O. G. 727.

That advertising the device is strong evidence of infringement, see Allis *v.* Stowell (1881), 19 O. G. 727.

make or use or sell a part of the invention, especially a part covered by a different patent or disclaimed in the patent which protects the entire invention, is not an infringement of the latter patent.[1] An apparent exception to this rule exists in reference to machine patents, which are infringed by acts that involve so much of the invention as embraces the complete expression of its structural law; but this exception is apparent only, for such acts in reality appropriate the whole idea of means, although excluding unessential matters of construction.[2] As more explicitly stated in preceding paragraphs, the invention made or used or sold must be the exact patented invention, — identical in effect, identical in function, identical in mode of operation.

§ 901. Intention of Actual Infringer Immaterial: When Intention may Evidence Infringement.

As a general proposition, the intention with which an act of infringement is performed is immaterial.[1] The rights of the patentee are equally invaded whether or not the infringer purposes to violate them, and even though he may be ignorant of their existence;[2] and the duty of the law to redress his in-

§ 900. [1] That to employ a distinct part of a patented invention is not an infringement, unless such part is also patented, see §§ 923, 924, and notes, *post*.

That the use of the essential parts of an invention, or their equivalents, is an infringement, see Sessions *v.* Romadka (1884), 28 O. G. 721; 21 Fed. Rep. 124.

That it is no infringement of a patent to make and sell that part of the patented invention which is not covered by the Claims of the patent, see Simon *v.* Neumann (1884), 20 Fed. Rep. 196; 27 O. G. 918.

That there is no infringement where the device was intended to be a reproduction of a device made two years before the patented invention, see Delamater *v.* Woodruff (1882), 11 Fed. Rep. 414.

That to make and improve upon a disclaimed part of the invention is not an infringement, see Hatch *v.* Moffitt (1883), 15 Fed. Rep. 252.

[2] That a machine-patent is infringed whenever the structural law of the machine is employed, though the parts vary in number or appearance, see § 926 and notes, *post*.

§ 901. [1] That the motive with which an infringement is committed is immaterial, see Parker *v.* Hulme (1849), 1 Fisher, 44.

[2] That there may be an infringement though the infringer does not work by the patent or even know of the patent, see Royer *v.* Coupe (1886), 39 O. G. 239; 29 Fed. Rep. 358; Matthews *v.* Skates (1860), 1 Fisher, 602; Parker *v.* Hulme (1849), 1 Fisher, 44.

That all persons are bound to take notice of a patent duly issued, see

juries is not affected by the mental condition of the person by whom they are inflicted.[3] But there are many actions, equivocal in character so far as the external operation is concerned, which are or are not acts of infringement according to the object contemplated by their actor,—actions otherwise innocent thus being regarded as violations of the rights secured by the patent, when intended as parts of a transaction which taken as a whole would be an infringement.[4] Like the specific intent in certain criminal cases, the intention of the infringer thus becomes an element in the act of infringement, the mental and physical operations concurring to complete the wrong by which the exclusive privileges of the patentee are violated.[5]

§ 902. Infringement through Ignorance of the Patent, how Prevented.

To guard as far as possible, however, against an ignorant infringement, the law imposes on the patentee the obligation of notifying the public of his claims at the same time that he informs them of the existence and the mode of practising his invention. In the case of an art this is sufficiently accomplished by the patent itself, since without recourse to the specification, or to some one who had learned the art therefrom or

National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 28 O. G. 1007 ; 19 Fed. Rep. 514.

[3] In Hogg *v.* Emerson (1850), 11 How. 587, Woodbury, J. : (607) "The intent not to injure, also, never exonerates, as is contended in these cases, from all damages for the actual injury or encroachment, though it may mitigate them."

That the fact that an infringement serves the public does not excuse it, see American Bell Telephone Co. *v.* Cushman Telephone & Service Co. (1888), 45 O. G. 1193.

[4] That an act of making with intent to sell or use, an act of making a part with intent that others shall make the remainder and unite them, an act of making a different article with intent that in its use it shall become the patented invention, &c., &c., are infringements, though the act of making without such intent would not be, see §§ 903, 924, and notes, *post*.

That acts of user or sale may thus be changed in character by their intent, see §§ 903–905, 924, and notes, *post*.

[5] That infringement is deliberate where the infringer knows of the patent, though he supposes that a patent of his own gives him the right to use the invention, see Burdett *v.* Estey (1880), 3 Fed. Rep. 566 ; 19 Blatch. 1 ; 5 Bann. & A. 308.

That a person who wrongfully uses the invention under claim of ownership of the patent is an infringer, see Continental Store Service Co. *v.* Clark (1885), 100 N. Y. 365.

from the inventor, the public could not gain the knowledge necessary to its use. But in the case of a patented article the article itself, being permanent and susceptible of examination, discloses its own nature, and being found in open market communicates to the public such knowledge as enables them to make and use it, and may thus be manufactured, used, and sold by others without any intimation of the exclusive privileges of the patentee. In reference to patented articles, therefore, the law provides that notice of the inventor's claims shall be given to the public by stamping the word "patented" with the date of the patent upon each article itself or on the package which contains it;[1] and that upon his failure so to do the owner of the patent shall not recover substantial damages for its infringement against any person who was not otherwise actually notified of the existence of the patent and his own violation of its claims.

§ 903. Infringement by Unlawful Making.

The act of making can be predicated only of an article as distinguished from an art, — the latter being intangible and fugitive, capable of use but not of manufacture or of sale. Making may consist in the construction of the article, or in such repairs upon it as amount to an entire or partial re-construction.[1] The act of making is complete when the article exists in a condition fit for use, though still in parts which

§ 902. [1] That a defendant cannot be held in damages as an infringer if the patentee put his invention on the market unstamped, unless he had notice of the patent, see Allen *v.* Deacon (1884), 10 Sawyer, 210; 21 Fed. Rep. 122.

See also, on the duty of stamping, etc., § 628 and notes, *ante*.

§ 903. [1] That an infringement may be committed by repairing as well as making the invention, if repairing involves reconstruction either in whole or in part, see Goodyear Dental Vulcanite Co. *v.* Preterre (1878), 14 O. G. 346; 15 Blatch. 274; 3 Bann. & A. 471.

To replace a part where the patent specially claims that part is infringement, see Gottfried *v.* Conrad Seipp Brewing Co. (1881), 8 Fed. Rep. 322; 10 Bissell, 368.

That where the different parts of a machine are covered by different patents a purchaser of the machine from the patentee cannot replace one of the parts separately patented when worn out, see Singer Mfg. Co. *v.* Springfield Foundry Co. (1888), 34 Fed. Rep. 393.

That a machine wrongfully sold by an infringer cannot be repaired without further infringement, see Graham *v.* Mason (1872), 1 O. G. 609; Holmes, 88; 5 Fisher, 290.

are to be united by the user.[2] To make a patented article is not *ipso facto* an infringement.[3] The intent of the maker here determines the legal complexion of his act, the purpose of the manufacture being an essential element of the transaction. To make as an experiment only, or for exhibition as a specimen of the manufacturer's mechanical skill, is not infringement.[4] To make for practical use or for sale is an infringement although the article be never used or sold, or be sold or used outside the territorial limits within which it is protected by the patent.[5] To make a single part of the invention with intent to use it in connection with the other parts already made, or to sell it to others by whom it will be united with the remaining portions of the article elsewhere obtained, is also an infringement.[6] To make a different article intending that by use it shall become the patented article, is likewise an infringement, — the maker being responsible for such changes as he contemplates in making it, though not for those which without his co-operation are subsequently introduced by those who use it.[7] On the other hand, to make the same tangible

[2] That to construct the parts ready for union by the purchaser is making, see § 924 and notes, *post*.

[3] That a mere making, without intent to sell or use, is not infringement, see § 898 and notes, *ante*.

[4] That to make for experiment, or amusement, or exhibition merely, is not an infringement, see Standard Measuring Machine Co. *v.* Teague (1883), 15 Fed. Rep. 390 ; Poppenhusen *v.* Falke (1861), 2 Fisher, 181 ; 4 Blatch. 493.

See also § 898 and notes, *ante*.

[5] That it is an infringement to make an article for use, though it is never used or sold, see Haselden *v.* Ogden (1868), 3 Fisher, 378 ; Whittemore *v.* Cutter (1813), 1 Gallison, 429 ; 1 Robb, 28.

That to make for sale abroad is an infringement, see Ketchum Harvester Co. *v.* Johnson Harvester Co. (1881), 8 Fed. Rep. 586 : 19 Blatch. 367.

[6] That to make a part with intent to use it, or to sell it to be used, in connection with the other parts of the invention, is infringement, see Celluloid Mfg. Co. *v.* American Zylonite Co. (1887), 30 Fed. Rep. 437 ; 40 O. G. 1453 ; Travers *v.* Beyer (1886), 26 Fed. Rep. 450 ; 23 Blatch. 423 ; Snyder *v.* Bunnell (1886), 29 Fed. Rep. 47 ; 38 O. G. 1130 ; Schneider *v.* Pountney (1884), 21 Fed. Rep. 399 ; 29 O. G. 84.

See also § 901 and notes, *ante*, and § 924 and notes, *post*.

[7] That to make a device with a view to a result produced by its use which would make it the same as the patented device is infringement, see N. Y. Bung & Bushing Co. *v.* Hoffman (1881), 20 Blatch. 3 ; 20 O. G. 1451 ; 9 Fed. Rep. 199 ; American Diamond Rock Boring Co. *v.* Sullivan Mach. Co. (1877), 14 Blatch. 119 ; 2 Bann. & A. 522 ; Renwick *v.* Pond (1872), 2 O. G. 392 ; 10 Blatch. 39 ; 5 Fisher, 569.

That an innocent manufacturer does

article for use or sale but as the embodiment of a distinct idea of means, or to make a single part not intended by the maker for use in union with the other parts, or to replace a part not covered by the patent, are not infringements.[8] A patent for the use of an article is not invaded by the act of making it, nor is the maker liable for its use by those to whom he sells it.[9] To make by the agency of others, whether workmen or co-partners, is infringement, and though the maker pays for the articles only by the piece and when completed and delivered.[10]

§ 904. Infringement by Unlawful Using.

To use a patented art or article for purposes of experiment only is not an infringement. But to employ it in any manner for beneficial uses of a pecuniary character is an invasion of the privileges of the patentee. It is immaterial that the article was made by others and has been purchased by the user, or now subsists in an altered condition, or is divided into parts

not infringe through changes made in his device after it leaves his hands and control, see De Long *v.* Bickford (1882), 13 Fed. Rep. 32 ; 22 O. G. 2242.

That it is not an infringement to make a device which can be forced to operate like the patented invention if such was not the intention of the maker, see Buzzell *v.* Andrews 1885), 25 Fed. Rep. 822 ; 34 O. G. 830.

That to make an article, not intended to resemble the patented invention, but which becomes like it by accident, wear and tear, or usage, is not an infringement, see Page *v.* Ferry (1857), 1 Fisher, 298.

[8] That if the article embodies a distinct idea of means and was so intended, though apparently similar to the patented invention, its manufacture is not infringement, see National Car Brake Shoe Co. *v.* D., L. & N. R. R. Co. (1880), 4 Fed. Rep. 224 ; Pitts *v.* Wemple (1855), 1 Bissell, 87 ; 2 Fisher, 10.

See also § 230 and notes, *ante*.

That to make an article which may be used in combination with others to form a patented invention is not infringement, unless intended for such use, see Campbell *v.* Kavanaugh (1882), 11 Fed. Rep. 83 ; 20 Blatch. 256.

See also §§ 900, 901, and notes, *ante*, and § 924 and notes, *post*.

[9] That a patent covering only the "use" of a certain thing is not infringed by "making" or "selling" it, nor are the maker or seller responsible for its use, see Keystone Bridge Co. *v.* Phœnix Iron Co. (1872), 5 Fisher, 468 ; 1 O. G. 471.

[10] That it is an infringement to employ a workman to infringe, see Lightner *v.* Brooks (1864), 2 Clifford, 287.

That a manufacturer infringes if his men work by the piece in making the device, see Wooster *v.* Marks (1879), 17 Blatch. 368.

which are successively employed, or is applied to different purposes from those intended by the inventor or to but one of several purposes for which it was designed, or is joined with new elements which enable it to perform additional functions, or is divested of its non-essential features, — the use is still an infringement of the patent, however meritorious may be the new uses or improvements discovered and made available by the infringer.[1] To use in part with intent that others shall complete the operation, or to use only through the agency

§ 904. [1] That to use an infringing device made by another is an infringement, see Haselden *v.* Ogden (1868), 3 Fisher, 378.

That the use of the device in an altered condition is infringement, see Illinois Central R. R. Co. *v.* Turrill (1876), 94 U. S. 695 ; 12 O. G. 709.

That to divide a single part into two parts, doing the same thing in the same way, is infringement, see Wheeler *v.* Clipper Mower & Reaper Co. (1872), 2 O. G. 442 ; 10 Blatch. 181 ; 6 Fisher, 1.

That to use two dies instead of one may be an infringement, see Baldwin *v.* Bernard (1872), 2 O. G. 320 ; 9 Blatch. 509 note ; 5 Fisher, 442.

That to take an invention for one purpose only is an infringement, see Adair *v.* Thayer (1880), 4 Fed. Rep. 441 ; 17 Blatch. 468 ; 5 Bann. & A. 118.

That to use a patented device for a new purpose is infringement, see Zinn *v.* Weiss (1881), 7 Fed. Rep. 914.

That the use of an inveution for a purpose not specified nor contemplated by the inventor is infringement, see Cincinnati Ice Mach. Co. *v.* Fosse-Schneider Brewing Co. (1887), 31 Fed. Rep. 469.

That to use an invention for a part of an operation, instead of the whole, is infringement, see Eames *v.* Andrews (1887), 122 U. S. 40 ; 39 O. G. 1319.

That to use a less quantity of a patented material is infringement, see Celluloid Mfg. Co. *v.* Chrolithion Collar & Cuff Co. (1885), 31 O. G. 519 ; 23 Fed. Rep. 397.

That the use of the essential features of the invention or their equivalents is infringement, see Sessions *v.* Romadka (1884), 28 O. G. 721 ; 21 Fed. Rep. 124.

That the use of a device which is an equivalent for the patented device and more, though in a way in which the patented device cannot be used, is infringement, see Yale Lock Mfg. Co. *v.* Norwich National Bank (1881), 6 Fed. Rep. 377 ; 19 Blatch. 123.

That the use of a separable patented part of the invention is an infringement, see Fetter *v.* Newhall (1883), 21 Blatch. 445 ; 17 Fed. Rep. 841 ; 25 O. G. 502.

That it is not infringement for the purchaser of a device to use it in a way forbidden to his vendor, see Goodyear *v.* Beverly Rubber Co. (1859), 1 Clifford, 348. But see §§ 824, 826, and notes, *ante*.

That a purchaser from a later inventor cannot use the device, pending an injunction against such inventor, without infringing, see Woodworth *v.* Edwards (1847), 3 W. & M. 120 ; 2 Robb, 610.

That the use of an invention involving a patented process is a continuing infringement, see Beadle *v.* Bennett (1887), 122 U. S. 71 ; 39 O. G. 1326.

of others who furnish to their principal the finished product resulting from such use, is likewise an infringement.[2]

§ 905. Infringement by Unlawful Selling.

To sell a patented article without authority from the patentee is always an infringement. A sale, in its true legal sense, imports a transfer of the ownership of property, accompanied by its delivery to the vendee, in consideration of a price or recompense in value. But any form of transfer, under whatever disguise concealed, which directly or indirectly passes the apparent title from one person to another, is a sale within the purpose and construction of the Patent Laws, and makes the transferor an infringer of the patent.[1] To sell a part of the invention with the intent that it shall be united or used in connection with its other parts, to sell a different article with the intent that in its use it shall become the one claimed in the patent, to transport knowingly for use and sale in collusion with infringing makers or vendors, are also acts of infringement.[2] But a sale pro-

[2] That a partial use to be completed by others is an infringement, see § 901 and notes, *ante*, and § 924 and notes, *post*.

That a merely colorable contract for the product by one who procures the infringing machine or process to be used for his benefit is an infringement, see Keplinger *v.* De Young (1825), 10 Wheaton, 358 : 1 Robb, 458.

That a person who makes a *bona fide* contract with an infringer to take the entire product of the infringing process or machine is not *per se* an infringer himself, though he knows that the machine or process is an infringement, see Keplinger *v.* De Young (1825), 10 Wheaton, 358 ; 1 Robb, 458.

That where the users of an infringing machine lease it to others who use it in complicity with the lessors, they may be joined as defendants, being joint infringers, see Wells *v.* Jaques (1874), 5 O. G. 364 ; 1 Bann. & A. 60.

§ 905. [1] That any transaction, whether it assume the form of a sale proper or an exchange or a judgment and recovery, or any other transfer of ownership, is a sale within the intent of the Patent Laws, see § 1252 and notes, *post*.

That to sell an infringing article is an infringement whoever may have been the maker, see Haselden *v.* Ogden (1868), 3 Fisher, 378.

That it is not infringement to make and sell to one who has a license to use, where the invention is a mere appendage and the patentee has agreed to license all makers who apply, see Saxe *v.* Hammond (1875), 7 O. G. 781 ; Holmes, 456 ; 1 Bann. & A. 629.

[2] That the manufacture and sale of a part of the device, with intent that it shall be used in infringing the patent, is itself an infringement, see Travers *v.* Beyer (1886), 26 Fed. Rep. 450 ; 23 Blatch. 423 ; Schneider *v.* Pountney

cured by the patentee or his agent is not an infringement, although it furnishes evidence of other sales which are infringements.[3] The sale of a part covered by one patent is not an infringement of a different patent for the entire article,

(1884), 21 Fed. Rep. 399; 29 O. G. 84.

That a sale of a *machine* to be used in infringing a patented combination is an infringement, see Holly *v.* Vergennes Mach. Co. (1880), 4 Fed. Rep. 74; 18 Blatch. 327; 18 O. G. 1177.

That sale of part of an article is not *ipso facto* an infringement, see American Cotton Tie Co. *v.* Simmons (1882), 106 U. S. 89; 22 O. G. 1976.

That the sale of an article which can be used only for the purpose of an infringement is itself an infringement, see Snyder *v.* Bunnell (1886), 29 Fed. Rep. 47; 38 O. G. 1130; Alabastine Co. *v.* Payne (1886), 27 Fed. Rep. 559; 35 O. G. 1438.

That mere capability of use for infringing purposes does not make the seller an infringer, see Snyder *v.* Bunnell (1886), 38 O. G. 1130; 29 Fed. Rep. 47.

That to make and sell an instrument capable of being used, and designed to be used, to effect the result of the patented invention by the means described in its claims is an infringement, see Renwick *v.* Pond (1872), 2 O. G. 392; 10 Blatch. 39; 5 Fisher, 569.

That to make and sell a device which in using it will become the same device covered by the patent is infringement, see N. Y. Bung & Bushing Co. *v.* Hoffman (1881), 20 Blatch. 3; 20 O. G. 1451; 9 Fed. Rep. 199; American Diamond Rock Boring Co. *v.* Sullivan Mach. Co. (1877), 14 Blatch. 119; 2 Bann. & A. 522.

That to sell with such directions as to use as, by the use, to copy the patented invention, is an infringement, see Boyd *v.* Cherry (1883), 4 McCrary, 70.

That to make and sell materials, knowing and intending their use for infringing purposes, makes the seller a joint infringer, see Celluloid Mfg. Co. *v.* American Zylonite Co. (1887), 30 Fed. Rep. 437; 40 O. G. 1453.

That knowingly to transport an invention to be used by consignees in violating a patent is an infringement, see American Cotton Tie Supply Co. *v.* McCready (1879), 17 O. G. 565; 17 Blatch. 291; 4 Bann. & A. 588.

That infringement by complicity must be clearly proved both as to act and intent, see Snyder *v.* Bunnell (1886), 38 O. G. 1130; 29 Fed. Rep. 47.

[3] In De Florez *v.* Raynolds (1878), 14 Blatch. 505, Wheeler, J.: (509) "The infringement shown is by proof of the sale of a can by the defendants, purchased for and by the direction of the orators. It is claimed that the orators so participated in this transaction that the defendants cannot be liable on account of it. This is probably true, and if this was all the defendants have done the orators would not be entitled to a decree. But this can was purchased of the defendants in the usual course of their business, which is some evidence that they are dealing in those articles. This evidence they have not met and denied, but have rather supported. From it it is found that they are dealing in these infringing cans in such a manner that, except as to this one purchased for the orators, they are liable to account, and to prevent which they should be restrained." 3 Bann. & A. 292 (296).

See also Byam *v.* Bullard (1852), 1 Curtis, 100.

nor is the sale of a part not intended for use in the infringing article, though capable of such use as well as others.[4] A sale by a sheriff, under legal process, of the materials of a patented article, though ready to be united and practically used, is not infringement.[5] A patent for the use of the article is not infringed by selling it, nor is the vendor responsible for its use by his own vendees.[6] An infringing sale may be effected through the agency of others, for whose acts the principal must answer as if they were committed by himself.[7] But acts of agents outside their authority implicate themselves alone; and personal representatives, by wrongful sales of patented articles found among the assets of the decedent, create no liability against his estate.[8]

§ 906. Infringement a Single Tort though Embracing Acts of Making, Use, and Sale.

Although a complete infringement is committed by a single act of either making, use, or sale, yet when the same person performs two or more of these, the number of the infringements is not thereby increased. To make and use, or to make and sell, or to make and use and sell are the same tort, perpetrated through the medium of different acts, and constituting a single cause of action.[1] The measure of damages may

[4] That to sell a part covered by one patent does not infringe another patent covering the whole, see Buerk *v.* Imhaeuser (1876), 11 O. G. 112; 2 Bann. & A. 165.

That to make and sell a useless part of a structure, not sold to be used nor used in an infringing structure, is not an infringement, see Campbell *v.* Kavanaugh (1882), 11 Fed. Rep. 83; 20 Blatch. 256.

[5] That a sale of the materials of a patented device by a sheriff on legal process is not infringement, see Sawin *v.* Guild (1813), 1 Gallison, 485; 1 Robb, 47.

[6] That a patent for the "use" is not infringed by a "sale," nor is the seller liable for the use by the vendee, see Keystone Bridge Co. *v.* Phœnix Iron Co. (1872), 5 Fisher, 468; 1 O. G. 471.

[7] That a sale by an agent is infringement by the principal, see Jones *v.* Sewall (1873), 3 Clifford, 563; 6 Fisher, 343; 3 O. G. 630; Poppenhusen *v.* N. Y. Gutta Percha Comb Co. (1858), 2 Fisher, 62.

[8] That a sale of infringing articles by an administrator does not make the estate liable for infringement, see Thompson *v.* Canterbury (1881), 2 McCrary, 332.

§ 906. [1] In Steam Stone Cutter Co. *v.* Sheldon (1884), 21 Fed. Rep. 875, Wheeler, J.: (877) "The orator could not in any mode recover both for the profits of the sale for use and the profits

differ, as will be hereafter seen, as one or more of these acts enter into the infringement, but for all purposes of compensation to the patentee, and of judicial restraint on the infringer, they are one wrong demanding but one redress.[2]

§ 907. No Infringement can be Committed before the Issue of the Patent.

No act of making, use, or sale can be an infringement of a patented invention unless it be performed during the life of the patent. An infringement may indeed be committed by the use, after the patent issues, of a device constructed before the creation of the monopoly, notwithstanding the good faith of its purchaser or maker and his belief that it will never be protected by a patent.[1] But an unauthorized appropriation of the invention, before the patent issues, although a tort for which the inventor has his remedy, is not an infringement

of the use. Each was a trespass upon the orator's exclusive rights, but not a separate and distinct trespass. A recovery for one would include a recovery for a part, at least, of the other, so that a recovery could be had for either, but not for both. The orator having had a recovery for one, cannot now have another for the other." 22 Blatch. 484 (487).

[2] That acts of making by one person and of use or sale by another are distinct infringements, see Blake *v.* Greenwood Cemetery (1883), 16 Fed. Rep. 676; 25 O. G. 89; 21 Blatch. 222.

That as determining the measure of damages, acts of making, use, and sale are essentially distinct, and vary in their effect according to the patentee's method of enjoying his monopoly, see Colgate *v.* Western Electric Mfg. Co. (1886), 28 Fed. Rep. 146; 37 O. G. 893.

That where one party makes and another sells they are liable jointly and severally, see Jennings *v.* Dolan (1887), 38 O. G. 1018; 29 Fed. Rep. 861.

§ 907. [1] In Evans *v.* Weiss (1809), 2 Wash. 342, Washington, J.: (344) "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, beforehand, that the right to 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 that 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.

capable of redress under the Patent Law.[2] In the English courts a contrary view has been taken and the relief due to the patentee has been extended to wrongs committed after the filing of the specification and before the patent had been sealed.[3] But under our system the privilege created by the patent is alone subject to infringement, and the invasion of the right has uniformly been held to be impossible until the right itself has been conferred. The date of the patent is thus the earliest moment at which an infringement can occur; and this is true not only in original patents but in re-issues also, which for this purpose are considered new patents and cannot be infringed by acts performed before they have been granted.[4]

§ 908. Infringement after the Patent has Expired.

As a general rule, the act must also be committed before the term, for which the patent issued or was extended, has expired. The termination of the exclusive privileges of the

Not only may individuals be injured by a literal 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 arm's length, so as to prevent them from profiting by the invention for a length of time during which the fourteen years is not running on. But all these hardships must rest with Congress to correct. It is beyond our power to apply a remedy." 1 Robb, 10 (12).

[2] That no infringement can take place before the issue of the patent, see Lyon *v.* Donaldson (1888), 34 Fed. Rep. 789.

That an injunction will not be granted where the evidence shows that the defendant is using the same devices or process which he employed before the patent was granted, see Dorlan *v.* Guie (1885), 25 Fed. Rep. 816; 34 O. G. 702.

That there can be no infringement by using an invention invented but withheld from the public by the patentee, see Page *v.* Ferry (1857), 1 Fisher, 298.

[3] That an infringement may be committed at any time after a complete specification is filed, see 15 & 16 Vict. c. 83.

[4] That a re-issue is not infringed by acts committed under the original patent, see § 696 and notes, *ante*.

That a re-issue with a broader Claim is not infringed by the use of devices made before the original patent, though they are covered by the new Claim, see Ives & Miller *v.* Hartford Spring & Axle Co. (1882), 11 Fed. Rep. 510; 20 Blatch. 333; 22 O. G. 1037.

That a device which does not infringe the original cannot infringe the re-issue, if the scope of original is measured by its description and not by its Claims alone, see Cammeyer *v.* Newton (1879), 16 O. G. 720; 4 Bann. & A. 159.

patentee is contemporaneous with the expiration of the patent which creates them, and the right to make, and use and sell the invention is then vested in the public beyond the control or interference of the inventor. To this rule there is one exception. As before stated, the making of the invention is not *ipso facto* an infringement, though it becomes such when coupled with an intent that the invention shall be used or sold in violation of the patent. Under this doctrine there is nothing to prevent the manufacture of the patented article in unlimited quantities during the life of the patent, to be put upon the market or into operation as soon as the patent expires to the possible injury of the business of the patentee or his licensees. The law regards such a transaction as a fraud upon the rights of the patentee, and an evasion of the rules by which those rights are protected; and the courts have therefore treated the use and sale, after the patent has expired, of articles made for that purpose without due authority while the patent was in force as infringements of the patent and as rendering the parties liable in the same manner and to the same extent as if the acts of use and sale, as well as that of making, had been committed during the existence of the patent.[1] The expiration of one among a series of connected

§ 908. [1] In American Diamond Rock Boring Co. *v.* Sheldon (1880), 1 Fed. Rep. 870, Wheeler, J.: (872) "The defendants have machines made during the term of the patent, and which were infringements when made. If they could be made then and used now, in defiance of the owner of the patent, the exclusive right granted would not be fully enjoyed. The grant of the exclusive right is substantially the same in this country as it is in England. The question raised here arose there in Crossley *v.* Derby Gas-light Co., Webst. Pat. Cas. 119. The case is more fully reported in 4 Law Jour. N. S. Chan. 25. There the patent would expire on the ninth of December, 1829; and on the twenty-eighth of November before a bill was filed praying for an injunction against using infringing machines and for an account, the vice chancellor granted the injunction, and directed the account, and the defendants appealed. After argument, the lord chancellor, Lyndhurst, said: 'This is an appeal from his honor, the vice chancellor, and is a case for an injunction against the invasion of a patent-right by preventing the use of certain gas-meters. This case is very peculiar, and is distinguishable from all other cases in the books. It appears that the plaintiff obtained his patent on the ninth of December, 1815, and that on the twenty-eighth of November, 1829, only a few days before the patent expired, he filed a bill. It was objected that the court would not interfere, just on the eve of the expiration of the patent, and grant an injunction

patents does not release to the public any invention covered by the others, and if the instrument or operation it protected cannot be enjoyed without the employment of the associated inventions, the public must postpone its appropriation to their use until the patents for these have also terminated.[2]

which would only last a week. The point has never yet been decided; but I am of opinion that the court would interfere after a patent had expired to restrain the sale of articles manufactured previous to its expiration in infringement of a patent-right, and that a party would not be allowed to prepare for the expiration of a patent by illegally manufacturing articles, and immediately after its expiration to deluge the markets with the products of his piracy, and thus reaping the reward of his improbous labor in making it. The court would, I say, in such case restrain him from selling them, even after the expiration of the patent.' This doctrine does not appear to have been denied or questioned afterwards, and was frequently carried out, in effect, by decreeing the destruction of infringing machines. Betts *v.* De Vitre, 34 Law Jour. Ch. 289; Needham *v.* Oxley, 11 Weekly Rep. 852. In Curtis on Pat. § 436, it is laid down as clear law that, 'if the patent has expired, the account and the injunction will extend to all the articles piratically made during the existence of the patent, though some of them may remain unsold.' The illegality attaches to the things themselves. The person making them has no right to make them — no right to them when made; he can impart none, and none will accrue by their passing into time when they might be made. The ordinary injunction in such cases, in effect, restrains all infringement of the patent, and is, in form, perpetual. It would, doubtless, cover an illegal sale or use after the expiration of the patent." 18 Blatch. 50 (52); 5 Bann. & A. 292 (294).

See also New York Belting & Packing Co. *v.* Magowan (1886), 27 Fed. Rep. 111; 34 O. G. 1278.

That the sale of an article after the patent expires is not an infringement though it were made under the patent, if the patentee consented to the making, see Reay *v.* Rau (1883), 23 O. G. 1928; 15 Fed. Rep. 740.

[2] In McKay *v.* Dibert (1881), 5 Fed. Rep. 587, Nixon, J.: (590) "Taking the case, then, as we find it, the naked question presented is: If an inventor embody in a machine a new mechanism to accomplish a desired and express purpose, does the Patent Law authorize him to procure (1) a patent for the machine, (2) a patent for the process by which the result was achieved, and (3) a patent for the product of the process as a new article of manufacture; and if such patents expire at different times has the court the power to decree that the younger patents in the series shall die when the older one runs out? Or, to state the proposition more succinctly, is there authority in the law to continue to an inventor the monopoly in the product of a machine after the machine itself has become public property by falling into the domain of public use? In determining such a question reference must be had, of course, to the law as it stood when the several patents were issued. These were the acts of July 4, 1836, and March 3, 1839, which were substantially the same as the present statute in regard to patentable subjects. By the sixth section of the first recited act the Commissioner of Patents was authorized to grant letters-patent to any person who had dis-

§ 909. Infringement can be Committed only within the Area of the United States.

A patent purports to protect the invention throughout the United States and the territories thereof. This protection

covered or invented 'any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement in 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.' By the seventh section of the later act such public use or sale shall not avoid the patent, unless the same has continued for two years prior to the application for the patent. It is here we find the scope and extent, as well as the limitation, of the power of the Commissioner of Patents in regard to granting or withholding letters-patent. If the inventor, after obtaining his first patent for the machine, had waited for more than two years before applying for the process and product patents, there may have been such disclosure and public use of the invention that the limitation would have applied, and the Patent Office been compelled, under the provisions of the supplement of 1839, to have rejected the subsequent application. But no such time elapsed, and I am of the opinion that it was competent for the patentee, within the two years, to take out his process and product patents, and thus to guard himself against the danger and loss that might arise from others using the process to accomplish other results, or securing the product by the agency of other means and instrumentalities. Two reasons were forcibly presented by the learned counsel for the defendant why the act should not have the above interpretation: (1) Because it was asking the court, by judicial construction, to extend the monopoly and life of a patent for two years beyond the time prescribed by the law; (2) because the machine patent having expired, and belonging to the public, it was a contradiction in terms to hold that its use could be restrained on the ground that by its use other patents were infringed. These reasons need not be considered separately, and I think the difficulties which they suggest grow out of a misapprehension of what the court is supposed, in fact, to do in the case. The argument was that if an inventor procures a patent for a machine, and, after holding it for any length of time less than two years, is permitted, without the surrender of the original and a re-issue, to apply for a patent for the process employed, and the product obtained from the use of the machine, and then, after the expiration of the machine patent, may restrain its use by the public until the process and product patents run out, it is practically extending the life of the first patent, and giving the owner a monopoly beyond the period of time to which the law in express terms limited it. But the court does not propose to restrain generally the use of the machine but only such unlawful use of it as infringes the vested rights of others. As long as separate patents for a machine, and the process and the product, are allowable, they represent distinct inventions (Kelleher *v.* Darling, 14 O. G. 673), and each one may live, without interference or molestation, its whole life, without regard to the death of the others. While the product patent continues in existence, the manufac-

exhausts the powers of Congress, so far as the place of its exercise is concerned. It also marks the limits within which acts of infringement must occur.[1] The area of the United States for this purpose as well as others is held, however, to include not only all the waters which embrace its shores but American vessels sailing upon whatever seas.[2] To make, use, or sell the patented invention within the area thus defined, or to make within the United States for sale abroad, is an infringement.[3] Foreign vessels, though within our territory, are

ture of the product by any instrumentality is prohibited, and it is no answer to the charge of infringement to say, 'I had the right to use the particular mechanism by which I obtained the product.' But the defendant insists that the machine belongs to the public to use, and that nothing can be manufactured from it except the product, of which the complainant has yet the monopoly. If this be true, then the public must find out some other use to put it to, or abstain from its use until the time comes in which it may be used without infringing the rights of others." 19 O. G. 1351 (1352).

But see McKay *v.* Jackman (1882), 12 Fed. Rep. 615; 22 O. G. 85; 20 Blatch. 466.

§ 909. [1] That a purchaser in England from the vendee of the patentee, who has sold the article without restrictions, is not an infringer when he uses or sells in the United States, see Holliday *v.* Matheson (1885), 23 Blatch. 239; 24 Fed. Rep. 185; 31 O. G. 1444.

That the use in England of infringing apparatus purchased abroad is infringement under English laws, see United Telephone Co. *v.* Sharples (1885), L. R. 29 Ch. D. 164.

[2] In Gardiner *v.* Howe (1865), 2 Clifford, 462, Clifford, J.: (464) "Reference is made by the defendant to the case of Brown *v.* Duchesne, 2 Cur. 371, and Same *v.* Same, 19 How. 183; but these cases do not apply where, as in this instance, the vessel where the act of infringement took place was American. Were it to be held that in cases like the present the plaintiff is not entitled to recover, patents for improvements in the tackle and machinery of vessels, or in their construction, would be valueless. The Patent Laws of the United States afford no protection to inventions beyond or outside of the jurisdiction of the United States; but this jurisdiction extends to the decks of American vessels on the high seas, as much as it does to all the territory of the country, and for many purposes is even more exclusive."

[3] In Ketchum Harvester Co. *v.* Johnson Harvester Co. (1881) 8 Fed. Rep. 586, Blatchford, J.: (586) "Although the patent could give no protection abroad in the sale of machines abroad, it gave protection in the United States in making machines in the United States for sale abroad. The patent prevented all persons but the patentee from making in the United States. The privilege of making in the United States, for sale abroad, was valuable, as was shown by the fact that the defendant made in the United States for sale abroad. The plaintiff was entitled to that privilege exclusively, and to damages for its violation. It may be that in the case of manufacture in the United States, without sale anywhere, nominal damages only are to be allowed; but where such

not within the jurisdiction of the United States, and the use thereon of articles procured abroad is not an infringement.[4] Articles procured here for use upon such vessels would involve an act of infringement on the part of the person by whom they were furnished, although their use may be beyond the reach of our judicial powers.

§ 910. Infringement by the Government and its Officials.

Any person, whether natural or artificial, who without due authority from the patentee performs an act of making, using, or selling a patented invention, or procures such an act to be performed, or adopts it and accepts its benefits when performed, is guilty of an infringement. Even the government of the United States, from whom the patent emanates, can neither grant to others the right to practise the invention, nor itself employ it, without the permission of the patentee.[1] Though

manufacture is followed by sale abroad, it cannot be said that the damages ought to be only nominal. It is true that the sale is the fruition and gives the profit, and that the sale is abroad, and the patent does not cover the sale abroad. But the unlawful act of making is made hurtful by a sale, wherever made. The legal damages for making and selling here may be, in some cases, greater than the legal damages for making here and selling abroad; but to deprive the patentee of all damages for unlawful making here, because the article is sold abroad, is to deprive him of part of what his patent secures to him." 19 Blatch. 367 (367).

[4] In Brown *v.* Duchesne (1856), 19 How. 183, Taney, J.: (198) "And the court are of opinion that the rights of property and exclusive use granted to a patentee does not extend to a foreign vessel lawfully entering one of our ports; and that the use of such improvement in the construction, fitting out, or equipment of such vessel while she is coming into or going out of a port of the United States, is not an infringement of the rights of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs."

§ 910. [1] In James *v.* Campbell (1882), 104 U. S. 356, Bradley, J.: (357) "That the Government of the United States, when it grants letters-patent for a new invention or discovery in the arts, confers upon the patentee an exclusive property in the patented invention, which cannot be appropriated or used by the Government itself without just compensation any more than it can appropriate or use without compensation land which has been patented to a private purchaser, we have no doubt. The Constitution gives to Congress 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,' — which could not be effected if the government had a reserved right to publish such writings or to use such inventions without the consent of the owner." 21 O. G. 337 (337).

See also Palmer *v.* United States

the invention be of no utility except for governmental purposes, or pertain to an art over which another grantee of the United States has an exclusive control, it is no less within the entire dominion of the patentee, and cannot be appropriated to such uses without incurring liability to him.[2] Officers of the United States, contractors on its public works, and others acting upon its behalf but guided by their own volition as distinguished from superior authority, are also responsible for acts committed by them in violation of the patent, although the ultimate benefit of the infringement accrues not to themselves but to the government for which they act.[3] In cases of great

(1885), 20 Ct. of Claims 432; Campbell *v.* James (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354; Cammeyer *v.* Newton (1876), 94 U. S. 225; 11 O. G. 287; Brady *v.* Atlantic Works (1876), 2 Bann. & A. 436; 10 O. G. 702; 4 Clifford, 408; United States *v.* Burns (1870), 12 Wall. 246; *quere*, Heaton *v.* Quintard (1869), 7 Blatch. 73.

That the government cannot grant the right to use a patented invention, see Colgate *v.* International Ocean Telegraph Co. (1879), 17 O. G. 194; 17 Blatch. 308; 4 Bann. & A. 609.

That a grant by the government of exclusive rights to carry on a certain business does not authorize the use of a patented invention in that business, see Colgate *v.* International Ocean Telegraph Co. (1879), 17 O. G. 194; 17 Blatch. 308; 4 Bann. & A. 609.

[2] In James *v.* Campbell (1882), 104 U. S. 356, Bradley, J.: (358) "Many inventions relate to subjects which can only be properly used by the government, such as explosive shells, rams, and submarine batteries, to be attached to armed vessels. If it could use such inventions without compensation, the inventors could get no return at all for their discoveries and experiments. It has been the general practice, when inventions have been made which are desirable for government use, either for the government to purchase them from the inventors and use them as secrets of the proper department, or if a patent is granted, to pay the patentee a fair compensation for their use. The United States has no such prerogative as that which is claimed by the sovereigns of England, by which it can reserve to itself, either expressly or by implication, a superior dominion and use in that which it grants by letters-patent to those who entitle themselves to such grants. The government of the United States, as well as the citizen, is subject to the Constitution; and when it grants a patent the grantee is entitled to it as a matter of right, and does not receive it, as was originally supposed to be the case in England, as a matter of grace and favor." 21 O. G. 337 (337).

[3] That it is not held in James *v.* Campbell, 104 U. S. 356, that an United States official is not liable for an infringement, see Forehand *v.* Porter (1883), 15 Fed. Rep. 256.

That a postmaster is liable if he uses an infringing device in the postal service, see Campbell *v.* James (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354. But see James *v.* Campbell (1882), 104 U. S. 356; 21 O. G. 337.

That the employees and contractors

public emergency, however, inventions may be taken by the government without the consent of the inventor under a right akin to eminent domain, and in these cases the officers through whom it acts are not infringers, although the patentee is entitled to compensation from the United States.[4] In suits against the United States, and in proceedings instituted in pursuance of an act of Congress for determining its liability for the use of patented inventions, its measure of responsibility is the same as that of private individuals.[5]

§ 911. Infringement by Public Corporations.

A municipal corporation is responsible for acts of infringement performed by its officers and agents for its benefit.[1] It is immaterial whether such officers are appointed by itself or constitute an independent corporation acting on its behalf by virtue of legislative authority; it is sufficient if it reaps the

of the government are liable if they infringe, see Brady *v.* Atlantic Works (1876), 10 O. G. 702; 4 Clifford, 408; 2 Bann. & A. 436.

That a patent for the application or employment of armor on war vessels is not *infringed by a mere workman* who applies it to a vessel of the United States, see Heaton *v.* Quintard (1869), 7 Blatch. 73.

[4] In Brady *v.* Atlantic Works (1876), 4 Clifford, 408, Clifford, J.: (412), "Private property, the Constitution provides, shall not be taken for public use without just compensation, and it is clear that that provision is as applicable to the government as to individuals, except in cases of extreme necessity, in time of war, and of immediate and impending public danger. Exigencies of the kind do arise where the prohibition does not apply to the public, and in such cases it must be conceded that the officer in the public service is not a trespasser, but it is equally true that the government is bound to make full compensation to the owner. Mitchell *v.* Harmony, 13 How. 134; United States *v.* Russell, 13 Wall. 627." 10 O. G. 702 (702); 2 Bann. & A. 436 (436).

[5] That the remedy against the United States is to be sought in the Court of Claims, where adequate compensation for the injury inflicted on the patentee may be obtained, see § 1258 and notes, *post.*

That it is doubtful whether a government official who uses an invention solely for the benefit of the government can be sued for infringement, and whether the case is not one solely for the Court of Claims, see James *v.* Campbell (1882), 104 U. S. 356; 21 O. G. 337.

§ 911. [1] That a city may be sued for infringement, see Bliss *v.* City of Brooklyn (1871), 4 Fisher, 596; 8 Blatch. 533.

That a city is liable in its corporate capacity for an infringement by its officers for its benefit, see Munson *v.* Mayor of New York (1880), 3 Fed. Rep. 338; 18 Blatch. 237; 5 Bann. & A. 486.

actual or supposed advantages of their infringement.[2] But a municipal corporation is not liable for infringements com-

[2] In Brickill v. Mayor of New York (1880), 7 Fed. Rep. 479, Wheeler, J.: (482) "It is urged that an infringement by the fire department of the city is not an infringement by the defendant, because that department was, under the law, a corporation of itself, over which the officers of the city had no control. It is understood, however, as was said in Allen v. The Mayor, etc., that the fire department was a mere agency of the city, having no funds of its own, and making no profits for itself apart from those of the city. If there are any gains and profits in the hands of any party to be accounted for, under these circumstances, on account of an infringement, they must be in the general treasury of the city, and the city itself must be liable to account for them." 18 O. G. 463 (464); 18 Blatch. 273 (276); 5 Bann. & A. 544 (547).

In Allen v. City of New York (1879), 17 O. G. 1281, Wheeler, J.: (1281) "The proof in respect to infringement is to the effect that seats embodying this invention were bought by the Board of Education of the city of New York for the use of the schools of the city, and have been in use in those schools under the direction of the Board of Education and the Department of Public Instruction, which has superseded the Board of Education. It is argued that upon this proof the city is not liable in this suit for two reasons. One is because these instrumentalities having charge of the schools are corporations themselves over which the city has no control; the other is that the use is under sovereign authority delegated by the State of New York in its sovereign capacity, for which the city or the Board of Education or the Department of Public Instruction can no more be held liable to suit than the State itself. It is understood that the Board of Education was, and that the Department of Public Instruction is, a corporation under the laws of the State, recognized and treated as such by the courts of the State, and having exclusive charge and control of the schools of the city, without whose action the city cannot be made liable for anything connected with the schools, and for whose contracts the city cannot be held liable otherwise than through proceedings against them. Ham v. The Mayor, etc., 70 N. Y. 459; Dannatt v. The Mayor, &c., 6 Hun, 88. But still the schools are the schools of the city, the Board of Education or Department of Public Instruction takes charge of them for the city, they are paid for with the money of the city, and whatever is saved in providing for them is to the advantage of the city. The corporation which that department or board constitutes is within that of the city, and is an instrumentality through which the educational interests of the city are cared for the same as if done by officers having the same powers, except that the officers could have only a personal and official period of existence, while that of the corporation is, under the law, theoretically perpetual. One principal ground of a suit in equity for the infringement of a patent is to compel an account of the gains or profits accrued to those proceeded against by means of the infringement. Obviously the proper party to proceed against is the one that has received the profits, or to whom the gains have accrued. If any party has saved or made anything by this infringement, it is the city, and the city seems clearly to be a proper party to account for these savings or profits. The board and department are proper parties also, for they have been directly engaged in the

mitted by a contractor on its public works, nor for the use of articles furnished to it by him although they are the product of infringing processes; nor can any agreement between the contractor and the patentee shift the responsibility for the infringement from the contractor to the corporation.[8] Public bodies which are not corporations, although composed of sev-

infringement. It is argued that the city as such could not stop the infringement nor control it, and therefore could not be guilty of any tort by which to acquire profits to account for. Probably the city could not, independently of this board or department, stop the infringement; but that is on account of the mode in which the law requires the educational matters of the city to be attended to, and not because the city has any just right to advantages which the wrongful acts of its board or department may acquire. Officers might be able to do the same, but, if so, the city would *not be shielded.* That the acts constituting the infringement were committed in the exercise of authority derived from the State cannot shield the defendant from liability. The grant of the exclusive right to this invention came from the sovereign power of the general government, and the right is a species of property secured to the inventor by law. *It is not subservient to public uses* without just compensation, ascertained and furnished upon being taken in a regular and lawful mode, any more than other property of any kind is. It has not been taken by any regular proceeding, but only by mere wrong-doing, which could of itself furnish no legal right. Cammeyer *v.* Newton, 4 Otto, 234." 17 Blatch. 350 (350); 5 Bann. & A. 57 (59).

Contra, that a city is not liable for the acts of a public board of education over whom it has no control, see Allen *v.* City of Brooklyn (1871) 4 Fisher, 598; 8 Blatch. 535.

[8] In Lightner *v.* Brooks (1864), 2 Clifford, 287, Clifford, J.: (293) "Where parties contract for implements, machines, or structures to contain any of the modern patented improvements, without any knowledge that the contractor is an infringer, or intends to use the improvement without authority, it is not the just and legal implication from the contract that the party ordering the article contemplates that the contractor will violate the rights of the patentee, or that he thereby commands or directs an infringement. Such contracts are now of daily occurrence, and unless there is some proof of concert, or something in the terms of the contract to indicate a contrary intent, the presumption must be that the person ordering the article either supposed that the contractor had the right to use the improvement, or, as part of the price to be paid by the purchaser of the article ordered, would procure the right of use from some person authorized to grant it for *that* purpose."

That a public body, employing a contractor to furnish articles for its buildings, is not liable for infringements by the contractor in supplying patented articles without authority, see May *v.* Juneau Co. (1887), 30 Fed. Rep. 241; 41 O. G. 578.

That where a contractor acting under a license does not pay his royalties, the principal hiring him does not infringe, see Stow *v.* Chicago (1877), 8 Bissell, 47; 3 Bann. & A. 83.

That a city using the product made by an infringing process by a contractor does not infringe, see Brown *v.* District of Columbia (1884), 3 Mackey, 502.

oral individuals exercising certain statutory powers, are not capable of committing an infringement or any other wrong except those specified in the statute which creates them.[4] Contractors and officials acting for such bodies are alone answerable for their unauthorized appropriation of a patented invention.[5]

§ 912. Infringement by Private Corporations: Liability of Officers and Stockholders.

A private corporation infringes by any act of its agents or employees, authorized or ratified by it, which wrongfully appropriates the patented invention. By procuring infringing devices and permitting its workmen to use them, by hiring contractors to practise the invention for its benefit, and in similar ways, it may commit a direct act of infringement; but it is not permitted to escape responsibility by any disguise of its transactions, and to accept, however indirectly, the benefit of the infringing acts of its officers and servants renders it liable to the patentee.[1] It cannot avoid this liability although

[4] That a county may be liable for infringements, see May *v.* Saginaw Co. (1887), 32 Fed. Rep. 629; May *v.* County of Logan (1887), 30 Fed. Rep. 250; 41 O. G. 1387; May *v.* County of Rolls (1887), 31 Fed. Rep. 473; 40 O. G. 575; May *v.* Mercer Co. (1887), 41 O. G. 815; 30 Fed. Rep. 246.

Contra, May *v.* Juneau Co. (1887), 30 Fed. Rep. 241; 41 O. G. 578.

That where a county is a municipal corporation, it is liable for infringements by contractors, see May *v.* Mercer Co. (1887), 41 O. G. 815; 30 Fed. Rep. 246.

That a State cannot exempt counties from liability for infringement, see May *v.* County of Rolls (1887), 31 Fed. Rep. 473; 40 O. G. 575.

That a board of county commissioners in Ohio is not a corporation and has no other liability than that imposed by statute, and can neither commit a wrong nor be liable for one, see Jacobs *v.* Board of Commissioners of Hamilton Co. (1862) 4 Fisher, 81; 1 Bond, 500.

Contra, May *v.* County of Logan (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

[5] That a contractor working for a body which cannot be liable for infringement is himself liable and cannot justify under his contract, though ignorant that he did infringe, see Jacobs *v.* Board of Commissioners of Hamilton Co. (1862), 4 Fisher, 81; 1 Bond, 500.

§ 912. [1] In Poppenhusen *v.* New York Gutta-Percha Comb Co. (1858), 2 Fisher, 62, Ingersoll, J.: (72) "A corporation can act only by their agents. It can act only by those who are in their employ. And when one in the employ of a corporation, in the business of his employment, does an act for their benefit, and which they adopt and approve and take advantage of, they will be deemed to have authorized

its stockholders constitute another corporation organized under the jurisdiction of a different State, and carrying on its business with their own employees and machinery, — the corporation whose affairs are thus conducted is still the actual infringer and is answerable therefor.[2] How far the officers, stockholders, and employees of a private corporation participate in its infringing acts and thereby share its liability is still an open question. That they may be enjoined whenever this is necessary to protect the patentee against future infringements is universally conceded;[3] but whether they can

the act, and will be as much bound by it as though expressly authorized. You are here to determine, gentlemen, whether these articles, manufactured by their agent, he being in the employment of the corporation, whether he did it in the business or employment of the corporation, whether it was for their benefit, and if they adopted and approved of it, by selling it in the market, and thereby took advantage of it, they will be deemed to have authorized the act, and will be bound by it." See also Jacobs *v.* Commissioners of Hamilton Co. (1862), 4 Fisher, 81; 1 Bond, 500.

That a corporation infringes by procuring the patented devices and permitting its employees to use them, see Ransom *v.* Mayor of New York (1856), 1 Fisher, 252.

That where the contractor is hired to work for the corporation and to use the infringing device, the hirer is probably liable, see Lightner *v.* Brooks (1864), 2 Clifford, 287.

That corporations cannot escape their liability by any disguise, see York & Maryland Line R. R. Co. *v.* Winans (1854), 17 How. 30.

[2] That where a railroad company was organized in one State, and all its stock was owned by a railroad company in another State, the latter company operating the road with its own agents and cars, the former company infringes by the use of a patented device on such cars, see York & Maryland Line R. R. Co. *v.* Winans (1854), 17 How. 30.

[3] In Goodyear *v.* Phelps (1853), 3 Blatch. 91, Nelson, J.: (91) "A point has been made, that the defendants are not liable for the infringement charged, as the only participation alleged in the same is as stockholders of an incorporated company, which company is engaged in manufacturing and selling the patented article. However that may be, it appears that the defendants are either directors of the company, who have the management and superintendence of the business, and under whose direction the articles are manufactured and sold, or are the agents of the same, concerned in conducting the business. On this ground, I am of opinion that they are responsible, and are properly made parties defendants." This was a bill for an injunction; the question of liability for damages not being raised.

That officers of an alleged infringing corporation may be joined with the corporation as defendants in an application for an injunction, see Consolidated Safety Valve Co. *v.* Ashton Valve Co. (1886), 26 Fed. Rep. 319.

That the officers of an infringing corporation may be enjoined, even if not liable for damages, see United Nickel Co. *v.* Worthington (1882), 23 O. G. 939; 13 Fed. Rep. 392.

That the managing officers of an in-

be held in damages for past infringements has been variously decided. One opinion, following the doctrine of limited liability as usually applied to private corporate bodies, regards the infringing act as the act of the corporation alone, and declares that none of its members or officials legally participate therein.[4] Another, affirming the rule that every vol-

fringing corporation may be made co-defendants and individually enjoined, see Iowa Barb Steel Wire Co. *v.* Southern Barbed Wire Co. (1887), 30 Fed. Rep. 123 ; 40 O. G. 577.

That an officer of a corporation acting on its behalf in renting infringing machines to users is a proper party defendant with such users, in a bill for an injunction, see Nichols *v.* Pearce (1869), 7 Blatch. 5.

[4] In United Nickel Co. *v.* Worthington (1882), 13 Fed. Rep. 392, Lowell, J. : (393) "The question, then, is whether the directors, stockholders, and workmen of the corporation are liable. It has been held that a mere workman who makes a patented article is not an infringer. Delano *v.* Scott, Gilp. 489 ; Heaton *v.* Quintard, 7 Blatch. 73. The reason given by Hopkinson, J., in the first of these cases goes far to decide the present. He says that the statute does not mean to class mere agents, servants, etc., as makers and venders of the patented improvement, but the principals, for whose account and benefit they act. It was conceded, but without being decided, in Lightner *v.* Brooks, 2 Clifford, 287, and in Lightner *v.* Kimball, 1 Low. 211, that a director who has acted affirmatively, so to speak, and ordered an infringement by the corporation, would subject himself to an action. But, upon further examination, I think the law is not so. Infringement is not a trespass. The form of action is case ; and this is because the act done is not of itself a direct interference with the tangible property of the plaintiff, but an indirect interference with his paramount right. It is like the building of a house upon a man's own land, which shuts out a light which his neighbor has a prescriptive right to enjoy. The person who is to pay damages for a disturbance is not every one who has had anything to do with the building, but he who owns it. It would be a great hardship if the directors of a railway or manufacturing corporation were bound, at their personal peril, to find out that every machine which the company uses is free of all claim of monopoly. No case precisely in point has been cited ; but the practice certainly is to ask for damages only against the corporation. Joinder in equity for purposes of discovery and injunction is another matter ; but I have not known damages to be asked for against the directors of a corporation, excepting in one case, which did not come to trial, but was discontinued as to the directors. I am of opinion that the only persons, who can be held for damages are those who should have taken a license, and that they are those who own or have some interest in the business of making, using, or selling the thing which is an infringement ; and that an action at law cannot be maintained against the directors, shareholders, or workmen of a corporation which infringes a patented improvement." 23 O. G. 939 (939).

That where a railroad company contracted for cars on which a patented invention was to be put, and the contract was signed by its president, who did not contemplate any infringement of the patent, he is not liable as an in-

untary perpetrator of a wrongful act of manufacture, use, or sale is an infringer, considers its directors, agents, and other servants, actually employing or authorizing the employment of the patented invention, as guilty of the infringement and personally answerable to the patentee.[5] A third, viewing the acceptance of the benefit of the infringing act as furnishing the test of liability, treats its stockholders as infringers, whether or not they are its officers or agents, and exempts the latter unless they are also members of the corporation.[6] The first opinion is scarcely consistent with a due regard to the rights of the patentee, whose invention might then be practised with impunity by an insolvent corporation, nor with the general tenor of the Patent Laws, which permit no voluntary and unauthorized act of manufacture, use, or sale, direct or indirect, to pass unpunished. The third confuses the benefit derived by the stockholders with that accruing to the corporation, — the benefit of the former being no more closely related to the infringement than that of creditors or

fringer, see Lightner *v.* Brooks (1864), 2 Clifford, 287.

That a liability for infringement is not a "debt" for which the officers of a corporation may be liable because it was improperly contracted, see Child *v.* Boston & Fairhaven Iron Works (1884), 137 Mass. 516.

[5] That all who join in an infringement are liable for damages as defendants though some are mere officers of corporations, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

That the president of a defendant corporation named as one of the defendants, but not personally served, who owns all the stock and swears to and signs the answer, and enters a general appearance without naming the other defendants, is personally liable for the infringement, see Smith *v.* Standard Laundry Mach. Co. (1883), 19 Fed. Rep. 826; 25 O. G. 393; 21 Blatch. 184.

[6] In Tyler *v.* Galloway (1882), 22 O. G. 1294, Blatchford, J.: (1294) "It is shown that the infringing cheese-hoop was owned by the association, and was used by its agents in making cheese in its business at its works for the benefit of its stockholders. Galloway, Durfee, and Billings were shareholders. The use aforesaid was a use by each of them quite as much as if there had been a co-partnership without shares of stock, or one with shares belonging to less than seven shareholders in number. The use by each was a tort, and each is liable to be enjoined." 13 Fed. Rep. 477 (478); 21 Blatch. 66 (67).

That the stockholders of an infringing incorporation may be held individually as infringers, see St. Louis Stamping Co. *v.* Quinby (1880), 18 O. G. 571; 5 Bann. & A. 275.

That a secretary of an infringing corporation is not liable unless he is also a stockholder, see Tyler *v.* Galloway (1882), 13 Fed. Rep. 477; 22 O. G. 1294; 21 Blatch. 66.

innocent employees, or that of dealers in or users of the products of infringing processes; and is pregnant with evil and unjust consequences to all members of private corporations, especially to minorities who neither acquiesce in the infringement nor in the appointment of the officers or agents by whom it is committed. The second is in harmony with other doctrines of the law, sufficiently protects the patentee, and justly punishes those whose wilful acts place them on the same footing with individual infringers. Under this opinion, all agents who perform acts of infringement, and all stockholders, directors, and other officers who in the prosecution of the business of the corporation authorize them, participate in the infringement and are personally responsible to the patentee.

§ 913. Infringement by a Joint-Owner of the Patent.

One of two or more co-owners of a patented invention may be guilty of infringement as against the others. The field of such infringement is of course comparatively narrow, since in the present condition of our law his right to profit by the patented invention is unlimited. While he restricts himself to the manufacture, use, or sale of this invention he does not, therefore, incur any liability to his co-owners. But his employment of other arts or articles, embracing the substance of the patented invention, and yet possessing different or additional features whereby he gains an advantage over his co-owners, is prohibited. The practice of such inventions by non-owners of the patent would be an infringement equally with that of the precise and separate invention which the patent claims, but would often strike more deeply at the interest of the patentee by driving his invention from the market through the superior utility of the infringing instrument or operation. If a co-owner were permitted to avail himself of these by virtue of his ownership of part of the patented invention, the property of the other owners might easily be rendered worthless; and hence the courts have held that his departure from the patented invention, as described and claimed in the patent, puts him in the same position as a non-owner, and renders him liable in the same manner to the other owners

for his infringing acts.[1] The measure of his liability, however, differs, since the infringement is committed not only against their interest in the patented invention but against his own also, and the injury inflicted and the compensation awarded is consequently apportioned to the other owners according to their respective shares.

§ 914. Infringement by Assignors, Grantors, and Grantees.

An assignment either transfers the entire interest of the assignor in a patented invention, or makes him a co-owner with the assignee. In the former case, the assignor becomes a stranger to the patent and capable of infringement by any act of unauthorized manufacture, use, or sale.[1] In the latter case, he is liable to the same extent and for the same acts as an ordinary co-owner, and has the same right to protection against his assignee. A grantor is a stranger to the patent within the territory exclusively conveyed to his grantee, while

§ 913. [1] In Herring *v.* Gas Consumers' Association (1878), 9 Fed. Rep. 556, Treat, J.: (557) "Can a part-owner infringe the common patent and escape all liability? If he can, it is obvious that, however small his aliquot part, he can make the enjoyment of the patent valueless to his joint-owner. He has, by virtue of the joint-ownership, a right to use the patent, but he has no right more than a stranger to infringe the same. If there is an infringement, the right of recovery is in the party wronged. All the joint-owners should ordinarily be parties plaintiff; but if the wrong-doer is one who is guilty to the damage of the other joint-owner, the latter should not be left remediless. As to such infringement they are strangers. All the joint-owners are on the record, and the amount of the recovery determines their respective interests. The infringer cannot escape the consequences of his wrong to his joint-owner by averring that he was by his infringement injuring not his joint-owner alone, but himself also. In other words, he cannot, under cover of his interest in the common patent, shield every wrong-doer who may infringe that patent. He can, as to the other part-owners, by infringing, become liable to them for the wrong done. The amount of recovery will be in proportion to their respective interests. Were this not so, the door would be open to the grossest frauds by one joint-owner against all other joint-owners." 13 O. G. 637 (637); 3 McCrary, 206 (206); 3 Bann. & A. 253 (254).

That an owner infringes if he uses or sells as to the right of his co-owner, see Pitts *v.* Hall (1854), 3 Blatch. 201.

That one co-owner cannot sue his co-owner for infringement by using the patented invention, see Aspinwall Mfg. Co. *v.* Gill (1887) 32 Fed. Rep. 697.

§ 914. [1] That an assignor may become liable to his assignee for an infringement, see Onderdonk *v.* Fanning (1880), 4 Fed. Rep. 148; 5 Bann. & A. 85.

the grantee is a stranger outside the limits of such territory; and each may thus invade the other's rights by any of the usual methods of infringement.[2] When the effect of the grant is to make them territorial co-owners, their liabilities to each other for acts performed within such territory are the same as those of other co-owners of a patent.

§ 915. Infringement by Licensees.

A license transfers an interest in the invention and estops the licensor from interfering with the enjoyment of such interest by asserting his monopoly against the licensee. If the license is an express license, the rights of the licensee and the estoppel against the licensor are defined by its specific terms. If the license is implied, the duties and obligations of the parties are defined by law.[1] No license can convey an interest in the invention or work an estoppel unless the licensor was an owner of the patent at the time the license was granted. While acting under his license, and within the scope of the interest it confers, the licensee does not infringe the patent, and on a failure to perform his own part of the agreement is liable only to an action on the contract in the local courts.[2] If the license is granted on conditions, it affords no protection to the licensee unless the conditions are fulfilled, though late authorities declare that it must be rescinded by agreement, or by a decree in equity, before an action for infringement by

[2] That a grantor reserving the right to use is not guilty of infringement by such use, see Hobbie *v.* Smith (1886), 27 Fed. Rep. 656.

That a grantee infringes by making outside his territory for use outside it, see American Paper Barrel Co. *v.* Laraway (1886), 37 O. G. 674; 28 Fed. Rep. 141.

That a sale of patented articles in the ordinary course of business beyond the territory of the grantee by his vendee is an infringement, see Hatch *v.* Adams (1884), 29 O. G. 776; 22 Fed. Rep. 434.

§ 915. [1] As to the nature of a license and the reciprocal rights and duties of licensors and licensees, see §§ 806–834 and notes, *ante*, and §§ 979, 1044, 1243–1252, and notes, *post*.

That the scope of an implied license to make and sell is fixed by the circumstances out of which the license arises, see Montross *v.* Mabie (1887), 30 Fed. Rep. 234; 41 O. G. 931.

[2] That a party acting under a license is not an infringer, and is only liable for fees, not in United States courts for infringement, see Kelly *v.* Porter (1883), 17 Fed. Rep. 519; 8 Sawyer, 482.

acts done under color of the license can be maintained.[3] A licensee repudiating the license, or abandoning it, or claiming his right against the licensor on other grounds, forfeits the privilege which it confers and can no longer set up its estoppel against the licensor.[4] Notwithstanding the existence of a license, therefore, the apparent licensee will be in reality a stranger to the patent, and will be guilty of infringement by any act of manufacture, use, or sale, if the license were originally invalid, or through his default never took effect, or being once effective has now ceased to operate.

§ 916. Infringement by a Licensee under an Express License.

A licensee, having an express license, infringes by the practice of any other patented invention than the one covered by his license, or by employing that in any other manner than

[3] That licensees under conditions infringe unless they fulfil the conditions, see Steam Cutter Co. *v.* Sheldon (1872), 5 Fisher, 477; 10 Blatch. 1.

That the use of the licensed invention beyond the limits of the license and against the reserved rights of the licensor is an infringement, see Chambers *v.* Smith (1870), 5 Fisher, 12.

That where a licensee had the option to use during the extension upon paying new fees, he will be an infringer if he uses without first exercising his option and paying the new fees, see England *v.* Thompson (1869), 3 Clifford, 271.

That a licensee may be sued for an infringement if his license were rescinded by a notice to that effect given in the mode prescribed by the license itself, see Hammacher *v.* Wilson (1886), 26 Fed. Rep. 239; 36 O. G. 233.

That a licensor cannot sue his licensee for infringement upon a failure to pay royalties unless the license contains a clause of forfeiture, see Consolidated Middlings Purifier Co. *v.* Wolf (1886), 28 Fed. Rep. 814; 37 O. G. 567.

That though it is agreed in a license that it is to be void in a certain event, and that the licensee may then be treated as an infringer, the license must be annulled by a separate proceeding in equity before a suit for infringement can be brought, see Adams *v.* Meyrose (1881), 7 Fed. Rep. 208; 2 McCrary, 360.

[4] That a licensee abandoning his license, or defending on other grounds, forfeits its protection, see Bell *v.* McCullough (1858), 1 Fisher, 380; 1 Bond, 194.

That a licensee having repudiated his license may be treated as an infringer, and his license will be no defence, see Hat Sweat Mfg. Co. *v.* Porter (1888), 34 Fed. Rep. 745; Cohn *v.* National Rubber Co. (1878), 3 Bann. & A. 568; 15 O. G. 829; Moody *v.* Tabor (1874), 5 O. G. 273; Holmes, 325; 1 Bann. & A. 41.

That a licensee making the licensor's invention under a different name, must pay the agreed license fees, and if he repudiates the license may be sued as an infringer, see Starling *v.* St. Paul Plough Works (1887), 41 O. G. 818; 32 Fed. Rep. 290.

his license specifies.[1] If he appropriates a different invention belonging to his licensor, whether protected by the same or by a different patent, and not essential to the enjoyment of the licensed invention;[2] or if he makes, or sells, or uses inventions of his own or of some other patentee which in themselves are infringements of the one that he is licensed to employ;[3] or if he performs an act in reference to the licensed invention which his license does not authorize, as by selling or using under a license to manufacture only;[4] or if he per-

§ 916. [1] That a licensee acting outside his license is an infringer, see Fetter *v.* Newhall (1883), 17 Fed. Rep. 841; 25 O. G. 502; 21 Blatch. 445; Wood *v.* Wells (1873), 6 Fisher, 382; Goodyear *v.* Providence Rubber Co. (1864), 2 Clifford, 351; 2 Fisher, 499.

That a licensee merely refusing to pay his royalties cannot be treated as an infringer, see Seibert Cylinder Oil-Cup Co. *v.* Detroit Lubricator Co. (1888), 34 Fed. Rep. 216.

That a licensee violating the terms of his license by doing acts not authorized thereby, at once infringes the patent and breaks his contract, see Pope Mfg. Co. *v.* Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That a licensee infringes if he exceeds the number of patented articles covered by his license, see Aspinwall Mfg. Co. *v.* Gill (1887), 32 Fed. Rep. 697.

That the covenants in a license cannot deprive the licensee of the right to show that his acts do not infringe, see White *v.* Lee (1882), 23 O. G. 1621; 14 Fed. Rep. 789.

[2] That a license under one patent affords no protection against another, see Stuart *v.* Shantz (1872), 6 Fisher, 35; 2 O. G. 524; Blanchard *v.* Puttnam (1869), 8 Wall. 420.

That a plaintiff may recover for the infringement of one Claim of a patent though the defendant is licensed under other Claims, and though his infringement is accomplished by using the licensed inventions, see United Nickel Co. *v.* California Electrical Works (1885), 11 Sawyer, 250; 25 Fed. Rep. 475.

That the license to make an article described in the patent does not protect the licensee if he makes one different from the one described, see Miller's Falls Co. *v.* Ives (1877), 14 O. G. 203; 14 Blatch. 169; 2 Bann. & A. 574; Magic Ruffle Co. *v.* Elm City Co. (1875), 8 O. G. 773; 13 Blatch. 151; 2 Bann. & A. 152.

That a licensee authorized to sell materials, to be used in a patented process, to the licensees of such process, infringes by selling to others who are known not to be licensees, see Willis *v.* McCullen (1886), 29 Fed. Rep. 641; 33 O. G. 1017.

[3] That if the licensee practices his own infringing invention under cover of the license, he is an infringer, see Miller's Falls Co. *v.* Ives (1877), 14 O. G. 203; 14 Blatch. 169; 2 Bann. & A. 574.

That under a license to use six or more of the patented machines upon certain conditions, the licensee using one under the patent and five under an infringing patent infringes as to the five, see Steam Cutter Co. *v.* Sheldon (1872), 5 Fisher, 477; 10 Blatch. 1.

[4] That a license to use does not give the right to make or sell, see Aiken *v.* Manchester Print Works (1865), 2 Clifford, 435. See also §§ 812, 827, and notes, *ante*.

forms the licensed act outside the territory or the period for which his license has been granted;[5] or in any other way exceeds the power conferred upon him, — he is guilty of infringement.[6] Where a license is assignable, the assignee rests under the same limitations as the original licensee, and may infringe the patent by the same modes of action.[7] A licensee may infringe not only by his own personal misappropriation of the patented invention, but through the agency of any others who unlawfully practise it with his consent.[8]

[5] That where a license permits use in only one place it is an infringement to use elsewhere, see Steam Cutter Co. *v.* Sheldon (1872), 5 Fisher, 477; 10 Blatch. 1.

That a licensee, having a right to sell the product of the patented device only in the section where made, infringes by selling outside it, see Wilson *v.* Sherman (1850), 1 Blatch. 536.

That a licensee to sell within certain territory infringes if he sells in that territory to those who he knows will sell outside it, see Hatch *v.* Hall (1887), 30 Fed. Rep. 613; 40 O. G. 1342.

That a licensee practising the invention after his license has expired is an infringer, see Wetherill *v.* Passaic Zinc Co. (1872), 9 Phila. 385; 6 Fisher, 50; 2 O. G. 471.

That the use of two machines in succession under a license to use one is an infringement, see Bloomer *v.* Gilpin (1859), 4 Fisher, 50.

[6] That it is not an infringement to use a second time an article marked, "Licensed to use once only," see American Cotton Tie Co. *v.* Simmons (1878), 13 O. G. 967; 3 Bann. & A. 320.

Contra, American Cotton Tie Co. *v.* Simmons (1882), 106 U. S. 89; 22 O. G. 1976; American Cotton Tie Supply Co. *v.* Bullard (1879), 17 O. G. 389; 17 Blatch. 160; 4 Bann. & A. 520.

[7] That where a license is assignable, the assignee is not an infringer, see Wilson *v.* Stolly (1849), 5 McLean, 1.

That a railroad company being licensed to use a device on their cars, the transfer of their rolling stock and revenues to a preferred creditor gives him the same right, he being the agent of the company and not a purchaser, and his use is not an infringement, see Emigh *v.* Chamberlain (1861), 2 Fisher, 192; 1 Bissell, 367.

That an assignee of a license is under the same restrictions and subject to the same liabilities as the original licensee, see Moody *v.* Taber (1874), Holmes, 325; 1 Bann.& A. 41; 5 O. G. 273.

That under a personal and unassignable license to make and sell, the articles on hand at the death of the licensee may be sold by his representatives, see Montross *v.* Mabie (1887), 30 Fed. Rep. 234; 41 O. G. 931.

That an optional contract to purchase a patent does not operate as a license to the vendee's licensees to make infringing articles, see Iowa Barb Steel Wire Co. *v.* Southern Barbed Wire Co. (1887), 30 Fed. Rep. 615; 40 O. G. 578.

[8] That a licensee infringes by an unlawful use of his machine by others with his consent, see Steam Cutter Co. *v.* Sheldon (1872), 5 Fisher 477; 10 Blatch. 1.

§ 917. Infringement by a Licensee under an Implied License.

A license is implied by law in various cases, its scope being determined by the nature of the circumstances from which it arose. A patentee who acquiesces in the practice of his invention by another person, receiving compensation or the promise of compensation therefor, or looking to a different source for his reward, cannot thereafter deny the right of such other person to practise the invention in the manner and to the extent established by this actual enjoyment.[1] The law here implies a license whose limits are indicated by the past conduct of the licensee as acquiesced in by the licensor, and in these cases acts outside such customary employment of the invention are infringements.[2] Again, a person who, before the patent has been issued, or before the grant of a re-issue or extension, has constructed the patented article for his own use with the permission of the patentee, acquires the right to use such article until it ceases to exist;[3] though to replace

§ 917. [1] That a long use, with the acquiescence of the patentee and an agreement to pay license fees, raises an implied license, see Blanchard *v.* Sprague (1859), 1 Clifford, 288.

That a patentee by taking compensation for the right to make, use, or sell the invention, impliedly licenses these acts and cannot enjoin them, see Gilbert & Barker Mfg. Co. *v.* Bussing (1875), 8 O. G. 144; 12 Blatch. 426; 1 Bann. & A. 621.

That where a patentee gave permission to the contractors for a city to use an invention, saying to them that he would look to the city for his royalty, the city received an implied license and was not liable for any royalty, see Bigelow *v.* City of Louisville (1869), 3 Fisher, 602.

That an absolute release *in presenti* to an infringer, and a contract by him to pay royalties for past infringements in pursuance of such release, relieves him from accountability for practising the invention in future, except as to the royalties, until the release is set aside, see Seibert Cylinder Oil-Cup Co. *v.* Detroit Lubricator Co. (1888), 34 Fed. Rep. 216; Loercher *v.* Crandall (1881), 11 Fed. Rep. 872; 21 O. G. 863; 20 Blatch. 106.

[2] A license by acquiescence in the practice of an invention rests either in implied contract or in estoppel. That in both cases the limits of the license are determined by the conduct of the parties, under the ordinary principles governing estoppels and implied agreements, and any use of the invention beyond these limits has the same legal aspect as an infringing use by an express licensee, see Montross *v.* Mabie (1887), 30 Fed. Rep. 234; 41 O. G. 931; also § 834 and notes, *ante*.

[3] That a person who with the consent of the inventor has constructed the invention before the patent issued, may use it after the patent is granted, see Sec. 4899, Rev. Stat.; Wade *v.* Metcalf (1889), 129 U. S. 202; Brickill *v.* Mayor of New York (1880), 18 O. G.

it with another, or to make such repairs upon it as practically amount to reconstruction, is infringement.[4] Again, an employee by applying his invention to the business of his employers and annexing it to their apparatus, or otherwise incorporating it into their property, confers on them a license to enjoy it which neither he nor his subsequent assignees can revoke.[5] This license gives to the employers a right to use

463; 7 Fed. Rep. 479; 18 Blatch. 273; 5 Bann. & A. 544; also § 831 and notes, *ante*, and §§ 979, 1044 and notes, *post*.

That a person who has constructed the invention under a defective patent with the consent of the inventor, may employ it after a re-issue, see §§ 698, 699, 831 and notes, *ante*.

That a person who has constructed the invention during the original term, by consent of the inventor, may use it during an extension, see Wooster *v.* Sidenberg (1875), 10 O. G. 244; 13 Blatch. 88; 2 Bann. & A. 91; Wood *v.* Michigan Southern & Northern Indiana R. R. Co. (1868), 3 Fisher, 464; 2 Bissell, 62.

See also § 831, 843 and notes, *ante*.

That where a patentee had publicly authorized all persons to use his invention, in connection with certain others, one who did this under the original term may use up, during the extension, whatever he had on hand at the end of the term, see Wooster *v.* Sidenberg (1875), 13 Blatch. 88; 2 Bann. & A. 91; 10 O. G. 244.

That the use of the patented invention with impunity, before the patent was amended, does not work a license to use it, see Howe *v.* Williams (1863), 2 Fisher, 395; 2 Clifford, 245.

That an unauthorized use under a defective patent confers no license to use under an amended one, see McWilliams Mfg. Co. *v.* Blundell (1882), 11 Fed. Rep. 419; 22 O. G. 177; Stimpson *v.* Westchester R. R. Co. (1846), 4 How. 380; 2 Robb. 335.

[4] That under Sec. 7, act of 1839, and the act of 1870, the license is to use only the precise thing after patent which was made or purchased before it, and to make and use others is infringement, see Brickill *v.* Mayor of New York (1880), 18 O. G. 463; 7 Fed. Rep. 479; 18 Blatch. 273; 5 Bann. & A. 544.

That the act of 1839, protecting the use of inventions which were used before the patent, does not cover the whole patented invention, but only such parts of it as were in use, see Brickill *v.* Mayor of New York (1880), 7 Fed. Rep. 479; 18 Blatch. 273; 18 O. G. 463; 5 Bann. & A. 544.

That though an assignee of the original term may use the articles constructed during the term after the extension, he has no implied license to make them for any purpose, see Wood *v.* Michigan Southern & Northern Indiana R. R. Co. (1868), 3 Fisher, 464; 2 Bissell, 62.

[5] That an employer has an implied license to use such inventions of his employee as were by the latter applied to the business of the former during the term of employment, see Herman *v.* Herman (1886) 37 O. G. 892; 29 Fed. Rep. 92; Whiting *v.* Graves (1878) 13 O. G. 455; 3 Bann. & A. 222; Continental Windmill Co. *v.* Empire Windmill Co. (1871), 8 Blatch. 295; 4 Fisher 428.

See also §§ 832, 833 and notes, *ante*.

That where a partner patents a design and applies it to articles made in the business of the firm, the firm may use the design until the partnership is dissolved, and after dissolution may sell by receiver or otherwise the articles on

the invention in the manner in which their employee, the inventor, has applied it, and until it is no longer capable of use. But to rebuild it, or supply its place with others of the same character, or to appropriate it to different uses, are acts beyond their implied authority and are infringements of the patent. Finally, the purchaser of a patented article from one who had a right to sell it, or who, having sold it wrongfully, has compensated the owner of the patent for the injury inflicted by the wrongful sale, has an implied license to use it for any purpose and in any place until it is destroyed, unless the terms of his purchase have otherwise provided.[6] But such a licensee cannot reconstruct the article, nor procure and use a new one in its stead, nor, if the purchase be restricted by conditions, use it in violation of his contract, without committing an infringement.[7] These are the principal cases in which a license is implied, and the tests of infringement em-

hand containing such design, see Montross *v.* Mabie (1887) 30 Fed. Rep. 234; 41 O. G. 931.

[6] That the purchaser of a patented material without restrictions, from one who had a right to sell it, may use it for any purpose, see Metropolitan Washing Mach. Co. *v.* Earle (1861), 2 Fisher, 203; 3 Wall. Jr. 320.

See also §§ 824, 826 and notes, *ante.*

That such purchaser may use the article in any place, see Roosevelt *v.* Western Electric Co. (1884), 20 Fed. Rep. 724; 28 O. G. 812.

That a purchaser of articles with knowledge of prior grants cannot use the articles within the granted territory, see Sheldon Axle Co. *v.* Standard Axle Works (1889), 37 Fed. Rep. 789.

That a purchaser of articles cannot sell them in the way of trade in another's exclusive territory, see Standard Folding Bed Co. *v.* Keeler (1889), 37 Fed. Rep. 693.

See also §§ 824, 826 and notes, *ante.*

That a purchaser from an infringing seller acquires no license to use, see Gilbert & Barker Mfg. Co. *v.* Bussing (1875), 8 O. G. 144; 12 Blatch. 426; 1 Bann. & A. 621.

See also §§ 824–830 and notes, *ante.*

That a purchaser from a licensee, who has previously repudiated his license, acquires no right to use if he knew of such repudiation, see Moody *v.* Taber (1874), 1 Bann. & A. 41; Holmes, 325; 5 O. G. 273.

That a purchaser from a wrongful seller, who has compensated the owner of the patent for the wrongful sale, has an implied license to use, see Steam Stone Cutter Co. *v.* Sheldon (1884), 22 Blatch. 484; 21 Fed. Rep. 875; Allis *v.* Stowell (1883), 16 Fed. Rep. 783; Gilbert & Barker Mfg. Co. *v.* Bussing (1875), 8 O. G. 144; 12 Blatch. 426; 1 Bann. & A. 621; Eunson *v.* Dodge (1873), 18 Wall. 414; 5 O. G. 95.

See also §§ 829, 830 and notes, *ante.*

That a vendee, under an unlawful but subsequently legalized sale, may himself resell, see Alabastine Co. *v.* Richardson (1886), 26 Fed. Rep. 620; 35 O. G. 1225.

[7] That his implied license to use gives the purchaser no right to rebuild,

ployed in these will furnish a sufficient guide for cases of less frequent occurrence.

§ 918. Infringement by Common Carriers.

A common carrier may participate in the infringing acts of others by aiding in their perpetration or in securing their unwarranted reward.[1] Thus if he conspires with an infringing manufacturer of the invention to transport his products to a market though beyond the limits of the United States, or with

see Gottfried *v.* Philip Best Brewing Co. (1879), 17 O. G. 675; 5 Bann. & A. 4.

See also § 827 and notes, *ante*.

That the purchaser's license does not authorize him to replace the purchased articles with new ones, see Aiken *v.* Manchester Print Works (1865), 2 Clifford, 435.

See also § 825 and notes, *ante*.

§ 918. [1] In American Cotton Tie Supply Co. *v.* McCready (1879), 17 O. G. 565, Blatchford, J.: (567) "It is contended for the defendants that the steamship company, as it acts solely in the capacity of common carrier of these ties, does not come within the meaning of the statute as an infringer of the patents; that it has nothing to do with the rights of the plaintiff or the invasion of those rights by others; that it does not use or aid others in using the ties, because such use cannot be had until after transportation and delivery; that the company, by transporting the ties, does not sell them to others to be used, or aid in selling them to others to be used; that as a common carrier the company is bound to receive and carry all goods offered by any person; that it would be against public policy to restrain the company; that it would impede its business and inflict injury on the whole community; that the suit is improperly brought against the defendants, and should be brought against the company; that the defendants are only officers of the company, with distinct duties, and have no control over the goods and no power to refuse to receive them; that the company ought not to be compelled, at its own expense, to protect the plaintiff's business; and that it owes no duty to the plaintiff to answer for the diligence which the plaintiff ought to use in the protection of its own interests. It is entirely clear that the owners of the infringing and unlicensed cotton ties, who are causing them to be transported by the vessels of the Old Dominion Steamship Company, are sending them for sale and use, and are employing said company and its officers as agents and servants in promoting and effecting such sale and use. It would seem, on principle, that there ought to be no difficulty in restraining by injunction all persons, whether officers of a corporation or not, who are aiding in the promotion of the infringing sale and use, whether such persons would be liable for profits or damages or not. It has been so held by this court. (Goodyear *v.* Phelps, 3 Blatch. C. C. R. 91; Poppenhusen *v.* Falke, 4 Blatch. 493)." 17 Blatch. 291 (298); 4 Bann. & A. 588 (595).

That a steamship company transporting infringing articles, after due notice from the patentee, act as an agent of the infringer, and are liable to injunction unless they disclose the names of the shipper, see American Cotton Tie

persons who desire to use or sell the invention in violation of the patent to procure it and deliver it to them, he makes himself an agent in the wrong and is responsible as a direct infringer. Whether he is accountable for the injury resulting to the patentee from the infringing manufacture, use, or sale, and if so in what measure, is not yet determined, though he thereby subjects himself to the restraining process of a court of equity. But in these cases the assistance given must have been wilful and collusive; for service rendered in the ordinary course of business and without illegitimate intent is merely a fulfilment of his duty, and does not make him liable for wrongs committed through his means by shippers or consignees.

§ 919. Infringement by Contractors.

The obligations under which a private individual may rest, either to other individuals or to the public, do not authorize him to practise any patented invention without permission from the patentee, even though his obligations were created in ignorance of the existence of the patent.[1] A contractor, in

Supply Co. *v.* McCready (1879), 17 O. G. 565; 17 Blatch. 291; 4 Bann. & A. 588.

That importation and transshipment by custom-house agents of the importers, having no possession nor control of the infringing articles, does not make them liable for infringement, see Nobel's Explosives Co. *v.* Jones (1881), L. R. 17 Ch. D. 721; 8 App. Cas. 5.

§ 919. [1] In Jacobs *v.* Commissioners of Hamilton Co. (1862), 4 Fisher, 81, Leavitt, J.: (85) "There can be no question that if the *contractor*, in the fulfilment of his obligation, violates the patent-right of another, he is answerable for the infringement. He cannot defend himself against the claim of the patentee by asserting that he committed the wrong under a contract with the county commissioners. It was his own folly to have imposed on himself such an obligation, and he alone is responsible for the injury which another may sustain as the consequence. If he had foreknowledge that the work he had bound himself to perform involved an infringement of a patent-right, it was his business to have procured a license for the use of the improvement; and, failing to do so, he takes on himself the responsibility of a violation of the patent. If he entered into the contract in ignorance of the fact that the work he has agreed to do would violate a patent-right, he is not therefore protected from liability. This fact may have a bearing on the question of the amount of damages to be recovered, but does not destroy the right of action by the injured party. And it is no answer to this view of the subject that cases may occur in which the patentee may fail in the enforcement of his just rights by the insolvency or irresponsibility of the contractor. This is an incident,

entering into an agreement to perform certain services or supply certain articles, assumes the risk of being prevented from the fulfilment of his contract by the assertion of the rights of some unknown patentee; and if he violates those rights he cannot screen himself under the duty which he owes to others. Where the public are interested in the fulfilment of the contract the remedies applied may be less peremptory than where the individual contractor or his promisee are alone concerned, and the completion of the contract may be permitted, leaving the patentee to seek his compensation from the contractor after his contract obligations are discharged;[2] but this lenity is not extended on account of the contractor, who in some form of remedy is compelled to pay the full penalty of his infringement.

§ 920. Infringements by Agents, and Workmen.

Agents who, of their own volition, participate in an infringing act thereby become infringers, although in the performance of the act itself they have no pecuniary interest.[1] No act of a mere agent is infringement, unless it would be such if personally perpetrated by his principal.[2] But salesmen selling on commission, and other servants who derive a distinct and independent benefit from their invasions of the patent, incur a separate liability upon their own account, as well as in the capacity of employees.[3] A workman acting

often connected with cases of legal liability, which can have no influence upon the application of known and settled legal principles. Such a result may be a great misfortune to a losing party, but cannot furnish a reason for casting responsibility upon another party not legally chargeable with it." 1 Bond, 500 (504).

[2] That a contractor may be allowed to finish a work of importance to the pub , though enjoined as to all other uses of the invention, see § 1200 and notes, *post*.

§ 920. [1] That a sale by a salesman having no interest in the sale is an infringement, see Potter *v.* Crowell (1866), 3 Fisher, 112; 1 Abbott, 89.

That an accommodation partner, who takes no part in the business and allows his co-partner to receive all its benefits, is liable as joining in and inducing the infringement and may be sued alone or jointly with the active infringer, see American Bell Telephone Co. *v.* Albright (1887), 32 Fed. Rep. 287.

[2] That unless the parties who are primarily liable infringe, those who are secondarily liable do not, see Bigelow *v.* City of Louisville (1869), 3 Fisher, 602.

[3] In Steiger *v.* Heidelberger (1880), 4 Fed. Rep. 455, Blatchford, J.: (457)

under orders and exercising no choice as to the objects upon which his energies are expended does not infringe by manufacturing or using patented inventions.[4]

§ 921. Infringement by Private Individuals.

All private individuals who voluntarily engage in the unauthorized manufacture, use, or sale of the patented invention, whether by itself or as a part of some more comprehensive instrument or operation, are guilty of infringement.[1] Neither the motive prompting the infringing act, nor the knowledge of his own wrong-doing on the part of the offender, are elements to be considered.[2] Where a specific intent is necessary

"As to the first branch of the plea, or the first plea, whichever it may be, . . . the plea must be overruled. The substance of it is that the defendant is not liable in this suit for what the plea sets forth as having been done by him. This is not so. The plea shows that the defendant has made a separate and independent profit to himself out of the sale of such goods as he has been instrumental in selling, by receiving a commission thereon, in which commission Loeb & Schoenfeld have no interest; that his commission is dependent on the sales; that he has made the sales for the purpose of receiving the commission; and that he obtains the commission by making the sales. This is a distinct profit from any profits made by Loeb & Schoenfeld. The commission to this defendant would not be included in any profits to be accounted for by Loeb & Schoenfeld, and such commission is a direct profit to this defendant from the sale of the goods. Moreover, this defendant, although selling only under the circumstances set forth, is liable to be restrained in this court by an injunction from selling the infringing goods, and this suit is properly brought against him for that purpose. This court has obtained jurisdiction over his person. The plaintiff has a right to restrain the defendant, by injunction, from participating in the way set forth in such sales, although a bill will also lie against Loeb & Schoenfeld to restrain them from participating in the way they do in the same sales (Malthy *v.* Boto, 14 Blatch. 53)." 18 O. G. 1463 (1463); 18 Blatch. 426 (428).

[4] That workmen, having no option, do not infringe by obeying orders, see Young *v.* Foerster (1889), 37 Fed. Rep. 203; United Nickel Co. *v.* Worthington (1882), 23 O. G. 939; 13 Fed. Rep. 392; Heaton *v.* Quintard (1869), 7 Blatch. 73; Delano *v.* Scott (1834), Gilpin, 489; 1 Robb, 700.

That a son acting under his father cannot be sued for infringement if he has no interest in the business, see McDonald *v.* Whitney (1885), 24 Fed. Rep. 600; 32 O. G. 1465.

That a father may be liable for the infringements of a minor son in his employ, see Dunks *v.* Grey (1880), 3 Fed. Rep. 862; 5 Bann. & A. 634.

§ 921. [1] That the voluntary maker is an infringer though he is employed by another to do so, see Bryce *v.* Dorr (1845), 3 McLean, 582; 2 Robb, 302.

[2] That knowledge and intent are immaterial, see § 901 and notes, *ante*.

That ignorance of the patent does

to constitute the infringing act, it must of course be present, but otherwise the exterior action is alone regarded.[3] The injury to the patentee and not the moral guilt of the infringer is the basis and the measure of responsibility, and though the infringer were a lunatic the rights and remedies of the patentee would be the same.[4]

§ 922. Infringement of a Patent for a Combination.

In applying the foregoing propositions to the different classes of inventions, the fundamental distinction between combinations and simple inventions must be first considered. A combination is a group of instruments or operations united under a co-operative law. Its identity depends upon the presence in the combination of each one of these elements or its equivalent, and upon their co-operation in this specific manner to produce the ultimate result. Hence any change in the number of its elements, or in their essential character, or in their mode of co-operation, is a departure from the substance of the combination, and constitutes a different invention. A patented combination is the combination described and claimed in the patent which protects it. Of whatever elements it may actually be composed and whatever may be the method of their union as the inventor conceived and practises his invention, the elements specified in the patent, and the co-operative law there prescribed, are those which characterize the patented combination and form the subject of the exclusive privileges of the patentee.[1] The infringement of a combination-patent

not excuse, see Royer *v.* Coupe (1886), 29 Fed. Rep. 358 ; 39 O. G. 239.

[3] That a specific intent to infringe may qualify acts otherwise innocent, see § 901 and notes, *ante*, and § 924 and notes, *post*.

[4] That a lunatic may infringe and be liable for profits and costs, see Avery *v.* Wilson (1884), 20 Fed. Rep. 856.

§ 922. [1] That the patentee of a combination cannot aver that any one of its claimed elements is useless and may be dispensed with, see Rowell *v.* Lindsay (1881), 6 Fed. Rep. 290 ; 19 O. G. 1565 ; 10 Bissell, 217 ; Coolidge *v.* McCone (1874), 5 O. G. 458 ; 2 Sawyer, 571 ; 1 Bann. & A. 78 ; Westlake *v.* Cartter (1873), 6 Fisher, 519 ; 4 O. G. 636 ; Vance *v.* Campbell (1861), 1 Black, 427 ; and §§ 278, 282, 527, 670, and notes, *ante*.

That the courts cannot decide that any element in a combination is immaterial, but merely whether an omitted part is supplied by an equivalent, see Water Meter Co. *v.* Desper (1879), 101 U. S. 332.

That if an inventor regards an ele-

therefore, consists in the manufacture, use, or sale of any combination in which precisely the same elements or their equivalents are united under the same co-operative law.[2] To make or use or sell a combination in which the same elements are differently combined,[3] or a combination which comprises only a portion of those elements, though the discarded elements are practically useless, and though the combination thus created was suggested by the former, is not an infringement.[4]

ment as material, those who claim under him cannot assert that it is immaterial, see Le Fevor *v.* Remington (1882), 13 Fed. Rep. 86; 22 O. G. 1537; 21 Blatch. 80.

[2] That a combination is infringed when the same elements and plan of co-operation are employed, see Dederick *v.* Cassell (1881), 9 Fed. Rep. 306; 20 O. G. 1233; 14 Phila. 503.

That a combination is infringed if equivalents are used, see Dederick *v.* Whitman Agricultural Co. (1886), 36 O. G. 570; 26 Fed. Rep. 763; Wheeler *v.* Morris (1886), 36 O. G. 822; 26 Fed. Rep. 918; Reay *v.* Raynor (1884), 26 O. G. 1111; 22 Blatch. 13; 19 Fed. Rep. 308; Mundy *v.* Lidgerwood Mfg. Co. (1884), 20 Fed. Rep. 114; 27 O. G. 718; and § 254 and notes, *ante*.

That a combination is not infringed by a union of different mechanical devices accomplishing the same result, see Good *v.* Bailey (1887), 41 O. G. 935; 33 Fed. Rep. 42.

[3] That a different combination of the same elements is not an infringement, see Pattee *v.* Moline Plow Co. (1881), 9 Fed. Rep. 821; 22 O. G. 173; 10 Bissell, 377; Byam *v.* Eddy (1853), 2 Blatch. 521; 24 Vt. 666.

That a change of arrangement may be infringement, see Belle Patent Button Fastener Co. *v.* Lucas (1886), 37 O. G. 1004; 28 Fed. Rep. 371.

[4] In Rowell *v.* Lindsay (1881), 6 Fed. Rep. 290, Dyer, J.: (297) "It follows, therefore, from these statements of the law, that if the defendants omit entirely one of the elements of the complainants' combination without substituting any other, or if they substitute another which is new, or which performs a substantially different function, or if it is one that is old, but was not known at the date of the complainants' patent as a proper substitute for the omitted ingredient, or if their machine consists in a new combination of the same ingredients, then the defendants do not infringe." 19 O. G. 1565 (1567); 10 Bissell, 217 (225).

Further, that the use of less than all the elements of a combination does not infringe a patent for the combination alone, see Byerly *v.* Cleveland Linseed Oil Works (1887), 31 Fed. Rep. 73; Thoens *v.* Israel (1887), 31 Fed. Rep. 556; Newark Mach. Co. *v.* Hargett (1886), 36 O. G. 692; 28 Fed. Rep. 567; Newark Mach. Co. *v.* Gaar (1886), 37 O. G. 1250; 29 Fed. Rep. 322; Tobey Furniture Co. *v.* Colby (1885), 34 O. G. 1276; 26 Fed. Rep. 100; Rowell *v.* Lindsay (1885), 113 U. S. 97; 31 O. G. 120; Saladee *v.* Racine Wagon & Carriage Co. (1884), 20 Fed. Rep. 683; 27 O. G. 1133; Sharp *v.* Reissner (1883), 23 O. G. 1530; 15 Fed. Rep. 919; Doane & Wellington Mfg. Co. *v.* Smith (1882), 24 O. G. 302; 15 Fed. Rep. 459; Goss *v.* Cameron (1882), 14 Fed. Rep. 576; 11 Bissell, 389; 23 O. G. 741; Hammerschlag *v.* Garrett (1882), 21 O. G. 1199; 10 Fed. Rep. 479; Fuller *v.* Yentzer (1876), 94 U. S. 288; 11

To select the most available elements in two distinct patented combinations, and unite them in a third, does not invade the

O. G. 551 ; Sands *v.* Wardwell (1869), 3 Clifford, 277 ; Case *v.* Brown (1862), 2 Fisher, 268 ; 1 Bissell, 382 ; Singer *v.* Walmsley (1860), 1 Fisher, 558 ; Bynm *v.* Eddy (1853), 2 Blatch. 521 ; 24 Vt. 666 ; Foster *v.* Moore (1852), 1 Curtis, 279 ; Evans *v.* Eaton (1816), Peters C. C. 322 ; 1 Robb, 68 ; and other cases cited in § 282, note 1, *ante*.

That a combination is not infringed unless all its elements, as they are claimed, are used, whether they are essential or not, see Royer *v.* Schultz Belting Co. (1886), 38 O. G. 898 ; 28 Fed. Rep. 850.

That a combination is not infringed by the use of less than all its elements unless the elements used were new and patentable to the same inventor, see Thoens *v.* Israel (1887), 31 Fed. Rep. 556.

That a combination is not infringed if one of its elements is omitted where the omitted element performs a function of its own not discharged by the remaining elements, see Tobey Furniture Co. *v.* Colby (1885), 26 Fed. Rep. 100 ; 34 O. G. 1276.

That a patent for a combination of old elements is not infringed by using less than all the elements, where the two combinations are not the same in operation, see Faurot *v.* Hawes (1880), 3 Fed. Rep. 456.

That a Claim for a combination of three elements is not infringed by the use of two only, though the third is useless, for the patentee must stand by his Claim, see Coolidge *v.* McCone (1874), 5 O. G. 458 ; 2 Sawyer, 571 ; 1 Bann. & A. 78.

That it is no infringement to use less than all the elements of a combination, though nearly all the material parts of the alleged infringing device were suggested by the other, see Snow *v.* Lake Shore & Mich. Southern R. R. Co. (1883), 18 Fed. Rep. 602 ; 25

That a combination is not infringed where one essential element is omitted and another is substituted accomplishing the same result in a different way, see Schmidt *v.* Freese (1882), 21 O. G. 1876 ; 12 Fed. Rep. 563.

That a combination of old elements is not infringed by substituting a new element not known at the date of the patent, see Rowell *v.* Lindsay (1881), 6 Fed. Rep. 200 ; 19 O. G. 1565 ; 10 Bissell, 217 ; American Bell Telephone Co. *v.* Spencer (1881), 8 Fed. Rep. 509 ; 20 O. G. 299.

That the combination may be infringed though some of the elements now used were unknown at the date of the patent, see Potter *v.* Stewart (1881), 19 O. G. 997 ; 7 Fed. Rep. 215 ; 18 Blatch. 561. For an explanation of the principle on which this doctrine rests, see § 256, note 2, *ante*.

That the substitution of a new element in a combination makes it a different combination, not an infringement, see Babcock *v.* Judd (1883), 15 Fed. Rep. 160 ; Babcock *v.* Judd (1880), 1 Fed. Rep. 408 ; 17 O. G. 1351 ; 5 Bann. & A. 127. This can be true only where the old combination loses its identity by the substitution of the new element.

That a combination is not infringed by using certain of its elements in connection with others which are not equivalents for those omitted, see Archer *v.* Arnd (1887), 31 Fed. Rep. 475 ; 40 O. G. 1032.

That a combination is not infringed where the elements used by the defendant will not make the patented combination in a practical form, see Gray *v.* Bangs (1887), 40 O. G. 812 ; 31 Fed. Rep. 342.

That where a Claim covers several

rights of either patentee.[5] But where the patented combination is employed, either alone or with improvements or as an element in a new combination, the patent which protects it is infringed.[6] A useless combination, although patented in violation of the law, is not patentable subject-matter, and if appropriated by one who so improves or adds to it as to produce a useful combination, he may practise it or patent it as his own invention.[7]

§ 923. Infringement of a Patent for a Combination: Unauthorized Use of its Elements and Sub-combinations.

A patent claiming a combination only does not protect the elements of which it is composed.[1] If these are old, they are old parts and one new part, it is not infringed if the new part is not used, see Bragg *v.* Fitch (1887), 121 U. S. 478; 39 O. G. 829.

[5] That where two patents for combinations are both assigned to the same person, his rights are not infringed by a combination distinct from either, but containing elements of both, see Washburn & Moen Mfg. Co. *v.* Griesche (1883), 16 Fed. Rep. 669; 5 McCrary, 246.

That a patent for a combination and a process is not infringed by the use of part of each, see Howe *v.* Abbott (1842), 2 Story, 190; 2 Robb, 99.

That Claims for a method and a combination are not infringed by a different method and fewer elements, see Goss *v.* Cameron (1882), 23 O. G. 741; 14 Fed. Rep. 576; 11 Bissell, 389.

[6] That the use of a patented invention as an element in a new combination is an infringement, see Cleveland *v.* Towle (1869), 3 Fisher, 525.

That the use of a combination in a different machine from that in which it was first described is an infringement, see La Rue *v.* Western Electric Co. (1886), 28 Fed. Rep. 85; 36 O. G. 453.

That to use the entire patented combination is an infringement though some of its details may be improved, see White *v.* Heath (1882), 22 O. G. 500; 10 Fed. Rep. 291; Foster *v.* Moore (1852), 1 Curtis, 279.

That where an element in a combination is improved, and yet performs the same functions in the same way, the use of the combination is an infringement, see Potter *v.* Stewart (1881), 19 O. G. 997; 7 Fed. Rep. 215; 18 Blatch. 561.

[7] That to use a useless patented combination as part of a new one is not infringement, the old patent being invalid, see Bliss *v.* Brooklyn (1873), 3 O. G. 269; 6 Fisher, 289; 10 Blatch. 521.

That the addition to a combination of an element which alone makes it an operative combination, and the use of the whole so constituted, is not an infringement, see Robertson *v.* Hill (1873), 6 Fisher, 465; 4 O. G. 132.

As to various points concerning identity, equivalence, etc., in combinations, see §§ 156, 241, 242, 254, 256, 267, 268, 277–282, and notes, *ante*.

§ 923. [1] That a combination is not infringed unless used as an entirety, see Fuller *v.* Yentzer (1876), 94 U. S. 288; 11 O. G. 551.

already the property of the public; if they are new inventions of the patentee, his failure to claim them is a concession, so far as this patent is concerned, that they are old.[2] It has indeed been sometimes stated that a combination-patent covers such of its elements and sub-combinations as are original with the patentee, but this opinion is not consistent with the strictness of the rules which require the inventor to distinctly claim whatever the patent is intended to secure.[3] The rea-

[2] That unless claimed as new in the patent, the elements of a combination are regarded as old, see Rowell *v.* Lindsay (1881), 6 Fed. Rep. 290; 19 O. G. 1565; 10 Bissell, 217.

[3] In Lee *v.* Blandy (1800), 2 Fisher, 89, Leavitt, J.: (93) "There are two classes or kinds of combinations recognized by our Patent Laws, which are properly the subject of a patent. The first may be defined to be one in which all the parts were before known, and where the sole merit of the invention consists in such an arrangement of them as to produce a new and useful result; or where, by adopting parts of a machine which may have been known for ages, an inventor has succeeded in making such an arrangement of them as that they produce a result never before obtained, and have in that point of view the merit of originality, and are, therefore, patentable. There is another class of combinations, where some of the parts or elements of the combination are new, and their invention claimed, but where they are used in combination with parts or elements that were known before. It is well settled that a patent may be obtained for the first class of combinations, but it is a principle well recognized that there is no infringement unless the party has used all the elements. If the combination consists of A, B, C, — three mechanical structures long known, — and if the party sued has only the parts B, C, and not A, he is not regarded as an infringer; he must use all to subject himself to liability. If the combination have the other character to which I have referred, being, to a certain extent, new, but embracing some old parts or elements, then there is an infringement by the use of that part which is new and the invention of the patentee." 1 Bond, 361 (365).

In Moody *v.* Fiske (1820), 2 Mason, 112, Story, J.: (117) "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. 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 paten-

sonable and generally acknowledged doctrine recognizes that elements and sub-combinations, being inventions entirely distinct from the combination into which they enter, must be separately claimed in order to make their appropriation an infringement of the patent.[4]

tee 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. And yet if the combination itself be not wholly new, but up to a certain point has existed before and the patentee claims the whole combination as new instead of his own improvements only, as by taking out a patent for the whole machine, doubtless his patent is void, for it exceeds his invention. But 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." 1 Robb, 312 (317).

See also Thoens *v.* Israel (1887), 31 Fed. Rep. 556; Rowell *v.* Lindsay (1881), 6 Fed. Rep. 290; 19 O. G. 1565; 10 Bissell, 217; Holly *v.* Vergennes Mach. Co. (1880), 18 O. G. 1177; 4 Fed. Rep. 74; 18 Blatch. 327; Sharp *v.* Tifft (1880), 2 Fed. Rep. 697; 17 O. G. 1282; 18 Blatch. 132; 5 Bann. & A. 399; Adair *v.* Thayer (1880), 4 Fed. Rep. 441; 17 Blatch. 468; 5 Bann. & A. 118.

Although the foregoing cases are often referred to as authorities for the position that a patent for a combination embraces such new elements and sub-combinations as are due to the same inventor's creative acts, yet in some of them, if not in all, the Claims of the patent were actually construed to cover the subordinate parts as well as the entire combination, and thus made the patent one for the elements as well as for the combination. In that view these cases are really in harmony with the proper and generally accepted rule.

[4] In McCormick *v.* Manny (1855), 6 McLean, 539, McLean, J.: (547) "A patent which claims mechanical powers or things in combination, is not infringed by using a part of the combination. To this rule there is no exception."

In Barrett *v.* Hall (1818), 1 Mason, 447, Story, J.: (474) "In the next place, a patent may be for a new combination of machines to produce certain effects; and this, whether the machines constituting the combination be new or old. But in such case, the patent being for the combination only, it is no infringement of the patent to use any of the machines separately, if the whole combination be not used; for in such case the thing patented is not the separate machines, but the combination; and the statute gives no remedy, except for a violation of the thing patented. This was the doctrine of Mr. Justice Washington in his most able opinion in Evans *v.* Eaton; and it has not been in the slightest degree shaken in the Supreme Court. I hesitate not one moment in adopting it, as established on solid foundations. It has indeed

§ 924. Infringement of a Patent for a Combination: Unauthorized Use of Part of the Combination.

The acts by which a combination-patent is infringed thus involve the making, use, or sale of the complete combination. A combination is complete when all its elements, with their connecting parts, are finished ready to be united. But here, as elsewhere, the specific intent may supply in some degree the place of the exterior act. To make or sell a single element with the intent that it shall be united to the other elements, and so complete the combination, is infringement.[1]

been said, that where there is a patent for the whole of a machine, whoever imitates it, either in whole or in part, is subject to an action at the suit of the patentee. But supposing this doctrine to be true in any case and under any qualifications (which *may* well be doubted), it can apply only where the whole machine is entirely new, and cannot apply where the patent is limited, by its very terms, to the combination of several machines." 1 Robb, 207 (235).

In Evans *v.* Eaton (1816), Peters C. C. 322, Washington, J.: (346) "If the plaintiff is not the inventor of the parts, he has no right to complain that they are used, if not in a way to infringe his right to their combined use. If he is the original inventor of the different machines constituting the whole discovery, or any of them, he might have obtained a separate patent for those of which he was the original inventor; in which case, the objections stated would not have been in his way." 1 Robb, 68 (94).

See also §§ 527, 670–672, and notes, *ante*.

That a combination-patent containing a Claim for each element is infringed by the use of any one element alone, see Henderson *v.* Cleveland Co-operative Stove Co. (1877), 12 O. G. 4; 2 Bann. & A. 604.

§ 924. [1] In Saxe *v.* Hammond (1875), 7 O. G. 781, Shepley, J.: (782) "Different parties may all infringe by respectively making or selling, each of them, one of the elements of a patented combination, provided those separate elements are made for the purpose and with the intent of their being combined by a party having no right to combine them. But the mere manufacture of a separate element of a patented combination, unless such manufacture be proved to have been conducted for the purpose and with the intent of aiding infringement, is not, in and of itself, infringement." Holmes, 456 (459); 1 Bann. & A. 629 (632).

In Barnes *v.* Straus (1872), 2 O. G. 62, Blatchford, J.: (64) "The pair of springs of the patent — that is, the two springs connected by the clasps — constitutes, as a whole, a patentable combination. The two springs and the clasps connecting them are all required to make the article as a 'corset-spring' at all useful in performing the functions which it performs when the springs are actually combined by the clasps when the corset is worn. The combination does not have its full effects developed until it is in the corset. Yet it exists, *pro tanto*, so as to be an infringement, when the springs and clasps are made, ready to be inserted in a corset." 5 Fisher, 531 (536); 9 Blatch. 553 (558).

In Wallace *v.* Holmes, Booth, & Haydens (1871), 1 O. G. 117, Woodruff,

But to sell elements suitable for several different patented combinations does not make the vendor a partaker in the in-

J.: (122) "The rule of law invoked by the defendants is this: that where a patent is for a combination merely, it is not infringed by one who uses one or more of the parts, but not all, to produce the same results either by themselves or by the aid of other devices. This rule is well settled, and is not questioned in the trial. The rule is fully stated by Chief Justice Taney in Prouty et al. *v.* Ruggles et al., 16 Peters, 341, and in other cases cited by the counsel: Ryan *v.* Fearn, 1 Curtis, 265; Foster *v.* Moore, 1 Curtis, 292; Vance *v.* Campbell, 1 Black, 427; Godfrey *v.* Eames, 1 Wallace, 79. But I am not satisfied that this rule will protect the defendants. If, in actual concert with a third party, with a view to the actual production of the patented improvement in lamps, and the sale and use thereafter, they consented to manufacture the burner, and such other party to make the chimney, and in such concert they actually make and sell the burner, and he the chimney, each utterly useless without the other, and each intended to be used and actually sold to be used with the other, — it cannot be doubtful that they must be decreed to be joint infringers of the complainants' patent. It cannot be that when a useful machine is patented as a combination of parts, two or more can engage in its construction and sale, and protect themselves by showing that, though united in an effort to produce the same machine, sell, and bring it into extensive use, each makes and sells one part only which is useless without the other, and still another person, in precise conformity with the purpose in view, puts them together for use. If it were so, such patents would indeed be of little value. In such cases all are tort-feasors, engaged in a common purpose to infringe the patent, and actually, by their concerted action, producing that result. . . . Here the actual concert with others is a certain inference, from the nature of the case, and from the distinct efforts of the defendants to bring the burner in question into use, — which can only be done by adding the chimney. The defendants have not, perhaps, made an actual pre-arrangement with any particular person to supply the chimney to be added to the burner, but every sale they make is a proposal to the purchaser to do this, and his purchase is a consent with the defendants that he will do or cause it to be done. The defendants are therefore active parties to the whole infringement, consenting and acting to that end, manufacturing and selling for that purpose." 5 Fisher, 37 (46); 9 Blatch. 65 (75).

See also, Maynard *v.* Pawling (1880), 18 O. G. 244; 3 Fed. Rep. 711; 5 Bann. & A. 551; Richardson *v.* Noyes (1876), 10 O. G. 507; 2 Bann. & A. 398; Coolidge *v.* McCone (1874), 1 Bann. & A. 78; 2 Sawyer, 571; 5 O. G. 458; Renwick *v.* Pond (1872), 5 Fisher, 569; 2 O. G. 392; 10 Blatch. 39.

That to divide a device into two parts, and so sell it to be combined by the user, is an infringement, see Strobridge *v.* Lindsay (1881), 6 Fed. Rep. 510; 19 O. G. 1285.

That a sale of the materials of a patented combination with an intent that the purchaser should combine them is an infringement, see Bowker *v.* Dows (1878), 15 O. G. 510; 3 Bann. & A. 518.

That to make and sell part of a combination, with intent that it be used in connection with the other parts, is infringement, and such intent may be inferred when the part sold is appar-

fringement of any one of them in which it may eventually be used, unless he and the infringer were in concert with each other.[2]

§ 925. Infringement of a Patent for an Art.

An art is an invention distinct alike from the apparatus by which it is practised and the product in which it results, and hence, if patented, it can be infringed neither by making and selling the one nor by the sale and use of the other.[1] The infringement of a patented art consists only in the performance of all the acts of which it is composed or their equivalents, in the manner and in the order in which they are claimed in the patent.[3] If one of the steps claimed as essen-

ently capable of no other use, see McKay *v.* Jackman (1882), 12 Fed. Schneider *v.* Pountney 1884), 29 O. G. Rep. 615; 22 O. G. 85; 20 Blatch. 84; 21 Fed. Rep. 399.

[2] That the seller of parts of a patented combination which are also useful in other connections does not infringe unless acting in concert with others, see Bliss *v.* Merrill (1887), 42 O. G. 97; Maynard *v.* Pawling (1880), 18 O. G. 244; 3 Fed. Rep. 711; 5 Bann. & A. 551; Saxe *v.* Hammond (1875), 7 O. G. 781; Holmes, 456; 1 Bann. & A. 629.

That it is not an infringement to make and sell elements which are useful in various combinations though the seller may expect them to be used in the patented combination, see Millner *v.* Schofield (1881), 4 Hughes, 258.

See also §§ 900, 903, and notes, *ante*.

§ 925. [1] That the purchaser of the product of a process does not infringe the process, see Brown *v.* District of Columbia (1884), 3 Mackey, 502.

That where there are three patents, one for a machine, the second for a process, and the third for a product, and the machine patent first expires, the use of the machine may infringe the patent for the process or the product, see McKay *v.* Dibert (1881), 5 Fed. Rep. 587; 19 O. G. 1351. But see 466.

That identity of product shows identity of process, *prima facie*, where both are new, see Pickhardt *v.* Packard (1884), 30 O. G. 179; 23 Blatch. 23; 22 Fed. Rep. 530.

[2] That to use a patented process to perform part of an act which it usually performs entirely is infringement, see Eames *v.* Andrews (1887), 122 U. S. 40; 39 O. G. 1319; Andrews *v.* Eames (1883), 15 Fed. Rep. 109; 23 O. G. 1123.

That the use of an invention involving a patented process is a continuing infringement, see Beedle *v.* Bennett (1887), 122 U. S. 71; 39 O. G. 1326.

That the sale of materials to be used in an infringing process is infringement, see Willis *v.* McCollin (1886), 38 O. G. 1017; 29 Fed. Rep. 641.

That a patent for a process arriving at a known result is not infringed by another process attaining the same result, see Anilin *v.* Levinstein (1883), L. R. 24 Ch. D. 156.

That the use of a patented process is an infringement whether or not the infringer made or set up the apparatus, see Andrews *v.* Cross (1881), 8 Fed.

tial is omitted, and its place is left unsupplied, or if for it is substituted a step which the patentee intended to avoid, or if the succession of the acts is changed in any material degree, the identity of the invention practised with the patented invention is destroyed and the former is not an infringement.[3] In that class of arts which express the idea of a force directed through the process upon a specific object, and thus involve the material to be treated as an essential element, the performance of the acts described in reference to other objects or materials is not infringement.[4]

Rep. 269 ; 19 O. G. 1705 ; 19 Blatch. 294.

That whenever one avails himself of another's patented discovery and process an infringement exists, see American Bell Telephone Co. *v.* Dolbear (1883), 15 Fed. Rep. 448 ; 23 O. G. 535.

That a patent for a process is infringed though an equivalent is used, see Kimball *v.* Hess (1883), 15 Fed. Rep. 393 ; 26 O. G. 107.

That when a patent describes a composition for producing a certain effect in a process, but does *not* give its ingredients as essential nor claim them, the process is infringed by the use of any equivalent composition, see Johnson *v.* Willimantic Linen Co. (1866), 33 Conn. 436.

That a patent for a process is infringed *only* where the same mode of reaching the result is followed as is described in the specification, see Royer *v.* Chicago Mfg. Co. (1884), 20 Fed. Rep. 853.

[3] That a process is infringed only when every step claimed as essential is used, see Arnold *v.* Phelps (1884), 29 O. G. 538 ; 20 Fed. Rep. 315 ; Hammerschlag *v.* Garrett (1882), 10 Fed. Rep. 479 ; 21 O. G. 1199 ; 15 Phila. 474.

That a patent for a process is not infringed by the use of all except the first and last steps, all the steps used being well known, see Heller *v.* Bauer (1884), 19 Fed. Rep. 96.

That a process omitting a patented step, and including a step which the patentee intended to avoid, is not an infringement, see Cotter *v.* New Haven Copper Co. (1882), 13 Fed. Rep. 234 ; 23 O. G. 740.

That a patent for a process and a combination is not infringed by the use of part of the combination and part of the process, see Howe *v.* Abbott (1842), 2 Story, 190 ; 2 Robb, 99.

That a process may be infringed though the order of the steps is varied, where the order is not essential, see Hammerschlag Mfg. Co. *v.* Bancroft (1887), 40 O. G. 1339 ; 32 Fed. Rep. 585.

That a process consisting in doing certain acts at a certain stage of events is not infringed by doing the same acts at a different stage, see Boneless Fish Co. *v.* Roberts (1882), 12 Fed. Rep. 627.

That a process may be infringed though its mode of use is varied, see Cary *v.* Wolff (1885), 32 O. G. 257 ; 24 Fed. Rep. 139 ; 23 Blatch. 92.

[4] That where a process and its material both enter into an invention there is no infringement unless both are used, see Goodyear Dental Vulcanite Co. *v.* Davis (1880), 102 U. S. 222 ; 19 O. G. 543.

§ 926. Infringement of a Patent for a Machine.

A machine is a mode of operation permanently embodied in tangible materials. The *modus operandi*, or structural law of the mechanism, is the essence of the invention, and its identity is never lost while this remains. Differences in its form and construction, in the number and relation of its parts, and in the uses to which it may be adapted, are all compatible with the preservation of this essential characteristic. A patented machine is thus infringed by any other which embodies the same structural law.[1] It is immaterial whether it resembles the patented invention in appearance or in the nature and arrangement of its different members, or whether it is less perfect or more perfect, or serves the same or additional purposes, or employs the same parts or equivalent ones, — if the structural law of the patented machine is found oper-

§ 926. [1] In Foss *v.* Herbert (1856), 2 Fisher, 31, Drummond, J. : (36) "An infringement of a patent takes place whenever a party avails himself of the invention of the patentee without such variation as will constitute a new discovery. A man may improve a patented machine so as to entitle him to a patent for his improvement, but that will not give him a right to use the invention of the first patentee without his license. A machine is an infringement of another if it incorporate in its structure and operation the substance of the invention, — that is, by an arrangement of mechanism which performs the same service, or produces the same effect, in the same way, or substantially the same way. Mere colorable alterations, or adroit evasions by substituting one mechanical equivalent for another in the combination which constitutes the machine, should never be allowed to protect a party." 1 Bissell, 121 (126).

In Sickels *v.* Borden (1856), 3 Blatch. 535, Nelson, J. : (541) "However different, apparently, the arrangements and combinations of a machine may be from the machine of the patentee, it may in reality embody his invention, and be as much an infringement as if it were a servile copy of his machine. According to the Patent Law, if the machine complained of involves substantial identity with the one patented, it is an infringement. If the invention of the patentee be a machine, it is infringed by a machine which incorporates, in its structure and operation, the substance of the invention, — that is, an arrangement which performs the same service, or produces the same effect, in the same way, or substantially the same way."

Further, that a machine patent is infringed by every machine which operates under the same structural law, see Cantrell *v.* Wallick (1886), 117 U. S. 689 ; 35 O. G. 871 ; Grier *v.* Castle (1883), 17 Fed. Rep. 523 ; 24 O. G. 1176 ; Brett *v.* Quintard (1882), 10 Fed. Rep. 741 ; 20 Blatch. 320 ; Waterbury Brass Co. *v.* Miller (1871), 5 Fisher, 48 ; 9 Blatch. 77 ; Cahoon *v.* Ring (1861), 1 Clifford, 592 ; 1 Fisher, 397.

That a machine whose mode of

ating unchanged in the other, the latter is an infringement.[3] An act of infringement is committed by the manufacture of the machine though it is never used or sold, the intent to put it to the practical use for which it is designed being inferred from its construction.[3] The use of the machine in any manner or for any beneficial purpose is infringement, and where one of several co-owners of an infringing machine operates it with their consent the infringing act is theirs as well as his.[4]

operation is substantially different does not infringe, see Schmidt *v.* Freese (1882), 12 Fed. Rep. 563; 21 O. G. 1876; Brett *v.* Quintard (1882), 10 Fed. Rep. 741; 20 Blatch. 320.

That a particular device is infringed only by a copy thereof, see Singer *v.* Walmsley (1860), 1 Fisher, 558.

That a machine intended to be different does not infringe merely because it may be forced to operate like the patented machine, see Buzzell *v.* Andrews (1885), 34 O. G. 830; 25 Fed. Rep. 822.

That a machine patent is not infringed by the use of a different machine for the same purpose, see Opinion Atty. Gen. (1873), 14 Op. At. Gen. 209.

[2] That the structural law being the same, differences in form are of no consequence, see Grier *v.* Castle (1883), 17 Fed. Rep. 523; 24 O. G. 1176; Brett *v.* Quintard (1882), 10 Fed. Rep. 741; 20 Blatch. 320; Dederick *v.* Cassell (1881), 14 Phila. 503; 9 Fed. Rep. 306; 20 O. G. 1233; Potter *v.* Wilson (1860), 2 Fisher, 102.

That a machine may infringe although it is less perfect, see Pitts *v.* Wemple (1855), 2 Fisher, 10; 1 Bissell, 87.

That the use of the substantial features of a machine is an infringement, though certain parts are omitted or equivalents are used, see Wheeler *v.* Clipper Mower & Reaper Co. (1872), 2 O. G. 442; 10 Blatch. 181; 6 Fisher, 1; Waterbury Brass Co. *v.* Miller (1871), 5 Fisher, 48; 9 Blatch. 77; Rich *v.* Close (1870), 4 Fisher, 279; 8 Blatch. 41; Foss *v.* Herbert (1856), 2 Fisher, 31; 1 Bissell, 121; Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23.

That a patent covering two machines is infringed by the use of either one of them, see Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23.

That on the question as to the infringement of a machine, attention is to be directed to the parts which do the work, not to matters of construction, see Holly *v.* Vergennes Mach. Co. (1880), 18 O. G. 1177; 4 Fed. Rep. 74; 18 Blatch. 327.

[3] That it is an infringement to make a patented machine though it is neither used nor sold, see Butz Thermo Electric Regulator Co. *v.* Jacobs Electric Co. (1888), 45 O. G. 833; Bloomer *v.* Gilpin (1859), 4 Fisher, 50.

[4] That a machine capable of serving two uses, at the option of its user, is an infringement on the same device intended for one use only, though it has been improved, see Holbrook *v.* Small (1876), 10 O. G. 508; 2 Bann. & A. 396.

That where one runs an infringing machine owned by himself and two others, all claiming under a patentee who was previously enjoined, all are infringers, see Woodworth *v.* Edwards (1847), 3 W. & M. 120; 2 Robb, 610.

The sale of the machine is also an infringement; but neither the use nor the sale of its manufactured products violates the patent unless the user or the seller are in collusion with the infringing operator of the machine.[5]

§ 927. Infringement of a Patent for a Manufacture.

The essential characteristics of a manufacture are not capable of any accurate general statement. They are embraced in the idea of means which the inventor has conceived and expressed in the article itself, and are in each case to be determined by an examination of its effects, its functions, and its method of performing them. Notwithstanding the difficulty of ascertaining it, however, its real nature is as definite and exact as any other species of invention, and any variation in its necessary attributes involves the loss of its identity. A patented manufacture is infringed by the making, use, or sale of any manufacture which possesses the same essential characteristics, although in other qualities the inventions may be totally dissimilar.[1] The method of producing the infringing manufacture is not important, the article being the same though made by a different process or machine.[2] Its use or

[5] In Boyd *v.* McAlpin (1844), 3 McLean, 427, *per Curiam*: (429) "A sale of the product of the machine is no violation of the exclusive right to use, construct, or sell the machine itself. If, therefore, the defendant has done nothing more than purchase the bedsteads from Brown, who may manufacture them by an unjustifiable use of the patented machine, still the person who may make the purchase from him has a right to sell. The product cannot be reached, except in the hands of one who is in some manner connected with the use of the patented machine." 2 Robb, 277 (279).

See also Goodyear *v.* Railroad (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That where a manufacture is in the market, purchasers are not obliged to find out whether it was made by a patented machine or a patented process, see Goodyear *v.* Railroad (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

§ 927. [1] That the patent for a manufacture is infringed by the use or the sale of it, see Goodyear *v.* Railroad (1853), 1 Fisher, 626; 2 Wall. Jr. 356.

That a patented hotel register is infringed by the landlord who uses it, see Hawes *v.* Washburn (1872), 5 O. G. 491; Hawes *v.* Cook (1872), 5 O. G. 493; Hawes *v.* Gage (1871), 5 O. G. 494.

That the use of equivalents in a manufacture is an infringement, see Singer *v.* Walmsley (1860), 1 Fisher, 558.

[2] That a patent for a manufacture is infringed in whatever way the article is made, see Celluloid Mfg. Co. *v.* American Zylonite Co. (1887), 40 O. G. 1453; 30 Fed. Rep. 437; Anilin *v.* Hamilton Mfg. Co. (1878), 13 O. G.

sale may be restricted or extensive and for the same or other purposes than those intended by the inventor, since in every use of which it is capable it still belongs to him.[3]

§ 928. Infringement of a Patent for a Composition of Matter.

A composition of matter is a true combination whose elements are the ingredients of which it is composed, and whose co-operative law determines the mode in which each ingredient operates upon the others to develop the properties that characterize the finished composition. Two compositions are identical when they possess the same or equivalent ingredients, united together in the same manner to produce the same result.[1] If one of these compositions is protected by a patent the other will infringe it, whether or not it is prepared by the same process or is known in the market by the same appellation;[2] though where a composition is patented as the product

273; 3 Bann. & A. 235; Woodward *v.* Morrison (1872), 2 O. G. 120; Holmes, 124; 5 Fisher, 357.

That where a product is patented as the result of *a certain process it is* infringed only when made by that process, see Van Camp *v.* Maryland Pavement Co. (1888), 43 O. G. 884; Cochrane *v.* Anilin (1884), 111 U. S. 293; 27 O. G. 813.

That where a patent covers an article only when made of certain materials it is not infringed by the same article made of different materials, see Western & Wells Mfg. Co. *v.* Rosenstock (1887), 30 Fed. Rep. 67; 41 O. G. 354.

That a patent for a new result is infringed by any process producing that result, see Anilin *v.* Levinstein (1883), L. R. 24 Ch. D. 156.

That identity of product is *prima facie* evidence of identity of process where both are new, see Pickhardt *v.* Packard (1884), 30 O. G. 179; 23 Blatch. 23; 22 Fed. Rep. 530.

[3] That a valid patent for a fabric is infringed by any one who uses the fabric in any manner or degree, see Celluloid Mfg. Co. *v.* Chrolithion Collar & Cuff Co. (1885), 23 Blatch. 205; 23 Fed. Rep. 397; 31 O. G. 519.

§ 928. [1] That the use of chemical equivalents, though better, is an infringement, see Woodward *v.* Morrison (1872), 2 O. G. 120; Holmes, 124; 5 Fisher, 357.

That a patent for a composition of matter is infringed if the new element does the same thing as the one for which it is substituted, though otherwise it is different, see Woodward *v.* Morrison (1872), 2 O. G. 120; Holmes, 124; 5 Fisher, 357.

That a composition of matter is not infringed, if elements are substituted producing different results, see Smith *v.* Murray (1886), 27 Fed. Rep. 69; 36 O. G. 1045.

[2] That a composition of matter is infringed by making, using, or selling the same composition though made by a different process, see Woodward *v.* Morrison (1872), 2 O. G. 120; Holmes, 124; 5 Fisher, 357.

That a patent for the composition of old ingredients is not infringed by the

of a specific process the patented composition is not appropriated unless the prescribed process is employed.[3] A patented composition is infringed not only by its unauthorized manufacture, but also by its wrongful use or sale.

§ 929. Infringement of a Patent for a Design.

A design is an appearance presented to the eye, and created by imposing upon physical substances some peculiar shape or ornamentation. Two designs are identical when they appear to be the same to the eye of an ordinary observer, though the lines or images of which they are formed are seen, on close inspection, to be different.[1] Design-patents are infringed by the same acts which violate the rights of other patentees, — the making, use, or sale of the physical substance bearing the design being the manufacture, use, or sale of the design itself. Where the physical substance is a patented invention of another class, the same act may thus violate the rights of different patentees and render the infringer liable for double compensation.

use or sale of any one of them, see Geis *v.* Kimber (1888), 444 O. G. 108.

[3] That where a patent claims a process and the composition as made by that process, the same composition, if made by a different process, is not an infringement, see Van Camp *v.* Maryland Pavement Co. (1888), 43 O. G. 884; Dittmar *v.* Rix (1880), 1 Fed. Rep. 342; 17 O. G. 973; 5 Bann. & A. 240.

§ 929. [1] In Miller *v.* Smith (1880), 18 O. G. 1047, Clifford, J.: (1048) "Speaking in the general sense, it is doubtless true that the test of infringement in respect to the Claims of a design-patent is the same as in respect to a patent for an art, machine, manufacture, or composition of matter; but it is not essential to the identity of the design that it should be the same to the eye of an expert. If in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer and sufficient to induce him to purchase one supposing it to be the other, the one first patented is infringed by the other." 5 Fed. Rep. 359 (365).

See also *Ex parte* Gerard (1888), 43 O. G. 1235; Dreyfus *v.* Schneider (1885), 25 Fed. Rep. 481; Tomkinson *v.* Willetts Mfg. Co. (1884), 23 Fed. Rep. 895; 31 O. G. 918; 32 O. G. 382.

That a patent for a design is infringed by copying a part thereof, if that part is covered by the patent, see Dryfoos *v.* Friedman (1884), 18 Fed. Rep. 824; 21 Blatch. 563.

That a design may be infringed though a different name be given it, see Perry *v.* Starrett (1878), 14 O. G. 599; 3 Bann. & A. 485.

§ 930. Infringement of a Patent for an Improvement.

An improvement is a development of the idea of means embodied in the original invention, and may relate to the entire idea or to one or more of its subordinate factors. Where it affects the whole invention its scope may be extensive and produce a great advancement in the art. Where it concerns only a single feature of the invention it is frequently confined within the narrowest limits. Its measure is found in the difference between the invention or the improved feature in its former state, and its condition since the improvement has been made. Applying to this difference the usual test, the improvement will be found to be that specific change in the invention or subordinate member by which its mode of operation in the performance of its functions is rendered more advantageous to the user. Other changes in the same part may have the same effect upon its mode of operation and be different improvements, but the essential attributes of this specific change belong to its inventor, and when protected by a patent are infringed by every other change which is substantially the same.[1] An improvement in an art can be infringed by practising the art in the peculiar manner discovered by the inventor of the improvement, but not by practising it in a different manner though the result of the two methods is the same. An improvement in an article can be infringed by making, using, or selling the improved device, but not by the appropriation of some different device improving the original invention in the same direction and to the same degree. An improver acquires thereby no right to practise the original invention, nor is the original inventor entitled to the use of the improvement.[2]

§ 930. [1] For a discussion of the nature and scope of an improvement, see §§ 210–218, 307–313, and notes, *ante*.

That one improvement does not infringe a patent for a different one, see Seymour *v.* Osborne (1869), 3 Fisher, 555.

[2] That neither the original patentee nor the improver can employ the invention of the other, see Cantrell *v.* Wallick (1886), 117 U. S. 689; 35 O. G. 871; Robertson *v.* Blake (1876), 94 U. S. 728; 11 O. G. 877; Fales *v.* Wentworth (1872), 2 O. G. 58; Holmes, 96; 5 Fisher, 302; Whipple *v.* Baldwin Mfg. Co. (1858), 4 Fisher, 29; Pitts *v.* Wemple (1855), 6 McLean, 558.

That the improvement infringes the original though it gives the invention

SECTION III.

OF INFRINGEMENT: REMEDY AT LAW.

§ 931. Remedy for Infringement at Law: Action on the Case.

Prior to the Act against Monopolies (21 Jac. I., c. 3) the remedy for an infringement of the rights conferred by letters-patent was administered in the court of Star Chamber under its general jurisdiction over all offences not covered by the common or the statute law.[1] By that Act, however, it was provided that violations of such patents as were thereafter to be lawful should be redressed according to the common law and not otherwise, — thus bringing the infringement of a patent within that class of wrongs which had immemorially been remedied by the courts of ordinary jurisdiction.[2] Being a tort involving consequential damage only to the patentee, the form of action applicable to it was trespass on the case, through which from that time to the present the injured party has pursued his remedy at law.[3]

all its value, see Gray *v.* James (1817), Peters C. C. 476; 1 Robb, 140.

And though it has superseded the original in the trade, see Turrell *v.* Spaeth (1878), 14 O. G. 377; 3 Bann. & A. 458.

§ 931. [1] That infringements of patent rights were cognizable in the Star Chamber, see 3 Inst. 183; Godson, 175; Coryton, 262. That the reason for this jurisdiction seems rather to reside in the unwillingness of the courts of common law to protect the owners of monopolies than in their inability to extend relief, see Darcy *v.* Alleyn (1602), Noy, 173; Clothworkers of Ipswich (1615), Godbolt, 252; both which were cases in King's Bench, where the patents were defeated, and the validity of letters-patent, except for new inventions, was denied. The Stat. Jac. I. not so much conferred jurisdiction over infringements on the courts of common law as it abolished the jurisdiction of the royal tribunal and made that of the common law courts exclusive.

[2] Stat. 21 Jac. I., c. 3, Sec. 2. "And be it further declared . . . that all monopolies . . . letters-patent, . . . and all other matters and things tending as aforesaid, and the force and validity of them and every of them, ought to be and shall be forever hereafter examined, heard, tried, and determined by and according to the common laws of this realm and not otherwise."

[3] That the action at common law for the infringement of letters-patent was trespass on the case, see Godson, 176; Coryton, 266; and all the English cases prior to our act of 1790. In the act of 1790 this form of remedy was directly prescribed (Sec. 4), and the same provision has been repeated in all

§ 932. Remedy at Law Insufficient: Equitable Jurisdiction Established.

The redress afforded by an action at law consisting simply in an award of damages for past infringements was early found to be inadequate for the protection of the patentee. In most instances the wrong is a continuing one, not capable of complete redress in any single proceeding but requiring numerous successive suits as new grounds of action may arise. It is also in many cases a secret injury which the patentee can neither discover by any of the usual methods of investigation nor establish under the common rules of evidence. For these and other reasons, inherent in the nature of the injury, the aid of courts of equity was first invoked to prevent the continuance of the wrong by injunction, to compel the alleged infringer to disclose the character and extent of his supposed infringement, and to bestow such other special relief as might be necessary to secure to the plaintiff at law the entire vindication and protection of his rights.[1] The assistance of equity

subsequent statutes. (Rev. Stat., 1874, Sec. 4919.) See also May *v.* Mercer Co. (1887), 41 O. G. 815; 30 Fed. Rep. 246; Stein *v.* Goddard (1856), 1 McAllister, 82.

That no previous notice is needed in order to sue for an infringement, see Ames *v.* Howard (1833), 1 Sumner, 482; 1 Robb, 689.

That a contract stipulating for an arbitration before suit is binding, and a plaintiff must show that he has made all reasonable efforts to arbitrate, see Perkins *v.* United States Electric Light Co. (1883), 24 O. G. 204.

That State laws may require claims against a county for infringement to be presented and payment demanded before suit, see May *v.* Buchanan Co. (1886), 39 O. G. 120; 29 Fed. Rep. 469.

That a patentee will not be enjoined from suing at law when the bill for an injunction shows a good defence at law, see Hapgood *v.* Hewitt (1886), 119 U. S. 226; 37 O. G. 1247.

§ 932. [1] Such was the stringency of the provision in the Stat. Jac. I. confining jurisdiction to the courts of common law, and the influence of the language of Lord Coke, 3 Inst. 181, expressly declaring that this provision excluded chancery jurisdiction, that for many years the aid of equity was not invoked, and when invoked was not accorded unless the patentee had already established his right in an action at law. See Blanchard *v.* Hill (1742), 2 Atk. 484. The earliest reported case in which equity afforded relief without a previous trial at law was Hicks *v.* Raincock (1783), 1 Abb. P. C. 23; 2 Dick. 647. In Boulton *v.* Bull (1796), 1 Abb. P. C. 97, the same position was taken, the issues of fact being tried on separate proceedings in the common law courts. For a discussion of the attitude of courts of chancery toward patent causes prior to A. D. 1800, see Coryton, 319, 320; Godson, 183.

in actions at law being thus shown to be not only effective but often indispensable, original proceedings were at length commenced in chancery by a petition for an injunction or discovery, and under the jurisdiction so obtained complete redress was given to the patentee, the aid of a court of law being sought only where issues of fact required the verdict of a jury.[2] The complicated and technical questions embraced in these issues frequently rendering them unfit for disposition by the common law tribunal, this last link between the two procedures was finally abandoned, and courts of equity assumed entire control over all actions instituted before them, thus giving to the injured patentee two distinct methods of redress, — an action at law upon the case for damages, and a bill in equity for an injunction, discovery, account, or any other relief to which he might in justice be entitled.[3] These gradual changes have been effected partly by judicial, partly

[2] In Harmer *v.* Plane (1807), 1 Abb. P. C. 166, after the issue of an injunction restraining the defendant until the merits could be tried at law, a case was stated by the chancellor and sent to King's Bench for a disposition of the issues of fact arising on the prayer for an injunction. These issues were duly tried (see Harmer *v.* Plane (1809), 1 Abb. P. C. 171), and the decision certified to the chancellor for the final disposition of the cause. This practice was followed in Manton *v.* Manton (1815), 1 Abb. P. C. 189; Wood *v.* Zimmer (1815), 1 Abb. P. C. 202; Cochrane *v.* Smethurst (1816), 1 Abb. P. C. 228. In other cases the patentee was ordered to institute independent proceedings in the courts of law, and the injunction was continued, or a bond and account was ordered, until the verdict could be obtained. See also Godson, 187.

[3] See Coryton, 321, etc. In Wilson *v.* Tindal (1841), 1 Web. 730, n., on an application for an injunction, Lord Langdale, M. R., treated the entire matter of a trial at law as within the discretion of the court of chancery before which the petition for equitable relief was pending. He says: "It is not the right of parties in every case to have an action tried in a court of law; it is a question of convenience, and the court is to exercise a fair discretion. I have no doubt whatever of the competency of this court to grant an injunction *simpliciter*." In Young *v.* Fernie (1866), 1 App. Cas. 63; 33 L. J. Ch. 192; 35 L. J. Ch. 523, after a trial had been once ordered at law without final result, the cause was heard and determined in equity without a jury. In Bovill *v.* Hitchcock (1868), L. R. 3 Ch. App. 417, the court refused to allow a trial at law, and this refusal was on appeal sustained. In Patent Marine Inventions Co. *v.* Chadburn (1873), L. R. 16 Eq. 447, Lord Selborne refusing a jury states that causes involving questions of Patent Law are generally unfit for a jury trial, and are more properly disposed of by a single judge. These cases mark the gradual steps by which complete jurisdiction in equity has been acquired.

by legislative, action. In England after the courts of equity had asserted, and for a considerable period had exercised, their peculiar authority for the protection of the patentee, an act of Parliament conferred equity powers upon the courts of law in patent cases, enabling them to prevent future infringements by injunction and to compel defendants to make discovery of their alleged unlawful acts.[4] In this country the earlier statutes provided only for an action on the case, but under these the courts of equity interfered by injunction and otherwise when the circumstances demanded it, until in 1819 another statute bestowed original jurisdiction as well in equity as at law upon the Federal courts over all patent cases, and opened both methods of relief to the patentee, as far as the nature of his injury required. This statute has been re-enacted with varied phraseology at different periods in the history of our patent-system, and in its present form permits the patentee to sue at law for damages in all cases of past infringement, invoking the aid of equity wherever it may be required, or to resort originally to equity if the redress to which he is entitled necessitates the exercise of chancery powers.[5] The

[4] 17 & 18 Vict. c. 125 (1854). Under this act, injunctions could be ordered by the common law court at any stage in the case, either before or after judgment; an inspection of books and infringing inventions could be compelled, and an accounting could be decreed.

[5] Prior to the act of 1819 the only remedy afforded under the statutes of the United States was the common law action on the case. That the Federal courts possessed no original equity powers in patent cases where the parties to the suit were citizens of the same State was conceded, though in Livingston *v.* Van Ingen (1811), 1 Paine, 45, Livingston, J., doubted whether these courts could not, when necessary, exercise chancery jurisdiction in aid of actions at law. In Isaacs *v.* Cooper (1821), 4 Wash. 259; 1 Robb, 332, Washington, J., speaks of the practice of giving such aid as if it were frequent, and within the ordinary operations of the court, while in Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477, Thompson, J., discusses the act of 1819 and declares that it neither enlarges nor alters the powers of the court to interfere, as a court of equity, but simply extends its jurisdiction to patent cases where the citizenship of the parties is the same. Thus it would appear always to have been the doctrine in this country that equity powers might be appropriately exercised in aid of a suit at law, without reference to the question of original jurisdiction over patent causes themselves. Comparatively few of the cases occurring before 1840 were, however, instituted in courts of equity, perhaps because of the construction given to the act of 1819 by Thompson, J., in Sullivan *v.* Redfield, *ante*. But after the passage of the act of 1836, the provisions of that statute, though couched

principal practical differences between these two remedies reside in their modes of procedure, and in the rules by which the compensation awarded to the plaintiff for the injury sustained by the infringement is determined. In considering each in detail the action at law will be first discussed, including all those topics which are common to both remedies, except that of Injunctions, whose intricacy and importance merit for it a separate examination. In this discussion the following order will be pursued:—

I. Jurisdiction of Courts.
II. Parties.
III. Process, Pleadings, and Evidence.
IV. Trial and Verdict.
V. New Trial, and Writ of Error.
VI. Costs.

§ 933. Jurisdiction over Actions for Infringement in General.

Jurisdiction over all cases arising under the Patent Laws is, as we have seen, vested exclusively in the Federal courts. The acts of Congress have further limited this jurisdiction to

in language closely resembling that of 1819, were held to confer full equity powers upon the Federal courts, as courts of original jurisdiction, over all cases arising under the Patent Laws, and to give the patentee an option either to seek his legal redress in one tribunal or his equitable remedy in the other. Actions in equity then became more frequent, but in these, as in actions at law, resort to a jury was considered necessary to determine any issue of fact involving the matter of infringement. This was accomplished by a feigned issue, according to the usual course of chancery practice. See Brooks *v.* Bicknell (1843), 3 McLean, 250; 2 Robb, 118; Brooks *v.* Bicknell (1845), 4 McLean, 70. Such a trial was nevertheless regarded as within the discretion of the court, which might substitute therefor a hearing before a master (Parker *v.* Hatfield (1845), 4 McLean, 61), or even before the chancery judge himself (Van Hook *v.* Pendleton (1846), 1 Blatch. 187; Woodworth *v.* Rogers (1847), 3 W. & M. 135; 2 Robb, 625). These modes of proceeding were found especially convenient, since a trial by jury must take place in the same court and involve nearly the same labor on the part of the judge as would his personal investigation and decision of the issues. Hence the transition was easy and rapid from the more ancient and complex to the later and more simple method of ascertaining the facts in controversy, and together with the growing distrust of juries in intricate cases has resulted in the almost entire substitution of actions in equity for actions on the case in courts of law where equity jurisdiction can be claimed.

As to the limits of equity jurisdiction and the line dividing it from law, see §§ 1082–1097, and notes, *post*.

the Circuit courts, to District and Territorial courts endowed with Circuit court powers, and to the Supreme Court of the District of Columbia, with an appellate jurisdiction in the Supreme Court of the United States. Every action for the infringement of a patent, whether at law or in equity, must, therefore, be instituted in one of the Circuit courts of the United States or in one of these equivalent tribunals. In determining what particular Circuit court has jurisdiction of any individual case, the question of locality is of paramount importance. An action for damages for past infringements is not a local action, and any court of competent jurisdiction may hear and determine all the matters in controversy between the parties, and render a judgment upon which process in the nature of an execution or of an action of debt upon the record may issue for the collection of the damages awarded to the plaintiff. As all Circuit courts and their equivalent tribunals have jurisdiction over the subject-matter in such actions for past infringement, the particular court before which any given case should be brought must be that court whose local jurisdiction embraces the parties to the suit; and any Circuit court obtaining jurisdiction over these may thus take complete cognizance of all matters properly in issue in any action at law between them.[1] An action in equity, as will hereafter more fully appear, stands on somewhat different ground. For the enforcement of the orders and decrees which may be necessary in the prosecution of this remedy, a more direct and permanent control over the parties and the subject-matter may be required than is afforded by that general jurisdiction over the subject and that temporary jurisdiction over the parties, which are sufficient for the purposes of an action at law; and a particular Circuit court may thus decline to take cognizance of such proceedings in cases where a suit at law would be unhesitatingly entertained.[2] This dis-

§ 933. [1] That an action at law may be brought in any district where the defendant can lawfully be served with process, see Thompson *v.* Mendelsohn (1871), 5 Fisher, 187; Allen *v.* Blunt (1849), 1 Blatch. 480.

[2] That an action in equity praying for an injunction can be brought only in the district where the defendant resides or does business, or where the infringement takes place, see Wilson Packing Co. *v.* Clapp (1878), 8 Bissell, 154; 3 Bann. & A. 243; 13 O. G. 368; Hodge *v.* Hudson River R. R. Co. (1868), 3

tinction must be kept in mind in examining the decisions upon these questions of local jurisdiction, lest the sweeping propositions applicable to all actions at law, and to some actions in equity, be regarded as in conflict with apparently different rules which govern only certain special cases.

§ 934. Jurisdiction over Actions at Law Vests in the Court for the Circuit in which the Defendant Resides or is Found.

An action at law for infringement may be brought before any Circuit court which has jurisdiction over the persons of the plaintiff and defendant. A plaintiff places himself within the jurisdiction of the court by instituting his action therein. Hence where a plaintiff has the capacity to sue, no question as to the jurisdiction of the court over him can properly arise. This is the case with all natural persons, and with all corporations also unless restrictions in their charters or in the local laws otherwise provide.[1] In the absence of such restrictions, any corporation or individual, whose rights under a patent have been violated, may institute legal proceedings for redress in any Circuit court whose jurisdiction extends to the person of the defendant. A Circuit court has jurisdiction over a defendant when he resides or is lawfully served with process in either of the districts which are included in

Fisher, 410; 6 Blatch. 85; Goodyear *v.* Chaffee (1855), 3 Blatch. 268. *Contra:* Thompson *v.* Mendelsohn (1871), 5 Fisher, 187; Wilson *v.* Sherman (1850), 1 Blatch. 536; Boyd *v.* McAlpin (1844), 3 McLean, 427; 2 Robb, 277.

That an injunction may issue against an infringer in the district where he lives forbidding him to infringe anywhere, see Hatch *v.* Hall (1884), 22 Fed. Rep. 438; 30 O. G. 1096.

That an action in equity for an accounting or damages, etc., can be brought in any district where the defendant can lawfully be served with process, see Allen *v.* Blunt (1849), 1 Blatch. 480; and §§ 1096, 1097, and notes, *post.*

§ 934. [1] That the Patent Laws do not change the rules established by the judiciary acts as to territorial jurisdiction over parties, or the service of process, see United States *v.* American Bell Telephone Co. (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

That a corporation may maintain a suit in the district where its rights are infringed, though it is created under the laws of another State, see Elm City Co. *v.* Wooster (1873), 4 O. G. 83; 6 Fisher, 452.

the circuit.[2] A resident defendant is always within the jurisdiction of the court, and the rules which require personal service of process upon him can at all times be fulfilled. Upon a non-resident defendant, however, process can be served only when he is personally within the territorial limits of the circuit.[3] Service by publication or by the attachment of property, though often sufficient under State laws to confer

[2] In Thompson *v.* Mendelsohn (1871), 5 Fisher, 187, McKennan, J. : (188) "The Patent Laws confer exclusive jurisdiction upon the circuit courts of all suits, in law or equity, for invasion of the rights of inventors under them, and the judiciary act expressly authorizes such suits to be brought and process to be served upon defendants in *any* district in which they may be found. The conclusion is inevitable that where these conditions are complied with, the court has power to afford such measure of protection to the plaintiff's rights as it is competent to afford in any case, of the subject-matter of which it has jurisdiction, and in which the parties are before it by the due service of process. Certainly by no act of Congress is this power restricted by the fact of the defendant's residence in another district; or that the wrong imputed to him was not committed in the district in which the suit is brought. The process of the court is primarily directed against the person of the wrong-doer, and it is no sufficient reason against the power of the court to award it, that it may not furnish to the plaintiffs effectual relief, or that its operation may be evaded by the defendant."

[3] The law as stated in the text and illustrated in the notes of this and succeeding paragraphs is that of the judiciary acts, and the decisions under them, prior to the act of March 3, 1887. The latter act provides that "no civil suit shall be brought before" the circuit courts of the United States "against any person by any original process of proceeding in any other district than that whereof he is an inhabitant." Whether this provision applies to cases arising under the Patent Laws may well be doubted. In Preston *v.* Fire Extinguisher Co. (1888), 46 O. G. 124, Gormully Mfg. Co. *v.* Pope Mfg. Co. (1888), 34 Fed. Rep. 818, and Halstead *v.* Manning (1888), 44 O. G. 344, it was held that patent causes were within the statute, and that a defendant must thus be sued in the district of his residence. On the other hand, it has been decided that another equally universal provision of the same act, limiting the jurisdiction of the circuit courts to controversies involving $2,000 or upwards, does not apply to patent cases. See Miller-Megee Co. *v.* Carpenter (1887), 43 O. G. 1118, where it is also intimated that the act of 1887 does not relate to suits under the Patent Laws. Patent rights and their invasions, as well as patent litigations, being matters *sui generis*, the consequences of embracing them under the sweeping provisions of general statutes cannot always be foreseen ; but many reasons will suggest themselves to any person familiar with industrial affairs in this country in favor of the retention of the former rule of practice in suits against infringers. Until the new position has been fully discussed and finally adopted by the courts, or more specifically defined by Congress, its soundness may, therefore, be regarded as an open question, and the doctrine built up by a century of legislation and judicial explanation be still treated as at least possibly correct and

jurisdiction over him for the purposes of the action thus commenced, does not answer the requirements of the Federal law.[4] Personal service within the circuit must be made upon him, and this must affirmatively appear upon the marshal's return, or the court acquires no jurisdiction over him.[5] Such service must be lawful and not be procured by fraud or imposition. Service on a non-resident defendant attending court within the circuit, or present at an examination of witnesses by stipulation, or inveigled by any means within the circuit in order that service may be made upon him, is fraudulent and void, and will be set aside on motion by the court.[6] But such a defendant, either without service or after improper service, may appear and submit himself to the jurisdiction of the court, whose authority thereafter over him will be as complete as if it had been regularly obtained.[7]

ultimately to prevail. In that view it is here considered as if the act of 1887 had not been passed.

That a circuit court has no jurisdiction unless the defendant is served in his own district, or is found and served where sued, see Day *v.* Newark India Rubber Mfg. Co. (1850), 1 Blatch. 628.

That suit may be brought in any district where the defendant can be served, whether either party lives there or not, but the defendant must be personally served therein, see Allen *v.* Blunt (1849), 1 Blatch. 480.

That service upon one co-partner does not give personal jurisdiction over a non-resident partner, see United States *v.* American Bell Telephone Co. (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That service cannot be made on an agent created by implication against the will of the parties and not actually appointed, see United States *v.* American Bell Telephone Co. (1886), 38 O. G. 1237 ; 29 Fed. Rep. 17.

[4] That the existence of property rights or pecuniary interests within the district are not alone enough to confer jurisdiction, see United States *v.* American Bell Telephone Co. (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That a service by attaching the defendant's goods gives no jurisdiction over him, see Chaffee *v.* Hayward (1857), 20 How. 208.

[5] That when a person is sued out of his own district it must affirmatively appear by the marshal's return that process was served on him in the district where the suit is brought or the court will acquire no jurisdiction, see Thayer *v.* Wales (1872), 5 Fisher, 448.

[6] That service upon a defendant while attending court in another State as a party defendant, or witness, is not lawful, see Wilson Sewing Mach. Co. *v.* Wilson (1885), 23 Blatch. 51.

That a service of process on a party attending an examination of witnesses by stipulation out of his own district will be set aside on motion, see Plimpton *v.* Winslow (1881), 22 O. G. 1207 ; 20 Blatch. 82 ; 9 Fed. Rep. 365.

[7] That a party appearing submits to the jurisdiction, see Macauley *v.* White Sewing Mach. Co. (1881), 21 O. G. 496 ; 9 Fed. Rep. 698.

That the judiciary acts, limiting

§ 935. Jurisdiction over Actions at Law against Domestic and Foreign Corporations.

A defendant corporation, like an individual, is always within the jurisdiction of the Circuit court in whose territory it is located by the act of its creation, and may there at any time be served with process. A corporation organized under the laws of a State is located at all places within the limits of the State, and may be sued in any Circuit court whose jurisdiction embraces any portion of such State.[1] Whether a corporation can be served with process outside the State of its location has been doubted.[2] Service within the circuit upon the officers of a non-resident corporation is clearly ineffectual, and does not become valid though the corporation appears by an attorney in order to plead to the jurisdiction.[3] But where State laws provide that foreign corporations doing business in

jurisdiction to cases where the defendant resides or is found within the district, confer only a personal privilege which may be waived by voluntary appearance or by accepting general conditions which impose a liability to suit, see United States *v.* American Bell Telephone Co. (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That an appearance in order to move to quash or to plead to the jurisdiction does not waive objections thereto, see United States *v.* American Bell Telephone Co. (1886), 29 Fed. Rep. 17 ; 38 O. G. 1237.

That where a defendant appears by attorney and files his plea to the jurisdiction by attorney, this admits and submits to the jurisdiction of the court, and the same result follows from the entry of a special appearance on the order-book at the request of the defendant's attorney without special leave of the court, see Thayer *v.* Wales (1872), 5 Fisher, 448.

That irregularities in service are waived unless objected to before answer, see Goodyear *v.* Chaffee (1855), 3 Blatch. 268.

That the privilege of freedom from service while attending a trial must be insisted on at the proper time or it will be waived, see Matthews *v.* Puffer (1882), 22 O. G. 332 ; 20 Blatch. 233.

§ 935. [1] That a corporation created by State laws resides in all parts of the State, and may be sued in any court whose jurisdiction embraces any part of such State, see Locomotive Engine Safety Truck Co. *v.* Erie Railway Co. (1872), 6 Fisher, 187; 3 O. G. 93 ; 10 Blatch. 292.

[2] That whether a suit can be brought against a corporation outside the district where it is located is doubtful, see Jones *v.* Osgood (1869), 3 Fisher, 591 ; 6 Blatch. 435.

[3] That a Circuit court does not acquire jurisdiction over a corporation organized under the laws of another State by serving process in its district on an officer of the corporation, nor is the objection waived though the corporation appears by attorney and pleads to the jurisdiction, see Decker *v.* New York Belting & Packing Co. (1873), 3 O. G. 441; 6 Fisher, 374.

that State shall appoint certain resident officials upon whom service of process may be made on behalf of the corporation, such corporation is found within that State for all purposes of jurisdiction both of the local and the Federal Courts.[4]

[4] That the Federal courts must decide whether a corporation is so "found" within a district as to be liable to be sued there, see St. Louis Wire Mill Co. *v.* Consolidated Barb Wire Co. (1887), 32 Fed. Rep. 802.

That a foreign corporation transacting business in a State is "found within the State" for the purposes of suit, if it can be served with process under State laws, see Williams & Albright *v.* Empire Transportation Co. (1878), 14 O. G. 523; 3 Bann. & A. 533.

That a corporation is "found" within a State when it has established an office or agency there for carrying on the business for which it was incorporated, see Carpenter *v.* Westinghouse Air Brake Co. (1887), 32 Fed. Rep. 434.

That a Circuit court has no jurisdiction of an action against a corporation organized in another State, unless it carries on business within the district through some agent appointed by and representing the corporation in such district, and would thereby, under the local law, be amenable to suit in such district, as an implied or express condition of its right to do business therein, see Carpenter *v.* Westinghouse Air Brake Co. (1887), 32 Fed. Rep. 434; United States *v.* American Bell Telephone Co. (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

That whether business is carried on is determined by what is done or has been done, not by what the corporation may have power to do, see United States *v.* American Bell Telephone Co. (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

That a corporation does not become an "inhabitant" of a State, nor is it "found there," for service of process merely by owning property there or by the fact that its officers reside there, see Carpenter *v.* Westinghouse Air Brake Co. (1887), 32 Fed. Rep. 434.

That a corporation doing no regular business and having no established agency within the district is not "found" there, simply because it sends there to purchase raw material, see St. Louis Wire Mill Co. *v.* Consolidated Barb Wire Co. (1887), 32 Fed. Rep. 802.

That to supply the means to do business is not the doing of business, see United States *v.* American Bell Telephone Co. (1886), 38 O. G. 1237; 29 Fed. Rep. 17.

That licenses rest on the common law, and a corporation licensor is not domesticated in the district of its licensees any more than any private person would be, see United States *v.* American Bell Telephone Co. (1886), 38 O. G. 1237; 29 Fed. Rep. 17.

That a "managing agent" is one who carries on the corporate business, or a substantial part thereof, see United States *v.* American Bell Telephone Co. (1886), 38 O. G. 1237; 29 Fed. Rep. 17.

That in New York service on the managing agent of a corporation organized in another State is service on a person "found" within the district, see Hat Sweat Mfg. Co. *v.* Davis Sewing Mach. Co. (1887), 31 Fed. Rep. 294.

That a "managing agent" of a foreign corporation need not have control of its entire business in the State, see Hat Sweat Mfg. Co. *v.* Davis Sewing Mach. Co. (1887), 31 Fed. Rep. 294.

That where a foreign corporation is amenable to suit under the local law, it

§ 936. Jurisdiction over Actions at Law where a Circuit Embraces Two or More Districts.

Where a Circuit court or its equivalent tribunal has jurisdiction over two or more districts, each district becomes the local unit of jurisdiction, and the rules hitherto applied to the territorial limits of the circuit are predicable of the district also. Thus a defendant must be sued in his own district or in a district where he can lawfully be served with process. Where there are several joint defendants resident in different districts proceedings may be properly commenced in either.[1] If the area of any district is identical with that of a State, a corporation created by that State is located within that district only and must there be sued, unless under the laws of other States where it does business it is also located within their borders.[2] On the other hand, if the State contains two or more districts, a corporation created by the State is located in all such districts and can be sued in that one which the plaintiff may elect.[3] Where districts are subdivided for judicial purposes, each subdivision forms the local boundary of jurisdiction, within which all defendants must reside or be personally found and served.

§ 937. Plaintiff in Actions at Law Must be the Legal Owner of the Patent at the Date of the Infringement.

With a single exception the plaintiff in an action at law must be the person or persons in whom the legal title to the patent resided at the time of the infringement.[1] An infringe-

may be also sued in the Federal courts for infringement, see Hussey Mfg. Co. *v.* Deering (1884), 28 O. G. 193; 20 Fed. Rep. 795.

§ 936. [1] That if joint infringers are living in different districts, suit may be commenced in either district against the defendant there residing, see Goodyear *v.* Toby (1868), 6 Blatch. 130.

[2] See § 935, notes 3, 4, *ante*.

[3] That where a State has more than one district, and the statute provides that the defendant be sued in his own district, a corporation may be sued in either, for it resides in all, see Locomotive Engine Safety Truck Co. *v.* Erie Railway Co. (1872), 6 Fisher, 187; 3 O. G. 93; 10 Blatch. 292.

§ 937. [1] That the legal title must be in the plaintiff, see Gamewell Fire Alarm Telegraph Co. *v.* City of Brooklyn (1882), 14 Fed. Rep. 255; 22 O. G. 1978.

That no one can sue for damages for infringement except the patentee, the assignee, or the owner of a territorial interest exclusive of the patentee, see Gordon *v.* Anthony (1879), 16 O. G.

ment is an invasion of the monopoly created by the patent, and the law which defines and authorizes this monopoly confers only upon its legal owners the right to institute proceedings for its violation. These owners are the patentee, his assignee, his grantee, or his personal representatives; and none but these are able to maintain an action for infringement in a court of law. Moreover, the injury inflicted by an act of infringement falls upon the individual who owns the monopoly at the date of the infringement.[2] It does not affect former owners whose interest had terminated before the infringement was committed, nor does it so directly prejudice a future owner that the law can recognize his loss and give him a pecuniary redress. Hence the plaintiff must not only have a legal title to the patent, but must have also been its owner at the time of the infringement. The exception above referred

1135; 16 Blatch. 234; 4 Bann. & A. 248; Hill *v.* Whitcomb (1874), 5 O. G. 430; Holmes, 317; 1 Bann. & A. 34.

That owners of patents granted before the act of July 8, 1870, may maintain suits for infringements committed afterwards, see Union Paper Bag Mach. Co. *v.* Newell (1873), 6 Fisher, 582; 11 Blatch. 379.

That where a second original patent has been granted to the same inventor for the same invention, he can sue only on the first patent, see Jones *v.* Sewall (1873), 3 Clifford, 563; 6 Fisher, 343; 3 O. G. 630; Odiorne *v.* Amesbury Nail Factory (1819), 2 Mason, 28; 1 Robb, 300.

That parties equitably interested in the patent need not be joined as plaintiffs, see Graham *v.* McCormick (1880), 11 Fed. Rep. 859; 21 O. G. 1533; 10 Bissell, 39; 5 Bann. & A. 244.

That assignees are indispensable parties, see Nellis *v.* Pennock Mfg. Co. (1882), 22 O. G. 1131; 13 Fed. Rep. 451; 15 Phila. 493.

That one to whom the "exclusive right to the use of the improvement" is transferred for the whole term of the patent, "by way of license and not as a transfer of a title," is the proper plaintiff in equity, see Herman *v.* Herman (1886), 29 Fed. Rep. 92.

[2] That a suit by "a party interested" means one interested in the patent when the infringement was committed, see Moore *v.* Marsh (1868), 7 Wall. 515.

That an interest in the proceeds of a suit for an infringement is not an interest in the patent, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

That suit will lie to recover damages for infringement though the plaintiff assigned his interest in the patent before suit was brought, see Spring *v.* Domestic Sewing Mach. Co. (1882), 22 O. G. 1445; 13 Fed. Rep. 446.

That a patentee may sue an infringer though he has granted an exclusive license to another to make and sell, see Freese *v.* Swartchild (1888), 35 Fed. Rep. 141.

That the legal owner cannot sue the equitable owner for an infringement, see Aspinwall Mfg. Co. *v.* Gill (1887), 40 O. G. 1133; 32 Fed. Rep. 697.

to arises where an assignment of a patent is coupled with an assignment of a right of action for past infringements. In this case the present owner of the monopoly may institute proceedings for its violation during the ownership of his assignor as well as for infringements committed since the transfer of the title to himself.

§ 938. Licensees and Owners of Equitable Interests cannot be Plaintiffs in Actions at Law.

Two classes of persons having interests in patented inventions are, by this rule, debarred from suing for infringement in their own names in courts of law. These are licensees, and those who, under contracts with the legal owners, have acquired an equitable title to the patent. A licensee has no standing in a court of law as plaintiff in an action for infringement.[1] He does not own the monopoly or any part thereof, however widely the interest transferred to him in the invention may estop the owner of the patent from asserting the monopoly against him. Though possessing an exclusive territorial right to sell the invention, or an exclusive right to use it for a special purpose, or an exclusive right to use it and to license others to use it for a definite period of time, or an exclusive right to make the manufacture or machine in which it is contained, and though protected by a guaranty from his licensor, which guaranty his licensor and others are jointly violating, he is still only a mere licensee, and whatever relief equity may be able to afford him, a court of law cannot regard him as entitled to vindicate the monop-

§ 938. [1] In Birdsell *v.* Shaliol (1884), 112 U. S. 485, Gray, J.: (486) "A licensee of a patent cannot bring a suit in his own name, at law or in equity, for its infringement by a stranger. An action at law for the benefit of the licensee must be brought in the name of the patentee alone." 30 O. G. 261 (261).

See also Bogart *v.* Hinds (1885), 33 O. G. 1268; 25 Fed. Rep. 484; Wilson *v.* Chickering (1883), 14 Fed. Rep. 917; 23 O. G. 1730; Union Paper Bag Mach. Co. *v.* Nixon (1882), 105 U. S. 766; 21 O. G. 1275; Gamewell Fire Alarm Telegraph Co. *v.* Brooklyn (1882), 22 O. G. 1978; 14 Fed. Rep. 255; Nellis *v.* Pennock Mfg. Co. (1882), 22 O. G. 1131; 13 Fed. Rep. 451; 15 Phila. 493; Ingalls *v.* Tice (1882), 22 O. G. 2160; 14 Fed. Rep. 297, and other cases cited in note 2, *post.*

That the non-joinder of licensees is no ground of abatement, see Forbes *v.* Barstow Stove Co. (1864), 2 Clifford. 379.

oly against its infringers.[2] Suits at law for the redress of injuries committed by infringement against licensees must be brought in the name of the real owner of the patent.[3] It is a part of the implied agreement between a licensor and licensee that the former will protect the latter against these wrongful invasions of his rights by instituting such proceedings as may become necessary for that purpose, and if the legal owner of the monopoly refuses to perform this duty, or is inaccessible, the licensee may sue at law for damages in his name.[4] A

[2] That a licensee having an exclusive right to sell for certain territory is not a proper plaintiff in infringement suits, but only the owner of the patent, see Ingalls *v.* Tice (1882), 22 O. G. 2160; 14 Fed. Rep. 297.

That a patentee, having transferred an exclusive right to use the invention for a particular purpose, is the only proper plaintiff, see Blanchard *v.* Eldridge (1849), 1 Wall. Jr. 337; 2 Robb, 737.

That a patentee having granted an exclusive right to use and to license others to use for five years has still a right to sue for infringements, see Still *v.* Reading (1881), 4 Woods, 345; 20 O. G. 1025; 9 Fed. Rep. 40.

That a suit at law to protect the licensee in his right to use a patented process for a particular manufacture should be brought in the name of the patentee, see Goodyear *v.* Bishop (1860), 2 Fisher, 96; 4 Blatch. 438.

That the owner of a patent having granted a license and agreed not to license any one else, and reserving a right to one half the damages for infringement, is a necessary party to a suit for infringement, see North *v.* Kershaw (1857), 4 Blatch. 70.

That the owner of a right to use and sell, but not to make, is a mere licensee and cannot sue, though protected by a guaranty from the patentee, and though the patentee with third parties are the infringers, see Hill *v.* Whitcomb (1874), 5 O. G. 430; Holmes, 317; 1 Bann. & A. 34.

[3] That the patentee may sue in behalf of the licensee, see Goodyear *v.* McBurney (1853), 3 Blatch. 32.

That a licensee can sue for infringement in the name of his licensor, see Birdsell *v.* Shaliol (1884), 112 U. S. 485; 30 O. G. 261; Wilson *v.* Chickering (1883), 14 Fed. Rep. 917; 23 O. G. 1730; Nellis *v.* Pennock Mfg. Co. (1882), 22 O. G. 1131; 13 Fed. Rep. 451; 15 Phila. 493; Union Paper Bag Mach. Co. *v.* Nixon (1882), 105 U. S. 766; 21 O. G. 1275; Gamewell Fire Alarm Telegraph Co. *v.* City of Brooklyn (1882), 22 O. G. 1978; 14 Fed. Rep. 255; Nelson *v.* McMann (1879), 16 O. G. 761; 16 Blatch. 139; 4 Bann. & A. 203; Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964; Potter *v.* Wilson (1860), 2 Fisher, 102; Gayler *v.* Wilder (1850), 10 How. 477.

That a licensee can sue only for infringements which affect his own rights under the patent, see Hayward *v.* Andrews (1883), 106 U. S. 272; 23 O. G. 533.

[4] That a stipulation by the licensor to sue infringers does not compel the licensees to look to him on his covenants, but they may institute suits in his name against infringers, see Goodyear *v.* Bishop (1860), 2 Fisher, 96; 4 Blatch. 438.

That if the owner of the patent will not sue or cannot be found, the licensee

suit thus brought is under the control of the licensee, and though the nominal plaintiff may claim indemnity against the costs and expenses of the suit, he cannot discontinue it or settle with the infringer in derogation of the rights of the real party in interest.[5] This privilege does not extend to the personal representatives of licensees, the license and all obligations under it, except those of contract, expiring at the death of the licensee.[6] To equitable owners of the patent, or of interests therein, relief can be afforded only in a court of equity.[7]

may use his name in a suit at law, and probably in equity also, see Wilson *v.* Chickering (1883), 14 Fed. Rep. 917; 23 O. G. 1730.

That the patentee is not obliged to sue after an assignment of his rights, see Bicknell *v.* Todd (1851), 5 McLean, 236.

[5] In Miller *v.* Liggett & Myers Tobacco Co. (1881), 7 Fed. Rep. 91, McCrary, J.: (92) "I think that a party who contributes money for the purpose of employing counsel and carrying on a litigation, under a contract with a party to the record, must of necessity be held to have the right to take such action in the case as will protect his own interest in it. As, for example, suppose there is a case which is understood to be a test case, involving the validity of a patent, or anything else, against a particular individual, but involving a subject-matter concerning which a large number of other persons are equally interested with the particular defendant in that case, and suppose all the parties who are interested, or a number of them, come together, enter into a contract that they will raise a fund to carry on that litigation, that they will unite for the purpose of employing counsel, and combine to carry it on in the name of the party to the record,— it seems to me that the persons, who under such a contract as that actually contribute money for the purpose of carrying on a suit, are authorized to go into that court and use the name of the party to the record in making such motions, and taking such steps as are necessary for the protection of their particular interest in it." 2 McCrary, 375 (377); 19 O. G. 1138 (1139).

That a nominal plaintiff cannot discontinue the suit brought to protect his licensee, and if he does so the real parties in interest will be permitted to make their rights apparent, see Goodyear *v.* Bishop (1860), 2 Fisher, 96; 4 Blatch. 438; Goodyear *v.* McBurney (1860), 3 Blatch. 32.

That a nominal plaintiff may claim indemnity against costs, see Goodyear *v.* Bishop (1860), 2 Fisher, 96; 4 Blatch. 438.

[6] That the executor of a licensee cannot sue for infringement in the name of the licensor, the license being personal and expiring at the death of the licensee, see Oliver *v.* Rumford Chemical Works (1883), 109 U. S. 75; 25 O. G. 784.

[7] In Sanford *v.* Messer (1872), 5 Fisher, 411, Shepley, J.: (413) "Unquestionably a contract for a purchase of a portion of the patent right may be good as between the parties as a license, and enforced as such in the courts of justice; but the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it." Holmes, 149 (150); 2 O. G. 470 (471).

§ 939. Patentee when Plaintiff in Actions at Law.

The primary legal owner of a patent is the patentee, and until it is assigned or granted by him, or at his death is vested in his administrator or executor, all suits at law upon it must be brought in his name alone.[1] After he has transferred it he may still maintain an action for infringements committed during his ownership, and if the transfer covers only an undivided interest he must join with the transferee in suits arising out of subsequent infringements.[2] A patentee who has conveyed his patent and afterward regained it may sue for violations of the monopoly during either period of his ownership, but not for those committed while the patent was the property of others.[3] In suits on a joint patent all the

§ 939. [1] That a patent once granted expire, may maintain a suit to protect their interests, see Freese *v.* Swartchild (1888), 35 Fed. Rep. 141; Otis Bros. Mfg. Co. *v.* Crane Bros. Mfg. Co. (1886), 27 Fed. Rep. 550; Still *v.* Reading (1881), 20 O. G. 1025; 9 Fed. Rep. 40; 4 Woods, 345.

That a patentee and licensor should be joined with the assignee of the licensor in a suit against the licensee if he is still interested in the patent, see Woodworth *v.* Cook (1850), 2 Blatch. 151.

That a former owner of the patent who has sold it, reserving certain special uses, is not a proper party plaintiff, see Frankfort Whiskey Process Co. *v.* Pepper (1885), 26 Fed. Rep. 336.

That the former owner of the patent may sue, after he has assigned it, for infringements committed against him during his ownership, see Moore *v.* Marsh (1868), 7 Wall. 515.

That no legal title exists in any one until the patent issues, see Pontiac Knit Boot Co. *v.* Merino Shoe Co. (1887), 31 Fed. Rep. 286.

That a patentee is presumed to be the owner of the patent if no assignment is alleged or proved, see Fischer *v.* Neil (1881), 6 Fed. Rep. 89; 19 O. G. 603.

That a patentee having contracted to sell portions of his right still owns the patent, and he alone can sue for infringement, see Wheeler *v.* McCormick (1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334; Sanford *v.* Messer (1872), 5 Fisher, 411; 2 O. G. 470; Holmes, 149; Park *v.* Little (1813), 3 Wash. 196; 1 Robb, 17.

[2] That a patentee, excluded from certain business in certain places, may nevertheless maintain suit for the use of his invention by others in such places, see Colgate *v.* International Ocean Telegraph Co. (1879), 17 O. G. 194; 17 Blatch. 308; 4 Bann. & A. 609.

That patentees, having reversionary interests after those of their grantees

That a former owner of the patent who has sold it, reserving certain special uses, is not a proper party plaintiff, see Frankfort Whiskey Process Co. *v.* Pepper (1885), 26 Fed. Rep. 336.

That the former owner of the patent may sue, after he has assigned it, for infringements committed against him during his ownership, see Moore *v.* Marsh (1868), 7 Wall. 515.

[3] That a patentee taking a release of all outstanding rights may sue in his own name for all future, but not for past, infringements, see Wheeler *v.* McCormick (1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334.

That a patentee cannot recover for damages arising since he assigned the patent, see Wheeler *v.* McCormick

patentees must be made plaintiffs, and the same rule applies in all cases of joint-ownership whether of assignees, grantees, or representatives.[4] That one of the joint owners has conveyed his interest in the patent since the infringement does not dispense with the necessity of joining him as plaintiff in a suit therefor.[5]

§ 940. Assignee when Plaintiff in Actions at Law.

An assignee of the entire interest in the patented invention must sue alone for any infringement committed during his sole ownership.[1] It is immaterial whether the assignment was made before or after the issue of the patent, provided the legal title of the assignee has been perfected as the law requires; but while the title remains imperfect, or resides in contract only, a court of law cannot take cognizance of any action brought by the assignee in his own name.[2] The motive of the assignment is also of no consequence,—it being sufficient that the legal title is duly vested in him.[3] An assignee of an

(1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334.

[4] That joint patentees and all other co-owners must be made plaintiffs, see Moore *v.* Marsh (1868), 7 Wall. 515; Stein *v.* Goddard (1856), 1 McAllister, 82; Whittemore *v.* Cutter (1813), 1 Gallison, 429; 1 Robb, 28.

[5] That one of two joint owners of a patent having assigned his interest after infringement, both may still sue at law for the injury, and no equitable interference is required, see Spring *v.* Domestic Sewing Mach. Co. (1882), 22 O. G. 1445; 13 Fed. Rep. 446.

§ 940. [1] That the assignee of the entire monopoly may sue in his own name, see Nellis *v.* Pennock Mfg. Co. (1882), 13 Fed. Rep. 451; 15 Phila. 493; 22 O. G. 1131; Moore *v.* Marsh (1868), 7 Wall. 515.

That an assignee can maintain a suit at law or in equity without joining the patentee, see Brooks *v.* Bicknell (1843), 3 McLean, 250; 2 Robb, 118.

That an assignee can sue in his own name only by force of the statute, see Suydam *v.* Day (1846), 2 Blatch. 20.

[2] That where an assignment was made before the patent was granted only the assignee can sue for infringements, see Herbert *v.* Adams (1825), 4 Mason, 15; 1 Robb, 505.

That an assignee before patent, with request that the patent issue to him, may sue in his own name though the patent actually issued to the inventor, see Consolidated Electric Light Co. *v.* McKeesport Electric Light Co. (1888), 34 Fed. Rep. 335; Consolidated Electric Light Co. *v.* Edison Electric Light Co. (1885), 25 Fed. Rep. 719; 23 Blatch. 412; 33 O. G. 1597.

[3] That an assignee may sue, no matter what may have been the motive for the assignment, see Seibert Cylinder Oil Cup Co. *v.* Phillips Lubricator Co. (1882), 10 Fed. Rep. 677.

undivided interest cannot sue alone, but must join his co-owners; and where an assignment is conditional, and interests of the assignor are liable to be affected by the suit, he must be made a party also, or if this is impracticable under the rules of pleading, recourse must be had to equity in which the rights of all parties can be secured.[4] An assignee in trust, though not entitled to the proceeds of the suit, is nevertheless the proper plaintiff until the trust has been fulfilled.[5]

§ 941. Grantee, when Plaintiff in Actions at Law.

The grantee of an exclusive territorial interest in the patented invention must sue alone for any infringement committed within his territory.[1] Under our earliest statutes grantees were not regarded as real owners of any part of the monopoly, and, therefore, could not sue at law for an infringement of the patent.[2] Since that power was conferred upon them, the close resemblance between many licenses and grants has caused some difficulty in determining whether given suits

[4] In Moore *v.* Marsh (1868), 7 Wall. 515, Clifford, J.: (520) "Where the patentee has assigned his whole interest, either before or after the patent is issued, the action must be brought in the name of the assignee, because he alone was interested in the patent at the time the infringement took place; but where the assignment is of an undivided part of the patent, the action should be brought for every infringement, committed subsequent to the assignment, in the joint names of the patentee and assignee, as representing the entire interest."

See also Stein *v.* Goddard (1856), 1 McAllister, 82; Whittemore *v.* Cutter (1813), 1 Gallison, 429; 1 Robb, 28.

That unless an assignment is absolute and unconditional and passes the legal title, the interests of the assignor may be affected by the suit, and he is a necessary party to it, see Cook *v.* Bidwell (1879), 20 O. G. 1083; 8 Fed. Rep. 452.

[5] That pending a trust conveyance to the plaintiff, he may bring suit for infringement, having a title in him, see Campbell *v.* James (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

That the receiver of a corporation in Pennsylvania has no title to its patents, and cannot sue thereon in his own name, see Dick *v.* Struthers (1885), 34 O. G. 131; 25 Fed. Rep. 103.

§ 941. [1] That a grantee may sue alone for an infringement in territory where his right is exclusive, see Hobbie *v.* Smith (1886), 27 Fed. Rep. 665; Moore *v.* Marsh (1868), 7 Wall. 515; Gayler *v.* Wilder (1850), 10 How. 477.

That where a grantee never performs the conditions of his grant or avails himself of it, but recognizes his grantor's exclusive rights, the grantor may sue for infringement in that territory after the grantee's death without naming him, see Railroad Co. *v.* Trimble (1870), 10 Wall. 367.

[2] That territorial grantees cannot sue under the act of 1793, Secs. 4 and

were properly instituted, and this difficulty is likely to continue as long as ambiguous agreements and conveyances afford room for doubt as to their true legal effect. But where the transferee is an actual grantee, as distinguished from a licensee, his right to sue for violations of the monopoly within his territory is as well established as that of an assignee.[3] Joint grantees like joint assignees must unite as plaintiffs in an action for infringement.

§ 942. Personal Representatives of Deceased Owner when Plaintiffs in Actions at Law.

The personal representatives of the deceased owner of a patent must be the plaintiffs in an action for infringement committed either during their own ownership or that of their decedent. The heirs or devisees, though beneficially entitled to the proceeds of the suit, are mere *cestuis que trust* and cannot appear as plaintiffs in a court of law.[1] Where there are several executors, some of whom take no part in the administration of the estate, those who act should be sole plaintiffs; and where a patent issues or re-issues to one of several executors, he only has the legal title and can maintain a suit

5, not being true assignees, see Tyler *v.* Tuel (1810), 6 Cranch. 324; 1 Robb, 14.

That the grantee of an exclusive territorial right could maintain a suit in equity in his own name under the act of 1793, whether he could at law or not, see Ogle *v.* Ege (1826), 4 Wash. 584; 1 Robb, 516.

[3] In Hill *v.* Whitcomb (1874), 5 O. G. 430, Shepley, J.: (431) "To enable the purchaser to sue, the assignment must undoubtedly convey to him the entire aud unqualified monopoly which the patentee held in the territory specified, excluding the patentee himself as well as others. Any assignment short of this is a mere license, and the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it."

1 Bann. & A. 34 (36); Holmes, 317 (321).

That a grantee of all right, title, and interest within certain territory may sue for infringement, see Perry *v.* Corning (1870), 7 Blatch. 195.

That an assignee of an exclusive right to use, but not to make, the invention within certain territory may sue an infringer in his own name, see Chambers *v.* Smith (1870), 5 Fisher, 12.

That the assignee of an exclusive territorial right to use two machines can sue in his own name even against the patentee, see Wilson *v.* Rousseau (1846), 4 How. 646; 2 Robb, 372.

§ 942. [1] That the next of kin are not to be joined with the executor or administrator as plaintiffs in a suit for an infringement or an account, see Hodge *v.* North Missouri R. R. Co. (1869), 4 Fisher, 161; 1 Dillon, 104.

thereon.[2] An administrator or executor can sue in any district without qualifying in the probate courts of the State in which the district is comprised, his relation to the patented invention being that of a trustee under the acts of Congress, and not dependent upon any local law.[3]

§ 943. Assignee of Claim for Past Infringements, when Plaintiff in Actions at Law.

The law permits the owner of a patent who has been injured by its infringement to assign his right of action for

[2] That where one alone of several executors of the patentee acts, he alone can sue at law for infringement, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

That when a patent issues or reissues to one of several executors, he is the sole patentee and the others need not join in the suit though the damages when recovered belong to the estate, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 788; Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351.

[3] In Goodyear *v.* Hullihen (1867), 3 Fisher, 251, Jackson, J.: (253) "It does not appear to me that this point is well taken; the reasons which exist for requiring an administrator, in ordinary cases, to qualify in the State in which he sues, do not apply to suits brought by an administrator to whom a patent has been granted for the invention of his intestate, for infringement of the rights thus granted. Under the act of Congress patents are granted, in case of the decease of the inventor, to 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 (act of July 4, 1836, § 10); and re-issues are also granted to the executor or administrator (act of July 4, 1836, § 13). In such cases the administrator is a trustee holding the legal title, and the patent is not assets in his hands belonging to the personal estate of the intestate, but is a franchise granted to the administrator for the benefit of the heirs-at-law or devisees of the deceased inventor. There is, therefore, no reason for requiring him to qualify in this State; besides which, the question may be considered as set at rest by the authority of the following cases, cited in argument by complainant's counsel: 'It is not necessary in an action by an administrator that he should produce his letters of administration. The patent being renewed to him, as administrator, is proof that he had satisfied the officer authorized to grant a renewal of his being administrator, and it is not competent for the court to go behind that decision.' Woodworth *v.* Hall, 1 W. & M. 254. 'An administrator of a patentee, residing in one State, may commence an action i the United States Circuit Court of another State for the recovery of damages for an infringement of a patent, without taking out letters of administration in the latter State.' Smith *v.* Mercer, 5 Penn. Law Jour. 531." 2 Hughes, 492 (495).

See also Hodge *v.* North Missouri R. R. Co. (1869), 4 Fisher, 161; 1 Dillon, 104.

such injury in conjunction with an assignment of the patent, and thus to transfer to the assignee not only the monopoly itself, but also the power to recover compensation for its past infringements.[1] These assignments must expressly include the right of action,[2] and are made subject to all the equities existing between the alleged infringer and the assignor.[3] The right of action cannot be conveyed separately from the patent, since this would confer the ability to sue for an infringement on other persons than those named in the statute as the legal owners of the monopoly.[4] An assignee of this character may maintain an action in his own name for these infringements

§ 943. [1] That a right to damages for past infringements is assignable, see Hamilton *v.* Rollins (1877), 3 Bann. & A. 157 ; 5 Dillon, 495.

That an assignment of a right to sue for the profits of an infringement is not an assignment of unliquidated damages, see Jenkins *v.* Greenwald (1857), 2 Fisher, 37 ; 1 Bond, 126.

That a right of action for past infringements vests in the administrator of the patentee, and may be sued on or assigned by him, see May *v.* County of Logan (1887), 30 Fed. Rep. 250 ; 41 O. G. 1387.

[2] That an assignment of a right of action for past injuries must be clearly expressed, see Emerson *v.* Hubbard (1888), 34 Fed. Rep. 327 ; Knowlton Platform & Car Coupling Co. *v.* Cook (1879), 70 Me. 143.

That the mere assignment of the patent does not transfer the right to sue for past infringements, see Kaolatype Engraving Co. *v.* Hoke (1887), 30 Fed. Rep. 444 ; 39 O. G. 589 ; May *v.* Juneau Co. (1887), 30 Fed. Rep. 241 ; 41 O. G. 578 ; N. Y. Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 18 Fed. Rep. 638 ; 25 O. G. 1076 ; 21 Blatch. 519 ; Merriam *v.* Smith (1882), 11 Fed. Rep. 588.

That the assignment of a patent by an administrator does not cover claims for past infringements, especially where only a nominal price is paid by the assignee, see May *v.* Juneau Co. (1887), 30 Fed. Rep. 241 ; 41 O. G. 578.

That the assignment of "all right, title, interest, claims, and demands whatsoever which the estate has in, to, by, under, and through" letters-patent carries rights of action for past infringement, see May *v.* Logan Co. (1887), 30 Fed. Rep. 250 ; 41 O. G. 1387.

That the assignee of claims for damages must allege and prove an assignment of such claims themselves, see New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 18 Fed. Rep. 638 ; 25 O. G. 1076 ; 21 Blatch. 519.

[3] That the assignee of damages for past infringements takes his title subject to all the equities against the assignors, see New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 18 Fed. Rep. 638 ; 25 O. G. 1076 ; 21 Blatch. 519.

That laches of an assignor of rights of action binds his assignee, see New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1885), 24 Fed. Rep. 604 ; 32 O. G. 1356.

[4] That a claim for past infringements cannot be severed from the title to the patent by assignment so as to give a right of action contrary to the statutes, see Gordon *v.* Anthony (1879), 16 O. G. 1135 ; 16 Blatch. 234 ; 4 Bann. & A. 248.

under the former owner, either during the life of the patent or after it has expired.[5] Transfers of title and of rights of action, *pendente lite*, do not affect the litigation unless the interests of the parties may require it, but notice of such transfer must be given to the defendant or he will be protected in his *bona fide* payments to the record plaintiff.[6]

§ 944. Plaintiff in Actions at Law must Sue in His Own Name.

The proper plaintiff in an action for infringement must institute the suit in his own name, according to the character imposed upon him by the local law.[1] Persons *sui juris* appear as the assertors of their legal rights. Married women must sue alone or jointly with their husbands, and infants by guardian or otherwise, as the State legislation fixing their capacity may indicate.[2] A corporation sues by its corporate

[5] That an assignee of a patent and of all claims for past infringements may sue at law or for an injunction in his own name, see May *v.* Logan Co. (1887), 30 Fed. Rep. 250; 41 O. G. 1387; Adams *v.* Bellaire Stamping Co. (1885), 25 Fed. Rep. 270; 33 O. G. 623; Spring *v.* Domestic Sewing Mach. Co. (1882), 22 O. G. 1445; 13 Fed. Rep. 446; Merriam *v.* Smith (1882), 11 Fed. Rep. 588; Campbell *v.* James (1880), 2 Fed. Rep. 338; 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354.

That in a suit at law, after a patent has expired, if the assignment does not cover claims for past infringements, the assignors must be joined as plaintiffs, see Adams *v.* Bellaire Stamping Co. (1885), 25 Fed. Rep. 270; 33 O. G. 623.

That where the plaintiff, when the suit begins, owns the patent and the entire interest in the claim for past infringements, he may recover for the infringements committed before he owned the patent, see Consolidated Oil Well Packer Co. *v.* Eaton, Cole, & Burnham Co. (1882), 12 Fed. Rep. 865.

[6] In Campbell *v.* James (1880), 18 O. G. 1111, Wheeler, J.: (1113) "Conveyances *pendente lite* do not at all affect the litigation as between the parties to the original controversy unless there are special statutes or circumstances to control; but courts of justice, even courts of law, and especially courts of equity, often protect the rights of the real owners to the fruits of a recovery as against those who are nominal but not real owners whenever their rights may have been acquired." 2 Fed. Rep. 338 (345); 18 Blatch. 92 (98); 5 Bann. & A. 354 (361).

That on an assignment of a claim pending suit notice must be given to the defendant that he may not pay the wrong party, see Gear *v.* Fitch (1878), 16 O. G. 1231; 3 Bann. & A. 573.

§ 944. [1] That the local law may determine who the real party in interest is, see Lorillard *v.* Standard Oil Co. (1880), 17 O. G. 1507; 18 Blatch. 199; 2 Fed. Rep. 902; 5 Bann. & A. 432.

[2] That in New York a married woman may sue alone in her own name for an infringement, she being by the State law a *feme sole* as to such matters,

name as determined by its charter, and an unincorporated association in the names of its individual members.[3] No plaintiff can commence or prosecute a suit in the name of his attorney or any other delegate.[4]

§ 945. Non-joinder or Misjoinder of Plaintiffs in Actions at Law.

Objections for the non-joinder or misjoinder of plaintiffs are not favored by the courts where the plaintiffs of record have a legal title, and must be made in due season or they cannot be regarded.[1] A misjoinder cannot be noticed after a final judgment in the Supreme Court of the United States.[2] A non-joinder is cured by a disclaimer of title, on the part of the alleged omitted parties, in favor of the actual plaintiffs.[3]

see Lorillard *v.* Standard Oil Co. (1880), 2 Fed. Rep. 902; 17 O. G. 1507; 18 Blatch. 199; 5 Bann. & A. 432.

[3] That in Pennsylvania the receiver of a corporation has no title to its property, and cannot sue on its letters-patent, see Dick *v.* Struthers (1885), 25 Fed. Rep. 103; 34 O. G. 131; Dick *v.* Oil Well Supply Co. (1885), 25 Fed. Rep. 105.

That the suit of an unincorporated company should be prosecuted in the names of the individual parties, not the company, see Metal Stamping Co. *v.* Crandall (1880), 18 O. G. 1531.

[4] In Goldsmith *v.* American Paper Collar Co. (1880), 18 Blatch. 82, Blatchford, J.: (83) "The party in interest must bring the suit, whether at law or in equity, in his own name, and cannot delegate the right to another person to bring the suit in the name of such other person when the suit is not for the benefit in any way of such other person. It is a question of public policy. The defendant has a right to require that the real owner or party in interest shall be in court, so that the court may exercise a control over him in the course of the suit, if necessary, to require him to do something which the rights of the defendant may require to be done." 18 O. G. 192 (192); 2 Fed. Rep. 239 (240); 5 Bann. & A. 300 (301).

See also Lorillard *v.* Standard Oil Co. (1880), 17 O. G. 1507; 2 Fed. Rep. 902; 18 Blatch. 199; 5 Bann. & A. 432.

§ 945. [1] That in equity an objection for non-joinder of plaintiffs is not favored if any of the parties to the suit have a legal title, see Graham *v.* McCormick (1880), 11 Fed. Rep. 859; 21 O. G. 1533; 10 Bissell, 39; 5 Bann. & A. 244; Graham *v.* Geneva Lake Crawford Mfg. Co. (1880), 11 Fed. Rep. 138; 21 O. G. 1536.

That an objection for non-joinder may be waived either at law or in equity, see Adams *v.* Howard (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

[2] That a misjoinder of parties cannot be objected to after final decree and in the Supreme Court, see Livingston *v.* Woodworth (1853), 15 How. 546.

That defect of parties cannot be urged after a hearing on the merits, unless they are indispensable to a decree, see Adams *v.* Howard (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

[3] That a disclaimer of title in favor of the plaintiffs by persons not joined will cure the non-joinder, see Graham *v.* Geneva Lake Crawford Mfg. Co. (1880), 11 Fed. Rep. 138; 21 O. G. 1536.

§ 946. Defendant in Actions at Law must be the Person Guilty of the Act of Infringement.

Any person who has been guilty of an act of infringement may be made a defendant in an action at law. An act of infringement is committed by making, using, or selling the patented invention without authority from the owner of the patent; or by employing others to make, use, or sell it for the benefit of the employer; or by accepting and enjoying the direct advantage flowing from the infringement; or by acting in complicity with others under any cover or pretence the practical effect of which is an invasion of the monopoly created by the patent.[1] All who perform or who unite in the performance of an act of infringement, by any of these methods, may be sued jointly or severally at the option of the plaintiff, provided they can lawfully be served with process in the territory over which the court has local jurisdiction.[2]

§ 947. All Infringers Liable as Defendants in Actions at Law.

No exemption from this liability to suit exists in favor of any person on the ground of infancy, lunacy, or coverture.[1] The government of the United States when practising a patented invention without permission from its lawful owner, though not technically guilty of an act of infringement or capable of being reached by ordinary process, may be sued in the Court of Claims for compensation in pursuance of the Federal statutes enacted for that purpose.[2] An officer of

§ 946. [1] See §§ 897–921 and notes, *ante*.

That infringements by the maker and the user are separate trespasses, see Blake *v.* Greenwood Cemetery (1883), 16 Fed. Rep. 676; 25 O. G. 89; 21 Blatch. 222.

[2] See §§ 947, 948, and notes, *post*.

That where defendants are jointly sued their relation to each other should be stated in the declaration, see Shickle *v.* South St. Louis Foundry Co. (1884), 22 Fed. Rep. 105.

That where several parties infringe, some by making and the others by selling, the wrongs are both joint and several, and judgment can be obtained against each, though there can be only one satisfaction, see Jennings *v.* Dolan (1887), 29 Fed. Rep. 861; 38 O. G. 1018.

§ 947. [1] That infants, married women, and lunatics are liable for damages for infringement, see § 921 and notes, *ante*.

[2] That the United States is liable, see § 910 and notes, *ante*, and § 1258 and notes, *post*.

the government infringing a patent in its service cannot be made defendant in an action for infringement when the judgment in such action would indirectly be a judgment against the United States, but he may be sued upon his personal account if his act of infringement has arisen from his own volition or has redounded to his individual benefit.[3] Cities and other true municipal or private corporations are liable to actions for the infringements of their officers or agents, whether these were previously authorized or subsequently ratified by them; and with them may be joined as co-defendants such officers and agents when they have directed, or have voluntarily performed, or have immediately and personally profited by, the infringing act.[4] All private individuals not acting under lawful obedience to their superiors are also liable to suit for their invasions of the monopoly, whether they are part owners, licensees, or strangers to the patent.[5] The amenability of an infringer to another court, or upon different proceedings, is no bar to a suit against him for the infringement in a court of law.[6]

§ 948. Non-joinder and Misjoinder of Defendants in Actions at Law.

The misjoinder or non-joinder of defendants is immaterial unless the act of alleged infringement was inseparable and could not have been performed by the record defendants alone, — in which case the plaintiff may fail in his cause through inability to prove his allegations. As in other actions of tort, persons improperly joined as defendants may have a verdict and recover costs, while the plaintiff may

[3] That government officials are liable, see § 910 and notes, *ante*.

[4] That corporations, their officers and agents, are liable, see §§ 911, 912, and notes, *ante*.

[5] That all private infringers are liable, see §§ 913-921 and notes, *ante*.

[6] That a defendant who has violated an injunction and is liable for contempt may still be sued for infringement, see Roemer *v.* Neumann (1885), 23 Fed. Rep. 447.

That a party who elects to take a judgment for the profits cannot have an action for damages for the same infringement while the former judgment is unreversed, since only one action will lie for a given tort if the damages can be ascertained in one, see Child *v.* Boston & Fairhaven Iron Works (1884), 19 Fed. Rep. 258.

prevail against the actual infringers.[1] No obligation rests upon the plaintiff to join all the defendants in one action. Like all wrong-doers each is liable for the entire loss occasioned by the infringement, and judgment may be obtained against each successively in different suits or against all collectively in one.[2] The plaintiff can, however, have but one satisfaction, and when he has received full compensation for his injury from one or more of the defendants, the judgments in all subsequent proceedings are restricted to the amount of taxable costs.[3] The death of a defendant does not abate the action, nor does his bankruptcy or the marriage of a *feme sole* defendant affect the suit, except to introduce new parties to the record.[4]

§ 949. Process in Actions at Law: The Declaration: Allegation of Inventive Act.

The process in an action at law for infringement does not differ from that employed in the Federal courts, within the district, to secure the appearance of the defendant in other civil actions. The declaration must contain all the averments which are necessary to support the evidence of the plaintiff's right and its violation.[1] Of these essential averments there

§ 948. [1] That a plaintiff may prove infringement against one of several defendants and recover against him alone, see Reutgen *v.* Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

[2] That non-joinder of defendants is no defence by joint infringers since each is liable for all, see Wallace *v.* Holmes, Booth, & Haydens (1871), 1 O. G. 117; 5 Fisher, 37; 9 Blatch. 65.

That whether joint infringers *must* be joined even in equity is doubtful, see Goodyear *v.* Toby (1868), 6 Blatch. 139.

[3] That recovery and satisfaction against one joint tort-feasor is a bar to a recovery against the others, except as to the costs in pending suits, see Sheldon *v.* Kibbe (1819), 3 Conn. 214.

That recovery from one tort-feasor is no bar to a suit against the others unless the judgment is satisfied or released, see American Bell Telephone Co. *v.* Albright (1887), 32 Fed. Rep. 287.

[4] That a suit survives against a deceased infringer's estate, see Kirk *v.* DuBois (1886), 37 O. G. 102; 28 Fed. Rep. 460; Smith *v.* Baker's Admr. (1874), 10 Phila. 221; 1 Bann. & A. 117; 5 O. G. 496.

§ 949. [1] That the allegations of the declaration must be as broad as the evidence needed to establish the plaintiff's right to recover, see Stanley *v.* Whipple (1839), 2 McLean, 35; 2 Robb, 1.

That an ordinary declaration on the case is sufficient, see May *v.* Mercer Co. (1887), 41 O. G. 815; 30 Fed. Rep. 246.

are five: (1) The invention of the patentable subject-matter by the patentee or his assignor; (2) The grant of letters-patent covering the invention; (3) The legal title of the plaintiff; (4) The infringement by the defendant; (5) The resulting damage to the plaintiff. Under the first averment the plaintiff must allege the performance of an inventive act on the part of the patentee or his assignor, producing a new and useful art or article not before known or used in this country, and not in public use or on sale more than two years before his application for a patent.[2] The date of this inventive act need not be stated, if it appears to have preceded that of the application.[3] The art or article may be described in this averment by the title given to it in the patent.[4] Though it is customary to allege the citizenship of the patentee it is not generally held to be essential.[5]

§ 950. The Declaration: Allegation of Grant of Letters-Patent.

Under the second averment the plaintiff must allege and describe the application of the inventor for a patent, its allowance by the Patent Office, and the issue of letters-patent thereon, specifying the nature of the invention which it purports to protect and making profert of the patent.[1] The compliance of the applicant with the preliminary requirements or of the officials of the department with their prescribed duties need not be stated, these being presumed from the

[2] That the declaration must tender an issue upon every point essential to the patentability of the invention, see Wilder *v.* McCormick (1846), 2 Blatch. 31; Gray *v.* James (1817), Pet. C. C. 476; 1 Robb, 140.

[3] That the declaration need not aver the date when the invention was made, except that it was before the application, nor allege the taking of the required preliminary steps, all these being presumed from the grant of the patent, see Wilder *v.* McCormick (1846), 2 Blatch. 31.

[4] That in averring the patentability of the invention it need not be particularly set forth, see Turrell *v.* Cammerer (1868), 3 Fisher, 462; Gray *v.* James (1817), Pet. C. C. 476; 1 Robb, 140.

[5] That citizenship is not in issue though alleged, see Fischer *v.* Neil (1881), 19 O. G. 603; 6 Fed. Rep. 89.

§ 950. [1] That the declaration must set out the attestation of the President, and allege that the patent was delivered, or it may be demurred to, see Cutting *v.* Myers (1818), 4 Wash. 220; 1 Robb, 159.

That the declaration must allege the improvement and show in what it consists, see Peterson *v.* Wooden (1843), 3 McLean, 248; 2 Robb, 116.

grant of the patent.[2] Nor is it necessary that the claims and specifications of the patent be set out at length, although it may be done, since the profert of the patent makes it part of the declaration when it is afterwards produced.[3] The patent should be indicated by its date and number, and if it be a re-issued patent its history should be traced by a recital of the grant of the original and intermediate re-issues as well as of the one on which the suit is brought.

§ 951. The Declaration: Allegation of Legal Title of the Plaintiff.

Under the third averment the exact legal title of the plaintiff must be set forth with certainty, as it appears or can be made to appear upon the records of the Patent Office.[1] If the plaintiff is the original inventor and patentee, this averment may consist of the simple affirmation that he is still the owner of the patent.[2] If he is an assignee of the inventor before patent, and by virtue of such assignment received the patent

[2] That the declaration need not aver that the preliminary steps to the issue of the patent were taken, see Cutting *v.* Myers (1818), 4 Wash. 220; 1 Robb, 159.

That the declaration must tender an issue on novelty and utility, not on the regularity of the proceedings in the Patent Office, see Wilder *v.* McCormick (1846), 2 Blatch. 31.

That a declaration need not describe the invention otherwise than as the patent does, for the defendant can crave oyer, if he desires it, of the specification, see Cutting *v.* Myers (1818), 4 Wash. 220; 1 Robb, 159; Gray *v.* James (1817), Peters C. C. 476; 1 Robb, 140.

That the profert of the patent makes it part of the declaration when afterwards produced, see Pitts *v.* Whitman (1843), 2 Story, 609; 2 Robb, 189.

That oyer of a patent or other public record is not demandable, see Smith *v.* Ely (1849), 5 McLean, 76.

That a declaration averring the patent and specification to be in "language of the import and effect following" and setting them out in their exact words is sufficient, and correctly describes their legal tenor and effect, see Wilder *v.* McCormick (1846), 2 Blatch. 31.

That where profert is made of a recorded paper in the complaint it is part of the pleadings and demurrable, see Bogart *v.* Hinds (1885), 25 Fed. Rep. 484; 33 O. G. 1268.

§ 951. [1] That the declaration must show title in the plaintiff with sufficient certainty, and set out all matters which are of the essence of the action, see Gray *v.* James (1817), Peters C. C. 476; 1 Robb, 140.

That the declaration must aver that the plaintiff had obtained a patent, not merely that he claimed one, see Stanley *v.* Whipple (1839), 2 McLean, 35; 2 Robb, 1.

[2] That an averment that the patent was issued to the plaintiff is a sufficient allegation of his title, see Cutting *v.* Myers (1818), 4 Wash. 220; 1 Robb, 159.

in his own name from the government, or if he has become an assignee or grantee since the patent, or holds as personal representative of a deceased owner, his entire chain of title must be alleged with such particularity that the defendant can investigate it and judge of its validity.[3] Where his ownership is made dependent on the performance of conditions precedent, the conditions must be stated and their fulfilment be averred.[4] These allegations of title, in all cases but that of the patentee, ought properly to be accompanied by profert of the instruments on which it rests, or by a reference to the records of the Patent Office on which they appear, and an averment that they have been lawfully recorded.[5]

§ 952. The Declaration: Allegation of Infringement.

Under the fourth averment the plaintiff must allege that the defendant has infringed the patent by making, using, or selling the invention therein described, without authority from the owner of the patent. This violation must be stated as broadly as the right claimed in the patent, in order that it may clearly appear that the acts of the defendant related to the precise invention thereby protected.[1] No specific phraseology is necessary for this purpose, the assertion that the in-

[3] That an averment that the plaintiff became an assignee before the patent issued is a sufficient allegation of title, see Rathbone *v.* Orr (1850), 5 McLean, 131.

That a plaintiff assignee must fully set out the fact of the assignment, see Dobson *v.* Campbell (1833), 1 Sumner, 319; 1 Robb, 681.

[4] That when the plaintiff's title depends on the performance of certain acts, he must set them out, see Gray *v.* James (1817), Peters C. C. 476; 1 Robb, 140.

[5] That allegations of assignment should aver that the instruments have been duly recorded, see Dobson *v.* Campbell (1833), 1 Sumner, 319; 1 Robb, 681.

That an omission to aver material facts in the declaration which must have been proved in order to obtain a verdict, and proof of which could have been made under the declaration, as, for example, the recording of an assignment, is cured by the verdict, see Stanley *v.* Whipple (1839), 2 McLean, 35; 2 Robb, 1; Dobson *v.* Campbell (1833), 1 Sumner, 319; 1 Robb, 681; Gray *v.* James (1817), Peters C. C. 476; 1 Robb, 140.

That if the declaration shows on its face that the plaintiff has not a legal title, but is merely a licensee, the defendant is entitled to judgment, see Suydam *v.* Day (1846), 2 Blatch. 20.

§ 952. [1] That a breach of the patent is to be assigned as broadly as the right is stated, see Cutting *v.* Myers (1818), 4 Wash. 220; 1 Robb, 159.

vention practised by the defendant was an "imitation of the patent," or any equivalent language, having been held sufficient.[2] Repeated acts of infringement may be alleged in the same manner.[3] In connection with this averment the acquiescence of all other persons in the plaintiff's exclusive right is sometimes declared, as well as the great worth and importance of the invention to the plaintiff, but these are not essential, since the infringement by the defendant is no less an actionable wrong though many others have been guilty of the same unlawful acts, and though the invention never has been recognized as possessing a commercial value.[4]

§ 953. The Declaration: Allegation of Damages.

The fifth averment is a formal though a necessary part of the declaration. It need not contain any special delineation of the methods in which the infringement has injuriously affected the plaintiff.[1] The law implies a damage to the owner

[2] That an averment that the defendant has made the device "in imitation of the patent" is sufficient, see Parker *v.* Haworth (1848), 4 McLean, 370; 2 Robb, 725.

That an averment that the defendant has "constructed, used, and vended" to others is sufficient, see Case *v.* Redfield (1849), 4 McLean, 526; 2 Robb, 741.

That the particular means by which the infringement was committed need not be averred, see Turrell *v.* Cammerrer (1868), 3 Fisher, 462; Case *v.* Redfield (1849), 4 McLean, 526; 2 Robb, 741.

[3] That numerous acts of infringement may be averred in the same declaration without duplicity, see Wilder *v.* McCormick (1846), 2 Blatch. 31; Case *v.* Redfield (1849), 4 McLean, 526; 2 Robb, 741.

That it is not necessary that each act of infringement be the subject of a distinct action at law, or the inventor might be ruined, see Motte *v.* Bennett (1849), 2 Fisher, 642.

That an allegation that one Claim in the patent is infringed discloses a cause of action, see Cook *v.* Ernest (1872), 2 O. G. 89; 5 Fisher, 396; 1 Woods, 195; Lee *v.* Blandy (1860), 2 Fisher, 89; 1 Bond, 361; Singer *v.* Walmsley (1860), 1 Fisher, 558; Waterbury Brass Co. *v.* N. Y. & Brooklyn Brass Co. (1858), 3 Fisher, 43; Emerson *v.* Hogg (1845), 2 Blatch. 1; Moody *v.* Fiske (1820), 2 Mason, 112; 1 Robb, 312.

That when a patent claims two inventions a suit may be brought on it for the infringement of either, and the patent will be treated as if it contained only that Claim, see McComb *v.* Brodie (1872), 5 Fisher, 384; 2 O. G. 117; 1 Woods, 153.

[4] This averment is especially important where an injunction is, or is to be, moved for in connection with the suit, see §§ 1185–1188, and notes, *post*.

§ 953. [1] That a declaration beginning in case and demanding actual damages in gross as a debt due is good, see Wilder *v.* McCormick (1846), 2 Blatch. 31.

of a patent from its wrongful invasion, and though evidence of actual loss is essential to the recovery of substantial damages the general averment is sufficient for the declaration.[2] A claim for treble damages is sometimes inserted, but as the power to award this increase over the amount found by the jury resides in the discretion of the court, it constitutes the proper subject of a motion rather than of the pleadings upon which the issues for the jury are to be framed.[3]

§ 954. The Declaration: Formal Requisites.

The language and logical coherence of a declaration are not severely scrutinized by the court, nor are objections to its modes of statement favored, if it accomplishes the object for which it was intended. It must put the defendant in possession of the facts on which the plaintiff's claim is based, and must leave open to the defendant every legal defence which he has a right to make. If it does this, its faults in other respects will not be critically regarded.[1] An omission to aver material facts which could have been proved under the pleadings as a whole, and which the jury must have found in order to have arrived at their decision, will be cured by verdict.[2]

[2] That nominal damages are implied from the violation of the patent, see Poppenhusen *v.* N. Y. Gutta Percha Comb Co. (1858), 2 Fisher, 62. See also §§ 1052, 1071, and notes, *post.*

That actual damages must be proved, see Mayor of New York *v.* Ransom (1859), 23 How. 487; Seymour *v.* McCormick (1853), 16 How. 480.

That in fixing the amount of damages the jury cannot exceed the sum named in the declaration, see Winans *v.* N. Y. & Harlem R. R. Co. (1855), 4 Fisher, 1.

[3] That the trebling of damages is a matter for the discretion of the court, see Seymour *v.* McCormick (1853), 16 How. 480; Stimpson *v.* Railroads (1847), 1 Wall. Jr. 164; 2 Robb, 595; Guyon *v.* Serrell (1847), 1 Blatch. 244.

§ 954. [1] That where a declaration contains all needed allegations to support the evidence of the plaintiff's right and its violation, and leaves every legal defence open to the defendants, it will not be critically regarded, see Wilder *v.* McCormick (1846), 2 Blatch. 31.

[2] That a verdict cures the defects which must have been supplied in order to enable the jury to reach their decision, see Stanley *v.* Whipple (1839), 2 McLean, 35; 2 Robb, 1; Dobson *v.* Campbell (1833), 1 Sumner, 319; 1 Robb, 681; Gray *v.* James (1817), Peters C. C. 476; 1 Robb. 140.

That the declaration need not conclude *contra formam statuti*, see Parker *v.* Haworth (1848), 4 McLean, 370; 2 Robb, 725; Tryon *v.* White (1815), Peters C. C. 96; 1 Robb, 64.

§ 955. The Declaration: Joinder of Several Patents where Violated by One Act of Infringement.

A single and indivisible act of infringement may often violate more than one patent belonging to the plaintiff, and render it essential to the vindication of his rights that all such patents should be joined as the foundation of a single action.[1] Such a case arises where an original invention and its improvements are covered by several patents owned by the same person, and are unlawfully appropriated by the same infringer. Here it would be impossible, on separate suits based on each patent, to distinguish the loss resulting to the plaintiff by the wrongful use of the original from that produced by the employment of the improvement. Other cases present the same difficulty, and in these the only recourse of the plaintiff is to join all such patents in one action and in one claim for damages. This he is permitted to do, and in his declaration he must then set out concerning each patent the matters properly embraced in the first three of the described averments, — the inventive act of the patentee or his assignor, the issue of the patent, and the title of the plaintiff. The averments of infringement and damages may be general, and refer to all the patents collectively.[2]

§ 956. Pleadings in Actions at Law: Pleas in Abatement.

The pleadings of the defendant in an action for infringement are either in abatement, by demurrer, or in bar. A plea in abatement should be filed whenever the defendant desires to object to the mode in which the proceedings have been instituted, whether the fault resides in the process or its service, in the incapacity, misdescription, misjoinder or non-joinder of

§ 955. [1] That more than one patent may be included in the same suit, see Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337.

That separate suits between the same parties on separate patents, all infringed by the same machine, may be consolidated on motion, see Deering *v.* Winona Harvester Works (1885), 32 O. G. 654; 24 Fed. Rep. 90.

See as to the rule of joinder in equity cases, § 1108, and notes, *post*.

[2] That where the plaintiff is the owner of the patent for the original invention, and also of a patent for an improvement thereon, he cannot claim separate damages in separate suits for the infringement of each, if both are infringed, see Case *v.* Redfield (1849), 4 McLean, 526; 2 Robb, 741.

the parties, or the pendency of another action between the same parties seeking the same remedy for the same wrong. Most of these objections can be urged only under this dilatory plea, and are waived unless taken advantage of in this formal manner.[1] A suit is not abated on account of other suits against the same defendant for a different act of infringement, nor on account of other suits against different defendants for the same infringement.[2] The bankruptcy of the plaintiff during the litigation is no ground of abatement.[3] The issues

§ 956. [1] That a plea to the jurisdiction is proper both in law and equity though it be partly or wholly negative, see Edison Electric Light Co. *v.* U. S. Electric Lighting Co. (1888), 43 O. G. 1456.

That an objection to the right of an executor to sue must be taken by plea in abatement, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

That a non-joinder of executors, where necessary to join them, can be taken advantage of only by plea in abatement unless it appears on the record, see Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351.

That a denial of the plaintiff's corporate capacity must be made by a plea in abatement, see Dental Vulcanite Co. *v.* Wetherbee (1866), 2 Clifford, 555; 3 Fisher, 87.

That if the plaintiffs are a corporation, the fact of their organization cannot be attacked in a plea in bar, but only by plea in abatement, see Dental Vulcanite Co. *v.* Wetherbee (1866), 3 Fisher, 87; 2 Clifford, 555.

That a plea that joint-infringers are not joined must allege that they all live within the district, see Goodyear *v.* Toby (1868), 6 Blatch. 130.

That if the defendant is sued out of his district he must plead his personal privilege, see Teese *v.* Phelps (1855), 1 McAllister, 17.

That defects in process or service, if apparent on the face of the record, may be taken advantage of by motion to quash the service or abate the writ, and if not thus apparent, by plea in abatement, see United States *v.* American Bell Telephone Co. (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

[2] That different suits for different infringements are proper though one is already pending, see Rumford Chemical Works *v.* Hecker (1874), 5 O. G. 644; 11 Blatch. 552; 1 Bann. & A. 120.

That a suit cannot be prosecuted for the infringement of an original patent pending an application for its re-issue, see Burrell *v.* Hackley (1888), 44 O. G. 1400; 35 Fed. Rep. 833.

That pending an accounting the plaintiff cannot sue at law for infringements committed since the decree, without leave of the court, see Morse *v.* Knapp (1888), 35 Fed. Rep. 218.

[3] That bankruptcy of the plaintiff is not a ground of abatement in equity, see Gear *v.* Fitch (1878), 16 O. G. 1231; 3 Bann. & A. 573.

That a plaintiff becoming bankrupt, and then purchasing the right of action from his assignee, cannot be met with a plea in abatement, see Gear *v.* Fitch (1878), 16 O. G. 1231; 3 Bann. & A. 573.

That no rule to plead will be granted until the defendant has properly appeared, see Parker *v.* Bigler (1857), 1 Fisher, 285.

formed upon a plea in abatement, as well as the judgment and the subsequent proceedings thereon, are similar to those in other civil actions.

§ 957. Demurrers in Actions at Law.

The defendant may demur to the declaration, either specially on account of its formal defects, or generally on the ground that it sets forth no cause of action. Defects of form are now so little regarded by the courts, and are so easily remedied by amendment, that a special demurrer in this as in other actions is of rare occurrence. A general demurrer will not be sustained, however imperfect in statement or arrangement the declaration may appear, if it substantially includes the five essential averments, and does not mislead the defendant or preclude him from making under the subsequent pleadings those defences which are open to him by the law.[1] The issue and judgment on demurrer, in this class of cases, do not differ from those in ordinary suits at law.

§ 958. Pleas in Bar in Actions at Law: The Defences Possible in Actions at Law.

A plea in bar in actions for infringement assumes the form either of the general issue alone, or of the general issue with notice of special matters, or of a special plea. Before considering these it is important to examine and classify the various defences which may be made to such an action on its merits, in order that the propriety and scope of each of the three forms of plea may be perceived.[1] The general character

§ 957. [1] That courts will sustain pleadings which are substantially sufficient even against a special demurrer, see Wilder *v.* McCormick (1846), 2 Blatch. 31.

§ 958. [1] The classification here attempted is not offered as complete and covering every defence which can at any time be made. New grounds of objection to recovery by a patentee from time to time appear in practice, and are sustained by the courts. An interesting instance occurs in the present condition of that defence which rests upon a simple use of the invention by the public for over two years before the application. Until recently no such defence was recognized except as a part of the wider defence of abandonment, the public use having no significance unless acquiesced in by the inventor. Where acquiescence is not required in order to give this use the force of a complete defence, it no longer can be based on the idea of an abandonment or directly on that of an estoppel, but assumes the law to be

of these defences is indicated by the several averments contained in the declaration, each of which must be found true in order to support a judgment for the plaintiff. The first averment is true only when seven different facts concur: (1) When the alleged invention is the result of an inventive act; (2) When this inventive act has been performed by the patentee or his assignor; (3) When its performance by the patentee or his assignor preceded its performance by any other person in this country; (4) When the alleged invention is embraced within one of the six classes of inventions made patentable by the acts of Congress; (5) When it is legally new; (6) When it is practically useful; (7) When it has not been abandoned to the public. The second averment is true only when nine different facts exist; (1) When the patent described in the declaration has been actually issued by the government; (2) When it was issued in the mode provided by the law; (3) When the invention which it purports to protect is, on its face, a patentable subject-matter; (4) When the specification is free from fraudulent assertion or concealment; (5) When the description is without ambiguity; (6) When the Claims do not embrace more than the actual invention, or if originally embracing more have been or may now properly be cured by a disclaimer; (7) When the Claims are free from ambiguity; (8) When the patent has not been surrendered; (9) When the patent has not been repealed. The third averment is true only when the plaintiff was the legal owner of the patent at the date of the infringement, or at the date of the commencement of the suit was the legal owner of the patent and the assignee of the right of action for the infringement. The fourth averment is

that an invention is not patentable after having been before the public for the period named. This is essentially a new defence, and would if fully established in our practice constitute an eighth species of defences to the first averment of the declaration. In like manner other defences, once employed, are no more in use (such as the non-introduction into market of the invention of an alien, etc.), and though found formerly in the courts, are here unnoticed.

That defences are not limited to those named in the statute, but embrace all violations of law in granting the patent, such violations raising questions of law on which the decision of the Commissioner is not final, see Gardner *v.* Herz (1886), 118 U. S. 180; 35 O. G. 998.

true only when four facts concur: (1) When the identical invention protected by the patent has been made, or used, or sold; (2) When the act of making, use, or sale has been performed by the defendant, either alone or in complicity with others; (3) When this act was performed while the patent was in force: (4) When this act was performed without authority from the owner of the patent. The fifth averment tenders no issue, its truth being implied by law to an extent sufficient to secure a verdict for some damages in favor of the plaintiff, if the other four averments are established. As each of these averments must be proved in order to entitle the plaintiff to a judgment, and as each of its subordinate facts must exist in order to the truth of each averment, it is apparent that the successful denial of any one of these subordinate propositions constitutes a complete defence to the action and requires the verdict to be given for the defendant. In addition to these defences there are four others of a special nature, not suggested by the declaration, but common to all actions at law; (1) The Statute of Limitations; (2) Estoppel; (3) Release; and (4) *Res Adjudicata.* In reference to most of these defences the courts have given further explanations, and in some of them the statutes recognize minuter subdivisions, which next require attention.

§ 959. First Defence: Denial that the Patented Art or Instrument is the Result of an Inventive Act.

The first defence in the order of the foregoing enumeration consists in a denial that the alleged invention is the result of an inventive act. An inventive act may be performed in either one of three different ways; (1) By the discovery of a new force, or of a new capability in a known force, and the practical application of this new force or capability to some object through some mode of application, such object and such mode of application being new or old; (2) By the discovery of a new object or of a new susceptibility in a known object, and by rendering this object or susceptibility practically useful by subjecting it to the operation of some force through some mode of application, such force and mode of application being new or old: (3) By the discovery and practical embodi-

ment of a new mode of application by which forces may be brought into connection with their objects, such forces and objects being new or old. When either of these three mental and physical operations produces a means, as distinguished from a mere function or effect, it constitutes a true inventive act. Contrariwise, if the alleged invention is only an effect or a function, or if, being a means, it has resulted from an act wanting either the element of discovery or that of practical application, no complete inventive act has been performed.[1] This defence, therefore, is properly subdivided into four: (1) That the alleged invention is a mere effect; (2) That it is a mere function; (3) That it involved no exercise of the inventor's powers of original discovery, but could have been produced by the employment of his imitative faculties; (4) That it has never been made practically available. This is a defence based solely on the scientific and inherent character of the invention as apprehended by a mind familiar with the state of the art at the time when the inventive act is claimed to have been performed. Of it the courts will take judicial notice, whether urged or not by the defendant, whenever from their knowledge of the art it is apparent to them that it might successfully be made.[2]

§ 959. [1] For a description of the inventive act and its patentable results, see §§ 78–156 and notes, *ante*.

That non-reduction to actual practice before application for a patent is no defence, see Starr *v.* Farmer (1883), 23 O. G. 2325; Opinion Sec. Interior (1883), 23 O. G. 2327; Wheeler *v.* Clipper Mower & Reaper Co. (1872), 2 O. G. 442; 6 Fisher, 1; 10 Blatch. 181.

[2] That where the court can see that a patent is void it *may so declare it on* a demurrer, see Eclipse Mfg. Co. *v.* Adkins (1888), 36 Fed. Rep. 554; West *v.* Rae (1887), 33 Fed. Rep. 45.

That a demurrer on the ground that the invention is not patentable should not be sustained unless the matter is so evident that no question of fact can be made on it, see Blessing *v.* Copper Works (1888), 34 Fed. Rep. 753.

That a demurrer does not admit the patentability of the invention, see Kaolatype Engraving Co. *v.* Hoke (1887), 30 Fed. Rep. 444; 39 O. G. 589.

That the courts will not entertain an action where it is apparent that no inventive act has been performed, though the defendant may not defend on that ground, see Ligowski Clay Pigeon Co. *v.* American Clay Bird Co. (1888), 34 Fed. Rep. 328; Slawson *v.* Grand St., Prospect Park, & Flatbush R. R. Co. (1883), 107 U. S. 649; 24 O. G. 99.

§ 960. Second Defence: Denial that the Patented Art or Instrument Resulted from the Inventive Act of its Alleged Inventor.

The second defence consists in a denial that the inventive act from which the alleged invention has resulted was ever performed by the patentee or his assignor. This defence raises no question as to the existence of an inventive act, but simply excludes the alleged inventor from among those by whose inventive skill the invention was produced. It is equivalent to an averment that the patentee has surreptitiously appropriated to himself and patented the invention of another, and is proper only when the invention, having been completely conceived by its real inventor, has become known to and been imitated by the patentee.[1] It does not necessarily involve an other, or against the true inventor by forestalling him in the obtaining of a patent. (See Dixon *v.* Moyer, (1821), 4 Wash. 68; 1 Robb, 324.) The act of 1836 transfers the word to an entirely different defence by requiring notice, not when the patentee is denied to be an inventor, but when the defendant purposes to show "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." This is obviously the third defence and not the second, for a patent is invalid when procured by the mere copyist of another's discovery, whether that other was using due diligence or not. But the word "surreptitiously" has here lost its former significance and become the equivalent of "unjustly," *i. e.*, against the rights of the prior inventor, since no fraud or deceit is necessary to render void a patent obtained by a later true inventor when the the first inventor is complying with the obligation of diligence imposed upon him by the law. See Phelps *v.* Brown (1859), 4 Blatch. 362; 1 Fisher, 479; 18 How. Pr. 7; also § 995 and notes, *post*.

§ 960. [1] This defence is liable to be confounded with the third, from the fact that the adverb "surreptitiously," which in the acts of 1790 and 1793 was employed in reference to the present subject, was in the act of 1836 and subsequent statutes applied to patents obtained by later inventors contrary to the rights of prior ones. This transfer of the adverb in the statutes has been followed naturally by its transfer in the decisions of the courts, and caution is thus necessary in its interpretation, lest the true nature of both defences be obscured.

The word "surreptitiously" first appears in the act of 1790, where it is used as an equivalent for "false suggestion," and is made a ground for repealing a patent thus obtained. In the act of 1793 it is employed in describing a defence of which the defendant must give previous notice to the plaintiff, the defence being that the patentee "had surreptitiously obtained a patent for the discovery of another person." Here again it conveys the idea of fraud either against the public whose rights are restricted by a patent granted to one who has no title to a monopoly, being a mere imitator of the invention of an-

allegation of wilful deceit on the part of the patentee; he may honestly but ignorantly believe that some substantial difference exists between his art or article and that which he has actually copied, and may suppose that his originated in his own inventive skill. The fact that instead of inventing a new means he has merely appropriated and obtained a patent for a means created by another, and is, therefore, not a true inventor, is sufficient to establish this defence.[2]

§ 961. Third Defence: Denial that the Alleged Inventor was the First Inventor of the Patented Art or Instrument.

The third defence consists in a denial that the patentee or his assignor performed the inventive act producing the alleged invention at an earlier date than any other inventors in this country. This defence concedes that the patentee or his assignor is a true inventor of the art or article in question, but denies that he was its *first* inventor.[1] It is equivalent to either one of two averments: (1) That rival inventors had completely conceived the idea of means embodied in the invention, and were using due diligence in reducing it to practice at the time when the patentee or his assignor conceived the same idea; or, (2) That although the patentee or his assignor had first conceived the idea he did not use due diligence in reducing it to practice, and that in the meantime some later conceiver but more prompt reducer had perfected the invention. This defence raises the same issue which is presented in interference cases in the Patent Office and in proceedings in equity to annul a rival patent, and is sustained when the evidence establishes either one of its equivalent averments.[2]

§ 962. Fourth Defence: Denial that the Patented Art or Instrument is within the Patentable Classes of Inventions.

The fourth defence consists in a denial that the invention falls within the classes protected by the acts of Congress as

[2] For the distinction between an imitation and a new invention, see § 78 and notes, *ante*.

§ 961. [1] For the relations of rival inventors to each other and the public, see §§ 370–391, and notes, *ante*.

[2] For a description of the issues raised in interference proceedings and actions to annul, see §§ 586–603, 724, and notes, *ante*.

those acts are interpreted by the courts. This defence is proper where the result of the inventive act performed by the patentee or his assignor is not an art, a machine, a manufacture, a composition of matter, a design, or an improvement.[1] It is also appropriate when the invention, though it purports to be a combination, is in reality a mere aggregation of independent elements.[2] This defence, like the first, is based upon the inherent character of the invention. When the nature of the invention is apparent, the application to it of the legal definitions given to the protected classes of inventions determines whether this defence is applicable. The court whose duty it is to ascertain from the description and Claims embodied in the patent what the invention is, and to apply thereto the tests afforded by these definitions, may, therefore, take judicial notice of this defence also without reference to the pleadings; and if it finds that the result of an inventive act, though new and useful, is not legally patentable under the acts of Congress, may refuse to entertain proceedings against those who have without authority employed it.[3]

§ 963. Fifth Defence: Denial of the Novelty of the Patented Art or Instrument.

The fifth defence consists in a denial that the invention resulting from the inventive act of the patentee or his assignor is new within the meaning of the law. The defence of want of legal novelty in the invention is sometimes related to the third defence of prior invention, but must not be confounded with it. If a prior rival inventor has perfected his invention, and either put it to practical use in this country, or patented

§ 962. [1] For the nature of each class of patentable inventions, see Art, §§ 159, 164–170, and notes, *ante;* Machine, §§ 173–179, and notes, *ante;* Manufacture, §§ 182–189, and notes, *ante;* Composition, §§ 192–197, and notes, *ante;* Design, §§ 200–207, and notes, *ante;* Improvement, §§ 210–218, 307–313, and notes, *ante.*

[2] For the nature of a combination, see §§ 153–156, 277–282, and notes, *ante.*

[3] That the court may take judicial notice of the nature of the patented invention and of the fact that it is not legally patentable, and may thereupon refuse to entertain the action, see Kaolatype Engraving Co. *v.* Hoke (1887), 30 Fed. Rep. 444; 39 O. G. 589; Slawson *v.* Grand St., Prospect Park & Flatbush R. R. Co. (1883), 107 U. S. 649; 24 O. G. 99; and cases cited in § 959 note 2, *ante.*

it, or published a printed description of it, before its invention by the patentee or his assignor, the defence of want of legal novelty as well as that of prior invention is appropriate. But if the prior inventor has not practised his invention, or patented or published it before the patentee or his assignor performed the inventive act, or if the patentee or his assignor first conceived the idea but through his want of diligence in reduction has given a later conceiver and prompt reducer the superior right to the invention, the defence of want of legal novelty cannot be sustained. A patented invention is new, within the meaning of the law, unless before the date of its complete conception by the patentee or his assignor it had been known or used in this country, or had been patented or described in a printed publication either at home or abroad.[1] A prior use, in order to create a want of novelty, must consist in the practical employment of the identical invention for business purposes in the United States, in such a manner as to render the knowledge of the invention accessible to the public before and until the date of its conception by the patentee or his assignor.[2] A prior patent constitutes a want of novelty when it was issued to the public before the date of the inventive act in question, and contains so full and complete a description and claim of the identical invention as to enable any person skilled in the arts to practise it without further invention of his own.[3] A prior publication proves a want of novelty when in its printed text, distributed to the public before the patentee or his assignor conceived the idea of the invention, the essential characteristics of the art or article are so disclosed that those skilled in the art can by the guidance of the publication alone construct it and apply it to practical use.[4] It is to be remembered that these three conditions under which novelty is wanting are not merely evidence that the invention is not legally new, but are facts which cause it to be legally old. Novelty is a legal attribute consisting in

§ 963. [1] For the nature of legal *novelty as distinguished from actual* novelty, see §§ 113, 123, 222–228, 315, 316, and notes, *ante*.

[2] As to prior use, see §§ 317–324, and notes, *ante*.

[3] As to prior patent, see §§ 331–337, and notes, *ante*.

[4] As to prior publication, see §§ 325–330, and notes, *ante*.

the absence of these three conditions, and when the existence of either is established by sufficient proof it is a conclusion of law, and not an inference of fact, that the invention is not new. Thus the defence of want of novelty may logically be subdivided into the three defences of prior use, prior patent, and prior publication, each of which may be urged without the others, and if found true forms a complete bar to the action.

§ 964. Sixth Defence: Denial of the Utility of the Patented Art or Instrument.

The sixth defence consists in a denial of the utility of the invention. An invention is useful within the meaning of the law if it is available for any use which on the whole is beneficial to the public. An utterly frivolous and worthless art or article has no utility. An invention capable of beneficial use, but so dangerous or disastrous to its employers as to be necessarily productive of more injury than advantage, is not useful. An invention whose practice may promote the interest of the individual user, but is inevitably prejudicial to the public, also wants utility.[1] This defence is thus equivalent to an averment that the invention is incapable of any beneficial use, or that its use involves a greater loss than gain to its employers, or that its use is detrimental to the public.[2] Defendants who have actually practised the invention, especially those who have endeavored to induce the public to participate in its results by purchasing the fruits of their infringements, are estopped from urging it on their own behalf when sued for their wrong-doing.[3]

§ 964. [1] For the nature and necessity of utility, see §§ 338–343, and notes, *ante*.

[2] That the want of utility is a perfect defence, see Bliss *v.* City of Brooklyn (1873), 6 Fisher, 289; 3 O. G. 269; 10 Blatch. 521.

That the manifest frivolity of the invention patented is a good defence, see Wilson *v.* Jones (1854), 3 Blatch. 227.

That an immoral or dangerous invention may lack utility, see § 340, and notes, *ante*.

[3] That to sustain a defence of want of utility the evidence must show that the invention is utterly worthless, and if the defendant has used it, that fact is a strong argument in favor of utility, see Kearney *v.* Lehigh Valley R. Co. (1887), 32 Fed. Rep. 320.

That want of utility avails little as a defence for parties who used the in-

§ 965. Seventh Defence: Abandonment of the Invention to the Public.

The seventh defence consists in an averment that the invention was abandoned to the public before the commission of the acts of which the defendant is accused. In this defence there is no question of incomplete and abandoned experiments performed by the patentee or his assignor while endeavoring to perfect the invention, or by rival inventors in their attempts to reach the same result. Evidence of such experiments may be admissible under the defences of prior invention and of prior use, but of themselves they constitute no bar to an action on the patent, and especially have no relation to this defence of abandonment. Abandonment is synonymous with dedication to the public. It assumes that the invention is complete and practically operative, and it occurs only where the invention, being in that condition, is intentionally and unreservedly surrendered to the public by its lawful owner.[1] This defence is, therefore, proper when such an intentional surrender has been made, either by the inventor or the patentee or any subsequent owner of the patent. A public use or sale of the invention, by the inventor or with his consent, for more than two years before his application for a patent, is one form of surrender.[2] Any other conduct of his or of the owner of the patent, which unequivocally manifests the same intention, is also an abandonment of the invention. Such conduct may consist either in acts or declarations of the inventor before his application, or in describing and not claiming the invention in his application, or in disclaiming it in connection

vention, see Phillips *v.* Carroll (1385), 23 Fed. Rep. 249; 31 O. G. 265; Cook *v.* Ernest (1872), 2 O. G. 89; 5 Fisher, 396; Vance *v.* Campbell (1859), 1 Fisher, 483.

That a defendant using an entire process is estopped to claim that any part of it is injurious, see Whitney *v.* Mowry (1870), 4 Fisher, 207.

That the defendant is estopped from denying the utility of the invention after having made and sold large quantities of it, and especially after advertising that the new invention had revolutionized the trade, see Robertson *v.* Garrett (1873), 6 Fisher, 278; 10 Blatch. 490.

§ 965. [1] As to the nature of abandonment, and its distinction from abandoned experiments and abandoned inventions, see § 346 and notes, *ante*.

[2] As to abandonment by public use or sale, see §§ 354–360, and notes, *ante*.

with his application or his patent, or in words, actions, or omissions of the owner of the patent after the patent has been granted.[3] This defence has sometimes been subdivided into two: (1) Abandonment by public use or sale; (2) Abandonment by conduct other than public use or sale. Between these two there is an important distinction which is well recognized in the forms of pleading and in the rules of evidence. A public use or sale is not simply an act from which an intention to abandon may be inferred, but it is conclusive evidence of that intention; and when such use or sale is proved there is no room for any further question as to the dedication of the invention to the public. Conduct other than public use or sale is merely a fact from which an intention to abandon may be inferred, but affords no conclusive presumption of such intention and may be rebutted by any evidence affording a contrary indication.[4] This distinction in practical effect has led certain jurists of great authority to separate these two defences from each other, and to treat them as if resting upon different foundations.[5] The doctrine which underlies them is nevertheless identical, as is apparent from the definitions given by the courts to the terms "public use and sale," each of which is limited to cases where the use or sale involves a voluntary and intentional surrender by the inventor of all control over the invention, neither an experimental use, however public, nor any sale restricted by conditions which the inventor can enforce against the property in the invention sold, falling within such definitions.[6] This seventh defence

[3] As to abandonment by general conduct, see §§ 350–353, and notes, *ante*.

[4] That except in cases of public use or sale, the presumption of an intention to abandon may be rebutted, see §§ 347, 348, and notes, *ante*.

[5] In Jones *v.* Sewall (1873), 3 O. G. 630, Clifford, J.: (637) "Persons charged with the infringement of letters-patent may set up as a defence that the inventor suffered the invention to be in public use and on sale more than two years before he applied for a patent; and they may also set up as a distinct defence, even in the same answer, that the inventor, before he applied for a patent, abandoned the invention to the public; but these two defences ought not to be blended in the same allegation, as they depend in many respects upon very different principles." 6 Fisher, 343 (365); 3 Clifford, 563 (589).

[6] That public use and sale are not abandonment except when unequivocal, unrestricted, and with the consent of the inventor, see §§ 354–360, and notes, *ante*.

completes the group of those which attack the merits of the invention and deny the right of the inventor or the owner of the patent to be protected in its exclusive use.[7]

§ 966. Eighth Defence: Denial of the Grant of the Alleged Letters-Patent.

The eighth defence, or the first one of that group which attacks the letters-patent as distinguished from the invention, consists in a denial that the patent described in the declaration was ever granted by the government. This defence is proper when the alleged invention never has been patented or when the patent which protects it is not correctly set forth by the declaration.[1] It simply raises an issue as to the existence of the document on which the plaintiff has based his suit, and is equivalent to the plea of *nul tiel record* at the common law. Any material variance between the actual patent and the statement of its tenor and effect in the declaration will support this defence, and unless cured by amendment will defeat the action.

[7] That the use of an invention without the consent of the inventor, pending his application, is no defence against the patent, see Dental Vulcanite Co. *v.* Wetherbee (1866), 3 Fisher, 87; 2 Clifford, 555.

That the defence of public use and sale more than two years "before the invention" is not known to our law, see Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

That under the defence of two years' public use, the defence of prior use cannot be made, nor is it sustained by evidence of a prior patent without the plaintiff's knowledge over two years before, see Myers *v.* Busby (1887), 32 Fed. Rep. 670; Parks *v.* Booth (1880), 102 U. S. 96; 17 O. G. 1089.

That in an action brought after the act of 1837, ("two years") on a patent granted before it, public use prior to the application is a good defence, see Winans *v.* New York & Harlem R. R. Co. (1855), 4 Fisher, 1.

That an application substituted at the instance of the Patent Office for one already filed dates from the filing of the former application as to the question of public use, see International Tooth Crown Co. *v.* Richmond (1887), 30 Fed. Rep. 775; 39 O.G. 1550.

N. B. In this seventh defence no notice is taken of the public use and sale "without the consent" of the inventor, which seems to be now recognized as a defence under the present statutes. That defence may perhaps rest indirectly on the doctrine of estoppel, but it is certainly not a simple dedication to the public. For a consideration of this subject, see §§ 357, 390, and notes, *ante*.

§ 966. [1] As to the averment of the patent in the declaration, see § 950 and notes, *ante*.

§ 967. Ninth Defence: Denial that the Letters-Patent were Issued in Conformity with Law.

The ninth defence consists in a denial that the patent, though actually issued by the government, was issued in accordance with the formal requirements of the law. It is equivalent to an averment that, in the allowance of the patent, the Patent Office has disregarded the established legal methods of procedure or performed acts beyond its jurisdiction. The law imposes numerous duties on an applicant as conditions precedent to the issue of a patent, the enforcement of which is entrusted to the Patent Office, whose decision in the premises the courts will not review.[1] A patent granted without the fulfilment of these prerequisites cannot be on that account attacked.[2] The omission of the prescribed oath or fee, the absence of the proper attestations, and other similar informalities are cured by the allowance of the patent, and cannot be set up as a defence in any action based thereon. Certain irregularities in the procedure of the Office of a trivial character are in like manner overlooked.[3] But there are some faults in the action of the Office of which courts do take notice and of which an infringer may avail himself in his defence. Thus if the patent has been issued upon a false oath or suggestion, or if the patent does not bear the signatures of the Secretary and Commissioner and the seal of the United States, or if it departs from the application and purports to protect a different invention or to secure it to a patentee other than the applicant or his lawful assignee,

§ 967. [1] That the action of the Patent Office upon certain of the prerequisites to a patent is final, see §§ 423, 451, 617, and notes, *ante*.

[2] That a patent cannot be collaterally attacked for informality in the grant, see Dorsey Harvester Revolving Rake Co. *v.* Marsh (1873), 6 Fisher, 387.

[3] That the want of legal prerequisites to the issue of the patent by the Commissioner, such as the grant for too long a term, or the want of proper signatures to the specification, is no defence to an action for infringement, see Railway Register Mfg. Co. *v.* North Hudson C. R. Co. (1885), 23 Fed. Rep. 593; 32 O. G. 519.

That the unintentional issue of the patent by the Patent Office cannot be set up in defence, and that none but the United States can attack it on that ground, see Doughty *v.* West (1869), 3 Fisher, 580; 6 Blatch. 429.

That the omission of the oath or fee is cured by the allowance of the patent, see § 458 and notes, *ante*.

or if it has been granted without the required notice to a pending caveator, or if it issued to a sole applicant for a joint invention or to joint applicants as joint inventors when the inventive act was sole, — these are errors which may render it invalid, and can be urged against it by the defendant.[4] Where the patent has been re-issued under circumstances which show that the alleged defect in the original was voluntary and intentional, and did not occur through inadvertence, accident, or mistake; or when the amended patent embraces matter which the inventor evidently did not intend or endeavor to protect in the original, the action of the Patent Office in allowing the re-issue transcends its jurisdiction, and a suit on the re-issued patent cannot be sustained.[5] Fraud on the part of the officials of the government in issuing the patent is not, however, a permissible defence in any private action, — the United States alone having a right to seek the cancellation of a patent for this reason by instituting a suit for its repeal.[6]

[4] That where the Commissioner exceeds his authority in issuing a patent, under a mistake of law, the question may be reviewed on a suit for infringement, see Mahn *v.* Harwood (1884), 112 U. S. 354; 30 O. G. 657.

That a patent issued upon a false oath or suggestion is invalid, see § 456 and notes, *ante*.

Contra, where the matter of the oath is formal only, and the falsehood unintentional, see Tondeur *v.* Chambers (1889), 46 O. G. 1110; 37 Fed. Rep. 333.

That a patent issued without the required official signatures or seal is void, see Marsh *v.* Nichols (1888), 128 U. S. 605; and § 620 and notes, *ante*.

That a patent granted without notice to a caveator is invalid against him, see Phelps *v.* Brown (1859), 4 Blatch. 362; 18 How. Pr. 7; 1 Fisher, 479.

That a sole patent for a joint invention is void, see § 402 and notes, *ante*.

That a joint patent for a sole invention is invalid, see § 402 and notes, *ante*.

[5] That a re-issue embracing "new matter" is invalid, see §§ 635, 661–667, and notes, *ante*.

That the irregularity of re-issue proceedings is no defence unless it can be shown that the re-issue was contrary to law or was granted to the wrong party, see Dental Vulcanite Co. *v.* Wetherbee (1866), 2 Clifford, 555; 3 Fisher, 87.

[6] That re-issued and extended patents cannot be impeached for fraud in suits for infringement, see Schillinger *v.* Cranford (1885), 4 Mackey, 450; 37 O. G. 1349; Milligan & Higgins Glue Co. *v.* Upton (1874), 6 O. G. 837; 1 Clifford, 237; 1 Bann. & A. 497; Gear *v.* Grosvenor (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

That no defence can be based on an allegation of fraud in procuring an extension, see Tilghman *v.* Mitchell (1871), 4 Fisher, 615; 9 Blatch. 18; Whitney *v.* Mowry (1870), 4 Fisher, 207; Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351.

That the decision of the Commis-

§ 968. Tenth Defence: Denial that the Invention Covered by the Patent is Legally Patentable.

The tenth defence consists in a denial that the invention covered by the patent is patentable subject-matter under the laws of the United States. The nature of this objection is the same as that urged in the fourth defence, the difference being in the point to which they are directed.[1] In that, the claim of the defendant is that the inventive act of the patentee or his assignor has not resulted in the production of any art or article which is entitled to protection, or which can lawfully be made the basis of a patent; in this, he claims that, be the actual invention of the plaintiff what it may, the one described in his patent does not fall within the classes mentioned in the statute. When this defect exists it is apparent on the face of the patent, and hence may be judicially noticed by the court as well as if pleaded and insisted on by the defendant.

§ 969. Eleventh Defence: Fraudulent Concealment or Misrepresentation in the Specification of the Patent.

The eleventh defence consists in a denial that the patentee or his assignor has acted in good faith toward the public in disclosing his invention in the specification annexed to his patent. This defence is equivalent to an averment that, for the purpose of deceiving the public, the description of the invention in the specification was made to contain less than the whole truth in reference to the invention or more than is necessary to produce the desired effect.[1] The essence of this

sioner on an extension is not reviewable in defence to an infringement suit, see Whitney *v.* Mowry (1870), 4 Fisher, 207.

§ 968. [1] See § 962 and notes, *ante*.

§ 969. [1] This defence, though stated in the language of the statute requiring notice to be given to the plaintiff when the defence is to be urged, does not itself rest upon the statute. A patent obtained by, or containing, wilfully false representations concerning the nature of the invention, has always been held void both in this country and in England, and the doctrine has sometimes been pushed to an extreme degree.

See Grant *v.* Raymond (1832), 6 Peters, 218; 1 Robb, 604; and cases cited in note 2, *post;* and § 494 and notes, *ante*.

Also, Tetley *v.* Easton (1852), Macrory, P. C. 48; Walton *v.* Bateman (1842), 1 Web. 613; Neilson *v.* Harford (1841), 1 Web. 295; Lewis *v.* Marling (1829), 1 Web. 493; 1 Abb. P. C. 421; Bovill *v.* Moore (1816), Davies P. C. 361; 1 Abb. P. C. 231.

defence is the fraudulent intent with which the erroneous description has been made.[2] Ambiguities of idea or expression arising from the want of clear conceptions in the mind of the inventor, or from inability to delineate them in words or drawings, do not enter into this defence.[3] A patent intended to deceive may be clear, precise, and graphic, and probably will be so; but however intelligible to those skilled in the art, if it is designed to mislead them as to the character of the real invention and either prevent them from employing it in its completeness or compel them to employ it at a disadvantage as compared with the inventor, his wilful endeavor to deceive forfeits all that right to protection which he might have otherwise enjoyed, and if established by sufficient evidence renders his patent void.[4]

§ 970. Twelfth Defence: Ambiguity in the Description of the Invention in the Patent.

The twelfth defence consists in an averment that the description of the invention in the specification is insufficient to enable persons skilled in the art to make and use it without the exercise of their own inventive skill. The law requires as a condition precedent to the issue of a patent that the applicant shall file in the Patent Office a written description of the invention, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to make, construct, compound, and use the same; and the decision of the Patent Office as to the applicant's compliance with this condition has, on numerous occasions, been held subject to reconsideration in the courts in cases of infringement.[1] Doubts have, however, been expressed from

[2] That to this defence a fraudulent intent is essential, see Lowell *v.* Lewis (1817), 1 Mason, 182; 1 Robb, 131; Gray *v.* James (1817), Peters C. C. 394; 1 Robb, 120; Whittemore *v.* Cutter (1813), 1 Gallison, 429; 1 Robb, 28.

[3] That ambiguity in the description is a defence only when persons skilled in the art could not from it practise the invention, see § 493 and notes, *ante*, and §§ 970, 1034, 1035, and notes, *post*.

[4] That any fraudulent concealment or redundancy which gives the inventor an advantage over others, even in the mode of enjoying the invention, is fatal, see cases cited in note 1, *ante*.

§ 970. [1] Sec. 4888, Rev. Stat. 1874. That unless a person skilled in the

time to time, and recently by high authority, whether simple ambiguity in the description, though so great as to prevent the public from acquiring any practical knowledge of the invention, if not intentional or fraudulent, could vitiate the patent, or enable an infringer to attack it on this ground alone.[2] This question is of great importance and will bear a somewhat extended consideration. In the first place, it is evident that on principle an ambiguous description of the invention in a patent ought to be regarded as a fatal defect. The contract between the inventor and the public, which is theoretically the basis of his rights, obliges him to place the invention fully before the public, and render it practically available to them, in return for the temporary protection which they accord to him.[3] The method which the law prescribes to him for making this disclosure of his invention is its description in the specification; and if he there fails to sufficiently reveal it, the consequences to the public are the same whether the failure were inadvertent or intentional, since if, in either case, the patent were considered valid, the inventor would receive the protection he desired without bestowing on the public the consideration that the law provides. The doctrine that unless the failure is intentional and fraudulent the patent cannot be attacked therefor entirely loses sight of the true nature of the patent-contract, ignores the right of the public to the disclosure of the invention, and treats the inventor as responsible for no infraction of his own obligations unless they are not only voluntary but spring from a corrupt and evil motive. Such a doctrine is an anomaly in the law of contracts which uniformly regards a breach on one side, from whatever cause arising, as discharging the other party from his corresponding duties. In harmony with the spirit of that law, the protection given to

art can construct and practise the invention from the specification alone without further research or exercise of inventive skill the patent is invalid, see §§ 483–494, and notes, *ante*.

[2] That whether an insufficient description is a defence unless it is fraudulent, and the fraud is alleged, is doubtful, see Loom Co *v.* Higgins (1882), 105 U. S. 580; 21 O. G. 2031.

[3] That the sole consideration for the grant of the monopoly is the communication of the invention to the public by the specification of the patent, see §§ 41, 42, 481, and notes, *ante*.

the patentee should be dependent on his performance of his part of the contract, and his omission to perform it should leave him in the same position which he would have occupied had the contract not been made.[4] Again, the law expressly provides that the patent shall not issue until a sufficient description has been filed. It does not authorize the Patent Office to grant a patent upon an honest attempt of the inventor to set forth his invention; it requires him to attain in his description a certain degree of perspicuity and completeness, to be measured by the ability of persons skilled in the art to practise the invention by merely following its directions. The Patent Office may not be able to subject the description to this test, and may award a patent upon a specification which will not endure it; but in so doing the Office acts beyond its jurisdiction as truly as if it had allowed the patent without requiring any specification whatever. The courts have always unhesitatingly gone behind the judgments of the Patent Office in all cases where its action was not warranted by law, and have held patents void whenever they were granted contrary to the express provisions of the law, although that fact could not be ascertained until some suit upon the patent gave the opportunity for an investigation of its merits.[5] The claim that this particular condition precedent may safely be omitted by the patentee rests upon no exception in the statute, and is not justified by any legal analogy. Again, the fault of ambiguity in the description differs entirely in its character from that of fraudulent redundancy or concealment. In the latter, the inventor endeavors to deceive the public, intending at the outset to obtain an unfair advantage over all those who may attempt to practise his invention. It does not alter his offence nor decrease its gravity that he distinctly

[4] That this doctrine works no hardship to the patentee is apparent from the fact that if his description is imperfect, experience must speedily demonstrate it to him, and the defect is then curable by re-issue. The hardship to the public of being compelled to respect the monopoly while unable to derive from the patent their lawful advantage and of being debarred from defending actions for infringement unless deceit were provable is, on the contrary, great and irremediable.

[5] That the action of the Patent Office in issuing a patent is only *prima facie* evidence of its validity see § 714 and notes, *ante*, and § 1016 and notes, *post*.

communicates a new invention to the public and renders practically available to them an art or instrument they had not before enjoyed. He may do this and still conceal matters which render the invention more available, or falsely represent as necessary to its operation objects or acts which make it more expensive or difficult to use. Such deceit avoids even a beneficial patent, not on the ground that the public have received no consideration for the patent, but on the ground that the attempted fraud forfeits all right of the inventor to protection. Thus though a patentee, who without intending to deceive has failed to properly disclose his invention, may have his patent declared void for want of that particular condition precedent or failure of consideration, he does not lose his right to the protection of his actual invention, but may amend his patent by re-issue and thereafter vindicate his privilege against infringers. But the fraudulent patentee has no such remedy. His patent, being declared void for intentional misrepresentation or concealment, cannot be amended. The defects therein did not occur through inadvertence, accident, or mistake, and hence he must remain perpetually deprived of his exclusive privilege while his invention passes into the free enjoyment of the public. Were these two faults united into one with these distinctions in their individual character and effect, no unintentional insufficiency in the description would in any case require amendment except for the more definite interpretation it might thereby furnish to the Claim, and every judgment against a patentee on the ground of ambiguity in the description would not only destroy the existing patent but debar him from procuring a re-issue. Such certainly has never been the doctrine of the courts, nor could it be adopted at the present day without disorganizing most important branches of our patent jurisprudence. The view here controverted being thus unsound in principle, contrary to statute, and impracticable in application, may safely be regarded as erroneous, and the general current of decisions be relied upon as accurate statements of the law.[6] According to

[6] This misconception arose like many others in the infancy of our patent system and before the distinctions now familiar were clearly recognized. Under the act of 1793 the court had power in a suit for infringement not merely to de-

these, the fact that persons skilled in the art could not from the description alone, without the exercise of their own inventive skill, make and use the invention, invalidates the patent, and constitutes a proper and complete defence in any action for infringement.

§ 971. Thirteenth Defence: Excessive Claims.

The thirteenth defence consists in an averment that the Claims contained in the patent are excessive and include matters which are either open to the public or have resulted from the inventive skill of other individuals. A patentee who intentionally puts forward such excessive Claims, or who persists in them after the discovery of his error, is presumed to be attempting to obtain an unfair advantage over the public by appropriating to himself inventions which belong to them or

cide in favor of the defendant but also to declare the patent itself entirely void, provided certain defences were asserted in a notice and maintained by evidence. Among these was that of fraudulent concealment or redundancy; and though it was always held that other defences known to the law of patents might be urged without such notice, for the purpose of defeating the action against the defendant without affecting the validity of the patent, it seems to have been assumed that when a defendant urged a defective specification it was urged under this statutory privilege and for this double purpose. Hence various decisions are found before the act of 1836, in which the view is taken that a fraudulent intent is necessary in order to render a patent void on account of a defective specification. (See Gray *v.* James (1817), Peters C. C. 394; 1 Robb, 120; Lowell *v.* Lewis (1817), 1 Mason, 182; 1 Robb, 131; Whittemore *v.* Cutter (1813), 1 Gallison, 429; 1 Robb, 28.) In the act of 1836, the power to declare the patent void in infringement suits was not bestowed on the court, but notice was still required to be given if the defendant desired to offer evidence that the specification was fraudulently defective. With this change in the statute the old doctrine of the courts should have also disappeared, especially after the decision in Grant *v.* Raymond (1832), 6 Peters 218; 1 Robb, 604, in which Marshall, J., stated that the notice and evidence of fraudulent intent was necessary only where the purpose of the defendant was to obtain a judgment avoiding the patent, while a defective specification was a good defence under the general issue when the defendant desired only to protect himself against the patentee. Like other errors, however, whose correction depends on an historical study of the law, it has been from time to time revived, and as seen in the case cited in note 2, has even extracted a *quere* from the Supreme Court itself. The paragraphs referred to in note 1 with the cases cited under them sufficiently indicate that the general current of authority supports the position that a defective specification without fraud is now a good defence to an action for infringement.

which they might receive from the actual inventors; and he, therefore, justly forfeits all those rights which otherwise his patent might confer.[1] Under the early English practice this question was determined by a mere inspection of the patent, and if it claimed too much upon its face, it was irremediably defective and invalid.[2] But under our present statutes an excessive Claim may be amended by re-issue or disclaimer when the excessive matter was inserted through inadvertence, accident, or mistake, without wilful default or intent to defraud or mislead the public, and when the remaining matter is a material or substantial part of the invention as originally claimed, and can exist independently of the excess as a complete and patentable invention, provided the amendment is made without unreasonable delay.[3] If, therefore, an excessive Claim is knowingly and wilfully inserted in the patent, or if although inserted without fault it cannot be amended without eliminating all patentable subject-matter from the Claim, or if although amendable its amendment has not been effected with reasonable diligence, the patentee cannot avail himself of the patent in the assertion or vindication of his rights. In all such cases this defence is proper, and the suit based on the patent fails. But in those cases where the Claim is amendable, and reasonable time for the amendment has not yet elapsed, the defect may be removed pending the suit, and this defence will only bar the plaintiff's right to costs.[4] After such an amendment all issues concerning the patentability of

§ 971. [1] That an intentional excessive Claim is an attempt to defraud the public and renders the patent void, see § 644 and notes, *ante*.

That where a Claim is intentionally excessive it cannot be cured by re-issue or disclaimer, see § 644 and notes, *ante*.

[2] That in England a Claim excessive on its face avoided the patent, see Bovill *v.* Moore (1816), Davies P. C. 361; 1 Abb. P. C. 231; Huddart *v.* Grimshaw (1803), 1 Web. 85; 1 Abb. P. C. 128; Rex *v.* Else (1785), 1 Web. 76; 1 Abb. P. C. 40.

[3] That an excessive Claim, if not intentional, is curable by re-issue or disclaimer, see §§ 642–644, 656–658, 687, and notes, *ante*.

[4] That a disclaimer restricting excessive Claims may be filed pending suit, and the plaintiff may then recover on the amended Claim, but without costs, see § 651 and notes, *ante*.

That where one Claim of a patent is declared invalid so nearly to the expiration of the patent that no disclaimer can be filed, the patentee can recover on the valid Claims, though he does not disclaim the invalid, see Kittle *v.* Hall (1887), 30 Fed. Rep. 239.

the invention are limited to the subject-matter of the amended Claim.[5]

§ 972. Fourteenth Defence: Ambiguity in the Claims.

The fourteenth defence consists in a denial that the Claim defines the invention which the patent purports to protect with such precision and completeness as to distinguish it from all other inventions. It is equivalent to an averment that the Claim is ambiguous, uncertain, or unintelligible, and that the patent is therefore void. The Claim of a patent is the life of the patent; and either alone or as interpreted by the description, it must clearly and exactly draw the line between the inventions over which the patentee asserts his exclusive rights, and those which are beyond the scope of his monopoly. If the Claim is unintelligible and conveys no idea of the invention claimed; or if it is uncertain, conveying some idea but not precisely specifying its essential characteristics; or if it is ambiguous, expressing the ideas that underlie two or more different inventions but leaving it doubtful which the inventor actually intends to claim, the patent is inoperative as a grant, and affords no protection to the patentee.[1] In patents which embrace more than one Claim, either for the same or different inventions, the presence of defective Claims does not impair the validity of the others if these are in themselves sufficient.[2] Each Claim is judged by itself, and stands or falls as though it were the only one included in the patent. Hence this defence is proper in suits based on a patent which

[5] That after a disclaimer all questions in reference to the patent concern it only in its amended state, see McCormick *v.* Seymour (1854), 3 Blatch. 209; Clark *v.* Kenrick (1843), 12 M. & W. 221.

That where a disclaimer is made pending suit, the proceedings need not be recommenced, unless the defendant has been prejudiced, see Libbey *v.* Mt. Washington Glass Co. (1886), 36 O. G. 572; 26 Fed. Rep. 757.

§ 972. [1] That ambiguity in the Claim is fatal to the patent, see Edgarton *v.* Furst & Bradley Mfg. Co. (1881), 10 Bissell, 402; 21 O. G. 261; 9 Fed. Rep. 450; Blake *v.* Stafford (1868), 6 Blatch. 195; 3 Fisher, 294; Carr *v.* Rice (1858), 4 Blatch. 200; 1 Fisher, 325; Hovey *v.* Stevens (1846), 3 W. & M. 17; 2 Robb, 567; Brooks *v.* Jenkins (1844), 3 McLean, 432; Ames *v.* Howard (1833), 1 Sumner, 482; 1 Robb, 689; Barrett *v.* Hall (1818), 1 Mason, 447; 1 Robb, 207.

[2] That defective Claims do not impair the validity of such as are sufficient, see §§ 537, 684, 695, and notes, *ante*.

contains a single and defective Claim, or on the invalid Claims of a patent which contains other perfect Claims not covering the infringed invention, but is of course inapplicable in cases where the invention in dispute is properly defined in any one Claim of the patent, however erroneously it is set forth in the others.

§ 973. Fifteenth Defence: Surrender of the Patent.

The fifteenth defence consists in a denial that the patent described in the declaration, though once existing as a valid patent, is now capable of serving as the foundation of a suit. This defence is equivalent to an averment that the patent and all rights of action under it have been extinguished. It concedes that the patent was lawfully issued to the patentee and complied with the various conditions requisite to its validity, but asserts that it has been determined in such a manner as to involve in its destruction all causes of action which had previously arisen. This can occur only in case of the surrender of a patent by its lawful owners, either for the purposes of a re-issue, or as a method of abandoning the invention to the public.[1] The expiration of a patent by lapse of the term for which it was granted does not affect the rights of action which already have accrued.[2] The repeal of a patent, whether at the suit of the government or of an interfering patentee, involves a judgment that it never existed as a valid patent. Thus this defence is applicable only in the case of a surrender, and is available whether the surrender took effect before or after the institution of the suit.

§ 974. Sixteenth Defence: Repeal of the Patent.

The sixteenth defence consists in a denial that the patent, though issued in apparent conformity with the requirements of the law, ever existed as a lawful patent, or still exists in any form whatever. It is equivalent to an averment that the patent was granted contrary to law, and has on that account

§ 973. [1] That the surrender of a patent extinguishes all existing rights of action, see Moffitt *v.* Gaar (1860), 1 Bond, 315.

[2] That an action may be maintained after the expiration of a patent for infringements committed during its term, see §§ 908, 937, 1092 and notes, *post*.

been recalled and cancelled by the government. This occurs in the two cases where a prior inventor and rival patentee obtains the revocation of the patent by an equitable proceeding for that purpose, and where the government itself institutes and prevails in a suit for its repeal. In these cases the patent is held void *ab initio*, all rights acquired under it existing in appearance only, and the monopoly which it purported to create being a wrongful and unwarranted imposition on the public or the true inventor.[1] Where the patent has been repealed *in toto*, as in proceedings by the government or between the rival patentees, this defence is available in any suit based on the patent. Where it has been annulled only in reference to certain owners of the rival patents, this defence is no bar to an action between other owners, the patent as to them remaining unaffected by the judgment.[2] This defence completes the group of those by which the patent is attacked, and its existence or validity denied, on grounds which do not touch the patentability of the invention or the right of the alleged inventor to a patent.

§ 975. Seventeenth Defence: Denial of a Legal Title in the Plaintiff.

The seventeenth defence attacks the title of the plaintiff to the patent, and consists in a denial that his interest in the patented invention is of such a character as to enable him to maintain an action at law. Questions concerning the capacity of the plaintiff to sue, whether they relate to defective corporate organization or to infancy or coverture, and questions concerning the misjoinder or non-joinder of plaintiffs, are not embraced in this defence, such matters being available to the defendant only in abatement.[1] This defence rests upon the

§ 974. [1] That the repeal or annulling of a patent is a rescission of the monopoly *ab initio*, and demonstrates that no rights under it could ever have existed, see §§ 723, 724, 730, and notes, *ante*.

[2] That where a patent is annulled as to certain parties or territory only, it remains in force as to other owners, see Mowry *v.* Whitney (1872), 14 Wall. 434; 1 O. G 499; 5 Fisher, 513; and §§ 723, 724 and notes, *ante*.

§ 975. [1] That the want of corporate capacity on the part of the plaintiffs is no defence, except in abatement, see Dental Vulcanite Co. *v.* Wetherbee (1866), 2 Clifford, 555; 3 Fisher, 87.

That a defect in the organization of a plaintiff corporation cannot be set up

doctrine that at law no one can sue for an infringement unless he is a legal owner of the monopoly, — that is, unless he is a patentee, an assignee, or a grantee enforcing his rights within his own territory.[2] Any defects in these legal titles may be taken advantage of under this defence, but equitable interests cannot be set up in a suit at law to defeat the claims of the record owner of the patent.[3]

§ 976. Eighteenth Defence: Denial that the Art or Instrument Employed by the Defendant is Covered by the Patent.

The eighteenth defence, which is the first one of the group raising an issue on the allegation of infringement, consists in a denial that the art or article employed by the defendant is covered by the patent of the plaintiff. This is equivalent to an averment that the idea of means, embodied and expressed in the invention described and claimed by the patent, is not identical with, or included in, the idea embodied in the invention used by the defendant. This defence does not simply deny the identity of the two inventions, for want of identity is not proof of non-infringement, — an original invention being infringed by the use of an improvement, though important differences subsist between them.[1] It denies that the defendant employs the patented invention either *in specie*, or as the foundation for, or as an element incorporated in, his own. Only, therefore, when his invention excludes the patented invention in every form can the defendant properly urge this defence, and seek escape from liability for an in-

as a defence in a suit for infringement, see Dental Vulcanite Co. *v.* Wetherbee (1866), 3 Fisher, 87 ; 2 Clifford, 555.

[2] That the legal owner of the patent at the date of the infringement, or the assignee of his cause of action, is the only proper plaintiff at law, see §§ 937–943 and notes, *ante*.

That it is no defence to a suit on an extended patent that third parties owned the territory where the infringement is claimed under the original patent, unless they owned the extension also, see Aultman *v.* Holley (1873), 5 O. G. 3.

[3] That the equitable interests of third persons in the patent cannot be set up in defence against the legal title of the plaintiff, see Graham *v.* McCormick (1880), 21 O. G. 1533 ; 11 Fed. Rep. 859 ; 10 Bissell, 39 ; 5 Bann. & A. 244.

§ 976. [1] That wherever the defendant uses the plaintiff's invention either alone or as part of another invention, or coupled with improvements, he is guilty of infringement, see §§ 891–894 and notes, *ante*.

fringement in the fact that the invention which he has employed is not within the monopoly created by the patent.[2]

§ 977. Nineteenth Defence: Denial that the Acts of the Defendant were Infringing Acts.

The nineteenth defence consists in a denial that the acts performed by the defendant in relation to the patented invention were of such a character as to subject him to an action for infringement. It is equivalent to an averment that whatever else he may have done, he has not voluntarily made or used or sold the patented invention. According to the judicial interpretation given to the terms "make" and "use" and "sell," they embrace many actions outside of their ordinary and technical meanings, their construction being extended to include the various artifices to which adroit infringers may resort, in order to effect the same results that are attained by the usual modes of making, use, or sale.[1] This defence is, therefore, appropriate when the conduct of the defendant in reference to the invention does not fall within the interpretation given to either of these terms. It is also proper where his acts, though in their nature true acts of infringement, were not voluntarily performed, as in the case of workmen, agents, or officials acting under orders and having no discretion as to the instruments or operations they employ in carrying out the commands of their superiors. In such cases the acts of infringement, though physically their own, are not legally imputable to them, but to the persons in obedience to whose orders and direction they have been committed.[2]

[2] That the defendant may show that he does not infringe at all or that he infringes only a part of the Claims, see Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337.

§ 977. [1] As to the various forms which acts of infringement may assume, see §§ 897–905, 922–930 and notes, *ante*.

[2] That an involuntary act, or an act in obedience to legal superiors is not an infringement, see Hollister *v.* Benedict Mfg. Co. (1885), 113 U. S. 59; Heaton *v.* Quintard (1869), 7 Blatch. 73; Delano *v.* Scott (1834), 1 Gilpin, 489; 1 Robb, 700.

§ 978. Twentieth Defence: Denial that the Alleged Acts of Infringement were Committed while the Patent was in Force.

The twentieth defence consists in a denial that the patent was in force when the alleged acts of infringement were committed. It concedes that the patented invention has been made or used or sold by the defendant, but avers that these acts were performed either before the patent issued or after it expired. Whatever rights of action may accrue at common law to the owner of an invention from its unauthorized use before the date of his patent, and whatever redress for such use may be awarded in the English courts in a suit based upon the patent, our own courts have uniformly held that no suit for infringement can be sustained under our Patent Law unless the acts complained of were performed after the patent had been granted.[1] The patent is regarded as the foundation of the right which is invaded by the infringement, and only acts committed while the patent is in force can violate the right which it creates. For this reason, also, acts perpetrated after the patent has expired are not infringements, except in cases where they are performed in consequence of plans devised and preparations made during the life of the patent, the present act thereby relating back and constituting one transaction with the former, and thus rendering the defendant liable for both.[2] This defence, therefore, either simply puts in issue the date of the alleged infringement as compared with the dates of the grant and the expiration of the patent, or, in addition to these, it raises the question whether the acts performed after the patent had expired were so connected with preceding acts as to make them elements in a line of conduct which, taken as a whole, amounted to infringement. In estimating the duration of a patent the term expressed upon its face is not conclusive.[3] If prior foreign patents have been

§ 978. [1] That no infringement of the patent is possible until after the patent has been granted, see § 907 and notes, *ante*.

[2] That acts of infringement may be committed after the patent has expired, if relating back to preparations made while the patent was in force, see § 908, and notes, *ante*.

[3] That the date of the expiration of a patent is fixed by law, whatever the term named therein may be, see § 622 and notes, *ante*.

issued for the same invention, the life of the domestic patent must be measured by that of the foreign patent which will first expire, if within the statutory period of seventeen years.[4]

§ 979. Twenty-First Defence: Co-ownership of the Patent, or License from its Lawful Owner.

The twenty-first defence consists in an averment that the acts of making, using, and selling the patented invention, though voluntarily performed by the defendant during the life of the patent, were not wrongful invasions of the plaintiff's rights. It is equivalent to a plea of justification, and an allegation that the defendant acted upon due authority. It is a proper defence where one part-owner of a patent is sued by his co-owner for acts which are confined to the employment of the patented invention, or where for similar acts a licensee is made defendant in proceedings instituted by his licensor.[1] But where the invention used by a part-owner or a licensee is not identical with that protected by the patent, this defence will not avail.[2] In such cases there is either no infringement because the invention practised does not include the patented invention, or the acts of the part-owner or licensee in employ-

[4] That the duration of a patent is limited by that of the prior foreign patent having the shortest term, see § 622–624 and notes, *ante*.

That an English patent, taken out without authority from the American inventor, cannot affect his rights in the United States, see Kendrick *v.* Emmons (1875), 9 O. G. 211; 2 Bann. & A. 208.

That the validity of an American patent is not affected by that of a foreign patent, though its duration may be, see Cornely *v.* Marckwald (1883), 24 O. G. 498; 21 Blatch. 367; 17 Fed. Rep. 83.

§ 979. [1] That a part-owner does not infringe by any use of the patented invention, see Herring *v.* Gas Consumers Association (1878), 9 Fed. Rep. 556; 21 O. G. 203; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253; also §§ 796, 797, 913 and notes, *ante*.

That the acts of alleged infringement are performed under a license, is a sufficient defence, see Watson *v.* Smith (1881), 20 O. G. 300; 7 Fed. Rep. 350.

See also § 915 and notes, *ante*.

[2] That a part-owner may infringe by using an infringing invention, see Herring *v.* Gas Consumers Association (1878), 9 Fed. Rep. 556; 21 O. G. 203; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253; also § 913 and notes, *ante*.

That a licensee may infringe by using an infringing invention, or by any use of the patented invention which is not covered by his license, see §§ 819, 915 and notes, *ante*.

That a receiver of a firm cannot defend on the ground of a license granted personally to the copartners, see Curran *v.* Craig (1884), 22 Fed. Rep. 101.

ing other inventions which include the patented invention lie outside the authority conferred upon them by the patent or the license, and hence are true infringements.[8] This defence completes the group of those which, admitting the patentability of the invention, the validity of the patent, and the title of the plaintiff, deny that the defendant voluntarily and without authority made, used, or sold the patented invention.

§ 980. Twenty-Second Defence: Statute of Limitations.

The twenty-second defence is the first one of a special group whose members have no immediate resemblance to each other, save that they recognize the existence of a cause of action on the part of the plaintiff against the defendant, and aver that he has forfeited by his own conduct his right to legal redress. All these defences rest ultimately on the doctrine of estoppel, — the difference between them residing in the acts out of which the estoppel arises and the authority by which it is defined and enforced. The first consists in an averment that the plaintiff has not commenced his action within the time prescribed by the Statute of Limitations. Whether this defence is permissible in a suit for the infringement of a patent is a question of some difficulty, which has not been completely settled by the courts. That where an act of Congress fixes a period, within which actions of infringement must be brought, the expiration of that period effectually deprives the owner of the patent of his right to sue may be regarded as indisputable. But when no Federal statute of this character exists, as was the case before the

[8] That mere non-payment of royalties does not forfeit a license unless the contract so provides, and the continued use of the licensed invention is a mere breach of contract, not an infringement, see Consolidated Middlings Purifier Co. *v.* Wolf (1886), 37 O. G. 567; 28 Fed. Rep. 814.

That the covenants in a license cannot deprive a licensee of the right to show that he does not infringe, see White *v.* Lee (1882), 23 O. G. 1621; 14 Fed. Rep. 789.

That if a license set up in defence is shown to have been revoked before the infringement, the defence will be overruled, and the defendant allowed to defend like other infringers, see Wooster *v.* Singer Mfg. Co. (1883), 23 O. G. 2513.

That the rights of a purchaser from a foreign maker are subordinate to those of the patentee under his American patent, see Graff *v.* Boesch (1887), 33 Fed. Rep. 279.

act of 1870 and has been since the Revision of 1874, the limitation, if there be any, must result from the statutes of the State in which the action is commenced. Whether such statutes apply to suits under the Patent Law is doubtful. Some courts have affirmed while others have denied it.[1] In

§ 980. [1] In Hayden *v.* Oriental Mills (1883), 15 Fed. Rep. 605, Lowell, J.: (605) "Several judges of great ability and experience have held that the Statutes of Limitation of the States do not affect actions upon patent rights, upon the theory that Sec. 34 of the Judiciary Act (now Rev. Stat. Sec. 721), making the laws of the States the rules of decision in the courts of the United States, in actions at the common law, does not apply to actions which are within the exclusive jurisdiction of the courts of the United States. There are several able decisions on the other side, but perhaps the weight of authority is with the plaintiff on this point. We give the citations in a note at the end of this opinion. This is an action at law, and if the statutes in question do not apply, there is no limitation, unless it be that of Rhode Island in 1789, — for a court of common law has no discretion to refuse to entertain stale claims. This result appears to us to be inadmissible. No reason is given in any decision for excepting one class of cases out of Sec. 721. Some arguments upon the general question have been made which we shall advert to. There is no such exception in the statute itself, and none in its intent and purpose. Exclusive jurisdiction is given for reasons which are apart from this question. For instance, in patent cases the Federal courts have this control in order that the construction of the law and of the patents granted under it may be as nearly uniform as possible, not that the remedies of a patentee shall be of uniform duration. Equity is a uniform system in the Federal courts throughout the United States, but the remedies in equity are barred in those courts by the State Statutes of Limitation in certain cases. . . . To us it seems as inadmissible to say that Sec. 721 does not apply to patent cases, as that the law adopting the general practice of the States does not apply to them. In one particular it perhaps does not, because the statute says that an action on the case shall be the remedy. This is a reproduction of the old law which was passed when all the States had that form of action, and may or may not now be an exclusive remedy; but no one can deny that in other respects the process and procedure acts apply to actions at law for the infringement of patent-rights. A dozen questions may arise in any patent case which can only be decided by the law of the State. There is no doubt, of course, of the right of Congress to make a Statute of Limitations for patent causes. The power is specially reserved in Sec. 721, and by the act of 1870, Sec. 55 (16 St. 206), they made such a law, which provides that all actions shall be brought within the term for which letters-patent shall be granted or extended, or within six years thereafter. Congress, when they passed this act, may have supposed that there was no limitation; but, if so, they found out their mistake, for they repealed this part of the patent law, when they passed the Revised Statutes, by omitting it from the chapter on patents. Sayles *v.* Oregon Central R. R. Co., 6 Sawy. 31; Vaughn *v.* East Tenn. &c. R. Co., 11 O. G. 789. When they thus repealed the act of Congress, the State law became again applicable

this divergence of authority no opinion can be more than probable. The peculiar nature of a patent right as a uni-

to future infringements, but one of the repealing sections (Sec. 5599) reserves all existing causes of action, so far as limitations are concerned, precisely as *though no repeal had been made.* Sayles *v.* Oregon Central R. R. Co., *supra;* Vaughn *v.* East Tenn. &c. R. Co. *supra.*" 24 O. G. § 601 (601).

In Sayles *v.* Richmond, Fredericksburg & Potomac R. R. Co. (1870), 3 Hughes, 172, Hughes, J.: (173) "The thirty-fourth section of the Judiciary Act of 1789 (Sec. 721 of the Revised Statutes of the United States) is the only general statute of limitations known in Federal legislation. In providing that the laws of the several States shall be the rules of decision *in trials at common law in courts* of the United States, except where treaties or acts of Congress otherwise provide, Congress virtually adopted the Statute of Limitations of each State as the limitation of actions brought in the United States courts held in that State. This point is so thoroughly settled that it is useless for me to cite authorities on the subject." 4 Bann. & A. 239 (240); 16 O. G. 43 (43).

Further, that State Statutes of Limitation apply where there is no Federal statute, see Royer *v.* Coupe (1886), 29 Fed. Rep. 358; 39 O. G. 239; Hayward *v.* City of St. Louis (1882), 11 Fed. Rep. 427; 3 McCrary, 614; Sayles *v.* Oregon Central R. R. Co. (1879), 6 Sawyer, 31; 4 Bann. & A. 429; Rich *v.* Ricketts (1870), 7 Blatch. 230; Parker *v.* Hawk (1857), 2 Fisher, 58.

That State Statutes of Limitation do not apply where there is a Federal statute, see Sayles *v.* Louisville City R. R. Co. (1881), 9 Fed. Rep. 512; Sayles *v.* Lake Shore & Michigan Southern R. R. Co. (1879), 9 Fed Rep. 515; Sayles *v.* Dubuque & Sioux City R. R. Co. (1879), 9 Fed. Rep. 516; 5 Dillon, 561; 3 Bann. & A. 219.

On the contrary: In Anthony *v.* Carroll (1875), 2 Bann. & A. 195, Shepley, J.: (197) "Should the *legislature* of a State pass an act in express terms limiting the time for bringing an action in the Federal courts for infringement of patent-rights, there can be no reasonable doubt that such a statute would be unconstitutional and void. The policy of the government to provide a uniform system of rights and remedies throughout the United States upon the whole subject-matter of patents for new and useful inventions and discoveries by placing it under the control of Congress and the Federal courts would be frustrated if such State legislation could directly or indirectly limit, restrict, or take away the remedy. For these reasons I think no State Statute of Limitations can be pleaded in bar of this action." 9 O. G. 199 (200).

In Read *v.* Miller (1867), 3 Fisher, 310, McDonald, J.: (313) "Since, then, no State has any power to legislate concerning patent-rights, and no State court has jurisdiction to adjudicate concerning any violation of them, it can hardly be supposed that a State may, nevertheless, pass Statutes of Limitation *concerning them,* which shall control national courts in suits brought for their infringement. It ought not to be presumed that the State legislature, in passing a Statute of Limitation, ever intended it to extend to patent-right litigations, since such litigation cannot arise in a State court. Nor ought the presumption to be indulged that Sec. 34 of the Judiciary Act could have been intended to authorize State legislatures to pass Statutes of Limitation on subjects over which the States have no control. Moreover, it should

versal franchise co-extensive with the United States, its extreme susceptibility to secret invasion, the fact that numerous causes of action against different defendants involving in the main the same issues and practically requiring but one extended litigation often arise almost simultaneously, and the manifest advantage of uniformity throughout the entire country in all matters connected with the enforcement of any universal right, indicate that this important feature of remedial jurisprudence is solely within Federal jurisdiction, and can be regulated only by the acts of Congress. If these prescribe no period of limitation for the remedies which they provide in cases where the rights which they create are violated, it is a fair presumption that Congress, in whom the supreme power over all these subjects unquestionably resides, intends that no such limitation shall exist. In this view it seems probable that State Statutes of Limitation afford the defendant no ground of defence. The only Federal statute of this character which

be noted that Sec. 34 of the Judiciary Act only makes the laws of the several States rules of decision in the national courts '*in cases where they apply.*' Now, it appears to me that these State laws do not apply in cases over which State governments have no control whatever, and which are under the exclusive control of the general government. The counsel for the defendants seems to rely confidently on the case of McLuny *v.* Silliman, 3 Peters, 270, as sustaining the pleas in question. But I think that case not in point. It was an action against Silliman, a land officer, for official misconduct. Over the subject-matter of it, I suppose the State and national courts had concurrent jurisdiction. If so, the case evidently fell within the provisions of Sec. 34 of the Judiciary Act, and so it was decided by the Supreme Court. In that case, therefore, the plea of the Statute of Limitation of the State of Ohio was very properly held to be a good bar to the action. Upon the whole, I conclude that no State Statute of Limitation can bar this action. And I think that, should a State legislature pass an act in express terms limiting the action on the case for violating patent-rights, a thing I believe never yet attempted by any State legislature, such an act would be unconstitutional and void." 2 Bissell, 12 (15).

Further, that State Statutes of Limitation do not apply to patent cases, see May *v.* Logan Co. (1887), 41 O. G. 1387; 30 Fed. Rep. 250; May *v.* Rills Co. (1887), 40 O. G. 575; 31 Fed. Rep. 473; May *v.* Cass Co. (1887), 30 Fed. Rep. 762; May *v.* Buchanan Co. (1886), 39 O. G. 120; 29 Fed. Rep. 469; Adams *v.* Bellaire Stamping Co. (1885), 33 O. G. 623; 25 Fed. Rep. 270; Anthony *v.* Carroll (1875), 9 O. G. 199; 2 Bann. & A. 195; Collins *v.* Peebles (1865), 2 Fisher, 541.

That whether State Statutes of Limitation apply is doubtful, see Stevens *v.* Kansas Pacific R. R. Co. (1879), 5 Dillon, 486; Sayles *v.* Dubuque & Sioux City R. R. Co. (1878), 5 Dillon, 561; 3 Bann. & A. 219; 9 Fed. Rep. 516.

ever has existed formed a part of the Patent Act of 1870.[2] It provided that all actions should be brought during the term for which the letters-patent were granted or extended, or within six years after the expiration thereof. This enactment was omitted from the Revised Statutes of 1874, presumably because it was judged inexpedient to retain it. While it was in force its construction was disputed, — some authorities deciding that a cause of action arising under the original term of a patent was barred in six years after the expiration of that term although the patent might have been extended; others regarding the original and extended terms as legally but one and the statute as inoperative against any right of action until six years had elapsed after the patent had finally expired.[3] To what causes of action the limitation applied was

[2] That before July 8, 1870, no Federal Statute of Limitations applied to patent cases, see Wood *v.* Cleveland Rolling Mill Co. (1871), 4 Fisher, 550.

[3] In Sayles *v.* Louisville City R. R. Co. (1881), 9 Fed. Rep. 512, Barr, J.: (514) "It is not true that letters-patent run for only one term when the patent is extended. In such a case there are two terms, — the original term and the extended term, — and though the law provides that when a patent is extended it shall have the same effect in law as though it had been originally granted for twenty-one years, that does not change this fact, nor does it change the fact that the original term was for fourteen years, and not twenty-one years. The act does not provide that the two terms shall be considered as one term in law, but simply provides that the extension of a patent shall have the same effect in law as though it had been originally granted for twenty-one years. I think Congress has, in the clause under consideration, clearly recognized that an extended term and the original term of letters-patent are distinct terms. An extended term of letters-patent can have the same effect in law as though it had been granted for twenty-one years, in the granting of a monopoly, without extending the time of the bar of the Statute of Limitation on existing causes of action. The patent-right is quite distinct from the causes of action which a patentee may have for its infringement; and because a patent-right may be extended it does not follow that the time within which such causes of action should be brought should also be extended."

In Sayles *v.* Lake Shore & Mich. So. R. R. Co. (1879), 2 Fed. Rep. 515, Harlan, J.: (515) "I have reached a conclusion entirely satisfactory to my own mind, and I think that statute means that where the party sues for any infringement under the original term, he must bring his action within six years after the expiration of that term; and when he sues for anything that has occurred under the extended term, he must sue within six years after the expiration of that extension; and that the statute does not mean, as contended for by the learned counsel for the complainant, that the party has the right to sue for an infringement, either under the original or extended term, within six years after the expiration of the extended term, and thus bring the

also doubtful. Under the general doctrine that Statutes of Limitation are not retrospective unless expressly so provided, this Federal statute could not affect a right of action existing at the date of its enactment, though based upon a patent which had long before expired, at least till after six years from the passage of the act.[4] Rights of action accruing under patents which expired while the act remained in force were held to have been barred in six years after such expiration, although meantime the act had been repealed.[5] And it has been asserted that rights of action, growing out of infringements committed during the existence of the statute against patents which expired after the statute was repealed, were also barred unless suit were commenced within six years after the patent had expired.[6] Giving to this defence its wid-

suit within twenty-seven years. I do not think that was the purpose of Congress, and I therefore sustain the grounds of demurrer as to all causes of action."

Further, that a suit for a cause of action arising under the original term must be brought within six years after such term expires, though the patent be meanwhile extended, see Hayden *v.* Oriental Mills (1884), 22 Fed. Rep. 103.

That under the Statute of Limitations of 1870, if a suit is brought within five years after the expiration of the extended term, the plaintiff may recover only for infringements during the extension, see Sayles *v.* Dubuque & Sioux City R. R. Co. (1878), 5 Dillon, 561; 3 Bann. & A. 219; 9 Fed. Rep. 516.

Contra: That where a patent has been extended and a suit is brought within the time limited by the statute after the extension expires, the plaintiff may recover for the entire twenty-one years of the patent, see Sayles *v.* Richmond, Fredericksburg, & Potomac R. R. Co. (1879), 3 Hughes, 172; 16 O. G. 43; 4 Bann. & A. 239.

[4] That Statutes of Limitation are only prospective unless the contrary appears, see Vaughn *v.* East Tennessee, Virginia, & Georgia R. R. Co. (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

That Sec. 55, act July 8, 1870, under Sec. 5599, Rev. Stat. 1874, applies to rights of action which were old enough at the time of its approval to have been fully barred by the State statute if such statute had been pleaded, see Hayden *v.* Oriental Mills (1884), 22 Fed. Rep. 103.

[5] That since the repeal of the limitation clause in Sec. 55, act of 1870, an action upon a patent expiring before the Revised Statutes were adopted may be brought within six years after the expiration of the patent, see Vaughn *v.* East Tennessee, Virginia, & Georgia R. R. Co. (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

[6] That Sec. 55, act of July 8, 1870, is not repealed so as to relieve either party from the rule limiting actions to six years after the end of the extended term, see Hayward *v.* City of St. Louis (1882), 11 Fed. Rep. 427; 3 McCrary, 614.

That no Federal Statute of Limitations affecting infringements committed since June 22, 1874, is now in force, see May *v.* Logan Co. (1887), 30 Fed. Rep. 250; 41 O. G. 1387.

est scope, it may, therefore, be proper for a defendant, now sued for an infringement committed while the Federal statute was in force, to urge that statute as a bar, in case the patent has expired more than six years before the suit was brought. It may also be proper to seek refuge in this statute in cases where the patent expired during its existence, although the infringement took place before it was enacted, as well as in cases where the patent had expired before the act was passed. It is not proper to urge the Federal statute where the infringement occurred after its repeal. In cases where the Federal statute is not applicable, a defence based on State statutes may be sustained. But the entire subject is involved in so much obscurity, through the doubt as to State jurisdiction in any case, and the confusion incident to the repeal of the Federal statute before the limitation could have affected any cause of action, that every form of this defence must be experimental until new legislation, or a decision of the court of last resort, shall make the matter plain.

§ 981. Twenty-Third Defence. Estoppel.

The twenty-third defence consists in an averment that the plaintiff, though having an existing cause of action, is estopped by his own conduct from pursuing any remedy against the defendant. This defence is based on that form of estoppel which arises out of the actions or omissions of the plaintiff in reference to the defendant or out of the relations which subsist between them. The doctrine of estoppel *in pais*, as applicable to suits at law, is not at the present time entirely clear. That where the plaintiff has designedly misled the defendant by his actions or omissions, he cannot take advantage of the position, in which the defendant has placed himself in consequence thereof, to injure the defendant, is now, as it has always been, a settled rule of law.[1] That where the law imposes on the plaintiff the performance of a

§ 981. [1] That the plaintiff cannot recover damages for acts which he has intentionally misled the defendant to perform, see Dickerson *v.* Colgrove (1879), 100 U. S. 578; Morgan *v.* R. R. Co. (1877), 96 U. S. 716; Barnard *v.* Campbell (1874), 55 N. Y. 456; Rice *v.* Barrett (1874), 116 Mass. 312; Bronson *v.* Chappell (1870), 12 Wall. 681.

certain duty for the protection of the defendant, he cannot avail himself of any fault of the defendant which his own fulfilment of that legal duty might have prevented, is equally indisputable.[2] In both these cases there is present an element of wilful wrong on the part of the plaintiff, which the law will not permit him to employ to his own benefit and the defendant's injury. In equity, however, this element of wilful wrong is not essential in order that the plaintiff may be bound by an estoppel. Equity places on an equal footing acts of intentional wrong and intentional acts whose consequences are identical with those of acts of intentional wrong. It looks upon the effect of conduct, not upon its motive, and thus works an estoppel whenever the voluntary actions or omissions of the plaintiff were calculated to and did mislead the defendant, although the plaintiff may have actually contemplated and designed no such result.[3] While courts of equity and courts of law were entirely distinct, each retained its own doctrine of estoppel *in pais*, and administered it without modification by the other. But in the recent approach and intermingling of these two systems of practical jurisprudence, the courts of law have adopted wider views of this as well as many other doctrines, and the precise line of demarcation between them has disappeared. Thus, as a defence to an action at law, estoppel *in pais* might unquestionably be urged by the defendant whenever the plaintiff had intentionally misled him into the violation of the plaintiff's rights, or where the plaintiff had neglected some legal duty by whose performance such viola-

[2] That the plaintiff cannot recover damages for acts which it was his own legal duty to prevent the defendant from ignorantly committing, unless his duty has been performed, see Pickard *v.* Sears (1837), 6 A. & E. 469; Young *v.* Grote (1827), 4 Bing. 253.

That silence when it is a duty to speak works an estoppel, see Bank *v.* Lee (1839), 13 Peters, 107.

That a plaintiff is not estopped by silence, unless his failure to speak when it was his duty to do so has misled the defendant, see Reay *v.* Raynor, (1884), 26 O. G. 1111; 19 Fed. Rep. 308; 22 Blatch. 13; N. Y. Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519; R. R. Co. *v.* DuBois (1870), 12 Wall. 47.

[3] That in equity a plaintiff cannot recover for acts which his own conduct or declarations induced the defendant to perform, although such inducement were not intentional, see Bispham, Eq. Jur., Secs. 282–290; 2 Story, Eq. Jur., Sec. 1538.

tion might have been prevented. According to the current of authority this defence can also be made when the conduct of the plaintiff, though he did not explicitly intend to mislead the defendant, was of such a character that he might reasonably have expected that the defendant would thereby be misled.[4] But conduct of the plaintiff, lawful in itself, and not of such a nature or coupled with such circumstances as indicate that he must reasonably have expected the defendant to be influenced by it in his own behavior, seems not yet regarded as working an estoppel in a court of law.[5] The estoppel which arises out of the relations that subsist between the parties is also of equitable origin, and the extent to which it may be made available in courts of law is not determined. Applying the foregoing doctrines to a suit at law for the infringement of a patent, this defence may be urged whenever the conduct of the plaintiff toward the defendant has been such as might reasonably be expected to mislead and has misled the defendant into the commission of the acts for which he is now sued.[6] Any enumeration of the actions or omissions of the

[4] That a party is bound by acts which his own conduct or declarations induced others to perform, if under the circumstances he might reasonably have expected that they would be misled, see Bassett *v.* Bradley (1880), 48 Conn. 224.

That in this country equitable estoppel is as valid a defence at law as in equity, see Concord *v.* Norton (1883), 16 Fed. Rep. 477.

[5] That in law the mere fact that the defendant was misled by the conduct or declarations of the plaintiff does not work an estoppel on the latter, see Drexel *v.* Berney (1883), 16 Fed. Rep. 522; 21 Blatch. 348.

[6] That a patentee cannot sue persons using the invention under a license from a third party whose interest in the patent has been admitted by the patentee, unless they continue such use after being notified of his exclusive rights, see Gear *v.* Grosvenor (1873), 3 O. G. 380; 6 Fisher, 314; Holmes, 215.

That an inventor who permits another to take out a patent, and then himself takes out a different patent for a different invention, is estopped to allege that he invented the subject-matter of the first patent, see Fraim *v.* Keen (1885), 25 Fed. Rep. 820; 34 O. G. 1048.

That where the officers of an infringing corporation purchase the patent and retire from the corporation, they cannot sue the corporation for infringing the patent under their management, see New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1885), 24 Fed. Rep. 604; 32 O. G. 1356.

That the owner of the patent is not estopped from suing by his admissions that he was not the owner, if the admissions were in good faith and were recalled before they were acted on, see Gear *v.* Grosvenor (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

That an inventor is not estopped by a mistaken claim in his application that

plaintiff which constitute such conduct is, of course, impossible. An estoppel is pre-eminently the creature of circumstances, and only in the light of all those which enter into and surround the given transaction can its character be definitely known. Many of the actions of the plaintiff which might be relied on as resulting in an estoppel have also been regarded by the courts as creating an implied license to practise the invention, and such acts may be taken advantage of either under this or that form of defence.[7] Among the omissions of the plaintiff, one derives its character and effect from the express provisions of the law. This consists in the neglect of the owner of the patent for an article to give the public information that the same is patented by stamping the artic itself, or the package in which it is contained, with the word "patented," accompanied by the date of the patent. A plaintiff, who omits this duty, is estopped from claiming substantial damages for any infringement committed by the defendant before he receives notice from the plaintiff that his acts are an invasion of the patent.[8] An omission to commence legal proceedings against infringers, within a reasonable time after their infringements became known to the owner of the patent, may work an estoppel in a court of equity.[9] Whether it has the same effect in a court of law may well be doubted, except in cases where it is sufficient evidence of an abandonment of the invention to the public.[10] But the institution of a single suit against one infringer is notice to all others that the plaintiff intends to vindicate his rights under the patent, and no delay in suing them can then raise an estoppel in their favor.[11] The relation that subsists between

his invention is the same as that covered by his foreign patents, see Commercial Mfg. Co. *v.* Fairbank Canning Co. (1886), 27 Fed. Rep. 78; 36 O. G. 1473.

[7] For a discussion of license by estoppel, see § 834 and notes, *ante*.

[8] For the effect of a failure to stamp patented articles as required by law, see § 628 and notes, *ante*.

[9] That a mere delay in suing an infringer may work an estoppel in equity, see §§ 1114, 1194, 1195, and notes, *post*.

[10] That in the absence of a Statute of Limitations a delay in suing an infringer does not work an estoppel, unless the conduct of the patentee is equivalent to an abandonment of the invention to the public, see Ransom *v.* Mayor of New York (1856), 1 Fisher, 252.

[11] That the bringing a suit against one infringer is, in equity, notice to all

a transferor or transferee of any interest in a patented invention is also ground for an estoppel in a court of law, in any case where the transferor is plaintiff, and in his suit he must attack either the existence or validity of the transfer he has made.[12]

§ 982. Twenty-Fourth Defence: Release.

The twenty-fourth defence consists in an averment that the cause of action formerly existing in favor of the plaintiff against the defendant has been voluntarily extinguished by the plaintiff. A cause of action arising from the infringement of a patent may be destroyed by the owner of the patent in either of two methods: (1) By a surrender of the patent to the government, which terminates alike the existence of the patent and all rights of action based thereon; or, (2) By a release to the infringer, which terminates the cause of action but does not affect the existence of the patent. As the present defence does not attack the validity or existence of the patent, but the cause of action only, it is proper in the single case where the owner of the patent, subsequently to the infringement, has expressly or impliedly released the infringer from his liability therefor.[1] Such a release may be in writing under seal, or may arise by presumption of law out of other transactions between the parties.[2] The releasor must have had the legal right to grant it, and the defendant must have received it in good faith

others of their liability, and prevents an estoppel by laches, see § 1114 and notes, *post*.

[12] That a transferor is estopped to deny the validity of the patent or the rights of his transferee, see Birdsall *v.* Curran (1887), 31 Fed. Rep. 918; 42 O. G. 1167; American Paper Barrel Co. *v.* Laraway (1886), 28 Fed. Rep. 141; 37 O. G. 674; Alabastine Co. *v.* Payne (1886), 27 Fed. Rep. 559; 35 O. G. 1438; Parker *v.* McKee (1885), 32 O. G. 137; 24 Fed. Rep. 808; Underwood *v.* Warren (1884), 21 Fed. Rep. 573; Thomas *v.* Quintard (1855), 5 Duer, 80; and §§ 787, 789, and notes, *ante*.

That a plaintiff cannot deny the existence of a corporation through which he derived title, see Bogart *v.* Hinds (1885), 33 O. G. 1268; 25 Fed. Rep. 484.

§ 982. [1] That a release is a good defence to an action for infringement, see Goodyear *v.* McBurney (1853), 3 Blatch. 32.

That a written release under seal of one of two joint infringers is a bar to a suit against the other, though he may still be enjoined from further infringements, see Babcock & Wilcox Co. *v.* Pioneer Iron Works (1888), 43 O. G. 756.

[2] That a release may be implied from circumstances, see 2 Pars. Cont. 715.

and not in fraud of other owners of the patented invention; and if it were conditional, such conditions must have been fulfilled.[3] A plaintiff having given a valid release to the defendant is bound by it, not only as a contract relinquishing his former cause of action, but as an estoppel which prevents him from pursuing any remedy thereon.[4]

§ 983. Twenty-fifth Defence: Res Adjudicata.

The twenty-fifth defence consists in an averment that whatever cause of action may have once subsisted in favor of the plaintiff against the defendant, it has now been merged in, or extinguished by, a lawful judgment. The doctrine of *res adjudicata* is fully applicable to cases of infringement. The recovery of a judgment by the plaintiff against the defendant for a given act of infringement changes the character of the plaintiff's claim from tort to contract, and when the judgment has been satisfied destroys it altogether. This defence is, therefore, proper when a second suit is instituted between the same parties on an infringement for which the plaintiff has already recovered a judgment against the defendant.[1] A judg-

[3] That no release is valid unless the releasor had at the time the legal right to grant it, see Goodyear *v.* McBurney (1853), 3 Blatch. 32.

That where in a suit by a patentee on behalf of a licensee the defendant sets up a release from the patentee, it will not avail him if the license was granted before the release, and this fact will be sufficient upon replication, see Goodyear *v.* McBurney (1853), 3 Blatch. 32.

That a fraudulent release is invalid, see 2 Pars. Cont. 715.

That an infringer, taking a release from one owner of a patent, receives it with notice of, and subject to, the equities of the other owners, see Kearney *v.* Lehigh Valley R. R. Co. (1886), 27 Fed. Rep. 699.

That a conditional release is no defence unless the conditions have been performed, see 2 Pars. Cont. 714.

[4] That a release destroys the cause of action and prevents the application of the remedy, see 2 Pars. Cont. 713.

§ 983. [1] That a former recovery is a bar to a new suit for the same cause of action, see Lyon *v.* Perin & Gaff Mfg. Co. (1888), 43 O. G. 983; Puetz *v.* Bransford, (1887), 41 O. G. 353; 32 Fed. Rep. 318; Cromwell *v.* County of Sac (1876), 94 U. S. 351.

For the effect of a recovery against one joint infringer, see § 948, note 3, *ante*.

That the wrongful sale of an invention is a tort for which the plaintiff can recover in a tort action, or by waiving the tort in assumpsit for the price received; and in the latter case no one could at any time be sued, if recovery were once had against the seller, see Steam Stone Cutter Co. *v.* Sheldons (1883), 15 Fed. Rep. 608; 24 O. G. 703; 21 Blatch. 260.

That a recovery from a maker is no

ment in favor of the defendant in a suit for an infringement is equally conclusive on the rights of the parties, and estops the plaintiff from any subsequent assertion of his claim.[2] The judgments in both these cases must have been final judgments, rendered on the merits, and covering the same issue of infringement.[3] Interlocutory decisions and judgments in

defence to the vendee unless the judgment against the maker has been satisfied, and included the article sold to the vendee, and a plea not alleging such satisfaction discloses no defence, see Fisher *v.* Consolidated Amador Mine (1885), 25 Fed. Rep. 201 ; 11 Sawyer, 190.

That a judgment and payment of nominal damages by one defendant, in a suit brought by the patentee without joining his licensee, for making and selling one machine are no bar to a suit by the patentee and licensee, for the benefit of the licensee, against the vendee of such defendant for using the same machine, see Birdsell *v.* Shaliol (1884), 112 U. S. 485 ; 30 O. G. 261.

[2] That a decree of invalidity in the Federal courts is conclusive on the parties, see Hawks *v.* Swett (1875), 4 Hun, 146 ; 6 Thomp. & C. 529.

That a former judgment on the same title may be a bar if specially pleaded, though some of the parties are different, see Richardson *v.* Lockwood (1870), 4 Clifford, 128.

That a final decision in an interference is conclusive between the parties until reversed or affected by equity proceedings under Sec. 4915, Rev. Stat., see Peck *v.* Collins (1877), 70 N. Y. 376.

That a decree by consent on an issue of title is *res adjudicata* as to all the parties, see Tomkinson *v.* Willets Mfg. Co. (1884), 31 O. G. 918 ; 23 Fed. Rep. 895 ; 32 O. G. 382 ; *Ex parte* Pentlarge (1879), 17 Blatch. 306 ; 4 Bann. & A. 607.

That a decree by consent in a former suit between the plaintiff's assignor and the present defendant is *res adjudicata*, see United States Metallic Packing Co. *v.* Tripp (1887), 39 O. G. 1554 ; 31 Fed. Rep. 350.

That a judgment works an estoppel only as to the matters controverted and decided, see Steam Gauge & Lantern Co. *v.* Meyrose (1886), 36 O. G. 1477 ; 27 Fed. Rep. 213.

That the judgment of a State court as to the contract relations of the parties is not *res adjudicata* on questions of title in the Federal courts, see Oliver *v.* Rumford Chemical Works (1883), 109 U. S. 75 ; 25 O. G. 784.

[3] That a judgment of non-infringement is no bar to another action between the same parties for a different *infringing* act, see Steam Gauge & Lantern Co. *v.* Meyrose (1886), 27 Fed. Rep. 213 ; 36 O. G. 1477.

That though the Supreme Court has decided that a machine does not infringe an original patent it may still be an infringement of the re-issue, see Wells *v.* Jacques (1874), 5 O. G. 364 ; 1 Bann. & A. 60.

That a judgment is not conclusive on a plaintiff in favor of a licensee under his victorious rival, when afterward sued by him, if the license were granted before the judgment was rendered, see Ingersoll *v.* Jewett (1879), 16 Blatch. 378 ; 4 Bann. & A. 361.

That a judgment between two patentees on the question of priority affects the title of the junior patentee, but a judgment that the senior patentee was not the first inventor of an invention not claimed by the junior patent, does not

collateral proceedings, although disposing of the suit then pending, do not fall within the reason or the definition of this doctrine, and cannot be available as a defence on the main issues of the suit.[4]

§ 984. Defendant may Employ all his Defences unless Estopped.

Any or all of the foregoing defences may be set up by the defendant in an action for infringement, unless he is himself estopped from urging them.[1] The defendant is bound by his prior conduct equally with the plaintiff, and is not permitted to assume positions inconsistent with those which he has previously occupied and on which the plaintiff has relied in the direction of his own affairs.[2] Thus a former owner of the patent, through whom the plaintiff's title was derived, cannot deny its validity when sued for its infringement, although it is

affect the latter patent, nor bar the senior from suing the licensee of the junior if the license were taken after the first suit was commenced, and with knowledge of its pendency, although the invention of the junior cannot be made without using that of the senior, see Brush *v.* Naugatuck R. R. Co. (1885), 24 Fed. Rep. 371; 23 Blatch. 277; 32 O. G. 894.

[4] That no action short of final judgment on the merits, can be pleaded in bar, see Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530.

That whether an interlocutory decree, *pro confesso*, followed by a release of profits, etc., is *res adjudicata* and an estoppel is doubtful, and being doubtful should not bind, see Roemer *v.* Neumann (1886), 26 Fed. Rep. 332.

That a suit dismissed for want of prosecution is no bar to another one for the same cause of action, see American Diamond Rock Boring Co. *v.* Sheldon (1879), 17 Blatch. 208; 4 Bann. & A. 551.

That the pendency of a suit in one district is no bar to a suit in another, though a recovery may be, see Wheeler *v.* McCormick (1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334.

See further as to *Res Adjudicata* in patent cases, §§ 1017, 1048, 1175–1184, and notes, *post*.

§ 984. [1] That the same defences are applicable to a patent granted on a renewed application, as if granted on an original one, see Lindsay *v.* Stein (1882), 10 Fed. Rep. 907; 21 O. G. 613; 20 Blatch. 370; United States Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 11 O. G. 373; 14 Blatch. 94; 2 Bann. & A. 493.

[2] That a defendant is estopped from setting up his defence to the same extent that a plaintiff may be estopped from bringing his action, see 1 Chitty on Pleading, 603.

That one who knowingly permits another to take out a patent for an invention, and then himself takes a patent for a different invention, is estopped to claim that he was the inventor of the former invention, see Fraim *v.* Keen (1885), 34 O. G. 1048; 25 Fed. Rep. 820.

invalid as against all others.[3] A licensee cannot attack the existence of the patent, nor the exclusive privilege which it creates, unless he first repudiates his license, although he may deny that the invention he employs is identical with that which it protects.[4] A defendant, who, without authority, has extensively practised a patented invention, cannot allege in his defence that it has no utility, especially if he has proclaimed its value to the public.[5] A fraudulent patentee, who has procured his patent knowing or believing that the inven-

[3] That a patentee is estopped from denying the validity of the patent in a suit for infringement brought by his assignee, see Underwood *v.* Warren (1884), 21 Fed. Rep. 573; Many *v.* Jagger (1848), 1 Blatch. 372; and cases cited in § 981, note 12, *ante*.

That a patentee is estopped from denying the validity of the patent or its re-issues in a suit against him by his assignee, although the re-issues were granted after the assignment, and the assignee ought to have known that they were void, see Burdsall *v.* Curran (1887), 31 Fed. Rep. 918; 42 O. G. 1167.

That where a member of an infringing firm was formerly a part-owner of the patent he is estopped from denying its validity, unless he conveyed his interest to the plaintiff without consideration, see Parker *v.* McKee (1885), 32 O. G. 137.

That an assignor is estopped from purchasing a prior patent and setting it up against his assignee, see Curran *v.* Burdsall (1883), 27 O. G. 1319.

That a defendant is estopped by a decree by consent in a suit where he was defendant and the present plaintiff's assignor was plaintiff, see United States Metallic Packing Co. *v.* Tripp (1887), 39 O. G. 1554; 31 Fed. Rep. 350.

See also as to estoppel of assignor, §§ 787, 981, and notes, *ante*.

[4] That a licensee, having covenanted not to deny the validity of the patent or the licensor's title, cannot defend against an action while the license is in force, except on the ground that the license is not exceeded, see Pope Mfg. Co. *v.* Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That a licensee having repudiated the license may deny validity, see Brown *v.* Lapham (1886), 23 Blatch. 475; 37 O. G. 676; 27 Fed. Rep. 77.

That a licensee who has paid large license fees and built up an extensive business under cover of a patent, though not technically estopped from denying its validity, urges such defence with every presumption against him, and if the rest of the public have acquiesced in the patent, he must produce the strongest of proof against it, see Hobbie *v.* Smith (1886), 27 Fed. Rep. 656.

That a defendant who is treated in the bill as an ordinary infringer may avail himself of any defence open to infringers, though he is only a licensee, see Pelham *v.* Edelmeyer (1883), 15 Fed. Rep. 262; 25 O. G. 292; 21 Blatch. 188.

That if a plaintiff sues in infringement instead of for royalties, a purchaser from the licensee is not estopped to deny the validity of the patent, see Baltimore Car-Wheel Co. *v.* North Baltimore Passenger R. R. Co. (1884), 21 Fed. Rep. 47.

Also see § 820 and notes, *ante*, and §§ 1251, 1252, and notes, *post*.

[5] That a defendant who has used and advertised an invention as of great

tion was not patentable or that he was not its first and true inventor, cannot dispute the patentability of the invention when sued by a rival *bona fide* patentee, although it may be evident that this defence would prove successful on behalf of any other defendant.[6] A *bona fide* patentee, however, even when defeated on an interference, may afterward deny the patentability of the invention in a suit brought against him by his rival.[7] A defendant is not estopped from setting up the invalidity of the patent by the fact that he once owned an

value thereby admits its utility, see Stanley *v.* Whipple (1839), 2 McLean, 35; 2 Robb, 1.

That a defendant who infringes both the patent for the original and that for the improvement cannot set up the former as anticipating the latter, see Cantrell *v.* Wallick (1886), 117 U. S. 689; 35 O. G. 871.

[6] That one who has fraudulently endeavored to patent an invention is estopped from defending against a prior patent on the ground that the invention was then open to the public, see Greenwood *v.* Bracher (1880), 17 O. G. 1151; 1 Fed. Rep. 856; 5 Bann. & A. 302.

[7] In Greenwood *v.* Bracher (1880), 1 Fed. Rep. 856, Nixon, J.: (858) "A new question is thus presented, and one by no means unimportant. Will the court allow a patentee, who has lost his rights to the protection of the law in consequence of proof that his alleged invention was anticipated by others, to protect himself in the continued use of the patented improvements by showing that neither he nor the other party was the first inventor? In other words, whether the issuing of a patent estops the patentee from proving that the invention claimed therein is not novel. I think the answer depends entirely upon the fact whether the party has acted in good faith in the matter. Every one making application for letters-patent is obliged to file therewith an oath that he believes himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, for which he solicits the patent. Sec. 4892 of Rev. Stat. This is often done honestly, and yet untruthfully, owing to the ignorance on the part of the applicant of the state of the art. I can perceive no satisfactory reason why any one should not be permitted, after he has discovered his mistake, to set up the defence of want of novelty against another party who claims an exclusive right to patented improvements which, in truth, belong to the public. But if one with a knowledge of the state of the arts surreptitiously attempts to appropriate to himself what he knows does not belong to him, he should be estopped when his fraud is found out, from interposing such a defence, especially against a person whom the Patent Office has decided, as against his claim, to be the original and first inventor." 17 O. G. 1151 (1151); 5 Bann. & A. 302 (304).

See also Sluter *v.* Davis (1883), 24 O. G. 303; 16 Fed. Rep. 564; Smith *v.* Halkyard (1883), 23 O. G. 1833; 13 Fed. Rep. 414.

That a defeated party to an interference, denying the novelty of the invention, must clearly prove it, if he had knowledge of the state of the art when he made his own application, see Smith *v.* Halkyard (1883), 16 Fed. Rep. 414; 23 O. G. 1833.

interest therein, if there is no privity of title between him and the plaintiff.[8] Nor can he be prevented from denying the identity between his own device and that protected by the patent by an agreement not to make the former, unless he also has conceded it to be the same in its essential characteristics as the latter.[9] When there are several defendants an estoppel operating against one does not bind the others, unless they are in privity with him in reference to the subject-matter to which the estoppel appertains.[10]

§ 985. Separate Defences Allowed against Each Patent and Each Claim in Controversy.

Where several patents constitute the basis of a single suit, each may be separately attacked by any of the methods of defence herein described.[1] A patent which embraces several Claims, whether for the same or different inventions, stands in this respect on the same ground as if each Claim were embodied in a separate patent; and every Claim is, therefore, open to all those defences which do not relate solely to the patent as a whole.[2] Re-issued patents, and patents granted on renewed applications, may be met with the same objections as to invalidity and the want of patentability in the invention

[8] That a defendant with whom there is no privity of title in the plaintiff is not estopped to deny the validity of the patent, see Baltimore Car-Wheel Co. *v.* North Baltimore Passenger R. R. Co. (1884), 21 Fed. Rep. 47.

[9] That a defendant agreeing not to manufacture a device is not estopped by the agreement unless that device is conceded to be identical with the one patented, see Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796.

[10] That a defendant is not estopped by the conduct or relations of other persons unless privity of title exists between them, see Baltimore Car-Wheel Co. *v.* North Baltimore Passenger R. R. Co. (1884), 21 Fed. Rep. 47.

That an estoppel by conduct is available at law, see Concord *v.* Norton (1883), 16 Fed. Rep. 477.

§ 985. [1] That each patent in suit may be made the subject of separate defences if the defendant so elects, see Kelleher *v.* Darling (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438; Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337.

That each patent in suit may be defended against on the grounds of prior invention and prior use, see Parks *v.* Booth (1880), 102 U. S. 96; 17 O. G. 1089.

[2] That some Claims of a patent may be infringed and not others, and each may be defended against, like a separate patent, see Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

as are admissible against original patents and patents granted on original applications.[3]

§ 986. Forms of Pleading Required for These Defences, a Matter of Dispute.

In reference to the form in which these various defences should be pleaded, the conflict of authorities appears irreconcilable, — some holding that the greater number may be urged under the general issue, others requiring for nearly all a notice or a special plea. Recurring to first principles for light upon this subject, it is evident that in an action on the case at common law the general issue was sufficient to cover all possible defences, the point in controversy being not whether a cause of action once existed in favor of the plaintiff, but whether at the time of pleading he ought in justice and good conscience to recover judgment against the defendant.[1] Under this issue such special matters of avoidance as a license, or release, or an accord and satisfaction, could be claimed and proved by the defendant.[2] Thus in an action for the infringement of a patent all the defences heretofore enumerated, except the Statute of Limitations, were admissible under the usual plea of not guilty, and the practice in the English courts in patent cases was in conformity with this position until the change in the rules of pleading in the 5 & 6 W. IV. (1833) and the special act regulating the pleas in patent causes of 6 W. IV. (1835).[3] By this change in the rules of pleading the scope of the general issue in an action on the case was limited to a denial of the wrongful act on which the suit was based, and any matter in bar or in avoidance of any other averment in the declaration must be made the subject of a special plea. By the special act referred to, the defendant in an action for infringement is required to file with his plea a notice of all objections on which

[3] That patents on renewed applications under the act of 1870, Sec. 35, are open to all defences, see § 984, note 1, *ante*.

§ 986. [1] Gould on Pleading, ch. vi. §§ 54, 55.

[2] Gould on Pleading, ch. vi. § 55.

[3] Thus Godson: (177) "The usual plea is *not* guilty, which, putting in issue the whole of the declaration, forces the plaintiff to support the grant in all its parts, and gives to the defendant the greatest latitude for evidence."

he intends to rely at the trial.[4] Thus under the English practice the mode of pleading in patent cases has always been clear and imperative, — before the change the general issue only, and since the change a special plea or notice for all defences, except the single one of non-infringement. At the time of the creation of our patent system, the common law mode of pleading prevailed also in this country. It remained unaffected by the changes introduced into the English practice, and in the absence of statutory provisions of our own would still permit the defendant to avail himself of all his defences under the general issue. In each of the principal acts of Congress on which our patent jurisprudence rests it has, however, been prescribed that the defendant shall set up certain of these defences only under a notice connected with the general issue, or, what the courts have uniformly regarded as its equivalent, under a special plea. The defences thus distinguished are few in number, and have not, in all the acts of Congress, been the same. Some of them are analogous to others not included in the words of this requirement, and suggest that if the former should be specially set forth, the latter should be also. Thence have arisen doubts and difficulties in our practice which can perhaps be removed only by a new act that, like the English statutes, shall cover the entire field of pleading. If any other solution of the questions can be reached, it must be by a careful scrutiny of the provisions out of which they have arisen, in view of the spirit and intent of the law in which they were incorporated.

§ 987. Pleadings under the Act of 1790.

The first appearance of this requirement is in the patent act of 1790, the earliest enactment of Congress in reference

[4] Thus Coryton: (272) "Formerly in an action for infringement the defendant could plead only the general issue. To provide against the surprise which was constantly occurring from the ignorance in which parties were left as to the real point intended to be urged against them at the trial, it is now required (Stat. 5 & 6 Will. IV.) that the plaintiff in an action for infringement shall deliver, with his declaration, particulars of the breaches he complains of. Similarly, the defendant to the action . . . must deliver with his pleas, . . . the particulars of the objections he is prepared to urge to the validity of the patent. No evidence is admissible in these respects on the trial which is not

to patents for inventions. The structure of this act is peculiar, but it is clearly consistent with itself; and each of its provisions if interpreted in connection with the others is appropriate and intelligible. The first section provides for the granting of a patent to the inventor of a new art or article upon his petition therefor, if the officers of the government deem the invention sufficiently useful and important. The second section requires the patentee to file with the Secretary of State, at the time of the granting of the patent, a written specification, with drawings and a model when admissible, sufficiently complete and exact to distinguish the invention from all other matters before known and to enable a person skilled in the art to practise the invention, to the end that the public may have the full benefit thereof after the expiration of the patent. The fourth section prohibits all other persons from employing the patented invention without the written permission of the owner of the patent under penalty of forfeiting such a sum of money as a jury might assess as damages, and also the thing made, used, or sold in violation of the patent, to be recovered in an action on the case based on the statute. The sixth section provides that in all such actions the patent and specification shall be *prima facie* evidence that the patentee was the true and first inventor of the invention therein described, and that the description given was correct; but that nevertheless the defendant might plead the general issue and give the statute in evidence, and also, upon due notice to the plaintiff, any other special matter tending to prove that the specification, by the concealment of part of the invention or the addition of more than was necessary to produce the effect described, was intended to mislead the public, or did so mislead them that the effect described could not be produced by the means specified, and that if this fact were established by the proof the defendant should prevail.[1] The

contained in such particulars." These particulars are notices, not pleadings, and form no part of the record. See p. 276.

§ 987. [1] Particular importance attaches to the fact that according to this act of 1790, the defendant might give the statute itself in evidence under the general issue. As the validity of the patent, the title of the patentee, and the liability of the defendant, were all dependent upon this statute, this provision set the whole case at issue under this common law plea, with the

extent of the departure of this statute from the common law and the English practice is at once perceptible. At common law the remedy for an infringement was an action on the case for compensatory damages merely, the general issue was a sufficient plea to put the plaintiff upon proof of all the facts on which his right to a recovery was based, and this proof must consist of testimony outside of the patent, upon all points except those of the issue of the patent and the title of the patentee. By our act of 1790 the remedy was an action on the statute for the recovery not only of damages but of one or more articles of personal property; the general issue did not permit the defendant to attack the sufficiency of the disclosure of the invention to the public without a notice to the plaintiff; and the patent was made *prima facie* evidence that the patentee was entitled to a patent and had complied with all the conditions imposed upon him by the law. Passing the first divergence as throwing no light on this question, since the form of action was still trespass on the case, it must be noticed that the other two departures do not affect the rules of pleading, but the rules of evidence. The statute did not require any other plea than the general issue, whatever defence the infringer might desire to present, following in this respect the common law; but it prohibited him from making one particular defence under the general issue unless he previously notified the plaintiff of his intention so to do. This notice has never been regarded as a plea.[2] Our courts have held that a special plea, setting up the same matters and served under the same conditions, might be substituted for the notice; but the notice itself, when given, formed no part of the pleadings in the action, was served upon the plaintiff instead of being filed in court, and has uniformly been considered as fulfilling its purpose when it put the plaintiff on his guard concerning the nature of the proposed attack upon his patent. Regarded simply as changes in the rules of evidence, the

single exception of the claim of concealment or redundancy in the description of the invention, which could not be made without a special notice. See Corning *v.* Burden (1853), 15 How. 252.

[2] That the notice of special matter is not a plea, see Cottier *v.* Stimson (1884), 20 Fed. Rep. 906; 10 Sawyer, 212.

effect of these two departures from the common law is obvious. To the validity of a patent three things were necessary: that the invention should be patentable; that the patentee should be its first and true inventor; that he should place his invention fully within the knowledge of the public. Under the common law the burden of proof rested upon the plaintiff, notwithstanding his patent, as to each of these essential conditions; and the defendant was at liberty to controvert either or all of them without other notice to the plaintiff than was implied in his plea of not guilty. Our statute made the patent itself *prima facie* evidence of these three facts. It left the defendant free to dispute the first two under the general issue without previous notice to the plaintiff, but required him to give such notice if he desired under that issue to avail himself of a denial of the third. The entire effect of these changes was, therefore, the introduction into our law of the doctrine that the grant of the patent raises a presumption of its validity which will prevail unless rebutted by opposing evidence, and the establishment of the rule that no opposing evidence shall be offered in reference to the sufficiency of the disclosure, unless the plaintiff has been forewarned that such an attack upon his patent will be made. The reason for requiring a notice upon this particular point and not upon the others readily suggests itself. The patentability of the invention and its original production by the patentee are indispensable conditions of his right to any patent whatever. They are facts which the patentee affirms by applying for the patent, and which he must at all times be ready to establish when his right to the patent is attacked. They are also existing and unalterable facts, not depending on human judgment nor subject to the tests of human insight and comprehension, but supported or denied by the positive, direct, and permanent evidence of the human senses. When our statute made the patent *prima facie* evidence of these facts, and threw upon the defendant the duty of opening the controversy concerning them, it was not deemed important to compel him to inform the plaintiff that he intended to deny what the plaintiff must have expected to become the subject of attack as the defendant's only mode of justifying his own

practice of the patented invention; and the act, therefore, permitted the defendant to make these defences in the same manner as at common law. The third condition was of a wholly different character. A failure to fulfil this condition did not affect the true inventor's right to a patent, but merely the validity of the patent which he had received, and though before the amendment of a patent was allowed the practical result to the patentee was the same as in the other cases, the difference between them in principle and in theory was fundamental. Justice then as now required that this difference should be recognized in jurisprudence, and that defects in statement, if not intended to deceive, should not invoke the same disastrous consequences to the patentee as want of patentability in the invention or the anticipation of his inventive act by that of a prior rival inventor. The fulfilment of this condition was also a fact which could not be evidenced by ordinary proof, but which must have been tested by human judgment and determined by experience. Until the specification was published and submitted to those skilled in the art, the patentee himself could not have known whether his disclosure was sufficient, and if it was intended to be a complete and exact description of his invention, he might safely assume it to be such until the contrary was alleged. To require him to be prepared at all times to meet attack on this ground would compel him to keep himself informed of the extent to which those skilled in the art had endeavored to practise the patented invention and of their success or failure in the attempt, and thus impose upon him a burden productive of no other benefit to himself than the ability to prove the sufficiency of his specification if it should ever chance to be denied. It was, therefore, with the utmost propriety that our law relieved the patentee from the necessity of investigating and accumulating evidence upon this point until notified by a defendant that such a denial would be made. The effect of the first Patent Act of the United States upon the rules of pleading and of evidence is evidently this: that the general issue still remained, as at common law, the proper plea in all cases without reference to the nature of the defence, but that in order to introduce testimony showing the insufficiency of

the specification, whether fraudulent or unintentional, the defendant must have previously notified the plaintiff and have thus afforded him an opportunity to prepare to sustain it.

§ 988. Pleadings under the Act of 1793.

The act of 1793, which superseded that of 1790, carried still further these alterations in the law. It changed the measure of damages to be recovered by the plaintiff, but left the form and statutory basis of the action undisturbed. In reference to the pleadings, it employed the same language as the prior act, but increased the number of defences upon which the defendant was forbidden to offer evidence without a previous notice to the plaintiff. It omitted the provision that the patent should be *prima facie* evidence of the right of the patentee to the patent and of the sufficiency of the description, and inserted a requirement that the patentee, before the patent issued, should make oath that he believed himself to be the first and true inventor of the art or article described. And it extended the effect of a judgment for the defendant upon any of the defences of which it required previous notice, so that not only was the defendant relieved from liability, but the patent itself was declared void. These changes indicate a different spirit and intention in the law from that embodied in the act of 1790. No attempt is made to modify the rules of pleading, the general issue being evidently deemed the proper mode of introducing all defences upon which an alleged infringer can rely. But an endeavor was apparent to make a suit for infringement serve a double purpose, — to vindicate the rights of the patentee if the patent were valid, and to operate as a repeal of the patent if it were void. To meet this latter object the rules of evidence were radically changed. The plaintiff was relegated to his common-law position in reference to the mode of proving his case, the patent being no longer *prima facie* evidence in his favor, and was compelled to assume the burden upon all defences except those on which the repeal or confirmation of his patent was to turn. Of these last defences there were four: a fraudulent specification; prior use; prior publication; and a surreptitious

patent obtained for the discovery of another person. Of these the defendant was required to give notice thirty days before the trial if he desired to offer evidence thereon either for his own deliverance or in the effort to destroy the patent. The reasons of the legislature for selecting these four as the grounds on which a judgment of repeal might be awarded are easily discerned. In a fraudulent specification the attempt to deceive the public is the real defect, and this attempt forfeits the right of the inventor to protection, however meritorious in other respects he may have been. The surreptitious application for, and reception of, a patent for another's invention is also an act which, if not wilfully fraudulent, has the effect of fraud and cannot be sustained or permitted to result in injury to the true inventor or the public by casting a cloud upon the title of the one, or unduly limiting the privileges of the other. An invention which has been in actual use or has been described in a public work before the patentee invented it is certainly not new and original with him, and independently of all other questions as to its patentability cannot become the subject-matter of a valid patent in his favor. These are defects necessarily fatal. They are proved, if provable at all, by clear and direct testimony as to past conditions and transactions. And if the attempt to introduce this new feature of repeal into a suit for infringement was practicable and expedient, the selection of these grounds for it and of this mode of procedure was commendable. But the provisions made for this purpose are not to be confounded with those existing in the act of 1790, where the sole object was to regulate the private controversy between the plaintiff and defendant, nor with those of later statutes which do not contemplate a judgment affecting the existence of the patent.[1]

§ 988. [1] In Grant *v.* Raymond (1832), 6 Peters, 218, Marshall, C. J., clearly recognizes this great distinction between the acts of 1790 and 1793, and refers to the failure of the courts to separate the two purposes which the latter act was intended to accomplish.

In Kneass *v.* Schuylkill Bank, (1820) 4 Wash. 9, the defendant pleaded the general issue without notice. The attention of the court was particularly directed to the provisions of the act of 1793, now under discussion, and the case was argued by distinguished counsel. The following questions were treated as matters of fact to be decided

§ 989. **Pleadings under the Act of 1836.**

The act of 1836 returned to the purpose and, to a great extent, to the methods of the act of 1790. The attempt to combine proceedings in repeal with an action for infringement was abandoned, and the defendant was permitted only to urge objections in his own behalf. The rules of pleading remained unchanged, and the general issue was allowed to cover every defence which the defendant might desire to raise against the several averments of the declaration, although a notice to the plaintiff was required when evidence on certain subjects was to be presented. In view of the fact that the alterations in the English practice, confining the general issue in all actions on the case to a denial of the wrongful act alleged and compelling the defendant to plead specially all other defences, were introduced three years before the passage of this statute, and that the Act 5 & 6 W. IV., providing that in all suits for infringement the defendant must file with his plea a particular statement of all the defences on which he purposed to rely, took effect only the year before, of both which changes in the English law Congress must be presumed to have had knowledge, the repetition in our statute of the common law rule of pleading is of the highest significance.[1] If it had not been the intention of Congress that the general issue should retain its ancient

under the pleadings: Whether the alleged invention belonged to either of the patentable classes; whether it possessed utility; whether it was a means or an effect; whether the specification so disclosed the invention as to enable persons skilled in the art to practise it. The learned judge also stated that under the general issue other questions might be determined, instancing the absence of a specification; that the patent is broader than the discovery; that the improvement is not distinguished from the original; that the patent does not contain the necessary recitals, etc. He further says that evidence of special matter cannot be given other than such as is particularly mentioned "unless it can be admitted upon general principles of law, as included in the general issue," thus recognizing the general issue in patent cases as equally comprehensive with the same plea in other cases, except when coupled with the requirement of notice.

That Sec. 6, act of 1793, as to notice, does not include all defences which the defendant may make, see Evans *v.* Hettick (1822), 7 Wheaton, 453; 1 Robb, 417.

That on a general issue without notice the defendant cannot give in evidence any of the matters named in Sec. 6, act of 1793, see Kneass *v.* Schuylkill Bank (1820), 4 Wash. 9; 1 Robb, 303.

§ 989. [1] See 1 Chitty on Pleading, 512.

comprehensiveness, it would certainly have been restricted by this statute, and other modes have been provided for the assertion of special matters in avoidance or in bar. The section of the act of 1836 which prescribes the mode of pleading and notice, therefore, so far from extending the defendant's common law rights of defence, imposes upon them a limitation, not affecting his right to plead but his right to offer evidence of a certain character under his plea, and restricts the latter right by making previous notice a condition of its exercise. The correctness of this interpretation of that section is established by the decisions of the courts concerning the propriety and method of substituting a special plea for the notice thus required. Such substitution is regarded as legitimate, provided the plea possesses the necessary attributes of the notice as to completeness of statement and time and mode of service, but not otherwise, — showing conclusively that it is not only as a plea putting matters in issue, but as a notice warning the plaintiff of the objections to be urged against his patent, that even a special plea must be employed. Thus there can be no doubt that the same practice prescribed by the act of 1790 in relation to the pleadings was revived and confirmed by the act of 1836. The changes in the rules of evidence consisted in an increase in the number, and some modification in the character, of the defences of which notice was required. Under the act of 1836 these were: a fraudulent specification; prior invention by another than the patentee; prior publication; abandonment by public use or sale; a surreptitious patent obtained for the invention of another; the failure of an alien patentee to put his patented invention on the market. None of these defences were identical with that of insufficient specification, for which a notice was essential under the act of 1790. Those mentioned in the act of 1793, however, are all represented, — prior invention covering the defence of prior use; and two are added, — abandonment by public use or sale, and the misconduct of an alien patentee in withholding his invention from the public. The reasons for retaining the four earlier defences under this rule are the same as those which made it proper in the first place to include them in its operation. The extension of the rule to the two additional

defences was equally justifiable. Both these defences were forms of abandonment. The public use or sale of the invention with the knowledge and consent of the inventor before his application for a patent destroyed his right to obtain a patent, and if he had obtained it rendered the patent void. The neglect of an alien patentee to put his invention into the hands of the public, within the period then limited by law, in the same manner forfeited his right to the patent and rendered the patent void. And as the law in all cases presumed against abandonment and permitted the patentee to rely on that presumption, it consistently required a defendant, who purposed to set up in his defence facts which the law regarded as conclusive evidence of an abandonment, to give the plaintiff a fair opportunity to meet and overthrow them.

§ 990. Pleadings under the Act of 1870 and the Revised Statutes.

The act of 1870, in the paragraph now forming Section 4920 of the Revised Statutes, repeats the provisions of the act of 1836 with even greater clearness and precision. It enacts that in any action for infringement the defendant may plead the general issue, and having given the required notice, may prove on trial any one or more of certain special matters.[1] There are but two ways of construing this enactment. Either it means that under the general issue the defendant may make all his defences as at common law, but that in reference to some he must give notice to the plaintiff as a condition precedent to offering evidence thereon, or it means that under the general issue he can make no defence except those of which notice is required. The latter interpretation is, of course, absurd.[2] The former harmonizes with all preceding statutes and with the doctrine and the practice under the common law, and hence must be the correct statement of the rule. The special matters of which notice is essential under this act are

§ 990. [1] That a defendant, upon filing the statutory notice, may give the special defences named in the act in evidence under the general issue, see Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337.

[2] Such a rule would forbid the defence of non-infringement, except under a special plea.

the same in substance as those mentioned in the act of 1836. To prior publication, prior patent is added as being a defence of the same nature and included in the spirit of the former. Abandonment by public use or sale is extended to embrace all modes of dedication to the public, and the failure of an alien patentee to practise his invention is omitted, that duty being no longer imposed on him by law.

§ 991. Summary of the Law concerning Pleadings in Actions for Infringement from 1790 to 1874.

As the result of this investigation and comparison of the various provisions of our Patent Laws concerning the form in which the defendant may present his different defences, the following propositions may be stated: (1) That no attempt has ever been made by Congress to change the rules of pleading in actions for infringement as they stood at common law when our patent system was inaugurated in 1790; (2) That at that period, and ever since, the general issue has been the proper form of pleading as to all defences which deny the existence of the plaintiff's right of action at the date of the filing of the plea; (3) That the rule requiring notice when certain defences are to be presented is a rule of evidence, intended not to provide a mode of raising issues but to protect the plaintiff against surprise; (4) That this rule has been and must be varied from time to time, as justice to the plaintiff may demand, but that such variations do not affect the attitude of either party before the court, or change the burden of proof, or impose any other obligation or disability upon the defendant than is contained in the simple duty of giving the prescribed notice to the plaintiff.

§ 992. General Issue, with or without Notice, a Sufficient Plea in all Defences except the Statute of Limitations.

Applying these propositions to the solution of the question now under consideration, it will be evident that the general issue is a sufficient plea for all defences which deny the existence of a cause of action in the plaintiff. Every defence which puts in issue any averment of the declaration comes within this description, whether it controverts the patenta-

bility of the invention, or the right of the patentee to the monopoly, or the existence or validity of the patent, or the title of the plaintiff, or the practice of the invention by the defendant without due authority. Every defence which, admitting the former existence of a cause of action, claims that it has been extinguished either by release or by estoppel or by a former judgment belongs in the same class.[1] The only remaining defence is that of the Statute of Limitations which recognizes a subsisting cause of action, but avers that by his laches the plaintiff has lost the right to any legal remedy. This defence requires a special plea.[2] But while the general issue is permitted in the foregoing cases it is not incumbent on the defendant to employ it. He may plead specially any or all of his defences except that which denies his performance of the infringing act, and this is always his proper course when he desires to tender a specific issue to be simply traversed by the plaintiff.[3] If in such special plea he sets up any fact of which notice to the plaintiff is required, the plea must not only be duly filed, as a plea, but served on the plaintiff as a notice in the mode provided by the statute.[4] The same matter cannot be presented both in a special plea and by a notice under the general issue.[5] When the defendant pleads

§ 992. [1] Gould on Pleading, ch. vi. § 55.

[2] That the Statute of Limitations must be specially pleaded at common law, see 1 Chitty on Pleading, 479.

[3] For a discussion of the relation of special pleas to the general issue, see Hubbell *v.* De Land (1882), 14 Fed. Rep. 471; 11 Bissell, 382; 22 O. G. 1883.

That the five special defences under Sec. 4920, Rev. Stat., may be made by special pleas with the general issue, and that other defences may be pleaded specially, with or without the general issue, see Cottier *v.* Stimson (1883), 9 Sawyer, 435; 18 Fed. Rep. 689.

That matter may be shown in special pleas or in the general issue with notice, see Root *v.* Ball (1846), 4 McLean, 177; 2 Robb, 513.

That the defendant may plead specially matters which are proper under the general issue, see Day *v.* New England Car-Spring Co. (1854), 3 Blatch. 179.

That the general issue with special plea of license, but no notice of special matter, is a good plea, see Day *v.* New England Car-Spring Co. (1854), 3 Blatch. 179.

That matters not admissible under a general issue and notice may be specially pleaded, see Wilder *v.* Gayler (1850), 1 Blatch. 597.

[4] That where the special plea covers matter of which notice is required, it must be served like a notice, see Cottier *v.* Stimson (1884), 20 Fed. Rep. 906; 10 Sawyer, 212.

[5] That the defendant cannot plead the general issue with notice and set up the same matter in a special plea in bar,

the general issue, whether with or without a notice, the plaintiff closes the pleadings with a *similiter*. If the defendant pleads specially, the plaintiff may either demur or traverse, or reply with new matter, as in other common-law actions, and thence the pleadings may proceed until an issue of law or fact is reached.[6]

see Read *v.* Miller (1867), 3 Fisher, 310; 2 Bissell, 12.

[6] This question of pleadings is further complicated by Sec. 914, Rev. Stat., which provides that "the practice, pleadings, and forms and mode of proceeding in civil causes other than equity and admiralty causes, in the circuit and district courts, shall conform, as near as may be, to the practice, pleadings, and forms and modes of proceeding existing at the time in like causes in the courts of record of the State within which such circuit or district courts are held," etc. It has been claimed and decided that this provision applies to patent cases as well as others, see Celluloid Mfg. Co. *v.* American Zylonite Co. (1888), 34 Fed. Rep. 744; Hayden *v.* Oriental Mills (1883), 15 Fed. Rep. 605; 24 O. G. 601; Cottier *v.* Stimson (1883), 9 Sawyer, 435; 18 Fed. Rep. 689.

The reasons against this position are numerous and forcible. In the first place, the language of the rule does not include patent causes. It prescribes the adoption of local practice and procedure only so far as it exists *in like causes* in the State tribunals. Now, there are no *like causes* in reference to cases arising under the Patent Laws. In these cases the right, the wrong, and the remedy are *sui generis*, and require, as they have always had, a proceeding equally peculiar, which has ever been recognized as properly prescribed by Federal law alone.

In the second place, the complete destruction of that uniformity of procedure which is so essential to the development of Patent Law must inevitably follow upon this application of the rule. That development depends largely upon the existence in this country of a body of trained patent lawyers, whose practice is unlimited by State boundaries, and whose learning, experience, and wisdom are thus rendered advantageous to the whole nation. The imposition upon this body of lawyers of the duty of acquainting themselves with the local practice of each State, and of changing their own methods as they pass from one area of conflict to another, can only be justified by greater necessities and clearer statutory enactments than have thus far appeared.

In the third place, this position contradicts the specific requirements of the Patent Law itself. Sec. 4919, Rev. Stat., expressly provides that the action at law for infringement shall be an action on the case. Sec. 4920, bestows on the defendant the privilege of pleading the general issue, *i. e.*, the *common law* general issue. As these sections are of equal authority with Sec. 914, all must be construed together, and no construction, saving all, is possible, except that which excludes patent cases from the operation of Sec. 914.

In the fourth place, it has been repeatedly decided that Sec. 914 does not apply to cases where Congress has legislated, nor include constructions placed upon common law remedies in the State courts, nor repeal by implication any previous act of Congress, providing a particular mode of proceeding. (See Desty, pp. 499, 500.) Hence it

§ 993. General Issue: when Notice also Required.

When the defendant pleads the general issue, he must also give a written notice to the plaintiff in any case where he desires to offer evidence tending to prove either of the five following states of fact: (1) That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; (2) That the patentee had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; (3) That the invention had been patented or described in some printed publication prior to his supposed invention or discovery thereof; (4) That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; (5) That the invention had been in public use or on sale in this country for more than two years before his application for a patent or had been abandoned to the public.[1] The relation of these states of fact to the defences already enumerated demands attention in order that the cases in which notice is required may be more easily distinguished.

§ 994. Notice Required where the Defence rests on an Alleged Fraudulent Specification.

The first of these states of fact is identical with that which constitutes the eleventh defence. It exists where the specification actually misleads the public, and was intended so to

is evident that so far as the substance of the proceedings in actions at law for infringement are concerned, the Federal statutes and the common law rules of pleading, as recognized in these statutes, still form the guide of the pleader and the court, however widely the local customs may lead to a departure in minor matters not relative to the essence of the cause.

The foregoing reasons, though not all that might be urged, are at least sufficient to warrant a dissent from the position taken in the cases first cited, until a higher authority endorses it, or it is fully accepted and acted on by the profession at large.

See also Read *v.* Miller (1867), 3 Fisher, 310; 2 Bissell, 12; Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351.

§ 993. [1] Sec. 4920, Rev. Stat.

do, by concealing some essential part of the invention, or by declaring some superfluous action or device to be necessary to its successful operation. A merely insufficient specification, as distinguished from a fraudulent one, although it fails to put the invention into the possession of the public, is not embraced in this state of facts, and may, therefore, be urged as a defence under the general issue without notice.[1]

§ 995. Notice Required where the Defence rests on the Allegation that the Patentee or his Assignor is not a True Inventor or was not the First Inventor.

The second state of facts is of less definite limitations, and whether it embraces the second defence only, or the third defence only, or both defences, is rendered doubtful by the variations which have taken place in the language of the statutes in reference to these defences. The act of 1793 required a notice where the invention was not originally discovered by the patentee but had been in use anterior to his supposed discovery; and under this provision it was held that evidence of any practical use, however slight and temporary, was sufficient to sustain this defence and defeat the patent. As the inventive act of the true discoverer could not be complete without such practical use, and as at that time the idea that diligence in reduction to practice causes the complete inventive act to relate back to the time of conception had not been incorporated into our law, it would appear that this clause of the act of 1793 referred to cases of prior rival invention, and prescribed a notice whenever the defendant, though conceding that the plaintiff was a true inventor, desired to show that he had been anticipated in his discovery by the previous performance of an entire inventive act. Then followed the clause requiring notice of the defence that the patentee had surreptitiously obtained a patent for the discovery of another person. This could not be interpreted as a

§ 994. [1] That no notice need be given where the defence rests on a merely defective but not fraudulent specification, see Kneass *v.* Schuylkill Bank (1820), 4 Wash. 9; 1 Robb, 303.

That whether a defective but not fraudulent specification is a defence, see § 970 and notes, *ante*.

mere repetition of the preceding proposition. The language was widely different. It spoke of a surreptitious or fraudulent act by which the discovery of another was appropriated to the patentee. In view of its connection, as well as phraseology, this clause could, therefore, refer only to a case where an imitator had obtained a monopoly for the results of another's inventive skill. In passing from the act of 1793 to the act of 1836 these clauses were materially changed, and the radical distinctions between these two cases were obscured. The interim had witnessed the development of the doctrine that the first inventor, if diligent in reduction, was the rightful patentee, although prior to his reduction a later conceiver had completed his inventive act; and frequent cases had made it evident that proof of prior conception on the part of another than the patentee was essential to sustain either the second or the third defence. As the law then stood, according to the decisions, an imitator, who had appropriated the conception of another, and a true inventor, who had himself conceived the principle of the invention after another had conceived it and while that other was using reasonable diligence in reduction, were equally unable to obtain a patent or to vindicate it if obtained. The act of 1836 in one clause required a notice that "the patentee was not the original and first inventor or discoverer;" and in a separate clause "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." If the latter clause had stood alone, and if the words "surreptitiously," etc., had not led the mind back to the provisions of the act of 1793, no doubt would have arisen but that this clause referred entirely to cases where a later but true conceiver had procured a patent, although another inventor by a prior conception and a diligent but subsequent reduction was the party actually entitled thereto; while the former clause referred to cases where the defendant claimed that the patentee was anticipated as to the entire inventive act, including both conception and reduction, by his rival,[1] and to cases where

§ 995. [1] To a correct understanding of this discussion, a clear recollection of the relations of rival inventors to each other, under the law, is essential. Rival in-

a mere imitator who of course could not be "the original and first discoverer" had obtained a patent; thus giving to these clauses, taken together, a construction covering all cases in which the patentee was alleged to be no inventor, or not the first to complete the inventive act, or not the first to conceive the idea of the invention. If this be the correct interpretation of the statute, as it probably is, the change which distinguishes the act of 1836 from that of 1793 consists in the transfer of the words "surreptitiously," etc., from the imitation of another's discovery to the wrongful appropriation by a subsequent inventor of that which had been previously

ventors may assume toward each other three distinct attitudes. The first conceiver may reduce to practice before reduction by the second conceiver; in which case the first conceiver is the only inventor whom the law can under any circumstances recognize. Or the second conceiver may reduce to practice before reduction by the first conceiver, although the first conceiver is employing reasonable diligence in that direction; in which case, also, the law regards the first conceiver as the only rightful patentee. Or the second conceiver may reduce to practice before reduction by the first conceiver, while the first conceiver is negligent in perfecting the invention; in which case, if the second conceiver obtains the prior patent, he is entitled to the monopoly against the first but negligent conceiver. Now, if the patent of the second conceiver were to be attacked by a defendant on the ground that the inventive act of the first conceiver had been first completed by reduction, it is obvious that the question of diligence would be immaterial. The second conceiver would occupy no better position than a mere imitator, since the law conclusively presumes that every invention, which has been in practical use to any extent whatever, is known to all alleged later inventors, and thus must have been simply copied by them. In such a case the proper notice would be that described in this former clause, "that the patentee was not the original and first inventor or discoverer," etc., no mention being needed of the exercise of diligence on the part of the real inventor. But if the second conceiver had first reduced to practice and obtained a patent, an entirely different defence must be presented. The question would no longer be whether the inventive act of the patentee preceded that of his rival, for as a completed act it is conceded that it must have anticipated his. The issue raised is whether the diligence of the later reducer so connects his reduction with his conception that, although completed after that of the patentee, it does in law precede it and so confers on him the title to the patent. If this issue is decided in the negative the patent of the second conceiver stands; if in the affirmative, it falls. A notice under the former clause would, therefore, give no warning to the patentee of the real nature of the defence and might mislead him into a reliance on his earlier reduction as sufficient to sustain his patent. To avoid this surprise the second clause was inserted, requiring the defendant to forewarn him of the special inquiry into the causes to which the later reduction of his rival might be due.

conceived and was being diligently reduced to practice by another, leaving the mere imitator to forfeit his patent whether his imitation were fraudulent or not, and making the issue of a patent to the earliest completer of an inventive act "unjust" and "surreptitious" when a prior conceiver was exerting due diligence in reducing his idea to practice.[2] This view of the nature of the change in the statutes will be fully sustained by an examination of that current of decisions by means of which the alteration in the doctrine and consequently in the language of the law was gradually effected. These clauses of the act of 1836 are repeated in the act of 1870 and the Revised Statutes, and in the light of the foregoing considerations it appears that the notice "that the patentee had surreptitiously or unjustly obtained the patent for that which was in fact invented by another who was using reasonable diligence in adapting and perfecting the same" is required only in reference to a portion of the third defence, and is not applicable to the second, — the second being included in the fourth state of facts as previously enumerated.

§ 996. Notice Required where the Defence Rests on the Allegation of Prior Patent or Publication.

The third state of facts embraces two of the three conditions under which the patent must be void for want of legal novelty in the invention. The other condition is covered, with other matters, by the description of the fourth state of facts hereafter to be considered. A prior publication was made the subject of a notice in the acts of 1793 and 1836, and the provision was extended to a prior patent by the act of 1870.[1] Under our present law, therefore, the defendant must give notice whenever he desires to dispute the legal novelty of the invention by proving that it had been patented or described in some printed publication prior to its alleged invention by the patentee.[2]

[2] See §§ 960, 961, and notes, *ante*.

§ 996. [1] Sec. 6, act of 1793; Sec. 15, act of 1836; Sec. 61, act of 1870; Stevenson *v.* Magowan (1887), 31 Fed. Rep. 824; 42 O. G. 1063.

[2] That a patent not set up in the notice or answer may be offered to show the date of the patented articles already in evidence, see Atlantic Works *v.* Brady (1883), 107 U. S. 192; 23 O. G. 1330.

That unless notice is given of a prior

§ 997. Notice Required where the Defence Rests on the Allegation of Prior Use.

The fourth state of facts embraces a field of wide extent, and covers several different defences. Its relation to prior invention and to mere imitation of the discovery of another person has already been sufficiently discussed.[1] It also includes that third condition of the want of legal novelty, in which, although the performance of the original inventive act cannot be traced to any definite individual, the use and knowledge of the invention by others in this country, prior to the date of its alleged invention by the patentee, proves that it could not have then been new. All the Principal Patent Acts, except that of 1790, have, under varied forms of phraseology, contained the substance of this provision.[2] The act of 1793 required a notice when the defendant wished to show that the patented invention "was not originally discovered by the patentee but had been in use" anterior thereto.[3] The act of 1836 made notice necessary when the defence was based upon the fact "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."[4] The act of 1870 and the corresponding clause in the Revised Statutes prescribe notice when the defendant claims that the patentee "was not the original and first inventor or discoverer of some material and substantial part of the thing patented."[5] These clauses were intended to cover all cases of alleged prior use or knowledge of the invention under whatever form. The act of 1793

patent it will be disregarded by the court though referred to in the argument, see Odiorne *v.* Denney (1878), 13 O. G. 965; 3 Bann. & A. 287.

That a prior publication cannot be offered to prove a want of novelty unless due notice has been given, see Silsby *v.* Foote (1862), 14 How. 218.

That if the notice of publication is given only by special plea, and this is struck out by the court, the publication cannot be read, see Foote *v.* Silsby (1849), 1 Blatch. 445.

That a publication is not admissible to show that the author had prior knowledge at a certain place unless due notice was given, see Silsby *v.* Foote (1862), 14 How. 218.

§ 997. [1] See § 995 and notes, *ante.*

[2] The act of 1790 provided a method for the repeal of a patent on the ground that the patentee was not the first and true inventor, and allowed the same fact to be urged in defence to a suit for infringement under the general issue.

[3] Sec. 6, act of 1793.

[4] Sec. 15, act of 1836.

[5] Sec. 61, act of 1870.

mentions such use in terms as equivalent to want of original discovery by the patentee. The later acts do not insert the word "use" in these clauses, but that it is included in the phrase they do employ is obvious from the subsequent requirement concerning the disclosure of the names and residences of those by whom the defendant claims that such use was made. As the provision stands in the acts now in force, it comprises every instance where the invention has been known or used in the United States before the date of the patentee's alleged inventive act, as well as where the origin of the invention in a prior rival, or prior sole inventor, can be definitely ascertained.[6] The second defence, with part of the third, and one of the three branches of the fifth are thus comprehended in this provision.

§ 998. Notice Required where the Defence Rests on an Allegation of Abandonment to the Public.

The fifth state of facts includes those which constitute the defence of abandonment in both its forms, — that which consists in acts affording a conclusive presumption of an intention to surrender the invention to the public, and that in which the general conduct of the inventor manifests the same determination. Under the earlier acts no notice was required to admit evidence of abandonment in any form. It was first prescribed in the act of 1836, in reference to abandonment by public use and sale or by the failure of an alien patentee to place his invention within reach of the public. The act of 1870 extended the requirement to all cases of abandonment, and thus made notice essential whenever the seventh defence is to be urged.[1]

[6] That the defendant cannot set up prior knowledge, invention, or use unless the thirty days notice has been given, see Roemer *v.* Simon (1877), 95 U. S. 214 ; 12 O. G. 796 ; Pickering *v.* Phillips (1876), 10 O. G. 420 ; 4 Clifford, 383 ; 2 Bann. & A. 417.

That evidence of a prior use not referred to in the notice can only be considered upon the question of the state of the art, see Geier *v.* Goetinger (1874), 7 O. G. 563 ; 1 Bann. & A. 553.

§ 998. [1] That evidence of abandonment cannot be admitted without notice given, see Bates *v.* Coe (1878), 98 U. S. 31 ; 15 O. G. 337.

That upon due notice the defendant may show two years public use and sale before application, see Bates *v.* Coe

§ 999. Defences Available under the General Issue without Notice.

As the result of this examination of the rules governing notice in actions for infringement, it appears that of the twenty-five ordinary defences open to defendants in such actions nineteen may be set up and proved under the general issue, without notice or special plea.[1] These are: (1) That the alleged invention is not the product of inventive skill; (2) That it does not fall within either of the protected classes of inventions; (3) That it is not useful; (4) That no such patent as the one declared upon has ever existed; (5) That the plaintiff's patent was issued contrary to law; (6) That the invention described in the patent is neither an art, a machine, a manufacture, a composition of matter, a design, or an improvement; (7) That the specification is ambiguous; (8) That the Claim is excessive and has not been cured within reasonable time by a disclaimer; (9) That the Claim is ambiguous; (10) That the patent in force at the date of the infringement has been surrendered; (11) That the patent declared on has been repealed; (12) That the plaintiff has no such title to the patent as enables him to sue at law; (13) That the invention practised by the defendant is not identical with the one covered by the patent; (14) That the acts of the defendant in reference to the patented invention were not acts

(1878), 98 U. S. 31; 15 O. G. 337.

That public use and want of novelty as shown by prior use, &c., are two distinct defences, and require distinct and special notices, see Myers *v.* Busby (1887), 32 Fed. Rep. 670.

§ 999. [1] Herein the reader will perceive one of the marked distinctions between the pleadings at law and in equity. In his answer in a court of equity, as will hereafter appear (§§ 1114–1117), the defendant must specially set forth every defence of which he would avail himself, and is regarded as admitting whatever of the plaintiff's claims he does not thus traverse or avoid. As the answer in equity embraces both pleadings and notice, and as many of the requisites of the answer, as they are commonly referred to by the courts, are stated generally and not confined to the answer as a pleading, it might by the incautious reader be supposed that the law of notice extended to every defence which can be urged whether at equity or law. Traces of error arising from this source may be seen in various declarations, in court opinions and text-writers, concerning the necessity of special pleadings in order to admit defences, many of which have been admissible under the general issue alone ever since the patent system was established.

of making, use, or sale; (15) That the practice of the invention by the defendant occurred before the issue of the patent or after it had expired; (16) That the practice of the invention by the defendant was in pursuance of his lawful rights; (17) That the plaintiff is estopped by his own conduct from pursuing his action against the defendant; (18) That the plaintiff's right of action against the defendant has been duly released; (19) That the plaintiff's right of action against the defendant has been extinguished by, or merged in, a judgment.[2] One defence must be made by special plea, the Stat-

[2] If the pleadings in all the earlier patent cases were conveniently accessible much light upon this question might be easily obtained by collecting instances in which these various defences have been made without objection under the general issue without notice. At present the result would scarcely justify the labor. Mr. Curtis, on the general authority of the common law, and the causes then decided, affirms that no notice is required in order to show that the invention is not patentable subject-matter (except upon the point of novelty); that it is not useful; that the patent was unlawfully issued; that the specification is defective; that the plaintiff has no title; and that the defendant does not infringe. These cover the defences enumerated in this sentence of the text, omitting the 10th, 11th, 17th, 18th, and 19th. He regards a special plea as proper in order to set up a surrender after the cause of action arose, though whether he deems it necessary is doubtful from the language used. As to the mode of pleading a repeal, an estoppel, a release, and a former judgment, he is silent. The recognition by this distinguished jurist, whose work has so long been referred to by our courts as reliable authority on nearly every question of Patent Law, of the general issue without notice as the proper form of pleading, except in the special cases prescribed in the statute, must be of great weight in this discussion, even though no judgments could be found sustaining his position.

That the plea of not guilty puts the novelty of the invention in issue, see Blanchard *v.* Putnam (1869), 8 Wall. 420.

That a defendant may raise the issue whether the thing patented is a patentable invention without statutory permission, see Gardner *v.* Herz (1886), 118 U. S. 180; 35 O. G. 999; Mahn *v.* Harwood (1884), 112 U. S. 354; 30 O. G. 657.

That the invention is not of one of the patentable classes may be shown on the general issue, see Guidet *v.* Barber (1873), 5 O. G. 149.

That an answer in equity need not set up that the patented invention was not of one of the patentable classes, see Hendy *v.* Golden State & Miners Iron Works (1888), 127 U. S. 370; 43 O. G. 1117.

That the invalidity of the patent on the ground that the inventor's representative substantially amended the application without a new oath may be urged without stating it in the pleadings, see Eagleton Mfg. Co. *v.* West, Bradley, & Carey Mfg. Co. (1884), 111 U. S. 490; 27 O. G. 1237.

That no notice is needed to admit evidence of non-infringement, see Evans *v.* Hettick (1822), 7 Wheaton, 453; 1 Robb, 417.

ute of Limitations. Five can be introduced under the general issue only after due notice: (1) That the inventive act resulting in the invention was not performed by the patentee, and that his patent was thus surreptitiously and unjustly obtained for the discovery of another; (2) That the patentee, though a true inventor, was not the first to perform the inventive act; (3) That the patented invention is not legally new; (4) That it has been abandoned to the public; (5) That the specification fraudulently misrepresents the scope of the invention or the mode of rendering it available in practice. Or the defendant may, if he prefers it, plead specially either or all of these five defences, and plead the general issue as to all the others except the Statute of Limitations.[3] When he does this, however, his special pleas must possess all the requisites which the law prescribes for notices under the general issue.

§ 1000. Form and Service of Notice.

The purpose of the law in requiring notice to be given to the plaintiff in reference to these defences is to secure to him an opportunity to prepare himself to meet them, and to guard him against unwarrantable surprise. The rules governing the form, the particularity, and the service of the notice have been framed with the same intent, and must be complied with unless waived by the plaintiff. The notice must be in writing,[1] and must be complete and precise enough to answer the end in view, giving to the plaintiff such information as to events, persons, places, and dates as will enable him to acquaint himself with the truth of the matters thus alleged.[2] If the first

[3] That the special matters which may be given in evidence under the general issue may be pleaded specially, see Cottier *v.* Stimson (1884), 20 Fed. Rep. 906; 10 Sawyer, 212; Cottier *v.* Stimson (1883), 9 Sawyer, 435; 18 Fed. Rep. 689.

§ 1000. [1] That the notice must be in writing, see New York Pharmical Co. *v.* Tilden (1883), 21 Blatch. 191; 14 Fed. Rep. 740; 23 O. G. 272; Judson *v.* Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539.

[2] In Silsby *v.* Foote (1852), 14 How. 218, Curtis, J.: (223) "The act does not attempt to prescribe the particulars which such a notice shall contain. It simply requires notice. But the least effect which can be allowed to this requirement is that the notice should be so full and particular as reasonably to answer the end in view. This end was not merely to put the patentee on inquiry, but to relieve him from the necessity of making useless inquiries and researches, and enable

notice is defective, another properly constructed may be substituted.[3] The notice is not to be pleaded, but must be served on the plaintiff or his attorney at least thirty days before the opening of the term at which the cause is to be tried, and a failure to make such service is good ground for a continuance of the case to the succeeding term.[4] In equity the notice is given in the answer, and by amendment, under the permission of the court, the stringency of this rule as to service is sometimes avoided.[5]

him to fix with precision upon what is relied on by the defendants, and to prepare himself to meet it at the trial. This highly salutary object should be kept in view, and a corresponding disclosure exacted from the defendant of all those particulars which he must be presumed to know, and which he may safely be required to state, without exposing him to any risk of losing his rights. Less than this would not be reasonable notice, and therefore would not be such a notice as the act must be presumed to have intended."

That it is enough if the sources of the defendant's proofs are indicated with such certainty that the plaintiff can resort to and identify them, see Smith *v.* Frazer (1872), 5 Fisher, 543; 2 O. G. 175.

[3] That the notice may be repeated if at first insufficient, see Teese *v.* Huntingdon (1859), 23 How. 2.

[4] That the notice of special matters of defence is not to be pleaded but served as a notice on the plaintiff, see Cottier *v.* Stimson (1884), 20 Fed. Rep. 906; 10 Sawyer, 212.

That the notice may be given without an order of court, see Teese *v.* Huntingdon (1859), 23 How. 2.

That the thirty days of notice means thirty days before the beginning of the term of trial, see Westlake *v.* Cartter (1873), 6 Fisher, 519; 4 O. G. 636.

That notice of special matter must be given thirty days before the term opens, not before trial merely, see Westlake *v.* Cartter (1873), 4 O. G. 636; 6 Fisher, 519.

That unless the notice is given thirty days before the trial, the evidence cannot be offered, see Judson *v.* Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539; Cammeyer *v.* Newton (1876), 94 U. S. 225; 11 O. G. 287; Teese *v.* Huntingdon (1859), 23 How. 2.

That the notice may be given after depositions have been taken and the depositions may then be admitted if pertinent, see Teese *v.* Huntingdon (1859), 23 How. 2.

That unless the notice or its equivalent plea or answer is filed thirty days before the term the plaintiff is entitled to a continuance, see Phillips *v.* Combstock (1849), 4 McLean, 525; 2 Robb, 724.

[5] That in equity the special defences are to be set up in the answer, not by plea or notice, see Carnrick *v.* McKesson (1881), 19 Blatch. 369; 8 Fed. Rep. 807; Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337; Pickering *v.* Phillips (1876), 2 Bann. & A. 417; 10 O. G. 420; 4 Clifford, 383; Doughty *v.* West (1865), 2 Fisher, 553; Pitts *v.* Edmonds (1857), 2 Fisher, 52; 1 Bissell, 168.

See also §§ 1116, 1120, and notes, *post*, concerning notice in equity and its amendment when necessary.

§ 1001. Notice of Fraudulent Specification: its Requisites.

The notice of a fraudulent specification must point out the concealment or redundancy on which the defendant relies, and aver specifically that it originated in an intention to deceive the public.[1] A general statement that the specification was fraudulently made too comprehensive or too narrow is not sufficient.[2] An allegation that the Description is vague and ambiguous, or contains superfluous matter, or that the Claim is frivolous, without asserting an intention to deceive, is equally defective.[3] The plaintiff must be forewarned both of the particular errors in his specification and of the defendant's claim that they were committed in pursuance of a design to mislead the public. Otherwise the notice merely gives information of such matters as the defendant might prove, under the defence of ambiguity in the specification, without notice, and compels him to rely for his defence, not on the fraudulent want of correspondence between the specification and the invention, but on the failure of the specification to disclose the invention to persons skilled in the art in a practical and operative form.

§ 1002. Notice that the Patentee or his Assignor, though a True Inventor, Surreptitiously Obtained the Patent for the Invention while a Prior Inventor was Diligently Reducing to Practice.

The notice that the plaintiff surreptitiously and unjustly obtained the patent for that which was in fact the invention of another, who was using reasonable diligence in adapting and perfecting it, should, in analogy to the requirements of

§ 1001. [1] That where the defendant wishes to set up fraud or false representation in the patent, he must give notice thereof, see Blake *v.* Stafford (1868), 3 Fisher, 294; 6 Blatch. 195.

[2] That an allegation that "the claim is fraudulently and falsely made broader and more general and comprehensive than his invention," does not present any question of fact or allege fraud, see Blake *v.* Stafford (1868), 3 Fisher, 294; 6 Blatch. 195.

[3] That allegations that the specification "is vague, ambiguous and uncertain, and does not sufficiently describe the invention," or that "it contains more than is necessary," or that "the Claim is frivolous," or that "for divers other reasons the patent is void," do not raise questions of fact except whether the invention is so described that any one could make it, see Blake *v.* Stafford (1868), 3 Fisher, 294; 6 Blatch. 195.

the notice of prior knowledge or use, give the name and residence of the prior inventor, the date of his conception of the idea of means, the date of its conception by the patentee, and aver that the former was employing due diligence in reducing it to practice.[1] No allegations of fraud or wilful wrong are necessary, — the defence being complete if the facts already stated are established, whatever may have been the motive or opinion of the patentee.

§ 1003. Notice of Prior Patent or Publication: its Requisites.

The notice of a prior patent must give the name of the patentee, and the date of his patent, and allege it to be prior to the date of the patent in suit.[1] The notice of prior publication must set forth its title and date of publication, and mention the particular arts or articles described therein which are now claimed to be identical with the patented invention, and name the volume and page of the publication in which such description is to be found.[2] No earlier date can be

§ 1002. [1] That notice of prior invention must give the name and residence of the prior inventor, see Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

That a notice alleging that the prior conceiver was not the first inventor need not state that he abandoned the invention, see Pennsylvania Diamond Drill Co. *v.* Simpson (1886), 29 Fed. Rep. 288; 37 O. G. 218.

§ 1003. [1] That a notice of prior patent must give the name of the patentee and date of the patent, see Judson *v.* Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539; Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438; Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796.

That a notice of prior patent must allege its date as being prior to the date of the patent in suit, see Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

[2] In Silsby *v.* Foote (1852), 14 How. 218, Curtis, J.: (223) "Now we do not perceive that the defendants would be exposed to the risk of losing any right, by requiring them to indicate, in their notice, what particular things described in the printed publication they intended to aver were substantially the same as the thing patented. This they might have done either by reference to pages or titles, and perhaps in other ways, for the particular manner in which the things referred to are to be identified must depend much upon the contents of the volume and their arrangement."

In Foote *v.* Silsby (1849), 1 Blatch. 445, Nelson, J.: (462) "The notice should have specified the page or heading in the public work in which the invention had been previously described, so as to enable the patentee to turn to the article without searching through the entire volume. There can be no difficulty in giving a particular reference to the part of the book intended to be relied on, as the defendant is pre-

ascribed either to a patent or a publication than its actual date of issue.[3] A printed publication or a patent, not properly set out in the notice, cannot be used as evidence to show that the author or the patentee had prior knowledge of the invention; nor is defective notice of a prior publication aided by the evidence of experts that they would know where to look in it for a description of the patented invention.[4]

§ 1004. Notice of Prior Use: its Requisites.

The notice of prior invention varies according to the nature of the defence which is to be supported by the evidence. When the defendant alleges that the patentee has imitated and appropriated the invention of another person, the notice should disclose the name and residence of the true inventor, with the date of his inventive act, and aver that the patentee obtained his own ideas of the invention from the art or article thus produced.[1] If the defendant admits that the patentee is a true inventor, but claims that a rival inventor first conceived the idea and first reduced it to practice, he must state the name and residence of the prior inventor, with the date of his inventive act, as well as that of the inventive act of the patentee.[2] But when the defendant denies the legal

sumed to have examined the article and to be familiar with it and with the page or heading where it may be found. A general reference to the work is calculated to mislead and embarrass the party, and ought not to be sanctioned, especially as there can be no difficulty in giving a more specific one."

That the notice of a prior publication, if it be a large book, must give the page or heading, see Silsby *v.* Foote (1852), 14 How. 218; Foote *v.* Silsby (1849), 1 Blatch. 445.

[3] That the date given by the notice to a patent or publication must not be earlier than its true issue, see Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

[4] That a defective description of a publication is not aided by offering it to show the prior knowledge of the author of the book, nor by the evidence of experts and others that they should know where to find the description in the book, see Foote *v.* Silsby (1849), 1 Blatch. 445.

§ 1004. [1] This rule in regard to notice is here stated on the supposition that the law still requires some notice to be given in such cases under the fourth state of facts, though the specific defence, as it stood in the act of 1793, has disappeared from the statutes. If notice is necessary, the requisites of such notice cannot be less or other than those mentioned in the text. See Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

[2] That notice of prior invention must give the names and residences of the

novelty of the invention on the ground of prior use, his notice must be of an entirely different character. It is immaterial to the defence of prior use whether the first inventor of the art or article is known or unknown, — the fact that the invention itself was known or used before the patentee invented it being fatal to his patent. Here the notice must state the names and residences of the persons who had knowledge of the invention, or who used it, before the patentee invented it, and the localities in which it was used.[3] It being the object of this notice to save the plaintiff from useless inquiries, and not merely to put him upon inquiry, the defendant must give such detailed information as he possesses, and can fairly impart without prejudicing his own rights. The notice is sufficient when the plaintiff can readily identify the persons and places therein named, and resort to them for further knowledge.[4] The persons to be named are not the witnesses by whom a prior knowledge or use is now to be proved, but

persons who invented it, see Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

[3] That notice of prior knowledge or use must give the names and residences of the persons having such knowledge, and state where and by whom it had been used, see Searls *v.* Bouton (1882), 12 Fed. Rep. 140; 21 O. G. 1784; 20 Blatch. 426; Allis *v.* Buckstaff (1882), 22 O. G. 1705; 13 Fed. Rep. 879; Judson *v.* Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539; Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438; Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796; Earl *v.* Dexter (1874), 6 O. G. 729; Holmes, 412; 1 Bann. & A. 400; Union Paper Bag Mach. Co. *v.* Newell (1874), 11 Blatch. 549; 1 Bann. & A. 113; 5 O. G. 459; Decker *v.* Grote (1873), 3 O. G. 65; 10 Blatch. 331; 6 Fisher, 143; Seymour *v.* Osborne (1870), 11 Wall. 516; Graham *v.* Mason (1869), 5 Fisher, 1; 4 Clifford, 88; Agawam Co. *v.* Jordan (1868), 7 Wall. 583; Judson *v.* Cope (1860), 1 Fisher, 615; 1 Bond, 327; Hays *v.* Sulsor (1859), 1 Fisher, 532; 1 Bond, 279.

That under Sec. 6, act of 1793, upon notice of use by A and others the defendant might prove a use by others as well as A, see Treadwell *v.* Bladen (1827), 4 Wash. 703; 1 Robb, 531; Evans *v.* Kremer (1816), Peters C. C. 215; 1 Robb, 66.

That due notice having been given, coupled with a statement that others, then unknown, had knowledge and used, and asking that when their names are discovered they might be added, such additions were allowed, no objection being made, and further notice is thus waived, see Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796.

That where one person was named as having prior knowledge and was not examined, another person not named might be called to prove the former's knowledge, see Many *v.* Jagger (1848), 1 Blatch. 372.

[4] In Smith *v.* Frazer (1872), 2 O. G. 175, McKennan, J.: (177) "The act was designed to secure the disclosure of

the individuals who had such knowledge or made such use of the invention before it was invented by the patentee, — any person, though not named in the notice, being a competent witness to prove such prior knowledge or use on the part of those actually named.[5] The notice may or may not mention

specific facts, presumptively without the complainant's knowledge, so that the patentee might be informed of the exact nature of the defence set up, and might be enabled to obtain full knowledge of all the facts and circumstances pertaining to it. Where prior knowledge and use are alleged, he must be informed of the name and residence of the person possessing such knowledge, and of the place where such use occurred. But it was not intended to dispense with the necessity of inquiry and research on the part of the patentee. The notice is only a guide to the sources of the defendant's proofs. If they are indicated with such distinctness that the complainant can readily identify and resort to them, the purpose of the law is answered." 5 Fisher, 543 (547).

In Wise *v.* Allen (1869), 9 Wall. 737, Miller, J.: (740) "Nor do we think that the party giving notice is bound to be so specific as to relieve the other from all inquiry or effort to investigate the facts. If he fairly puts his adversary in the way that he may ascertain all that is necessary to his defence or answer, it is all that can be required, and he is not bound by his notice to impose an unnecessary and embarrassing restriction on his own right of producing proof of what he asserts. We are all, therefore, of opinion, that when, in addition to the particular town or city in which such large objects as millstones are used, the name and residence of the witness by whom that use is to be proved is also given, there is sufficient precision and certainty in the notice."

[5] In Allis *v.* Buckstaff (1882), 13 Fed. Rep. 879, Dyer, J.: (884) "There are reported cases to the effect that the names of the witnesses, by whom it is expected to prove the alleged prior use, should be stated in the answer. Such is the intimation, if not the positive ruling, in Richardson *v.* Lockwood, 6 Fisher, 454. But all cases in which it has been so held are overruled by Roemer *v.* Simon, 95 U. S. 219, and Planing Machine Co. *v.* Keith, 101 U. S. 479, wherein it is held that only the names of those who had invented or used the anticipating machine or improvement, and not of those who are to testify touching its invention or use, are required to be set forth." 22 O. G. 1705 (1706).

See also Sutro *v.* Moll (1881), 19 Blatch. 89; 8 Fed. Rep. 909; Woodbury Patent Planing Mach. Co. *v.* Keith (1879), 101 U. S. 479; 17 O. G. 1031; Planing Mach. Co. *v.* Keith (1879), 4 Bann. & A. 100; Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796; Wilton *v.* Railroads (1847), 1 Wall. Jr. 192; 2 Robb, 641.

For cases in which it was stated that the names of the witnesses must be given, see Wise *v.* Allen (1869), 9 Wall. 737; Judson *v.* Cope (1860), 1 Fisher, 615; 1 Bond, 327.

Other cases recognize the same doctrine indirectly. See La Baw *v.* Hawkins (1874), 6 O. G. 724; 1 Bann. & A. 428; Richardson *v.* Lockwood (1873), 4 O. G. 398; 6 Fisher, 454.

It is easy to see the origin of this error. As the witnesses called to prove prior use or knowledge were frequently the very persons who had used or known the invention before the plaintiff's inventive act, the name "witnesses" was applied to them in the latter capacity as

the name and residence of the original inventor.[6] The locality in which the prior use of the invention was made must be alleged with reasonable certainty. It is not sufficient to describe it as occurring in a given county.[7] The mention of certain mining or manufacturing establishments within the county as the places of its use is, however, equally definite with that of towns or villages, and complies with this requirement of the law.[8] The statement of the residences of the persons using does not dispense with that of the places of the use, although the two localities may be the same. The notice must not only point out the places *of* which the users were inhabitants but those *at* which they employed the invention.[9] This is necessary in order to enable the plaintiff to inquire into the fact of use and the nature of the invention used, as well as concerning the persons by whom the use is claimed to have been made. The date of such knowledge and use need not be stated except by the general averment that it preceded the inventive act of the patentee.[10] The allegations of the notice must not be limited to one or more of the elements of which the patented art or article consists, but must extend to the entire invention claimed.[11] The want of such a notice

well as in that of individuals giving testimony before the court. By "witness," in most of the cases where notice of "the names and residences of witnesses" is spoken of, is evidently meant not the mere testifier, but the testifier to his own prior use or prior knowledge. Thence the transition to the idea that the witness, as a testifier generally, was the person to be named was natural.

[6] That notice of prior use need not name the original inventor, see Evans *v.* Kremer (1816), Peters C. C. 215; 1 Robb, 66.

[7] That to give the name of a county as the place of knowledge or use is not sufficiently definite, see Hays *v.* Sulsor (1859), 1 Fisher, 532; 1 Bond, 279.

[8] That it is enough to name certain mining establishments in a certain county as the places of use, see Smith *v.* Frazer (1872), 5 Fisher, 543; 2 O. G. 175.

That under Sec. 6, act of 1793, notice of prior use in some places admits evidence of it in other places not named, see Evans *v.* Eaton (1818), 3 Wheaton, 454; 1 Robb, 243.

That under Sec. 6, act of 1793, when the notice named certain mills where the invention was used evidence as to other mills might be given, see Evans *v.* Eaton (1816), Peters C. C. 322; 1 Robb, 68.

[9] That a notice naming persons using as *of* a certain place but not *at* any place is not sufficient, see Searls *v.* Bouton (1882), 21 O. G. 1784; 12 Fed. Rep. 140; 20 Blatch. 426.

[10] That the notice need not mention the time when the witness knew or used, but only his name and residence and the place of use, see Phillips *v.* Page (1860), 24 How. 164.

[11] That the notice of prior use must

cannot be supplied by any form in which the evidence may be presented.[12] Neither a prior publication, nor a patent, nor a rejected application, can be offered to prove use or knowledge by the author, patentee, or applicant, unless preceded by the proper warning to the plaintiff.[13] Where the plaintiff or his licensee was himself the prior user, and is now endeavoring to enforce a patent obtained by one whom his own acts have anticipated no notice of such prior use is necessary.[14]

§ 1005. Notice of Abandonment to the Public: its Requisites.

The notice of abandonment also differs according to the nature of the evidence to be adduced. Abandonment by public use or sale and abandonment by general conduct, though

apply to the whole invention as patented, see Parks *v.* Booth (1879), 102 U. S. 96; 17 O. G. 1089.

That the notice need not specify the particular portion of the letters-patent to which the evidence will relate, see Westlake *v.* Cartter (1873), 4 O. G. 636; 6 Fisher, 519.

[12] That no evidence of any form against the novelty of the invention can be admitted unless the proper notice is given, see Marks *v.* Fox (1880), 6 Fed. Rep. 727; 18 Blatch. 502; American Saddle Co. *v.* Hogg (1872), 2 O. G. 595; 6 Fisher, 67; Holmes, 177; Railroad Co. *v.* Dubois (1870), 12 Wall. 47.

That the witness cannot be examined unless the notice is given as the law requires, see Philadelphia & Trenton R. R. Co. *v.* Stimpson (1840), 14 Peters, 448; 2 Robb, 46.

That if the evidence be received without notice and against objection the Supreme Court will reverse the judgment, though the appeal were based on different grounds, see Blanchard *v.* Putnam (1869), 8 Wall. 420.

[13] That in the absence of a notice of prior use, foreign patents and other evidence showing knowledge in this country are not admissible, see Earl *v.* Dexter (1874), 6 O. G. 729; Holmes, 412; 1 Bann. & A. 400.

That the existence of the alleged prior devices cannot be shown without proper notice of prior use, see Howe *v.* Williams (1863), 2 Fisher, 395; 2 Clifford, 245.

That without notice of prior use the rejected application of a third person cannot be proved, see Union Paper Bag Mach. Co. *v.* Pultz & Walkley Co. (1878), 15 O. G. 423; 15 Blatch. 160; 3 Bann. & A. 403.

That a notice stating that a certain person made a prior application, not naming his residence, does not warrant the admission of his testimony as to his prior knowledge or use, see Decker *v.* Grote (1872), 3 O. G. 65; 10 Blatch. 331; 6 Fisher, 143.

[14] That notice need not be given of the time, place, and person of prior use when the person is the plaintiff himself or his licensee, see American Hide & Leather Splitting & Dressing Mach. Co. *v.* American Tool & Machine Co. (1870), 4 Fisher, 284; Holmes, 503. This proposition really belongs under the doctrine of public use, as the case cited shows, but is equally true of prior use when occurring as stated in the text.

not distinct defences, are widely separated from each other by the conclusive presumption attaching to the acts which constitute the former, and the defendant is required in his notice to specifically point out which of these two methods of abandonment he intends to prove.[1] If he relies on both, they must be set forth in separate allegations.[2] The notice of simple abandonment by general conduct is sufficient when it states that fact without particulars. The notice of abandonment by public use or sale must aver that such sale or use occurred more than two years before the application for a patent.[3] A notice of such use or sale more than two years before the invention was made by the patentee is insufficient, no such defence being known to the law.[4] Under a notice of public use or sale in proper form, evidence of prior use is inadmissible.[5]

§ 1006. Evidence as to the State of the Art Admissible without Notice.

No notice is required in order to admit evidence concerning the state of the art at the date when the inventive act of the patentee is claimed to have been performed.[1] The primary

§ 1005. [1] That abandonment by public use and sale rests on different principles from abandonment by general conduct, see Jones *v.* Sewall (1873), 6 Fisher, 343 ; 3 O. G. 630 ; 3 Clifford, 563.

[2] That if both modes of abandonment are to be urged, they must be separately noticed, see Jones *v.* Sewall (1873), 6 Fisher, 343 ; 3 O. G. 630 ; 3 Clifford, 563.

That abandonment by public use must be specially alleged, see Bates *v.* Coe (1878), 98 U. S. 31 ; 15 O. G. 337 ; Wyeth *v.* Stone (1840), 1 Story, 273 ; 2 Robb, 23.

[3] That the allegation of public use or sale must aver it to have been more than two years before the application, see Agawam Co. *v.* Jordan (1868), 7 Wall. 583 ; Root *v.* Ball (1846), 4 McLean, 177 ; 2 Robb, 513.

That the consent of the inventor to the public use need not now be alleged, see Campbell *v.* City of New York (1888), 35 Fed. Rep. 504.

[4] That notice of public use or sale two years before the plaintiff's *invention* is improper, see Kelleher *v.* Darling (1878), 4 Clifford, 424 ; 14 O. G. 673 ; 3 Bann. & A. 438.

[5] That prior use cannot be shown under a notice of public use, see Kelleher *v.* Darling, (1878), 4 Clifford, 424 ; 14 O. G. 673 ; 3 Bann. & A. 438.

§ 1006. [1] That evidence of the state of the art is admissible without notice, see Stevenson *v.* Magowan (1887), 31 Fed. Rep. 809 ; 42 O. G. 1063 ; Eachus *v.* Broomall (1885), 115 U. S. 429 ; 33 O. G. 1265 ; Brown *v.* Piper (1875), 91 U. S. 37 ; 10 O. G. 417 ; La Baw *v.* Hawkins (1874), 6

purpose of such evidence is to define the exact scope of the alleged invention by comparing the point to which the art had attained before the invention was made with that to which it was carried by the invention. Such evidence may actually disclose an entire want of legal novelty in the alleged invention, but this constitutes no reason for excluding it, although the court will not permit the defendant to derive any advantage from it upon that defence.[2] Thus patents issued before the date of the invention, the use of instruments of similar character by different persons, and the existence of articles resembling or identical with that covered by the patent, may be proved by the defendant, without notice, in all cases where they tend to throw light upon the art to which the patented invention appertains.[3] Evidence not having this effect, though offered for this purpose, is not admissible unless the proper notice has been served.[4]

O. G. 724; 1 Bann. & A. 428; Richardson *v.* Lockwood (1873), 4 O. G. 398; 6 Fisher, 454; American Saddle Co. *v.* Hogg (1872), 5 Fisher, 353; 2 O. G. 59; Holmes, 133; Vance *v.* Campbell (1861), 1 Black, 427.

[2] That evidence admissible only to show the state of the art must be confined thereto, though it also shows prior use, see Zane *v.* Soffe (1880), 2 Fed. Rep. 229; 5 Bann. & A. 284; Geier *v.* Goetinger (1874), 7 O. G. 563; 1 Bann. & A. 553.

[3] That prior patents may be offered without notice to show the state of the art and the proper construction of the present patent, see Grier *v.* Wilt (1887), 120 U. S. 412; 38 O. G. 1365; Westlake *v.* Cartter (1873), 4 O. G. 636; 6 Fisher, 519.

That a patent not set up in the answer cannot be admitted to show priority, but only the state of the art, see American Saddle Co. *v.* Hogg (1872), 2 O. G. 59; Holmes, 133; 5 Fisher, 353; Railroad Co. *v.* Dubois (1870), 12 Wall. 47.

That the existence and use of an article may be proved without notice to show the state of the art, but not to show prior use, and must be confined thereto, see Zane *v.* Soffe (1880), 2 Fed. Rep. 229; 5 Bann. & A. 284.

That evidence as to the existence of certain improvements at the date of the plaintiff's invention is admissible without notice, see Vance *v.* Campbell (1861), 1 Black, 427.

That the date of a patent not set up in the answer may be shown as evidence of the existence at that time of a device otherwise shown to be in actual use, see Atlantic Works *v.* Brady (1882), 107 U. S. 192; 23 O. G. 1330.

That prior publications cannot be offered to show the state of the art, see Westlake *v.* Cartter (1873), 4 O. G. 636; 6 Fisher, 519.

[4] That when a patent not mentioned in the notice could only show that plaintiff's patent was anticipated, it is not admissible to prove the state of the art, see American Saddle Co. *v.* Hogg (1872), 5 Fisher, 353; 2 O. G. 59; Holmes, 133.

§ 1007. Evidence in Actions at Law for Infringement Governed by the Usual Rules.

The rules of evidence in actions for infringement are, in their general character, identical with those by which the Federal courts are guided in other suits at law. The various issues which arise in patent litigation differ so widely, however, from those which are presented by any controversy concerning other rights and wrongs that in their details, as developed and applied by judicial decision, those rules now constitute a peculiar and distinct department of our practical jurisprudence. In their discussion in these pages, such of their features as are derived from the common law of evidence may properly be passed over without special consideration, our attention being directed chiefly to those particular precepts and provisions which distinguish them as members of the body of our Patent Law.

§ 1008. Rules of Evidence in the Federal Courts Identical with Those in Force in the Local Courts.

The Judiciary Act of 1789, according to the interpretation given to it by the Supreme Court of the United States, provided that the rules of evidence prevailing in each State should be applied in actions at common law in the Federal courts held within that State, except when otherwise required by the Constitution, treaties, or statutes of the United States.[1] The act of 1862, affirming in this respect the Judiciary Act, enacted that the laws of the State in which the court is held should determine the competency of witnesses in trials at law in the Federal courts. Later acts removed from witnesses all incompetency on account of color, or of interest in the issue to be tried. Subject, therefore, to the modifications which are now to be considered the rules of evidence in actions for infringement, whether relating to the competency of witnesses on any other ground than that of color or interest, or to the production and effect of testimony, are those recog-

§ 1008. [1] That the rules of evidence in common law cases in the Federal Courts correspond with those in the State courts, except where modified by acts of Congress, according to the act of 1789, see Curtis, Jurisdiction and Practice of U. S. Courts, 227.

nized and followed by the courts of the State in which the Federal court is held.[2]

§ 1009. Facts of which the Federal Courts in Actions at Law for Infringement Take Judicial Notice.

All courts of common law jurisdiction take judicial notice of six classes of facts, concerning which no evidence is required from either party. These are: (1) Political facts, such as the existence of other nations, their flags and seals, the law of nations, the territorial divisions and political constitution of the State, the public matters which affect the State, its elections and general legislative meetings, its weights and measures, coins and other circulating medium, and its public and special fasts and festivals; (2) Legal facts, including the public laws of the State, its various courts with their jurisdiction and rules of practice, their officers and seals, the names and persons of their judges, the general customs of trade, and such other matters relating to law and usage as are equally well known to all citizens; (3) Official facts, embracing the names and functions of the President, senators, representatives, ambassadors, marshals, sheriffs, and all who hold office in the State by virtue of public election or appointment, the signatures of the President, marshals, and sheriffs, and the signatures and seals of notaries; (4) Public history, including the facts which constitute the political, social, and topographical development of the State and which are generally known and regarded as true; (5) Natural history, comprising such facts in nature as are permanent and uniform, and do not require special investigation in order to discover them, such as the number of days in a given month, the succession of the seasons, and the coincidence of week-days with certain days of the month and year; (6) The vernacular language, or the meaning of all common English words, and of such terms of art as are in common use.[1] As a general rule the Federal courts, in the trial of actions at law for infringe-

[2] Sec. 858, Rev. Stat.

§ 1009. [1] See 1 Greenleaf Ev. §§ 4–6; Robinson, Elementary Law, § 293.

That courts take judicial notice of all other nations and their seals of State, but not of their inferior departments and seals, see Schoerken *v.* Swift & Courtney & Beecher Mfg. Co. (1881),

ment, accept these six classes of facts as established, without the production of any testimony, and a judge may refer to any source of recognized authority in order to refresh his memory concerning them.[2] They also take judicial notice of all objects in common use in the arts, and of all matters of ordinary knowledge, including matters of science, but not of the substantial differences between the successive conditions of the same material in the various stages of its manufacture.[3]

19 O. G. 1493; 7 Fed. Rep. 469; 19 Blatch. 209.

That a French patent, certified by the Director of the Conservatoire National des Arts et Metiers de France, under seal of that Department, verified by the Minister of Agriculture and Commerce and the Minister of Foreign Affairs under their seals, is duly authenticated and admissible, see Schoerken *v.* Swift & Courtney & Beecher Mfg. Co. (1881), 19 O. G. 1493; 7 Fed. Rep. 469; 19 Blatch. 209.

[2] That matters of public notoriety, affecting the right of the applicant to a patent, will be taken notice of judicially, see Anson *v.* Woodbury (1877), 12 O. G. 1.

That courts may refresh their recollections by any safe means, see Brown *v.* Piper (1875), 91 U. S. 37; 10 O. G. 417.

[3] That a court will take judicial notice of all things in common use and of all matters of common knowledge, see Kaolatype Engraving Co. *v.* Hoke (1887), 30 Fed. Rep. 444; 39 O. G. 589; Reed *v.* Lawrence (1886), 29 Fed. Rep. 915; King *v.* Gallun (1883), 109 U. S. 99; 25 O. G. 980; McCloskey *v.* Du Bois (1881), 19 O. G. 1286; 20 O. G. 371; 8 Fed. Rep. 710; 19 Blatch. 205; Terhune *v.* Phillips (1878), 99 U. S. 592.

That courts will judicially notice whatever is generally known, including matters of science, see Slawson *v.* Grand St., Prospect Park, & Flatbush R. R. Co. (1883), 107 U. S. 649; 24 O. G. 99; Brown *v.* Piper (1875), 91 U. S. 37; 10 O. G. 417.

That courts will take judicial notice of mechanical devices of common knowledge, see Aron *v.* Manhattan Ry. Co. (1886), 26 Fed. Rep. 314; 34 O. G. 1508; Knapp *v.* Benedict (1886), 26 Fed. Rep. 627; 35 O. G. 1226.

That the court may avail itself of common knowledge of things to aid it in defining the scope of a patent, see Knapp *v.* Benedict (1886), 35 O. G. 1226; 26 Fed. Rep. 627.

That where, on a demurrer in equity, the facts of which the court must take judicial notice, show that the invention is not patentable, the bill may be dismissed, see West *v.* Rae (1887), 33 Fed. Rep. 45; Kaolatype Engraving Co. *v.* Hoke (1887), 30 Fed. Rep. 444; 39 O. G. 589.

That a court will not dismiss on demurrer for non-patentability unless the case is perfectly clear, see Eclipse Mfg. Co. *v.* Adkins (1888), 36 Fed. Rep. 554; Blessing *v.* Copper Works (1888), 34 Fed. Rep. 753.

That where a patent is manifestly void it is the duty of the court to charge the jury to render a verdict for the defendant, see Torrent & Arms Lumber Co. *v.* Rodgers (1884), 112 U. S. 659; 30 O. G. 449.

That courts do not take judicial notice of the contents of encyclopedias, etc., unless they are within the knowledge of persons in general, see Kaola-

§ 1010. Competency of Witnesses.

Any person of sufficient age and mental capacity is a competent witness in an action for infringement, unless the laws of the State in which the court is held exclude him on some other ground than that of interest or color.[1] In judging of the credibility of a witness, however, the jury may consider his interest in the cause, as a motive operating upon his disposition to disclose the truth, and in this point of view the rules by which the existence and degree of his interest were formerly determined as a test of competency are still important.[2] The ancient rules were founded upon sound reason and long experience, and in departing from them under the exigencies of modern jurisprudence, the legislatures and the courts have not intended to put interested and disinterested parties on an equal footing as witnesses to controverted facts. The interest which formerly disqualified altogether still weakens the effect of testimony, and ought to exercise a potent influence on the judgment of a jury when evidence proceeding from individuals once incompetent to testify is contradicted by evidence to which no corresponding imputation is attached. The interest which under the earlier rule rendered a witness incompetent was either that of a party to the suit, or that arising from the certainty that he must either gain or lose by the direct legal operation and effect of the judgment or that the record would be legal evidence for or against him in some other action. An interest in the question to be decided, or a remote and contingent interest in the cause itself, was not sufficient to disqualify.[3] This distinction is of great consequence in patent cases, where one question — the validity of the patent — may form the only real issue in numerous suits against different infringers, all of whom are, therefore, interested in the question to be decided in each case, though not

type Engraving Co. *v.* Hoke (1887), 30 Fed. Rep. 444 ; 39 O. G. 589.

That courts do not take judicial notice of substantial differences between the different states of materials, such as lead, &c., see McCloskey *v.* Du Bois (1881), 19 O. G. 1286 ; 20 O. G. 371 ; 8 Fed. Rep. 710 ; 19 Blatch. 205.

§ 1010. [1] Sec. 858, Rev. Stat.

[2] That the defendant's witnesses are infringers or employees of infringers may be shown to affect their evidence, see Wetherell *v.* Keith (1886), 27 Fed. Rep. 364 ; 37 O. G. 337.

[3] See 1 Greenleaf, Ev., § 389-397.

in the judgment to be rendered for or against the individual defendant. Thus, while the ancient rule was still in force, a witness was competent although another suit was pending against him for the infringement of the same patent, or though he was conceded to have used devices resembling those belonging to the plaintiff.[4] Persons who claimed exclusive privileges under the same patent, such as grantees of other sectional interests or the assignor of the defendant when not bound by a covenant of warranty, and persons whose sole connection with the suit consisted in the pecuniary aid which they afforded to the parties litigant, were also competent to testify.[5] In all these and in similar cases the jury are to pass upon the credibility of the witness on the ordinary grounds of interest and bias, uninfluenced by that presumption of a want of credibility which exists when he possesses such an interest as would formerly have excluded him from offering any evidence whatever.

§ 1011. Credibility of Witnesses.

The credibility of a witness is measured by his ability as well as his disposition to disclose the truth. His ability to disclose the truth depends upon the accuracy of his perceptions, the retentiveness of his memory, and his power to embody his recollections in suitable expressions. Perceptions are more or less accurate according to the familiarity of the witness with the object perceived, and the degree of attention which he devotes to its examination. The retentiveness of his memory is determined by his natural or acquired capacity

[4] That a witness is competent though he is defendant in another action for infringement, see Evans *v.* Hettich (1822), 7 Wheaton, 453 ; 1 Robb, 417.

That a witness who uses a device like the plaintiff's is competent, since the judgment cannot affect him, see Evans *v.* Eaton (1818), 3 Wash. 443 ; 1 Robb, 193.

That the assignor of an alleged prior patent to the defendant is a competent witness, having no interest in the event of the suit, see Treadwell *v.* Bladen (1827), 4 Wash. 703 ; 1 Robb, 531.

That a person who contributes to a fund to pay the expenses of witnesses in attending court is a competent witness, as the verdict could not affect him, see Evans *v.* Hettick (1818), 3 Wash. 408 ; 1 Robb, 166.

[5] That a grantee of a different sectional interest from the plaintiff is a competent witness, the verdict not being evidence against him, see Buck *v.* Hermance (1848), 1 Blatch. 322.

of recollection, and the occasion he has had to keep the controverted fact in mind. His power to represent the fact, as he remembers it, in words is governed by his ordinary command of language, and by his knowledge or ignorance of the terms in which the characteristics of the fact remembered are commonly described. Among honest and unbiassed witnesses there may thus be vast differences of credibility, arising solely from the differences in their ability to perceive, remember, and narrate the truth. This is particularly the case in testimony relating to inventions, the proper understanding of which so often demands extensive prior knowledge and the most careful and exact investigation, while their distinctive characteristics easily escape the memory unless it is constantly refreshed by re-investigation, and even when clearly recollected can be adequately described only in technical language which the most intelligent jury must fail to comprehend.[1] No question presents a greater difficulty, in this respect, than that of prior use, where the art or article by which the patented invention

§ 1011. [1] In Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86, Sprague, J. : (96) "Two things are to be regarded in weighing the testimony of all who testify, — the ability of the witness to tell the truth, and his disposition to tell the truth. These do not always go together. The ability to tell the truth as to past transactions, or those events that have transpired, may depend, in the first place, upon the accuracy of the observation, and in the accuracy of the knowledge at the time; then upon the occasion that the party has had to keep it in his mind and memory since ; and in the tenacity of his memory is his ability. His disposition, his moral integrity, or freedom from bias, may lead him to testify one way or the other. Now, the accuracy of knowledge at the time, as well as the ability of the man to testify the truth, depend very much upon the subject-matter. Some things that men have a full, clear, and perfect knowledge of at the time they transpire, may not be of that interesting character that they retain them in their memory. There are other things of which their knowledge at the time may not be perfect ; and when you come to the question of machinery, a question of structure, the question whether the person had a full knowledge at the time may depend upon his habit of accurate observation, and his opportunity of observing the particular structure or machine, and his intelligence or understanding of it. For if he had not a clear idea at the time, of course he cannot have immediately afterward a very clear idea to communicate tc others. You will consider, therefore, in weighing the evidence as to what it is that the witnesses undertake to describe, how far you can rely upon their memory in undertaking now to say what that was ; so that you can ascertain the instrument, the operations, and effects, so as to compare that with the plaintiff's machine."

is claimed to have been anticipated has passed out of existence, and remains only in the memories of those who saw or used it. Unless the invention were so simple or so universal as to become a matter of ordinary knowledge, or were so fully understood and carefully examined by witnesses whose recollection cannot be impeached that it can be substantially reproduced from their description, it is evident that no great reliance can be placed on any impressions they may have concerning its identity with that which forms the subject of the patent.[2] Courts, therefore, are frequently called upon to caution juries against undue dependence upon such uncertain evidence, and to disparage witnesses whose disposition to disclose the truth is undeniable.

§ 1012. Expert Witnesses.

The uncertainty which, on this account, attaches to the testimony of an ordinary witness, in cases where the character and identity of inventions are in controversy, has led to the employment of a special class of witnesses, whose previous training and accurate habits of observation fit them to perceive, remember, and explain the essential attributes of the inventions submitted to their judgment.[1] Notwithstanding the strictures passed upon expert testimony by many jurists on each side of the Atlantic, and the truth of the assertions by which these censures have been justified, it is still certain

[2] That evidence from long recollection is often delusive, see Parker *v.* Hulme (1849), 1 Fisher, 44.

That evidence of witnesses as to events occurring thirty years before is not of great weight when unsupported by exhibits, and not consistent with admitted facts, see Seibert Cylinder Oil Cup Co. *v.* Nightingale (1887), 32 Fed. Rep. 171 ; 41 O. G. 1041.

That evidence of prior use when the thing used is not produced is of little weight, after a long interval, as to its identity with the patented invention, see Adams & Westlake Mfg. Co. *v.* Rathbone (1886), 26 Fed. Rep. 262 ; Wetherell *v.* Keith (1886), 27 Fed. Rep. 364 ; 37 O. G. 337 ; and other cases cited under § 1026, *post*, in reference to evidence of prior use.

That evidence of prior use is to be weighed in view of the lapse of time since the alleged use, see Yale Lock Mfg. Co. *v.* Berkshire Nat. Bank (1885), 26 Fed. Rep. 104.

§ 1012. [1] That the opinions of experts are admitted, contrary to the general rule that witnesses must testify to facts, see Conover *v.* Rapp (1859), 4 Fisher, 57.

That no person is an expert unless skilled in the science involved, see Allen *v.* Hunter (1855), 6 McLean, 303.

that in most patent cases expert evidence is, and must always be, indispensable.[2] That the expert is consulted before he is summoned as a witness; that when his opinion is unfavorable to the party who consults him he is not produced in court, at least on that side of the case; that when called as a witness his testimony is expected to support, and generally does support, the claims of the litigant on whose behalf he is presented, — are no doubt true; but this is only what occurs in every other trial where counsel have properly prepared their case.[3] The error lies with those who ascribe judicial functions to the patent-expert, and demand of him such freedom from partisanship as the exercise of judicial power requires. That there are experts in other departments of affairs upon whose opinion the court is forced to rely as the foundation of its own judgments, because incapable of forming an opinion for itself, and that such experts consequently fill the places of judges and should be beyond the influence and control of parties, must be conceded. But such is not the case with patent-experts, whose opinion is received in evidence only in connection with the reasons on which it is based, and is to be accepted or rejected by the jury according to their own view of its fallacy or truth.[4] The patent-expert, considered in his real

[2] That expert evidence is of little value, see American Middlings Purifier Co. *v.* Christian (1877), 4 Dillon, 448; 3 Bann. & A. 42; King *v.* Louisville Cement Co. (1873), 6 Fisher, 336; 4 O. G. 181.

That *ex parte* affidavits of experts are not valuable, see Sargent *v.* Carter (1857), 1 Fisher, 277.

[3] That experts usually agree where the data are the same, see Sargent *v.* Carter (1857), 1 Fisher, 277.

[4] In Conover *v.* Roach (1857), 4 Fisher, 12, Hall, J.: (27) "In reference to these opinions, it happens as it usually does in patent cases, that the opinions of the two experts on one side are apparently, if not actually, diametrically opposed to the opinions of the two experts on the other side. Indeed, it may be assumed in this and in most other patent cases, that neither party would have called the experts on his own side, unless he had supposed that their opinions, in reference to the straining point of the case, would be directly opposed to the opinions which he supposes will be expressed by the experts of his adversary. Their well considered and deliberately formed opinions are asked in advance, and if they are found to be adverse to the party who seeks such opinion, that expert is not called on his part. I do not say this, gentlemen, to impeach the integrity or fairness of the experts, or to convey the impression that they are wanting in intelligence or mechanical knowledge, for few experts possess any of these qualities in a higher degree than those called in this

character, is an explorer, gifted with unusual powers of discernment and apprehension; a chronicler, trained to preserve the recollection of the essential attributes of things; an expositor, fitted to embody those essential attributes in accurate and intelligible language; a monitor, able to suggest the conclusions which follow from the premises he has described. His relation to the jury is not unlike that which counsel sustain to the court, as guides to a correct decision of the issues severally confided to their judgment,—the one pointing out facts and applying them in support of the claims advanced by his employer, as the other produces his authorities and applies them to the maintenance of his claims of law.[5] As no wise judge would undervalue the assistance which industrious and learned advocates afford him, on the ground that each was wedded to his own side of the cause, so no tribunal engaged in the examination of inventions can safely reject the light which the skill and experience of expert witnesses, though manifestly partisans, enable them to throw upon the nature and scope of an invention and its essential identity with, or diversity from, other inventions by which it is asserted to have been anticipated or to be infringed.[6] Their statements of fact are simply to be weighed, like those of all

case; but to show you that upon these questions of mechanical equivalents, of substantial identity, and substantial difference of organization and mode of operation, these *opinions* are to be regarded by you as *opinions* merely, and that you must decide which opinions are correct, after carefully considering such opinions, and the reasons upon which the experts have told you they are based, in connection with the other evidence in the case and that furnished by your own senses in the examination of the models which have been given in evidence. In no other way can you decide between the conflicting opinions of these experts, and it is your opinions and judgments, and not the opinions of the experts which must, in the end, determine the questions of substantial identity and equivalents litigated in the case. In that you are to consider the evidence, the opinions of the experts, the reasons they have given for their opinions, to look and consider the models, to deliberately exercise your own judgments, and then decide."

[5] That a patent-expert is an "auxiliary counsellor" who argues upon the law and the facts, see Steam Gauge & Lantern Co. *v.* Ham Mfg. Co. (1886), 28 Fed. Rep. 618.

[6] That expert evidence is of great value in patent cases, see Potter *v.* Muller (1864), 2 Fisher, 465; Morris *v.* Barrett (1859), 1 Bond, 254; 1 Fisher, 461; Carr *v.* Rice (1856), 1 Fisher, 198; French *v.* Rogers (1851), 1 Fisher, 133; Parker *v.* Stiles (1849), 5 McLean, 44; Allen *v.* Blunt (1845), 3 Story, 742; 2 Robb, 288; Brooks *v.* Jenkins (1844), 3 McLean, 432.

other witnesses, by their ability and disposition to disclose the truth; and their opinions are to be followed when, in the judgment of the jury, they are supported by the facts from which they are deduced.[7]

§ 1013. Classes of Expert Witnesses: their Distinctions.

Patent-experts are of two classes, — scientific experts and mechanical experts. A scientific expert is a witness who has made himself familiar, by study or experiments, with the principles of any science, and has thereby become qualified to understand, distinguish, and explain the properties of the objects to which such science appertains. A mechanical expert is a witness who, by practical training in an art, has acquired a degree of skill in its rules and manipulations which enables him to comprehend and apply its various instruments and methods.[1] The spheres of these two classes of experts are entirely distinct. The former brings to the examination of

[7] That expert evidence is not conclusive on the jury, see Many *v.* Sizer (1849), 1 Fisher, 17.

That expert evidence is judged by the same standards as ordinary evidence, see May *v.* County of Fond du Lac (1886), 27 Fed. Rep. 691; Carter *v.* Baker (1871), 4 Fisher, 404; 1 Sawyer, 512; Page *v.* Ferry (1857), 1 Fisher, 298.

That the jury are to give such weight to expert evidence as they see fit, according to its credibility, see Johnson *v.* Root (1858), 1 Fisher, 351; Allen *v.* Hunter (1855), 6 McLean, 303; Brooks *v.* Jenkins (1844), 3 McLean, 432.

That the evidence of experts usually varies, and their value depends on their skill, not their number, see Brooks *v.* Bicknell (1845), 4 McLean, 70.

That the value of expert opinions is measured by their reasons, see Parham *v.* American Buttonhole, Overseaming & Sewing Mach. Co. (1871), 4 Fisher, 468; Jordan *v.* Dobson (1870), 4 Fisher, 232; 7 Phila. 533; 2 Abbott, 398; Johnson *v.* Root (1858), 1 Fisher, 351; Whipple *v.* Baldwin Mfg. Co. (1858), 4 Fisher, 29; United States Annunciator & Bell Telegraph Mfg. Co. *v.* Sanderson (1854), 3 Blatch. 184.

That when experts disagree the court will make an examination and decide for itself, see La Baw *v.* Hawkins (1874), 6 O. G. 724; 1 Bann. & A. 428.

That in a conflict of scientific evidence the court may employ an independent expert to give advice as to the judgment, see Anilin *v.* Levinstein (1883), L. R. 24 Ch. D. 156.

That the evidence of an expert based on facts prevails over that of another based on mere theories, see Béné *v.* Jeantet (1889), 129 U. S. 685.

§ 1013. [1] That one "skilled in the art," a practical operator, not a scientific theorist, is an expert, see Page *v.* Ferry (1857), 1 Fisher, 298.

See for a description of these two classes of experts, Curtis on Patents, §§ 479–481.

an invention a broad and general knowledge of the fundamental truths of science, of the properties of matter, of the laws of chemistry and physics, of the progress of the arts, of the field open to inventors at any given period of time, and of the tests by which ideas of means can be distinguished from each other. His services become available whenever the character of an invention is to be determined, or its apparent scope is to be limited by the condition of the art at the date of its production, or the line is to be drawn between it and similar but independent triumphs of inventive skill.[2] Thus the evidence of scientific experts is admissible upon the following questions: (1) Whether the alleged invention is or is not the result of an inventive act; (2) Whether the elements described in the patent as constituting the invention, or included in its practical embodiment, are all essential to the expression of its idea of means; (3) Whether a given invention embraces or excludes a different invention; (4) Whether a given invention is substantially the same in principle, in function, or in effect, with any other invention. The mechanical expert, on the other hand, represents the skilled workman in his art, and brings to his examination of an invention the practical knowledge which enables him to pass upon its usefulness, and on his own ability or that of other artisans to reproduce it from the disclosure made by its inventors. His evidence is important in the following cases: (1) Where, on a defence of want of novelty, a prior patent or publication has been offered, as to the sufficiency of whose description of the invention a dispute has arisen; (2) Where the defence is

[2] That expert evidence is admissible to prove that the principle of two inventions is the same, see Tillotson *v.* Ramsay (1878), 51 Vt. 309; Tucker *v.* Spaulding (1871), 13 Wall. 453; 1 O. G. 144; 5 Fisher, 297; Page *v.* Ferry (1857), 1 Fisher, 298.

That experts are admitted to testify on questions of mechanical difference, and if qualified and unbiassed, their opinions are entitled to great respect, see Morris *v.* Barrett (1859), 1 Fisher, 461; 1 Bond, 254.

That whether one thing is the equivalent of another is a question of fact on the evidence of experts on an inspection of the inventions, see Foss *v.* Herbert (1856), 2 Fisher, 31; 1 Bissell, 121.

That an expert cannot testify, from his investigation of books and otherwise, that the invention was well known before the application, this being matter of fact and not opinion, see McMahon *v.* Tyng (1867), 14 Allen, 167.

based on the alleged inutility of the invention; (3) Where the defendant claims that the description in the specification of the patent is ambiguous, and does not furnish to those skilled in the art the necessary guidance in the practice of the invention. The wide diversity between these spheres of expert evidence, and between the qualifications of the witnesses in each, does not, however, forbid the same person from appearing and testifying in both capacities, if he possesses the required skill and knowledge.

§ 1014. Expert Testimony: when Admissible.

The opinions of experts, with their reasons, are admissible in reference to questions which are to be decided by the court, as well as upon those which are to be submitted to the jury, provided the subject-matter of the question is one to which such evidence can be properly applied. The construction of a patent lies within the province of the judge, whose duty it is to determine, from the specification of the patent, what the invention is, and whose interpretation of the patent thus furnishes the standard with which all alleged infringing or anticipating inventions are to be compared.[1] Whether a prior patent covers the same invention as the patent in dispute, and whether a re-issue departs from its original, are also questions settled by the court, which construes each of the related patents, and judges their inventions to be identical, or distinct, or one inclusive of the other. In the performance of this duty of construction, the court is at liberty to avail itself of expert evidence to such an extent as it deems expedient.[2] Neither party has a right to offer it, nor is it error in the judge to refuse to admit or consider it.[3] On the contrary, if

§ 1014. [1] That the evidence of experts is useful to show the operation of devices, but they cannot tell what the patent is for (this being the province of the court), nor whether it has been infringed (this being for the court and jury), see Waterbury Brass Co. *v.* N. Y. & Brooklyn Brass Co. (1858), 3 Fisher, 43.

That the opinion of a witness as to whether a patent is for a process or a machine is not admissible, see Corning *v.* Burden (1853), 15 How. 252.

[2] That experts may aid the court in construing a patent, see Day *v.* Stellman (1859), 1 Fisher, 487; Winans *v.* N. Y. & Erie R. R. Co. (1858), 21 How. 88.

[3] That the judge cannot be compelled to receive expert evidence to aid

an inspection of the invention practised by the defendant, in connection with the one described and claimed in the patent, satisfies the court that there has been no infringement, or if its interpretation of the present and a prior patent proves the former void for want of novelty, or if it is apparent that a re-issue cannot legitimately bear a construction which will enable it to be regarded as an amendment of its original, there is no occasion for extraneous evidence, and the court should direct the jury to return a verdict for the defendant without further inquiry.[4] In any doubtful case, however, the

in construing a patent, but may call on experts if he desires it, see Winans *v.* N. Y. & Erie R. R. Co. (1858), 21 How. 88.

[4] In Bischoff *v.* Wethered (1869), 9 Wall. 812, Bradley, J.: (814) "It is undoubtedly the common practice of the United States Circuit Courts, in actions at law, on questions of priority of invention, where a patent under consideration is attempted to be invalidated by a prior patent, to take the evidence of experts as to the nature of the various mechanisms or manufactures described in the different patents produced, and as to the identity or diversity between them; and to submit all the evidence to the jury under general instructions as to the rules by which they are to consider the evidence. A case may sometimes be so clear that the court may feel no need of an expert to explain the terms of art or the descriptions contained in the respective patents, and may therefore feel authorized to leave the question of identity to the jury, under such general instructions as the nature of the documents seems to require. And in such plain cases the court would probably feel authorized to set aside a verdict unsatisfactory to itself, as against the weight of evidence. But in all such cases the question would still be treated as a question of fact for the jury, and not as a question of law for the court. And under this rule of practice, counsel would not have the right to require the court, as matter of law, to pronounce upon the identity or diversity of the several inventions described in the patents produced. Such, we think, has been the prevailing rule in this country, and we see no sufficient reason for changing it. The control which the courts can always exercise over unsatisfactory verdicts will enable them to prevent any wrong or injustice arising from the action of juries; whereas, if the courts themselves were compellable to decide on these often recondite and difficult questions, without the aid of scientific persons familiar with the subjects of the inventions in question, they might be led into irremediable errors which would produce great injustice to suitors. We are disposed to think that the practice adopted by our courts is, on the whole, the safest and most conducive to justice. It may be objected to this view that it is the province of the court, and not the jury, to construe the meaning of documentary evidence. This is true. But the specifications of patents for inventions are documents of a peculiar kind. They profess to describe mechanisms and complicated machinery, chemical compositions, and other manufactured products which have their existence *in pais*, outside of the documents themselves, and which are commonly described by terms

courts accept the aid of experts, and when their opinions are supported by sufficient reasons, attach to them great value and importance. But neither a court nor a jury are permitted to follow the guidance of any expert in defiance of the results of practical operation and experiment, nor against conclusions derived by necessary inferences from established facts.[5]

of the art or mystery to which they respectively belong; and these descriptions and terms of art often require peculiar knowledge and education to understand them aright; and slight verbal variations, scarcely noticeable to a common reader, would be detected by an expert in the art, as indicating an important variation in the invention. Indeed, the whole subject-matter of a patent is an embodied conception outside of the patent itself, which, to the mind of those expert in the art, stands out in clear and distinct relief, whilst it is often unperceived, or but dimly perceived, by the uninitiated. This outward embodiment of the terms contained in the patent is the thing invented, and is to be properly sought, like the explanation of all latent ambiguities arising from the description of external things, by evidence *in pais*."

In Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64, Sprague, J.: (76) "It will not follow that because experts have expressed an opinion that Whipple's patent is like a preceding patent, the court will consider that as evidence to go to a jury. The court must look at it itself. It might be urged, I know, that this is evidence, and that, therefore, it is a matter to be weighed by a jury. That is not always true of opinions of experts. We must see how much the opinions of experts *embody* questions of law as well as of fact, or whether they embrace in them any question of law. When a question of law is involved in the opinion of experts, that is not to be left to a jury; and when the fact stated involves, in effect, the construction of a patent, that fact is founded on a question of law, and is of no force except as it embraces a question of law. Consequently the opinion of the experts contains nothing to go to a jury and in fact nothing on which they can sustain themselves."

See also § 1019 note 2, *post*.

[5] That the opinions of experts cannot prevail over established facts, see Tilghman *v.* Werk (1862), 2 Fisher, 229; 1 Bond, 511.

That expert opinions are outweighed by practical operation and experiment, see Hudson *v.* Draper (1870), 4 Fisher, 256; 4 Clifford, 178.

That the opinion of experts that a device is impracticable does not weigh much against evidence that it succeeds in actual use, see Seymour *v.* Marsh (1872), 2 O. G. 675; 6 Fisher, 115; 9 Phila. 380.

That for the purpose of an injunction *ex parte* affidavits and opinions of experts, contradicted by equal evidence, prove neither the validity of the plaintiff's patent nor an infringement, see Pullman Palace Car Co. *v.* Baltimore & Ohio R. R. Co. (1881), 19 O. G. 224; 4 Hughes, 236; 5 Fed. Rep. 72.

§ 1015. Documentary Evidence in Actions at Law for Infringement.

The principal documentary evidence available in actions for infringement is drawn from the files and records of the Patent Office, and from the private agreements of the parties. The patent in dispute is admissible, if regular on its face, though it contains no recital that the prerequisites have been fulfilled.[1] Other patents, whether foreign or domestic, when duly verified by the appropriate officers according to the law of the government from which they issue, are also admissible when relevant to the matter in controversy.[2] The specifications, drawings, and models annexed to or connected with such patents are likewise proper evidence if legally authenticated.[3] Assignments, grants, and licenses are competent to show the title to the patented invention, and the authority conferred on the defendant to make, or use, or sell it.[4] A caveat may be offered to prove the claims of the caveator

§ 1015. [1] That a patent is admissible though it contains no recital that the prerequisites were fulfilled, see Philadelphia & Trenton R. R. Co. *v.* Stimpson (1840), 14 Peters, 448 ; 2 Robb, 46.

That a patent not properly signed is not evidence nor can copies of the record of the patent as complete be admitted, see Marsh *v.* Nichols (1888), 128 U. S. 605 ; Marsh *v.* Nichols (1883), 24 O. G. 901; 15 Fed. Rep. 914.

[2] That foreign patents duly authenticated are admissible when relevant, see Schoerken *v.* Swift & Courtney & Beecher Mfg. Co. (1881), 19 O. G. 1493 ; 7 Fed. Rep. 469; 19 Blatch. 209.

[3] That specifications annexed to or connected with their applications are admissible, see Schoerken *v.* Swift & Courtney & Beecher Mfg. Co. (1881), 19 O. G. 1493; 7 Fed. Rep. 469; 19 Blatch. 209 ; Northwestern Fire Extinguisher Co. *v.* Phila. Fire Extinguisher Co. (1874), 10 Phila. 227 ; 1 Bann. & A. 177; 6 O. G. 34 ; Davis *v.* Gray (1867), 17 Ohio St. 330; Winans *v.* Schenectady & Troy R. R. Co. (1851), 2 Blatch. 279 ; Peck *v.* Farrington (1832), 9 Wend. 44.

That drawings may be shown in evidence, see Tinker *v.* Wilbers Eureka Mower & Reaper Mfg. Co. (1880), 1 Fed. Rep. 138 ; 5 Bann. & A. 92 ; Winans *v.* Schenectady & Troy R. R. Co. (1851), 2 Blatch. 279.

That models may be admitted, see Everet *v.* Thatcher (1878), 2 Flippin, 234 ; 3 Bann. & A. 435 ; 16 O. G. 1046 ; Johnsen *v.* Beard (1875), 2 Bann. & A. 50 ; 8 O. G. 435 ; Carter *v.* Baker (1871), 1 Sawyer, 512 ; 4 Fisher, 404 ; Swift *v.* Whisen (1867), 2 Bond, 115 ; 3 Fisher, 343 ; Blanchard *v.* Puttman (1867), 2 Bond, 84 ; 3 Fisher, 136.

[4] That an assignment may be offered in evidence, see Dederick *v.* Whitman Agricultural Co. (1886), 26 Fed. Rep. 763; 36 O. G. 570 ; New York Pharmical Association *v.* Tilden (1883), 21 Blatch. 190; 23 O. G. 272; 14 Fed. Rep. 740 ; Lee *v.* Blandy (1860), 2 Fisher, 89 ; 1 Bond, 361 ; Pitts *v.* Whitman (1843), 2 Story, 609; 2 Robb, 189.

concerning the invention at the date of its transmission to the Patent Office, and the existence in his mind of the ideas therein described, but not that the invention was then wholly or in part perfected.[5] A disclaimer is appropriate evidence upon the question of abandonment, or to limit the scope of the invention to which it refers, and is admissible if signed and filed by the patentee.[6] The application for the patent, and the correspondence of the applicant with the Patent Office in explanation or assertion of his rights, may be produced as declarations accompanying an act, and as tending to define the nature of the patented invention and the relations toward it of the applicant and patentee.[7] Preliminary papers filed by third parties are generally inadmissible, being *res inter alios acta*, and mere hearsay evidence;[8] but are some-

[6] That a caveat surreptitiously placed on file is admissible for what it is worth, although the attorney who placed it there has been disbarred, see Campbell *v.* James (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456. See also § 446 and notes, *ante*.

[6] That a disclaimer is not admissible unless proved to be signed by the patentee, and shown to be either an original or a certified copy, see Foote *v.* Silsby (1849), 1 Blatch. 445.

[7] That the application of the patentee is admissible, see Toohey *v.* Harding (1880), 1 Fed. Rep. 174; 4 Hughes, 253; 5 Bann. & A. 195.

That the correspondence with the Patent Office is admissible as a declaration accompanying an act or *res gestæ*, see Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530.

That the file-wrapper and contents are admissible to show the transactions between the inventor and the Patent Office, see Sutter *v.* Robinson (1886), 119 U. S. 530; 38 O. G. 230.

That the file-wrapper and correspondence between the patentee and the Office are admissible to aid in the interpretation of the patent, see Wirt *v.* Brown (1887), 32 Fed. Rep. 283.

That the preliminary statement filed in interference proceedings is admissible evidence in the courts, see Detroit Lubricator Co. *v.* Lunkenheimer (1886), 30 Fed. Rep. 190; 38 O. G. 331.

That evidence of what passed in the Patent Office pending the examination of an application is admissible, see Ewart Mfg. Co. *v.* Bridgeport Malleable Iron Co. (1887), 31 Fed. Rep. 149.

That the correspondence between the Patent Office and the inventor is admissible to show what the latter said his Claims meant, see Pike *v.* Potter (1859), 3 Fisher, 55.

That letters of the plaintiff to the Secretary of State containing the application and specification and certified under seal as papers in that department are admissible, see Pettibone *v.* Derringer (1818), 4 Wash. 215; 1 Robb, 152.

[8] That preliminary papers filed in the Patent Office by strangers to the litigated patent are mere declarations of third parties and are hearsay, see Howes *v.* McNeal (1880), 17 O. G. 799; 17 Blatch. 396; 4 Fed. Rep. 151; 5 Bann. & A. 77.

times received to fix a date or to describe more clearly the attributes of an invention whose existence has been otherwise established.[9] Of all these documents written or printed copies, authenticated by the seal of the Patent Office and certified by the Commissioner or Assistant Commissioner, are by statute made evidence of equal weight and pertinency with the originals.[10] The admissibility of private writings, includ-

[9] In Northwestern Fire Extinguisher Co. *v.* Phila. Fire Extinguisher Co. (1874), 6 O. G. 34, McKennan, J.: (37) "But it does not follow that a rejected specification and drawings are, under all circumstances, inadmissible as evidence. By themselves they are inconsequential, but when the inventor's idea is perfected by a practical adaptation of it, in the form of mechanism, they are valuable guides in ascertaining the date of the invention, the design of the inventor, and the principle, intended functions, and mode of operation of his mechanism, and they must, therefore, necessarily be considered in connection with it." 10 Phila. 227 (231); 1 Bann. & A. 177 (186).

That the contents of a re-issue file may be examined in order to determine the scope of the re-issue, see Hopkins & Dickinson Mfg. Co. *v.* Corbin (1881), 103 U. S. 786; 20 O. G. 297.

[10] That the statute renders admissible copies of records, &c., in the Patent Office and patents duly authenticated in the United States, and copies duly certified of the specifications of foreign patents, and makes them *prima facie* evidence, see Schoerken *v.* Swift & Courtney & Beecher Mfg. Co. (1881), 19 O. G. 1493; 7 Fed. Rep. 469; 19 Blatch. 209; Brooks *v.* Jenkins (1844), 3 McLean, 432; Peck *v.* Farrington (1832), 9 Wend. 44.

That the copies of foreign patents deposited in the Patent Office sufficiently show their dates and numbers, see *Ex parte* Trotter (1885), 32 O. G. 1603.

That a copy of a drawing filed under Sec. 1, act of 1837, where the original had none, is admissible, and with the original patent and specification is *prima facie* evidence of the particulars of the invention, see Winans *v.* Schenectady & Troy R. R. Co. (1851), 2 Blatch. 279.

That a copy of a second drawing, filed to amend one which was filed to supply one burnt in 1837, is admissible, see Emerson *v.* Hogg (1845), 2 Blatch. 1.

That a certified and sealed copy of the specifications not accompanied by a copy of the patent to which they belong is not evidence of the existence or contents of the patent, see Davis *v.* Gray (1867), 17 Ohio St. 330.

That certified copies of papers in the Patent Office, such as applications, letters, waivers, &c., may be admitted in proper cases, see Toohey *v.* Harding (1880), 1 Fed. Rep. 174; 4 Hughes, 253; 5 Bann. & A. 195.

That certified copies of assignments, &c., are admissible, see Dederick *v.* Whitman Agricultural Co. (1886), 26 Fed. Rep. 763; 36 O. G. 570; Lee *v.* Blandy (1860), 2 Fisher, 89; 1 Bond, 361; Brooks *v.* Jenkins (1844), 3 McLean, 432.

That an incorrect transcript from the Patent Office may be corrected by a new transcript, see Brooks *v.* Jenkins (1844), 3 McLean, 432.

That a clerk in the Patent Office is a proper witness to prove what documents are on record or on file in the Patent Office, see Sone *v.* Palmer (1859), 28 Mo. 539.

ing contracts, books kept in the usual course of business, and entries against interest, as well as that of parol evidence to supply defects and correct errors in the written, are governed by the same rules as in ordinary actions.[11]

§ 1016. The Patent as Evidence.

A patent, regular on its face, is *prima facie* evidence of all the facts which are essential to its own validity.[1] This rule appeared as an express provision in the act of 1790; and though omitted from subsequent statutes, and discarded by

[11] That pleadings in avoidance are not evidence, but are to be supported by evidence, see Howe *v.* Williams (1863), 2 Clifford, 245; 2 Fisher, 395.

That records of companies of which the plaintiff is not a member cannot be offered by the defendant, see Pennock *v.* Dialogue (1825), 4 Wash. 538; 1 Robb, 466.

That records showing that a certain company acknowledged the plaintiffs as inventors of an art cannot be read, the defendant not being a member of the company and not claiming that the company invented it, see Pennock *v.* Dialogue (1825), 4 Wash. 538; 1 Robb, 466.

That parol proof of lost memoranda, containing a list of persons to whom the patentee has sold rights and showing a sale to the defendant's assignors is inadmissible, such right not being capable of proof by parol, see Baldwin *v.* Sibley (1858), 1 Clifford, 150.

§ 1016. [1] That the patent is *prima facie* evidence of its own validity, and can be overcome only by clear evidence, see Frankfort Whiskey Process Co. *v.* Mill Creek Distilling Co. (1889), 37 Fed. Rep. 533; Vulcanite Paving Co. *v.* American Artificial Stone Paving Co. (1887), 42 O. G. 828; Comstock *v.* Sandusky Seat Co. (1878), 3 Bann. & A. 188; 13 O G. 230; Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438; Storrs *v.* Howe (1876), 10 O. G. 421; 4 Clifford, 388; 2 Bann. & A. 420; Brady *v.* Atlantic Works (1876), 10 O. G. 702; 4 Clifford, 408; 2 Bann. & A. 436; Smith *v.* Woodruff (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; Westlake *v.* Cartter (1873), 6 Fisher, 519; 4 O. G. 636; Hoffheins *v.* Brandt (1867), 3 Fisher, 218; Wing *v.* Richardson (1865), 2 Clifford, 449; 2 Fisher, 535; Potter *v.* Holland (1858), 1 Fisher, 382; 4 Blatch. 238; Allen *v.* Hunter (1855), 6 McLean, 303; Heinrich *v.* Luther (1855), 6 McLean, 345; Brooks *v.* Jenkins (1844), 3 McLean, 432; Philadelphia & Trenton R. R. Co. *v.* Stimpson (1840), 14 Peters, 448; 2 Robb, 46.

That whenever the evidence is doubtful the patent will prevail, see American Bell Telephone Co. *v.* People's Telephone Co. (1884), 22 Fed. Rep. 309; 22 Blatch. 531; 29 O. G. 1029; Crouch *v.* Speer (1874), 6 O. G. 187; 1 Bann. & A. 145; Agawam Co. *v.* Jordan (1868), 7 Wall. 583.

That in order to defeat the patent the evidence must remove all reasonable doubt, see Campbell *v.* Mayor of New York (1881), 9 Fed. Rep. 500; 20 O. G. 1317; 20 Blatch. 67; Shirley *v.* Sanderson (1881), 8 Fed. Rep. 905.

That the issue of a patent is not conclusive proof of its validity, see Andrews *v.* Hovey (1888), 42 O. G. 1235.

the courts until after the reconstruction of the patent system by the act of 1836, it has ever since the latter date been recognized as an established doctrine of our law. Thus, until contradicted, the patent proves that the alleged invention is the result of an inventive act; that the patentee or his assignor was its first and true inventor; that the invention is patentable subject-matter; that it is new and useful; and has not been abandoned to the public. It also demonstrates that the patent was lawfully issued to the proper patentee; if a re-issue, that it corresponds with the original; if an extension, that the requirements of the law have been obeyed; that the invention described therein differs essentially from all other inventions described and claimed in any prior patent; that its specification is without fraud and free from ambiguity; that its Claims are not excessive and clearly define the actual invention; and that the patent has neither been surrendered nor repealed.[2] When the plaintiff is the patentee it

[2] In Poppenhusen *v.* New York Gutta Percha Comb Co. (1858), 2 Fisher, 62, Ingersoll, J.: (67) "And the law is that the patent, when produced in evidence, is *prima facie* evidence that the patentee was the inventor; that the thing patented was new and useful; and that in the specification there is contained a description in such full, clear, and exact terms as will enable any one skilled in the art to which it appertains to put it in practice from the description contained in the specification."

In Potter *v.* Holland (1858), 1 Fisher, 382, Ingersoll, J.: (387) "The patent is *prima facie* evidence that the several grants of right contained in it were valid, that the several things, methods, and devices granted were new, that they were useful, that they required invention, and that they were the invention of Wilson. And this *prima facie* evidence must have full effect, unless it is rebutted by countervailing evidence." 4 Blatch. 238 (241).

In Parker *v.* Stiles (1849), 5 McLean, 44, Leavitt, J.: (60) "The patent, however, raises the presumption of the novelty and utility of the plaintiff's invention. Before a patent can issue, the person applying for it is required to make oath that he is, as he verily believes, 'the original and first inventor or discoverer' of the improvement or invention for which he seeks a patent. And it has been held that this oath, constituting as it does a part of the letters-patent, and being in evidence to the jury, forms a legal ground for the presumption of the novelty and originality of the patentees' claim, until the contrary be proved. Upon this inquiry the burden of proof is thrown upon the defendant; it being the province of the court to decide what constitutes novelty, and of the jury to determine from the evidence adduced whether the patentees' invention is new. The same remarks apply also to the subject of the utility of the invention."

That a patent is *prima facie* evidence that the invention has been made, that the patentee is the inventor, that the

is, in like manner, *prima facie* evidence of his legal title to the patented invention, and of his right to maintain an action for its infringement.[3] The weight of a patent as *prima facie* evidence is increased by its re-issue, by the success of the patentee in an interference proceeding, by its extension, and by the long and continuous recognition of its validity on the part of the public.[4] A patent granted to or owned by a de-

invention is new and useful, and that the patent has been lawfully issued, see Byerly *v.* Cleveland Linseed Oil Works (1887), 31 Fed. Rep. 73.

That a patent affords *prima facie* evidence of the patentee's right to all matters contained in it, see Johnson *v.* Root (1858), 1 Fisher, 351.

That a patent and a certified copy of the record thereof, and of its drawings are, under the act of Mar. 3, 1837, *prima facie* proof of the particulars patented, see Winans *v.* N. Y. & Erie R. R. Co. (1856), 1 Fisher, 213.

That the patent is *prima facie* evidence of novelty, see Shaver *v.* Skinner Mfg. Co. (1887), 30 Fed. Rep. 68; 41 O. G. 232; Vulcanite Paving Co. *v.* American Artificial Stone Paving Co. (1887), 42 O. G. 828; Dean *v.* Hodge (1886), 35 Minn. 146; Lehnbeuter *v.* Holthaus (1881), 105 U. S. 94; 21 O. G. 1783; Miller *v.* Smith (1880), 18 O. G. 1047; 5 Fed. Rep. 359; Crouch *v.* Speer (1874), 6 O. G. 187; 1 Bann. & A. 145; Roberts *v.* Dickey (1871), 4 Brews. (Pa.) 260; 4 Fisher, 532; 1 O. G. 4; Tompkins *v.* Gage (1865), 2 Fisher, 577; 5 Blatch. 268.

That the patent is *prima facie* evidence of utility, see Kirk *v.* DuBois (1887), 33 Fed. Rep. 252; Dean *v.* Hodge (1886), 35 Minn. 146; Lehnbeuter *v.* Holthaus (1881), 105 U. S. 94; 21 O. G. 1783.

See also as to each issue, §§ 1022–1040, and notes, *post*.

That where the state of the art has been shown, the question of patentability is open, without any presumption arising from the patent, see Adams *v.* Bellaire Stamping Co. (1886), 28 Fed. Rep. 360; 36 O. G. 567.

[3] That the patent is *prima facie* evidence of the title of the patentee, see Fischer *v.* Neil (1881), 6 Fed. Rep. 89; 19 O. G. 603.

That a patent gives the patentee a *prima facie* right to recover from every infringer, see Celluloid Mfg. Co. *v.* Goodyear Dental Vulcanite Co. (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

[4] That a re-issue increases the weight of a patent as *prima facie* evidence, see Tyler *v.* Crane (1880), 7 Fed. Rep. 775; 19 O. G. 128; La Baw *v.* Hawkins (1874), 6 O. G. 724; 1 Bann. & A. 428.

That a recovery in interference aids the force of the patent, see Ayling *v.* Hull (1865), 2 Clifford, 494.

That an extension increases the weight of a patent as *prima facie* evidence, see Tyler *v.* Crane (1880), 7 Fed. Rep. 775; 19 O. G. 128; La Baw *v.* Hawkins (1874), 6 O. G. 724; 1 Bann. & A. 428; Cook *v.* Ernest (1872), 5 Fisher, 396; 2 O. G. 89; Whitney *v.* Mowry (1867), 3 Fisher, 157; 2 Bond, 45; Swift *v.* Whisen (1867), 3 Fisher, 343; 2 Bond, 115; Ransom *v.* Mayor of New York (1856), 1 Fisher, 252.

That long admitted validity is a strong support to a patent, see Tyler *v.* Crane (1880), 7 Fed. Rep. 775; 19 O. G. 129. See also §§ 1185–1188, and notes, *post*.

fendant or his licensor enjoys the same rank as evidence, and raises the same presumptions, as one issued to the plaintiff.[5] An extension or a re-issue represents its expired or surrendered original, and is *prima facie* evidence of all the facts necessary to the validity of either.[6] A patent furnishes no evidence, however, that the defendant has been guilty of infringement.[7]

§ 1017. Records of Former Judgments as Evidence.

The records of former judgments are admissible, not only as matters of estoppel, but for various purposes connected with the interpretation of the patent, the patentability of the invention, and the identity of the defendant's process or device with that protected by the patent. A judgment between the same parties, on the same issues, by the same or a superior tribunal, is conclusive against the defeated litigant and his privies, as well as against all who so participated in the suit as to control the conduct of the action.[1] Judgments on the same points between the same parties in co-ordinate or inferior tribunals are of more or less weight according to the nature of the points decided, and the consideration to which the tribunal may be legally entitled. Such judgments cannot be departed from in any manner which simply revives the former controversy and gives the defeated party a new trial on the merits of the decided cause, except in an appellate court

[5] That the defendant's patent raises the same presumptions of novelty, &c., see Smith *v.* Woodruff (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; Blanchard *v.* Puttman (1867), 3 Fisher, 186; 2 Bond, 84; House *v.* Young (1867), 3 Fisher, 335.

[6] That a re-issue has the same effect as evidence as the original, see Serrell *v.* Collins (1857), 1 Fisher, 289.

[7] That the patent is not *prima facie* evidence of infringement, see Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86.

§ 1017. [1] That all persons who are interested in the subject-matter of a suit and have a right to make defence, control the proceedings, or produce evidence are bound by a decree, if they have knowledge of the suit, whether or not they appear to protect their rights, but all other persons are strangers to the cause, see American Bell Telephone Co. *v.* National Improved Telephone Co. (1886), 27 Fed. Rep. 663.

That a judgment is not *res adjudicata* except as to the exact points in controversy, see Brush *v.* Naugatuck R. R. Co. (1885), 23 Blatch. 277; 24 Fed. Rep. 371; 32 O. G. 894.

That a judgment is of no weight except upon the questions raised at the trial, see Celluloid Mfg. Co. *v.* Tower (1885), 26 Fed. Rep. 451.

to which the case is taken by due course of law. But these judgments, like those rendered in suits between other parties in the same or different tribunals, are often of great value upon questions relating to the construction of the patent, the identity and patentability of inventions, and other matters which must present the same aspects by whomsoever and wheresoever the questions may be raised; and in all such cases the records of these judgments, with the opinions of the court, are proper subjects for consideration, and may either be submitted in the form of evidence or cited as authorities bearing upon the issues in the case at bar.[2]

[2] That decisions of co-ordinate courts are of great weight and will usually be followed in order to preserve uniformity in the legal position of the patent, see Celluloid Mfg. Co. *v.* Zylonite Brush & Comb Co. (1886), 27 Fed. Rep. 291; 35 O. G. 1228.

That former judgments on the same patent will be followed where there is no new evidence, see American Bell Telephone Co. *v.* Wallace Electric Co. (1889), 37 Fed. Rep. 672.

That a judgment between other parties though not conclusive is entitled to great weight, see Asmus *v.* Alden (1886), 27 Fed. Rep. 684; 36 O. G. 231.

That a judgment is of greater weight against a person who was familiar with the suit and might have aided the defendant by suggestions, etc., than against one ignorant of it, see Cary *v.* Lovell Mfg. Co. (1885), 24 Fed. Rep. 141; 32 O. G. 1009.

That where a patent has been held invalid in one circuit, for not embracing patentable matter, no future bill will be entertained in that circuit on the same facts, see McCloskey *v.* Hamill (1883), 15 Fed. Rep. 750; 23 O. G. 2122.

That a concurrent line of decisions for years, in favor of a patent, are not conclusive in another circuit on other states of fact, see United Nickel Co. *v.* California Electrical Works (1885), 25 Fed. Rep. 475; 11 Sawyer, 251.

That a judgment after a long contest covering all ordinary defences is almost conclusive upon the question of validity, see Cary *v.* Domestic Spring-Bed Co. (1885), 27 Fed. Rep. 299.

That no judgment can be a precedent unless rendered after full argument, see Celluloid Mfg. Co. *v.* Tower (1885), 26 Fed. Rep. 451.

That a former judgment sustaining the patent is of no weight where the present objections raise questions not before considered, see Lockwood *v.* Faber (1886), 27 Fed. Rep. 63.

That where the validity of a re-issue has been fully considered and decided in a former case, and an appeal is pending in the Supreme Court, no opinion will be expressed thereon, see Green *v.* French (1882), 11 Fed. Rep. 591; 21 O. G. 1351.

That the rejection of an application by the Patent Office is not *res adjudicata*, see Mathews *v.* Flower (1885), 25 Fed. Rep. 830; 33 O. G. 887.

That judgments of the Patent Office are *prima facie* not conclusive, see Wilson *v.* Barnum (1849), 2 Fisher, 635; 1 Wall. Jr. 347; 2 Robb, 749.

That the judgment of a State court for damages will not be enforced against

§ 1018. Burden of Proof.

Where the pleadings in an action for infringement are closed upon the general issue, either with or without notice, the burden of proof is upon the plaintiff in reference to all the averments in his declaration. He must offer evidence to show the patentability of the invention, the validity of the patent, his own legal title, the infringement by the defendant, and the damages he has sustained.[1] The exhibition of his patent, or a certified copy thereof, makes out a *prima facie* case upon the first and second of these points, and if he is the patentee, upon the third also.[2] If he is an assignee or grantee, the instruments of conveyance, or duly authenticated copies, are sufficient evidence of his right to sue.[3] His averments of infringement, and of damages if he would recover

the patent in the United States courts, see Ryan *v.* Lee (1882), 10 Fed. Rep. 917.

On this subject of former judgments and their effect as estoppels or precedents, see §§ 1175–1184, and notes, *post*.

§ 1018. [1] In Reckendorfer *v.* Faber (1875), 92 U. S. 347, Hunt, J. : (350) "Looking at this section alone it may be safely said no one is entitled to a patent unless (1) he has discovered or invented an art, machine, or manufacture ; (2) which art, machine, or manufacture is new ; (3) which is also useful ; (4) which is not known or patented as therein mentioned. It is not sufficient that it is alleged, or supposed, or even adjudged by some officer to possess these requisites. It must in fact possess them ; and that it does possess them the claimant must be prepared to establish in the mode in which all other claims are established, to wit, before the judicial tribunals of the country." 10 O. G. 71 (72).

That the burden of proof rests upon the plaintiff to show the validity of his patent, see Miller *v.* Smith (1880), 5 Fed. Rep. 359 ; 18 O. G. 1047 ; Kelleher *v.* Darling (1878), 14 O. G. 673 ; 4 Clifford, 424 ; 3 Bann. & A. 438 ; Storrs *v.* Howe (1876), 10 O. G. 421 ; 4 Clifford, 388 ; 2 Bann. & A. 420 ; Brady *v.* Atlantic Works (1876), 10 O. G. 702 ; 4 Clifford, 408 ; 2 Bann. & A. 436.

That the burden of proof as to infringement is on the plaintiff, see Rogers *v.* Beecher (1880), 18 O. G. 793 ; 5 Bann. & A. 619 ; 3 Fed. Rep. 639.

See also § 1041 and notes, *post*.

That the burden as to damages is on the plaintiff, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514 ; 28 O. G. 1007 ; Fitch *v.* Bragg (1883), 16 Fed. Rep. 243 ; 21 Blatch. 302.

See also § 1071 and notes, *post*.

[2] That the patent is *prima facie* evidence of patentability, validity, and the title of the patentee, see § 1016 and notes, *ante*.

[3] That the production of duly authenticated instruments of assignment or grant satisfies the burden as to title, see Brooks *v.* Jenkins (1844), 3 McLean, 432.

See also § 1040 and notes, *post*.

more than nominal damages, must be supported by proper testimony.[4] On the last two issues the burden of proof remains upon him during the entire progress of the cause. On the first three it shifts to the defendant upon the exhibition of the patent and the muniments of title, and he must overcome the presumptions of patentability, validity, and ownership thus created, by clear and satisfactory evidence, removing every reasonable doubt.[5] Where the defendant files a special plea the burden rests on the party having the affirmative upon the pleadings as they are finally closed; but in this case also the patent satisfies the burden in reference to all the matters of which it is *prima facie* evidence, and imposes upon the defendant the task of overcoming its presumptions by conclusive proof.[6]

§ 1019. Evidence concerning the Nature of the Patented Invention Limited by the Interpretation given to the Patent by the Court.

A patent covers the invention or inventions which the court, in construing its provisions, decides that it describes and claims.[1] By this decision the parties and the jury are

[4] That the patent is not *prima facie* evidence of infringement, see Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86.

[5] That the patent being in evidence, and infringement shown by the plaintiff, the burden of proof rests on the defendant to show that the patent is invalid, unless it is defective on its face, see Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796; Hoffheins *v.* Brandt (1867), 3 Fisher, 218.

That unless the defendant by conclusive evidence overcomes the *prima facie* evidence of the patent, the novelty, and utility of the invention, its result from an inventive act, its invention by the patentee as the first and true inventor, and the validity of the patent, will be regarded as established, see American Bell Telephone Co. *v.* People's Telephone Co. (1884), 22 Fed. Rep. 309; 22 Blatch. 531; 29 O. G. 1029; Cushman *v.* Parham (1876), 9 O. G. 1108; Smith *v.* Woodruff (1873), 6 Fisher, 476; 4 O. G. 635; 1 Macarthur, 459.

That where the evidence leaves a question in doubt the burden of proof is not satisfied, see Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86.

That where the burden of proof is on the defendant and the evidence is conflicting the plaintiff will prevail, see Patterson *v.* Duff (1884), 20 Fed. Rep. 641.

[6] That the burden of proof is on the defendant to sustain his plea or answer and support all his defences, see Collender *v.* Came (1876), 10 O. G. 467; 4 Clifford, 393; 2 Bann. & A. 412; Crouch *v.* Speer (1874), 6 O. G. 187; 1 Bann. & A. 145.

§ 1019. [1] That the patent grants what the court construes it to grant and

bound, and the former must present their cause, and the latter must determine it, upon the hypothesis that the invention really is what the court has thus interpreted it to be. Evidence offered under any other view of the patent is inadmissible, and a verdict based on any other construction is contrary to law and will be set aside and a new trial granted.[2] This rule applies to patents introduced by the defendant as well as to those on which the plaintiff's case depends. In its interpretation of a patent the court may have recourse to any testimony to explain the meaning of its language, or to expert evidence to ascertain the essential characteristics of the described invention and the differences between it and other patented inventions, or to papers in the Patent Office which are connected with the patent or whose contents were known to the inventor at the date of his application, to show the significance which he attached to the terms that he employed.[3] But of whatever aid the courts avail themselves, their interpretation must be based upon the patent as it stands, and when its scope is once fairly apparent it can neither be limited nor extended by extraneous evidence.[4]

the jury are so to take it, see Johnson *v.* Root (1858), 1 Fisher, 351 ; Serrell *v.* Collins (1857), 1 Fisher, 289 ; Page *v.* Ferry (1857), 1 Fisher, 298.

See also §§ 731–751, and notes, *ante*.

[2] That unless the jury follow the instructions of the court as to the meaning and effect of a patent the verdict will be set aside and a new trial granted, see Johnson *v.* Root (1862), 2 Clifford, 80 ; 2 Fisher, 291.

That patents offered in evidence by the defendant are to be construed by the court, and if as thus construed they do not support the issue they are inadmissible, see Cahoon *v.* Ring (1861), 1 Clifford, 592.

That the construction of a patent offered as evidence of prior invention is for the court, see Clark Patent Steam & Fire Regulator Co. *v.* Copeland (1862), 2 Fisher, 221.

That patents offered by defendant to defeat plaintiff's patent cannot be rendered admissible by extraneous evidence, see Cahoon *v.* Ring (1861), 1 Clifford, 592.

That the court may determine that the specification of the patent in question does not cover the same invention as a preceding patent, and the jury are bound by this decision, see Serrell *v.* Collins (1857), 1 Fisher, 289.

[3] That evidence is admissible to show the meaning of terms used in the patent, see Loom Co. *v.* Higgins (1882), 105 U. S. 580 ; 21 O. G. 2031.

See also § 1015 and notes, *post*.

[4] That the file-wrapper and contents are not admissible to limit the construction of the patent, see Westlake *v.* Cartter (1873), 6 Fisher, 519 ; 4 O. G. 636.

That correspondence with and proceedings in the Patent Office are not

§ 1020. Evidence Concerning the State of the Art at the Date of the Invention.

Evidence as to the state of the art at the date of the conception of an invention is always admissible for the purpose of showing what was then known, of distinguishing the new features of the invention from the old, and of thus enabling the court to perceive the precise limits of the inventive act.[1] Such evidence requires no previous notice to either party.[2] It may consist of printed or written documents, of the oral testimony of witnesses then familiar with the art, or of specimens and exhibits of the devices then employed. Evidence offered for this purpose, though in its nature applicable to one or more of the defences to which notice is essential, cannot be considered by the jury as bearing upon such defences unless the necessary notice has been given.[3]

admissible to vary or enlarge the Claims of a patent, see Goodyear Dental Vulcanite Co. *v.* Gardiner (1871), 3 Clifford, 408 ; 4 Fisher, 224.

See also § 1015 and notes, *ante*.

That the model and rejected application of a third person are admissible to show the circumstances of the invention, in connection with evidence that the patentee knew of them, and so give construction to the patent, see Union Paper Bag Mach. Co. *v.* Pultz & Walkley Co. (1878), 15 O. G. 423 ; 15 Blatch. 160 ; 3 Bann. & A. 403.

§ 1020. [1] That evidence is admissible to show the state of the art at the date of the invention in order to enable the jury or court to understand the invention, see Loom Co. *v.* Higgins (1882), 105 U. S. 580 ; 21 O. G. 2031.

That the state of the art is proof of what was old and in general use at the date of the invention, see Brown *v.* Piper (1875), 91 U. S. 37; 10 O. G. 417.

That the state of the art is provable for three purposes : (1) To show what was then old ; (2) To distinguish what was then new ; (3) To aid the court in construing the patent, — see Brown *v.* Piper (1875), 91 U. S. 37 ; 10 O. G. 417.

That evidence as to the state of the art, though it may not show prior use, may narrow the field of invention and limit the range of inquiry, see Washburn & Moen Mfg. Co. *v.* Haish (1880), 19 O. G. 173 ; 4 Fed. Rep. 900 ; 10 Bissell, 65.

That an earlier English provisional specification may show the state of the art and thus negative invention, see McNab & Harlem Mfg. Co. *v.* Nathan Mfg. Co. (1887), 40 O. G. 1240 ; 32 Fed. Rep. 155.

[2] That evidence of the state of the art is admissible without notice or mention in the answer, see Brown *v.* Piper (1875), 91 U. S. 37 ; 10 O. G. 417.

See also § 1006 and notes, *ante*.

[3] That proof of the state of the art may aid the court in construing the patent, but cannot be permitted to defeat the suit by anticipating the invention unless that issue is raised by the pleadings, see Middletown Tool Co. *v.* Judd (1867), 3 Fisher, 141.

That evidence given as to prior use

§ 1021. Evidence Excluded on the Ground of Estoppel.

Evidence otherwise admissible may be excluded on the ground that the witness through whom it must be presented is estopped, by matter of record or *in pais*, from claiming these facts against the adverse party. A party is not permitted to deny the truth of documents or of assertions either by word or conduct, by means of which he has induced the other party to act in such a manner as might now be prejudicial to his interests if these documents or assertions could be contradicted.[1] Thus a patentee is not allowed to set up, as against his own assignee, that the patented invention is worthless or was abandoned, or that for any other cause the patent is invalid.[2] A disclaimer debars the disclaimant from asserting that the part disclaimed was actually embraced in the invention.[3] Admissions by a patentee in his application or description that any element of an invention is covered by a prior patent estop him from denying its validity.[4] An inventor, having obtained a patent for his invention, is thereby precluded from claiming that the same invention is protected under a prior patent, or that a subsequent patent for the same invention can be valid.[5] Joint patentees are estopped from averring that the invention was sole as long as the joint patent is in force, and sole patentees are in like manner disa-

See also § 1006 and notes, *ante*.

§ 1021. [1] That a witness may be estopped from giving evidence to defeat rights which he has previously induced the plaintiff to acquire, see 1 Greenleaf, Ev., § 383, etc.; and notes to § 981, *ante*.

[2] That an assignor cannot testify against his assignee in denial of the validity of the patent, see Many *v.* Jagger (1848), 1 Blatch. 372.

[3] That a disclaimer in the defendant's patent of the devices found in the plaintiff's prior patent, referring thereto, admits the validity of the plaintiff's patent, see Waterbury Brass Co. *v.* N. Y. & Brooklyn Brass Co. (1858), 3 Fisher, 43.

[4] That the patentee's admission in his application or specification cannot be afterwards contradicted by him, see Moffitt *v.* Rogers (1881), 8 Fed. Rep. 147.

[5] That a patentee cannot claim that he was not the first inventor of the patented invention, see American Paper Barrel Co. *v.* Laraway (1886), 28 Fed. Rep. 141; 37 O. G. 674.

bled from alleging that the inventive act was joint. The assignor of a patented invention cannot urge against his assignee that his own title was defective, and that the title of his alienee must, therefore, fail. These various estoppels rest upon the ordinary rule, that no person shall be permitted to deceive another by causing him to believe in the existence of a fact and afterwards attempting to disprove it.

§ 1022. Evidence under the First Defence: Origin of the Alleged Invention in an Inventive Act.

The evidence applicable to each of the several defences which may be offered to an action of infringement is governed by rules deduced from the foregoing general principles in connection with the nature of the particular defence. The first defence raises the question whether inventive skill was involved in the production of the alleged invention. This is a question for the jury in view of the state of the art at the date of the supposed inventive act and of the result attained,[1] unless it is apparent on the face of the patent that the art or article required no inventive skill, when the court will take judicial notice of that fact and declare the patent invalid.[2] The burden of proof upon this question rests upon the plaintiff, but is satisfied by the introduction of the patent, and the defendant must then overcome the presumptions arising therefrom.[3] He may prove, if he is able, by the testimony of com-

§ 1022. [1] That inventive skill is a question of evidence in view of the condition of the art and the result accomplished, see *In re* Pennock (1874), 1 MacArthur, 531 ; 5 O. G. 668.

[2] That if the want of inventive skill is apparent from the description in the patent, the court may declare the patent invalid, see Slawson *v.* Grand St., Prospect Park, & Flatbush R. R. Co. (1883), 107 U. S. 649 ; 24 O. G. 99.

[3] That the patent itself is *prima facie* evidence that the alleged invention is the result of an inventive act, see Smith *v.* Woodruff (1873), 6 Fisher, 476 ; 4 O. G. 635 ; 1 MacArthur, 459 ; Potter *v.* Holland (1858), 1 Fisher, 382 ; 4 Blatch. 238.

That the patent is *prima facie* evidence that the invention had been made when the application was filed, see Jones *v.* Sewall (1873), 3 Clifford, 563 ; 3 O. G. 630 ; 6 Fisher, 343 ; Wing *v.* Richardson (1865), 2 Fisher, 535 ; 2 Clifford, 449 ; White *v.* Allen (1863), 2 Fisher, 440 ; 2 Clifford, 224 ; Johnson *v.* Root (1862), 2 Fisher, 291 ; 2 Clifford, 108.

That reduction to practice need be shown only by the specifications and drawings, when the invention as thus

petent witnesses, either lay or expert, that the idea embodied in the invention was sufficiently suggested by then existing appliances to enable any person skilled in the art to construct and use it. He may show that the alleged inventor has not discovered either a new capability in the force employed or a new susceptibility in the object acted on, or a new mode of connecting the force and object with each other, but has merely re-arranged, or varied in constructive details, an invention which had been already known. He may attack the idea conceived by the inventor and prove that it is not a true idea of means but only of a force or function or effect. He may deny that it had ever passed beyond the mental conception of the inventor, and the verbal or graphical descriptions of the patents, into a tangible and practical embodiment. In opposition to this evidence the plaintiff may, in his rebuttal, demonstrate by proper testimony, that the idea expressed in his invention is an idea of means, and that it was reduced to practice before his application for a patent.[4] That inventive skill was necessary to its production he may prove by the evidence of experts and others skilled in the art. He may show its great utility and general acceptance by the public as the basis of an inference that if mechanical skill could have derived it from existing arts or articles it would have long before been given to mankind.[5] He may disclose its essential

disclosed is evidently practical, see Starr *v.* Farmer (1883), 23 O. G. 2327.

That where an original patent and the re-issue agree, the specification of the re-issue may be conclusive evidence that the invention was made and the means invented, as described in the original, but if they differ in substance it is not such evidence, see Sickels *v.* Evans (1863), 2 Clifford, 203; 2 Fisher, 417.

[4] That reduction to practice may be shown by actual use, see Coffin *v.* Ogden (1869), 3 Fisher, 640; 7 Blatch. 61.

See also as to reduction, §§ 125, 126, and notes, *ante*.

[5] That the great utility of the device may be shown to prove that if known it must have been in general use, see *In re* Pennock (1874), 1 MacArthur, 531; 5 O. G. 668; Sayles *v.* Chicago & Northwestern Railway Co. (1871), 4 Fisher, 584; 3 Bissell, 52; Judson *v.* Moore (1860), 1 Fisher, 544; 1 Bond, 285.

That the superior working of the plaintiff's invention is competent evidence of its novelty, see Judson *v.* Cope (1860), 1 Fisher, 615; 1 Bond, 327.

That the general acceptance and use of a device indicates that it is the result of an inventive act, see Washburn & Moen Mfg. Co. *v.* Haish (1880), 4 Fed. Rep. 900; 19 O. G. 173; 10 Bissell,

diversity from all other inventions before known, to indicate that inventive genius could alone have taken the forward step that resulted in its conception and development. If upon the entire oral testimony the jury entertain a reasonable doubt as to the exercise of inventive skill by the inventor, the *prima facie* evidence of the patent must prevail, and the issue must be found in favor of the plaintiff.

§ 1023. Evidence under the Second Defence: Performance of the Inventive Act by the Alleged Inventor.

The second defence presents the question whether the patentee or his assignor has himself performed the inventive act resulting in the alleged invention, or has unlawfully appropriated and obtained a patent for what was in fact the invention of another. Upon this question the patent affords *prima facie* evidence in favor of the plaintiff.[1] To overthrow this evidence the defendant must prove by conclusive testimony that the patented invention was conceived by some specific person other than the alleged inventor, that the alleged inventor in some manner obtained a knowledge of the invention thus conceived, and falsely claiming it to be the result of his own creative skill, procured a patent for it to be issued to himself.[2] The inventive act of the true inventor may be shown by his

65; Strobridge *v.* Lindsay (1880), 18 O. G. 62; 2 Fed. Rep. 692; 5 Bann. & A. 411; Judson *v.* Moore (1860), 1 Fisher, 544; 1 Bond, 285.

That success is not conclusive evidence of novelty, for the old may not have become widely known, see Crandall *v.* Richardson (1881), 8 Fed. Rep. 808; 19 O. G. 1628.

That where a pressing want has existed strong evidence is necessary to show that an old device would have filled it, see Howe *v.* Morton (1860), 1 Fisher, 586.

For a more complete discussion of inventive skill and its indications, see §§ 78–124, and notes, *ante*.

§ 1023. [1] That the patent is *prima facie* evidence that the patentee was a true inventor, see Potter *v.* Holland (1858), 1 Fisher, 382; 4 Blatch. 238.

[2] That on the defence that the plaintiff derived his idea of the invention from a third party, the burden of proof is on the defendant, and any doubt is fatal to him, see Locke *v.* Lane & Bodley Co. (1888), 35 Fed. Rep. 289; Duffy *v.* Reynolds (1885), 24 Fed. Rep. 855; 33 O. G. 621; McMillin *v.* Barclay (1871), 4 Brews. (Pa.) 275; 5 Fisher, 189.

That an allegation that the defendant received the information from a government employee who was the true inventor and used it for the United States must be affirmatively proved, see Brady *v.* Atlantic Works (1876), 4 Clifford, 408; 10 O. G. 702; 2 Bann. & A. 436.

own testimony, if he is accessible as a witness, or by the evidence of persons acquainted with the facts, or by any descriptions or models embodying the invention which can be identified as original with him. That the patentee or his assignor did not perform the inventive act may be established by his own admissions, by the declarations of others within his knowledge and uncontradicted by him, or by proof of his unsuccessful attempts in the same direction until he learned of the result accomplished by the true inventor and of his immediate adoption of that result as the product of his own inventive faculties.[3] No evidence of actual bad faith or intentional piracy is necessary; it is sufficient that there has been piracy in fact. In rebutting this testimony of the defendant, the plaintiff may introduce the person described in his patent as the inventor to detail the steps by which he reached the art or article in question, and thus demonstrate that it originated in his own mind, and was not imitated by him from the invention of another. The testimony of other persons who were cognizant of his experiments and successes, his own descriptions given before the conception of the alleged actual inventor had been sufficiently disclosed to communicate all its essential attributes, and any evidence tending to show his non-acquaintance with the achievements of the one to whose inventive genius the defendant ascribes the invention, are also admissible for the same purpose.[4] If doubt exists upon the entire testimony offered, the plaintiff is entitled to a verdict on this issue in his favor.[5]

[3] That the records of a company of which the plaintiff was a member, and which claimed the invention, are admissible to show that the plaintiff did not invent it, see Pennock *v.* Dialogue (1825), 4 Wash. 538; 1 Robb, 466.

[4] Upon this issue any evidence proper to show an inventive act in either of the alleged inventors and the date of such act, as well as the relations between them, and the borrowing or opportunity to borrow the conceptions of each other are admissible.

See as to the Inventive Act, §§ 99, 100, 376–379, and notes, *ante*; Suggestions of others, §§ 84, 393–395, and notes, *ante*; Date of Inventive Act, §§ 132, 380–386, 400, and notes, *ante*, and 1024, 1026, and notes, *post*.

See also Union Paper Collar Co. *v.* Van Deusen (1874), 23 Wall. 530; 7 O. G. 919; Alden *v.* Dewey (1840), 1 Story, 336; 2 Robb, 17.

[5] As to the value of this second defence, and the facts necessary to be proved thereunder, see also § 960 and notes, *ante*.

§ 1024. Evidence under the Third Defence: Priority of the Inventive Act of the Alleged Inventor.

The third defence raises the question whether the inventive act performed by the patentee, or his assignor, preceded or followed that of a rival inventor who has produced the same invention. Here, also, the patent makes out a *prima facie* case for the plaintiff, and being offered in evidence throws on the defendant the burden of proof.[1] To satisfy this burden

§ 1024. [1] That the patent is *prima facie* evidence that the patentee is the first inventor, see Maurice *v.* Devol (1883), 23 W. Va. 247; Corvallis Fruit Co. *v.* Curran (1881), 8 Fed. Rep. 150; 7 Sawyer, 270; Rogers *v.* Beecher (1880), 18 O. G. 793; 5 Bann. & A. 619; 3 Fed. Rep. 639; Miller *v.* Smith (1880), 18 O. G. 1047; 5 Fed. Rep. 359; Hoe *v.* Cottrell (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; Haskell *v.* Shoe Machinery Mfg. Co. (1878), 15 O. G. 509; 3 Bann. & A. 553; Cahill *v.* Brown (1878), 15 O. G. 697; 3 Bann. & A. 580; Judson *v.* Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539; Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796; Crouch *v.* Roemer (1877), 11 O. G. 1112; 2 Bann. & A. 637; Smith *v.* Goodyear Dental Vulcanite Co. (1876), 93 U. S. 486; 11 O. G. 246; Cammeyer *v.* Newton (1876), 94 U. S. 225; 11 O. G. 287; Tucker *v.* Tucker Mfg. Co. (1876), 10 O. G. 464; 4 Clifford, 397; 2 Bann. & A. 401; Needham *v.* Washburn (1874), 7 O. G. 649; 4 Clifford, 254; 1 Bann. & A. 537; Smith *v.* Woodruff (1873), 6 Fisher, 476; 4 O.G. 635; 1 MacArthur, 459; Goodyear Dental Vulcanite Co. *v.* Gardner (1870), 4 Fisher, 224; 3 Clifford, 408; Seymour *v.* Osborne (1870), 11 Wall. 516; Sands *v.* Wardwell (1869), 3 Clifford, 277; Hoffheins *v.* Brandt (1867), 3 Fisher, 218; Brodie *v.* Ophir Silver Mining Co. (1867), 4 Fisher, 137; 5 Sawyer, 608; Johnson *v.* Root (1862), 2 Fisher, 291; 2 Clifford, 108; Cahoon *v.* Ring (1859), 1 Fisher, 397; 1 Clifford, 592; Potter *v.* Holland (1858), 1 Fisher, 382; 4 Blatch. 238; Poppenhusen *v.* N. Y. Gutta Percha Comb Co. (1858), 2 Fisher, 62; Wayne *v.* Holmes (1856), 2 Fisher, 20; 1 Bond, 27; Philadelphia & Trenton R. R. Co. *v.* Stimpson (1840), 14 Peters, 448; 2 Robb, 46; Knight *v.* Baltimore & Ohio R. R. Co. (1840), Taney, 106; 3 Fisher, 1.

That the patent, including its specification and drawings, is *prima facie* evidence that the patentee is the original inventor of the described improvements, and the burden of proof is on the defendant to show prior invention, see Cahoon *v.* Ring (1859), 1 Fisher, 397; 1 Clifford, 592.

That a re-issued patent is *prima facie* evidence that the patentee was the first inventor and can be overcome only by clear proof, see Herring *v.* Nelson (1877), 12 O. G. 753; 14 Blatch. 293; 3 Bann. & A. 55.

That the presumption that the patentee is the original inventor arises only at the grant of the patent, and does not relate back beyond the filing of the application, see Wing *v.* Richardson (1865), 2 Clifford, 449; 2 Fisher, 535.

That the patent being in evidence the burden of proof is on the defendant to show that the patentee was not the first inventor, see American Bell Telephone Co. *v.* People's Telephone Co. (1884), 29 O.G. 1029; 22 Fed. Rep. 309:

the defendant must show that the alleged rival inventor conceived the invention before the idea of means which it embodies was generated in the mind of the inventor named in the patent, and that he either first reduced it to practice or exercised reasonable diligence in the endeavor so to do.[2] The date of the conception of the invention by the plaintiff's inventor is, at this stage of the case, assumed to be that of the patent itself, or if the application is referred to in the patent, to be that of the filing of the application.[3] The date of its conception by the alleged rival inventor may be shown by his own testimony, or by contemporaneous models or descriptions indicating that the idea was then present in his mind.[4] The date of his reduction to practice may be fixed by

22 Blatch. 531 ; Worswick Mfg. Co. *v.* City of Buffalo (1884), 20 Fed. Rep. 126; 27 O. G. 1239 ; 22 Blatch. 157 ; Putnam *v.* Hollender (1881), 6 Fed. Rep. 882 ; 19 O. G. 1423 ; 19 Blatch. 48 ; Rogers *v.* Beecher (1880), 18 O. G. 793; 5 Bann. & A. 619; 3 Fed. Rep. 639; Crouch *v.* Roemer (1877), 11 O. G. 1112 ; 2 Bann.& A. 637; Taylor *v.* Wood (1874), 8 O. G. 90 ; 1 Bann. & A. 270 ; 12 Blatch. 110; Doherty *v.* Haynes (1874), 6 O. G. 118 ; 1 Bann. & A. 289 ; 4 Clifford, 291 ; McMillin *v.* Barclay (1871), 4 Brews. (Pa.) 275 ; 5 Fisher, 189 ; Sands *v.* Wardwell (1869), 3 Clifford, 277 ; Hoffheins *v.* Brandt (1867), 3 Fisher, 218 ; *Brodie v. Ophir Silver* Mining Co. (1867), 4 Fisher, 137 ; 5 Sawyer, 608 ; Wayne *v.* Holmes (1856), 2 Fisher, 20 ; 1 Bond, 27 ; Pitts *v.* Hall (1851), 2 Blatch. 229 ; Knight *v.* Baltimore & Ohio R. R. Co. (1840), Taney, 106 ; 3 Fisher, 1.

That the defence of prior invention rests upon evidence controlled by the party asserting it, and must be proved beyond reasonable doubt, see Thayer *v.* Hart (1884), 28 O. G. 542 ; 20 Fed. Rep. 693 ; 22 Blatch. 229.

That the preliminary statement filed in interference proceedings is admissible in evidence on the question of priority in rebuttal of the claimant's testimony, see Detroit Lubricator Co. *v.* Lunkenheimer (1886), 30 Fed. Rep. 190 ; 38 O. G. 331.

[2] That the defendant must show that the date of the prior invention was earlier than the plaintiff's could have been, according to the evidence adduced, see United States Stamping Co. *v.* Jewett (1880), 18 Blatch. 469 ; 18 O. G. 1529 ; 7 Fed. Rep. 869.

[3] That the date of the patent is *prima facie* the date of the invention, see Webster Loom Co. *v.* Higgins (1879), 16 O. G. 675 ; 15 Blatch. 446 ; 4 Bann. & A. 88.

That if the application is referred to in the patent the date when it was filed is *prima facie* that of the inventive act, see § 1026, note 15, *post.*

[4] That descriptions of the invention, given by the alleged inventor to others, may be shown for the purpose of proving that he had then invented it, as no one but himself can otherwise become aware of that fact, see Sayles *v.* Hapgood (1869), 3 Fisher, 632 ; 2 Bissell, 189; Philadelphia & Trenton R. R. Co. *v.* Stimpson (1840), 14 Peters, 448 ; 2 Robb, 46 ; Evans *v.* Hettick (1818), 3 Wash. 408 ; 1 Robb, 166.

witnesses who knew of his production of the art or article in a form available for immediate practical use.[5] His diligence in perfecting the invention may be proved by any evidence establishing his perseverance in the effort to render it available as far as his health, his means, and his command of his own time and energies reasonably permitted.[6] The plaintiff, in rebutter, may show that the date of the inventive act performed by his inventor preceded that of his patent or his application, and was in fact earlier than its performance by his rival, offering for this purpose the same class of evidence by which the date of his rival's inventive act might have been established.[7] Or failing in this he may attack the diligence of his rival by testimony proving that his opportunities for perfecting the invention were unreasonably neglected, and that his rights as first conceiver were thereby forfeited in favor of the prompt reducer to whom the patent has been issued. Where this question of priority of invention has already been decided in an interference proceeding, the record of that judgment is admissible in favor of the then successful party, and though not conclusive on the jury is entitled to grave consideration.[8] But the defendant must establish his position be-

[5] That actual use proves reduction to practice, see Coffin *v.* Ogden (1869), 3 Fisher, 640 ; 7 Blatch. 61.

[6] For rules concerning diligence in reduction, see §§ 383–387, and notes, *ante*.

That if the patentee temporarily abandoned his efforts and then resumed them after another inventor had applied for a patent, he cannot show that he invented before the date of his resumption, see Johnson *v.* Root (1862), 2 Fisher, 291 ; 2 Clifford, 108.

That where the later inventor first reduced to practice and applied for and obtained a patent, and the earlier inventor applied for a patent before he had reduced to practice, and was not diligent, the later inventor does not infringe the earlier inventor's patent, see Electric R. R. Signal Co. *v.* Hall R. R. Signal Co. (1881), 6 Fed. Rep. 603.

[7] That when the defendant proves that he invented the device before the plaintiff filed his application, the burden is on the plaintiff to show that he invented before the defendant did, see Thayer *v.* Hart (1884), 20 Fed. Rep. 693 ; 28 O. G. 542 ; 22 Blatch. 229.

That a foreign inventor cannot carry the date of his invention back by showing acts done in a foreign country, see Boulton *v.* Illingworth (1888), 43 O. G. 508.

That the fact that an alleged prior inventor, though patenting other kindred inventions, did not patent this one is competent evidence against his invention of it, see Frink *v.* Petry (1874), 11 Blatch. 422 ; 1 Bann. & A. 1 ; 5 O. G. 201.

[8] That a patent is increased in weight as *prima facie* evidence of priority by the success of the patentee in interference

yond reasonable doubt; otherwise the presumption arising in favor of the patentee from his own oath as to priority, confirmed by the issue of the patent, will prevail.[9] The question involved in this defence sometimes presents itself in a modified form, as where the plaintiff's inventor was the first conceiver of the invention but is alleged by the defendant to have forfeited his right to a patent in favor of a later inventor, by his unreasonable delay in its reduction. The attitude of the parties toward certain of the issues raised by this defence are thus reversed, the defendant now attacking and the plaintiff supporting the diligence of the first conceiver; but the evidence applicable to these issues remains the same, and the burden of proof still rests on the defendant to overcome the presumptions created by the plaintiff's patent. This burden is not removed by the fact that the defendant has himself received a subsequent patent for the same invention.[10]

proceedings, see Ayling *v.* Hull (1865), 2 Clifford, 494.

That the burden of proof as to priority rests on him to whom the decision of the Patent Office on an interference is adverse, see Wire Book Sewing Mach. Co. *v.* Stevenson (1882), 11 Fed. Rep. 155.

That the decisions of the Commissioner as to priority are not conclusive, though entitled to very great weight, see Gloucester Isinglass & Glue Co. *v.* Brooks (1884), 19 Fed. Rep. 426.

[9] That the defendant's evidence of prior invention must remove all reasonable doubt, see Donoughe *v.* Hubbard (1886), 27 Fed. Rep. 742; 35 O. G. 1561; Worswick Mfg. Co. *v.* City of Buffalo (1884), 20 Fed. Rep. 126; 22 Blatch. 157; 27 O. G. 1239; Gottfried *v.* Phillip Best Brewing Co. (1879), 17 O. G. 675; 5 Bann. & A. 4.

That the presumption that the patentee is the first inventor arises from his oath, and remains till the contrary is proved, see Elizabeth *v.* Pavement Co. (1877), 97 U. S. 126; Union Sugar Refinery *v.* Matthiesson (1865), 2 Fisher, 600; 3 Clifford, 639; Bartholomew *v.* Sawyer (1859), 1 Fisher, 516; 4 Blatch. 347.

[10] That the introduction of the defendant's subsequent patent does not change the burden of proof as to priority of invention, see Goodyear Dental Vulcanite Co. *v.* Gardner (1870), 4 Fisher, 224; 3 Clifford, 408.

That when the plaintiff first applied for a patent and the defendant obtained his by disclaiming the plaintiff's invention, but after the plaintiff's patent was granted re-issued his to cover the matter before disclaimed, the burden of proof is on him to show that his inventive act was the earliest, see Smith *v.* Allen (1865), 2 Fisher, 572.

That the testimony of a defendant that he was the first inventor of the article is overcome by proof that after the date of his alleged invention he applied for a patent relating to the same subject but based on an essentially *different principle*, see Lamson Cash Railway Co. *v.* Osgood Cash Car Co. (1886), 29 Fed. Rep. 210; 38 O. G. 1490.

That inferences drawn by the court

§ 1025. Evidence under the Fourth Defence: the Alleged Invention not within the Protected Classes.

The fourth defence raises the question whether the patented invention is embraced within either of those six classes of inventions which are made patentable by the Acts of Congress. Though this is a question for the jury, the court may take judicial notice that the invention is not among those thus protected, when that fact is evident from the patent, and may then, without testimony, direct a verdict on this issue for the defendant.[1] The plaintiff's patent furnishes *prima facie* evidence that the invention described and claimed therein is patentable.[2] The defendant may contradict this evidence by expert and other testimony that the alleged invention does not possess the essential characteristics either of an art, a machine, a manufacture, a composition of matter, a design, or an improvement. If the alleged invention purports to be a combination, he may prove by similar evidence that its elements do not co-operate for the production of a unitary result, and that it is, therefore, a simple aggregation. In his rebutter, the plaintiff offers evidence of the same nature to

from the conduct of a party may outweigh the direct testimony of any number of witnesses, see the Telephone Cases (1888), 126 U. S. 1; 43 O. G. 377.

That the fact that one who now claims to have been the first inventor made no protest against the use of the invention or against the claims of another to be its inventor, but patented an improvement on it without attempting to cover the original, is strong proof against his present claims, see Hutchinson *v.* Everett (1885), 35 O. G. 1110; 26 Fed. Rep. 531.

Upon the subject of priority as between rival inventors, see §§ 370–391, 961, and notes, *ante*.

§ 1025. [1] That the court may order a verdict for the defendant if it is apparent on the face of the patent that the invention is not within the protected classes, see Blessing *v.* Copper Works (1888), 34 Fed. Rep. 753; West *v.* Rae (1887), 33 Fed. Rep. 45; Slawson *v.* Grand St., Prospect Park, & Flatbush R. R. Co. (1882), 107 U. S. 649; 24 O. G. 99; Everett *v.* Thatcher (1878), 16 O. G. 1046; 2 Flippin, 234; 3 Bann. & A. 435. These were cases in equity, but the same principles there applied would compel the court to protect the defendant against an adverse verdict at law. See also § 962, and notes, *ante*.

[2] That the patent is *prima facie* evidence of the patentability of the invention, see Fraim *v.* Keen (1885), 25 Fed. Rep. 820; 34 O. G. 1048; Strobridge *v.* Lindsay (1880), 18 O. G. 62; 2 Fed. Rep. 692; 5 Bann. & A. 411.

That the presumption of patentability arising from the patent is not repelled when the device, though needed, is not shown to have been in use before, see Patterson *v.* Duff (1884), 20 Fed. Rep. 641.

controvert these positions of the defendant. The effect of such evidence, on either side, must be confined to the conformity of the invention claimed in the patent with the legal definition of these patentable classes of inventions. What the necessary attributes of the patented invention are is settled by the court through its construction of the patent, and cannot be affected by extraneous evidence.[3] What the essential characteristics of each of the six classes of patentable inventions are is matter of determinate law, and equally beyond the sphere of testimony.[4] Evidence is admissible to show that the attributes of the invention, as ascertained by the court, correspond with the essentials of a patentable art or article as defined by the law; but this evidence must consist almost entirely of the opinions of persons skilled in the detection of resemblances and differences, rather than of observers and narrators of specific facts. In many cases, indeed, the field of evidence is so narrow that the whole question must be practically treated as a question of law, the jury being required to follow the instruction of the court in reference to its decision.

§ 1026. Evidence under the Fifth Defence: Novelty of the Patented Invention: Prior Use.

The fifth defence raises an issue as to the legal novelty of the patented invention. This issue embraces three questions: (1) Whether the invention had been used in such a manner in this country as to render it accessible to the public at the date of its alleged invention by the patentee or his assignor; (2) Whether it had been patented anteriorly to that date; (3) Whether it had been described in any printed publication which, before that date, had been placed within reach of the public. An affirmative answer to either of these three questions is equivalent to a denial of the legal novelty of the pat-

[3] That the patented invention is what the court construes the patent to cover and cannot be varied by other evidence, see §§ 731, 1019, and notes, *ante*.

[4] For the essential attributes of each class of inventions, see §§ 159–220, and notes, *ante*.

For the characteristics of a patentable combination, see §§ 153–156, and notes, *ante*.

ented invention, and, therefore, of the validity of the patent in which it is described and claimed.[1] The patent answers all these questions in the negative, and thus throws upon the defendant the burden of proving the affirmative, in reference to at least one of them, beyond a reasonable doubt in order to maintain this defence.[2] The question of prior use is

§ 1026. [1] That if the defence of want of legal novelty is satisfactorily proved, it must avail, see Miller *v.* Smith (1880), 5 Fed. Rep. 359; 18 O. G. 1047.

As to the scope of this defence, see § 963, and notes, *ante*.

That legal novelty cannot exist where there was either prior use, prior patent, or prior publication, see §§ 113, 123, 222, 315, 316, and notes, *ante*.

[2] That the patent itself is *prima facie* evidence of the novelty of the invention, see Byerly *v.* Cleveland Linseed Oil Works (1887), 31 Fed. Rep. 73; Shaver *v.* Skinner Mfg. Co. (1887), 30 Fed. Rep. 68; 41 O. G. 232; Deane *v.* Hodge (1886), 35 Minn. 146; Lehnbeuter *v.* Holthaus (1881), 105 U. S. 94; 21 O. G. 1783; Corvallis Fruit Co. *v.* Curran (1881), 8 Fed. Rep. 150; 7 Sawyer, 270; Rogers *v.* Beecher (1880), 18 O. G. 793; 3 Fed. Rep. 639; 5 Bann. & A. 619; Thomas *v.* Shoe Machinery Mfg. Co. (1878), 16 O. G. 541; 3 Bann. & A. 557; Miller & Peters Mfg. Co. *v.* Du Brul (1877), 12 O. G. 351; 2 Bann. & A. 618; Needham *v.* Washburn (1874), 7 O. G. 649; 4 Clifford, 254; 1 Bann. & A. 537; Smith *v.* Woodruff (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; Roberts *v.* Dickey (1871), 4 Brews. (Pa.) 260; 4 Fisher, 532; 1 O. G. 4; Whitney *v.* Mowry (1867), 3 Fisher, 157; 2 Bond, 45; Blanchard *v.* Puttman (1867), 3 Fisher, 186; 2 Bond, 84; Swift *v.* Whisen (1867), 3 Fisher, 343; 2 Bond, 115; Poppenhusen *v.* N. Y. Gutta Percha Comb Co. (1858), 2 Fisher, 62; Potter *v.* Holland (1858), 1 Fisher, 382; 4 Blatch. 238; Wayne *v.* Holmes (1856), 2 Fisher, 20; 1 Bond, 27; Ransom *v.* Mayor of New York (1856), 1 Fisher, 252; Teese *v.* Phelps (1855), 1 McAllister, 48; Parker *v.* Stiles (1849), 5 McLean, 44.

That a patent for a combination of old elements is *prima facie* evidence that it is new, see Shaver *v.* Skinner Mfg. Co. (1887), 30 Fed. Rep. 68; 41 O. G. 232.

That a re-issued patent is evidence that the invention was new, see Serrell *v.* Collins (1857), 1 Fisher, 289.

That an extension after a hearing is strong evidence of novelty, see Black *v.* Thorne (1872), 2 O. G. 388; 5 Fisher, 550; 10 Blatch. 66; Whitney *v.* Mowry (1867), 3 Fisher, 157; 2 Bond, 45; Swift *v.* Whisen (1867), 2 Fisher, 343; 2 Bond, 115.

That a British patent under the great seal proves itself, but is only *prima facie* evidence that the invention is new and useful and of some probable value, see Gatling *v.* Newell (1857), 9 Ind. 572.

That the weight of a patent as *prima facie* evidence of novelty may be aided by showing that the invention was subjected to rigid scrutiny and comparison with previous patents in the Patent Office, see Shaver *v.* Skinner Mfg. Co. (1887), 30 Fed. Rep. 68; 41 O. G. 232.

That the patent being in evidence the burden of proof rests on the defendant to show want of novelty, see Vulcanite Paving Co. *v.* American Artificial Stone Pavement Co. (1887), 42 O. G. 828; Bostock *v.* Goodrich (1884), 21 Fed. Rep. 316; 29 O. G. 278; Double-

further divisible into two others: (1) Whether the art or article alleged to have been previously used was identical with the patented invention; (2) Whether the use alleged was such as to have rendered the invention accessible to the public at the date of its conception by the plaintiff's inventor.[3]

day *v.* Beatty (1882), 11 Fed. Rep. 729; 22 O. G. 859; Green *v.* French (1882), 11 Fed. Rep. 591; 21 O. G. 1351; Woven Wire Mattress Co. *v.* Wire-Web Bed Co. (1881), 8 Fed. Rep. 87; Miller *v.* Smith (1880), 18 O. G. 1047; 5 Fed. Rep. 359; Gear *v.* Grosvenor (1873), 6 Fisher, 314; 3 O. G. 380; Holmes, 215; Clark *v.* Scott (1872), 2 O. G. 4; 9 Blatch. 301; 5 Fisher, 245; Baldwin *v.* Schultz (1871), 2 O. G. 315; 9 Blatch. 494; 5 Fisher, 75; Roberts *v.* Dickey (1871), 1 O. G. 4; 4 Brews. (Pa.) 260; 4 Fisher, 532; Howes *v.* Nute (1870), 4 Fisher, 263; 4 Clifford, 173; Tompkins *v.* Gage (1865), 2 Fisher, 577; 5 Blatch. 268; Union Sugar Refinery *v.* Matthiesson (1865), 2 Fisher, 600; 3 Clifford, 639; Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530.

That the defendant must prove want of novelty beyond reasonable doubt, see American Bell Telephone Co. *v.* Globe Telephone Co. (1887), 31 Fed. Rep. 729; Cary *v.* Lovell Mfg. Co. (1887), 31 Fed. Rep. 344; 40 O. G. 1239; Cohansey Glass Mfg. Co. *v.* Wharton (1886), 28 Fed. Rep. 189; 36 O. G. 343; Doubleday *v.* Beatty (1882), 11 Fed. Rep. 729; 22 O. G. 859; Crouch *v.* Speer (1874), 6 O. G. 187; 1 Bann. & A. 145; Wood *v.* Cleveland Rolling Mill Co. (1871), 4 Fisher, 550; Tompkins *v.* Gage (1865), 2 Fisher, 577; 5 Blatch. 268.

That although the defendant has received a patent and introduces it, the burden of proof on the question of novelty still rests on him, see Goodyear Dental Vulcanite Co. *v.* Gardner (1870), 4 Fisher, 224; 3 Clifford, 408.

[3] That proof of actual prior use does overcome the presumption arising from the patent, see Judson *v.* Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539.

That prior use is a question of fact, see Fisk *v.* Church (1872), 1 O. G. 634; 5 Fisher, 540.

That where the prior invention was identical with the one patented, was complete, capable of producing some result, and was known in this country, the defence will prevail, see Stitt *v.* Eastern R. R. Co. (1884), 22 Fed. Rep. 649.

That the *prima facie* evidence of novelty afforded by the patent is not overcome unless true anticipating inventions are definitely proved to have been in prior use, see Butler *v.* Bainbridge (1886), 29 Fed. Rep. 142; 37 O. G. 1124.

That evidence showing the existence of practical operative devices, before their conception by the patentee, invalidates the patent, see American Bell Telephone Co. *v.* People's Telephone Co. (1884), 29 O. G. 1029; 22 Blatch. 531; 22 Fed. Rep. 309.

That what would infringe, if later, anticipates, if earlier, see Peters *v.* Active Mfg. Co. (1884), 28 O. G. 1102; 21 Fed. Rep. 319.

That prior use of articles, less perfect but identical in principle, invalidates the patent, see Magin *v.* McKay (1885), 32 O. G. 1237; 24 Fed. Rep. 743.

That a prior use of similar but not identical devices cannot defeat the patent, though they may show the state of the art and thus limit the patent, see McFarland *v.* Spencer (1885), 32 O. G.

Upon both of these points the defendant's evidence must be conclusive.[4] The identity of the prior art or article with the patented invention may be established by any kind of relevant testimony.[5] If the invention is an article, specimens in exist-

893; 23 Fed. Rep. 150; 23 Blatch. 155.

That a small device may show prior use, see Peters *v.* Active Mfg. Co. (1889), 129 U. S. 530.

That courts cannot pronounce a patent void for prior use unless the evidence shows that the same principles were before employed, see Case *v.* Morey (1818), 1 N. H. 347.

That a defence to a patent for a combination as a whole must apply to the entire combination and not to separate parts, see Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337.

[4] That the burden of proof rests upon the defendant to show the existence of the identical invention before the grant of the plaintiff's patent, see Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86.

That a defendant has the burden of proof on the question of prior use, see Thayer *v.* Spaulding (1886), 27 Fed. Rep. 66; 36 O. G. 1044; Cantrell *v.* Wallick (1886), 117 U. S. 689; 35 O. G. 871; Dreyfus *v.* Schneider (1885), 25 Fed. Rep. 481; Worswick Mfg. Co. *v.* City of Buffalo (1884), 27 O. G. 1239; 20 Fed. Rep. 126; 22 Blatch. 157; Parker *v.* Remhoff (1879), 17 Blatch. 206; 14 O. G. 601; 3 Bann. & A. 550; Webster Loom Co. *v.* Higgins (1879), 16 O. G. 675; 15 Blatch. 446; 4 Bann. & A. 88; Fisk *v.* Church (1872), 1 O. G. 634; 5 Fisher, 540; Baldwin *v.* Schultz (1871), 5 Fisher, 75; 2 O. G. 315; 9 Blatch. 494; Magic Ruffle Co. *v.* Douglass (1863), 2 Fisher, 330; Wayne *v.* Holmes (1856), 2 Fisher, 20; 1 Bond, 27.

That prior use must be proved beyond reasonable doubt, see Osborne *v.* Glazier (1887), 40 O. G. 1137; 31 Fed. Rep. 402; Cluett *v.* Claflin (1887), 30 Fed. Rep. 921; 41 O. G. 1042; Wetherill *v.* Keith (1886), 27 Fed. Rep. 364; 37 O. G. 337; Cantrell *v.* Wallick (1886), 117 U. S. 689; 35 O. G. 871; Thayer *v.* Spaulding (1886), 27 Fed. Rep. 66; 36 O. G. 1044; Dreyfus *v.* Schneider (1885), 25 Fed. Rep. 481; Everest *v.* Buffalo Lubricating Oil Co. (1884), 20 Fed. Rep. 848; 28 O. G. 1101; American Bell Telephone Co. *v.* People's Telephone Co. (1884), 22 Fed. Rep. 309; 29 O. G. 1029; 22 Blatch. 531; Thayer *v.* Hart (1884), 20 Fed. Rep. 693; 22 Blatch. 229; 28 O. G. 542; Campbell *v.* James (1879), 18 O. G. 979; 4 Bann. & A. 456; 17 Blatch. 42; Hawes *v.* Antisdel (1875), 8 O. G. 685; 2 Bann. & A. 10; Coffin *v.* Ogden (1873), 18 Wall. 120; 5 O. G. 270; Magic Ruffle Co. *v.* Douglass (1863), 2 Fisher, 330; Washburn *v.* Gould (1844), 3 Story, 122; 2 Robb. 206.

That every reasonable doubt in regard to prior use must be resolved in favor of the plaintiff, see Washburn & Moen Mfg. Co. *v.* Haish (1880), 4 Fed. Rep. 900; 19 O. G. 173; 10 Bissell, 65; Hawes *v.* Antisdel (1875), 8 O. G. 685; 2 Bann. & A. 10; Coffin *v.* Ogden (1873), 18 Wall. 120; 5 O. G. 270; Parham *v.* American Buttonhole Overseaming & Sewing Mach. Co. (1871), 4 Fisher, 468; Washburn *v.* Gould (1844), 3 Story, 122; 2 Robb. 206.

That mere preponderance of evidence cannot establish anticipations twenty years before, see Smith *v.* Fay (1873), 6 Fisher, 446.

[5] In Stitt *v.* Eastern R. R. Co. (1884), 22 Fed. Rep. 649, Colt, J.: (651) "The primary inquiry is one of identity between

ence before the date of the plaintiff's patent may be produced and compared with the patented invention, with or without the aid of expert evidence.[6] Descriptions of the invention, written or printed, whether in private papers or in prior patents, applications, or other documents in the Patent Office, may be introduced to show its essential characteristics and its correspondence with the patented invention.[7] The testimony of

two things. If the identity can only be known by actual use, such use should be proved. If the identity is apparent on inspection, it is not necessary to prove actual use. If there is a reasonable doubt as to identity, want of novelty is not made out. Walk. Pat. § 72. By the weight of authority and of reason, it would seem that if the prior invention was the same as that described in the patent; if it was complete, and capable of producing the same result, and was known in this country, it is sufficient to sustain the defence of want of novelty."

In Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86, Sprague, J.: (102) "Gentlemen, this is, as I have already mentioned to you, a question of what existed some seventeen years ago. Now, I think it proper to say to you, that where an invention of any useful machine or structure, or improvement in any machine, is shown to have been made, and it is sought to be invalidated by an old machine made years ago, the jury should examine the testimony and the evidence with care and caution, so as to be satisfied that that which is said to have existed was actually and substantially the same. The rule of law is a reasonable one, at all events it is a rule of law, that a party who sets up such an old instrument, that has passed away, has upon him the burden of satisfying the jury upon a preponderance of evidence that it is substantially the same as what has taken place, before they will set aside the patent. If they are so satisfied by the evidence, that it was substantially the same and known before, then it is their duty so to say when considering the patent."

[6] That whether one thing is identical with or the "equivalent" of another is a question of fact on the evidence of experts on an inspection of the inventions, see Foss *v.* Herbert (1856), 2 Fisher, 31; 1 Bissell, 121.

That prior machines are admissible to show that if defendant copies them he does not infringe, or if he does infringe, then the patent is void for prior use, see Whipple *v.* Baldwin Mfg. Co. (1858), 4 Fisher, 29.

That in attacking novelty specimens of the anticipating invention itself should be offered, not specimens since made from the descriptions given by those who saw the old, see Theberath *v.* Rubber & Celluloid Harness Trimming Co. (1883), 15 Fed. Rep. 246; 23 O. G. 1121.

That prior use is proved if a sample of the article used is produced and verified by several witnesses whose character for truth is not impeached, see Miller *v.* Foree (1885), 116 U. S. 22; 33 O. G. 1496.

[7] That an application which fully describes an invention is conclusive evidence that the invention was made before the application was filed, see Kearney *v.* Lehigh Valley R. R. Co. (1887), 32 Fed. Rep. 320.

That the record of a rejected application to the Patent Office with its specification, models, etc., is admissible to establish prior invention, in connection with other proof that a working machine

persons who saw the article, or observed the practice of the art, may also be received for the same purpose. Of these three forms of evidence, that of existing specimens is, of course, the most reliable; and when they do exist, and are under the control of the defendant, his failure to present them raises a strong presumption against their identity with the article protected by the plaintiff's patent.[8] The evidence of witnesses who speak from personal recollection only is of comparatively little value, its weight being diminished in proportion to the remoteness of their observation, and the intricacy of the invention which they endeavor to recall.[9] To merit any consideration it must be positive and specific, not conjectural and indefinite.[10] Identity cannot be inferred from

embodying the invention was made, and that successful experiments with it were performed in public, see Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co. (1874), 6 O. G. 34; 10 Phila. 227; 1 Bann. & A. 177.

That a prior application without evidence of reduction to practice cannot show prior use, see Adams *v.* Howard (1884), 26 O. G. 825; 19 Fed. Rep. 317.

[8] That machines as shown by their models are evidence of the highest class, see Morris *v.* Barrett (1859), 1 Fisher, 461; 1 Bond, 254.

That doubtful evidence as to prior use becomes still more doubtful if the defendant fails to produce specimens of the devices used, see Chase *v.* Wesson (1873), 6 Fisher, 517; 4 O. G. 476; Holmes, 274.

That if the defendant has possession of an alleged prior article and does not produce it, the presumption will be strong against him, see Bailey Washing & Wringing Mach. Co. *v.* Lincoln (1871), 4 Fisher, 379.

[9] That evidence concerning anticipation must be weighed in view of the lapse of time since the alleged prior use, see Yale Lock Mfg. Co. *v.* Berkshire Nat. Bank (1885), 26 Fed. Rep. 104.

That recollections, after many years, of devices, none of which are produced in court, are not reliable testimony, see Adams & Westlake Mfg. Co. *v.* Rathbone (1886), 26 Fed. Rep. 262.

That the memory of a witness as to an article he saw twenty-one years before is not very reliable, see Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64.

That the patent will not be set aside on the testimony of a single witness that many years ago he saw an article like the one claimed, see La Baw *v.* Hawkins (1874), 6 O. G. 724; 1 Bann. & A. 428.

That the unreliability of the memory as to dates, the delay of an alleged prior inventor in utilizing or patenting the invention, &c., tend to prevent the evidence from removing reasonable doubt, see Osborne *v.* Glazier (1887), 31 Fed. Rep. 402; 40 O. G. 1137.

[10] That indefinite recollections of a use twenty years past, no models being produced, is not sufficient proof of prior use, see Wetherell *v.* Keith (1886), 27 Fed. Rep. 364; 37 O. G. 337.

That testimony of witnesses who say they saw the device in use many years before, but who are contradicted by others, is not sufficient when the de-

the opinion of a witness that the alleged anticipating device might have been altered to become the patented invention, or might have been employed to perform its functions, or that a product then existing might have resulted from a process similar to that claimed by the plaintiff in his patent.[11] Even when positive and specific, such evidence is easily overcome by acts or testimony inconsistent with its truth. The silence of the maker of the prior article, if present in court in the interest of the defendant but not examined on this subject, outweighs the declarations of numerous observers.[12] The oral statement of a patentee that his invention, as originally produced, possessed the characteristic features of the plaintiff's, is negatived by their absence from the description in his patent.[13] The asseveration of a workman that he used the same invention in his employers' business, is contradicted by the fact that at a later period they sought the invention elsewhere.[14] Still,

vices are not produced, see Wetherell *v.* Keith (1886), 27 Fed. Rep. 364; 37 O. G. 337; Washburn & Moen Mfg. Co. *v.* Haish (1880), 19 O. G. 173; 4 Fed. Rep. 900; 10 Bissell, 65; Smith *v.* Fay (1873), 6 Fisher, 446.

[11] That on the issue of novelty evidence as to what might have been done with prior machines, or that these could have been altered into the one patented, is not admissible, see Cook *v.* Ernest (1872), 2 O. G. 89; 5 Fisher, 396; Livingston *v.* Jones (1859), 1 Fisher 521.

That evidence as to what might have been done with prior machines is mere speculation and avails nothing, see Judson *v.* Cope (1860), 1 Fisher, 615; 1 Bond, 327.

That evidence that a witness had seen an article which might have been made by a device like the plaintiff's before his invention, cannot outweigh the patent unless the jury are satisfied that it was made by this device, see Treadwell *v.* Bladen (1827), 4 Wash. 703; 1 Robb, 531.

[12] That the maker of an alleged prior machine is present but is not examined is to be considered in estimating the value of other evidence, see Wood *v.* Cleveland Rolling Mill Co. (1871), 4 Fisher, 550.

[13] That the oral testimony of a patentee that he made the device, when his own patent does not show it, and the device is not produced, is not sufficient, see Woven Wire Mattress Co. *v.* Wire-Web Bed Co. (1881), 8 Fed. Rep. 87.

[14] That a witness swearing to prior use is rendered unreliable by evidence that his employers, after having the benefit of his skill, sought the right elsewhere, see St. Louis Stamping Co. *v.* Quinby (1879), 16 O. G. 135; 4 Bann. & A. 192.

That testimony of prior use is overthrown by evidence that the witnesses accepted and operated under a license from the patentee, see Lockwood *v.* Hooper (1885), 25 Fed. Rep. 910.

That the plaintiff may show that the defendant offered a large sum for the patent, and then took out patents for similar devices, this being inconsistent

with all its necessary infirmities, this species of evidence is admissible and may be sufficient to convince a jury, even without specimens or contemporaneous descriptions, that the prior art or article was identical with the patented invention. Identity being thus established, the defendant must further prove that the art or article in question was used in such a manner as to render the invention accessible to the public at the date of its conception by the plaintiff's inventor. Here, as elsewhere, the date of the inventive act of the plaintiff's inventor is assumed to be that of his patent or his application; and it is sufficient for the defendant to show that the use of the invention was prior to that date, in order to throw upon the plaintiff the burden of proving that his conception of the invention preceded not merely the date of his own application but also that of the use shown by the defendant.[15] However,

with his claim of want of novelty, see Bostock *v.* Goodrich (1884), 21 Fed. Rep. 316; 29 O. G. 278.

That a circular published by a person claiming that the invention was then new outweighs his parol evidence that it had previously existed, see Masury *v.* Tiemann (1871), 4 Fisher, 524; 8 Blatch. 426.

[15] That the date of the plaintiff's patent is *prima facie* the date of his inventive act, see Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1880), 2 Fed. Rep. 774; 17 O. G. 1504; 18 Blatch. 218; 5 Bann. & A. 475.

That the invention claimed in a reissue is presumed to have been made at the date of the original, see House *v.* Young (1867), 3 Fisher, 335.

That if the application accompanies the patent, the date of the application is *prima facie* the date of the inventive act, see Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1880), 17 O. G. 1504; 2 Fed. Rep. 774; 18 Blatch. 218; 5 Bann. & A. 475; Wing *v.* Richardson (1865), 2 Fisher, 535; 2 Clifford, 449.

That on a question of prior use the patent relates back to the date of the original discovery, see Consolidated Bunging Apparatus Co. *v.* Woerle (1887), 29 Fed. Rep. 449; 38 O. G. 1015.

That the date of filing the application cannot be shown by parol but by the records of the Patent Office, see Wayne *v.* Winter (1855), 6 McLean, 344.

That if the defendant shows knowledge or use prior to the application, or patent if the application be not in evidence, the burden shifts to the plaintiff to prove that his inventive act preceded such knowledge or use, see Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1880), 17 O. G. 1504; 18 Blatch. 218; 2 Fed. Rep. 774; 5 Bann. & A. 475; Webster Loom Co. *v.* Higgins (1879), 16 O. G. 675; 4 Bann. & A. 88; 15 Blatch. 446; Hazelip *v.* Richardson (1876), 10 O. G. 747; Jones *v.* Sewall (1873), 6 Fisher, 343; 3 O. G. 630; 3 Clifford, 563; Wing *v.* Richardson (1865), 2 Fisher, 535; 2 Clifford, 449; Union Sugar Refinery *v.* Matthiesson (1865), 2 Fisher, 600; 3 Clifford, 639.

That the burden of proof is on the

as the defendant is not allowed to reproduce his evidence of prior use after the rebuttal of the plaintiff, it is incumbent on him, when making his defence, to exhaust his testimony as to the remoteness of such use, and fix its date as early as his evidence permits.[16] The use of an invention renders it accessible to the public only when the invention is complete and operative, and when it is practically used in such a manner as to disclose its character, construction, and mode of operation to the public.[17] That an invention was complete and operative may be shown by specimens, if any still exist, or by the testimony of witnesses having personal knowledge of its condition. Descriptions, printed or written, sketches and drawings, are not sufficient of themselves to prove that the invention was operative, or was practically used.[18] The evidence of practical use must be derived from witnesses who actually used the invention or had knowledge of its use by others. Such use must have been in public, not in secret, and in the practical application of the invention to industrial purposes.[19]

patentee to show that he made the invention before the date of filing his application, and he must show that it was before that time reduced to practice, see Johnson *v.* Root (1862), 2 Fisher, 291 ; 2 Clifford, 108.

[16] That new evidence for the defendant is not allowed after the plaintiff's rebutter, see Ames *v.* Howard (1833), 1 Sumner, 482 ; 1 Robb, 689.

[17] That prior use is not proved by the existence of a device capable of such use, it must have been practically used, see Piper *v.* Brown (1870), Holmes, 20 ; 4 Fisher, 175 ; Pennock *v.* Dialogue (1825), 4 Wash. 538 ; 1 Robb, 466.

That sufficient prior use must be shown to prove that the device will accomplish what is claimed, see Sayles *v.* Chicago & Northwestern Railway Co. (1871), 4 Fisher, 584 ; 3 Bissell, 52.

[18] That a rejected application is not evidence that the invention was completed or in use, see Howes *v.* McNeal (1878), 15 O. G. 608 ; 15 Blatch. 103 ; 3 Bann. & A. 376 ; Rubber Step Mfg. Co. *v.* Metropolitan R. R. Co. (1878), 13 O. G. 549 ; 3 Bann. & A. 252.

That file-wrappers, &c., are not evidence to show the reduction to practice of inventions claimed to be prior to the one patented, being only hearsay evidence and declarations of third parties, see Howes *v.* McNeal (1880), 4 Fed. Rep. 151 ; 17 O. G. 799 ; 17 Blatch. 396 ; 5 Bann. & A. 77.

That a prior patent does not show a use earlier than the date of the patent, see Howes *v.* McNeal (1880), 17 O. G. 799 ; 17 Blatch. 396 ; 4 Fed. Rep. 151 ; 5 Bann. & A. 77 ; Kelleher *v.* Darling (1878), 4 Clifford, 424 ; 14 O. G. 673 ; 3 Bann. & A. 438.

That a caveat is not conclusive evidence that an invention is not perfected, see Johnson *v.* Root (1858), 1 Fisher, 351.

That catalogues, etc., may be offered to show prior use, see Forschner *v.* Baumgarten (1886), 26 Fed. Rep. 858 ; 35 O. G. 137.

[19] That to overcome the presumption

A single instance of such use being established the defence is complete without proof of continued user, except in cases where the use was so remote that the knowledge thus communicated to the public was extinguished, and the invention had become a lost art, at the date of its conception by the plaintiff's inventor.[20] It has been held that proof of actual use is not essential when the invention in its complete and operative state fully disclosed its character and mode of operation without practical employment, and was known in that condition to the public.[21] This cannot be true of an art, since an art can be perceived only while in process of employment, nor of articles whose qualities are manifested only during their practical application. Other articles, disclosing their essential attributes to mere inspection, if shown to have been subject to public observation, may, however, become known by the public without actual use, and in such cases evidence of knowledge without use may be sufficient. Under all other circumstances actual use must be established. Such use must have occurred in the United States, — a use abroad, though known to persons in this country, not impairing the validity of a domestic patent.[22] Even a foreign use of the invention,

arising from the grant of the patent the evidence must show such prior knowledge as gave the public a right to use the invention, see Crouch *v.* Speer (1874), 6 O. G. 187 ; 1 Bann. & A. 145.

[20] That prior use may be proved though the use has been abandoned, see Shoup *v.* Henrici (1872), 9 O. G. 1162 ; 2 Bann. & A. 249 ; Evans *v.* Hettick (1818), 3 Wash. 408 ; 1 Robb, 166.

That a device was in use twenty-five years ago does not warrant a finding that it is still in operation, see Seymour *v.* McCormick (1856), 19 How. 96.

[21] That both prior knowledge and use need not be proved, for the use may or may not be the sole evidence of identity and knowledge, see Stitt *v.* Eastern R. R. Co. (1884), 22 Fed. Rep. 649.

That evidence of prior use is sufficient if it shows that the invention was complete and capable of working and was known to a number of persons and had been in use, see Judson *v.* Bradford (1878), 16 O. G. 171 ; 3 Bann. & A. 539 ; Coffin *v.* Ogden (1873), 18 Wall. 120 ; 5 O. G. 270.

[22] That evidence of reduction to practice abroad prior to invention in the United States is inadmissible, see Bell *v.* Brooks (1881), 19 O. G. 290.

That evidence of use abroad is not admissible, see Doyle *v.* Spaulding (1884), 27 O. G. 300 ; Schillinger *v.* Greenway Brewing Co. (1883), 24 O. G. 495 ; 21 Blatch. 383 ; 17 Fed. Rep. 244 ; Judson *v.* Cope (1860), 1 Fisher, 615 ; 1 Bond, 327.

That a prior foreign patent is not admissible to prove prior use, see Cornely *v.* Marckwald (1883), 17 Fed. Rep. 83 ; 24 O. G. 498 ; 21 Blatch. 367.

That foreign machines not arriving in

of which the plaintiff's inventor was cognizant when he made oath to his application, does not disprove the legal novelty of the invention, although the fraud and falsehood of the applicant would invalidate the patent.[23] The testimony of witnesses as to the fact of use and the completeness and availability of the invention is not open to the same suspicion as their evidence concerning its identity with the patented invention. The recollection of an honest witness as to the operativeness and actual employment of an art or article, whose existence is conceded or established, may in all ordinary cases be regarded as reliable. But where his statements are inconsistent with the general current of events, or where the use to which he testifies must have been observed, if it occurred, by others who deny all knowledge of such use, his evidence is wanting in the conclusiveness and credibility which it must possess in order to overcome the presumptions arising from the patent, and satisfy that burden of proof which the law throws upon the defendant.[24] The plaintiff in rebutting the defendant's evidence of prior use may attack either the identity or the use of the prior art or article. He may disprove its identity by evidence of the same species as that by which the

this country until after the date of the plaintiff's inventive act, have no bearing on the question of novelty, see Weston Dynamo Electric Mach. Co. *v.* Arnoux (1884), 28 O. G. 285; 20 Fed. Rep. 112.

That the issue of an American patent, in the case of a foreign invention, does not prove an introduction into common use, without other evidence, see Weston *v.* White (1876), 9 O. G. 1196; 13 Blatch. 364; 2 Bann. & A. 321.

[23] That the oath of the patentee, that he believed himself to be the first inventor, is not contradicted by proof of foreign prior use, see Bartholomew *v.* Sawyer (1859), 4 Blatch. 347; 1 Fisher, 516; Furbush *v.* Cook (1857), 2 Fisher, 668.

[24] That the testimony of witnesses as to a reduction to practice is incredible, when the devices themselves will not operate, see American Bell Telephone Co. *v.* People's Telephone Co. (1885), 25 Fed. Rep. 725; 34 O. G. 561.

That the patent is not overcome by the testimony of a single witness that the device was in use twenty years before in a large town, where, if it were so, many must have known it, and when no model or machine is now in existence, and there is no evidence of a general use though the device must have been of great utility, see Blake *v.* Eagle Works Mfg. Co. (1871), 4 Fisher, 591; 3 Bissell, 77.

That the evidence must be very clear in order to show that an old patent on an article well known and constantly used is invalid for a prior use occurring twenty-three years before the prior use was known, see Zane *v.* Peck Bros. (1881), 9 Fed. Rep. 101.

defendant has attempted to affirm it. In addition thereto, he may show the superior utility of either invention to the other as the basis of an inference that differences of such extent in the effect could only proceed from a substantial difference of means.[25] This superior utility may be established by comparing the two inventions, or their practical operation, or their acceptance by the public; the commercial success of one invention and the failure of the other being regarded as an indication of greater usefulness, and consequently of essential differences, in the former.[26] In attacking the alleged use of the invention the plaintiff may endeavor to show either that the invention was not complete and operative, or that it was not practically used in public, or that its use did not anticipate the inventive act of his own inventor. Upon the first point, positive evidence of any kind tending to show that the invention was inoperative and incomplete, until the date of its conception by the inventor from whom he derives it, is admissible. Besides this, he may prove that the prior article or art, after the use referred to by the defendant's witnesses, was abandoned by its inventor as an unsuccessful experiment, and such abandonment may be inferred from the cessation of its use where the invention, if successful, would have been of great utility and would have satisfied a recognized public want.[27] Upon the second point, where he cannot impeach the

[25] That where novelty or *modus operandi* are in question it is proper to show what the effect of the invention is, see Klein *v.* Russell (1873), 19 Wall. 433.

[26] That superior utility shows want of identity, see §§ 116–121, 344, and notes, *ante*.

[27] In Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86, Sprague, J.: (102) "If there were experiments made, gentlemen, and they tend to a certain point, and there is no certainty to what extent they went, then the subsequent conduct of the parties who made experiments, and were interested in it, may aid you in forming an opinion of what they accomplished. If they preserved it as a thing valuable, it has a weight in one direction as showing that they had accomplished something. If they did not preserve it but abandoned it, the evidence is to be weighed whether it was abandoned or not; whether a success has been obtained in anything that was worthy of preservation, or could accomplish a practical and useful purpose; and the weight of this you will probably know is in proportion to the importance of the thing. There may be an invention, gentlemen, of so unimportant a character, that although it be really an invention, something of practical use, it may be in relation to a subject-matter of so little importance, or of transient interest, that the occa-

testimony of the witnesses who claim to have used the invention or to have knowledge of its use, he may attempt to prove that the invention became a lost art, and passed from the knowledge of the public, and that it was discovered and again bestowed upon them by his own inventor.[28] The negative evidence of witnesses, who would have been acquainted with the invention if it had been practically used and known, is here of great importance, and may be offered to contradict the fact of use, as well as its continuance and publicity, and the accessibility of the invention to the public at the date of its conception by the inventor named in the patent.[29] Upon the third point, it is only necessary for the plaintiff to carry back the date of the inventive act of his inventor to a period anterior to the earliest practical use in public which has been already proved by the defendant. If such use did not precede the filing of the application for a patent, a certified copy of the application from the Patent Office with the date of its reception is sufficient. If the use occurred before the application, evidence of the earlier conception of the invention may be offered, consisting either of specimens made or descriptions framed before the alleged use, or of the testimony of witnesses

sion may pass by and it may be laid aside and never used afterward, because there was no occasion for it. . . . On the other hand, if the invention be of something which can be of great practical importance, an enduring importance, then you will consider how much stronger will be the incentive to success in perfecting that which would have been of importance; and the greater the importance of the invention, the less probable that if achieved it would have been laid aside and not extended itself to others interested in its use."

[28] That the existence of an invention which became a lost art before the inventive act of the patentee does not show prior use, see §§ 321–324, and notes, *ante*.

[29] That negative evidence is important, such as non-attack upon patent, non-publication in books, etc., non-acquaintance of those skilled in the art, etc., see Parker *v.* Hulme (1842), 1 Fisher, 44.

That the evidence of a witness that at a particular time the plaintiff made a device which the witness never before saw or heard of is admissible, see Pennock *v.* Dialogue (1825), 4 Wash. 538; 1 Robb, 466.

That silence raises a stronger presumption than the evidence of witnesses, see Smith *v.* Fay (1873), 6 Fisher, 446.

That intangible presumptions must yield to positive proof, see Bliss *v.* Merrill (1837), 42 O. G. 97.

That positive evidence of witnesses as to the existence of prior devices must outweigh merely negative proof, see Sayles *v.* Chicago & Northwestern Railway Co. (1871), 4 Fisher, 584; 3 Bissell, 52.

who, prior to such use, saw the invention which he had produced, or in some other way derived from him a knowledge of its essential characteristics.[30] The burden of proof, on this point, shifts to the plaintiff when the defendant proves a use anterior to the date of the application, especially where the existence of the invention is evidenced by a patent issued before the patent of the plaintiff. With this exception, the burden on the entire issue of prior use rests upon the defendant, and though when proved it is destructive to the patent, yet if his testimony falls short of removing every reasonable doubt, and leaves a mere preponderance in his favor, the *prima facie* evidence of the patent is not overcome and the novelty of the invention remains unimpeached.[31] This issue of prior use may be raised by the defendant in reference to several distinct inventions, each of which he claims as an anticipation of the one covered by the plaintiff's patent. In such a case each stands alone as to the questions of identity and actual use, and must not only be separately considered by the jury but also distinguished in their verdict, unless the issue is found alike on all in favor of the plaintiff.[32] The same

[30] In Philadelphia & Trenton R. R. Co. *v.* Stimpson (1840), 14 Peters, 448, Story, J.: (462) "The conversations and declarations of a patentee, merely affirming that at some former period he invented that particular machine, might well be objected to. But his conversations and declarations, stating that he had made an invention, and describing its details and explaining its operations, are properly to be deemed an assertion of his right, at that time, as an inventor to the extent of the facts and details which he then makes known; although not their existence at an antecedent time." 2 Robb, 46 (69).

That the plaintiff in rebutting the evidence attacking the novelty of his invention, may show the date of his inventive act by sketches and drawings, see Kneeland *v.* Sheriff (1880), 18 O. G. 242; 2 Fed. Rep. 901; 5 Bann. & A. 482; Draper *v.* Potomska Mills Co. (1878), 13 O. G. 276; 3 Bann. & A. 214; Reeves *v.* Keystone Bridge Co. (1872), 1 O. G. 466; 5 Fisher, 456; 9 Phila. 368.

That the plaintiff may show that alleged prior users subsequently became his licensees, see Evans *v.* Eaton (1818), 3 Wheaton, 454; 1 Robb, 243.

That the former testimony of the plaintiff that he had invented does not constitute invention, see Pennsylvania Diamond Drill Co. *v.* Simpson (1886), 37 O. G. 218; 29 Fed. Rep. 288.

[31] That the court will presume against prior knowledge or use in case of doubt, see note 4, *ante*.

That when the defendant's evidence is fully up to the standard, the novelty is successfully impugned, see Doubleday *v.* Beatty (1882), 11 Fed. Rep. 729; 22 O. G. 859.

[32] That where several prior inventions are offered to defeat a patent each

rule applies where several prior patents or publications are set up by the defendant.

§ 1027. Evidence under the Fifth Defence: Novelty of the Patented Invention: Prior Patent.

When the defendant denies the novelty of the invention on the ground of a prior patent, two questions, similar to those involved in the defence of prior use, also arise: (1) Whether the invention described and claimed in the plaintiff's patent is identical with or included in the invention described and claimed by the alleged prior patent; (2) Whether the prior patent was duly issued before the conception of the invention by the plaintiff's inventor. The plaintiff's patent is *prima facie* evidence that the invention described and claimed therein is essentially distinct from all inventions covered by preceding patents.[1] The defendant must, therefore, affirmatively prove that the prior patent embraced the invention of the plaintiff. His evidence on this point is the prior patent itself, construed by the court in connection with the plaintiff's patent.[2] Other testimony is unnecessary on either side, unless the court de-

stands alone as to evidence and verdict, and the jury must agree on each separately, and if they find for the defendant on one of them they must agree on that one, see Waterman *v.* Thomson (1863), 2 Fisher, 461.

That when a patent claims three inventions the plaintiff must prove a right to each, see Heinrich *v.* Luther (1855), 6 McLean, 345.

§ 1027. [1] That the grant of a patent is a decision by the Commissioner that the invention is not covered by prior patents, see Putnam *v.* Keystone Bottle-Stopper Co. (1889), 38 Fed. Rep. 234; Serrell *v.* Collins (1857), 1 Fisher, 289.

That the patent is *prima facie* evidence that the thing patented differs from every other patented invention and from anything described in any specification of any patent, see Poppenhusen *v.* N. Y. Gutta-Percha Comb Co. (1858), 2 Fisher, 62.

That a patent for a later machine is strong *prima facie* evidence of its essential difference from an earlier patented machine, especially if the later patent has been re-issued and extended, see La Baw *v.* Hawkins (1874), 6 O. G. 724; 1 Bann. & A. 428.

[2] That a defendant may offer in evidence his own patent, see Corning *v.* Burden (1853), 15 How. 252.

That the defendant's patent *is prima facie* proof of the novelty and utility of his invention, see Worswick Mfg. Co. *v.* City of Kansas (1889), 38 Fed. Rep. 239.

That a defendant who infringes both the patent for the original and that for the improvement, cannot set up the former patent as anticipating the latter, see Cantrell *v.* Wallick (1886), 117 U. S. 689; 35 O. G. 871.

sires the aid of experts in explaining and comparing the claims and descriptions of the patents.[3] Upon the second question the defendant also has the burden of proof. To satisfy it he must show that the alleged prior patent is a public document, that it was made accessible to the public before the conception of the invention by the plaintiff's inventor, and that its description of the invention is sufficiently precise and complete to enable persons skilled in the art to practise it without the exercise of their own inventive faculties.[4] Whether or not a prior patent is a public document depends upon the provisions of the law under which it issues. A patent granted by the United States is always of that character, but in some foreign countries patents are public or secret as the government in each case may determine. It is incumbent on the defendant to show that the patent which he offers as anticipating that of the plaintiff is a public patent according to the law of the place in which it has been granted.[5] He must also prove that it was issued to the public before the date of the inventive act under which the plaintiff claims. The date of the prior patent is regarded as the earliest date at which it could have been given to the public, and evidence of its preceding publication or existence is inadmissible.[6] The date of

[3] That the prior patent is to be submitted to the jury with the evidence of experts as to identity, see Tucker *v.* Spalding (1871), 13 Wall. 453; 1 O. G. 144; 5 Fisher, 297.

[4] For the requisites of a prior patent, see §§ 331–337, and notes, *ante*.

That the defence of prior patent is not established where the original prior patent did not cover the invention, and has been re-issued to embrace it since the date of the patent in dispute, see Vogler *v.* Semple (1877), 11 O. G. 923; 7 Bissell, 382; 2 Bann. & A. 556.

[5] That French patents, being some private, some public, the defendant must show which they are, see Brooks *v.* Norcross (1857), 2 Fisher, 661.

That although some French patents are secret, yet one verified after the manner of public records is to be regarded as a public one, see Schoerken *v.* Swift & Courtney & Beecher Mfg. Co. (1881), 19 O. G. 1493; 7 Fed. Rep. 469; 19 Blatch. 209.

That copies of specifications and drawings without the patent do not show that an invention was patented, see Brooks *v.* Norcross (1851), 2 Fisher, 661.

[6] That patents cited as anticipating the plaintiff's invention are regarded only as public grants, and nothing from the Patent Office is admissible to show an earlier date than that of the patent, see Howes *v.* McNeal (1880), 17 O. G. 799; 17 Blatch. 396; 4 Fed. Rep. 151; 5 Bann. & A. 77; Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337.

That a patent issued upon an application filed before the date of a conflicting patent is presumed to have priority

the patent itself is not, however, evidence that it then became accessible to the public. Under our own system, the issue of the patent and its publication are substantially contemporaneous, but under other systems the grant of the monopoly may be awarded before the full disclosure of the invention to the public is required. In such cases the patent takes effect as a prior and anticipating patent only at the time when its completed specification is filed and published, and the defendant must, therefore, fix by his evidence the date of this disclosure as the date from which his prior patent operates against all subsequent inventors.[7] Such proof is generally furnished by the certified copies of the specifications and drawings of the patent, which are by statute made *prima facie* evidence of the existence of the patent and of its date and contents.[8] Where these are unobtainable, the date of publication may be proved by any other competent and accessible testimony. If the date thus fixed by the defendant as that of the publication of the alleged prior patent is anterior to the date of the plaintiff's patent, it becomes the duty of the plaintiff to prove that the invention was conceived by his inventor before the prior patent had been given to the public.[9] His evidence upon this

unless the contrary appears, see Kearney *v.* Lehigh Valley R. R. Co. (1887), 32 Fed. Rep. 320.

That file-wrappers, contents, and drawings of a patent set up in defence do not show that the invention was made at the date of the oath or was then reduced to practice, see Howes *v.* McNeal (1880), 17 O. G. 799; 17 Blatch. 396; 4 Fed. Rep. 151; 5 Bann. & A. 77.

[7] That under Sec. 4920, Rev. Stat., an English patent is not issued until a complete specification is filed, see Coburn *v.* Schroeder (1882), 22 O. G. 419; 11 Fed. Rep. 425; 20 Blatch. 392.

That an English patent is effective as an anticipation only from the date of its sealing, see Bliss *v.* Merrill (1887), 42 O. G. 97.

That an earlier English provisional specification may show the state of the art and thus negative invention, see McNab & Harlem Mfg. Co. *v.* Nathan Mfg. Co. (1887), 40 O. G. 1240; 32 Fed. Rep. 155.

[8] That copies of domestic or foreign patents from the Patent Office, duly authenticated, are sufficient evidence of their issue and date, see §§ 1015, 1016, and notes, *ante*.

[9] That the defence of prior patent is sustained when the date of the patent is earlier than that of the patent in suit, and the plaintiff must then carry his date back beyond it by the application or by some other evidence, see Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

That a prior patent is held prior if its date is prior to the one in suit, unless the latter is accompanied by its application, or the parol proof shows that its patentee invented before the

point is the same as that required whenever the date of an inventive act is to be ascertained. In proving that the prior patent disclosed the invention with sufficient completeness and precision to enable any person skilled in the art to practise it, the defendant must rely upon the testimony of persons who have actually constructed and used it under the guidance of the prior patent, or on that of experts and practical workmen that the invention could be practised, from the descriptions and directions in the patent, by skilled artisans without the exercise of their own inventive powers. To this evidence the plaintiff may reply with testimony of the same character, and the credibility and weight to be attached to the antagonistic proof must be determined by the jury from their own general acquaintance with the subject and from the apparent ability and integrity of the witnesses produced.[10] In case of doubt the plaintiff must prevail.

§ 1028. Evidence under the Fifth Defence: Novelty of the Patented Invention: Prior Publication.

A denial of the novelty of the patented invention on the ground of a prior publication also embraces two questions: (1) Whether the invention patented is identical with or included in the one described in the alleged publication; (2) Whether the alleged publication constitutes such a disclosure of the invention to the public as is by law made fatal to the patent. The burden of proof on both points rests on the defendant after the patent of the plaintiff has been introduced. The identity of the two inventions may be shown by comparing the descriptions, with or without the aid of experts, or by the examination of specimens proved to have been made

date of the rival patent, see Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337.

That the defendant may offer his own re-issue of a patent earlier than the plaintiff's, and if the evidence rests there, he will prevail, see House *v.* Young (1867), 3 Fisher, 335.

That the patentee may prove that he invented and reduced to practice before the date of a foreign patent which was granted before he filed his application, see White *v.* Allen (1863), 2 Fisher, 440; 2 Clifford, 224.

[10] That if a foreign patent is offered to anticipate the plaintiff's patent he may show that the device therein described is inoperative and worthless, see Harwood *v.* Mill River Woollen Mfg. Co. (1869), 3 Fisher, 526.

under the sole direction of the publication and without a knowledge of the invention of the plaintiff. Counter-evidence of the same class may be offered for the plaintiff in rebuttal. The legal sufficiency of the publication to invalidate the plaintiff's patent depends on its possession of the following requisites: (1) It must be in its nature a public work; (2) It must describe the invention in such a manner that any person skilled in the art can practise it without further directions; (3) It must have been made accessible to the public before the conception of the invention by the plaintiff's inventor.[1] That the publication is a public work may appear from its general contents, from the source whence it proceeds, or from the persons for whom it is evidently intended. The printing of a book or document for unrestricted circulation, or for the use of all who may require it, or for any extensive class of persons, is sufficient to give the work the necessary public character.[2] These facts may be established by an inspection of the work itself, or may be proved by any witness acquainted with its origin and purpose. That the description renders the invention clear to competent workmen, and enables them to practise it, is shown or contradicted by the testimony of experts and practical mechanics, and of those artisans who have succeeded or failed in their endeavors to construct or use it in obedience to the directions given. To prove that the printed book or document has been made accessible to the public, evidence of actual presentation to the public, in some form, must be offered. If the work has been placed in a public library and duly catalogued, or otherwise brought within the reach of those who may be interested in its contents, or if it has been publicly exposed for sale, or gratuitously distributed to the community, or lodged in some governmental office where it may be consulted or copies of its statements may be obtained on application, it is regarded as communicating to the public

§ 1028. [1] For the general requisites of a prior publication, see §§ 325–330 and notes, *ante*.

[2] That a report to a hose company describing the invention is not a public work and cannot be read by the defendant, see Pennock *v.* Dialogue (1825), 4 Wash. 538; 1 Robb, 466.

That catalogues, etc., may be admitted as prior publications if notice of them as such has been given, see Forschner *v.* Baumgarten (1886), 26 Fed. Rep. 858; 35 O. G. 187.

whatever information it contains.[3] Either or all of these acts, and others of a similar character, may be proved by the defendant by any testimony, oral or written, that may be available. This evidence must also show that the act of publication occurred before the date of the conception of the invention by the plaintiff's inventor. The latter date is *prima facie* that of the plaintiff's patent or his application, but inasmuch as in rebuttal he may anticipate that date by the usual evidence of an earlier inventive act, the defendant must establish for the act of publication a date anterior to any which the plaintiff can maintain, or the issue will eventually be found against him.[4] For the purpose of fixing the date of publication, the imprint of the work is not sufficient.[5] Extraneous evidence showing the fact of presentation to the public on or before a given day is necessary, there being no presumption that a book or document was placed in circulation at or near the period mentioned in its pages. Much of the testimony on the several points involved in this defence of prior publication is ordinarily derived from the printed book or document itself, which is produced in court and submitted to the examination of the witnesses and jury. Where the defendant is unable to obtain a copy for production, and satisfactorily accounts for its absence, he is permitted to prove by parol not only the

[3] See as to the fact of publication § 327 and notes, *ante*.

That the evidence of the prior publication is proof of the fact of publication only, see Seymour *v.* McCormick (1856), 19 How. 96.

That under Sec. 61, act of 1870, a defence of previous publication by an English provisional specification must be clearly proved, see Cohn *v.* United States Corset Co. (1874), 6 O. G. 259; 12 Blatch. 225; 1 Bann. & A. 340.

[4] That if a complete description was published before the date of the patent in controversy, the defendant has sustained his defence until the plaintiff proves that his own inventive act was earlier, see Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

[5] In Reeves *v.* Keystone Bridge Co. (1872), 1 O. G. 466, McKennan, J.: (471) "It is not shown that the work was published before the date of the complainant's patent. This must be directly proved. It is not deducible from the imprint on the title-page. That the work was then printed may be inferred from this imprint; but when it was put in circulation or offered to the public is a distinct fact, which must be proved independently. The intended circulation of a book of a public nature may be presumed from its being put into print; but it does not follow that a work such as the one in question was made accessible to the public as soon as it was printed, or that it was actually published at all." 9 Phila. 368 (374); 5 Fisher, 456 (467).

fact and date of publication, but the contents of the work in reference to the invention.[6] Such evidence is, however, always subject to serious infirmities arising from faulty recollection and unintentional misstatement, and is entitled to slight consideration when opposed by other testimony.

§ 1029. Evidence under the Sixth Defence: Utility of the Patented Invention.

The sixth defence denies the utility of the patented invention. The patent is *prima facie* evidence in favor of the plaintiff on this issue, and the defendant must therefore prove the uselessness of the invention beyond reasonable doubt.[1] The testimony ordinarily available for this purpose is that of experts whose inspection of the invention has satisfied them of its inutility, and that of practical mechanics who

[6] That the date and contents of a publication may, in some extreme cases, be shown by parol, see Allen *v.* Hunter (1855), 6 McLean, 303.

§ 1029. [1] That the patent is *prima facie* evidence of utility, see Kirk *v.* Du Bois (1887), 33 Fed. Rep. 252; Deane *v.* Hodge (1886), 35 Minn. 146; Lehnbeuter *v.* Holthaus (1881), 105 U. S. 94; 21 O. G. 1783; Corvallis Fruit Co. *v.* Curran (1881), 8 Fed. Rep. 150; 7 Sawyer, 270; Thomas *v.* Shoe Mach. Mfg. Co. (1878), 16 O. G. 541; 3 Bann. & A. 557; Miller & Peters Mfg. Co. *v.* Du Brul (1877), 12 O. G. 351; 2 Bann. & A. 618; Smith *v.* Woodruff (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; Whitney *v.* Mowry (1867), 3 Fisher, 157; 2 Bond, 45; Blanchard *v.* Puttman (1867), 3 Fisher, 186; 2 Bond, 84; Swift *v.* Whisen (1867), 3 Fisher, 343; 2 Bond, 115; Bell *v.* Daniels (1858), 1 Fisher, 372; 1 Bond, 212; Poppenhusen *v.* N. Y. Gutta Percha Comb Co. (1858), 2 Fisher, 62; Ransom *v.* Mayor of N. Y. (1856), 1 Fisher, 252; Parker *v.* Stiles (1849), 5 McLean, 44.

That the patent is *prima facie* evidence of utility although the invention be very simple and not the best mode of effecting the result, see Bell *v.* Daniels (1858), 1 Fisher, 372; 1 Bond, 212.

That courts do not usually reverse the decision of the Patent Office that an invention is useful, however slight the utility, see Doherty *v.* Haynes (1874), 6 O. G. 118; 4 Clifford, 291; 1 Bann. & A. 289.

That a patent, whether an original or a re-issue, is *prima facie* evidence that the invention is useful, see Serrell *v.* Collins (1857), 1 Fisher, 289.

That the patent is only *prima facie* evidence of utility, see Green *v.* Stuart (1874), 7 Baxter (Tenn.), 418.

That the patent being in evidence the burden of proof rests on the defendant to show want of utility, see Vance *v.* Campbell (1859), 1 Fisher, 483; Parker *v.* Stiles (1844), 5 McLean, 44.

That the defence of want of utility can prevail only when there is no reasonable doubt, see Kearney *v.* Lehigh Valley R. R. Co. (1887), 32 Fed. Rep. 320; Whitney *v.* Mowry (1867), 2 Bond, 45; 3 Fisher, 157; Tilghman *v.* Werk (1862), 1 Bond, 511; 2 Fisher, 229.

have attempted to employ it and have found it worthless. If this testimony demonstrates that the invention is either mischievous or frivolous, the defence will be sustained.[2] The plaintiff may rebut the evidence of the defendant by introducing experts who have formed opposite opinions, and practical mechanics who have had a contrary experience. He may prove its extensive use, its general effect upon the state of the art, or its commercial success, from either of which facts its utility may be inferred.[3] The very contest of the parties over the invention affords some indication of its value.[4] A defendant who is shown to have actually used the invention, whether wrongfully or under a license from the patentee, or who has obtained a patent covering substantially the same art or article, is estopped from denying its utility.[5]

[2] As to utility in general, see §§ 338–344, and notes, *ante*.

As to want of utility as a defence, see § 964, and notes, *ante*.

[3] That the effect of the invention may indicate its utility, see Klein *v.* Russell (1873), 19 Wall. 433.

That success and practical results are evidence of utility, see Judson *v.* Moore (1860), 1 Fisher, 544; 1 Bond, 285.

That utility is shown by extensive use, see Turrill *v.* Spaeth (1878), 3 Bann. & A. 458; 14 O. G. 377; Adams *v.* Edwards (1848), 1 Fisher, 1.

[4] That the very contest of the parties over the patent is some evidence of utility, see Middletown Tool Co. *v.* Judd (1867), 3 Fisher, 141.

[5] That a defendant who has used the invention cannot deny its utility, see La Rue *v.* Western Electric Co. (1887), 31 Fed. Rep. 80; 40 O. G. 576; Newbury *v.* Fowler (1886), 28 Fed. Rep. 454; 36 O. G. 817; Palmer *v.* United States (1884), 19 Ct. of Claims, 669; Bliss *v.* City of Brooklyn (1871), 8 Blatch. 533; 4 Fisher, 596; Lee *v.* Blandy (1860), 2 Fisher, 89; 1 Bond, 361; Haya *v.* Sulsor (1859), 1 Bond, 279; 1 Fisher, 532; Simpson *v.* Mad River R. R. Co. (1855), 6 McLean, 603; Wash. 9; 1 Robb, 303.

That use by defendant is strong evidence of utility, see Kearney *v.* Lehigh Valley R. R. Co. (1887), 32 Fed. Rep. 320; Adams & Westlake Mfg. Co. *v.* Rathbone (1886), 26 Fed. Rep. 262; Niles Tool Works *v.* Betts Mach. Co. (1886), 27 Fed. Rep. 301; Phillips *v.* Carroll (1885), 23 Fed. Rep. 249; 31 O. G. 265; Hancock Inspirator Co. *v.* Jenks (1884), 21 Fed. Rep. 911; Foye *v.* Nichols (1882), 8 Sawyer, 201; 22 O. G. 2243; 13 Fed. Rep. 125; Tyler *v.* Crane (1880), 7 Fed. Rep. 775; 19 O. G. 129; Smith *v.* Glendale Elastic Fabrics Co. (1874), Holmes, 340; 5 O. G. 429; 1 Bann. & A. 58; Turrill *v.* Illinois Central R. R. Co. (1867), 3 Fisher, 330; 3 Bissell, 66; Mabie *v.* Haskell (1865), 2 Clifford, 507.

That every doubt as to utility is resolved against a defendant who used the invention, see Phillips *v.* Carroll (1885), 31 O. G. 265; Whitney *v.* Mowry (1870), 4 Fisher, 207.

That a former license to the defendant to use the invention is evidence of its utility, see Lee *v.* Blandy (1860), 2 Fisher, 89; 1 Bond, 361.

That features claimed to be useful in

§ 1030. Evidence under the Seventh Defence: Abandonment of the Patented Invention to the Public.

The seventh defence asserts that the invention was abandoned and passed into the possession of the public before the date of the infringement. An invention may be abandoned either before the application for a patent, or by or during the pendency of the application, or after the patent has been granted. The patent itself is *prima facie* evidence that there has been no abandonment at any time, and the defendant must overcome this evidence by conclusive proof of dedication to the public.[1] No abandonment can take place unless the invention is complete and operative, and available for immediate public use. The certainty and weight of evidence required to prove abandonment varies according to the period at which it is alleged to have occurred, — the presumption against it being stronger after than before the application, and strongest after the issue of the patent.[2] Abandonment before the application may be shown by evidence of any acts or declarations of the inventor, manifesting an intention to abandon. His mere omission to practise the invention or to make application for a patent is not sufficient;[3] but proof

the defendant's machine must be useful also in the plaintiff's, see Foye *v.* Nichols (1882), 22 O. G. 2243; 13 Fed. Rep. 125; 8 Sawyer, 201.

§ 1030. [1] As to abandonment as a defence, see § 965 and notes, *ante*.

That the patent is *prima facie* evidence that there has been no abandonment by public use or otherwise, see United States Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 11 O. G. 373; 14 Blatch. 94; 2 Bann. & A. 493; Brown *v.* Whittemore (1872), 5 Fisher, 524; 2 O. G. 248; Johnsen *v.* Fassman (1872), 5 Fisher, 471; 2 O. G. 94; 1 Woods, 138.

That the burden of proof rests on the defendant to shew that the invention was in public use or on sale two years before the application, see American Hide & Leather Splitting & Dressing Mach. Co. *v.* American Tool & Machine Co. (1870), 4 Fisher, 284; Holmes, 503; Hussey *v.* Bradley (1863), 2 Fisher, 362; 5 Blatch. 134; Knight *v.* Baltimore & Ohio R. R. Co. (1840), Taney, 106; 3 Fisher, 1.

That the evidence of abandonment must be conclusive, see Pitts *v.* Hall (1851) 2 Blatch. 229; McCormick *v.* Seymour (1851), 2 Blatch. 240.

[2] That evidence that the plaintiff has abandoned his patent is admissible, see Wayne *v.* Holmes (1856), 2 Fisher, 20; 1 Bond, 27.

That the evidence of abandonment after patent must be very strong, see Bell *v.* Daniels (1858), 1 Fisher, 372; 1 Bond, 212.

[3] The present condition of the authorities renders this doctrine doubtful, however strongly it may have been asserted in past decisions. See §§ 357, 388–390, and notes, *ante*.

that he has voluntarily destroyed the finished article without intending to rebuild it, or that he has distributed it to others asserting that no effort would be made to patent it, or has permitted its universal public use without objection or the expression of his intention to protect his rights, will, if uncontradicted, justify the jury in finding this issue for the defendant.[4] In replying to this evidence the plaintiff may offer testimony contradicting the statements of the defendant's witnesses, or showing other acts and declarations of the inventor from which a contrary intention is to be inferred. The filing of the application for the patent proves irrefutably that the inventor did not then intend to abandon, and is of greater weight than any doubtful acts of prior dedication.[5] Declarations of the inventor that it was not his purpose to forego his rights cannot, however, overcome those inferences concerning his intention which necessarily arise from his admitted conduct.[6] Abandonment before the application may be also shown by evidence of any public use or sale of the invention, with the acquiescence of the inventor, more than two years before the application was filed. The proof of a single instance of such sale or use conclusively establishes abandonment and invalidates the patent. The evidence on this point must disclose a practical use for business purposes, either by the public or subject to their observation, or a sale

[4] That the abandonment of an unpatented invention may be shown by its being broken up without intent to reconstruct it, see Johnson *v.* Root (1862), 2 Clifford, 108 ; 2 Fisher, 291.

That a machine was abandoned shows it to have been an unsuccessful experiment, see Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86. See also §§ 318, 351, and notes, *ante*.

[5] That the filing of an application is conclusive evidence that the inventor did not then intend to abandon the invention, but does not prove the want of subsequent intention, see United States Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 11 O. G. 373 ; 14 Blatch. 94 ; 2 Bann. & A. 493.

That to rebut a claim of abandonment the plaintiff may show the filing of drawings or any other act in assertion of his rights, see Emerson *v.* Hogg (1845), 2 Blatch. 1.

[6] That where the acts of the inventor show abandonment, his statement that he did not intend to abandon is of little weight, see Bevin *v.* East Hampton Bell Co. (1871), 5 Fisher, 23 ; 9 Blatch. 50.

That a mere averment in the bill alleging non-abandonment does not avail against facts showing it, see Marsh *v.* Sayles (1872), 5 Fisher, 610 ; 2 O. G. 340.

untrammelled by conditions which still retain the invention under the control of the inventor. This evidence may be produced by witnesses who participated in or had knowledge of the transactions to which it relates.[7] The acquiescence of the inventor in such use or sale may be inferred from words or actions indicating his intelligent consent, or from his failure when acquainted with such use or sale to protest or seek the interference of the Patent Office or the courts for his protection.[8] Tortious uses and sales without his knowledge, and uses or sales under the authority of unknown rival inventors, even though these have obtained patents, are not proof of abandonment by him.[9] The plaintiff may rebut the evidence of public use or sale by testimony which denies the fact of use or sale, or shows the use to have been experimental or in secret, or the sale to have been conditional, or either use or sale to have been without the inventor's knowledge. An abandonment by application may consist in a specific disclaimer of the invention, or in describing but omitting to insert it in the Claim.[10] The first form of abandonment is proved by a certified copy of the application in which the disclaimer is contained. This evidence is usually conclusive on the plaintiff, though where no rival claimant exists, and the disclaimer was inserted by mistake and was corrected within reasonable time after the discovery of the error, or reasonable time for its correction has not yet elapsed, the plaintiff may be properly allowed to show the truth, and either escape the conse-

[7] As to public use or sale and their requisites, see §§ 354–360, and notes, *ante*.

That under the defence of public use the defendant must show two years' sale or use before the application with the consent of the inventor, see Jones *v.* Sewall (1873), 6 Fisher, 343; 3 O. G. 630; 3 Clifford, 563.

[8] That the evidence of abandonment by public use or sale must be clear and conclusive, see Campbell *v.* James (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

That where a two years' public use is proved the burden is on the plaintiff to show that it was experimental, see Smith & Griggs Mfg. Co. *v.* Sprague (1887), 123 U. S. 249; 41 O. G. 1037.

[9] That tortious uses or sales are piracies and no public use grows out of them, see Jones *v.* Sewall (1873), 6 Fisher, 343; 3 O. G. 630; 3 Clifford, 563; see also § 357 and notes, *ante*.

[10] As to abandonment by application, see §§ 352, 506, 690–692, and notes, *ante*.

That abandonment may be shown by the absence of the invention from the model or caveat, see Johnson *v.* Root (1862), 2 Clifford, 108; 2 Fisher, 291.

quences of his former inadvertence or secure an opportunity for the amendment of his patent.[11] The omission to claim an invention which is fully disclosed in the description is regarded as conclusively establishing a dedication to the public, unless the omitted invention is embraced in a new application, or in an amendment of the former specification, within a reasonable time.[12] The evidence in reference to this form of abandonment must be adapted to the circumstances under which the issue has arisen. When the suit is based on the original patent, in which the description and Claim of the application are now embodied, their construction by the court simply shows that the omitted invention is not covered by the patent, and leaves no room for any question of fact or issue of abandonment. If the suit is based on a re-issue in which the original defect has been supplied, the issue arises, not under the defence of abandonment, but on the validity of the re-issue under the ninth defence. Thus this form of abandonment seems to be available as a subdivision of the present seventh defence only in an action founded on a new patent containing matter described, but not claimed, in a former patent to the same inventor. This new patent, though otherwise impregnable, is invalid on the ground of abandonment, if the invention which it covers was disclosed to the public but not claimed by the inventor in the application for the former patent, and his application for the new patent has been unreasonably delayed. In proving such abandonment, the former patent, or a certified copy thereof, may be offered by the defendant to exhibit the variance between its Claim and

[11] That a mistaken disclaimer is not conclusive when there are no private adverse interests, see Hussey *v.* Bradley (1863), 2 Fisher, 362; 5 Blatch. 134. See also § 689, and notes, *ante*.

That a description of the invention in a prior patent to the same inventor is no bar to a patent and does not show abandonment, see Vulcanite Paving Co. *v.* American Artificial Stone Pavement Co. (1887), 42 O. G. 828.

That a re-issue, unless fraudulent, is *prima facie* evidence that there has been no abandonment, and that all necessary prerequisites were complied with, see Hoffheins *v.* Brandt (1867), 3 Fisher, 218.

[12] That omission to claim a fully described invention is abandonment unless the error be at once corrected, see Parker & Whipple Co. *v.* Yale Lock Co. (1887), 123 U. S. 87; 41 O. G. 811; Wollensak *v.* Reiher (1885), 115 U. S. 96; 31 O. G. 1301. See also § 690, and notes, *ante*.

its description. If this discrepancy is not apparent on the face of the patent, the record of a judicial interpretation, if it has received one, may be introduced, or any evidence concerning the state of the art or the nature of the invention, which tends to show that the inventor must have known of the divergence between his description and his Claim.[13] His unreasonable delay in securing a new patent, after such knowledge was acquired, may appear from evidence of his ability and opportunity to do so at a period of time substantially earlier than the one in which it was accomplished. An error of this character, evident on the face of his former patent, demands instant correction, in order that the public may not be misled, and any avoidable delay is unreasonable if the rights of other innocent parties or of the public intervene; but in cases where the error is ascertained only by the result of litigation, or after a more intimate acquaintance with the art, a wider latitude is permitted to the inventor, though still within such limits as preserve the just and equitable privileges of others.[14] The evidence must, in both these cases, show that the inventor could have applied for the new patent sooner than he did after the necessity therefor became known to him, and that he either acquiesced in the disclosure of his unprotected invention for a period too long to be consistent with an original intention on his part to claim it, or while he had such knowledge of its appropriation by others as now estops him from averring that he did not then intend to dedicate it to the public.[15] The plaintiff, in replying to this evidence, is confined to the question of unreasonable delay except in cases where his knowledge of the insufficiency of his Claim is said to be derived from other sources than the language of his patent or its interpretation by the courts. His cognizance of an evident discrepancy, or of a defect revealed by the decision of the court of last resort, he cannot be permitted to deny. But where his knowledge is inferred from extraneous facts,

[13] That the patentee's knowledge of the defect may appear from the face of the patent, see Wollensak *v.* Reiher (1885), 115 U. S. 96; 31 O. G. 1301; and other cases cited in § 690, note 2, *ante*.

[14] That an apparent defect must be immediately corrected, see § 690 and notes, *ante*.

[15] As to unreasonable delay in re-issue, see §§ 690–692, and notes, *ante*.

he may contradict both facts and inference by any evidence which shows that no such notice of the error had been given him as to charge him with the duty of correcting it. Upon the question of unreasonable delay he may prove any circumstances in his own condition which rendered it impracticable for him to make an earlier effort for his protection, or may show that his avoidable delay has not misled the public or made his late assertion of his rights a cause of injury to others. An abandonment during the pendency of the application can occur by an amendment or disclaimer which excludes the invention from the application as one already in possession of the public. Such an exclusion is a solemn admission on the part of the inventor that the excluded matter is not patentable, and even when made at the demand of the examiner, and as a condition of the allowance of the patent, it cannot be recalled, unless in certain cases of gross mistake and where the recall would prejudice no other interests.[16] While the amendment or disclaimer remains in force it is sufficient proof of the abandonment. It may be shown by certified copies of the papers in the Patent Office, and cannot be rebutted. An abandonment after the patent is granted may be effected by overt acts or express declarations, or even by neglect to act when action is evidently required. Every presumption is against such an abandonment, however, and the proof must, therefore, be of the strongest and most conclusive character. Mere non-user of the invention, whatever be its duration, is of no significance on this point, but long continued acquiescence in its use by others, or an entire neglect to claim its advantages for himself when it had proved to be of great commercial value and had been widely accepted by the community, may satisfy the jury, as well as positive conduct or assertions, of his intention to relinquish all exclusive privileges and finally confer the invention on the public.[17] Evidence of such acts, or declarations, or

[16] As to the effect of disclaimer in the Patent Office, see §§ 688, 689, and notes, *ante*.

As to the effect of an amendment excluding patentable matter from the application, see § 689 and notes, *ante*.

[17] That abandonment after patent may be shown by acts of surrender or relinquishment to the public, see Bell *v.* Daniels (1858), 1 Fisher, 372; 1 Bond, 212.

That proof of the abandonment of

omissions may be drawn from any source of testimony which is able to supply it, and counter-evidence of the same character may be offered by the plaintiff in reply.

§ 1031. Evidence under the Eighth Defence: Non-existence of the Letters-Patent.

The eighth defence denies the existence of the patent described in the declaration. The plaintiff's evidence on this point, as well as that of the defendant, is the patent itself. If it corresponds substantially with the averments in the declaration, the issue must be found for the plaintiff. If a substantial variance appears, the defendant is entitled to a judgment. It is sufficient that the patent and its description agree in such formal parts as are essential to distinguish it from every other patent, such as its date, title, number, and grantee, and in the general tenor of its statements concerning the nature of the patented invention. Thus the averment of a patent for several distinct inventions is supported by the production of a re-issue in an equal number of divisions, the whole relating back to one original, and constituting substantially but a single patent.[1]

§ 1032. Evidence under the Ninth Defence: Illegality of the Letters-Patent.

The ninth defence asserts that the grant of the patent was unlawful, either because certain essential prerequisites were not fulfilled, or because the grant, as made, exceeded the jurisdiction of the Patent Office. When it appears from the patent itself that the formal requirements of the law have not been heeded, no other evidence is necessary.[1] Where the

some less important part of an invention does not show that the entire invention was abandoned, see New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519.

§ 1031. [1] That a declaration that a patent was granted for one principal and three minor improvements is supported by evidence of a re-issue in four divisions, one for each, these re-issues relating back to the original, see Read *v.* Bowman (1864), 2 Wall. 591.

See also § 966 and notes, *ante*.

§ 1032. [1] See as to this defence in general § 967 and notes, *ante*.

The omission of formal requirements can appear from the patent only when the patent affirmatively declares that they have been omitted. Mere absence of statement shows nothing. See note 3, *post*.

patent asserts that they have been complied with, no contrary testimony can be offered, unless the defendant claims that a fraud has been committed against the Patent Office and the public.[2] When the patent is silent upon this point, its issue creates a presumption that all prerequisites have been observed, and throws the burden of proving the contrary upon the defendant. The chief defects, of which the law allows notice to be taken in an action for infringement, are the absence from the patent of the necessary official signatures, and falsehood in the oath accompanying the application. The absence of the necessary signatures is apparent on the face of the patent, and is a fatal defect of which no further evidence is required.[3] The entire omission of the oath, or its improper form, is a fault which the Patent Office can condone, as it can overlook nearly all other formal defects, but

[2] That the averments of the patent concerning the fulfilment of prerequisites are conclusive in the absence of fraud, see Hancock Inspirator Co. *v.* Jenks (1884), 21 Fed. Rep. 911.

That the decision of the Commissioner on matters within his exclusive jurisdiction, such as the sufficiency of formal acts, etc., is final, see U. S. Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 11 O. G. 373; 14 Blatch. 94; 2 Bann. & A. 493.

That the decision of the Commissioner that the application is properly made cannot be collaterally attacked, see Hoe *v.* Cottrell (1880), 18 O. G. 59; 17 Blatch. 546; 5 Bann. & A. 256; 1 Fed. Rep. 597.

That the decision of the Commissioner as to the abandonment of the application is not conclusive, see Planing Mach. Co. *v.* Keith (1879), 101 U. S. 479; 17 O. G. 1031.

That the decision of the Commissioner allowing an extension is conclusive evidence as to all the facts he is required to find, see Jordan *v.* Dobson (1870), 4 Fisher, 232; 2 Abbott, 398; 7 Phila. 533.

That the issue of a patent is a judgment that all the facts entitling the patentee to the patent do exist, and constitutes *prima facie* evidence thereof, see Wooster *v.* Muser (1884), 28 O. G. 286; 20 Fed. Rep. 162; Konold *v.* Klein (1878), 3 Bann. & A. 226.

That patents, being issued upon an adjudication of a public officer, are presumed correct, see Sands *v.* Wardwell (1869), 3 Clifford, 277.

That a patent cannot be objected to on account of matters not appearing on its face concerning the power of the Commissioner or Assistant Commissioner to issue it, see Woodworth *v.* Hall (1846), 1 W. & M. 389; 2 Robb, 517.

[3] That the signatures of the Secretary and Commissioner are essential to a patent and if omitted cannot be supplied by their successors, nor is the defect aided by a copy of the record in which the signatures appear, see Marsh *v.* Nichols (1888), 128 U. S. 605; *Marsh v.* Nichols (1883), 24 O. G. 901; 15 Fed. Rep. 914.

a wilful false oath is a fraud which forfeits all the rights of the inventor.[4] It is immaterial whether the falsehood relates to some matter which affects the allowance of the patent, or to one which simply enlarges the privileges thereby conferred; in either case the attempt to deceive may be shown by proper evidence, and when established will defeat the patent.[5] The oath made by the applicant is proved by a certified copy of the jurat from the records of the Patent Office; its falsehood by evidence disclosing the true state of the facts concerning which it speaks; the intention to deceive, by testimony from which the applicant's knowledge of the truth may be inferred.[6] The plaintiff may contradict this evidence by any relevant testimony concerning the existence of the facts deposed, or the knowledge and intent of the deponent. The

[4] That a patent cannot be attacked on the ground that the application oath was omitted, see Crompton *v.* Belknap Mills (1869), 3 Fisher, 536; and § 458 and notes, *ante.*

That a patent can be attacked on the ground that the application oath was wilfully false, see § 456 and notes, *ante.* But see Tonduer *v.* Chambers (1889), 37 Fed. Rep. 333.

That the issue of a patent on an application amended by the inventor's representative without a new oath is invalid, and a defence on this ground need not be set up in the pleadings, see Eagleton Mfg.. Co. *v.* West, Bradley, & Cary Mfg. Co. (1884), 111 U. S. 490; 27 O. G. 1237.

That in the absence of fraud the patent recitals are conclusive evidence that proper oaths were taken, see Seymour *v.* Osborne (1870), 11 Wall. 516.

That a patent issued on an amended application, which recites that the patentee has made oath to his application, is conclusive in the absence of fraud, on an infringment suit, that the necessary oath was taken, see Hancock Inspirator Co. *v.* Jenks (1884), 21 Fed. Rep. 911.

[5] That the nature of the falsehood sworn to is unimportant if the false oath were material and wilful, see Child *v.* Adams (1854), 3 Wall. Jr. 20; 1 Fisher, 189.

[6] That the defendant may show prior use abroad as having been known to the plaintiff in rebutting his oath that he believed himself to be the first inventor, see Furbush *v.* Cook (1857), 2 Fisher, 668.

That proof that a patentee made an improper oath in form on his application must also show that he made no other oath or it is immaterial, see Hoe *v.* Kahler (1885), 23 Blatch. 354; 34 O. G. 127; 25 Fed. Rep. 271; Hoe *v.* Kahler (1882), 20 Blatch. 430; 12 Fed. Rep. 111.

That the discovery among the papers of an unfilled blank form of oath does not overcome the *prima facie* proof arising from the recital that the oath was taken, see Crompton *v.* Belknap Mills (1869), 3 Fisher, 536.

That while the presence of papers in a file-wrapper from the Patent Office proves their existence, their absence does not show that they did not exist, see Hoe *v.* Kahler (1885), 23 Blatch. 354; 34 O. G. 127; 25 Fed. Rep. 271.

principal cases, in which the grant exceeds the jurisdiction of the Patent Office, are the issue of letters-patent to sole patentees for joint inventions, or the contrary, and the allowance of reissues which include new inventions or inventions intentionally excluded from the original patent. A joint patent for a sole invention, and a sole patent for a joint invention, are alike void.[7] *Prima facie*, the patent as it stands is correct and valid, and the defendant can overcome it only by the clearest and most reliable testimony.[8] The existence of a prior foreign patent in favor of the same inventor or inventors, but directly opposed to the domestic patent in its statements concerning the joint or several origin of the invention, does not change the burden of proof, — the American patent not only outweighing the foreign patent, but in the absence of conclusive extraneous evidence determining the issue for the plaintiff.[9] As the patent

[7] That a joint patent for a sole invention is void, see Stewart *v.* Tenk (1887), 41 O. G. 1502; and § 402, note 3, *ante*.

That a sole patent for a joint invention is void, see Slemmer's Appeal (1868), 58 Pa. St. 155; and § 402, note 2, *ante*.

That this latter position is modified in cases where the sole patentee can in equity be treated as trustee for his co-inventor, see § 402 and notes, *ante*.

[8] That a sole patent is *prima facie* evidence that the patentee was a sole inventor, see Puetz *v.* Bransford (1887), 31 Fed. Rep. 458; 39 O. G. 1083.

That a joint application for a patent raises a presumption that the applicants are joint inventors, which can only be overcome by proof, see Consolidated Bunging Apparatus Co. *v.* Woerle (1887), 29 Fed. Rep. 449: 38 O. G. 1015.

That the defence that joint patentees were not joint inventors is not favored unless the conduct of the patentees was disingenuous or misled the defendant, see Consolidated Bunging Apparatus Co. *v.* Woerle (1887), 29 Fed. Rep. 449; 38 O. G. 1015; Butler *v.* Bainbridge (1886), 29 Fed. Rep. 142; 37 O. G. 1124.

That the burden of proof rests on the defendant to show that a sole patentee was a joint inventor, see Hoe *v.* Cottrell (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; Ashcroft *v.* Cutler (1869), 6 Blatch. 511.

That the burden of proof rests on the defendant to show by clear and unequivocal evidence that an invention applied for, sworn to, and patented as a joint invention, was a several one, see Worden *v.* Fisher (1882), 11 Fed. Rep. 505; 21 O. G. 1957; Hoe *v.* Cottrell (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; Gottfried *v.* Phillip Best Brewing Co. (1879), 17 O. G. 675; 5 Bann. & A. 4.

[9] That the burden of proof rests on the defendant to show that the patentee is not the sole inventor, though there is a prior joint foreign patent to him and others, see Hoe *v.* Cottrell (1880), 1 Fed. Rep. 597; 18 O. G. 59; 17 Blatch. 546; 5 Bann. & A. 256.

That where there is a joint foreign

shows to whom it has been granted, the defendant sustains his position if he proves that the inventive act was joint or sole, contrary to the assertions of the patent. An inventive act is joint when the conception of the idea of means has been evolved by the mutual consultations, suggestions, and experiments of the inventors. It is sole when the conception has arisen and been developed by the operation of one mind, though aided by the advice or achievements of others.[10] That the inventive act was sole may be established by evidence which proves that it existed, complete and ready for reduction to practice, in the mind of the sole inventor before his connection with the alleged joint inventor. Such evidence may consist in his contemporaneous descriptions, drawings, or models of the invention or in his own testimony detailing the steps by which the invention was produced. Evidence that the inventive act was joint may be found in the absence of any memorandum or communication of the complete idea before the inventors met in consultation, as well as in the efforts which they jointly made and in the joint successes they attained. The defendant introduces such of this testimony as supports his claims. The plaintiff, in rebuttal, offers the contrary evidence. In most cases, where any unity of endeavor has existed, it is difficult, if not impossible, to ascertain how much of the result is due to either party, and the law, therefore, is inclined to recognize the merits of both and regard them as joint inventors. But where this question has been once decided by the issue of a patent, the presumption in its favor overcomes all doubts, and can be counteracted only by the most conclusive proof. The jurisdiction of the Patent Office over the subject of re-issues was conferred solely for the purpose of enabling an inventor to correct a defective patent, and thereby cause it to protect, with greater certainty, the invention which he had attempted to secure by the original. It was

patent to A and B and a sole American patent to B, and A swears that the invention was joint and B swears it was sole and there is no other evidence, the American patent will prevail, see Hoe v. Cottrell (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256.

[10] For the characteristics of a joint inventive act, the legal presumptions regarding it, and the facts by which its joint nature is indicated, see §§ 396–402 and notes, *ante*.

never intended as a method of extending an existing patent to cover new inventions, or old inventions which had been intentionally omitted from the original patent. Hence, while the invention claimed in the re-issue must be found in the original description, the Claims of the re-issue must also be confined to inventions which were not advertently excluded from the original Claims.[11] Such an exclusion occurs where an invention fully disclosed in the original description is not embraced within the original Claims, and no amendment of these Claims is attempted within a reasonable time.[12] The departure of the re-issue from the original is shown by comparing the two patents.[13] The defendant must introduce the original patent and from it satisfactorily establish either that the re-issue includes new inventions or inventions which though embraced in the original description are not contained in the original Claims.[14] In this comparison he may avail himself of expert evidence to point out the differences between the inventions claimed in the respective patents, and may offer copies of the files, and models from the Patent Office to

[11] As to the purpose and scope of re-issues, see §§ 633–635, 653–659, and notes, *ante*.

[12] As to abandonment by describing and not claiming or amending within reasonable time, see §§ 352, 506, 690, 691, 1030, and notes, *ante*.

That a re-issue may be defended against as departing from the original, see Parker & Whipple Co. *v.* Yale Lock Co. (1887), 123 U. S. 87 ; 41 O. G. 811 ; Newton *v.* Furst & Bradley Mfg. Co. (1882), 14 Fed. Rep. 465 ; 11 Bissell, 405.

That a delay in a re-issue is fatal unless the plaintiff proves original inadvertence, see Newton *v.* Furst & Bradley Mfg. Co. (1882), 14 Fed. Rep. 465 ; 11 Bissell, 405.

[13] That the want of identity between an original and a re-issue must be shown by comparing them, see Doherty *v.* Haynes (1874), 6 O. G. 118 ; 4 Clifford, 291 ; 1 Bann. & A. 289.

[14] That when the validity of a re-issue is in dispute the original patent must be put in evidence by the defendant, or the validity of the re-issue will be presumed, see Knapp *v.* Shaw (1883), 15 Fed. Rep. 115 ; 23 O. G. 2236 ; National Pump Cylinder Co. *v.* Simmons Hardware Co. (1883), 5 McClary, 592 ; 18 Fed. Rep. 324 ; Searls *v.* Bouton (1881), 21 O. G. 1784 ; 12 Fed. Rep. 140 ; 20 Blatch. 426 ; Doherty *v.* Haynes (1874), 4 Clifford, 291 ; 6 O. G. 118 ; 1 Bann. & A. 289 ; Seymour *v.* Osborne (1870), 11 Wall. 516.

That on a defence that the re-issue is not the same as the original, the plaintiff is not obliged to introduce the original in evidence, and the defence does not avail in the Supreme Court unless the original is apparent on the record, see Bates *v.* Coe (1878), 98 U. S 31 ; 15 O. G. 337.

demonstrate more fully the nature of the invention which the original and re-issue were intended to protect.[15] If he succeeds in showing that the re-issue covers new matter the fault must be cured by disclaimer or the suit will fail.[16] If he proves that matter, disclosed but not protected by the original, has now been claimed in the re-issue, the question of intentional exclusion arises, and further evidence must be produced to show that after the insufficiency of his Claims became known to the inventor he omitted to apply for their amendment within reasonable time. This question is similar to that raised under the seventh defence, on abandonment by the application; and the testimony of the defendant in support of the intention to exclude and of the plaintiff in denial are substantially the same.[17] If it appears that the inventions which the Claims of the re-issue were extended to embrace had been designedly omitted from the original patent, a disclaimer alone can save the re-issued patent and the suit. The decision of the Commissioner allowing the re-issue is of great weight with the court on all these controverted points, since all are presumed to have been fully considered and adjudged by him.[18]

[15] That if the re-issued patent is in evidence, with a different drawing from the original, and a model is then introduced conforming to the changed drawing, the defendant may show the condition of the model when it was filed in the Patent Office, and at the date of the original patent, and the case will be re-opened to receive such proof if newly discovered, see Johnsen *v.* Beard (1875), 8 O. G. 435; 2 Bann. & A. 50.

That evidence of what passed in the Patent Office pending the application for the original is admissible on the question of identity in the re-issue, see McCormick *v.* Graham (1889), 129 U. S. 1; Ewart Mfg. Co. *v.* Bridgeport Malleable Iron Co. (1887), 31 Fed. Rep. 149.

[16] That a claim of new matter in the re-issue may be cured by disclaimer, see Torrent *v.* Duluth Lumber Co. (1887), 30 Fed. Rep. 830; 39 O. G. 1425; Schillinger *v.* Cranford (1885), 4 Mackey, 450; 37 O. G. 1349; Schillinger *v.* Gunther (1879), 16 O. G. 905; 17 Blatch. 66; 4 Bann. & A. 479.

That if the suit can be sustained only by extending the scope of the re-issue beyond the original invention, the defendant will prevail, see Covell *v.* Pratt (1880), 18 O. G. 301; 18 Blatch. 126; 2 Fed. Rep. 359; 5 Bann. & A. 380.

[17] See § 1030 and notes, *ante*.

[18] That a re-issued patent is *prima facie* evidence that the re-issue is legal, see Spaeth *v.* Barney (1885), 30 O. G. 997; 22 Fed. Rep. 828.

That the decision of the Commissioner on the identity of the re-issue with the original is of great weight with the court, see Hussey *v.* Bradley (1863), 2 Fisher, 362; 5 Blatch. 134.

That technical objections to patents are to be strictly construed, see Wood-

§ 1033. Evidence under the Tenth Defence: The Patented Invention not Embraced in the Protected Classes.

The tenth defence denies that the invention claimed in the patent is embraced in any one of the six classes protected by the Acts of Congress. This defence is identical with the fourth, except that it attacks the patent instead of the actual invention. The evidence is also mainly the same with that available under the fourth defence.[1] The patent raises a presumption that the claimed invention is patentable subject-matter, which the defendant must rebut.[2] The questions here arising are principally, and sometimes entirely, questions of law relating to the construction of the patent and the definitions of the classes of privileged inventions, on which the court will either decide without a jury or direct a verdict for the party who is legally entitled to obtain it.[3]

§ 1034. Evidence under the Eleventh Defence: Fraudulent Specification.

The eleventh defence alleges that the specification of the patent was made to contain less than the whole truth relative to the invention, or more than is necessary to produce the desired effect, for the purpose of deceiving the public. Two points are put in issue: (1) The concealment or redundancy; (2) The intent to deceive. On both these points the patent is *prima facie* evidence in favor of the plaintiff and the burden of proof rests on the defendant.[1] The evidence as to the first point

worth *v.* Hall (1846), 1 W. & M. 248; 2 Robb, 495.

§ 1033. [1] See §§ 968, 1025, and notes, *ante*.

[2] That the decision of the Patent Office on a question of patentable invention will not be departed from by the courts except upon clear proof, see Fraim *v.* Keen (1885), 25 Fed. Rep. 820; 34 O. G. 1048.

[3] That where the patent discloses a want of patentable subject-matter the court may take judicial notice thereof, and order a verdict for the defendant, see Slawson *v.* Grand St., Prospect Park, and Flatbush R. R. Co. (1882), 107 U. S. 649; 24 O. G. 99; and § 1025, note 1.

§ 1034. [1] That the patent is *prima facie* evidence of the correctness of the specification, see Westlake *v.* Cartter 1873), 4 O. G. 636; 6 Fisher, 519; Poppenhusen *v.* N. Y. Gutta Percha Comb Co. (1858), 2 Fisher, 62.

That the intent to deceive must be proved to the satisfaction of the jury, see Celluloid Mfg. Co. *v.* Russell (1889), 37 Fed. Rep. 676; Grant *v.* Raymond (1832), 6 Peters, 218; 1 Robb, 604; Lowell *v.* Lewis (1817), 1 Mason, 182; 1 Robb, 131; Gray *v.* James (1817), Peters, C. C. 394; 1 Robb, 120; Whittemore *v.*

consists of the testimony of experts, or of practical mechanics acquainted with the actual invention. If it appears from this evidence that a person skilled in the art could not practise the invention from the disclosure contained in the specification, the alleged concealment is established.[2] If it is proved that those who follow the directions of the specification are compelled to incur greater expense, or employ more numerous or less effective appliances, or surmount more formidable difficulties, than are necessary in order to secure the best results from the invention, the redundancy is manifest. Upon the second point positive evidence, however desirable, is not essential and can rarely be obtained. The intention to deceive must be inferred from circumstances.[3] If the facts concealed are so important that the inventor must have known that no mechanic could construct and use the invention from the description given, or if the invention, as practised by himself at or before the filing of his specification, was relieved from the steps or appliances now shown to be unnecessary and burdensome, it is a fair presumption that he intended to mislead the public.[4] The same intention may be proved by his contemporaneous declarations, by secret instructions given to his licensees concerning better modes of using the invention, or by any other acts relating to the invention which manifest a fraudulent purpose to put the public at a disadvantage when the term of the patent shall have expired.[5] The plaintiff, in reply, may contradict or explain the circumstances, or deny the inference. The entire question is for the jury, who must find that both elements of the defence are clearly proved, or award the issue to the plaintiff.[6]

Cutter (1813), 1 Gallison, 429 ; 1 Robb, 28 ; Park *v.* Little (1813), 3 Wash. 196 ; 1 Robb, 17 ; Reutgen *v.* Kanowrs (1804), 1 Wash. 168 ; 1 Robb, 1.

[2] That if a mechanic, after the patent has expired, could not practise the invention from the specification alone the concealment is material, see Reutgen *v.* Kanowrs (1804), 1 Wash. 168 ; 1 Robb, 1.

[3] That an intent to deceive can rarely be proved directly but must be inferred from other facts, see Gray *v.* James (1817), Peters, C. C. 394 ; 1 Robb, 120.

[4] That if the patentee knew of better methods when he framed his description, it is evidence of fraud, see Bovill *v.* Moore (1816), 1 Abb. P. C. 231 ; Dav. P. C. 361 ; Turner *v.* Winter (1787), 1 Abb. P. C. 43 ; 1 Web. 77.

[5] That secret instructions to licensees show fraud, see Dyson *v.* Danforth (1865), 4 Fisher, 133.

[6] That the degree of evidence neces-

§ 1035. Evidence under the Twelfth Defence: Ambiguity of the Description.

The twelfth defence avers the ambiguity of the description. It raises the issue whether the disclosure of the invention is sufficient to enable persons skilled in the art to practise it without the exercise of their own inventive faculties. The patent makes a *prima facie* case for the plaintiff on this issue, and the defendant must contradict it by satisfactory evidence.[1] The testimony most pertinent and convincing is that of practical mechanics, who have endeavored to construct and use the invention by following the directions given in the patent.[2] The evidence of scientific experts on this point is also proper. A single instance of success or failure in the endeavor of a practical mechanic to employ the invention is, however, of more weight and value than numerous opinions to the contrary. No question as to the intention of the inventor arises under this defence, and evidence indicating the existence of a fraudulent purpose is, therefore, inadmissible.[3]

§ 1036. Evidence under the Thirteenth Defence: Excessive Claims.

The thirteenth defence asserts that the Claim of the patent is excessive and has not been cured within a reasonable time by a disclaimer. Whether the Claim is excessive is a mixed

sary to show fraudulent intent is for the jury to decide, see Gray *v.* James (1817), Peters, C. C. 394 ; 1 Robb, 120.

See also as to this subject §§ 494, 969, and notes, *ante*.

§ 1035. [1] That the patent is *prima facie* evidence that the specification is sufficient, see Poppenhusen *v.* New York Gutta Percha Comb Co. (1858), 2 Fisher, 62.

That the burden of proof as to the uncertainty of the patent rests on the defendant, see Westlake *v.* Cartter (1873), 4 O. G. 636 ; 6 Fisher, 519.

[2] That the jury are to say on the evidence of persons skilled in the art whether the description is clear enough to enable them to make the invention, see Wood *v.* Underhill (1847), 5 How. 1 ; 2 Robb, 588.

That the claim of ambiguity in the description is rebutted by the testimony of competent mechanics that they could construct the device from it, see Wayne *v.* Holmes (1856), 2 Fisher, 20 ; 1 Bond, 27.

[3] That the defendant need not prove that the plaintiff intended to deceive by his erroneous specification, see Grant *v.* Raymond (1832), 6 Peters, 218 ; 1 Robb, 604.

As to the sufficiency of the description, see §§ 490–493, and notes, *ante*.

As to this defence in general, see § 970 and notes, *ante*.

question of law and fact. The court is to construe the Claim as matter of law and instruct the jury as to the nature of the invention which it purports to embrace.[1] The jury are to decide from the evidence whether the Claim as thus interpreted includes more than the actual invention.[2] Upon this point of the defence the patent is *prima facie* evidence of the correctness of the Claim. The defendant must, therefore, prove the essential characteristics of the true invention and show that it does not comprise all the substantial features covered by the Claim. The evidence on both sides consists of specimens, drawings, or descriptions of the actual invention, illustrated and explained by expert witnesses. Upon the question whether an excessive Claim has been cured by a disclaimer within reasonable time, the patent furnishes no evidence. The burden of proof properly falls upon the plaintiff, and he should be prepared to show either that he has filed the disclaimer without unreasonable delay, or that a reasonable time for filing it has not elapsed since he became aware of the existence of his error. An inventor is not chargeable with notice that his Claim is excessive until it has received judicial interpretation in the court of last resort, except in cases where the excess is evident upon its face.[3] The reasonableness or unreasonableness of the delay is matter of law for the court upon the facts disclosed by the evidence.[4] If the amendment is made immediately upon the discovery of its necessity, there is no delay. When the delay is unavoidable it cannot be unreasonable.[5] Although avoidable, it will not be unreasonable unless protracted to an extreme degree, where no other interests are at stake and the public are not liable to be misled.[6]

§ 1036. [1] That the Claims of a patent are construed by the court as matter of law, see §§ 732, 733, and notes, *ante*.

[2] That the jury are to decide whether the Claims set forth the actual invention, see Teese *v.* Phelps (1855), 1 McAllister, 48; Orr *v.* Burwell (1849), 15 Ala. 378.

[3] That no duty to disclaim arises until the plaintiff becomes chargeable with knowledge of the excess, see Kittle *v.* Hall (1887), 30 Fed. Rep. 239; and cases cited in notes to § 646, *ante*.

[4] That the court must decide as to reasonable delay, see § 646 and notes, and § 690, notes 5 and 8, *ante*.

[5] That an unavoidable delay is not unreasonable, see Hartshorn *v.* Eagle Shade Roller Co. (1883), 18 Fed. Rep. 90; 25 O. G. 1191.

[6] That the effect of a delay upon other parties may show whether or not it is unreasonable, see Stutz *v.* Arm-

If the plaintiff maintains that a disclaimer has been filed, it may be proved by a certified copy from the Patent Office. The evidence in reference to delay must show when the inventor first discovered that his Claim embraced more than the actual invention, and the circumstances which compelled him to postpone the amendment of his patent. Upon this portion of the issue the defendant may produce any testimony tending to fix an earlier date for the discovery of the error, or to prove that the delay of the inventor was unjustifiable in view of his own condition or that of others interested in the invention. When this defence applies to more than one Claim in the patent, evidence appropriate to each must be introduced.[7]

§ 1037. Evidence under the Fourteenth Defence: Ambiguity of the Claim.

The fourteenth defence asserts the ambiguity of the Claim. This defence raises a question of law for the court, and except in certain rare cases presents no issue for the jury. A Claim is ambiguous when the court is unable to ascertain from it what the patentee intended to protect as his invention.[1] The allowance of the patent by the Patent Office is a decision that its Claims are not ambiguous, and this decision is *prima facie* correct. The courts, however, in the discharge of their duty in construing the patent must encounter this question and settle it, though every presumption is in favor of the plaintiff, and the patent will, if possible, be sustained. For this purpose not only the Claim itself, with the Description and drawings, will be considered, but extraneous evidence may be offered to show the meaning of technical terms, or any other facts generally known in the art by which its obscure phrase-

strong (1884), 28 O. G. 367; 20 Fed. Rep. 843; and cases cited in note 7, § 690, *ante*.

[7] That each Claim of the patent may be contested on the ground of excess, see 537, note 4, *ante*.

See on the matter of excessive Claims §§ 537, 643, 971, and notes, *ante*.

On the matter of disclaimer, see §§ 640–652, and notes, *ante*.

§ 1037. [1] For ambiguity of Claim, see §§ 512–515, 537, 972, and notes, *ante*.

That whether the Claims are ambiguous is a question of law for the court, see Wayne *v.* Holmes (1856), 2 Fisher, 20; 1 Bond, 27.

ology may be rendered intelligible.[2] The introduction of such evidence by the parties is not a matter of right, but of judicial discretion.[3] It consists principally of the testimony of experts, and of persons practically acquainted with the art, or of copies of papers in the Patent Office relating to the invention.[4] When the Claim itself refers to facts, the existence and character of which must be determined before the Claim can be construed, evidence concerning these facts may be submitted to the jury, whose finding thereon thus enters into and becomes an element in the interpretation of the Claim.[5]

§ 1038. Evidence under the Fifteenth Defence: Surrender of the Letters-Patent.

The fifteenth defence alleges that the patent described in the declaration has been surrendered to the government. The production of the patent by the plaintiff is *prima facie* evidence that it is still in force, and the defendant must therefore prove the contrary. His evidence consists of certified copies from the records of the Patent Office showing the fact of surrender, the ownership of the patent by the parties who surrendered it, and its cancellation or the re-issue of an amended patent in its stead.[1]

§ 1039. Evidence under the Sixteenth Defence: Repeal of the Letters-Patent.

The sixteenth defence avers that the patent described in the declaration has either been repealed *in toto* by a judgment

[2] That the court in construing a Claim may resort to extraneous evidence, see §§ 739–741, and notes, *ante*.

[3] That evidence is not admissible, as a matter of right, to aid the court in construing the Claim, see § 732, and notes, *ante*.

[4] That the court may avail itself of expert testimony, see Day *v.* Stellman (1859), 1 Fisher, 487.

That a drawing may be used in evidence to interpret an ambiguous specification, but cannot supply the entire want of any part of a specification or Claim, see Tinker *v.* Wilbers Eureka Mower & Reaper Mfg. Co. (1880), 1 Fed. Rep. 188; 5 Bann. & A. 92.

[5] That the jury apply the construction given by the court to the facts, and if the construction given is conditioned on the existence of extraneous facts, the jury are to find such facts and then apply the Claim as interpreted by the court, see Silsby *v.* Foote (1852), 14 How. 218; Emerson *v.* Hogg (1845), 2 Blatch. 1.

§ 1038. [1] For a statement of the requisites and mode of a surrender, see §§ 696–699, and notes, *ante*.

See as to this defence § 973 and notes, *ante*.

in favor of the United States against the owner of the patent, or has been annulled in whole or in part in a proceeding instituted or defended by some person interested in an interfering patent. On both these issues the patent is *prima facie* evidence for the plaintiff. The defendant may show its repeal by a properly authenticated copy of the judgment, or where the patent, in pursuance of this judgment, has been returned to the Patent Office and been cancelled he may produce a certified copy of the record of such cancellation.[1] In proving that the patent has been annulled, the fact and scope of the judgment of avoidance may be evidenced by a copy from the records of the court, while copies of the record title in the Patent Office disclose that the plaintiff or his assignor was the party against whose interest in the patent such judgment was rendered.[2]

§ 1040. Evidence under the Seventeenth Defence: Want of Title in the Plaintiff.

The seventeenth defence denies the legal title of the plaintiff to the patent. When the plaintiff is the patentee, the patent is *prima facie* evidence upon this point in his favor, and the defendant must sustain his denial by satisfactory proof.[1] But where the plaintiff is an assignee or grantee, the burden rests upon him to establish the conveyances by which he claims to have derived his title from the patentee. The original assignment or grant is admissible for this purpose, though not recorded before the action was commenced, and is sufficient if in writing and executed in conformity with the local law.[2] In the absence of the original instruments, certi-

§ 1039. [1] As to the repeal of patents see §§ 725–730, and notes, *ante*.

[2] As to the annulling of patents, see §§ 721–724, and notes, *ante*.

See as to this defence § 974 and notes, *ante*.

§ 1040. [1] That the patent is *prima facie* evidence that the patentee owns the patented invention unless the contrary is proved, see Fischer *v.* Neil (1881), 6 Fed. Rep. 89; 19 O. G. 603.

As to this defence see §§ 937, 975, and notes, *ante*.

[2] That an assignment may be offered in evidence, whether recorded before or after suit, see Pitts *v.* Whitman (1843), 2 Story, 609; 2 Robb, 189.

That the assignment of a patent duly acknowledged before a notary may be put in evidence in New York, and the signatures of the assignors need not be proved, such assignment being valid by the laws of that State, see New York Pharmical Association *v.* Tilden (1883), 21 Blatch. 190; 23 O. G. 272; 14 Fed. Rep. 740.

fied copies from the records of the Patent Office may be offered, and these not only prove the contents of the records, but are also *prima facie* evidence of the genuineness of their originals.[3] The defendant, in reply, may attack either the existence or the validity of the alleged conveyances, or set up a legal title in himself acquired for valuable consideration, without notice, after the three months for recording the plaintiff's conveyance had elapsed.

§ 1041. Evidence under the Eighteenth Defence: Diversity of the Alleged Infringing Art or Article from the Invention Covered by the Patent.

The eighteenth defence denies that the invention practised by the defendant is identical with or is included in the patented invention. Upon this question, as upon all others embraced in the issue of infringement, the patent raises no presumption in favor of the plaintiff.[1] The burden rests upon him to show by extraneous evidence that the defendant has made, used, or sold the patented invention in violation of the patent, and if the testimony is of equal weight on either of these points the defendant must prevail.[2] When the plaintiff has made out a

[3] That copies of records of assignments are evidence, see Brooks *v.* Jenkins (1844), 3 McLean, 432.

That a certified copy from the Patent Office of an assignment is *prima facie* evidence of the genuineness of the original and may be read in evidence to the jury, see Lee *v.* Blandy (1860), 2 Fisher, 89; 1 Bond, 361.

That a certified copy of a recorded but unacknowledged instrument purporting to be an assignment is sufficient evidence of its execution, unless met by opposing testimony, see Dederick *v.* Whitman Agricultural Co. (1886), 26 Fed. Rep. 763; 36 O. G. 570.

That in the absence of all other proof as to the date of an assignment, the date of the patent will be taken as the date of the application and also of the assignment if before patent, see Worley *v.* Loker Tobacco Co. (1882), 104 U. S. 340; 21 O. G. 559.

§ 1041. [1] That the patent is not *prima facie* evidence of the infringement, but the plaintiff must prove it by other evidence, see Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86.

[2] In Brooks *v.* Bicknell (1844), 3 McLean, 432, McLean, J.: (453) "The proof here devolves on the plaintiffs. They allege that the defendants have infringed their rights, and to obtain your verdict they must show it. Doubts under this head will incline you favorably to the defendants, as they are not to be deprived of a right which is common to every citizen, unless it shall clearly appear that their machine is substantially like the one claimed by Woodworth."

Further, that the burden of proof rests upon the plaintiff to show the infringement by the defendant, see Hayes *v.* Bickelhoupt (1885), 23 Fed. Rep. 183; 32 O. G. 135; Mallory Mfg. Co.

prima facie case, however, the defendant must answer it by evidence, not by mere assertion in his pleadings; but he is not compelled to go beyond the contradiction of the evidence already offered, since the plaintiff cannot, in his rebuttal, strengthen his case upon the issue of infringement to the surprise or injury of the defendant.[3] The identity of the patented invention with that employed by the defendant depends upon the same principles and is settled by reference to the same standards, as when the question of identity arises under the defence of prior use or prior patent.[4] Though novelty and

v. Hickok (1885), 34 O. G. 923; 25 Fed. Rep. 827; Royer *v.* Chicago Mfg. Co. (1884), 20 Fed. Rep. 853; Price *v.* Kelly (1881), 20 O. G. 1452; Miller *v.* Smith (1880), 5 Fed. Rep. 359; 18 O. G. 1047; Rogers *v.* Beecher (1880), 18 O. G. 793; 3 Fed. Rep. 639; 5 Bann. & A. 619; Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337; Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438; Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796; Fuller *v.* Yentzer (1876), 94 U. S. 299; 11 O. G. 597; Storrs *v.* Howe (1876), 10 O. G. 421; 4 Clifford, 388; 2 Bann. & A. 420; Brady *v.* Atlantic Works (1876), 10 O. G. 702; 4 Clifford, 408; 2 Bann. & A. 436; Francis *v.* Mellor (1871), 8 Phila. 157; 5 Fisher, 153; 1 O. G. 48; Hudson *v.* Draper (1870), 4 Fisher, 256; 4 Clifford, 178; Howes *v.* Nute (1870), 4 Clifford, 173; 4 Fisher, 263; Sands *v.* Wardwell (1869), 3 Clifford, 277; Graham *v.* Mason (1869), 5 Fisher, 1; 4 Clifford, 88; Hodge *v.* Hudson River R. R. Co. (1868), 3 Fisher, 410; 6 Blatch. 85; Whitney *v.* Mowry (1867), 3 Fisher, 157; 2 Bond, 45; Union Sugar Refinery *v.* Matthiesson (1865), 2 Fisher, 600; 3 Clifford, 639; Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86; Parker *v.* Stiles (1849), 5 McLean, 44; Brown *v.* Jenkins (1844), 3 McLean, 432; Dixon *v.* Moyer (1821), 4 Wash. 68; 1 Robb, 324.

[3] That if the plaintiff offers any evidence of infringement the defendant must overcome it, see Bennett *v.* Fowler (1869), 8 Wall. 445.

[4] In Parker *v.* Stiles (1849), 5 McLean, 44, Leavitt, J.: (62) "On the question of infringement, the burden of proof is with the plaintiff. He must make it appear, to the satisfaction of the jury, that the defendant has violated the exclusive right granted by his patent. And in order to make out the fact of infringement, the plaintiff must prove that the defendant has used his invention, either in the precise form in which it is constructed under the patent, or in a form and on principles substantially the same. To constitute this identity, and to make out the fact of infringement, it is not necessary that the structure or machine used by the defendant should be the same in appearance, form, or proportions, as that invented and patented by the plaintiff. It has been well said by a distinguished judge in this country, that 'simply changing the form or proportion of a machine shall not be deemed a new discovery.' If the operative principle of the two machines be the same, the substantial identity contemplated by the Patent Law is established."

As to the indications of identity, see §§ 229–236, 892–896, 963, 1026, and notes, *ante*.

infringement present distinct issues, and the former must be proved before the latter can be considered, yet in each case the patented invention is compared with some other instrument or operation for the purpose of determining their substantial similarity or difference, and the mode of this comparison, as well as the evidence admissible in connection therewith, is in both cases the same.[5] Where the invention practised by the defendant is covered by a separate patent, under which the defendant acts, the identity of the two inventions is ascertained by the court by comparing the Claims of the patents, with such aid from expert or other witnesses as it may deem desirable.[6] If the defendant acts without the shelter of a patent, the identity between the invention which he uses and the patented invention is best shown by the actual inspection of the two inventions, or of models exhibiting their essential attributes, either with or without the explanations of expert witnesses.[7] This is especially true where the inventions are designs, which in many instances manifest their identity or diversity to any careful observer.[8] When such inspection is insufficient to determine the question, the inventions may be examined while in actual use, if this is practicable.[9] Or without recourse to either of these methods, the

[5] That novelty and infringement do not raise the same issues, see Union Sugar Refinery *v.* Matthiesson (1865), 2 Fisher, 600 ; 3 Clifford, 639.

As the identity of two inventions, for whatever purpose they may be compared, must rest on the same essential characteristics in each, the evidence by which identity is proved or denied must be in all cases the same.

[6] That the identity of two patented inventions is shown by comparing their Claims, see McMillan *v.* Rees (1880), 1 Fed. Rep. 722 ; 17 O. G. 1222 ; 5 Bann. & A. 269.

[7] That a comparison of the devices of the plaintiff and the defendant is the best evidence on the question of infringement, see Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337; Fuller *v.* Yentzer (1876), 94 U. S. 288 ; 11 O. G. 551; Hudson *v.* Draper (1870), 4 Fisher, 256 ; 4 Clifford, 178 ; Seymour *v.* Osborne (1870), 11 Wall. 516 ; Cahoon *v.* Ring (1861), 1 Clifford, 592; 1 Fisher, 397.

That a court of equity may order an inspection of the defendant's device on a question of identity, see Wilson *v.* Keely (1888), 43 O. G. 511.

That the jury are to determine from the models and other evidence whether the defendant infringes, see Smith *v.* Pearce (1840), 2 McLean, 176 ; 2 Robb, 13.

[8] That designs may be compared by the court in some cases to show identity, no other evidence being needed, see Jennings *v.* Kibbe (1882), 10 Fed. Rep. 669 ; 20 Blatch. 353 ; 22 O. G. 331.

[9] That a machine effecting the same end by the same means is an infringement, and the jury are to examine both

testimony of experts familiar with the defendant's invention may be offered to disclose its characteristics and their agreement or disagreement with those found in the patented invention.[10] Where the defendant conceals the art or article he uses, and declines to produce it for inspection, there is a strong presumption that it is identical with the one covered by the plaintiff's patent, particularly when from other evidence it is apparent that he intends to imitate it as closely as he can without detection.[11] The amount of proof required from the plaintiff on this issue is measured by the quantity which the defendant can present. The uncontradicted evidence of a single witness that the defendant employed a device substantially like that of the plaintiff is sufficient, but in case of contradiction the jury must find for the defendant unless a clear preponderance of evidence supports the plaintiff's declaration.[12] When the invention used by the defendant is not

and see how they work and what they do, see Cahoon *v.* Ring (1861), 1 Clifford, 592; 1 Fisher, 397.

[10] That experts may be examined and their evidence taken as to the identity of the plaintiff's and defendant's devices, see Hudson *v.* Draper (1870), 4 Fisher, 256; 4 Clifford, 178; Page *v.* Ferry (1857), 1 Fisher, 298.

That expert evidence is not necessary, see Hayes *v.* Bickelhoupt (1885), 23 Fed. Rep. 183; 32 O. G. 135.

That the opinion of experts is not for the jury if it involves a question of law or the construction of the patent, see Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64.

That if the court can say on inspection that the defendant's device does not infringe the plaintiff's, there is no room for expert evidence or jury action, see Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64.

That a prior judgment finding that a given device infringes a patent is of weight to show that similar devices are also infringements, see Steam Gauge & Lantern Co. *v.* Myers Mfg. Co. (1886), 28 Fed. Rep. 624.

[11] That the refusal of a defendant to exhibit his device raises a presumption of infringement, see Piper *v.* Brown (1873), Holmes, 196; 6 Fisher, 240; 8 O. G. 97.

That if the defendant comes as near the plaintiff's method as he can, this tends to show infringement, see Turrill *v.* Illinois Central R. R. Co. (1873), 5 Bissell, 344.

That a defendant denying access to his machine, and failing to show its model, drawing, product, or patent, cannot expect much weight to be attached to his denials of identity, or much favor to be shown him in case of doubt, see Union Paper Bag Mach. Co. *v.* Binney (1871), 5 Fisher, 166.

That a party who tries to suppress truth has all the presumptions against him, while one who freely discloses it has no presumption either way, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 28 O. G. 1007; 19 Fed. Rep. 514.

[12] That the uncontradicted evidence of a single witness that the defendant used machines substantially like the plaintiff's is enough to prove infringe-

intended for the same purpose as that of the plaintiff, and the infringement is, therefore, collateral or accidental, the proof of identity must be so conclusive as to leave no room for any other reasonable construction.[13] The plaintiff, under all circumstances, must abide by the Claims and descriptions contained in his own patent, neither adding nor discarding anything in order to bring his invention into correspondence with that of the defendant.[14] The defendant may show that notwithstanding any resemblances between his processes, effects, or products, and those of the plaintiff, the means he uses are essentially different.[15] He may offer evidence of the substantial superiority of his art or device, as the basis of an inference that a distinct idea is therein expressed.[16] He may also prove that the invention which he practises is identical with one in use before the date of the inventive act of the plaintiff or his inventor, since if the plaintiff's invention be actually new, it cannot in this case be the same with that of the defendant. Whether a later patent, obtained by the defendant or his assignor, grantor, or licensor, could be produced in evidence on his behalf was formerly disputed.[17] It is now admitted for two purposes: (1) To show the good faith of the defendant, which may become material in view of the power of the court to increase the damages awarded by

ment, see Spring *v.* Domestic Sewing Mach. Co. (1881), 21 O. G. 633; 9 Fed. Rep. 505; Gear *v.* Fitch (1878), 16 O. G. 1231; 3 Bann. & A. 573; Goodyear *v.* Berry (1868), 3 Fisher, 439; 2 Bond, 189.

That the evidence of a witness that he saw the infringing device in the defendant's possession may be sufficient proof, see Gear *v.* Fitch (1878), 16 O. G. 1231; 3 Bann. & A. 573.

[13] That where the defendant's device was not intended to evade a patent but for a different purpose, and the infringement is thus purely accidental, the evidence of it must be so clear as to leave no other reasonable construction, see National Car Brake Shoe Co. *v.* D., L., & N. R. R. Co. (1880), 4 Fed. Rep. 224.

[14] That the plaintiff is limited to the Claims of his patent, see § 505 and notes, *ante*.

[15] That in a suit for infringement the defendant may show that his machine differs though the process is the same, see Corning *v.* Burden (1853), 15 How. 252.

[16] That the superior utility of the defendant's device or process may show its substantial diversity from the plaintiff's, see §§ 116–121, 344, and notes, *ante*.

[17] That it was formerly doubted whether the defendant's patent was admissible at all, and though it is now admitted it does not materially affect the question of infringement, see Goodyear Dental Vulcanite Co. *v.* Gardner (1870), 4 Fisher, 224; 3 Clifford, 408.

the jury; (2) To show that the expert examiners in the Patent Office regarded the invention which it covers as essentially distinct from that protected in the earlier patent of the plaintiff.[18] Such a decision in the Patent Office is strong evidence in favor of the defendant on this question of identity, and must be properly considered by the jury, though it cannot control their verdict.[19] Its weight is increased by a re-issue or extension of the defendant's patent.[20] But where the defendant originally secured his patent by disclaiming the plaintiff's invention, and after the plaintiff's patent had been granted re-issued his own to cover the invention, his defence must rest upon the priority of his inventive act, not on an absence of identity between the two inventions.[21]

§ 1042. Evidence under the Nineteenth Defence: Non-commission of the Infringing Acts by the Defendant.

The nineteenth defence denies that the defendant has made, used, or sold, the invention which the plaintiff claims to be

[18] That where the defendant acts in good faith under a later patent the court will refuse to inflict punitive damages, see Buerk *v.* Imhaeuser (1876), 14 Blatch. 19; 10 O. G. 907; 2 Bann. & A. 452.

That the defendant's patent is entitled to the same presumptions of novelty and utility as the plaintiff's, see Smith *v.* Woodruff (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; Blanchard *v.* Puttman (1867), 3 Fisher, 186; 2 Bond, 84; House *v.* Young (1867), 3 Fisher, 335.

[19] That the defendant may offer in evidence the later patent of his licensor to show that the inventions are not the same, see Blanchard *v.* Puttman (1867), 3 Fisher, 186; 2 Bond, 84.

That the grant of a patent is a decision by the Commissioner that the invention is not covered by prior patents, see Putnam *v.* Keystone Bottle Stopper Co. (1889), 38 Fed. Rep. 234; Serrell *v.* Collins (1857), 1 Fisher, 289.

That the validity of the defendant's patent is not in issue, see Larabee *v.* Courtlan (1851), Taney, 180.

That patents granted pending a prior application for the patent in issue are no protection to an infringer, see Johnson *v.* Fassman (1872), 2 O. G. 94; 1 Woods, 138; 5 Fisher, 471.

That at law no comparison can be made between the defendant's machine and prior machines, but only between them and the plaintiff's upon the question of novelty, see Judson *v.* Cope (1860), 1 Fisher, 615; 1 Bond, 327.

[20] That a re-issue or extension increases the weight of a patent on the question of novelty, see Whitney *v.* Mowry (1867), 2 Bond, 45; 3 Fisher, 157.

[21] See § 1024, note 10, *ante*.

That where the plaintiff obtained his patent on the defendant's refusal to submit to arbitration under Sec. 9, act of 1793, and afterward the defendant obtained a patent, this is not conclusive proof that the latter was issued on false suggestion, see Stearns *v.* Barrett (1816), 1 Mason, 153; 1 Robb, 97.

As to this defence in general, see § 976 and notes, *ante*.

identical with his own. The plaintiff must prove these acts of the defendant to the satisfaction of the jury, but inasmuch as direct testimony upon this point is often unobtainable, and the entire matter lies within the knowledge of the defendant who can explain his conduct if he chooses, the jury are allowed to base their verdict upon the indications afforded by circumstances not amounting to specific acts of making, use, or sale. Thus, although to make and to use the invention are distinct injuries, the proof of use or sale, coupled with evidence tending to show that the defendant did not elsewhere procure the articles sold or used, may establish an averment that he made them.[1] The testimony of a witness that he saw the invention in the defendant's factory or in his possession, if not denied or explained, is sufficient ground for the conclusion that he used it.[2] The evidence of a workman that he was employed by the defendant under a contract which, as read to him, required him to make use of the patented invention, will, if uncontradicted, also warrant a finding for the plaintiff.[3] The fact that the defendant advertised the patented articles for sale is likewise admissible as tending to prove actual making, use, or sale, according to the other circumstances shown.[4] The refusal of the defendant to allow his

§ 1042. [1] See as to this defence §§ 903–905, 977, and notes, *ante*.

That proof of use alone sustains the allegation of making and using, see Locomotive Engine Safety Truck Co. *v.* Erie R. R. Co. (1872), 3 O. G. 93 ; 10 Blatch. 292 ; 6 Fisher, 187.

That though a sale to the patentee is not an infringement it may be evidence of infringement by sale to others, see De Florez *v.* Raynolds (1878), 14 Blatch. 505 ; 3 Bann. & A. 292.

That the sale of the device to an agent of the patentee employed by him to buy it is not *per se* infringement, but may be evidence of it, see Byam *v.* Bullard (1852), 1 Curtis, 100.

That where a declaration limits the period of infringement the evidence must be confined to that time, see Creamer *v.* Bowers (1888), 35 Fed. Rep. 206.

[2] That where a witness saw the infringing device in the defendant's possession, and the defendant does not deny the infringement explicitly, it is regarded as proved, see Gear *v.* Fitch (1878), 16 O. G. 1231 ; 3 Bann. & A. 573.

[3] That where a workman testifies without contradiction that a certain written contract was read to him as a contract for putting down the plaintiff's device, and the contract not being produced parol evidence is given of its contents, the evidence is conclusive as to infringement, see Andrews *v.* Creegan (1881), 19 O. G. 1140 ; 19 Blatch. 113 ; 7 Fed. Rep. 477.

[4] That although an advertisement of

processes or products to be inspected, and even his failure to deny the alleged infringing acts when evidenced by any probable testimony, are matters which may weigh against him with the jury.[5] The sources of evidence upon this question, for both the plaintiff and defendant, are the same as those in any other controversy where acts of manufacture, use, or sale are involved, — the testimony consisting of the statements of witnesses who personally know the facts which they narrate. If the defendant, not denying the alleged acts of making, use, or sale, disclaims his own liability for them on the ground that he was acting under orders and not of his own volition, he must sustain this position by sufficient evidence. Such evidence must disclose the name of the principal or employer under whom he acts, and establish the existence of such authority in him over the defendant as not only renders him responsible for the acts of the defendant in reference to the invention, but excludes the defendant's voluntary choice from the operative causes of the infringement.[6]

§ 1043. Evidence under the Twentieth Defence: Non-commission of the Infringing Acts During the Life of the Patent.

The twentieth defence denies that the acts of infringement were committed while the patent was in force. The date of the patent, and the term which it purports to cover, appear upon the face of the instrument, and afford *prima facie* evidence that the patent was in force during the entire period described. The plaintiff must prove acts of infringement within that period by such evidence as is suggested in the foregoing paragraph, and this evidence may be contradicted or explained by the defendant without attacking the correctness

the infringing device may not be an infringement and violate an injunction, it is strong evidence thereof and to be overcome by positive proof to the contrary, see Allis *v.* Stowell (1881), 19 O. G. 727.

[5] That the refusal of the defendant to allow his articles or processes to be inspected is evidence of infringement, see Union Paper Bag Mach. Co. *v.* Binney (1871), 5 Fisher, 166.

[6] That a defence of agency must disclose the principal, see American Cotton Tie Supply Co. *v.* McCready (1879), 17 Blatch. 291 ; 4 Bann. & A. 588 ; 17 O. G. 565 ; Morse *v.* Davis (1862), 5 Blatch. 42.

of the patent in this particular. If, however, he asserts that the patent, though apparently in force when these acts were committed, had previously expired, he assumes the burden of proof, and must show either that the patent had been then surrendered or repealed or that its term is erroneously stated in the instrument itself. The method of proving a surrender or repeal has been already considered under those defences.[1] If the term stated in the patent is greater than the seventeen years permitted by the statutes, it is incorrect upon its face and the patent will be held valid only for the lawful period.[2] If the term named in the patent is the one limited by law, a defendant, who claims that it should be restricted on account of a prior foreign patent to the same inventor, must produce the foreign patent covering the invention, or a certified copy thereof from the Patent Office, and establish by sufficient evidence the connection of the plaintiff or his assignor with its prior issue.[3] When the names of the two patentees are identical, the evidence outside the patents must show the identity of the persons named. When the foreign patentee is a different person, the relations between himself and the American patentee, whom he represents, must also be disclosed by evidence of their contracts, correspondence, co-operation in business, participation in profits or expenses, or of any other facts tending to show that the foreign patent issued in the interest of the domestic patentee.[4] This evidence may be contradicted or explained by the plaintiff in the usual manner.

§ 1043. [1] See §§ 907, 908, 978, 1038, 1039, and notes, *ante*.

[2] That where the term as stated in the patent is greater than the law allows, the patent will be in force only during the lawful period, see Bate Refrigerating Co. *v.* Hammond (1889), 129 U. S. 151; De Florez *v.* Raynolds (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140; and § 622 and notes, *ante*.

[3] That the burden of proof is on him who seeks to limit the term of the patent by a foreign patent, and he must show the facts which limit it, see American Diamond Rock Boring Co. *v.* Sheldon (1879), 17 Blatch. 303; 4 Bann. & A. 603.

That where an objection to a patent is based on the taking out of a prior foreign patent the evidence must connect the plaintiff with its issue, see Goodyear Dental Vulcanite Co. *v.* Willis (1874), 1 Flippin, 388; 1 Bann. & A. 568; 7 O. G. 41.

That the plaintiff's patent expired with certain foreign patents is matter for original defence and cannot be introduced in rebuttal, see American Paper Barrel Co. *v.* Laraway (1886), 28 Fed. Rep. 141; 37 O. G. 674.

[4] That the foreign patent must have

§ 1044. Evidence under the Twenty-First Defence: Co-ownership or License.

The twenty-first defence asserts that the acts of the defendant, in making, using, and selling the patented invention, were performed under, and not in violation of, the plaintiff's patent. Upon this defence the plaintiff has the burden of proof and must make out a *prima facie* case. Slight evidence is, however, sufficient for this purpose, such, for example, as his own denial of authority, the defendant having the means at his disposal to clearly prove his right if it exists. When the defendant claims to be a part-owner, assignee, or grantee under the patent, his title must be shown by the written instruments of conveyance or a certified copy from the records in the Patent Office.[1] If he is a licensee under an express written license, the license must be produced, or its absence must be satisfactorily accounted for and parol evidence of its contents given.[2] An absolute license in the possession of the defendant will be presumed to have been

issued to the same inventor, or by his authority, see Edison Electric Light Co. *v.* United States Electric Lighting Co. (1888), 35 Fed. Rep. 134; Kendrick *v.* Emmons (1875), 2 Bann. & A. 208; 9 O. G. 201.

§ 1044. [1] See as to this defence §§ 797, 913–917, 979, and notes, *ante*.

That a title to the patent must be proved by the proper instruments or certified copies thereof, see § 1040 and notes, *ante*.

[2] That a plea of license must be sustained by proof that a license was actually granted, see Tilghman *v.* Hartell (1876), 11 Phila. 500; 9 O. G. 886; 2 Bann. & A. 260.

That negotiations for a license do not prove an actual license, see Tilghman *v.* Hartell (1876), 9 O. G. 886; 11 Phila. 500; 2 Bann. & A. 260.

That a plea of license must be proved as a completed contract, and if proved it ends the case, since the Federal courts cannot inquire into the contract relations of the parties if they are once proved to exist, see Tilghman *v.* Hartell (1876), 9 O. G. 886; 11 Phila. 500; 2 Bann. & A. 260.

That on a suit for infringement the Federal courts may determine whether or not there is a subsisting license, see Hammacher *v.* Wilson (1886), 26 Fed. Rep. 239; 36 O. G. 233.

That on a suit for infringement against a licensee, who has failed to pay royalties as agreed, an excuse for his failure does not raise the question whether his license should be rescinded but whether it still exists, see Hammacher *v.* Wilson (1886), 26 Fed. Rep. 239; 36 O. G. 233.

That if a license is conditional the defendant must perform the conditions, and if he justifies under the license he must show that its conditions were performed, see Brooks *v.* Stolley (1845), 3 McLean, 523; 2 Robb, 281.

regularly executed and delivered, until the contrary appears.[3] An oral license may be proved by any proper testimony. The defendant must also show that his acts were performed by him as such licensee, and not in antagonism to the patent nor under a license derived from a different patent.[4] If the defendant justifies under an implied license he must prove the facts from which the license arises. A license to make may be implied from an express license to use or sell, when the latter rights could not be reasonably enjoyed without the former.[5] A license to use or sell may be implied in like manner from an express license to make, when the power to manufacture would otherwise be without benefit to the licensee.[6] A license to use or sell a specific article may be implied from its sale without restrictions by any person having authority under the patent thus to sell it.[7] A license to employ a specific process arises from the sale, by the owner of the patent for the process, of a device whose sole utility is in connection with that process.[8] In any of these cases the nature and sources of the defendant's evidence are suggested by the facts from which his license is implied. The defendant, having thus offered evidence tending to prove his right to

[3] That an absolute license from the plaintiff, when produced by the defendant, throws on the plaintiff the burden of proving that it was delivered as an escrow, see Mellon *v.* D. L. & W. R. R. Co. (1882), 21 O. G. 1616; 12 Fed. Rep. 640.

[4] That no evidence that the defendant is licensee or owner under a different patent is an excuse for an infringement which appears by comparing his device with the plaintiff's patent, see Blanchard *v.* Putnam (1869), 8 Wall. 420.

That a license given as part of the settlement of a suit is not evidence against a stranger, see Gottfried *v.* Crescent Brewing Co. (1884), 22 Fed. Rep. 433; 30 O. G. 892.

[5] That an express license to use or sell may carry the right to make, see §§ 812, 813, and notes, *ante*.

[6] That an express license to make may carry the right to use or sell, see § 811 and notes, *ante*.

[7] That a lawful sale without restrictions carries the right to use, and sometimes also to sell, see §§ 824–827, and notes, *ante*.

[8] That the purchaser of a machine from the patentee of a process which consists in the operation of the machine may defend against the patent on the ground of license to use the machine and process both, see Downton *v.* Yaeger Milling Co. (1880), 17 O. G. 906; 1 Fed. Rep. 199; 1 McCrary, 26; 5 Bann. & A. 112.

That where the licensed device can be used only in connection with other patented inventions belonging to the same licensor, it may be used in that way, see Roosevelt *v.* Western Electric Co. (1884), 20 Fed. Rep. 724; 28 O. G. 812.

practise the invention, the plaintiff must rebut it, either by denying the existence of the alleged authority on counter evidence, or by showing that the acts of the defendant are not within the scope of the authority conferred. A licensee is an infringer if he assumes a right which his license does not bestow, and even an owner of the patent may violate the monopoly by making, using, or selling an invention which, though not identical with the patented invention, embraces and employs it.[9] It is for the plaintiff to prove that these departures from the lawful use of the invention have been made by the defendant, and to separate his acts of infringement from those which he has properly performed; and this proof may be met and answered by the defendant by showing a wider scope for his authority or a correspondence of his acts with the authority bestowed.[10]

§ 1045. Evidence under the Twenty-Second Defence: Statute of Limitations.

The twenty-second defence is based upon the Statute of Limitations.[1] This defence must be specially pleaded, and the burden of proof on the issues created by such plea rests on the defendant. The nature of the evidence to be adduced depends upon the provisions of the statute. If the period within which actions may be brought commences at the date of the infringement, the testimony concerning the acts of infringement, taken in connection with the record date of

[9] That the part owner of a patent can sue his co-owner for infringement committed by using an infringing device, but not for using the patented one, see Herring *v.* Gas Consumers Association (1878), 9 Fed. Rep. 556; 21 O. G. 203; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253.

[10] That it is for the plaintiff to show that the defendant's use is numerically in excess of his license and amounts to an infringement, see Hodge *v.* Hudson River R. R. Co. (1868), 3 Fisher, 410; 6 Blatch. 85.

That a defendant claiming license has the burden of proof to show that the articles were made and sold under the license, see Searls *v.* Bouton (1882), 12 Fed. Rep. 140; 21 O. G. 1784; 20 Blatch. 426.

That where a defendant sets up a license which is shown to have been violated and revoked before the infringement, the defence will be overruled, and the defendant permitted to defend like other infringers, see Wooster *v.* Singer Mfg. Co. (1883), 23 O. G. 2513.

§ 1045. [1] See as to this defence § 980 and notes, *ante*.

the institution of the suit, will disclose whether the actions were commenced within the time prescribed. If the statute begins to run at the expiration of the patent, the date of such expiration is determined by the statements of the instrument, or by the records of its surrender or repeal, or by the evidence of a prior patent limiting its term, while the files in the action show the date of the commencement of the suit. When the statute contains exceptions preventing its operation in certain cases, the evidence concerning these must correspond on both sides with the issues thus presented.

§ 1046. Evidence under the Twenty-Third Defence: Estoppel.

The twenty-third defence alleges that the plaintiff is estopped, either by matter of record or *in pais*, from maintaining his suit against the defendant. The burden of proof is on the defendant. If the estoppel claimed arises from any written instrument the document itself must clearly exhibit the statements out of which the estoppel flows; and when the plaintiff and defendant are not parties to the instrument, their respective privity to its parties must be shown.[1] An estoppel *in pais* is implied from the actions or omissions of the plaintiff, and when asserted by the defendant he must prove the circumstances on which it is based, and his reliance on the facts thereby suggested as a guide for his own conduct in the use of the invention. The evidence in each case must be suited to the facts alleged. When the defendant claims an estoppel against the plaintiff on the ground that his patented articles were put upon the market without a proper stamp, he may produce the unstamped articles or packages and prove that they were in the market in that condition, or he may show the same state of affairs by evidence from those who know the fact. The plaintiff may reply to this testimony by proving actual notice to the defendant before the date of the infringement.[2]

§ 1046. [1] See as to this defence § 981 and notes, *ante*.

That a document offered to prove admissions by the plaintiff against his right speaks for itself whether in his favor or against him, see Campbell *v.* James (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456.

[2] That under Sec. 13, act of March 2, 1861, the burden of proof is on the

§ 1047. Evidence under the Twenty-Fourth Defence: Release.

The twenty-fourth defence asserts that the cause of action described in the declaration has been released by the plaintiff. The burden of proof on this issue rests upon the defendant. When the release is in writing it must be produced or its absence duly accounted for and its contents proved. When the release is embraced in a broader transaction between the parties, so much of the transaction must be proved as to make it appear that the release was intended by the plaintiff and was made upon a lawful consideration. If there is any reasonable doubt as to its existence, or its applicability to the infringement on which the suit is based, the plaintiff must prevail.[1]

§ 1048. Evidence under the Twenty-Fifth Defence: Res Adjudicata.

The twenty-fifth defence asserts that the cause of action arising out of the infringement has been extinguished by or merged in a judgment. The defendant assumes the burden of proof, and his evidence must show that the same acts of which the plaintiff now complains have been the subject of a prior suit, in which judgment was rendered for the defendant on some point fatal to the cause of action, or for the plaintiff to recover damages, either actual or nominal, for the infringement.[1] The record of the judgment, or a certified copy thereof, must be offered, together with such other evidence

defendant to show the failure of the patentee to stamp as required, then the burden shifts to the patentee to show that the defendant was notified that he was infringing and persisted in so doing, see Goodyear *v.* Allyn (1868), 3 Fisher, 374; 6 Blatch. 33.

§ 1047. [1] See as to this defence § 982 and notes, *ante*.

§ 1048. [1] That a judgment works an estoppel only when the record shows that the particular point in controversy was heard and decided, see Steam Gauge & Lantern Co. *v.* Meyrose (1886), 27 Fed. Rep. 213; 36 O. G. 1477.

See also §§ 983, 1175–1188, and notes, *post*.

That a defendant, parting with his interest in the infringing business during suit, but without change of parties on the record, is bound by the decree, see Gloucester Isinglass & Glue Co. *v.* Le Page (1887), 30 Fed. Rep. 370.

That an absolute decree on the merits binds the parties, see Lyon *v.* Perin & Gaff Mfg. Co. (1888), 43 O. G. 983.

That a new defence set up by a party to several prior suits should be proved beyond reasonable doubt, see Seibert Cylinder Oil-Cup Co. *v.* Michigan Lubricator Co. (1888), 34 Fed. Rep. 33.

as may be necessary to connect the plaintiff and defendant with the contestants in the former suit, either by showing that they are the same parties or that they are in privity with them.

§ 1049. Evidence Concerning Damages.

The special rules of evidence discussed in the preceding paragraphs are applicable to the first four of the five averments in the declaration, — the invention of the patentable subject-matter by the patentee or his assignor, the lawful issue and existence of the patent, the title of the plaintiff, and the infringement of the patent by the defendant. The fifth averment declares that the infringement has resulted in damage to the plaintiff; and of the evidence admissible upon the issue raised by this averment it is impossible to treat intelligibly until the principles which govern the award of damages have been considered. These principles are few and simple, and though the topic has been long regarded as one of the most confused and difficult in the whole body of our Patent Law, the careful distinguishing of one subject from another will relieve it of much of its obscurity, and indicate the proper rules to be observed in fixing the amount to which the plaintiff is entitled in every case that may arise.

§ 1050. Distinction between the Rule of Damages at Law and the Measure of Recovery in Equity.

The first distinction to be made is that between the measure of recovery in equity and the measure of recovery at law. The theory of a suit in equity for an infringement is entirely different from that at law. The accountability of the defendant rests upon grounds totally dissimilar, and imposes upon him obligations utterly unlike those which he sustains in an action at law. This is especially apparent in the rules by which the amount of his pecuniary liability to the plaintiff is determined. In law he is regarded as a mere wrong-doer, compelled to make compensation for the injury he has inflicted. In equity he has a double character, being first treated as a species of agent or trustee practising the invention for the benefit of its true owner and obliged to pay to

him the profits of the enterprise, and then, if in the judgment of the court the interests of the plaintiff so require, mulcted as a tort-feasor in a sum sufficient to redress the injury which the plaintiff has sustained.[1] This wide and fundamental dis-

§ 1050. [1] In Birdsall *v.* Coolidge (1876), 93 U. S. 64, Clifford, J.: (68) "Controversies and cases arising under the Patent Laws are originally cognizable, as well in equity as at law, by the circuit courts, or by any district court having circuit powers. Prior to the passage of the act of the 8th of July, 1870, two remedies were open to the owner of a patent whose rights had been infringed, and he had his election between the two. He might proceed in equity and recover the gains and profits which the infringer had made by the unlawful use of his invention, the infringer in such a suit being regarded as the trustee of the owner of the patent as respects such gains and profits; or the owner of the patent might sue at law, in which case he would be entitled to recover, as damages, compensation for the pecuniary injury he suffered by the infringement, without regard to the question whether the defendant had gained or lost by his unlawful acts; the measure of damages in such case being not what the defendants had gained, but what the plaintiff had lost. (Curtis on Pat., 4th ed. 461; 5 Stats. at Large, 123.) When the suit is at law, the measure of damages remains unchanged to the present time, the rule still being that the verdict of the jury must be for the actual damages sustained by the plaintiff, subject to the right of the court to enter judgment thereon for any sum above the verdict, not exceeding three times that amount, together with costs. (16 Stat. 207.) Damages of a compensatory character may also be allowed to the complainant suing in equity in certain cases, where the gains and profits made by the respondent are clearly not sufficient to compensate the complainant for the injury sustained by the unlawful violation of the exclusive right secured to him by the patent. Gains and profits are still the proper measure of damages in equity suits, except in cases where the injury sustained by the infringement is plainly greater than the aggregate of what was made by the respondent, in which event the provision is that the complainant shall be entitled to recover, in addition to the profits to be accounted for by the respondent, the *damages* he has sustained thereby." 10 O. G. 748 (750).

In Goodyear Dental Vulcanite Co. *v.* Van Antwerp (1876), 2 Bann. & A. 252, Nixon, J.: (254) "The terms *profits* and *damages* as used in the act are hardly convertible. They seem to mean different things. The latter are to be awarded '*in addition*' to the former. Profits, doubtless, refer to what the defendant has gained by the unlawful use of the patented invention, and damages to what the complainant has lost. Before the act of 1870 it was incumbent on the patentee to make his election of remedies, and to proceed at law for the damages which he could show had been sustained from the infringement, or in equity for the gains and profits that the defendant had realized for the unauthorized use of his property. Now no such election is necessary, because he is entitled to pray in one action for the relief both in regard to profits and damages." 9 O. G. 497 (498).

In Cowing *v.* Rumsey (1870), 4 Fisher, 275, Woodruff, J.: (277) "A patentee whose rights are infringed has

tinction leads to radical differences in the standards by which the court or jury are to estimate the amounts to be awarded, and in the rules by which the relevancy and weight of evidence concerning these amounts must be determined. The principles adopted in the courts of equity cannot be imported into the courts of law, or those of law into equity, without serious confusion and inevitable mistake. Nor can the definitions and modes of calculation recognized in one tribunal be followed by the other without equally disastrous consequences. Decisions in which this essential distinction has been disregarded have been rendered, and to these may be attributed much of the difficulty which besets the legal aspect of this subject. It is, therefore, of primary importance that in discussing damages at law, or profits and damages in equity, each topic should be kept free from the special doctrines appertaining to the other, and that the former be investigated in the light of its own principles as these have been interpreted and applied in courts of law.

his election of remedies. He may treat the infringer who illegally appropriates the invention to his own use, making profit thereby, as his trustee in respect of such profits, and compel him to account therefor in equity. In such case the plaintiff may recover those profits, be they more or less; and he can recover no more, however great the damages may be which the illegal interference has occasioned. If, on an accounting, it should appear that the defendant used the invention so unskilfully that he realized no profit, there could be no recovery. On the other hand the patentee may sue at law for the damages which he has sustained; and those damages he is entitled to recover whether the defendant has made any profits or not. In such an action it is precisely what is lost to the plaintiff, and not what the defendant has gained, which is the legal measure of the damages to be awarded. Under this rule it may often be entirely proper to prove the profits of the ordinary use of the invention, and the demand existing in the market, evidenced by sales made, and so, as an element of consideration, show the profits realized by the defendant, in order to furnish to the jury all proper materials for determining how much the plaintiff has lost. But I apprehend that they are to answer the precise question — how much loss has the plaintiff sustained by reason of the defendants' infringement?" 8 Blatch. 36 (38).

The statement in the foregoing extracts, that the plaintiff has an election of remedies, is qualified by more recent cases. See §§ 1084–1094, and notes, *post*.

§ 1051. Distinction between the Rule of Damages and the Rules of Evidence concerning Damages.

Another essential distinction, which is too often overlooked, is that between the rule of damages in actions at law and the rules governing the evidence by which the amount of damages is to be ascertained. The rule of damages is fixed and uniform, as much so as in any ordinary action on the case. It recognizes two species of damages, — nominal and actual. It determines definitely when nominal damages shall be awarded, and when actual damages shall be allowed. It establishes the same measure for the latter as that which courts of law adopt in all breaches of contract as well as in all other torts. But inasmuch as the infringement of a patent may inflict injuries of various degrees and characters, according to the method of infringement or the mode in which it reaches and affects the plaintiff, the evidence by which his loss is proved, and the amount of his recovery is determined, must also be of great variety. No more unalterable rule can, therefore, be prescribed concerning the admissibility or weight of certain evidence, or the bearing of certain facts upon the question of damages, in actions of infringement than in actions of trespass *quare clausum*, or of general assumpsit.[1] Each case must stand on its own facts, and be illustrated by its own evidence, admitted and weighed in accordance with the general rules of relevancy and credibility.[2] With this distinction

§ 1051. [1] In Graham *v.* Mason (1872), 5 Fisher, 290, Shepley, J. : (293) "It must be apparent to the most superficial observer of the immense variety of patents issued every day, that there cannot, in the nature of things, be any rule of damages or any rule for estimating profits which will equally apply to all cases. The mode of estimating profits or damages must necessarily depend on the peculiar nature of the monopoly granted. (Seymour *v.* McCormick, before cited.) Where the patentee is entitled to damages, the rule must be so modified as to afford him indemnity and give him the actual damage he has suffered by the infringement. Where he is entitled to profits, he is entitled to any profit the infringer has made by the unlicensed use of the contrivance included in the monopoly, and of that alone, without regard to profit or loss on the whole structure or machine of which such mechanism forms a part, and without recoupment for losses on other infringing mechanisms made or sold." 1 O. G. 609 (610) ; Holmes, 88 (90).

See also Bell *v.* Daniels (1858), 1 Fisher, 372 ; 1 Bond, 212 ; Ransom *v.* Mayor of New York (1856), 1 Fisher, 252 ; Earle *v.* Sawyer (1825), 4 Mason, 1 ; 1 Robb, 490.

[2] That in estimating damages all the

in mind, the rule of damages in actions at law for infringement loses most of its obscurity, while even the rules of evidence seem capable of clearer and more permanent definition than those applied in many other actions. To this rule of damages our attention will now be directed, after which the rules of evidence will be considered.

§ 1052. Rule of Nominal Damages.

The rule of damages requires that in all cases where the jury find the issues for the plaintiff on the first four averments of the declaration, they shall award him at least nominal damages.[1] The law implies damage from the violation of the patent, and though the infringement may be ignorant or unintentional, or result in no particular injury to the plaintiff, the commission of the wrong entitles him to some recovery in vindication of his invaded rights.[2] The amount of such recovery the jury are at liberty to determine within the ordinary limits of nominal damages.[3]

§ 1053. Rule of Actual Damages.

The rule of damages further provides that, upon proper evidence, the jury shall allow the plaintiff actual damages.[1]

circumstances must be considered, see Whitney *v.* Emmett (1831), Baldwin, 303; 1 Robb, 567.

§ 1052. [1] In Poppenhusen *v.* New York Gutta Percha Comb Co. (1858), 2 Fisher, 62, Ingersoll, J.: (73) "When a patent has been violated, it necessarily follows that the plaintiff is entitled to some damages. The act of violation is proof that he is entitled to some damages; and when the amount of damages is not proved, the rule is, that the jury give nominal damages; and if the plaintiff intends to claim more than nominal damages, he, being entitled to recover his actual damages, must satisfy the jury what his actual damages are."

[2] That damages are implied from the infringement, see Wooster *v.* Muser (1884), 28 O. G. 286; 20 Fed. Rep. 162; Campbell *v.* Barclay (1870), 5 Bissell, 179; Whittemore *v.* Cutter (1813), 1 Gallison, 429; 1 Robb, 28.

That the character and financial condition of the parties are not to be considered in estimating damages, see Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86.

That the good faith of the defendant does not excuse him, see Hogg *v.* Emerson (1850), 11 How. 587.

[3] That six cents are nominal damages, see Hall *v.* Bird (1869), 6 Blatch. 438; 3 Fisher, 595.

§ 1053. [1] That a patentee proving his case is entitled to the same relief as any other plaintiff, see McComb *v.* Ernest (1871), 1 Woods, 195.

That actual damages alone will be awarded, see Philp *v.* Nock (1873), 17

Actual damages are an indemnity for injury inflicted, a compensation for a loss sustained.[2] Their amount is to be measured by the direct and immediate evil consequences to the plaintiff of the wrongful act of the defendant, from the date of the infringement to the institution of the suit.[3] The proof

Wall. 460; Page *v.* Ferry (1857), 1 Fisher, 298; Whitney *v.* Emmett (1831), Baldwin, 303; 1 Robb, 567.

[2] In Birdsall *v.* Coolidge (1876), 93 U. S. 64, Clifford, J.: (64) "Damages are given as a compensation, recompense, or satisfaction to the plaintiff for an injury actually received by him from the defendant. Compensatory damages and actual damages mean the same thing, — that is, that the damages shall be the result of the injury alleged and proved, and that the amount awarded shall be precisely commensurate with the injury suffered, neither more nor less, whether the injury be to the person or estate of the complaining party. 2 Greenl., Ev., 10th ed., sec. 253." 10 O. G. 748 (749).

In Parker *v.* Hulme (1849), 1 Fisher, 44, Kane, J.: (56) "The damages to be assessed should be compensatory. The criterion is indemnity. You may take into consideration the loss sustained by the plaintiff, as you may likewise the profit made by the defendant. In estimating the loss to the plaintiff from the defendant's unauthorized use of the machine, the price of a license is sometimes a fair guide; but not always. Sometimes a trifle from every one may well content the patentee, as in the case of a medicine, where a license to use is thrown in to all who will pay for the dose. So in the case of machines; in some of which, as for example, an improved pocket-knife or comb, where a half-cent, singly, might amply compensate a patentee in the sale of a license, but would be no criterion of damage in case of infringement. It is so with every other invention which depends, for its value, on a general use by the community, and is, from policy, sold cheap. You are therefore to give compensatory damages, such as may indemnify the plaintiff for the injuries he has directly sustained; but, according to the directions heretofore given in this court, you will not include his expenses of litigation in the amount of your verdict. Yet, upon the whole, the question of damages being one of compensation, of which it is always, in such cases, difficult to fix a standard, much must depend upon the discretion of the jury, who may sometimes properly take the conduct and motives of a defendant into consideration. I may add that, with the limitations and qualifications which I have stated, your verdict may be founded upon a full and liberal measure of the plaintiff's actual damages."

[3] That only direct and immediate damages can be recovered, see Buerk *v.* Imhaeuser (1876), 10 O. G. 907; 14 Blatch. 19; 2 Bann. & A. 452.

That remote consequential damages cannot be recovered, see Carter *v.* Baker (1871), 4 Fisher, 404; 1 Sawyer, 512.

That the jury in estimating damages from general evidence can only allow them for the period of infringement not for the whole term of the patent, see Suffolk Co. *v.* Hayden (1865), 3 Wall. 315.

That damages are recoverable for the period between loss of the patent by fire and its restoration, if there be no unreasonable delay, see Hogg *v.* Emerson (1848), 6 How. 437; 2 Robb, 655.

That damages for infringement before re-issue are not recoverable in a

of the existence and extent of these consequences must be clear and definite, and present sufficient data to the jury to enable them to estimate with certainty the compensation to which the plaintiff is entitled.[4] In the absence of such proof, either through the fault or the misfortune of the plaintiff, nominal damages alone can be awarded.[5] Vindictive damages are not permitted, power being conferred upon the court to increase the amount fixed by the jury in cases of malicious or persistent injury.[6]

suit on the re-issue, see Agawam Co. *v.* Jordan (1868), 7 Wall. 583.

That a verdict can only cover the damages up to the date of the writ, see Hayden *v.* Suffolk Mfg. Co. (1862), 4 Fisher, 86.

[4] That the plaintiff must affirmatively show the amount of actual damages, see § 1071 and notes, *post.*

[5] That nominal damages of six cents only are recoverable unless actual damages are proved, see Hall *v.* Bird (1869), 6 Blatch. 438 ; 3 Fisher, 595.

That although it is a mere lack of evidence which prevents the plaintiff from proving such infringements as would call for heavy damages, this is his misfortune, and the jury can only give nominal damages unless he proves actual ones, see Schwarzel *v.* Holenshade (1866), 3 Fisher, 116 ; 2 Bond, 29.

[6] In Whittemore *v.* Cutter (1813), 1 Gallison, 478, Story, J. : (482) "As to the rule by which the plaintiff's damages are to be estimated, it is clear by the statute, that only the actual damages sustained can be given. By the terms '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 rights. In mere personal torts, as assaults and batteries, defamation of character, etc., the law has, in proper cases, allowed the party to recover not merely for any actual injury, but for the mental anxiety, the public degradation and wounded sensibility, which honorable men feel at violations of the sacredness of their persons or characters. But the reason of the law does not apply to the mere infringement of an incorporeal right, such as a patent, and the legislature meant to confine the damages to such a sum as would compensate the party for his actual loss." 1 Robb, 40 (44).

See also Goodyear *v.* Bishop (1861), 2 Fisher, 154 ; Smith *v.* Higgins (1859), 1 Fisher, 537 ; Ransom *v.* Mayor of N. Y. (1856), 1 Fisher, 252 ; Wintermute *v.* Redington (1856), 1 Fisher, 239 ; Hall *v.* Wiles (1851), 2 Blatch. 194 ; Buck *v.* Hermance (1849), 1 Blatch. 398 ; Guyon *v.* Serrell (1847), 1 Blatch. 244.

In several decisions statements may be found giving authority for the claim that vindictive damages may be awarded in cases of wilful infringement. Thus in Parker *v.* Corbin (1848), 4 McLean, 462, McLean, J. : (463) "That where the act complained of had been done without a knowledge of the plaintiff's right, and under such circumstances as to authorize the jury to infer that the defendant was not aware that he was

§ 1054. Rules of Evidence Concerning Damages Vary with the Mode in which the Plaintiff takes the Benefit of his Monopoly.

The rules of evidence concerning damages are all intended to secure the presentation of such testimony to the jury as will enable them to ascertain the loss inflicted on the plaintiff, and the amount of actual damages which will compensate him for the injury. The evil consequences resulting to the plaintiff from the violation of his patent depend upon the method in which he receives the benefits of his monopoly, and the extent to which these benefits are affected by the infringement.[1] The owner of a patent who neither derives, nor purposes to derive, any advantage from his rights under

violating the rights of any one, the damages should be so graduated as to give nothing more than to compensate the injury done to the plaintiff. But where the circumstances were of a somewhat aggravated character, what was sometimes called in the law vindictive damages might be given, which would include counsel fees, and something more by way of example to deter others from doing the same thing." 2 Robb, 736 (736).

See also Buerk *v.* Imhaeuser (1876), 10 O. G. 907; 14 Blatch. 19; 2 Bann. & A. 452; American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439; Bryce *v.* Dorr (1845), 3 McLean, 582; 2 Robb, 302.

That no exemplary damages are allowed where the defendant purchased the invention in good faith in open market not knowing of the patent, and abandoned it upon notice, see Emerson *v.* Simm (1873), 3 O. G. 293; 6 Fisher, 281.

That one who works under another patent is not liable to punitive damages, see Buerk *v.* Imhaeuser (1876), 10 O. G. 907; 14 Blatch. 19; 2 Bann. & A. 452.

The power of the court to increase the damages is, however, sufficient for all the purposes of a penalty, and so far as these cases suggest that the jury have a similar power, the doctrine must be regarded as erroneous. See, further, § 1069, and notes, *post*.

§ 1054. [1] In Spaulding *v.* Page (1871), 4 Fisher, 641, Sawyer, J.: (645) "One patentee may choose to use his invention himself, and find his profits in the sale of its products; another may establish a royalty for the use of his patent; another sell his right out for designated portions of territory; and another exclusively manufacture and sell his machines and seek his remuneration in the profits of such manufacture and sale. The measure of damages, and the consequences of a recovery, should have some relation to the mode of remuneration adopted by the patentee, and to the nature of the injury inflicted by the infringement. Even the consequences of a recovery with respect to the subsequent rights of the parties, may be modified by the measure of damages adopted." 1 Sawyer, 702 (705).

That the monopoly protects only the *use* of the invention, not the ultimate property therein, see § 61 and notes, *ante*.

the patent, cannot sustain substantial injury from any appropriation of the invention on the part of others.[2] If he confines his own enjoyment of his privilege to a single mode of use, he does not suffer loss from the employment of the invention in a totally different method. Hence the first point, on which proof should be offered in reference to actual damages is the use made of his patent privilege by the plaintiff; the second is the effect produced upon the value of such use by the wrongful acts of the defendant. If the evidence on these two points is so presented as to afford the jury a complete view of the facts which they involve, the amount of actual damages to be awarded can be easily determined.

§ 1055. Evidence Concerning Damages: Two Modes in which the Plaintiff may Take the Benefit of his Monopoly.

The methods by which the owner of a patent can avail himself of his monopoly may be grouped in two distinct classes. In methods of the first class the practice of the patented invention is thrown open to the public upon condition that the user pay to the owner a definite pecuniary consideration. In methods of the second class the exclusive use of the invention is confined to the owner of the patent or to specific licensees, and the remainder of the public are prohibited from its employment upon any conditions.[1] When any method of

[2] That a patentee, who neither derives nor intends to derive benefit from his invention, cannot suffer loss by its infringement, see Everest *v.* Buffalo Lubricating Oil Co. (1887), 31 Fed. Rep. 742; Hoe *v.* Knap (1886), 27 Fed. Rep. 204; 36 O. G. 1244; Whitney *v.* Emmett (1831), Baldwin, 303; 1 Robb, 567.

§ 1055. [1] The distinction between these two modes of enjoyment will be lost sight of unless it be remembered that the former embraces only those cases where the license is universal. The patentee has a right to limit the number of his licensees, and where he does this, no other persons can become licensees against his will. The number of his specific licensees is immaterial. However great their multitude, the patent protects them in their exclusive enjoyment against all the world, and one who uses without authority granted to him violates the monopoly, and cannot be regarded as in any sense a licensee. In such cases a license fee is never the measure of damages; if it were, the patentee could be compelled to grant licenses against his will to all on the mere ground that he had chosen to license certain individuals. It is only where he offers licenses to all who desire to take them, without discrimination of persons, that an infringer can be treated as a licensee, and the recovery be restricted to the customary fee.

the first class is adopted, it is evident that the sole injury sustained by the owner of the patent from the act of a defendant, who has practised the invention without fulfilling the condition, is the withholding of the definite pecuniary recompense, and that this, when ascertained, is therefore the measure of his actual damages. When methods of the second class are pursued, the loss suffered by the owner of the patent or his specific licensees, is the depreciation of the pecuniary value of their own enjoyment of the exclusive use of the invention through its wrongful use by the defendant. The amount of such depreciation can rarely be measured by any absolute standard. It is a matter of inference from all the circumstances of the case; but when the facts are clearly proved, and the inference is probable, the jury are warranted in assuming it as a sufficient guide. The owner of the patent may resort to methods of either class at his pleasure, and may employ the different classes within different areas. He may also adopt the methods of one class in relation to one of his exclusive rights, and the methods of the other class in relation to his other rights, as where he freely licenses all who desire to make and use the invention, but preserves a close monopoly in reference to its manufacture and sale. But he cannot employ methods of the distinct classes in relation to the same right at the same time and within the same territory, since it is impossible for him at once to offer to the whole public an unrestricted privilege upon definite terms, and prohibit portions of the public from enjoying it on any terms. Hence in any case of infringement it can be shown which class of methods was in operation, at the date

Hence evidence of numerous existing licenses, though, as appears in § 1057, *post*, it is sufficient to prove the amount of the established fee, cannot show that an infringer, even when performing acts for which the licenses are granted, has a right to pay the fee and thus escape further liability. It must be also manifest from the testimony that the plaintiff, at the date of the infringement, contemplated the enjoyment of the invention by the public, and by the defendant as a member of the public, and that the sole wrong committed by the latter has, therefore, virtually consisted in delaying the payment of the proper recompense for such a privilege. In the absence of this testimony the case comes under the second class, and the license fee, whatever light it may throw upon the amount of the plaintiff's loss by the infringement, cannot be accepted as an absolute measure of damages.

and place of the infringement, in reference to the right wrongfully exercised by the defendant. If the method belonged to the first class the defendant must make compensation by paying the established fee. If it belonged to the second class the defendant must make good that depreciation in the value of the plaintiff's enjoyment which his own wrongful act has caused.[2]

§ 1056. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses.

Of the methods of the first class there are various forms, though all are reducible to the same contract relation between the owner of the patent and those who practise the invention. Whether he bestows on all who wish to comply with his conditions the right to make and use or the right to make and sell, and whether he receives his payments in a gross sum, or in periodical instalments, or in royalties based on the number of the patented articles that may be used or sold, and whether the privilege already conferred be personal and universal, or confined to a single shop or locality, the principle underlying the transaction is the same. The owner of the patent has put his own price upon the exercise of the right, and offered it to all who are disposed to pay the price for its enjoyment.[1] He has thus fixed the measure of his compensation for every case in which the right so estimated may be exercised, and the defendant's employment of the privilege may, therefore, be properly and fairly treated as an acceptance of the offer and as constituting the basis of an implied contract upon his part to pay the customary fee.[2] He has, in fact, become by his own act,

[2] That the value of the plaintiff's invention is determined by the way he uses it, whether by licensing or manufacturing, see Creamer *v.* Bowers (1888), 35 Fed. Rep. 206; Spaulding *v.* Page (1871), 4 Fisher, 671; 1 Sawyer, 702; Burr *v.* Duryee (1862), 2 Fisher, 275.

That the grantor of an exclusive license at a specific royalty can sustain no damage except the loss of his royalty, whatever his licensees may suffer, see Bell *v.* United States Stamping Co. (1887), 32 Fed. Rep. 549.

§ 1056. [1] That by establishing a license fee the plaintiff fixes the compensation which he is willing to receive, see Livingston *v.* Jones (1861), 2 Fisher, 207; 3 Wall. Jr. 330; Seymour *v.* McCormick (1853), 16 How. 480.

[2] That by using the invention, as licensees in general use it, the defendant

though not perhaps intentionally, the licensee of the owner of the patent under the terms contained in the proposition of the latter to the public, and is bound, like any other licensee, to comply with the obligations which he has thereby assumed.[3] In order to establish this, or any other contract relation, two matters must be proved: the offer by the plaintiff; and its acceptance by the defendant. In the absence of either of these elements no such relation can be implied, and the defendant is neither obliged to pay, nor the plaintiff to receive, any predetermined sum as compensation for the infringement.

§ 1057. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses: Evidence that the Plaintiff has Adopted that Mode of Enjoyment.

The proposal of the owner of a patent to permit the public to enjoy a right in his invention, upon payment of a definite pecuniary consideration, may be proved either by his formal declarations to that effect, or by his conduct in customarily receiving this specific compensation. To show his formal declarations, his circulars, advertisements, or oral propositions, if such exist, are admissible. To prove his customary reception of a definite recompense, the testimony must demonstrate that this amount has generally been paid by those who have exercised the right, in pursuance of an agreement previously made with the owner of the patent, until it has become an established fee.[1] What constitutes a general use

accepts the offer of the plaintiff and becomes liable for the customary fee, see Livingston *v.* Jones (1861), 3 Wall. Jr. 330; 2 Fisher, 207; Seymour *v.* McCormick (1853), 16 How. 480.

[3] That a license fee fixes the amount of damages where there have been licenses enough issued to establish a market value, and where the use by the defendant has been with the express or implied consent of the plaintiff, and no compensation has been agreed on, see Packet Co. *v.* Sickles (1873), 19 Wall. 611.

§ 1057. [1] In Rude *v.* Westcott (1889), 130 U. S. 152, Field, J. (165): "It is undoubtedly true that where there has been such a number of sales by a patentee of licenses to make, use, and sell his patents, as to establish a regular price for a license, that price may be taken as a measure of damages against infringers. . . . Sales of licenses, made at periods years apart, will not establish any rule on the subject and determine the value of the patent. Like sales of ordinary goods they must be common, that is, of frequent occurrence, to establish such a market price for the article

and payment, and after what period the fee customarily paid shall be regarded as established, are questions for the jury to determine. A single license cannot show a custom, nor can a license fee, varying with the obstinacy of the licensee, ever become definite, nor can promises to pay be taken as equivalent to actual payments.[2] The essential legal requisite, however, is that the amount be fixed by previous agreement with a view to future use, and under circumstances where the owner of the patent is at liberty to demand what he deems a

that it may be assumed to express, with reference to all similar articles, their salable value at the place designated. In order that a royalty may be accepted as a measure of damages against an infringer, who is a stranger to the license establishing it, it must be paid or secured before the infringement complained of, it must be paid by such a number of persons as to indicate a general acquiescence in its reasonableness by those who have occasion to use the invention, and it must be uniform at the places where the licenses are issued."

That an established royalty is a proper measure of damages, but not where the invention has been used but little or for a short time, general evidence being necessary in such cases, see Judson *v.* Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539.

That a license fee does not become "established" until sufficient cases arise to fix the market value of the patent at a uniform rate, see Adams *v.* Bellaire Stamping Co. (1886), 28 Fed. Rep. 360; 36 O. G. 567; Packet Co. *v.* Sickles (1873), 19 Wall. 611.

That a license fee to be a measure of damages must be a fee for the identical invention, and it alone, see Adams *v.* Bellaire Stamping Co. (1886), 28 Fed. Rep. 360; 36 O. G. 567.

That license fees paid for two patents jointly will not establish a fee for either separately, see Vulcanite Paving Co. *v.* American Artificial Stone Pavement Co. (1888), 36 Fed. Rep. 378; Adams *v.* Bellaire Stamping Co. (1886), 28 Fed. Rep. 360; 36 O. G. 567; Westcott *v.* Rude (1884), 19 Fed. Rep. 830; 27 O. G. 719.

[2] That a single license cannot establish a license fee, see Graham *v.* Piano Mfg. Co. (1888), 35 Fed. Rep. 597; Westcott *v.* Rude (1884), 19 Fed. Rep. 830; 27 O. G. 719.

That two licenses may evidence an established fee, see Cary *v.* Lowell Mfg. Co. (1889), 37 Fed. Rep. 654.

That no license fee can be said to be fixed when it varies with the persistence of the infringer, see Black *v.* Munson (1877), 14 Blatch. 265; 2 Bann. & A. 623.

That where an assignee is compelled by the acts of the defendant to allow him to use the invention for a certain royalty, the royalty is no criterion of the damages, see American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

That the allowance of a *pro rata* sum as damages in a suit does not establish a license fee, see Graham *v.* Piano Mfg. Co. (1888), 37 Fed. Rep. 597.

That a license fee must be shown by actual payments, not by mere promises to pay, see Adams *v.* Bellaire Stamping Co. (1886), 28 Fed. Rep. 360; 36 O. G. 567.

fair compensation, and the alleged licensees are free to accept or reject his terms.[3] A fee of small amount temporarily adopted in order to introduce the invention, or to raise money under the pressure of necessity, does not comply with this requirement; nor, on the other hand, does a large amount paid under compulsion by infringers in settlement for injuries inflicted by their wrongful acts; and evidence of either of these payments under emergency is inadmissible.[4] The amount of

[3] In National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514, Woods, J.: (517) "I instruct you that it is competent for a patentee, in order to enable the jury to measure his damages, to prove contract prices at which licenses had been granted under the patent while it was in force, but that it is not competent for him to prove the prices paid for infringements; that is to say, payments made in settlement of infringements already perpetrated. In order to be competent evidence of value, the prices agreed upon must have been fixed with regard to future use, when, there being no liability between the parties, they are presumed, on both sides, to have acted voluntarily, and therefore to have made up their minds deliberately as to what was a fair price. Such arrangements, licenses thus granted, fees thus fixed, are competent evidence to consider in determining what the actual value of an invention is, and what the recovery ought to be for its use. But settlements for past transactions, where the parties are liable to suit if they do not pay, I instruct you, are not admissible as evidence for the plaintiff upon the subject of value." 28 O. G. 1007 (1008).

[4] In Campbell *v.* Barclay (1870), 5 Bissell, 179, Blodgett, J.: (179) "The price for which the plaintiff has sold his rights to certain territory is no criterion by which to determine the value of his patent or the damage sustained by its infringement in the territory retained. Inventors are frequently compelled by stress of poverty, or force of circumstances, to dispose of some part of their rights in the thing invented at much lower rates than they and others know them to be worth. The fact that the inventor has sold or given away some portion of a patented right is no justification to another who has wrongfully infringed upon the rights retained."

That early contracts at varying rates do not establish a license fee, see Gottfried *v.* Crescent Brewing Co. (1884), 30 O. G. 892; 22 Fed. Rep. 433.

That agreements to secure the introduction of an invention do not furnish a guide to true license fees, see Graham *v.* Geneva Lake Crawford Mfg. Co. (1885), 32 O. G. 1603; 24 Fed. Rep. 642; Sickels *v.* Borden (1856), 3 Blatch. 535.

That special permits under special circumstances do not alter the usual license fee, see Asmus *v.* Freeman (1888), 34 Fed. Rep. 902.

That a grantee of territory, making a contract with an agent to sell machines without limit, repudiates a close monopoly and his damages must be measured by the usual fee, see Burdell *v.* Denig (1865), 2 Fisher, 588.

That payments made in settlement of suits for infringement do not establish a license fee, see Cornely *v.* Marckwald (1889), 131 U. S. 159; Rude *v.* Westcott (1889), 130 U. S. 152; United Nickel Co. *v.* Central Pacific R. R. Co. (1888), 36 Fed. Rep. 186; Cornely *v.*

an established license fee may be shown by parol, though the licenses by which it is fixed are in writing, and the defendant was not a party to the instruments, the important fact being the payment of the fee.[5]

§ 1058. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses: Evidence that the Defendant's Acts are Identical with those Covered by such Licenses.

The acceptance of the plaintiff's proposal by the defendant must be proved by evidence showing his performance of the precise act for which the license fee has been established. Not every invasion of the monopoly by the defendant subjects him to the payment of this fee or entitles him to claim that the plaintiff's damages are to be limited to that amount. It is only when he has put himself in the same position which he would have occupied had he been a licensee under a previous agreement, that he can be held liable to the obligations, and can avail himself of the immunities, of such a licensee. Thus where the license fee has been established in regard to one right under the patent and he has exercised a different right, or where it contemplates a continuous and permanent employment of the invention and his employment of

Marckwald (1885), 23 Blatch. 163; 32 Fed. Rep. 292; Gottfried *v.* Crescent Brewing Co. (1884), 22 Fed. Rep. 433; 30 O. G. 892.

That where the plaintiff had settled with certain infringers for less than the usual license fee, the amount so paid may in some cases be taken as the measure of damages, see Yates *v.* St. Johnsbury & L. C. R. Co. (1887), 32 Fed. Rep. 628.

That a license fee cannot be fixed by settlements between the plaintiff and other infringers, where various amounts are received or where other circumstances show that there is no regular fee, see Matthews *v.* Spangenberg (1882), 14 Fed. Rep. 350.

[5] That the amount of the license fee may be shown by parol though the license is in writing, if the defendant is not one of the parties to the license, see Wooster *v.* Simonson (1884), 20 Fed. Rep. 316; 28 O. G. 918.

That a rescinded contract for royalties is not competent evidence as to the measure of damages, see Bussey *v.* Excelsior Mfg. Co. (1880), 17 O. G. 744; 1 Fed. Rep. 640; 1 McCrary, 161; 5 Bann. & A. 135.

That a revoked or abandoned license may show what value an inventor puts upon the right to use his invention, see Graham *v.* Geneva Lake Crawford Mfg. Co. (1885), 32 O. G. 1603; 24 Fed. Rep. 642.

That evidence of license fees charged or sales made to others is admissible to show the value of the invention to the plaintiff, but is not conclusive, see Gottfried *v.* Crescent Brewing Co. (1884), 30 O. G. 892; 22 Fed. Rep. 433.

it has been short or infrequent, his acts do not fall within the scope of the proposed license and do not create a contract relation between him and the plaintiff.[1] If the owner of the patent, for example, grants licenses to make and use the patented invention, but retains the exclusive right to make and sell, a wrongful sale by the defendant cannot be contemplated as within the license, nor the loss which it inflicts upon the plaintiff be measured by the amount of the established fee.[2] If a different fee is fixed as the compensation for the enjoyment of each different right, and the defendant exercises either alone, the fee established for the other is irrelevant. When the license fee is a gross sum, whose payment authorizes the enjoyment of the invention during the term of the patent or for any considerable period, and the defendant's use has been brief and limited, or when the use of several connected inventions is covered by an indivisible fee and but one of these inventions is employed by the defendant, or where he uses only a part of an invention to which, as a whole, a single compensation is attached, the customary price ceases to afford an exact criterion of the amount of loss incurred, or of the damages to be paid.[3] In all such cases the actual dam-

§ 1058. [1] That a license fee for the whole invention is no measure of damages when only a part is infringed, but further evidence must be given to show the value of the part employed, see Wooster *v.* Simonson (1883), 16 Fed. Rep. 680.

[2] That a license fee for the use of an invention is no measure of the damage caused by an infringing sale, see Colgate *v.* Western Electric Mfg. Co. (1886), 28 Fed. Rep. 146; 37 O. G. 893.

That a royalty for a license to sell the right to use does not show the value of a right to sell, see Colgate *v.* Western Electric Mfg. Co. (1886), 37 O. G. 893; 28 Fed. Rep. 146.

That a use under two Claims must be of more value than a use under one, and a license fee covering both does not show the value of either, see Westcott *v.* Rude (1884), 27 O. G. 719; 19 Fed. Rep. 830.

[3] In Judson *v.* Bradford (1878), 16 O. G. 171, Clifford, J.: (174) "Frequent cases arise where proof of an established royalty furnishes a pretty safe guide for the instructions of the court and the finding of the jury; but cases also arise where it cannot be applied without qualification, as where the patented improvement has been used only to a limited extent, and for a very short period. Proof of a single license was given in this case, but it cannot, in view of the circumstances, be regarded as affording the only measure of compensation to which the plaintiff is entitled. Where there is proof of an established license fee, it may, in case of protracted infringement, be regarded as a pretty safe guide; but the proof in this case is not of that character, and in such a case

ages must be ascertained by a different method. The defendant, not having performed the acts, and all the acts for which the license fee is the established compensation, cannot be justly required to pay it to the plaintiff. The plaintiff, not having empowered him to enjoy the invention as he has enjoyed it upon condition that he will make the customary recompense, cannot be justly compelled to accept such recompense as his entire satisfaction for the injury. No other course is possible than to treat the defendant as an invader of the exclusive privileges of the plaintiff, and estimate the compensation of the latter by the actual damage which he can prove himself to have sustained.[4]

general evidence may be resorted to as the basis of decision." 8 Bann. & A. 589 (549).

In Birdsall *v.* Coolidge (1876), 93 U. S. 64, Clifford, J.: (70) "Evidence of an established royalty will undoubtedly furnish the true measure of damages in an action at law where the unlawful acts consist in making and selling the patented improvement, or in the extensive and protracted use of the same, without palliation or excuse; but where the use is a limited one, and for a brief period, as in the case before the court, it is error to apply that rule arbitrarily and without any qualification." 10 O. G. 748 (751).

That a license fee for an exclusive right to sell is not a measure of damages for occasional sales in particular territory, see Colgate *v.* Western Electric Mfg. Co. (1886), 26 Fed. Rep. 146; 37 O. G. 393.

That the full established license fee is a proper measure of recovery, though the infringement has been limited and brief, if it were malicious, see Stutz *v.* Armstrong (1885), 25 Fed. Rep. 147.

That where a rescinded contract for the use of several patents fixed the same royalty however many of the patents were used, and only two of the patents were infringed, the royalty furnishes no measure of damages, and if none are proved, only nominal damages will be allowed, see Bussey *v.* Excelsior Mfg. Co. (1880), 17 O. G. 744; 1 McCrary, 161; 1 Fed. Rep. 640; 5 Bann. & A. 135.

That where the whole patent is covered by a gross license fee, and the defendant infringes a single Claim, if the license fee can be fairly apportioned among the Claims it may be taken as the measure of damages, see Willimantic Thread Co. *v.* Clark Thread Co. (1886), 27 Fed. Rep. 865.

That though when the license has expired the license fee is still the usual measure of damages, yet if the device embodies other patented inventions, it must be shown how much of the license fee is paid for the one in question, see Porter Needle Co. *v.* National Needle Co. (1885), 22 Fed. Rep. 829.

[4] Although a license fee furnishes the precise measure of recovery only in the specific cases named, yet it is a fact often relevant to the question of damages in other cases, and in connection with additional facts may afford an inference as to the amount of loss the plaintiff has sustained. Thus, for example, a general license fee covering two inventions is relevant as to the damage resulting from the wrongful use of one of them, if other testimony shows the proportionate value of the use of each, etc. So, also, on the question of profits made by the defendant from the use of an improvement with its

§ 1059. Evidence Concerning Damages: Monopoly Enjoyed by Granting Licenses: License Fee the Measure of Damages for Wrongful Acts which are Identical with those Covered by such Licenses.

When the evidence discloses that a license fee has been established and that the defendant's acts of infringement have been such as in quality and extent were contemplated by the license to which the fee has been attached, the amount of this fee as it existed at the date of the infringement, with interest from that date, must be taken by the jury as conclusive proof of the actual damages to which the plaintiff is entitled.[1] It is the sum which he has offered to accept; it is

original, the license fee voluntarily paid by others, who make the same use of the improvement, may tend to show the proportion of profits due to the improvement alone. In all these cases the relevancy of the evidence must be decided by the court according to the usual rules.

§ 1059. [1] In McCormick *v.* Seymour (1854), 3 Blatch. 209, Nelson, J.: (224) "As we understand the opinion of the Court, it lays down these principles: In cases where a patentee avails himself of his invention, and of his exclusive right to the enjoyment of its profits, by putting it into market, and selling rights under it, as is most usually the case with inventors,—that is, rights for States, or counties, or smaller districts, or portions of the invention itself,—in such cases the customary charge for the right to use the patented invention is the measure of the damages which the patentee is entitled to recover in case of an infringement, with interest upon the same from the time of infringement. In other words, if he is accustomed to sell a single right for the manufacture of a machine for twenty, thirty, forty, fifty, or one hundred dollars, and if that is his usual price for the right throughout the country, that fee, with interest from the time of the particular infringement, is the measure of damages for each infringement."

In Seymour *v.* McCormick (1853), 16 How. 480, Grier, J.: (490) "Where an inventor finds it profitable to exercise his monopoly by selling licenses to make or use his improvement, he has himself fixed the average of his actual damages, when his invention has been used without his license. If he claims anything above that amount, he is bound to substantiate his claim by clear and distinct evidence. When he has himself established the market value of his improvement, as separate and distinct from the other machinery with which it is connected, he can have no claim in justice or equity to make the profits of the whole machine the measure of his demand."

That an established license fee is the proper measure of damages for an infringement which consists of acts covered by the license, see Jennings *v.* Dolan (1887), 38 O. G. 1018; 29 Fed. Rep. 861; Keller *v.* Stolzenbach (1886), 28 Fed. Rep. 81; 37 O. G. 564; May *v.* County of Fond du Lac (1886), 27 Fed. Rep. 691; Clark *v.* Wooster (1886), 119 U. S. 322; 37 O. G. 1477; Canan *v.* Pound Mfg. Co. (1885), 31 O. G. 119; 23 Blatch. 173; Graham *v.* Geneva Lake Crawford Mfg. Co. (1885), 32 O. G. 1603; 24 Fed. Rep. 642; Wooster *v.* Simonson (1884), 20 Fed. Rep. 316; 28 O. G. 918; Cottier *v.*

the sum which the defendant has impliedly agreed to pay; and the jury can do no otherwise than ratify this agreement by their verdict. It is immaterial whether the practice of the invention has been profitable to the defendant, or whether other devices which he was free to use might not have better served his purpose.[2] It is equally immaterial whether the plaintiff has been prejudiced by the defendant's enjoyment of the right under the patent. Evidence upon these points is, therefore, inadmissible, in order to increase or diminish any damages which are to be computed on the basis of a license fee, though often accepted provisionally as a guide to the

Stimson (1884), 20 Fed. Rep. 906; 10 Sawyer, 212; Westcott *v.* Rude (1884), 19 Fed. Rep. 830; 27 O. G. 719; Emigh *v.* Balt. & Ohio R. R. Co. (1881), 19 O. G. 935; 6 Fed. Rep. 283; 4 Hughes, 271; Locomotive Engine Safety Truck Co. *v.* Pennsylvania R. R. Co. (1880), 2 Fed. Rep. 677; 5 Bann. & A. 514; 14 Phila. 432; Croninger *v.* Paige (1880), 48 Wis. 229; Wooster *v.* Taylor (1878), 14 Blatch. 403; 3 Bann. & A. 241; Birdsall *v.* Coolidge (1876), 93 U. S. 64; 10 O. G. 748; Goodyear Dental Vulcanite Co. *v.* Van Antwerp (1876), 9 O. G. 497; 2 Bann. & A. 252; Burdell *v.* Denig (1875), 92 U. S. 716; American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439; Emerson *v.* Simm (1873), 3 O. G. 293; 6 Fisher, 281; Packet Co. *v.* Sickles (1873), 19 Wall. 611; Philp *v.* Nock (1873), 17 Wall. 460; Spaulding *v.* Page (1871), 4 Fisher, 641; 1 Sawyer, 702; Goodyear *v.* Bishop (1861), 2 Fisher, 154; Sanders *v.* Logan (1861), 2 Fisher, 167; Livingston *v.* Jones (1861), 2 Fisher, 207; 3 Wall. Jr. 330; Sickels *v.* Borden (1856), 3 Blatch. 535.

That a license fee at a given rate, with a discount for prompt payment, will be taken as fixing the lower rate as the true measure of damages, see Graham *v.* Geneva Lake Crawford Mfg. Co. (1885), 32 O. G. 1603; 24 Fed. Rep. 642.

That damages are not unliquidated when a royalty was established before the defendant began to infringe, see Locomotive Engine Safety Truck Co. *v.* Penna. R. R. Co. (1880), 14 Phila. 432; 5 Bann. & A. 514; 2 Fed. Rep. 677.

That the license fee existing at the date of the infringement is the measure, see Wooster *v.* Thornton (1886), 34 O. G. 560; 26 Fed. Rep. 274.

That a license fee established after the infringement is not a conclusive measure of damages though it may be considered, see Wooster *v.* Thornton (1886), 34 O. G. 560; 26 Fed. Rep. 274.

That whether the value at the date of the infringement was equal to the subsequent license fee is a question of fact, see Wooster *v.* Thornton (1886), 34 O. G. 560; 26 Fed. Rep. 274.

That interest must be allowed on license fees when taken as a measure of damages, see Creamer *v.* Bowers (1888), 35 Fed. Rep. 206; Sickels *v.* Borden (1856), 3 Blatch. 535.

[2] That a cessation of use or the fact that other equally useful devices existed is of no weight as to the amount of damages when there is a regular license fee to measure by, see Emerson *v.* Simm (1873), 3 O. G. 293; 6 Fisher, 281.

amount of actual damages in case the license fee and the defendant's implied obligation to pay it should not be fully proved.

§ 1060. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Two Forms of Such Exclusive Practice and of Corresponding Injury.

When no established license fee is proved, or when the acts of the defendant do not correspond with those for which the license fee is payable, the loss sustained by the plaintiff, if any loss there be, must arise from the effect produced by the infringement upon the value of the exclusive enjoyment of the invention by the owner of the patent or his specific licensees.[1] Two forms of this exclusive enjoyment are possible. The first consists in the use of the invention and the sale of its products; and this form is the common one when the invention is a process or a design, and is frequent when the invention is a machine. The second consists in the making and sale of the patented articles, and is usually adopted when the invention is a manufacture or a composition of matter.[2] When it is an improvement, its enjoyment follows the form which is pursued in reference to its original. The pecuniary value of the first form is measured by the advantage which the use of the invention confers on its employer, by improving the quality of his products and giving him a greater command of the market, or by diminishing their cost of manufacture in comparison with the price for which they sell and thereby increasing the percentage of his profits.[3] The pecuniary value of the second form is represented by the difference between the expense of production and the price obtained.[4] In both forms the amount of compensation to the

§ 1060. [1] That where there is no established license fee general evidence concerning damages may be given, see Suffolk Co. *v.* Hayden (1865), 3 Wall. 315.

[2] That infringements by sale and by use are essentially distinct, see Colgate *v.* Western Electric Mfg. Co. (1886), 28 Fed. Rep. 146; 37 O. G. 893.

[3] That the difference in the cost or the value of the product when made by the plaintiff's process may be considered in estimating damages, see Waterbury Brass Co. *v.* New York & Brooklyn Brass Co. (1858), 3 Fisher, 43.

[4] That the measure of damages for an unlawful sale may be the difference between the cost price to the patentee and the market price when the sales are

enjoyer of the monopoly depends upon the quantity sold and the price received, and hence the amount of injury inflicted upon him by the infringement is determined by its effect upon his prices or his sales. The evidence concerning this effect may be either direct or indirect. Direct evidence shows the extent to which the actual enjoyment of the invention by the plaintiff has been diminished by the wrongful acts of the defendant. Indirect evidence discloses the benefits derived by the defendant from the infringement, and thence infers the extent of the plaintiff's loss. Evidence of both species is admissible whenever it can tend to prove the amount of injury which the plaintiff has sustained.

§ 1061. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Direct Evidence of the Extent of Injury.[1]

Direct evidence of the extent to which the plaintiff has been injured consists of testimony showing the amount of the plain-

made, see American Saw Co. *v.* Emerson (1880), 8 Fed. Rep. 806.

§ 1061. [1] In examining and citing cases in reference to damages and profits great discrimination is necessary. Profits were until recently the only measure of recovery in equity. They have always been admissible in evidence upon the question of the amount of damages at law. Damages are and must be the measure of recovery at law. By the act of 1870 they may also be awarded in equity where the account of profits fails to give the plaintiff a sufficient compensation. Thus any cases since 1870, whether at law or in equity, may have required an investigation into both damages and profits, and have demanded the discussion of their modes of ascertainment and the principles by which they are governed. But profits at law are not estimated in all respects as they are in equity, nor do they occupy the same relation toward the measure of recovery, and yet so great is their similarity and so nice and subtle are their distinctions that it would be in vain expected that the judges should have confined their definitions and illustrations to that species of damages and profits which was appropriate to the tribunal wherein for the time being they presided.

A protracted study of the reported cases has satisfied the present writer that any attempt to classify them would be futile. Profits at law have often been present, perhaps unconsciously, in the mind of the court when giving an opinion concerning profits in equity. Damages in equity and their relation to profits have found consideration in judgments awarding damages at law. In this condition of the cases two courses were open: one, to select those only which were decided in the tribunal whose acts and jurisdiction were the subject of discussion in the text, and which limited their statements and explanations to the doctrines and methods

tiff's sales or prices before the invasion of his rights by the defendant and the decrease in either which has resulted from the infringement. The effect of the infringement on the quantity sold may be proved by evidence that customers have been diverted from the plaintiff to the defendant, or that the defendant has supplied the market formerly controlled by the plaintiff, or that the inferiority of the defendant's infringing articles has lowered the reputation of and reduced the demand for the plaintiff's goods.[2] The effect of the in-

there appropriate; the other, to employ all cases which were useful for their definitions and illustrations, without reference to the tribunal, trusting to the caution of the reader, under the guidance of the text, to preserve him from serious errors. The first course would have reduced the cited cases to a number pitifully small, and would have cast aside a multitude of valuable decisions which, if they could be safely utilized, could not well be spared. The latter course has, therefore, been adopted; and in referring to the cases, those at law and equity have been distinguished from each other by the letters L. and E. whenever in the judgment of the author the reader needed to be put upon his guard.

[2] In McComb *v.* Brodie (L. 1872), 5 Fisher, 384, Woods, J.: (394) "This rule is not what defendant made by the infringement, or what he might have made, but it is the loss sustained by plaintiffs by reason of the infringement. The amount of this loss you must gather from the evidence. It is proper to inquire how many customers were diverted from plaintiffs by the wrongful conduct of defendant, and what loss plaintiffs have sustained in profits by reason of such diversions. If plaintiffs were ready to supply the market with their patented goods, and their business was hindered or interfered with by the competition of defendant, plaintiffs' damages will be the amount of profit which they have lost by reason of *such interference*." 1 Woods, 153 (161); 2 O. G. 117 (120).

That where the infringement consists in the sale of infringing articles, the damages are measured by the loss of trade diverted from the plaintiff and the profits he could have made therefrom, see Hall *v.* Stern (E. 1884), 20 Fed. Rep. 788.

That where no licenses are sold the damages to the plaintiff may be determined by inquiring how many customers were diverted from the plaintiff to the defendant, whether the plaintiff was prepared to supply the market and was prevented by the defendant, and whether the competition has interfered with the plaintiff's business or damaged him in a sum equal to the profits he would have made if he had sold the quantity sold by the defendant over and above what he himself had sold, see Goodyear *v.* Bishop (L. 1861), 2 Fisher, 154.

See also § 1063, note 3, *post*.

That the damages for infringing a patented hotel register include the profit on the book when sold and of the advertisements in it, see Hawes *v.* Washburne (L. 1872), 5 O. G. 491; Hawes *v.* Gage (L. 1872), 5 O. G. 494.

That damages are to cover loss through disparagement of plaintiff's invention by defendant's publications during the infringement, see McCormick *v.* Seymour (L. 1851), 2 Blatch. 240.

fringement on the prices may be shown by evidence that the defendant has compelled the plaintiff to lessen his rates of recompense by diminishing his own, or by flooding the market with his products, or by asserting the superiority of the infringing articles to those offered by the plaintiff.[3] To the

[3] That reduction of prices, and consequent loss of profits, through infringing competition, is proper ground for damages, see Yale Lock Co. *v.* Sargent (E. 1886), 117 U. S. 536 ; 35 O. G. 497 ; Sargent *v.* Yale Lock Mfg. Co. (E. 1879), 17 O. G. 105 ; 17 Blatch. 244 ; 4 Bann. & A. 574 ; Smith *v.* O'Connor (E. 1873), 6 Fisher, 469 ; 4 O. G. 633 ; 2 Sawyer, 461.

That the plaintiff has a right to keep up the price of the invention and if the infringement prevents this, the reduction in price is part of the damages, see Carter *v.* Baker (L. 1871), 4 Fisher, 404 ; 1 Sawyer, 512.

That where the plaintiff grants no licenses but makes and sells articles containing the invention which are unsalable without it, and the defendant by selling infringing articles compels the plaintiff to lower his prices, the entire loss is imputable to the defendant, and may be recovered by the plaintiff less a proper allowance for other patented devices contained in the defendant's article and for advantages enjoyed by him in selling, see Yale Lock Co. *v.* Sargent (E. 1886), 117 U. S. 536 ; 35 O. G. 497 ; Fitch *v.* Bragg (E. 1883), 16 Fed. Rep. 243 ; 21 Blatch. 302 ; Sargent *v.* Yale Lock Mfg. Co. (E. 1879), 17 O. G. 105 ; 17 Blatch. 244 ; 4 Bann. & A. 574.

That where the only damage consists in the reduction of the plaintiff's sales, and the essential features of the plaintiff's and defendant's devices are the same, and this being part of a structure is always embraced with other things, and yet by it the profit on the entire structure is made, and the defendant sells at low prices and so takes away the entire profit which the plaintiff would otherwise have made, the entire loss of the plaintiff is to be compensated for in damages, after deducting a proper sum for any other patented device contained in the defendant's device and for any other cause giving the defendant an advantage in selling the device, see Fitch *v.* Bragg (E. 1883), 16 Fed. Rep. 243 ; 21 Blatch. 302.

That the value of the invention to the plaintiff may be shown by license fees, prices on sales, etc., see Gottfried *v.* Crescent Brewing Co. (E. 1884), 30 O. G. 892 ; 22 Fed. Rep. 433.

That damages are measured by the profit the patentee ordinarily received from the sale of machines of that size, see Blake *v.* Greenwood Cemetery (E. 1883), 16 Fed. Rep. 676 ; 21 Blatch. 222.

That where the plaintiff manufactures the invention his damages may be measured by the manufacturer's profits, see Westlake *v.* Cartter (L. 1873), 4 O. G. 636 ; 6 Fisher, 519.

That when the plaintiff is deprived of his profits by the use of an element covered by his patent, they are the measure of damages, that being the amount the defendant would have paid him for it, see Putnam *v.* Lomax (E. 1881), 9 Fed. Rep. 448 ; 10 Bissell, 546.

That a loss by reduction of prices must be proved to be due solely or to a definite extent to the defendant's infringement, see Cornely *v.* Marckwald (E. 1889), 131 U. S. 159.

That loss by reduction of prices through defendant's competition must be proved, not conjectured, and is counter-indicated if the plaintiff had gradually dropped his prices before the in-

loss inflicted by this decrease of sales or lowering of prices may be added that on goods made and left unsold through the defendant's competition.[4] Evidence of remote or contingent losses, which cannot be measured by the difference between the amount that the plaintiff would have cleared by his invention had it not been for the infringement and the amount of profits which he has actually received, is not admissible.[5]

§ 1062. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Indirect Evidence of the Extent of Injury in Cases where the Owner of the Patented Invention Uses the Invention and Sells its Products.

Indirect evidence of the extent to which the plaintiff has been injured, in cases where his exclusive enjoyment of the invention consists in its use in his own business and the sale of its products, is afforded by the profits resulting to the defendant from the use of the invention during the infringement.[1] There is no presumption, either of law or fact, that

fringement, see Cornely *v.* Marckwald (E. 1885), 28 Blatch. 163; 32 Fed. Rep. 292.

That if the defendant causes the plaintiff to lower his prices by publishing the superiority of the infringing articles, this is to be also considered, see McCormick *v.* Seymour (L. 1851), 2 Blatch. 240.

[4] That the loss on goods made and not sold on account of the defendant's competition are part of the damages, see Carter *v.* Baker (L. 1871), 4 Fisher, 404; 1 Sawyer, 512.

[5] That remote and uncertain losses not distinctly traceable to the infringement cannot be shown, see Carter *v.* Baker (L. 1871), 4 Fisher, 404; 1 Sawyer, 512.

§ 1062. [1] Under the theory of equity that an infringer is accountable to the patentee for all the gains or savings which he may have effected by the unlawful use of the invention, the plaintiff is of course entitled to recover all the defendant's profits irrespective of his own loss, not, however, as damages but as benefits accruing from the use of his invention. In several cases the courts have been misled by this equitable doctrine into the statement that the plaintiff may recover at law, as damages, whatever the defendant may have made by the infringement, employing thus his profits as the measure of the plaintiff's loss. See Carter *v.* Baker (L. 1871), 4 Fisher, 404; 1 Sawyer, 512; Case *v.* Brown (L. 1862), 2 Fisher, 268; 1 Bissell, 382; Conover *v.* Rapp (L. 1859), 4 Fisher, 57; Serrell *v.* Collins (L. 1857), 1 Fisher, 289; Sickels *v.* Borden (L. 1856), 3 Blatch. 535; Wintermute *v.* Redington (L. 1856), 1 Fisher, 239; McCormick *v.* Seymour (L. 1851), 2 Blatch. 240; Wilbur *v.* Beecher (L. 1850), 2 Blatch. 132; Buck *v.* Hermance (L. 1849), 1 Blatch, 398; Parker *v.* Bamker (L. 1855), 6 McLean, 631.

That the profits realized by the de-

the plaintiff has lost all that the defendant has gained, or that the defendant's advantage is equal to the plaintiff's loss. But

fendant from the use of the invention represent the value of that use to him, and constitute a fact to be considered by the jury in arriving at an estimate of the plaintiff's loss, there can be no doubt. Such a rule is sound in theory and has been demonstrated by experience to be advantageous in practice. Thus that the profits made by the defendant from the infringement may be shown by evidence and regarded by the jury, see Byerly *v.* Cleveland Linseed Oil Works (L. 1887), 31 Fed. Rep. 73; Royer *v.* Coupe (L. 1886), 39 O. G. 239; 29 Fed. Rep. 358; Burdell *v.* Denig (L. 1875), 92 U. S. 716; Littlefield *v.* Perry (L. 1874), 21 Wall. 205; 7 O. G. 964; Cowing & Ramsey (L. 1870), 4 Fisher, 275; 8 Blatch. 36; Waterbury Brass Co. *v.* N. Y. & Brooklyn Brass Co. (L. 1858), 3 Fisher, 43; Ransom *v.* Mayor of New York (L. 1856), 1 Fisher, 252.

It is also sometimes stated that in ascertaining the defendant's profits the methods proper in equity may be employed. (See Burdell *v.* Denig (L. 1875), 92 U. S. 716.) So far as this relates to the actual profits received by the defendant in money or in money's worth it is perhaps true. But in equity the profit of the defendant is measured by the advantage which he derived from the use of the infringing invention in excess of what he might have gained by the employment of some art or instrument already open to the public,—a method whose justice and correctness is doubtful at least in equity and which is evidently erroneous at law. (See the matter discussed, note 5, *post.*) In equity the defendant's profit also includes not merely the positive gains which he obtained by the infringement, but the saving from greater losses than he has actually incurred, though the infringing business has been conducted at a loss. (See Conover *v.* Mers (E. 1873), 11 Blatch. 197; 6 Fisher, 506.) That such savings can in all cases be embraced in the defendant's profits as a guide to the loss sustained by the plaintiff may well be disputed. When the infringement can be separated from the other parts of the defendant's enterprise, and has in its separate state been profitable, such profits are to be considered. But when the infringement takes place under circumstances which entail a loss on the defendant, *and* at the same time show that had the plaintiff engaged in the undertaking in which he has been thus forestalled by the defendant he would have met with similar losses, the fact that the defendant's loss would have been greater if he had not employed the patented invention, so far from tending to show that his infringement has prevented the plaintiff from realizing profits, proves that it has benefited him by protecting him from loss.

The true doctrine of profits at law seems to be stated in the following cases: In Campbell *v.* Barclay (L. 1870), 5 Bissell, 179, Blodgett, J.: (180) "Nor is the amount of damages to be measured solely by the profits which the defendant realized by the use of the patent, because he may have conducted his business in so unsuccessful a manner as to have made no profits, notwithstanding the use of the patent. In other words, he might have lost money in the business whether he used the patented tool or used the old-fashioned implement."

In Many *v.* Sizer (L. 1849), 1 Fisher, 17, Sprague, J.: (30) "The number of wheels which the defendant has made, and the amount of profit he has realized from them have been presented to you by the plaintiff, as grounds of damages.

the pecuniary benefit which the defendant has derived from the unlawful use of the invention, whether by an increase in the quality of his products and the quantity of his sales, or by a decrease in the expense of manufacture, is a fact from which, in connection with other facts, the jury may infer the amount by which the plaintiff's sales and prices have been reduced through the infringement.[2] If it be shown that the

They are proper to be taken into consideration, but are not conclusive as to the extent of the injury, which may be either greater or less than the profits realized by the defendants. A plaintiff may be manufacturing his patented article himself, and making it to a profit, while another man may make it to a disadvantage, and yet the spurious article carried into the market may displace the original. In such case, the injury to the patentee would be greater than any profit upon the spurious production. On the other hand, a defendant's article may not displace the original, and in that case the injury would be less. And again, it may be that a plaintiff may derive a profit from licensing other parties to construct his invention; and any piracy upon it, by depriving him of a portion of the profits of such licenses, would be an injury to be taken into account by a jury."

That the profits of the defendant are not always the measure of the plaintiff's damages, the damages being the loss actually sustained by the plaintiff as shown by the evidence, see Magic Ruffle Co. *v.* Elm City Co. (E. 1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506; Birdsall *v.* Coolidge (L. 1876), 93 U. S. 64; 10 O. G. 748; Goodyear Dental Vulcanite Co. *v.* Van Antwerp (E. 1876), 9 O. G. 497; 2 Bann. & A. 252; McComb *v.* Brodie (L. 1872), 2 O. G. 117; 1 Woods, 153; 5 Fisher, 384; Cowing *v.* Rumsey (L. 1870), 4 Fisher, 275; 8 Blatch. 36.

That the defendant's profits measure the damages only when the invention is a new thing, or a new form of a known thing, which as a distinct species can be put into market cheaper, or is more valuable, so as to supersede or exclude other articles of the same class, and where the profit of the patentee consists in a complete monopoly of the invention as a unit, all competition being excluded, see Livingston *v.* Jones (E. 1861), 2 Fisher, 207; 3 Wall. Jr. 330.

That profits due to the use of an improvement cannot be regarded as part of the damages in a suit upon a patent for the original invention, see Carter *v.* Baker (L. 1871), 4 Fisher, 404; 1 Sawyer, 512.

[2] In Philp *v.* Nock (L. 1873), 17 Wall. 460, Swayne, J.: (462) "In arriving at their conclusion the profit made by the defendant and that lost by the plaintiff are among the elements which the jury may consider."

In Suffolk Co. *v.* Hayden (L. 1865), 3 Wall. 315, Nelson, J.: (320) "This question of damages, under the rule given in the statute, is always attended with difficulty and embarrassment both to the court and jury. There being no established patent or license fee in the case, in order to get at a fair measure of damages, or even an approximation to it, general evidence must necessarily be resorted to. And what evidence could be more appropriate and pertinent than that of the utility and advantage of the invention over the old modes or devices that had been used for working out similar results? With a knowledge of these benefits to the persons who have used the invention, and the extent of the use

plaintiff was ready and able to supply the market with his products, the inference is a fair one that he would have sold all that the defendant sold.[9] If his facilities for manufacturing were equal to those of the defendant it may well be concluded that the percentage of his profits would not have been less than those of the defendant. When those two connecting facts are established, the value of the use of the invention to the defendant, as shown by the increase of his sales or profits, affords a just and reasonable measure of the plaintiff's loss.[1] It has been often stated by the courts that in estimating the

by an infringer, a jury will be in possession of material and controlling facts, that may enable them, in the exercise of a sound judgment, to ascertain the damages, or, in other words, the loss to the patentee or owner, by the piracy instead of the purchase of the use of the invention."

See also Cowing v. Ramsey (L. 1870), 4 Fisher, 275; 8 Blatch. 80.

That profits may be recovered for the use of the invention without reference to the usual royalty, see Knox v. Great Western Quicksilver Mining Co. (E. 1878), 14 O. G. 807; 6 Sawyer, 430; 4 Bann. & A. 25.

That profits cannot be measured by royalties, see Tilghman v. Proctor (E. 1888) 125 U. S. 136; 43 O. G. 628; Wooster v. Taylor (E. 1878) 14 Blatch. 403; 3 Bann. & A. 341.

[8] That there is no presumption of law that the plaintiff would have sold all that the defendant did, see Roemer v. Simon (E. 1887), 31 Fed. Rep. 41; 40 O. G. 1456; Cornely v. Marckwald (E. 1885) 32 Fed. Rep. 392; 23 Blatch. 163; Zane v. Peck Brothers (E. 1882), 13 Fed. Rep. 475; 23 O. G. 101; Ingersoll v. Musgrove (E. 1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304; Hawes v. Washburne (L. 1872), 5 O. G. 491; Carter v. Baker (L. 1871), 4 Fisher, 404; 1 Sawyer, 512; Goodyear v. Bishop (L. 1861), 2 Fisher, 154; Seymour v. McCormick (L. 1850), 16 How. 480. See also § 1008, note 2, *post*. Contra, McCormick v. Seymour (L. 1851), 2 Blatch. 240; Wilbur v. Beecher (L. 1850), 2 Blatch. 192.

That the measure of damages is the profits the plaintiffs would have made if they had supplied the defendant's customers provided it is shown that they would have supplied them, see Zane v. Peck Brothers (E. 1882), 13 Fed. Rep. 475; 23 O. G. 101.

That where the plaintiff is able and ready to supply all customers and has had a previous control of the market, it may be inferred that all who bought of the defendant would have bought of him, see Gould's Mfg. Co. v. Cowing (E. 1882), 105 U. S. 253; 21 O. G. 1277; Bigelow Carpet Co. v. Dobson (E. 1882), 21 O. G. 1200; 10 Fed. Rep. 385.

That where before his infringement the defendant bought the articles from the plaintiff it is a fair presumption that had he not infringed he would have bought the same number which he wrongfully made, see Creamer v. Bowers (E. 1888) 35 Fed. Rep. 206.

[9] That the profits of the defendant are equally the measure of the plaintiff's damages, whether the infringement is wilful or not, see Wintermute v. Redington (L. 1856), 1 Fisher, 239.

advantage derived by the defendant from the use of the plaintiff's invention, the comparison must be instituted between the patented invention and such instruments or operations as are open to public employment, and that if the benefit which he receives from the practice of the plaintiff's invention does not exceed that which he would obtain by using other means already in possession of the public, he does not gain nor does the plaintiff lose by the infringement.[6] The theory on which this doctrine rests is this, — that as the quality of the defendant's products and the quantity of his sales are not increased, by the invasion of the monopoly, beyond the standard which they might have rightfully reached without it, nor the cost of production reduced below the amount attending the proper use of different appliances, it cannot be considered that his profits or his sales have been enlarged by his unlawful use of the invention; while the existence of other inventions, to which the public had no free access, or of better means which were devised and patented after the issue of the plaintiff's

[6] In Black v. Thorne (E. 1884), 111 U. S. 122, Field, J.: (124) "It does not always follow that because a party may have made an improvement in a machine and obtained a patent for it, another using the improvement and infringing upon the patentee's rights will be mulcted in more than nominal damages for the infringement. If other methods in common use produce the same results, with equal facility and cost, the use of the patented invention cannot add to the gains of the infringer or impair the just rewards of the inventor. The inventor may indeed prohibit the use, or exact a license fee for it, and if such license fee has been generally paid, its amount may be taken as the criterion of damage to him when his rights are infringed. In the absence of such criterion, the damages must necessarily be nominal." 27 O. G. 415 (416).

See also Tilghman v. Proctor (E. 1888) 125 U. S. 136; 43 O. G. 628; Shannon v. Bruner (E. 1888) 33 Fed. Rep. 871; McMurray v. Emerson (L. 1888) 30 Fed. Rep. 901; Royer v. Coupe (L. 1886), 29 Fed. Rep. 358; 30 O. G. 289; Turrill v. Illinois Central R. R. Co. (E. 1878), 5 Biatch. 344; Serrell v. Collins (L. 1867), 1 Fisher, 289.

That the damages may be measured by the difference in value between the old and new devices, see Brodie v. Ophir Silver Mining Co. (L. 1867), 4 Fisher, 187; 5 Sawyer, 608.

That the measure of damages for the infringement of a design is its excess of value over any open to the public, see Tomkinson v. Willetts Mfg. Co. (E. 1888) 34 O. G. 586.

That some one else has got as good a device as the plaintiff's does not destroy its value though it may affect it, see National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co. (L. 1884), 19 Fed. Rep. 514; 28 O. G. 1007.

patent, are facts which cannot be considered, since the defendant, having chosen to avail himself of the plaintiff's invention, should not be permitted to escape responsibility on the ground that he could have derived a similar benefit from the infringement of a different patent.[6] Whether or not this doctrine and its underlying theory will bear investigation when applied to profits in equity, they certainly seem to be erroneous in reference to those profits which can be taken as the measure of damages at law.[7] But they have been so

[6] That the defendant could have obtained the same advantage by employing a different patented invention is immaterial, see Turrill *v.* Illinois Central R. R. Co. (E. 1880), 20 Fed. Rep. 912.

[7] The doctrine whose correctness is here questioned may be stated in the following proposition: viz., that the profits of a defendant from the use or sale of an infringing invention, when taken as the subject-matter of an account in equity or as the measure of damages at law, includes only such gains or savings as he could not have derived from the use or sale of any invention then open to the public. This proposition contains a truth which must be carefully distinguished before the errors of the remainder can be fairly judged.

(1) Every invention is either an original invention or an improvement on an original. If an original, it belongs entirely to the inventor and its infringement involves an injury commensurate with the scope of the complete invention used. If an improvement, the improvement merely, not the original, belongs to the inventor, and an infringement consisting in the use or sale of the original *plus* the improvement involves an injury commensurate only with the scope of the improvement as distinguished from the original; the employment of the latter, if it be not open to the public, being an injury to the rights of its inventor alone. Hence where the plaintiff's invention is an improvement used with its original, and he is not the owner of the patent for the original, or the original is free to the public, the sole loss that he can sustain, and the sole benefit which the defendant can derive, from the infringement must relate to the improvement; and in ascertaining this benefit, whether in equity or at law, no advantage should be included which could have been obtained by the use of the original without the plaintiff's improvement. This rule is indisputable, but it is simply another way of stating that the profits arising from the use of the plaintiff's invention must be separated from those arising from any other cause, and required no additional expression in the proposition now considered. It applies, however, in either mode of statement only to cases in which the improvement is used *with its original*, since if the improvement is independently employed it loses its character as an improvement and follows the rule now to be discussed concerning original inventions.

(2) When an infringing act of making, use, or sale, is confined to and embraces the plaintiff's entire invention, such invention is, at least in reference to that infringement, an original invention, not dependent on any other for whose use in connection with it an allowance must be made, and not including any whose value must be separated from its own in order that the plaintiff's loss or

long accepted, and are now supported by so many eminent authorities, that they must here be treated as correct. If,

the defendant's gain from its employment may be measured. Here it would seem most in harmony with the foregoing rule, whose proper antithesis it is, as well as with the ordinary methods of practical jurisprudence, to estimate the profits of the defendant at the entire advantage derived by him from the use of the invention, irrespective of any other arts or instruments whatever. And such would probably have been the current of authority but for the utterances of several of our courts (of which the extract in note 6, *ante*, is a sample) where the doctrine applicable to improvements only is stated without limitation and thus extended to cover all infringements of whatever character or scope. To detect and weigh the error in these utterances it is necessary to consider them first as they affect the rule of profits in equity, and second as they affect the rule of damages at law.

(3) First, profits in equity are the gain or saving, or both, which the defendant has made by employing the infringing invention. This gain or saving is a fact. It is an actual pecuniary benefit which has resulted directly from the defendant's wrongful use of the plaintiff's property, which he has had and enjoyed, and to which, on equitable theories, the plaintiff is entitled. Now what relevancy to this condition of affairs has the fact, if it be a fact, that the defendant, by using an invention which he had a right to use, might have received the same pecuniary benefit? It does not alter the fact that he has wrongfully used the plaintiff's invention. It does not lessen the amount of dollars and cents that he has received or saved as the direct result of his infringement. It does not qualify the plaintiff's claim to his own property and to the proceeds of its unauthorized use. On the contrary, to allow the defendant to keep his unrighteous gains, because he might have honestly acquired an equal amount, ignores the facts, deprives the plaintiff of his lawful rights, and recompenses the wrong-doer for the injury he has inflicted. Such a proceeding finds no parallel in any other department of remedial justice, whether civil or criminal. If the defendant were a true trustee of the plaintiff, and by a misappropriation of the trust estate had fortunately realized large profits, could he retain them on the ground that he had property of his own with which he might have entered on the same enterprises with the same results? If he were a trustee *de son tort*, and having intruded himself into the management of the *cestui que trust's* estate had profited by converting its resources to his own use, could he refuse to render up both capital and profits because other and lawful methods might have yielded him a corresponding gain? If he were a simple tort-feasor and were required to disgorge the fruits of his appropriation of the plaintiff's property, could he defend by showing that he might have bought or borrowed to the same advantage property of the same amount or kind? The rule becomes an absurdity upon analysis or varied application, and its presence in our law can only be accounted for by regarding it as a careless extension of the true rule which separates between the improvement and the original invention.

(4) Second, at law the profits of the defendant serve merely as an indication of the amount which the plaintiff has lost through the infringement, and are of no significance until it has been proved that the advantage derived by the defendant from the invention would, but for the infringement, have been enjoyed

therefore, the evidence discloses that the defendant enjoyed advantages in the use of the plaintiff's invention which could

by the plaintiff. Obviously to make this rule of any practical value the same mode of estimating the defendant's profits must be employed that would have been pursued in ascertaining them if they had been made by the plaintiff. The same items must be debited to him as representing the "yield" of the enterprise, and the same deductions allowed as constituting the "cost," as if he were the plaintiff balancing his account of gains and loss. But into a calculation of profits by the rightful owner of an invention, the amount he might have made by using something else never enters either as an expense or a receipt. The enterprise, like all other commercial undertakings, stands by itself, its results being rendered neither greater nor less by the possible results of different ventures to which the time or capital or labor of the manufacturer or merchant might have been directed. The profit which the plaintiff would have made thus embraces the entire difference between "cost" and "yield"; the loss which he has suffered is commensurate with the profit he would have made; and this profit having been received by the defendant must be estimated as the plaintiff's profits would have been and as his loss must be, irrespective of all exterior comparisons, or the whole rule becomes uncertain, speculative, and impracticable. The analogies as well as the reason of the law are all in harmony with this position. A disseisor cannot reduce the amount of *mesne profits* for which he is accountable by showing that he might have occupied land of his own with equal benefit to himself. A converter of personal property does not decrease the plaintiff's damages for the unlawful detention by proving that similar and as available chattels were lawfully at his command. On what ground can a distinction be made in the case of a wrongful appropriation of another's patented invention, whereby the owner is to be deprived wholly or in part of adequate redress because the defendant could, by obedience to law, have reaped a similar advantage?

(5) To the foregoing argument it may be objected that the benefit conferred by any inventor on the public is measured by the difference in value between his new art or instrument and those which were already in possession of the public. Theoretically this is true; but it has nothing to do with the present question for two reasons: first, that such a difference is always incapable of pecuniary calculation or of any approximate conjecture; and second, that though it were ascertainable, the general benefit to the public from the invention, if it were free, cannot tend to show the actual loss to the inventor or the unlawful gain to the infringer by his invasion of the monopoly. It would be an outrage upon common-sense as well as justice to decide that a defendant who had lost by the infringement must account in equity for profits which, on the basis of the general public benefit derived from the invention, he ought to have secured; or, it being found that but for the infringement the plaintiff would have commanded the entire market, to mulct the infringer in damages at law measured by the profits which manufacturers in general would have realized from the business, without regard to his own expense for production or the prices realized upon his sales. And on the other hand an equal wrong would be inflicted on the plaintiff if compensation for the infringement were denied him on the ground that his invention, however valuable in itself and productive to its

not have been attained by the employment of means already given to the public, the pecuniary value of that advantage, measured by whatever increase in his sales or profits may be due to the invention, indicates the extent to which the plaintiff has suffered by his wrongful acts. This value should be calculated for the entire period of the infringement, but must not include the advantage which the defendant may have gained by any use of the invention before the issue of the patent.[8] It must also be confined to the benefits which flow from the use of the plaintiff's invention, as distinguished from every other instrument or operation which the defendant has employed in the manufacture of his products. Thus

employers, was of no greater comparative utility than other inventions which were not protected by a patent. Of the limitation placed by the court to the operation of this controverted doctrine, in confining the comparison to inventions already free to the public, and making no allowance to the defendant because other patented inventions might have been equally profitable to him, it is necessary to say only that if the main doctrine is unsound this becomes of no consequence, while if the former is sustained as an arbitrary rule of calculation the latter, which evidently rests rather upon some notion of a penalty to the wrong-doer than on that of compensation to the injured party, is no more arbitrary and unreasonable than the former.

(6) Shorn of the errors thus pointed out and explained, the true rule in reference to the subject seems to be this:

1. That the inventor of an improvement is entitled to profits or damages only for the infringement of his improvement, and that in estimating these a deduction must be made from the entire profits of the enterprise of all such profits as are due to the original.

2. That where the invention is an original invention, or an improvement used independently and as an original, the plaintiff is entitled to profits or damages for its use by the defendant as he has used it, without regard to anything else he might have used, lawfully or unlawfully, in the promotion of his business.

Recognitions more or less explicit of this distinction and of the rule as here maintained are discoverable in many of the cases heretofore referred to, of which Shannon *v.* Bruner (1888), 26 Fed. Rep. 901, and American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764, 1 Bann. & A. 439, are fair examples. In the text, however, the rule as generally stated by the courts is followed, their utterances being regarded as the law, to whatever criticism it may be subjected in this collateral discussion.

[8] That the value of an infringement is its value at the date of the infringement, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (L. 1884), 28 O. G. 1007; 19 Fed. Rep. 514.

That where the infringing articles were in use when the patent was granted the value of their use since the issue of the patent and as long as they will last, is the measure of damages, see Brodie *v.* Ophir Silver Mining Co. (L. 1867), 4 Fisher, 137; 5 Sawyer, 608.

where the plaintiff's invention is a mere improvement upon an existing process or machine, the advantage derived from the improvement must be separated from that accruing from the original, and only the value of the former advantage be considered.[9] But if the process or machine was valueless without the improvement, or if the two were always used together in the practice of the art, or if the defendant has so confused his own invention with that of the plaintiff that their respective benefits cannot be separated, the value of the whole advantage gained is imputed to the plaintiff's improvement and may be taken as the measure of his loss.[10] The amount of the pecuniary profit received by the defendant from his use of the invention may be shown by evidence disclosing the quantity of his sales, the prices obtained, the cost of manufacture, and the expense of marketing.[11] If his products

[9] In Philp *v.* Nock (L. 1873), 17 Wall. 460, Swayne, J.: (462) "Where the infringement is confined to a part of the thing sold, the recovery must be limited accordingly. It cannot be as if the entire thing were covered by the patent; or, where that is the case, as if the infringement were as large as the monopoly."

That the damages are to be ascertained by the increased profit to the defendant from making and selling the invention, not considering the increased facilities in manufacture due to inventions since the issue of the patent or its assignment to the plaintiff, see Wayne *v.* Holmes (L. 1856), 2 Fisher, 20; 1 Bond, 27.

That the profits of the patented invention alone are to be considered, apart from other devices with which it may be associated, see Tuttle *v.* Gaylord (E. 1886), 36 O. G. 694; 28 Fed. Rep. 97; Hayden *v.* Suffolk Mfg. Co. (L. 1862), 4 Fisher, 86; Seymour *v.* McCormick (L. 1853), 16 How. 480.

See § 1063, note 6, *post*.

[10] That where the plaintiff's invention is an improvement and the old device is now never used without it, the entire profit is the measure of damages, see McCormick *v.* Seymour (L. 1851), 2 Blatch. 240.

That if the defendant's process derives all its value from the plaintiff's invention, the profits are measured by that value, though other processes equally useful to the defendant, but resulting in a different but as valuable a product, were open to him, see Whitney *v.* Mowry, (E. 1870), 4 Fisher, 207.

That the profits due to the defendant's improvements do not form a measure of the plaintiff's damages, but if inseparable from those resulting from the use of the plaintiff's device, they belong to the plaintiff, not to the defendant who wrongfully confused them, see Carter *v.* Baker (L. 1871), 4 Fisher, 404; 1 Sawyer, 512.

See also § 1063, note 7, *post*.

[11] That when damages are measured by profits, these are the selling price less the cost of making and selling, the risk of bad debts and interest on capital, see McCormick *v.* Seymour (L. 1851), 2 Blatch. 240; Wilbur *v.* Beecher (L. 1850), 2 Blatch. 132.

That the added price charged by the

derive their entire market value from the use of the plaintiff's invention, this evidence will be sufficient, since the difference between cost and receipts will be the profit resulting from the invention. If his products are marketable when not made with the plaintiff's process or machine, but in less quantities or at a lower price or greater cost, other evidence becomes necessary to separate that increase in the sales or profits which is due to the invention. Definite and direct testimony upon this point is not always procurable, and in its absence any facts which indicate the degree of such increase may be shown. The amount afterwards paid by the defendant for an equivalent invention, or for a license to use it, or as royalties upon his products, may thus be proved as an admission by him of its value in his business.[12] Even the opinions of witnesses having experience in the trade are proper testimony upon this subject.[13] But the expense of making the invention, or the price for which it is sold to others by the plaintiff, or the amount of an injunction-bond demanded from the defendant in the case at bar, are of themselves no guide to its value to the defendant, since this value must depend, not on the cost of the invention, nor the estimation formed by others of its worth, but on the profits he himself has made by its employment.[14] When the value of the advantage received by

defendant when he used the plaintiff's invention is a fair indication of its value to him, see Vulcanite Paving Co. *v.* American Artificial Stone Pavement Co. (E. 1888), 36 Fed. Rep. 378.

That upon the question of the defendant's profits, the whole expense of opening and closing up the business cannot be charged to the patent, see Goodyear *v.* Bishop (L. 1861), 2 Fisher, 154.

Upon the whole question of profits and the items which enter into the account, see §§ 1063, 1138–1149, and notes, *post*.

[12] That the value of the invention to the defendant may be shown by license fees paid by him for an equivalent benefit, see Sargent *v.* Yale Lock Mfg. Co. (E. 1879) 17 Blatch. 249; 4 Bann. & A. 579; 17 O. G. 106.

That an established royalty is evidence of value but not an absolute test, see Wooster *v.* Thornton (E. 1886), 26 Fed. Rep. 274; 34 O. G. 560.

[13] That when there is no established license fee, the court in estimating damages may consider (1) the manufacturer's price; (2) the percentage which usually makes a fair royalty; (3) the judgment of competent experts familiar with the sale and profit; (4) the price paid by others for licenses, etc., see McKeever *v.* United States (1878), 14 Court of Claims, 396; 23 O. G. 1525.

[14] That neither the price for which the device might sell nor the expense of making it is the proper measure of

the defendant from the use of the plaintiff's invention has been thus determined, and other evidence has demonstrated that but for the infringement the plaintiff would have supplied the market at an equal profit, the question still remains whether the plaintiff has not suffered other losses beyond the mere supersedure of his own products by those of the defendant. The goods placed on the market by the defendant may have been of an inferior quality and by diminishing the reputation may have decreased the salability of all products of the patented machine or process by whomsoever manufactured, or the defendant may have lowered his prices to obtain a market, content with a less profit than justice would award the plaintiff at whose expense of skill or time or money the invention was created, and in this manner may not only have received a smaller benefit himself than the plaintiff would have gained from the manufacture and sale of the same products, but have directly injured the business of all those who use the invention under the protection of the patent.[15] These damages

damages where only making is proved, see Whittemore *v.* Cutter (L. 1813), 1 Gallison, 478 ; 1 Robb, 40.

That the damages are not shown by the prices at which the plaintiff sold certain territory, see Campbell *v.* Barclay (L. 1870), 5 Bissell, 179.

That it cannot be assumed that the defendant's profit was as much as the plaintiff's would have been, see Roemer *v.* Simon (E. 1887), 31 Fed. Rep. 41 ; 40 O. G. 1456.

That the amount of the bond ordered on an injunction is no evidence of the value in dispute, see Brown *v.* Shannon (E. 1857), 20 How. 55.

[15] That where the goods sold by the defendant would otherwise have been sold at a higher price by the plaintiff, the measure of damages is the profit the plaintiff would have received on such sales at such advanced price, see Hobbie *v.* Smith (L. 1886), 27 Fed. Rep. 656 ; American Saw Co. *v.* Emerson (E. 1880), 8 Fed. Rep. 806 ; McComb *v.* Brodie (L. 1872), 5 Fisher, 384 ; 2 O. G. 117 ; 1 Woods, 153; Carter *v.* Baker (L. 1871), 4 Fisher, 404 ; 1 Sawyer, 512.

See also § 1063, note 10, *post.*

That the defendant's profits are usually the measure of the plaintiff's damages, though additional damages are occasionally required, see Littlefield *v.* Perry (E. 1874), 21 Wall. 205 ; 7 O. G. 964.

That the plaintiff's profit is the measure of damages if it be shown that the sales would have been made by him, see Blake *v.* Greenwood Cemetery (E. 1883), 16 Fed. Rep. 676 ; 25 O. G. 89 ; 21 Blatch. 222 ; American Saw Co. *v.* Emerson (E. 1880), 8 Fed. Rep. 806 ; McComb *v.* Brodie (L. 1872), 5 Fisher, 384 ; 2 O. G. 117 ; 1 Woods, 153.

That a receipt in full for the use of certain machines is admissible to lessen the damages *pro tanto*, see Burdell *v.* Denig (L. 1875), 92 U. S. 716.

That no damages are allowed unless the invention is proved to be useful, see

are not shown by the value of the use of the invention to the defendant, but are additional losses falling upon the plaintiff or his specific licensees in consequence of the infringement, and are to be proved by direct evidence in the mode before described.

§ 1063. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Indirect Evidence of the Extent of Injury when the Owner of the Patented Invention Makes and Sells it to the Public.

When the exclusive use of the invention by the plaintiff or his specific licensees assumes the second form, and consists in the manufacture and sale of the patented invention, indirect evidence of the loss sustained by the infringement is afforded by the profits made by the defendant upon his unlawful sales.[1] Here, as in the case of an infringing use of the invention, it cannot be assumed that the plaintiff would have sold all that the defendant sold, or that his percentage of profit would have been the same.[2] Nor, on the

Knight *v.* Baltimore & Ohio R. R. Co. (L. 1840), Taney, 106; 3 Fisher, 1.

That the defendant cannot show that the plaintiff's device was useless to him, if he used it, see Turrill *v.* Illinois Central R. R. Co. (E. 1873), 5 Bissell, 344.

§ 1063. [1] That the profits made by the defendant on infringing articles sold by him tends to show the amount of the plaintiff's loss, see Covert *v.* Sargent (E. 1889), 38 Fed. Rep. 237; Carter *v.* Baker (L. 1871), 4 Fisher, 404; 1 Sawyer, 512; Buck *v.* Hermance (L. 1849), 1 Blatch. 398.

[2] In Seymour *v.* McCormick (L. 1853), 16 How. 480, Grier, J.: (490) "It is only where, from the peculiar circumstances of the case, no other rule can be found, that the defendant's profits become the criterion of the plaintiff's loss. Actual damages must be actually proved, and cannot be assumed as a legal inference from any facts which amount not to actual proof of the fact. What a patentee 'would have made, if the infringer had not interfered with his rights,' is a question of fact and not 'a judgment of law.' The question is not what speculatively he may have lost, but what actually he did lose. It is not a 'judgment of law' or necessary legal inference that if all the manufacturers of steam-engines and locomotives who have built and sold engines with a patented cut-off, or steam-whistle, had not made such engines, that therefore all the purchasers of engines would have employed the patentee of the cut-off, or whistle; and that, consequently, such patentee is entitled to all the profits made in the manufacture of such steam-engines by those who may have used his improvement without his license. Such a rule of damages would be better entitled to the epithet of 'speculative,' 'imaginary,' or 'fanciful,' than that of 'actual.'"

A contrary doctrine has sometimes

contrary, can it be inferred that the plaintiff's loss is limited to what the defendant may have gained. When it is proved that the plaintiff was ready and able to supply the market, that those who would have been his customers have bought of the defendant, and that his expense in manufacturing and marketing the patented articles would not have exceeded that incurred by the defendant, it may safely be presumed that but for the infringement he would have made the profits which have been received by the defendant.[3] These essential connecting facts being established, the amount of the defend-

been held. Thus in Wilbur *v.* Beecher (L. 1850), 2 Blatch. 132, Nelson, J.: (143) "If the defendant has been guilty of violating the plaintiff's rights, the rule on the question of damages is, that the plaintiff is entitled to all the actual profits which the defendant has made by the use of the principle of the plaintiff's combination. In other words, the plaintiff is entitled to all the damages which he has sustained by reason of the use which the defendant has made of the plaintiff's property. This is, in effect, the same thing, because the law presumes that if the defendant had not put his machines into the market, the demand would have been for the plaintiff's, and that he would have received the profits on the machines which have been made and sold by the defendant. Vindictive or exemplary damages are not allowed. The jury are confined to the actual damages, and the law has provided that the court may increase those damages in proper cases."

Further, that it cannot be presumed that the plaintiff would have sold all that the defendant sold, see Roemer *v.* Simon (E. 1887), 31 Fed. Rep. 41; 40 O. G. 1456; Hall *v.* Stern (E. 1884), 20 Fed. Rep. 788; Ingersoll *v.* Musgrove (E. 1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304; Hawes *v.* Washburne (L. 1872), 5 O. G. 491; Carter *v.* Baker (L. 1871), 4 Fisher, 404; 1 Sawyer, 512; Goodyear *v.* Bishop (L. 1861), 2 Fisher, 154.

That it cannot be assumed that the plaintiff would have sold all the defendant sold, especially where defendant's articles are cheaper and of poorer quality, see Dobson *v.* Dornan (E. 1886), 118 U. S. 10; 35 O. G. 750.

[3] That where the plaintiff has had control of the market it will be presumed that he would have sold all that has been sold, and that all profits made by the defendant would have been made by him, see Gould's Mfg. Co. *v.* Cowing (E. 1882), 105 U. S. 253; 21 O. G. 1277.

That on proof of the quantity sold by the plaintiff during his first season with the profit on it, and of the quantity sold by the defendant during the second season and that plaintiff's sales declined, the measure of damages is the profit which would have accrued to the plaintiff if he had sold the quantity sold by the defendant, it being presumed that the plaintiff would have sold what the defendant did sell, see Bigelow Carpet Co. *v.* Dobson (E. 1882), 21 O. G. 1200; 10 Fed. Rep. 385.

That the jury may infer from circumstances such as diversion of custom, &c., that the plaintiff would have made the sales but for the infringement, see Covert *v.* Sargent (E. 1889), 38 Fed. Rep. 237.

ant's profits on his sales becomes an important indication of one element in the plaintiff's loss. The other elements are comprised in the injury which his own business may have suffered by the depreciation of demand or prices on account of the defendant's wrongful acts, and which is to be shown by direct evidence, in the manner already stated.[4] The profits arising from the sale of a patented article are represented by the difference between cost and yield. In its cost are included the expense for materials and interest thereon, the price paid for labor in making and selling, the manufacturer's profit on materials and labor, the rental value of the factory or store, and any other items which a manufacturer ordinarily reckons among the expenses of his business. Its yield is the price obtained by the infringer.[5] When the plaintiff's patent covers the entire article, the defendant's profit is thus ascertained by a simple process of computation upon the data afforded by the gross amount of his prices and expenses. But where the patent covers only a portion of the article, such as an improvement in a composition or machine, the profit due to the incorporation of the improvement into the article must be separated from the profit which would have been received by the defendant had this portion been omitted, and the latter profit be excluded from the computation.[6] If the article

[4] That injuries to the plaintiff's rights by reducing prices, etc., are additional grounds of recovery, see § 1061, notes 1 and 2, and § 1062, note 14, *ante*.

[5] In Rubber Co. *v.* Goodyear (E. 1869), 9 Wall. 788, Swayne, J. : (804) "The profits made in violation of the rights of the complainants in this class of cases, within the meaning of the law, are to be computed and ascertained by finding the difference between cost and yield. In estimating the cost, the elements of price of materials, interest, expenses of manufacture and sale, and other necessary expenditures, if there be any, and bad debts, are to be taken into the account, and usually nothing else. The calculation is to be made as a manufacturer calculates the profits of his business. 'Profit' is the gain made on any business or investment, when both the receipts and payments are taken into the account."

See also Piper *v.* Brown (E. 1873), 6 Fisher, 240 ; 3 O. G. 97 ; Holmes, 196; McCormick *v.* Seymour (L. 1851), 2 Blatch. 240 ; Wilbur *v.* Beecher (L. 1850), 2 Blatch. 132.

As to the items to be reckoned in estimating profits on sales of infringing articles, see further §§ 1138–1143, and notes, *post*.

[6] That the damages must be limited to the value of the use of the improvement infringed, see Burdell *v.* Denig (L. 1865), 2 Fisher, 588.

That where the entire invention be-

would, however, have been unsalable without this portion, or if through the defendant's fault in confusing this with the other portions of the article no separate estimate of profits can be made, the entire profit may be regarded as derived from the invention of the plaintiff.[7] In this inquiry into the

longs to the plaintiff the whole profit is regarded as due to it, see Welling *v.* La Bau (E. 1888), 43 O. G. 117.

That if the entire value of the defendant's device flows from the plaintiff's invention the entire profits belong to that invention, but otherwise they must be apportioned, see Hurlburt *v.* Schillinger (E. 1889), 130 U. S. 456; Fifield *v.* Whittemore (E. 1888), 38 Fed. Rep. 835; Reed *v.* Lawrence (E. 1886), 29 Fed. Rep. 915; Whitney *v.* Mowry (E. 1868), 4 Fisher, 141.

That the plaintiff must prove what portion of the profits are due to his invention, or else that the defendant's device is unsalable without it, see Fay *v.* Allen (E. 1887), 30 Fed. Rep. 446.

That evidence as to the special value of the part used by the infringer is not required where the rest is without value, see Asmus *v.* Freeman (E. 1888), 34 Fed. Rep. 902.

[7] In McCormick *v.* Seymour (L. 1854), 3 Blatch. 209, Nelson, J.: (224) "But if the patentee comes to the conclusion not to vend to others his rights under the patent, and not to avail himself of the proceeds of sales of his mere patent-right, but to use the patented invention exclusively himself, and to furnish the products to the community himself out of his own manufactory or establishment, — in such cases a different measure of damages is to be adopted by the jury. And that is this: If the patent is for a machine, — an entire machine, — the patentee is entitled, as damages in case of infringement, to the profits he could have made in constructing and vending his machine, over and above the mere profits arising out of its manufacture. By that we mean the mere profits of its mechanical construction, and not the profits that grow out of the exclusive right to manufacture the invention under the patent. The latter belong to the patentee, while the former — the mere mechanical profits — are excluded from the damages. And if the case is one of an improvement on a machine, then he is entitled, as a measure of damages, to all the advantages of the use of his patented improvement, excluding the profits of the manufacture, and excluding also the value, if any, of the use of the old machine. Now, so far as respects the benefits and advantages that a patentee would derive from an improvement on a machine, you see at once that they would depend very much, if not altogether, upon the usefulness of the machine with that improvement, compared with its usefulness without that improvement. Hence you have found in the course of the trial that witnesses have been introduced for the purpose of ascertaining the relative value of the plaintiff's machine with the improvements in controversy, and of the same machine without those improvements. If the machine stripped of those improvements would be a useless article in the market, and if no person would buy it unless those improvements were annexed to it, then its value, so far as its utility is concerned, depends on those improvements; because they give it vitality and usefulness in the eye of the business community. Hence, it is proper

amount of the defendant's profits, moreover, the actual profit made is alone to be considered.[8] It is immaterial how much

to make this discrimination in canvassing the facts bearing upon the proper measure of damages."

In McCormick *v.* Seymour (L. 1851), 2 Blatch. 240, Nelson, J. : (257) "It has been suggested by the counsel for the defendants that, inasmuch as the claims of the plaintiff in question here are simply for improvements upon his old reaping machine, the patent for which expired on the 21st of June, 1848, and not for an entire machine and every part of it, the damages should be limited in proportion to the value of the improvements thus made ; and that, therefore, a distinction exists, in regard to the rule of damages, between an infringement of an entire machine and an infringement of a mere improvement on a machine. I do not assent to this distinction. On the contrary, according to my view of the law regulating the *measure of damages in cases of this* kind, the rule which is to govern is the same whether the patent covers an entire machine or an improvement on a machine. Those who choose to use the old machine in this case, have a right to use it without incurring any responsibility. But if they engraft on it an improvement secured by a patent, and use the machine with that improvement, they have deprived the patentee of the fruits of his invention, the same as if he had invented the entire machine ; because it is his improvement that gives value to the machine, on account of the public demand for it. The old instrument is abandoned, and the public call for the improved instrument, and the whole instrument, with the improvement upon it, belongs to the patentee. Any person has a right to use the old machine, but if an inventor engrafts upon the old machine, which he has a right to use, an improvement that makes it superior to anything of the kind for the accomplishment of its purposes, he is entitled, under a patent for the improvement, to the benefit of the operation of the machine under all circumstances, with the improvement engrafted upon it, to the same degree in which the original patentee was entitled to the old machine." See a criticism on this language in Seymour *v.* McCormick (L. 1853), 16 How. 480.

That it cannot be assumed that the profit made by the plaintiff on each article sold by him is made by the defendant on each article sold by him, unless it is shown that the value of the article depends on the plaintiff's invention, see Roemer *v.* Simon (E. 1887), 31 Fed. Rep. 41 ; 40 O. G. 1456 ; Dobson *v.* Hartford Carpet Co. (E. 1884), 114 U. S. 439 ; 31 O. G. 787.

That where the defendant's device is useless without the plaintiff's, the entire profits are part of the damages, see Zane *v.* Peck Bros. (E. 1882), 23 O. G. 191 ; 13 Fed. Rep. 475 ; Carter *v.* Baker (L. 1871), 4 Fisher, 404 ; 1 Sawyer, 512.

That a defendant who wrongfully confuses his invention with the plaintiff's is liable for the entire profit, see Carter *v.* Baker (L. 1871), 4 Fisher, 404 ; 1 Sawyer, 512.

[8] That the plaintiff cannot recover profits unless the defendant made profits, see Elizabeth *v.* Pavement Co. (E. 1877), 97 U. S. 126 ; Vaughn *v.* Central Pacific R. R. Co. (E. 1877), 4 Sawyer, 280 ; 3 Bann. & A. 27.

That where the profits of the defendant are the proper measure of damages, the amount is governed by the profits the defendant actually made,

he might have realized with higher skill or diligence, since the only theory on which the evidence of his profits becomes admissible is that the plaintiff would have sold what he has actually sold, and has, therefore, lost what he has actually made.[9] In addition to such profits as the defendant has received, the plaintiff is also entitled to recover any excess which would have been included in his own profits had he supplied the market with a similar amount and quality of goods.[10] It being proved that he would have sold all that

not by what the plaintiff can show he might have made, see Burdell *v.* Denig (L. 1875), 92 U. S. 716.

[9] That the gain which the defendant might have made by diligence, etc., is no measure of the plaintiff's loss, though the actual gain might be, see New York *v.* Ransom (L. 1859), 23 How. 487; Dean *v.* Mason (E. 1857), 20 How. 198.

That articles sold before the issue of the patent cannot be reckoned in the account of profits or damages, see Lyon *v.* Donaldson (L. 1888), 34 Fed. Rep. 789.

[10] In Pitts *v.* Hall (L. 1851), 2 Blatch. 229, Nelson, J.: (238) "One mode of arriving at the actual damages is to ascertain the profits which the plaintiff derives from the machines which he manufactures and sells, and which have been made and sold by the defendant. This mode is founded on the presumption of law that if the defendant had not been wrongfully concerned in the manufacture of the machines, those persons who procured them from him would have applied to the patentee or assignee for them. Another mode, and the one resorted to partially in this case, is to ascertain the profits which the party infringing has derived from the use of the invention or the construction of the machines; because whatever profits he has derived have arisen from the wrongful use of the invention, and belong to the real owner of the machine. This measure of damages, however, is not controlling, and ought not to be; because a party concerned in infringing a patent stands in a different position from the patentee, not having been previously subjected to the expense and labor to which the latter is frequently exposed in the process of invention and experiment. Hence the person who enters upon the business without previous expense may very well afford to sell machines at less profit than the patentee. The latter must have his profit, not only for the expense of putting in operation the improvement, but by way of indemnity for the previous time, labor, and money which he has been obliged to bestow on the invention. He must, therefore, charge a higher price, to cover these greater expenses. Thus profits which the party infringing might be satisfied with, and which would afford him compensation, would not afford indemnity to the patentee. If, therefore, on looking into the profits made by the defendant, the jury shall be of opinion that they do not correspond with the fair profits which the plaintiff, if left alone, would have realized, they are not bound by the measure of the profits of the defendant, but have a right to look to the profits which the plaintiff or the patentee would have made under the circumstances, if not interfered with."

Further, that the excess of the plaintiff's profits over the defendant's may be

the defendant sold, and that his expense of manufacture would not have been greater than that of the defendant, it is evident that he would have derived an equal profit if his sales had been effected at the same prices. But if he could have made the articles at less expense, or sold them at a higher price, than the defendant did, his loss exceeds the profit of the defendant by whatever sum may cover this difference between the profit which he would have realized and that which the defendant has obtained. The testimony concerning the amount of the defendant's sales and profits is generally elicited by subjecting him to examination as a witness, in connection with his books of account, though any other relevant evidence may be offered.

§ 1064. Evidence Concerning Damages: Monopoly Enjoyed by the Exclusive Practice of the Invention: Evidence of the Extent of Injury where the Infringing Acts Differ from those by which the Monopoly is Enjoyed.

The acts of infringement performed by the defendant do not always correspond with those by which the plaintiff or his specific licensees enjoy the patented invention. Where their advantage is derived from the use of the invention and a sale of its products, the defendant may infringe by making and selling the patented article itself. Or while they seek their profit in its manufacture and sale, he may make and use it only in his individual business. In such cases the loss sustained by the plaintiff must be determined in a different manner. When the defendant makes and sells an instrument, the use of which is confined by the plaintiff to himself and certain licensees, the sale no otherwise affects the plaintiff than as it puts the invention into the hands of others to be used by them

added to the latter in computing damages, where the jury are satisfied that the plaintiff would have sold all the defendant has sold, see Hobbie *v.* Smith (L. 1886), 27 Fed. Rep. 656; Zane *v.* Peck Bros. (E. 1882), 13 Fed. Rep. 475; 23 O. G. 191; Carter *v.* Baker (L. 1871), 4 Fisher, 404; 1 Sawyer, 512.

The evidence necessary to show this excess and the circumstances from which the jury would be justified in believing that the plaintiff's sales would have covered those made by the defendant, must in most if not all cases be equivalent to direct evidence of the loss occasioned to the plaintiff by the defendant's infringement, and thus require no investigation of the profits of the latter.

in methods hostile to his own. The purchasers and users thus become the principal infringers, and liable for the actual damages resulting from their infringing use. The maker and seller may be held responsible for all these damages, in addition to that arising from the act of sale, on the ground of his concurrence in their acts of user, or on the ground that in the price which he received the value of such use must be presumed to have been included.[1] If neither of these grounds is tenable, the sale must be regarded as an independent infringement, and its evil effect, if any, on the sales and prices of the plaintiff's products must be the measure of his actual injury. If no such evil effect follows from the sale, the damages are only nominal. When the plaintiff enjoys his monopoly by the manufacture and sale of the patented articles, and the defendant infringes by making and using the articles in his individual business, the amount of profit which the plaintiff would have gained if the defendant had bought the articles of him is the measure of his loss, and consequently of his actual damages. Ordinarily, the mere making of the invention, without using or selling it, does not interfere with the plaintiff's enjoyment, and though an infringement of the patent is compensated for by nominal damages.[2]

§ 1064. [1] That one who makes and sells a patented invention, or the parts of a patented invention, with intent that the articles sold shall be used in violation of the patent, becomes thereby a joint tort-feasor with the actual users, and may be sued singly or together with them for the damages inflicted on the plaintiff, see §§ 903, 924, and notes, *ante*.

[2] In Whittemore *v.* Cutter (L. 1813), 1 Gallison, 478; Story, J.: (483) "If the jury are of opinion that an user of the machine is actually proved in this case, the rule of damages should be the value of the use of such a machine during the time of the illegal user. If the jury are of opinion that a making of the machine only is proved, as there is no evidence in the case to shew any actual damages by the making, they ought to give nominal damages to the plaintiffs. For where the law has given a right, and a remedy for the violation of it, such violation of itself imports damage; and in the absence of all other evidence the law presumes a nominal damage to the party. The counsel for the plaintiffs have argued that although there is 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. But neither of these estimates can 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

§ 1065. Effect of Recovery of Damages upon the Future Rights of the Defendant.

The effect of a recovery of damages upon the future rights of the defendant, and of those who claim under him, depends upon the measure adopted for the estimation of such damages. When the measure is an established license fee, payable in a gross sum and covering the entire term of the patent, the defendant, having satisfied the judgment, becomes entitled to enjoy the licensed privilege during the remainder of the term. If the measure is a license fee paid in royalties based upon quantities or sales, or in periodical instalments, and the license privilege is unrestricted in duration, he may continue to employ the invention upon the same conditions after judgment as are allowed to other licensees.[1] But if the plaintiff's

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, viz., the future user of the defendant's machine, so that there might be a double recovery for the same supposed injury." 1 Robb, 40 (45). See also Carter *v.* Baker (L. 1871), 4 Fisher, 404; 1 Sawyer, 512.

§ 1065. [1] In Spaulding *v.* Page (1871), 4 Fisher, 641, Sawyer, J.: (645) "This was so held by Mr. Justice Nelson in his charge to the jury in Sickels *v.* Borden, 3 Blatch. 536. If the principles stated in that case be correct, I think it decisive of this case. The learned justice stated to the jury that if the patentee has an established price in the market for his patent right, or what is called a patent fee, that sum with the interest constitutes the measure of damages. He also stated that the adoption of the patent fee, as the measure of damages for infringement by the use of a machine, operates to vest in the defendant the right to use the machine during the term of the patent. Ib. 543, 545. This must be upon the principle that the patentee has adopted a patent fee, or royalty, as one mode of remuneration, and in the fee has fixed his own measure of the value of the use of the machine for the entire term, or till that particular machine is worn out; and in case of an infringement the court gives him his price, and the defendant, having paid the full price, is entitled henceforth to the use of the machine." 1 Sawyer, 702 (705). See also Stutz *v.* Armstrong (1885), 25 Fed. Rep. 147; Emerson *v.* Simm (1873), 6 Fisher, 281; 3 O. G. 293; Sickels *v.* Borden (1856), 3 Blatch. 535.

That where a plaintiff exercises his rights by selling licenses the defendant

use of the invention is exclusive, or if he preserves a monopoly in its sale, the satisfaction of the judgment confers on the defendant no right to any future use or sale.[2] His vendees, under sales for which he has already made compensation to the plaintiff, have an implied license to use the purchased articles until they are destroyed, but neither the judgment nor its payment authorizes any repetition of the acts for which the damages have been recovered.[3] These damages are esti-

will be allowed to take a license on reasonable terms, see Colgate *v.* Gold & Stock Telegraph Co. (1879), 16 O. G. 583 ; 4 Bann. & A. 415 ; 16 Blatch. 503.

That where there is an established license fee the plaintiff may, in some cases not falling within the license, recover damages only for the past infringement, and restrain the defendant for the future, see Stutz *v.* Armstrong (1885), 25 Fed. Rep. 147.

[2] In Spaulding *v.* Page (1871), 4 Fisher, 641, Sawyer, J.: (645) "If no patent fee has been adopted, then generally the patentee is entitled to recover the profits made in the use of the machine. A recovery of the profits for the use of the machine does not vest the title in the defendant, for the recovery, based upon this rule of damages, can only be for the use of the machine prior to the recovery, and ordinarily does not cover the value of the use for the entire period over which the patent right extends, or the period during which the particular machine is capable of being used. While the recovery of the established patent fee covers the entire value as fixed by the patentee himself, of the use for the entire term, and affords a complete compensation, the recovery of the profits for the use is but for a limited portion of the time, and but a partial compensation." 1 Sawyer, 702, (706). See also Sickels *v.* Borden (1856), 3 Blatch. 535.

That a decree for damages gives no right to use the invention during the life of the patent, see Birdsell *v.* Shaliol (1884), 112 U. S. 485 ; 30 O. G. 261.

That the satisfaction of a judgment for damages gives no right to a future use of the invention, see Bragg *v.* City of Stockton (1886), 11 Sawyer, 597 ; 27 Fed. Rep, 509 ; Matthews *v.* Spangenberg (1883), 23 O. G. 1624 ; 15 Fed. Rep. 813.

That a judgment for nominal damages does not operate as a license for the future, see Blake *v.* Greenwood Cemetery (1883), 25 O. G. 89 ; 21 Blatch. 222 ; 16 Fed. Rep. 676.

That a judgment for nominal damages with satisfaction in favor of a licensor is not a bar to a suit by the licensee against a subsequent user of the article sold by the former defendant, see Birdsell *v.* Shaliol (1884), 112 U. S. 485 ; 30 O. G. 261.

[3] In Steam Stone Cutter Co. *v.* Sheldons (1884), 21 Fed. Rep. 875, Wheeler, J.: (878) "There is another view of this question which has been touched upon formerly in this case, and that is that the recovery of the profits of the sale for use vested the title to the use in the purchaser of the machines. (Stone Cutter Co. *v.* Sheldons, 15 Fed. Rep. 608.) It was upon this ground that the recovery of the profits against the Windsor Manufacturing Co. was based. (Stone Cutter Co. *v.* Windsor Manufacturing Co., 17 Blatch. 24.) This view is supported by several decided

mated only in view of acts performed before the suit was instituted for the infringement, and any subsequent acts of the same character are new injuries demanding similar redress.

§ 1066. Interest on Damages: when Recoverable.

The interest allowable upon the items which enter into the foregoing estimate of actual damages also depends upon the measure which has been adopted for determining the plaintiff's loss. In all cases where this measure is a license fee, however payable, interest is to be computed from the date on which, in the usual course of business, it should have been paid to the plaintiff.[1] When the amount is fixed by the value of the use of the invention to the defendant or by the profits on his sales, the date of his reception of the benefit or profits is that from which the interest should be reckoned.[2] When

cases (Perrigo *v.* Spaulding, 13 Blatch. 389; Spaulding *v.* Page, 1 Sawyer, 702; Allis *v.* Stowell, 15 Fed. Rep. 242); and it is not inconsistent with Blake *v.* Greenwood Cemetery, 16 Fed. Rep. 676. There merely nominal damages had been recovered against a manufacturer of the infringing machine with an injunction. The defendant purchased the machine and set up the former recovery as a bar to a recovery for the infringement by its use by him. This was held to be no bar, because there had been no recovery for this use, or for the profits or damages on a sale for use. Where an owner of a patent has compensation for the sale of a specific machine embodying the invention, that machine is forever freed from the monopoly. (Bloomer *v.* Millinger, 1 Wall. 340.) A compensation by recovery in an action for the same thing should have the same effect." 22 Blatch. 484 (487). See also § 830, and notes, *ante*.

That the settlement of the vendor with the patentee for past infringements does not protect vendees subsequently purchasing, see Matthews *v.* Spangenberg (1882), 23 O. G. 92; 20 Blatch. 482; 19 Fed. Rep. 823.

That a plea alleging a former recovery against the defendant's vendor must show that the judgment has been satisfied or it does not disclose a defence, see Fisher *v.* Consolidated Amador Mine Co. (1885), 11 Sawyer, 190; 25 Fed. Rep. 201.

§ 1066. [1] That interest is allowed on license fees, see Sickels *v.* Borden (1856), 3 Blatch. 535.

[2] That the value of the damages is the value at the time of the infringement, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

That interest is allowed by way of damages, see Bates *v.* St. Johnsbury & L. C. R. R. Co. (1887), 32 Fed. Rep. 628; Tatham *v.* Le Roy (1852), 2 Blatch. 474.

It is indeed sometimes held that interest on the profits made by the defendant cannot be awarded, the rule appropriate to unliquidated damages being also here applied (see Tilghman *v.* Proctor (E. 1888), 125 U. S. 136; 43 O. G. 628; Illinois Central R. R. *v.*

the amount of damages is based upon the injury directly inflicted on the plaintiff's own enjoyment of the invention, as shown by his diminished sales or prices, the date of the suit is the period at which the damages are complete and the interest begins.[3] Whenever commencing, interest continues to the date of judgment, and should be included in the amount awarded to the plaintiff.[4]

§ 1067. Counsel Fees, etc., not Recoverable as Damages.

Counsel fees and other expenses of the litigation do not enter into the estimate of actual damages.[1] They are in-

Turrill (E. 1884), 110 U. S. 301 ; 26 O. G. 917 ; Parks *v.* Booth (E. 1880), 102 U. S. 96 ; 17 O. G. 1089). Upon the theory, however, that the profits actually received by the defendant would, but for the infringement, have been paid to the plaintiff (which is the only view in which such profits can be regarded at all in an action at law), it would certainly appear that the plaintiff's loss became complete when the profit was realized by the defendant, that its amount in each case was at the same time definitely settled, and that this amount with interest was, as in actions for conversion or for money had and received, the only and true measure of recovery. Thus in Creamer *v.* Bowers (E. 1888), 35 Fed. Rep. 206, Wales, J., (210) : "The general rule is that interest should be allowed on royalties from the time those royalties ought to have been paid, in all cases where a royalty is the measure of the complainant's damages, — the theory in such cases being that damages are liquidated at such time as the royalty would have been due, if the defendant had elected to purchase instead of to infringe the right to the use of the invention in suit, but that no interest is due on damages measured otherwise than by royalty, because such damages are unliquidated until they are ascertained by an action. But the latter part of this rule is subject to exceptions, and in equity the allowance of interest appears to have been left largely to the discretion of the court. On reason, it is difficult to conceive why, where a patentee's loss is ascertained to have been incurred at a certain time, interest should not begin to run from that time, whether the loss was measured by a royalty or by other equally conclusive evidence of the fact." See also Bates *v.* St. Johnsbury & L. C. R. R. Co. (1887), 32 Fed. Rep. 628. As the account of profits in equity is based on an entirely different theory, the rule there may well be different. See § 1152 and notes, *post*.

[3] In this case the damages are truly unliquidated, and cannot be ascertained until the verdict, and then by an arbitrary decision based on such evidence as may be offered. The period of damage terminates only at the commencement of the suit and the amount of loss to the plaintiff now becomes a definite and interest-bearing sum. In this respect the infringement resembles trespasses to person or property, in actions for which no interest is awarded.

[4] That interest on damages from the date of suit may be recovered, see May *v.* County of Fond du Lac (1886), 27 Fed. Rep. 691 ; McCormick *v.* Seymour (1851), 2 Blatch. 240.

§ 1067. [1] In Teese *v.* Huntingdon

curred, not in consequence of the infringement, but of the defendant's neglect or refusal to make compensation for the injury without a suit, and such of the items of expense as are legally chargeable to the defendant are taxable against him among the costs. The power, given to the court, of increasing the damages in certain cases, enables it to protect the plaintiff against serious loss in this respect, and to punish the defendant for any wanton and unreasonable defiance of the plaintiff's claims.[2]

§ 1068. Nominal Damages: when Recoverable.

When the plaintiff fails to prove an established license fee, or a depreciation of the value of his exclusive use by the infringement, he can recover only nominal damages.[1] Even

(1859), 23 How. 2, Clifford, J.: (8) "Counsel fees are not a proper element for the consideration of the jury in the estimation of damages in actions for the infringement of a patent right. That point has been directly ruled by this court, and is no longer an open question. Jurors are required to find the actual damages incurred by the plaintiff at the time his suit was brought; and if, in the opinion of the court, the defendant has not acted in good faith, or has caused unnecessary expense and injury to the plaintiff, the cou may render judgment for a larger sum, not exceeding three times the amount of the verdict." See also Parks *v.* Booth (1880), 102 U. S. 96; 17 O. G. 1089; Philp *v.* Nock (1873), 17 Wall. 460; Bancroft *v.* Acton (1870), 7 Blatch. 505; Blanchard's Gun Stock Turning Factory *v.* Warner (1848), 1 Blatch. 258; Stimpson *v.* Railroads (1847), 1 Wall. Jr. 164; 2 Robb, 595; Whittemore *v.* Cutter (1813), 1 Gallison, 429; 1 Robb, 40.

That expenses of suit are never allowed in assessing damages or profits, see Parks *v.* Booth (1880), 102 U. S. 96; 17 O. G. 1089; Holbrook *v.* Small (1878), 17 O. G. 55; 3 Bann. & A. 625; Philp *v.* Nock (1873), 17 Wall. 460; Parker *v.* Hulme (1849), 1 Fisher, 44; Blanchard's Gun Stock Turning Factory *v.* Warner (1848), 1 Blatch. 258; Stimpson *v.* Railroads (1847), 1 Wall. Jr. 164; 2 Robb, 595.

[2] That when a verdict included counsel fees and expenses, and no exception was taken, the verdict was allowed to stand, as the court would reach the same result by increasing the damages, see Stimpson *v.* Railroads (1847), 1 Wall. Jr. 164; 2 Robb, 595.

§ 1068. [1] That unless some measure of actual damages is clearly proved, only nominal damages can be awarded, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 28 O. G. 1007; 19 Fed. Rep. 514; Faulks *v.* Kamp (1882), 10 Fed. Rep. 675; 22 O. G. 2244; Fisk *v.* West, Bradley, & Cary Mfg. Co. (1880), 19 O. G. 545; Ingersoll *v.* Musgrove (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304; Robertson *v.* Blake (1876), 94 U. S. 728; 11 O. G. 877; Philp *v.* Nock (1873), 17 Wall. 460; Campbell *v.* Barclay (1870), 5 Bissell, 179; Poppenhusen *v.* New York Gutta Percha

when actual damages are clearly shown, nominal damages alone may be awarded if the defendant has been misled by the plaintiff under circumstances out of which a complete estoppel to the action does not arise.[2] A jury have no power to go beyond the evidence in this particular, and give substantial damages where nominal damages only are appropriate. Such an error in their verdict is a fatal one, and cannot be cured by a *remittitur*, but the verdict must be set aside by the court and a new trial ordered.[3] A verdict for excessive actual damages, when actual damages are proper, can, however, be accepted, and upon a suitable *remittitur* be made the basis of a judgment, though no objection to a verdict on this ground will be regarded unless the excess is evident.[4]

Comb Co. (1858), 2 Fisher, 62. See also § 1071, and notes, *post*.

That if the plaintiff has claimed a close monopoly and the defendants show that he did not preserve it, he must prove a license fee or he can recover only nominal damages, see Burdell *v.* Denig (1865), 2 Fisher, 588.

That if open methods are equally cheap and useful, and no license fee is proved, only nominal damages are allowed, see Black *v.* Thorne (E. 1883), 111 U. S. 122; 27 O. G. 415. But see § 1062, note 7, *ante*.

That only nominal damages are allowed where the license offered to show the measure of damages covers two patents, one of which is void, and the value of the infringement of the other is not proved, see Moffitt *v.* Cavanagh (1886), 27 Fed. Rep. 511.

That when only one Claim of the patent is found valid, and no license fee is proved therefor, only nominal damages can be awarded, see Proctor *v.* Brill (1880), 4 Fed. Rep. 415.

That nominal damages alone are recoverable where only certain Claims of the patent, and those of little importance, were infringed, see Moffitt *v.* Cavanagh (1886), 27 Fed. Rep. 511.

That mere nominal damages should not be allowed if the invention is valuable, though the question of actual damages is difficult to settle, see Graham *v.* Genova Lake Crawford Mfg. Co. (1885), 32 O. G. 1603; 24 Fed. Rep. 642.

That for the mere making without sale or use only nominal damages are allowed, see Carter *v.* Baker (1871), 4 Fisher, 404; 1 Sawyer, 512; Whittemore *v.* Cutter (1813), 1 Gallison, 429; 1 Robb, 28; Whittemore *v.* Cutter (1813), 1 Gallison, 478; 1 Robb, 40.

[2] That where the defendant has been misled by the plaintiff, only nominal damages will be allowed, see Adams *v.* Edwards (1848), 1 Fisher, 1.

That only nominal damages are allowed unless the plaintiff's device was stamped or due notice was given, see McComb *v.* Brodie (1872), 5 Fisher, 384; 2 O. G. 117; 1 Woods, 153.

That no damages can be awarded for infringements to which the plaintiff consented, see Westlake *v.* Cartter (1873), 6 Fisher, 519; 4 O. G. 636.

[3] That where the court instructs the jury to give only nominal damages and they obstinately give more, a new trial must be had, and the error is not cured by *remittitur*, see Johnson *v.* Root (1862), 2 Fisher, 291; 2 Clifford, 108.

[4] That where the verdict was exces-

§ 1069. **Increase of Damages by the Court.**

In order to provide for cases in which a verdict for the actual damages sustained would not afford complete redress to the plaintiff, the law empowers the court to increase the award of the jury to an amount not exceeding three times that fixed by the verdict.[1] This is distinctively the province of the court, and confers no authority upon the jury, on any ground, to transcend the limits of the actual damages which have been established by the evidence.[2] The court exercises this power principally in cases of wanton infringement, or where the defendant has compelled the plaintiff to resort to needless and expensive litigation.[3] Where the plaintiff is a mere assignee for speculative purposes and not a *bona fide* user of the invention,[4] or where the defendant has acted in

sive and it appeared that the defendant infringed wantonly, no new trial was allowed, but the damages were reduced by a *remittitur*, and then increased by the court, see Russell *v.* Place (1871), 5 Fisher, 134; 9 Blatch. 173.

That damages are not considered excessive unless clearly too great, see Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530; Whitney *v.* Emmett (1831), Baldwin, 303; 1 Robb, 567. See also §§ 1052, 1053, and notes, *ante*.

§ 1069. [1] Sec. 4919, Rev. Stat. 1874.

That where a license fee is the measure of damages, the court may increase the amount, see Clark *v.* Wooster (1886), 119 U. S. 322; 37 O. G. 1477.

[2] That the verdict of the jury must be confined to the actual damages, and the court may then treble them, see Judson *v.* Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539; Birdsall *v.* Coolidge (1876), 93 U. S. 64; 10 O. G. 748; Smith *v.* Higgins (1859), 1 Fisher, 537; Ransom *v.* Mayor of New York (1856), 1 Fisher, 252; Gray *v.* James (1817), Peters, C. C. 394; 1 Robb, 120; Whittemore *v.* Cutter (1813), 1 Gallison, 478; 1 Robb, 40.

[3] That the discretion to treble damages was given to the court to meet cases of wilful wrong where the jury did not give enough, see Russell *v.* Place (1871), 5 Fisher, 134; 9 Blatch. 173; Merchant *v.* Lewis (1857), 1 Bond, 172; Motte *v.* Bennett (1849), 2 Fisher, 642.

That the damages are to be trebled where the invention is valuable, the piracy wanton, the litigation expensive, and the verdict small, see Schwarzel *v.* Holenshade (1866), 3 Fisher, 116; 2 Bond, 29.

That the court can increase the damages found by the verdict, but should exercise this power only when the plaintiff is compelled to vindicate himself against wanton and persistent infringement, see Brodie *v.* Ophir Silver Mining Co. (1867), 4 Fisher, 137; 5 Sawyer, 608. See also Lyon *v.* Donaldson (1888), 34 Fed. Rep. 789.

That damages will be increased if the defendant perseveres in the infringement after notice, or combines with others to resist the plaintiff's suit, see Peek *v.* Frame (1871), 5 Fisher, 113; 9 Blatch. 194.

[4] In Schwarzel *v.* Holenshade (1866), 3 Fisher, 116; Leavitt, J.: (119)

good faith, or under the protection of a rival patent, the plaintiff will be left to the compensation given him by the jury.[5]

"Cases may be readily conceived in which it would be the imperative duty of a court to exercise the discretion given by the statute, by increasing the damages. It has happened, and may occur again, that a meritorious inventor of a valuable improvement, after spending years of patient thought and toil in making it practically useful, and obtaining a patent for it, has been wantonly and unjustly pirated upon, and compelled for the establishment of his rights to engage in long, vexatious, and expensive litigation, in which, at last, the sum that may be awarded by the verdict of a jury may be wholly inadequate as a compensation for the wrongs and injuries he has sustained. In such a case the instincts of justice would demand of a judge that he should exercise the discretion vested in him by law, by trebling the damages and thus as far as practicable doing justice to one who, from the great utility of his invention, may be entitled to the name of a public benefactor. But clearly there is no such feature in the present case. The plaintiff has no claim or merit as an inventor, but is the mere assignee of a patented machine, the right to which he has purchased on speculation. The law under such circumstances will give him the actual damages which his evidence shows he has sustained, but will give him nothing more." 2 Bond, 29 (33).

That power is given to the court to treble the damages in order to remunerate patentees who are compelled to sustain their patents against malicious infringers, not to benefit mere collectors on expired patents, see Bell *v.* McCullough (1858), 1 Fisher, 880; 1 Bond, 194.

[5] In American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764, Nixon, J.: (770) "It is proper to premise that there is nothing in the case which authorizes the court, if it had the power and were so disposed, to visit upon the defendants any consequences in the nature of a penalty. They were not wanton infringers. They were proceeding under an authority equal on its face to that of complainant, to wit, a patent from the Government of the United States, and they had a right to assume that it was valid until a competent tribunal declared to the contrary. They are not to be treated like another class of infringers — unhappily too large — who, without a pretext of right, seize upon the inventions or property of others, and trust to the ignorance, or the poverty, or the kind-heartedness of the owners, for immunity in retaining their piratical gains. All that the defendants should be required to do in the present case is simply to restore to the complainant the money which the use of its property had enabled them to make." 1 Bann. & A. 439 (457). See also Adams *v.* Edwards (1849), 1 Fisher, 1.

That where the defendant believed himself to be in the right, the damages will not be increased on the ground that he stoutly contested the case, see Welling *v.* La Bau (1888), 35 Fed. Rep. 302.

That the good faith of the infringer is a reason for not increasing the damages, see Hogg *v.* Emerson (1850), 11 How. 587.

That the ignorance of the infringer may be considered, see Parker *v.* Hulme (1849), 1 Fisher, 44.

Among the above are cases in which it was held that the facts named might lessen the damages. If this implies that actual damages may be reduced in view of the defendant's good faith, &c., the position is not sustainable, the plaintiff

An increase may be made in proper cases though no costs could be allowed on account of a disclaimer pending suit.[6]

§ 1070. Distribution of Damages Recovered among Different Plaintiffs.

Where there are several plaintiffs, each entitled to his individual proportion of the damages recovered, no mention of the share of each is necessary in the verdict.[1] The entire sum may be awarded in gross and paid by the defendant upon the execution or into court, and from this sum the different plaintiffs will receive their respective amounts.[2] In a suit by one part owner against another the plaintiff is entitled only to such a portion of the actual damages as is commensurate with his interest in the patent.[3] The damages recovered in a suit by an executor belong to the estate if the infringement occurred during the life of his testator, but if after his death to those equitable owners of the patent of whom the executor is the representative.[4]

§ 1071. Burden of Proof on the Question of Damages.

The burden of proof in reference to the existence and amount of damages resting upon the plaintiff, he must produce sufficient evidence to satisfy the jury that he has sustained actual damages, and must furnish the necessary data for their computation, before the defendant can be required to

being entitled to compensation without regard to the motive of the defendant. But the discretion of the court to increase the damages may properly be governed by these and similar considerations.

[6] That courts may increase the damages even where no costs can be allowed because no disclaimer was filed, see Guyon *v.* Serrell (1847), 1 Blatch. 244.

§ 1070. [1] That a recovery by joint plaintiffs is in proportion to their respective interests, see Campbell *v.* James (E. 1880), 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354; 2 Fed. Rep. 338.

[2] That where several plaintiffs in interest recover in equity, the court will allow the defendant to pay the gross sum into the registry instead of his share to each, see Campbell *v.* James (E. 1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354.

[3] That part owners suing each other for infringement recover in proportion to their respective interests, see Herring *v.* Gas Consumers Association (E. 1878), 9 Fed. Rep. 556; 21 O. G. 203; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253.

[4] That the damages recovered in a a suit by an executor belong to the estate, see Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351.

offer anything whatever on the subject.[1] While the plaintiff's case on this point remains unproved, irregularities in the

§ 1071. [1] In New York *v.* Ransom (1859), 23 How. 487, Grier, J.: (488) "Where a plaintiff is allowed to recover only actual damages, he is bound to furnish evidence by which the jury may assess them. If he rest his case after merely proving an infringement of his patent, he may be entitled to nominal damages, but no more. He cannot call on a jury to guess out his case without evidence. Actual damages must be calculated, not imagined, and an arithmetical calculation cannot be made without certain data on which to make it."

Further, that the plaintiff must affirmatively show the amount of his loss or give the jury sufficient data from which to compute it, see Rude *v.* Westcott (1889), 130 U. S. 152; Bell *v.* U. S. Stamping Co. (1887), 32 Fed. Rep. 549; Tuttle *v.* Gaylord (1886), 36 O. G. 694; 28 Fed. Rep. 97; Cornely *v.* Marckwald (1885), 32 Fed. Rep. 292; 23 Blatch. 163; National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514; 28 O. G. 1007; Maier *v.* Brown (1883), 17 Fed. Rep. 736; Fitch *v.* Bragg (1883), 16 Fed. Rep. 243; 21 Blatch. 302; Calkins *v.* Bertrand (1881), 8 Fed. Rep. 755; 10 Bissell, 445; Garretson *v.* Clark (1879), 16 O. G. 806; 4 Bann. & A. 536; Ingersoll *v.* Musgrove (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304; Gould's Mfg. Co. *v.* Cowing (1877), 3 Bann. & A. 75; 12 O. G. 942; 14 Blatch. 315; Robertson *v.* Blake (1876), 94 U. S. 728; 11 O. G. 877; Buerk *v.* Imhaeuser (1876), 10 O. G. 907; 14 Blatch. 19; 2 Bann. & A. 452; Gould's Mfg. Co. *v.* Cowing (1874), 8 O. G. 277; 12 Blatch. 243; 1 Bann. & A. 375; Philp *v.* Nock (1873), 17 Wall. 460; Carter *v.* Baker (1871), 4 Fisher, 404; 1 Sawyer, 512; Campbell *v.* Barclay (1870), 5 Bissell, 179; Schwarzel *v.* Holenshade (1866), 3 Fisher, 116; 2 Bond, 29; Goodyear *v.* Bishop (1861), 2 Fisher, 154; Poppenhusen *v.* New York Gutta Percha Comb Co. (1858), 2 Fisher, 62.

That the burden of proof rests on the plaintiff to show the amount of profits made by the defendant from the infringement, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628; Faulks *v.* Kamp (1882), 10 Fed. Rep. 675; 22 O. G. 2244; Kirby *v.* Armstrong (1881), 5 Fed. Rep. 801; 19 O. G. 661; 10 Bissell, 135; Garretson *v.* Clark (1879), 16 O. G. 806; 4 Bann. & A. 536; Black *v.* Munson (1877), 14 Blatch. 265; 2 Bann. & A. 623; Robertson *v.* Blake (1876), 94 U. S. 728; 11 O. G. 877; Buerk *v.* Imhaeuser (1876), 2 Bann. & A. 452; 10 O. G. 907; 14 Blatch. 19.

That unless the plaintiff shows what profits are due to his exact invention, only nominal damages can be recovered, see Byerly *v.* Cleveland Linseed Oil Works (1887), 31 Fed. Rep. 73; Roemer *v.* Simon (1887), 40 O. G. 1456; 31 Fed. Rep. 41; Bostock *v.* Goodrich (1885), 34 O. G. 1047; 25 Fed. Rep. 819; Garretson *v.* Clark (1884), 111 U. S. 120; 27 O. G. 524; National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 28 O. G. 1007; 19 Fed. Rep. 514; Kirby *v.* Armstrong (1881), 19 O. G. 661; 10 Bissell, 135; 5 Fed. Rep. 801; Gould's Mfg. Co. *v.* Cowing (1877), 12 O. G. 942; 14 Blatch. 315; 3 Bann. & A. 75; Gould's Mfg. Co. *v.* Cowing (1874), 8 O. G. 277; 12 Blatch. 243; 1 Bann. & A. 375; Burdell *v.* Denig (1865), 2 Fisher, 588.

That a plaintiff must show what profits or damages are attributable to the infringing design, see Dobson *v.* Dornan (1886), 118 U. S. 10; 35 O.

rejection or reception of the defendant's evidence are, therefore, of no consequence and cannot be made the occasion for review on writ of error.[2] But the plaintiff is not obliged to produce such testimony as removes all reasonable doubt. The inquiry is to be conducted on the same principles as any other investigation into an amount of damages, and especially when the infringement has been wilful must the evidence be liberally interpreted in favor of the plaintiff.[3] After he has shown that his entire loss has resulted from the infringement, and has refuted all the defendant's suggestions as to contributory causes, he is not obliged to controvert all other possible causes and exclude every hypothesis except that which he maintains.[4]

§ 1072. Order in which Evidence is Produced in Court.

When the pleadings are closed upon the general issue, whether with or without notice, the plaintiff goes forward at the trial, and must introduce the evidence required to make out a *prima facie* case upon all the averments in his declaration. The letters-patent, or a certified copy thereof, being

G. 750; Dobson *v.* Dornan (1885), 114 U. S. 439; 31 O. G. 786.

That there is no presumption that all the defendant's goods infringed because some did, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

[2] That the defendant's evidence is of no consequence until the plaintiff establishes his claim to profits or damages, and objections to its admissibility will not be considered, see Garretson *v.* Clark (1878), 14 O. G. 485; 15 Blatch. 70; 3 Bann. & A. 352; Black *v.* Munson (1877), 14 Blatch. 265; 2 Bann. & A. 623.

[3] That the plaintiff is entitled to substantial damages if he furnishes reasonably satisfactory evidence, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

That where wanton infringers conceal their profits, and the plaintiff gives some available evidence as to the amount, he may recover them, see Creamer *v.* Bowers (E. 1888), 35 Fed. Rep. 206.

That in cases of wilful infringement the defendant is held to rigid accountability, and there is no presumption in his favor as to the inconclusiveness of the plaintiff's proof, but such proof is interpreted liberally for the plaintiff, see Bigelow Carpet Co. *v.* Dobson (1882), 21 O. G. 1200; 10 Fed. Rep. 385; 15 Phila. 476.

[4] That after the plaintiff has shown that the defendant's infringement had caused his entire damage, and has refuted all the defendant's suggestions as to contributory causes, he need not disprove all possible causes not claimed as existing, see Fitch *v.* Bragg (1883), 16 Fed. Rep. 243; 21 Blatch. 302.

produced and offered, sufficiently prove their own validity as well as the patentability of the invention.[1] Some writers, indeed, assert that in addition to the patent extraneous testimony of the novelty and utility of the invention, and of the completeness and precision of the specification, should be presented; but the courts having held that the patent is *prima facie* evidence on these points, it would seem to be unnecessary though frequently practised. The plaintiff must then prove his title, either by the patent if he is the patentee, or by the proper documentary evidence if he is an assignee or grantee.[2] Evidence of the performance of the infringing acts by the defendant, and of the identity of the invention which he sells or uses with that covered by the plaintiff's patent, must be also laid before the jury, and the data given for an estimate of the damages sustained.[3] To this evidence the defendant must reply by counter-proof, either in whole or in part, according to the number and nature of his defences. The plaintiff follows with testimony rebutting the new matter disclosed by the defendant, or supporting the *prima facie* presumptions of his patent against the denials or evasions of his adversary. When the defendant files a special plea on which issue is joined, the order of procedure is reversed. Such special plea admits all allegations in the declaration which it does not specifically or impliedly dispute. The defendant, therefore, first offers evidence in pursuance of his plea, to which the plaintiff replies by testimony appropriate to the issue, and the defendant in rebuttal controverts the plaintiff's proof. The rule regarding the burden of proof upon the different questions involved in the action is the same, whatever form the pleadings may assume or in whatever order the evidence may be introduced.

§ 1073. Nonsuit not Ordered in Federal Courts: Equivalent Procedure.

The Federal courts have no authority to order a nonsuit of the plaintiff, though his evidence may be plainly insufficient

§ 1072. [1] See §§ 1016, 1018, and notes, *ante*.

[2] See § 1040 and notes, *ante*.

[3] See §§ 1041–1048, 1071, and notes, *ante*.

to warrant a verdict in his favor, but must submit the issue to the jury on such proof as has been offered.[1] The defendant may, however, request the court to instruct the jury that the testimony will not support a verdict for the plaintiff, and a refusal of the request in cases where it should be granted is a ground of error.[2] If the jury disregard this instruction and render a verdict for the plaintiff, the court cannot accept it, but must set it aside and order a new trial.[3] But when any evidence is introduced by the plaintiff which could, in the reasonable and legal judgment of a jury, tend to support the plaintiff's cause, whether the judge would consider it sufficient as a guide to his own conclusions or not, it must be submitted to them, and their verdict on it, if otherwise correct, must be received.[4]

§ 1073. [1] That the Federal courts cannot order a nonsuit, see Castle *v.* Bullard (1859), 23 How. 172; Silsby *v.* Foote (1852), 14 How. 218; Foote *v.* Silsby (1849), 1 Blatch. 445; Crane *v.* Morris (1832), 6 Peters, 598; De Wolf *v.* Rabaud (1828), 1 Peters, 476; Elmore *v.* Grymes (1828), 1 Peters, 469.

That if the plaintiff is guilty of fraud against the defendant it is no ground for a nonsuit, but the jury may give nominal damages, see Reutgen *v.* Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

[2] That upon a demurrer to evidence in an action at law the judge must decide whether the plaintiff has made out a *prima facie* case, and if not must charge the jury to find for the defendant, see Royer *v.* Schultz Belting Co. (1886), 28 Fed. Rep. 850; 38 O. G. 898; Millner *v.* Schofield (1881), 4 Hughes, 258; Bevans *v.* United States (1871), 13 Wall. 56.

That to refuse to instruct the jury to find for the defendant when the plaintiff has not made out a *prima facie* case is error, see Torrent & Arms Lumber Co. *v.* Rodgers (1884), 112 U. S. 659; 30 O. G. 449; Curtis, Jur. Courts U. S. 222.

That where a patent is manifestly void it is the duty of the court to charge the jury to return a verdict for the defendant, and failure so to charge is error, see Torrent & Arms Lumber Co. *v.* Rodgers (1884), 112 U. S. 659; 30 O. G. 449.

[3] That where the jury without sufficient evidence against the defendant, render a verdict for the plaintiff, the verdict should be set aside and a new trial granted, see Wilson *v.* Janes (1854), 3 Blatch. 227.

[4] In Roberts *v.* Schuyler (1875), 12 Blatch. 444, Shipman, J.: (447) "It is true that the same weight is not given by courts to the verdict of a jury upon the validity of a patent which is justly given to the opinion of a jury upon other questions of fact. The subject-matter involved often requires a patient and quiet examination of different structures, and an investigation of the modes of operation of machinery, for which the hurried and imperfect scrutiny which the jury can give during the trial of a case is sometimes inadequate. The result often depends more upon the examination of machines or structures than upon the testimony of witnesses. And yet, notwithstanding the fact that less weight and

§ 1074. Charge to the Jury: Requests: Exceptions.

The charge of the judge to the jury must arise out of and be limited to the questions in controversy and the evidence produced, and must be sufficiently full and clear to serve them as an intelligible guide in arriving at their verdict.[1] General abstract discussions are improper.[2] Either party may request the judge to give certain instructions, and if this request is not complied with the instructions are regarded as refused.[3] Unless such requests are made, the court is bound to notice only the points made by either party on the trial.[4] When the request is granted it is not essential that the exact form of the desired instruction should be followed, if the instruction actually given comports with the justice of the case and

authority is given to the decision of a jury in this class of cases than in other civil causes, it is equally true that the verdict of a jury is not to be set aside merely because the court might have arrived at a different conclusion. Unless the court can see that the jury was palpably mistaken, and that the weight of evidence is decidedly against their verdict, it should not be set aside. Otherwise the court enters upon the province of the jury, and passes beyond the limit of its own duty. At the same time, when it is manifest that juries have been warped from the direct line of their duty by mistake, prejudice, or even by an honest desire to reach the supposed equity, contrary to the law of the case, it will be the duty of the court to set the verdict aside." 2 Bann. & A. 5 (8). See also Aiken *v.* Bemis (1847), 3 W. & M. 348; 2 Robb, 644; Brooks *v.* Bicknell (1845), 4 McLean, 70.

That if there is evidence on both sides of the issue, the matter must be submitted to the jury unless the court would set aside the verdict as against evidence if they decided contrary to its judgment, see Keyes *v.* Grant (1886,) 118 U. S. 25; 35 O. G. 747.

§ 1074. [1] That the instructions of the court must be sufficient to enable the jury to arrive at a proper verdict, see Morris *v.* Platt (1864), 32 Conn. 75; Waters *v.* Bristol (1857), 26 Conn. 398; 3 Chitty, Gen. Prac. pp. 911–916.

That the court should instruct the jury that the burden of proof as to novelty, after the patent is in evidence, is on the defendant, see Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb,,530.

That where the court would set aside a verdict, if given for the plaintiff, it should instruct the jury to find for the defendant, see Royer *v.* Schultz Belting Co. (1886), 29 Fed. Rep. 281.

[2] That abstract discussions in the charge should be avoided, see Gayler *v.* Wilder (1850), 10 How. 477; Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530; Pitts *v.* Whitman (1843), 2 Story, 609; 2 Robb, 189.

[3] That failure to comply with requests to charge is equivalent to a refusal, see Emerson *v.* Hogg (1845), 2 Blatch. 1.

[4] That the failure of the court to charge on special points not essential to the understanding of the case is not error unless requests to that effect were made, see Pennock *v.* Dialogue (1829), 2 Peters, 1; 1 Robb, 542.

affords the jury an opportunity to render a proper verdict.[5] A refusal to give desired instructions may be taken advantage of on writ of error, but the exception must be noted at the time, so that the error can be corrected while the jury are at bar, or the objection will be waived.[6]

§ 1075. Questions of Law: Questions of Fact.

Under each of the twenty-five enumerated defences certain questions arise whose decision is within the province of the court, while others are to be determined by the jury. The general distinction between these is that which always separates matters of law from matters of fact, but their particular characteristics are best comprehended when they are stated in connection with the defences in which they arise. On the first defence, which denies that the invention originated in an inventive act, the court defines the nature of an inventive act and of its result; the jury decide whether the patented invention is due to such an act and corresponds with such result.[1] On the second defence, which admits that the

[5] That the court is not bound to instruct the jury as counsel request if the instruction given is correct, see Pitts *v.* Whitman (1843), 2 Story, 609; 2 Robb, 189.

That a court having given the jury all needed instructions may decline to give special instructions as requested, see Winans *v.* New York & Harlem R. R. Co. (1855), 4 Fisher, 1.

That in a suit at law on a question of priority the counsel cannot require that the court, on inspecting rival patents, shall instruct the jury, as matter of law, that they are or are not identical, see Bischoff *v.* Wethered (1869), 9 Wall. 812.

[6] That errors or refusals not excepted to at the time are waived, see Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530; Emerson *v.* Hogg (1845), 2 Blatch. 1.

§ 1075. [1] The performance of an inventive act is determined largely by comparing the alleged invention with inventions previously known, and ascertaining its substantial identity with or diversity from them. This is a matter for the jury under the direction of the court. Thus in Tucker *v.* Spalding (1872), 13 Wall. 453, Miller, J.: (455) "Whatever may be our personal opinions of the fitness of the jury as a tribunal to determine the diversity or identity in principle of two mechanical instruments, it cannot be questioned that when the plaintiff, in the exercise of the option which the law gives him, brings his suit in the law in preference to the equity side of the court, that question must be submitted to the jury if there is so much resemblance as raises the question at all. And though the principles by which the question must be decided may be very largely propositions of law, it still remains the essential nature of the jury trial that while the court may, on this mixed question

invention originated in an inventive act, but denies the performance of that act by the alleged inventor and asserts that he has surreptitiously appropriated to himself the fruit of another's inventive skill, the court describes the attributes of an inventive act; the jury determine whether the alleged inventor has performed this act, or has derived his idea of the invention from the true inventor.[2] On the third defence, which admits that an inventive act resulting in the patented invention has been performed by the alleged inventor, but avers that the same act had previously been performed by a different inventor, who had already reduced it to practice, or who was using reasonable diligence in its reduction, the court declares at what stage of its development the conception of an idea of means becomes complete, and what diligence the law requires of the inventor in perfecting it; the jury find whether the complete conception of the invention by the supposed prior inventor anticipated that of the plaintiff's inventor, and whether the former, if the first conceiver, had reduced it to practice before its production by the latter, or was then reducing it with such diligence as the law demands.[3] On the fourth defence, which denies that the invention patented is embraced in either of the six classes made patentable by the Acts of Congress, the court determines from the patent what the character of the invention is, and from the law whether it is included in the protected classes; the duty of the jury is to render a verdict in pursuance of this finding of the court, unless the patent employs terms of art upon whose meaning

of law and fact, lay down to the jury the law which should govern them, so as to guide them to truth and guard them against error, and may if they disregard instructions set aside their verdict, the ultimate response to the question must come from the jury." 5 Fisher, 297 (300); 1 O. G. 144 (145).

See also Tyler *v.* Boston (1868), 7 Wall. 327; Turrill *v.* Railroad Co. (1863), 1 Wall. 491; Battin *v.* Taggert (1854), 17 How. 74; Tatham *v.* Le Roy (1852), 2 Blatch. 474; Reutgen *v.* Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

[2] That the jury are to determine by whom an inventive act was performed, see Gray *v.* Halkyard (1886), 28 Fed. Rep. 854; 38 O. G. 784; Reutgen *v.* Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

[3] That priority of invention is a question of fact, see Gray *v.* Halkyard (1886), 28 Fed. Rep. 854; 38 O. G. 784; Reutgen *v.* Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

they must also pass.[4] On the fifth defence, which denies the novelty of the invention, the court defines the attributes of novelty and the essential qualities of a prior use or prior publication, and decides whether the Claims of a prior patent cover the same invention as the one in suit; the jury find whether the patent, or the publication, or the use, existed in such a manner as to render the invention accessible to the public before it was conceived by the alleged inventor.[5] On the sixth defence, which denies the utility of the invention, the court declares in what utility consists, and where the patented invention is manifestly frivolous or injurious to the public directs the jury to find accordingly; otherwise the jury determine whether the invention is practically available for any useful purpose.[6] On the seventh defence, which asserts

[4] So far as this question involves the character of the patented invention as a simple art, machine, manufacture, composition, design, or improvement, it may nearly always be considered as mainly a question of law; the answer consisting in a definition of the patentable class and an interpretation of the Claims of the patent, with a submission of the question to the jury under such instructions as this definition and interpretation require. See Bischoff *v.* Wethered (1869), 9 Wall. 812; Teese *v.* Phelps (1855), 1 McAllister, 17. When the invention purports to be a combination, however, additional questions are raised which are essentially questions of fact and must be passed on by the jury. Thus, that where the effect and operation of mechanical contrivances enter into a question of a combination, the question is one of law and fact for the jury to determine under the instructions of the court, see Foote *v.* Silsby (1849), 1 Blatch. 445.

That whether an invention is patentable is a mixed question of law and fact and usually is not to be settled without a jury trial unless the title is fixed by law, see Teese *v.* Phelps (1855), 1 McAllister, 17.

[5] That novelty is a question for the jury, see Westlake *v.* Cartter (1873), 6 Fisher, 519; 4 O. G. 636; Battin *v.* Taggert (1854), 17 How. 74; Carver *v.* Braintree Mfg. Co. (1843), 2 Story, 432; 2 Robb, 141.

That the identity of prior and present inventions is a question for the jury, see Tyler *v.* Boston (1868), 7 Wall. 327; Turrill *v.* Railroad Co. (1863), 1 Wall. 491.

That whether two patents, whose specifications are not in the same terms, describe the same invention, is a question for the jury, see Hawkes *v.* Remington (1872), 111 Mass. 171; Bischoff *v.* Wethered (1869), 9 Wall. 812.

That whether the patented invention is identical with one described in a printed publication is a question for the jury, where the inventions differ on their face and in the judgment of experts, see Keyes *v.* Grant (1886), 118 U. S. 25; 35 O. G. 747; Adams *v.* Bellaire Stamping Co. (1886), 28 Fed. Rep. 360; 36 O. G. 567.

[6] That utility is a question for the jury, see Westlake *v.* Cartter (1873), 6 Fisher, 519; 4 O. G. 636. *Doubted:* Langdon *v.* De Groot (1822), 1 Paine, 203; 1 Robb, 433.

That where an invention is useless

that the inventor has abandoned the invention to the public, the court defines the doctrine of abandonment, and the presumptions that arise from public use or sale; the jury pass upon all questions of intention on the part of the inventor, on the existence and significance of the facts urged as evidence of his purpose to abandon, and on the occurrence of such instances of public sale or use as are in law conclusive evidence of an abandonment.[7] On the eighth defence, which denies the issue of any patent corresponding with the description in the declaration, the court determines the necessary characteristics of the described patent; the jury judge whether the patent of the plaintiff is the one described.[8] On the ninth defence, which asserts that the issue of the plaintiff's patent was in violation of the rules of law, the court declares the requisites of a legal patent so far as they are applicable to the one in suit, decides whether the patent covers a sole or joint invention, and whether the Claims of a re-issue depart from the invention attempted to be described and claimed in the original; the jury find whether the legal requisites existed, whether the invention was in fact joint or sole, and whether the invention claimed in the re-issue is identical with that which the inventor attempted to secure by his original patent.[9] On the tenth defence the questions for the court

on its face the court may so direct the jury, see Langdon *v.* De Groot (1822), 1 Paine, 203; 1 Robb, 433.

[7] That abandonment is a question for the jury, see Kendall *v.* Winsor (1858), 21 How. 322; Battin *v.* Taggert (1854), 17 How. 74.

That the motive for the delay in applying for a patent while the invention is in use is a question for the jury, see Morris *v.* Huntington (1824), 1 Paine, 348; 1 Robb, 448.

That the question of the continuity of an application is for the jury, see Godfrey *v.* Eames (1863), 1 Wall. 317.

That the question whether the continuity of an application is destroyed by the filing of a new application is, in an action at law, for the jury, see Howe *v.* Newton (1865), 2 Fisher, 531.

[8] This issue may be determined in several ways. If the patent is offered in evidence and excluded, the plaintiff's case necessarily fails, and no nonsuit being permitted, the court directs a verdict for the defendant. But where the evidence, not being objected to, is submitted to the jury, the question of identity between the patent declared on and the one in evidence is in form passed upon by the jury, under the instruction of the court.

[9] That whether the re-issue is broader than the invention attempted to be protected by the original is a question for the jury, see Battin *v.* Taggert (1854), 17 How. 74; Carver *v.* Braintree Mfg. Co. (1843), 2 Story, 432; 2 Robb, 141.

That whether a re-issue was obtained with fraudulent intent is for the jury,

and jury are the same as on the fourth, already stated. On the eleventh defence, which asserts that the description of the invention given in the patent is fraudulent, the court construes the language of the specification and points out what invention it purports to describe; the jury decide whether the actual invention is disclosed by this description, and if not, whether the concealment or redundancy resulted from an intention to deceive.[10] On the twelfth defence, which asserts that the description is ambiguous, the court defines the attributes of a sufficient description and determines what interpretations can be given to the language of the one contained in the patent; the jury find whether this description so discloses the invention that persons skilled in the art can practise it from such disclosure.[11] On the thirteenth defence, which avers that the Claims of the patent are excessive and have not been lawfully cured by a disclaimer, the court construes the alleged excessive Claim, and fixes the standard by which the diligence of the plaintiff in filing any necessary disclaimer must be measured; the jury decide whether the Claim exceeds the limits of the actual invention, and whether the delay in filing a disclaimer is unreasonable.[12] On the fourteenth defence, which alleges the ambiguity of the Claim, the court interprets the Claim so far as it is capable of an interpretation, and declares whether an exact intelligible conception of the real character of any invention can be thence derived; the jury follow this interpretation, and if it does not,

see Carver *v.* Braintree Mfg. Co. (1843), 2 Story, 432; 2 Robb, 141.

[10] That whether a specification is fraudulent is a question for the jury, see Reutgen *v.* Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

[11] That whether a specification would enable one skilled in the art to practise the invention is a question of fact for the jury, see Westlake *v.* Cartter (1873), 6 Fisher, 519; 4 O. G. 636; Page *v.* Ferry (1857), 1 Fisher, 298; Battin *v.* Taggert (1854), 17 How. 74; Carver *v.* Braintree Mfg. Co. (1843), 2 Story, 432; 2 Robb, 141; Reutgen *v.* Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

[12] That what is an unreasonable delay in filing a disclaimer is a mixed question of law and fact to be decided by the jury under the instructions of the court, see McCormick *v.* Seymour (1854), 3 Blatch. 209; Hall *v.* Wiles (1851), 2 Blatch. 194; Brooks *v.* Bicknell (1844), 3 McLean, 432.

That under certain circumstances the question of unreasonable delay may be a question of law only, for the court, see Singer *v.* Walmsley (1860), 1 Fisher, 558; Seymour *v.* McCormick (1856), 19 How. 96.

in the judgment of the court, clearly set forth any patentable matter, finds the patent void.[13] On the fifteenth defence, which rests upon a surrender of the patent, the court declares the law which governs the surrender of a patent and its effect upon existing rights of action: the jury determine whether the patent of the plaintiff has thus been cancelled and destroyed. On the sixteenth defence, which asserts that the patent has been annulled or repealed, the court informs the jury of the nature and consequences of these different proceedings and the weight to be attached to the records of these judgments: the jury acting under such instructions find whether the patent is extinct or still remains in force.[14] On the seventeenth defence, which denies the title of the plaintiff, the court determines the meaning and effect of the written instruments in pursuance of which he claims to be the owner of the patent; the jury pass upon the fact of the execution of such instruments by their alleged makers, and on the identity of the plaintiff with the party to whom the conveyances were made. On the eighteenth defence, which denies that the invention used by the defendant is identical with that included in the plaintiff's patent, the court defines the patented invention as indicated by the language of the Claims; the jury judge whether the invention so defined covers the art or article employed by the defendant.[15] On the nineteenth defence, which asserts that the acts of the defendant in reference to the patented invention were not acts of infringement, the court declares the legal attributes of an infringing act, the circumstances under which an em-

[13] That the court must determine whether the Claim is ambiguous, and its instructions on this point control the jury, see Ames *v.* Howard (1833), 1 Sumner, 482; 1 Robb, 689; Barrett *v.* Hall (1818), 1 Mason, 447; 1 Robb, 207.

[14] As to both the fifteenth and sixteenth defences the finding of the jury must in most cases be simply *pro forma*, since the evidence is matter of record, and, being accepted and interpreted by the court in reference to the questions at issue, constitutes such proof that no verdict departing from it could be accepted.

[15] That the identity of the plaintiff's and defendant's inventions is a question for the jury, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514; 28 O. G. 1007; Tyler *v.* Boston (1868), 7 Wall. 327; Battin *v.* Taggert (1854), 17 How. 74; Orr *v.* Burwell (1849), 15 Ala. 378; Reutgen *v.* Kanowrs (1804), 1 Wash. 168; 1 Robb, 1.

ployee is or is not responsible for obedience to the commands of his employer, and what degree of complicity renders one whose act is not a complete act of infringement liable for the infringement when completed by the acts of others; the jury decide whether the defendant's acts were true infringements according to the doctr nes thus declared.[16] On the twentieth defence, which allege that the term of the patent had expired before the acts the defendant were committed, the court informs the jury tion the patent would expire of its own limitation, what eff t would be produced upon it by a prior foreign patent to t e same inventor having a shorter term, and whether the fore gn patent covers the same invention as the one in suit; the jury find whether a prior foreign patent had been granted to the same inventor, or to another party in his interest, and whether the infringing act anticipated the expiration of the domestic patent as fixed by its own limitations or by the term of the foreign patent. On the twenty-first defence, which asserts that the use of the patented invention by the defendant was authorized by the owner of the patent, the court declares the legal rights of part owners or licensees, as the nature of the defence requires, interprets the effect of the instruments or contracts under which the defendant claims, and defines the acts which they empower him to perform; the jury pass upon the existence and authenticity of the conveyances, the identity of parties, and the correspondence of the defendant's acts with those permitted by his grant. On the twenty-second defence, which rests upon the Statute of Limitations, the court construes the statute; the jury decide whether the suit was instituted within the time prescribed. On the twenty-third defence, which avers that the plaintiff is estopped from pursuing his remedy against the defendant, the court explains the doctrine of estoppel, interprets any written instruments out of which an estoppel is said to have arisen, and defines any legal duty of the plaintiff by the neglect of which the defendant claims that he has been misled into the acts for which he has been sued; the jury

[16] That whether the defendant infringes is a question for the jury, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514; 28 O. G. 1007; Jackson *v.* Allen (1876), 120 Mass. 64.

determine whether the facts alleged as the basis of the estoppel actually occurred, whether the defendant acted on them in good faith, and whether he would now be prejudiced were the plaintiff permitted to avoid them. On the twenty-fourth defence, which sets up a release of the defendant by the plaintiff, the court declares the nature and effect of a release, construes it if in writing, and if by parol gives the jury legal tests of its sufficiency; the jury find whether the release was given and whether the infringing acts of the defendant are within its operation. On the twenty-fifth defence, which claims that the cause of action has been extinguished by or merged in a former judgment, the court declares the doctrine of *res adjudicata*, and interprets the record of the previous adjudication; the jury decide whether the plaintiff and defendant were parties or privies to such judgment, and whether the present and the former suits were based upon the same infringing acts. On the question of damages the court instructs the jury in the rule of damages, and points out the inferences which they are permitted to deduce from indirect evidence; the jury, in pursuance of this rule, draw their conclusions from the data furnished by the testimony, and compute the amount of the compensation to be awarded for the plaintiff's loss.[17] In reference to many of the foregoing points the spheres of the court and jury approach so closely to each other that the latter appear rather to affirm by their verdict the decision of the former than to exercise an independent judgment of their own; but with one or two exceptions which are above stated, this appearance is illusive, the jury having in all the other questions a necessary judicial function to perform. For either tribunal to assume the powers of the other in any matter of importance is a ground of error, unless the parties have precluded themselves from making the objection by treating the question during the trial as if it were presented to the authority by whom it has been decided.[18]

[17] That the amount of damages is matter for the jury, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

[18] That when the defendant treats a question as to the nature of the invention as a question of fact for the jury, he cannot claim that the court erred by not defining it as a matter of law, see Foote *v.* Silsby (1849), 1 Blatch. 445.

§ 1076. Verdict.

The verdict of the jury must follow the evidence, not their private opinion apart from the evidence, and must be based on all the testimony offered.[1] If manifestly the result of prejudice or error, or contrary to the instructions given by the court, or void for repugnancy or uncertainty, it will be set aside and a new trial ordered.[2] But it is not to be interfered with simply because the court would have arrived at a different conclusion from the same premises, nor because the jury have awarded larger damages than might have been expected, unless the amount is palpably extravagant, and therefore indicates corruption or mistake.[3]

§ 1077. Trial of Issues of Fact by the Court without a Jury.

An act of Congress passed in 1865 empowered the circuit courts to try issues of fact in civil causes without the inter-

§ 1076. [1] In Page *v.* Ferry (1857), 1 Fisher, 298, Wilkins, J.: (316) "Your verdict, to be true, must be based on the evidence, and not according to your private belief independent of the evidence, and be based on all the evidence. A juror, as a judge of facts, should be without bias — have no friendships — be free from all favor or affections, in order to be 'no respecter of persons,' to render righteous judgment. Sometimes a juror will enter the judgment seat with his mind bent upon a particular course, irrespective of the law or the evidence. Such a course is highly dishonorable. It stains the soul with perjury, and pollutes the fountains of justice with the poison of prejudice. The jury-box, as the bench, is holy ground, and we must put off our shoes ere we tread the sacred threshold. A juror holds a highly honorable and important position in the administration of the law, and as he would value his own just self-esteem, let him cleave with pertinacity to the simple issue, and to the evidence admitted as bearing upon it. This is the only safe ground for both court and jury."

[2] That a verdict evidently resulting from mistake, prejudice, or a higher regard for the equities than the law of the case, will be set aside, see Roberts *v.* Schuyler (1875), 12 Blatch. 444; 2 Bann. & A. 5.

That a repugnant or uncertain verdict will be set aside, see Stearns *v.* Barrett (1816), 1 Mason, 153; 1 Robb, 97.

[3] That a verdict is not set aside as against evidence merely because the court might have come to a different conclusion, see Roberts *v.* Schuyler (1875), 12 Blatch. 444; 2 Bann. & A. 5.

That a new trial for a verdict against evidence will not be granted if there was evidence on both sides, unless there has been a clear mistake or manifest abuse, see Aiken *v.* Bemis (1847), 3 W. & M. 348; 2 Robb, 644; Brooks *v.* Bicknell (1845), 4 McLean, 70.

That a verdict will not be set aside on the ground that the damages are excessive unless the excess is evident, see Aiken *v.* Bemis (1847), 3 W. & M. 348; 2 Robb, 644, and cases cited in § 1068, notes 3 and 4, *ante*, and § 1078, note 7, *post*.

vention of a jury, whenever the parties or their attorneys of record should file with the clerk a stipulation in writing to that effect.[1] In such cases the trial proceeds before the court alone, who determines all questions of law and fact, and whose finding occupies the same position as the verdict of a jury. This finding may be either general or special, at the discretion of the court. A special finding resembles a special verdict, and the decision of the court upon any question of law or fact thereby presented is reviewable in the Supreme Court of the United States.[2]

§ 1078. New Trials.

The Federal courts have authority to grant new trials in civil cases, in which a verdict has been rendered by a jury, for the reasons recognized by other courts of law as sufficient to warrant such proceedings.[1] These reasons consist principally of some error committed by the court or jury during the former trial, or of the discovery of new evidence by the defeated party since the former verdict. The court may err by admitting improper evidence, or rejecting admissible evidence, or by departing from the law in its instructions to the jury.[2] The admission of improper evidence is generally a sufficient ground for a new trial; but if the same facts have been shown by proper testimony, or if the evidence was rendered immaterial by subsequent disclosures, or if the objection though sustained is purely technical and the result of the trial was justified by the remaining correct evidence, the motion for another trial will be refused.[3] A similar rule is

§ 1077. [1] Sec. 649, Rev. Stat. 1874. Desty, Fed. Prac. 256; Judson *v.* Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539.

[2] Sec. 700, Rev. Stat. 1874. Desty, Fed. Prac. 318.

That a question certified to the Supreme Court under Sec. 652, Rev. Stat. must be a question of law involving a single point, not a general question as to the whole case, see California Artificial Stone Paving Co. *v.* Molitor (1885), 113 U. S. 609; 31 O. G. 1044.

§ 1078. [1] Sec. 726, Rev. Stat. 1874.

[2] As to the grounds of new trial in general, see 1 Graham & Waterman, N. T. Introd. 1–502; 2 Graham & Waterman, N. T. 1–50; 3 Bl. Com. pp. 378, 386–393.

[3] That a new trial will not be granted on the ground of the admission of inadmissible evidence where the same facts were afterwards proved by admissible evidence, or where the erroneous evidence was rendered immaterial, or the objection was purely formal, and the

followed when the error has arisen through the rejection of admissible evidence; if its reception would have made no difference in the result, or if its place has been supplied by other testimony, its exclusion will not be sufficient ground for a new trial.[4] An error in the charge of the court to the jury, either by submitting a question of law to their decision, or by misdirecting them on a material point, is fatal to the verdict, but a neglect to give the instructions prayed for by the defeated party does not warrant a new trial if the same ground is covered by the charge and the law governing the whole case has been correctly stated.[5] The jury may err either by the misconduct of any or all of their number during the trial, or by departing from the law or the evidence in rendering their verdict. The former errors cannot be enumerated. They consist in acts or omissions which involve a breach of the oath taken by the jury when impanelled, and vitiate the entire subsequent proceedings.[6] Errors in their verdict may be committed by finding for the plaintiff or defendant contrary to the evidence, or by returning a verdict for excessive damages. In the first case the verdict will be set aside; in the second the plaintiff may cure the error by entering a *remittitur*.[7] Mistakes of the defeated party or his counsel, in not

proper evidence justified the verdict, see Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530. See this case for a full statement of the doctrine of new trials.

[4] That the improper rejection of a witness is ground for a new trial, see Buck *v.* Hermance (1848), 1 Blatch. 322.

[5] That the submission to the jury of a question of law, such as the construction of the patent, is ground for new trial, see Emerson *v.* Hogg (1845), 2 Blatch. 1.

That a misdirection in a material point is ground for new trial, see Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530.

That a refusal to charge as requested is no ground for a new trial if the charge as given was sufficient and correct, see Winans *v.* New York & Harlem R. R. Co. (1855), 4 Fisher, 1; Pitts *v.* Whitman (1843), 2 Story, 609; 2 Robb, 189.

[6] That an irregularity in the conduct of the parties or the jury, in order to obtain a new trial, must be satisfactorily proved, though it need not appear that the conduct of the party certainly influenced the jury, if it might have affected the impartiality of the proceedings, see Johnson *v.* Root (1862), 2 Fisher, 291; 2 Clifford, 108.

[7] That a verdict against evidence may be set aside, see Wilson *v.* Janes (1854), 3 Blatch. 227.

That a verdict will not be set aside as against evidence unless the preponderance of evidence is clear, see Brooks *v.* Bicknell (1845), 4 McLean, 70.

That where there is a fair balance of evidence the verdict will not be set

properly preparing the case for trial, or in not attending to the case when called, are irremediable;[8] and any of the foregoing errors, which came to the knowledge of the defeated party or his counsel during the former trial, and were not then excepted to, are thereby waived.[9] A new trial may be granted for the introduction of newly discovered evidence provided the evidence is material and not cumulative, will probably change the result, and could not have been known before or during the former trial by the exercise of due diligence.[10] But where the evidence was known and was not

aside unless it appears that the jury acted wrongfully in other respects, see Milligan *v.* Lalance & Grosjean Mfg. Co. (1884), 29 O. G. 367; 21 Fed. Rep. 570.

That on a motion for a new trial on a feigned issue the proponent may have the evidence, or the substance of it, as submitted to the jury, made part of the record, and the court will determine whether the conclusions of the jury are satisfactory, see Watt *v.* Starke (1879), 101 U. S. 247; 17 O. G. 1092.

That a verdict will not be set aside for excessive damages unless they were plainly and largely beyond the injury sustained, see Aiken *v.* Bemis (1847), 3 W. & M. 348; 2 Robb, 644; Stimpson *v.* Railroads (1847), 1 Wall. Jr. 164; 2 Robb, 595; Stephens *v.* Felt (1846), 2 Blatch. 37; Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530; and cases cited in § 1068, notes 3 and 4, *ante.*

That where the damages are merely excessive the error can be cured by *remittitur*, see Russell *v.* Place (1871), 5 Fisher, 134; 9 Blatch. 173. See also § 1068, notes 3 and 4, *ante.*

[8] That mistakes and negligence of parties and counsel are not ground for new trial, see De Florez *v.* Raynolds (1879), 16 Blatch. 397; 4 Bann. & A. 331.

[9] That errors known to the party during the trial are waived unless excepted to, see Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530; Emerson *v.* Hogg (1845), 2 Blatch. 1.

[10] That a new trial will not be granted in order to introduce immaterial evidence, see Spill *v.* Celluloid Mfg. Co. (1884), 29 O. G. 773; 22 Blatch, 441; 22 Fed. Rep. 94; Munson *v.* Mayor of New York. (1882), 22 O. G. 586; 20 Blatch. 358; 11 Fed. Rep. 72.

That the discovery of new cumulative evidence is no ground for new trial, see Pfanschmidt *v.* P. H. Kelly Mercantile Co. (1887), 41 O. G. 1501; 32 Fed. Rep. 667; Aiken *v.* Bemis (1847), 3 W. & M. 348; 2 Robb, 644; Ames *v.* Howard (1833), 1 Sumner, 482; 1 Robb, 689.

That where prior use was originally in issue, new evidence of other instances of prior use is merely cumulative, see Blandy *v.* Griffith (1873), 6 Fisher, 434.

That a new trial will be refused unless the new evidence would probably change the result, see Starling *v.* St. Paul Plow Works (1887), 41 O. G. 818; 32 Fed. Rep. 290; Munson *v.* City of New York (1882), 22 O. G. 586; 20 Blatch. 358; 11 Fed. Rep. 72; McCloskey *v.* DuBois (1881), 20 O. G. 1086; 9 Fed. Rep. 38; 20 Blatch. 7; De Florez *v.* Raynolds (1879), 16 Blatch. 397; 4 Bann. & A. 331.

That where the new evidence could by due diligence have been discovered before or during the former trial a new

produced because its materiality could not be perceived until the testimony of the adversary had been offered, the surprise affords no ground for a new trial. A continuance in order to obtain the evidence should have been requested, and if the party has seen fit to risk the issue on the proof presented, he is without a remedy.[11] Any party in interest who bears the expenses of the suit may move for a new trial, but such a motion once denied cannot be repeated except upon the basis of additional facts.[12]

§ 1079. Writ of Error.

A writ of error lies to the Supreme Court of the United States from the judgment of a circuit court in any action at law for an infringement, whether the trial has been conducted with or without a jury.[1] This writ is a matter of right, and the amount involved is of no consequence if the error to be corrected relates to any principle or rule of Patent Law.[2] The judgment must have been final, and not upon a matter

trial will be refused, see Spill *v.* Celluloid Mfg. Co. (1884), 29 O. G. 773; 22 Blatch. 441; 22 Fed. Rep. 94; De Florez *v.* Raynolds (1879), 16 Blatch. 397; 4 Bann. & A. 331; Aiken *v.* Bemis (1847), 3 W. & M. 348; 2 Robb, 644.

That the motion for a new trial on the ground of new evidence must state in detail what efforts were made to obtain the evidence for the former trial, see Burdsell *v.* Curran (1887), 31 Fed. Rep. 918; 42 O. G. 1167; Spill *v.* Colluloid Mfg. Co. (1884), 29 O. G. 773; 22 Blatch. 441; 22 Fed. Rep. 94; Page *v.* Holmes Burglar Alarm Tel. Co. (1880), 18 Blatch. 118; 5 Bann. & A. 439; 2 Fed. Rep. 330; Barker *v.* Stowe (1879), 16 O. G. 807.

That where the new evidence is of late discovery, and the excuse for delay is vague and unsatisfactory, no new trial will be allowed, see Albany Steam Trap Co. *v.* Felthousen (1886), 26 Fed. Rep. 318.

That if a new trial is granted on this ground the mover must pay the costs of the former trial, see Aiken *v.* Bemis (1847), 3 W. & M. 348; 2 Robb, 644.

[11] That if a party is taken by surprise a continuance may be granted, but if he goes on he waives the matter of surprise, see Ames *v.* Howard (1833), 1 Sumner, 482; 1 Robb, 689.

[12] That a motion once rejected cannot be repeated unless on a new basis of facts, see Gage *v.* Kellogg (1886), 36 O. G. 234; 26 Fed. Rep. 242; Matthews *v.* Puffer (1882), 22 O. G. 332; 20 Blatch. 233.

That if a verdict is satisfactory to the court and evidence was given on both sides, a decision on a motion for a new trial will not be elaborately set out, see Bray *v.* Hartshorn (1860), 1 Clifford, 538.

§ 1079. [1] Secs. 691, 699, 700, Rev. Stat. 1874.

[2] That the writ of error is matter of right, not of discretion, without regard to the amount in controversy, see Philp *v.* Nock (1871), 13 Wall. 185.

within the discretion of the court, such as a question of continuance, new trial, amendment, or costs.[3] Errors in law alone can be the subject of a writ of error, and these must appear upon the record with the exceptions duly taken.[4] Any party aggrieved by the judgment can obtain this writ, even though other parties on the same side of the cause decline to join, by stating that fact on the record.[5] The writ must issue within two years after the entry of the final judgment, except in certain cases when the disability of the defeated party necessitates a longer period.[6] The entire record in the circuit court must be sent to the Supreme Court, and the matters claimed as error must be properly assigned, or they will not be noticed in the court above.[7] The Supreme Court has power to reverse or modify or affirm the judgment, and when affirming it to award the prevailing party suitable damages for the delay.[8]

[3] That error lies only from a final judgment, see Potter *v.* Mack (1868), 3 Fisher, 428; Rutherford *v.* Fisher (1800), 4 Dallas, 22.

That error does not lie from a decision on any matter within the discretion of the court, see Pomeroy *v.* Bank of Indiana (1863), 1 Wall. 592; Dean *v.* Mason (1857), 20 How. 198; Silsby *v.* Foote (1852), 14 How. 218.

That no error lies on the grant or refusal of a continuance, see Livingston *v.* Dorgenois (1813), 7 Cranch, 577.

That no error lies on the grant or refusal of a new trial, see Insurance Co. *v.* Benton (1871), 13 Wall. 603; Pomeroy *v.* Bank of Indiana (1863), 1 Wall. 592.

That no error lies on a decision allowing or rejecting an amendment, see Pickett *v.* Legerwood (1833), 7 Peters, 144; Walden *v.* Craig (1824), 9 Wheaton, 576.

That no error lies on a decision regarding costs unless they exceed $2000, see Sizer *v.* Many (1853), 16 How. 98.

[4] That errors in law alone can be noticed on writ of error, see Miles *v.* United States (1880), 103 U. S. 304; United States *v.* Goodwin (1812), 7 Cranch, 108.

That no error can be noticed unless it appears of record, see Chaffee *v.* Boston Belt Co. (1859), 22 How. 217; Phelps *v.* Mayer (1853), 15 How. 160.

That a bill of exceptions must follow the established forms, see Pomeroy *v.* Bank of Indiana (1863), 1 Wall. 592.

[5] That any party aggrieved may have a writ of error though other parties refuse to join, see O'Dowd *v.* Russell (1871), 14 Wall. 402.

[6] Sec. 1008, Rev. Stat. 1874.

[7] Sec. 997, Rev. Stat. 1874. Rule 8, Supreme Court Rules.

That where the invention is clearly not patentable the Court will dismiss the suit, though that defence was not set up, see Slawson *v.* Grand Street R. R. Co. (1882), 107 U. S. 649; 24 O. G. 99.

[8] Secs. 691, 699, 700, Rev. Stat. 1874.

That where the cause is tried without a jury and a special finding is made, the Supreme Court may decide whether the

§ 1080. Costs.

As a general rule, the party who recovers judgment in an action at law for infringement also recovers costs.[1] To this rule there are, however, certain exceptions. When an excessive Claim is cured by a disclaimer pending suit, or where upon a contest over several Claims one is adjudged to be excessive and no disclaimer has been filed, or where certain Claims are abandoned at the trial as unlawful, though without a formal disclaimer, costs to the plaintiff are denied.[2] But a disclaimer filed without necessity, or after verdict, or in a different divi-

facts found support the judgment, see Sec. 700, Rev. Stat. 1874.

That damages for the delay may be allowed when the judgment is affirmed, see Sec. 1010, Rev. Stat.; Pennywit *v.* Eaton (1872), 15 Wall. 380; McKee *v.* Rains (1869), 10 Wall. 22.

§ 1080. [1] That in actions at law for infringement costs usually follow the judgment, see Sec. 4919, Rev. Stat. 1874. See also Kittredge *v.* Race (1875), 92 U. S. 116.

That under Sec. 14, act of 1836 (repeated in Sec. 4919, Rev. Stat.), costs follow a verdict for any amount, and whether the court increases the damages or not, see Merchant *v.* Lewis (1857), 1 Bond, 172.

[2] In Peck *v.* Frame (1871), 5 Fisher, 211, Woodruff, J.: (212) "On the one hand, the mere fact that the plaintiffs obtained a verdict is not conclusive that they are also entitled to costs; for they may have obtained the verdict under and in pursuance of section 9 of the act of 1837, which warrants a recovery for an infringement of what is, in fact, new, and claimed as the plaintiff's invention, notwithstanding the patentee has also, through mistake, without fraud or intent to deceive, claimed something which is not new. If this verdict was rendered for an infringement of valid Claims, and it appeared that other Claims were rejected in pursuance of that section, then although the plaintiffs obtained a verdict, they are not entitled to costs. But if the verdict was in fact upon all the Claims, in affirmance of the validity of each, and of the novelty of the inventions claimed in each, then the plaintiffs are entitled to costs. On the other hand, the mere fact that the plaintiffs have, since the trial and verdict, disclaimed one or more of the Claims made in the patent, is not alone conclusive that the plaintiffs are not entitled to costs. If the verdict was rendered, as secondly above suggested, upon all the Claims, affirming their validity, and the novelty of the invention claimed in each, then what the plaintiffs may have said or done, by disclaimer or otherwise, does not deprive them of the effect of the verdict; and so long as it remains in force, not set aside, it is conclusive between the parties. The fact of disclaimer is high evidence, in such case, that the verdict was wrong, and that the plaintiff should only have recovered on the parts of the invention or patent therefor which are not disclaimed, and such evidence might warrant a new trial. But while such a verdict stands it is conclusive."

See also, as to disclaimer Hayes *v.* Bickelhoupt (1885), 23 Fed. Rep. 183; 32 O. G. 135; Matthews *v.* Spangenberg (1882), 23 O. G. 92; 20 Blatch. 482; 19 Fed. Rep. 823; Tuck *v.* Bramhill (1868), 3 Fisher, 400; 6 Blatch. 95;

sion of a re-issued patent, has no effect upon the right to costs.[3] A verdict for nominal damages usually carries costs.[4] Various reasons operate in equity to deprive a victorious party of his costs, as where the suit is based on several patents some of which are held invalid, or where the defendant

Singer *v.* Walmsley (1860), 1 Fisher, 558.

That suits can be maintained on the valid Claims in a re-issue, but no costs can be recovered unless the invalid Claims were disclaimed, see Worden *v.* Searls (1884), 21 Fed. Rep. 406.

That a disclaimer to save costs, under Sec. 4922, is needed only when the Claim is originally excessive, not when the right to claim by re-issue has been lost by delay and a disclaimer is thus necessary, for then costs are allowed, see Mundy *v.* Lidgerwood Mfg. Co. (1884), 20 Fed. Rep. 191.

That when the patent contains several Claims, some of which are abandoned at the trial, costs will not be allowed unless a disclaimer were filed before suit, see Proctor *v.* Brill (1883), 16 Fed. Rep. 791.

That valid Claims may be recovered on without costs if invalid Claims are not disclaimed, but unreasonable delay in disclaiming defeats also the valid Claims, see McCormick *v.* Seymour (1854), 3 Blatch. 209; Hall *v.* Wiles (1851), 2 Blatch. 194.

That where the plaintiff recovers on a valid Claim and invalid Claims have not been disclaimed and the patent having expired no disclaimer can now be filed, if there has been no unreasonable delay in disclaiming, the plaintiff may have a decree without costs on the valid Claim, and on an appeal to the Supreme Court each party pays his own costs and one half the expense of printing the records, see Yale Lock Co. *v.* Sargent (1886), 117 U. S. 536; 35 O. G. 497.

[3] That if a disclaimer is unnecessarily filed costs will be allowed the plaintiff as if it were not filed, see Sharp *v.* Tifft (1880), 17 O. G. 1282; 18 Blatch. 132; 2 Fed. Rep. 697.

That the disclaimer of immaterial features does not affect costs, see Peek *v.* Frame (1871), 5 Fisher, 211.

That a disclaimer after verdict may give rise to a new trial, but cannot affect the verdict or costs in any other way, see Peek *v.* Frame (1871), 5 Fisher, 211.

That a disclaimer upon one division of a re-issue has no effect upon the costs in a suit on the other, see Elastic Fabrics Co. *v.* Smith (1879), 100 U. S. 110.

[4] In Merchant *v.* Lewis (1857), 1 Bond, 172, Leavitt, J.: (173) "A verdict for damages, whatever may be the amount, implies that the defendant has been a wrong-doer in the unauthorized use of the plaintiff's exclusive right under his patent; and such a verdict will carry costs. It is not a just inference, in a patent-right case, that because nominal damages are found by the jury, the action is necessarily frivolous or vexatious. It happens, not unfrequently, that the owner of a patent is compelled, for the protection of his rights, to sue for an infringement under circumstances in which he neither seeks to recover nor asserts a right to anything beyond mere nominal damages. This may be necessary for the establishment of his patent, and to prevent infringements. And, as by the legislation of Congress, the Circuit Courts of the United States have exclusive jurisdiction in patent cases, it would be a great hardship if he were subjected to the costs in thus asserting his legal rights."

has been misled by the plaintiff into the belief that his acts were not an invasion of the patent, or where upon the trial of two distinct issues each party prevails in one, or where the suit is brought entirely for the vindication of the plaintiff's patent, or to secure a judicial interpretation of its Claims, and the defendant has been guilty of no wilful wrong.[5]

[5] That when the patent contains two Claims and only one is sustained, plaintiff recovers no costs, under Sec. 4922, see Stewart *v.* Mahoney (1879), 5 Fed. Rep. 302 ; 4 Bann. & A. 84.

That where the plaintiff recovers on one patent and the defendant on the other, costs will be apportioned, see Pennsylvania Diamond Drill Co. *v.* Simpson (1886), 29 Fed. Rep. 288 ; 37 O. G. 218.

That where the suit is based on several patents and the plaintiff recovers only on one, he can have no costs, see Schmid *v.* Scoville Mfg. Co. (1889), 37 Fed. Rep. 345 ; Albany Steam Trap Co. *v.* Felthousen (1884), 20 Fed. Rep. 633 ; 22 Blatch. 169 ; American Wood Paper Co. *v.* Heft (1867), 3 Fisher, 316.

That no costs will be taxed against a defendant who has been misled by the plaintiff into believing that he did not infringe, see Sarven *v.* Hall (1873), 6 Fisher, 495 ; 4 O. G. 666 ; 11 Blatch. 295.

That a defendant who misled the plaintiff into buying the patent cannot recover costs if the patent is defeated, see Bunker *v.* Stevens (1885), 36 O. G. 345 ; 26 Fed. Rep. 245.

That the successful party recovers costs unless his conduct has been such as to render their allowance unlawful or unjust, see Bunker *v.* Stevens (1885), 36 O. G. 345 ; 26 Fed. Rep. 245.

That where there are two distinct causes of action and the plaintiff prevails in one and the defendant in another, no costs will be allowed, see Adams *v.* Howard (1884), 19 Fed. Rep. 317; 22 Blatch. 47; 20 O. G. 825; Yale & Greenleaf Mfg. Co. *v.* North (1867), 3 Fisher, 279 ; 5 Blatch. 455.

That if the proceeding is solely for the plaintiff's benefit, no costs are allowed against the defendant unless he is guilty of wrong, but if the defendant succeeds on other grounds his own costs may be disallowed, see Hovey *v.* Stevens (1846), 3 W. & M. 17 ; 2 Robb, 567.

That one who unnecessarily joins in a defence on the merits cannot recover costs, see Tyler *v.* Galloway (1882), 13 Fed. Rep. 477 ; 22 O. G. 1294 ; 21 Blatch. 66.

The following decisions concerning the items to be allowed or rejected from a bill of costs in patent cases are here inserted, a discussion of them in the text being regarded as unnecessary.

Patents, Copies, etc. :

That copies of the plaintiff's patent procured by defendant are not taxable in his favor, because the plaintiff is bound to produce it, see Hathaway *v.* Roach (1846), 2 W. & M. 63.

That copies of patents procured by the defendant cannot be taxed as costs against the plaintiff, see Woodruff *v.* Barney (1862), 2 Fisher, 244; 1 Bond, 528.

Assignments, Copies :

That copies of assignments of the patent, procured by the defendant, are taxable, see Hathaway *v.* Roach (1846), 2 W. & M. 63.

Models, Copies, etc. :

That models like the plaintiff's device may be included in the taxation of costs,

SECTION IV.

OF INFRINGEMENT: REMEDY IN EQUITY.

§ 1081. Origin of Equity Jurisdiction over Infringement Cases in England.

The right of the owner of a patent to invoke the assistance of a court of equity in cases of infringement, where no ade-

see Woodruff *v.* Barney (1862), 2 Fisher, 244; 1 Bond, 528; Hathaway *v.* Roach (1846), 2 W. & M. 63.

That copies of models in the Patent Office are taxable, but other models, machines, or photographs are not taxable, see Wooster *v.* Handy (1885), 23 Fed. Rep. 49; 23 Blatch. 113; Hussey *v.* Bradley (1864), 5 Blatch. 210; Parker *v.* Bigler (1857), 1 Fisher, 285.

That the expense of obtaining a model of defendant's infringing machine is not taxable among the plaintiff's costs, see Cornely *v.* Marckwald (1885), 23 Blatch. 248; 24 Fed. Rep. 187.

Attendance, Parties, Counsel, etc.:

That the expense of attending court, and of counsel for attending, is not taxable, see Hussey *v.* Bradley (1864), 5 Blatch. 210.

Copies of Arguments, etc.:

That the expense of copying papers or of reporting arguments for the use of the court will not be taxed, see Hussey *v.* Bradley (1864), 5 Blatch. 210.

Printing:

That the expense of printing pleadings, evidence, briefs, etc., and of lithographing drawings, unless incurred by order of the court, or by agreement of the parties, is not taxed, see Hussey *v.* Bradley (1864), 5 Blatch. 210.

Expense of Getting Evidence:

That the expenses required to obtain needed evidence may be taxed under the act of 1858, see Spaulding *v.* Tucker (1871), 4 Fisher, 633.

Telegraphing:

That necessary telegraphic expenses may be taxed, see Hussey *v.* Bradley (1864), 5 Blatch. 210.

Marshal:

That a marshal cannot tax mileage by zig-zag travel to reach a witness, see Parker *v.* Bigler (1857), 1 Fisher, 285.

That a marshal is not entitled to fees for serving a rule to plead, see Parker *v.* Bigler (1857), 1 Fisher, 285.

Witnesses:

That the travelling fees of voluntary witnesses, attending at the request of the prevailing party, will not be taxed against the loser, see Spaulding *v.* Tucker (1871), 4 Fisher, 633.

That witnesses who attend without summons are voluntary witnesses and cannot be taxed against the loser, see Woodruff *v.* Barney (1862), 2 Fisher, 244; 1 Bond, 528.

That witnesses from out of the district, or living over one hundred miles distant, are always voluntary witnesses, see Spaulding *v.* Tucker (1871), 4 Fisher, 633.

That the reasonable expenses of a voluntary witness may be taxed when the evidence is taken under an agreement of the parties, see Spaulding *v.* Tucker (1871), 4 Fisher, 633.

That a witness summoned in several suits against several defendants, is entitled to attendance and mileage in each case, see Parker *v.* Bigler (1857), 1 Fisher, 285.

That a witness has mileage for going

quate relief is possible at law, rests upon fundamental principles of jurisprudence, and is independent of any legislative enactment.[1] It is true that in the statute of James I. exclusive jurisdiction over all letters-patent, and over all questions concerning their force and validity, was reserved to the tribunals which administered the "common laws;" and that for a long period this reservation was interpreted as prohibiting the interference of the court of chancery, at least until the claims of the patentee had been fully vindicated in a court of law. But in the latter part of the last century the rigor of this doctrine was abated, and the chancellors began to grant injunctions without a prior suit at law, and if the plaintiff's right was undisputed to order an account of profits and thus dispose of the entire cause without a jury. Theoretically, however, those proceedings were always in aid of an action at law; and, therefore, when the defendant denied either the validity of the patent, or the title of the plaintiff, or the fact of infringement, these issues were submitted to a jury in a court of common-law jurisdiction, and the verdict there rendered was made the basis of the final decree in equity.[2]

§ 1082. Origin of Equity Jurisdiction over Infringement Cases in the United States.

It was during this condition of the English chancery practice, in cases of infringement, that our own patent system was

home, not for coming to court, see Woodruff . Barney (1862), 2 Fisher, 244; 1 Bond, 528.

Depositions:

That a deposition cannot be taxed if instead of using it the party called and examined the witness in court, see Hathaway *v.* Roach (1846), 2 W. & M. 63.

Practice;

That the Circuit Court may tax costs *nunc pro tunc* after the mandate of the Supreme Court has been issued and received by the Circuit Court, see Sizer *v.* Many (1853), 16 How. 98.

That where, on a judgment for the defendant, the costs cannot be collected on execution, the court will not on motion appoint a receiver to dispose of the patent as an asset, but a new bill for that purpose must be filed, see Thayer *v.* Hart (1885), 23 Blatch. 303; 24 Fed. Rep. 558.

For further rules in equity cases, see §§ 1162, 1163, and notes, *post.*

§ 1081. [1] As to the necessity and advantage of equitable interference by injunction in cases of infringement, see § 1168 and notes, *post.*

[2] As to the origin and development of equitable jurisdiction over patent cases in England, see § 932 and notes, *ante.*

established. The acts of Congress, prior to 1819, made no provision for any suit in equity by the owner of a patent, nor for his enjoyment of any form of equitable relief in connection with his action for damages at common law. Nevertheless, the Federal courts, following the decisions of the lords chancellors, held that equity had jurisdiction over patents for inventions, and could exercise its ordinary powers in behalf of the patentee, whenever these were needed to give complete effect to the statute under which the patent had been granted.[1] But this jurisdiction was not regarded as original, or even as concurrent with that of the courts of common law. While proceedings might commence by the filing of a bill in equity, and by the issue of a preliminary injunction against the defendant, yet if the case were contested on its merits an immediate trial at law was ordered to determine the real points in controversy; after which, if the plaintiff obtained a verdict, the court of equity could decree an accounting and a perpetual injunction in his favor.[2]

§ 1083. Difficulties in the Administration of Equitable Remedies before the Act of 1819: Object of the Act.

In the administration of these equitable remedies the Federal courts encountered one difficulty which only a legislative enactment could remove. The authority conferred upon these courts by the Judiciary Act of 1789 did not extend to actions between parties both of whom were citizens of the same individual State, and thus required suits for infringement to be

§ 1082. [1] The acts of 1790, 1793, and 1800 gave to the plaintiff the right to recover certain specific penalties by an action on the case founded on the statute. That such actions at law could be aided by a Federal court of equity seems never to have been doubted, except where the litigants were citizens of the same State (see Livingston *v.* Van Ingen (1811), 1 Paine, 45), and is recognized as a long subsisting practice by Thompson, J., in Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477. See also § 932 and notes, *ante*.

[2] That equity interferes only in aid of an action at law, see Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477.

That where a material issue was raised, relating to the fact of infringement or the validity of the patent, a trial at law was ordered, or a feigned issue sent to a jury for decision, see Orr *v.* Merrill (1846), 1 W. & M. 376; 2 Robb, 823; Brooks *v.* Bicknell (1845), 4 McLean, 70; Parker *v.* Hatfield (1845), 4 McLean, 61; Brooks *v.* Bicknell (1843), 3 McLean, 250; 2 Robb, 118.

brought before the local courts except in cases where the parties were resident in different States. The act of 1800 cured this defect, so far as actions at law were concerned, but left the jurisdiction in equity unchanged. Hence while a suit for damages would lie against an infringer in any Circuit court, irrespective of his citizenship, no equitable relief could be obtained against him unless he resided in a different State from that of the plaintiff.[1] To remove this difficulty the act of 1819 was passed, bestowing on the Circuit courts original cognizance, in equity as well as at law, over all patent cases, with full authority to grant injunctions according to the course and principles of courts of equity.[2]

§ 1084. Legal and Equitable Jurisdiction over Infringement Cases not Concurrent.

The sweeping language employed in the act of 1819, and adopted from it into the acts of 1836 and 1870, gave rise to an erroneous doctrine concerning the nature and extent of equity jurisdiction over patent causes, which has found its expression in numerous decisions of the courts. These acts provide 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. Under this provision it has been claimed and held that the jurisdiction in equity is concurrent with that at law in all cases, and that no suit for infringement can be maintained at law which could not also be prosecuted in equity; thus giving to the injured patentee a choice of remedies without reference to the situation of the parties or the facts in controversy.[1] This doctrine ignores the

§ 1083. [1] That prior to the act of 1819 the Federal courts had no equity jurisdiction in patent cases unless the parties were citizens of different States, see Livingston *v.* Van Ingen (1811), 1 Paine, 45.

[2] That the purpose of the act of 1819 was to extend equity jurisdiction to patent cases in which the parties are citizens of the same State, see Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477.

§ 1084. [1] In Nevins *v.* Johnson (1853), 3 Blatch. 80, Betts, J.: (82) "We see no reason for regarding the power to issue injunctions as the primary and substantive authority of courts of equity under this statute. They have plenary

fundamental distinction between law and equity, as systems of practical jurisprudence, and contemplates the Circuit court not as an ordinary judicial body clothed with common-law and chancery powers, but as a special tribunal constituted to hear and determine patent causes and authorized to entertain actions on the case or bills for injunctions or accounts, at the option of the plaintiff. In opposition to this doctrine, however, it has with equal pertinacity been held by other judges that the equitable jurisdiction of the Federal courts was not enlarged as to its subject-matter or its forms of procedure by these acts of Congress, but that the spheres of law and equity are still distinct in patent cases as in all others, and that the latter powers are exercisible only where the plaintiff has no adequate remedy at law.[2] This view has been accepted and confirmed by the Supreme Court in a recent and exhaustive

jurisdiction over all actions, suits, controversies, and cases in equity and at law, arising under the Patent Laws. A suit demanding a discovery of the extent of an infringement of a patent right, and an account of the profits realized from such infringement, is manifestly a case arising under the Patent Law; and the natural interpretation of the language of the act would seem to be, that Congress has bestowed upon this Court a common jurisdiction, both on its law and equity sides, over all cases of that class, and that no suit of that character can be maintained at law which may not also be prosecuted in equity." See further Birdsall *v.* Coolidge (1876), 93 U. S. 64; 10 O. G. 748; Perry *v.* Corning (1870), 7 Blatch. 195; Hoffheins *v.* Brandt (1867), 3 Fisher, 218; Goodyear *v.* Hullihen (1867), 3 Fisher, 251; 2 Hughes, 492.

That the Circuit courts have original jurisdiction over patent cases in equity as well as in law, and the power to issue an injunction is a mere incident, see Atwood *v.* Portland Co. (1880), 10 Fed. Rep. 283; 5 Bann. & A. 533.

That the Federal court has jurisdiction in equity when the parties to a patent case belong in different States, but whether it has such jurisdiction when they belong in the same State, except for the purposes of an injunction, is doubtful, see Sayles *v.* Richmond, Fredericksburg, & Potomac R. R. Co. (1879), 16 O. G. 43; 3 Hughes, 172; 4 Bann. & A. 239.

[2] That although jurisdiction in equity is complete it is not exclusive, nor are its differences from law abolished, see Livingston *v.* Jones (1861), 2 Fisher, 207; 3 Wall. Jr. 330.

That equity has no jurisdiction where there is adequate remedy at law, see Spring *v.* Domestic Sewing Mach. Co. (1882), 13 Fed. Rep. 446; 22 O. G. 1445; Hayward *v.* Andrews (1882), 12 Fed. Rep. 786; Merriam *v.* Smith (1882), 11 Fed. Rep. 588.

That the act of 1819 did not enlarge or alter the equity jurisdiction of the Federal courts over the subject-matter of the controversy, but simply empowered those courts to exercise that jurisdiction when both the litigants were citizens of the same State, see Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477.

decision, and it may now, therefore, be considered as a settled principle that the legal and equitable remedies afforded to the owner of a patent are not concurrent, or interchangeable, nor can they be made so without a violation of the Federal Constitution, but that where adequate legal remedy exists he must seek his redress in an action at law, the issues in which may be submitted to a jury.[3]

§ 1085. Jurisdiction of Equity Complete whenever any Form of Equitable Relief is Necessary.

Pending the settlement of the foregoing question, another equitable doctrine has gradually introduced a change into the practice of the courts, and rendered still more clear the distinction between the jurisdictions of chancery and law. It is an established principle of equity that whenever it obtains cognizance of a cause for any purpose it will retain it until complete relief has been afforded to the injured party.[1] Thus in the earlier period of patent litigation, although after the grant of a preliminary injunction a trial at law was ordered upon certain issues, the case was finally adjudicated by the court of chancery, which awarded not only a compensation for the plaintiff's loss, but whatever other remedies might be required for his protection.[2] Under the influence of the theory that the acts of Congress enlarged the powers of equity, and the increasing conviction that the intricate questions of fact involved in patent causes were more appropriate for the determination of a skilful judge than of an inexperienced

[3] In Root *v.* Lake Shore & Michigan Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112; the following fundamental propositions are stated by the Supreme Court:—

1. That Secs. 55, 59, and 61 of the act of 1870 (being in substance Secs. 4919, 4920, and 4921 of the Revised Statutes, and embracing the provisions of the act of 1819, &c.) do not abolish the distinction between law and equity, nor change their ancient boundaries.

2. That the preservation of the distinction between law and equity is guaranteed by the Constitution.

3. That legal rights must be enforced in courts of law.

4. That equity cannot interfere where there is an adequate remedy at law.

§ 1085. [1] That if equity obtains jurisdiction for one purpose it will exercise it as to all, see Burdell *v.* Comstock (1883), 15 Fed. Rep. 395; Magic Ruffle Co. *v.* Elm City Co. (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

[2] For instances of this practice at an early date, see cases cited in notes to § 932, *ante*.

jury, this doctrine gained additional importance, and was applied to such advantage that trials at law upon the merits of the controversy slowly disappeared, and the entire disposal of the cause, in all its stages, vested in the court of equity alone.[3] Hence, though the judge in chancery has still the power to send the issues to a jury in a court of common law, this measure is rarely if ever adopted, and the whole proceedings are conducted as if no other tribunal than his own were in existence.[4]

§ 1086. No Equity Jurisdiction where Adequate Remedy Exists at Law.

As the result of these two principles, the respective jurisdictions of law and equity over suits for infringement are now clearly defined, and capable of accurate statement. Where the remedy at law is adequate, equity has no jurisdiction.[1]

[3] For examples of this complete assumption of equity jurisdiction without reference to proceedings at law, see cases cited in notes to § 932, *ante*.

[4] That chancery may still send an issue to be tried at law, see Watt *v.* Starke (1879), 101 U. S. 247; 17 O. G. 1092.

That equity has complete jurisdiction in patent causes and without the aid of courts of law may determine rights and give a complete remedy, see Wise *v.* Grand Avenue R. R. Co. (1888), 33 Fed. Rep. 277; Avery *v.* Wilson (1884), 20 Fed. Rep. 856; Sickles *v.* Gloucester Mfg. Co. (1856), 1 Fisher, 222; 3 Wall. Jr. 196.

That Sec. 61, act of 1870, provides a mode of trying all issues of fact and law without framing special issues and sending them to a jury, see Root *v.* Lake Shore and Michigan Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112.

That the equity jurisdiction of the Federal courts is not merely ancillary to law, and does not require that the patent be first established by the verdict of a jury, see Wise *v.* Grand Avenue R. R. Co. (1888), 33 Fed. Rep. 277; McMillin *v.* Barclay (1872), 4 Brews. (Pa.) 275; 5 Fisher, 189; Doughty *v.* West (1865), 2 Fisher, 553; Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351; Potter *v.* Fuller (1862), 2 Fisher, 251; Sanders *v.* Logan (1861), 2 Fisher, 167; Sickles *v.* Gloucester Mfg. Co. (1856), 1 Fisher, 222; 3 Wall. Jr. 196; Motte *v.* Bennett (1849), 2 Fisher, 642.

§ 1086. [1] That the distinction between law and equity is the same in patent cases as in others, and if the remedy at law is adequate equity has no jurisdiction, see Brooks *v.* Miller (1886), 28 Fed. Rep. 615; Crandall *v.* Plano Mfg. Co. (1885), 32 O. G. 1122; 24 Fed. Rep. 738; Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112; Spring *v.* Domestic Sewing Mach. Co. (1882), 13 Fed. Rep. 446; 22 O. G. 1445; Hayward *v.* Andrews (1882), 12 Fed. Rep. 786; Merriam *v.* Smith (1882), 11 Fed. Rep. 588; Sayles *v.* Richmond,

Where equitable interference is necessary for the complete protection of the plaintiff, equity has jurisdiction not only for that purpose but for all purposes, and can fully hear and finally determine all the issues in the cause.[2] No precise and universal test can be established for ascertaining the necessity of equitable interference. It depends upon the circumstances of the individual case, and relief will never be withheld where justice to the parties apparently requires its application. There are, however, certain classes of cases, which evidently fall upon one side or the other of the line dividing equity from law, and concerning which, therefore, the rule of jurisdiction may be more fully and explicitly declared.

§ 1087. Adequate Remedy Exists at Law in what Cases.

An adequate remedy at law exists in favor of the owner of a patent against an infringer wherever the sole relief required

Fredericksburg, & Potomac R. R. Co. (1879), 16 O. G. 43; 3 Hughes, 172; 4 Bann. & A. 239; Jenkins *v.* Greenwald (1857), 2 Fisher, 37; 1 Bond, 126; Motte *v.* Bennett (1849), 2 Fisher, 642.

That the test of equity jurisdiction is adequate remedy at law under the Judiciary Act of 1789 and subsequent Federal legislation, see McConihay *v.* Wright (1887), 121 U. S. 201.

That jurisdiction in equity attaches unless the legal remedy, both in respect to the final relief and the mode of obtaining it, is as efficient as the remedy which equity would confer under the same circumstances, see Kilbourn *v.* Sunderland (1889), 130 U. S. 505.

That the remedy in account is generally more complete and adequate in equity than at law, see Kilbourn *v.* Sunderland (1889), 130 U. S. 505.

That where the plaintiff's remedy at law is adequate the bill will be dismissed on demurrer, see Crandall *v.* Plano Mfg. Co. (1885), 32 O. G. 1122; 24 Fed. Rep. 738.

[2] That equity will take jurisdiction whenever the rights of the parties require it, see Brick *v.* Staten Island R. R. Co. (1885), 25 Fed. Rep. 553; Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112.

That if equity obtains jurisdiction for any purpose it will afford complete relief as to all matters involved in the suit, see Burdell *v.* Comstock (1883), 15 Fed. Rep. 395; *Magic Ruffle Co. v.* Elm City Co. (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann & A. 506.

That if the evidence shows that no equitable relief is or was required the bill will be dismissed *in toto*, and no relief given, see Clark *v.* Wooster (1886), 119 U. S. 322; 37 O. G. 1477.

That equity will retain jurisdiction after the death of an infringer, though no injunction will issue, but only an accounting can be ordered, see Kirk *v.* Du Bois (1886), 37 O. G. 102; 28 Fed. Rep. 460. *Contra*, Judson *v.* Draper (1873), 3 O. G. 354; 6 Fisher, 327; Holmes, 208.

is compensation for a past injury, provided this relief can be afforded without equitable aid. Thus where the plaintiff has chosen to seek his recompense for the enjoyment of the patented invention through an established license fee, and the infringing acts of the defendant raise an implied acceptance of the offer of the plaintiff, the sum which the plaintiff is entitled to recover is fixed and certain, the remedy at law is adequate, and equity can have no jurisdiction.[1] Where the infringement has already ceased, and the defendant, having made no gains or savings by his wrongful acts, can be held liable only for the damages sustained by the plaintiff, the legal remedy is also sufficient, and equity cannot interfere.[2] Where profits

§ 1087. [1] In Livingston *v.* Jones (1861), 2 Fisher, 207, Grier, J.: (210) "But it is plain that a patentee, whose invention is only valuable because used by all who pay a license fee, and who suffers no other wrong than the detention of such fee, has fixed his own measure of compensation, and needs none of the remedies which it is the duty of the chancellor to give for his protection. An injunction would do him no good; an account is not wanted; and the only remedy to which he is entitled being a judgment for a given sum of money, with interest, a court of law is his proper resort, where also he may recover a penalty to the extent of treble damages, if the judge sees fit to inflict it." 3 Wall. Jr. 330 (343). See also Brewster *v.* Tuthill Spring Co. (1888), 34 Fed. Rep. 769; Smith *v.* Sands (1885), 24 Fed. Rep. 470; 32 O. G. 1467; Vaughn *v.* Central Pacific R. R. Co. (1877), 4 Sawyer, 280; 3 Bann. & A. 27; Sanders *v.* Logan (1861), 2 Fisher, 167.

That the licensor cannot sue in equity to recover royalties, see Crandall *v.* Plano Mfg. Co. (1885), 24 Fed. Rep. 738; 32 O. G. 1123.

That a court of equity will not annul a license on the ground that the licensee does not pay the royalties, or make report, the remedy at law being adequate, see Densmore *v.* Tanite Co. (1887), 32 Fed. Rep. 544.

That an action for damages or profits on a license cannot be maintained in equity unless there is some other ground for equitable relief, see Consolidated Middlings Purifier Co. *v.* Wolf (1886), 28 Fed. Rep. 814; 37 O. G. 567.

That equity has jurisdiction to compel a discovery of the number of articles made under a license, where the licensee refuses to make his periodical reports as agreed, see Pope Mfg. Co. *v.* Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That where the patentee grants licenses to certain persons only, he may sue an infringer at law for the license fee or damages, or in equity for an injunction with profits and damages, see Bragg *v.* City of Stockton (1886), 27 Fed. Rep. 509; 11 Sawyer, 597.

[2] That where the plaintiff has a mere right to damages for past infringements equity has no jurisdiction, see Ulman *v.* Chickering (1887), 33 Fed. Rep. 582; Burdell *v.* Comstock (1883), 15 Fed. Rep. 395; Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112; Spring *v.* Domestic Sewing Mach. Co. (1882), 22 O. G. 1445; 13 Fed. Rep. 446; Jenkins *v.*

have been made by the defendant by an infringement now incapable of repetition, and the amount of these profits can be ascertained and collected through the ordinary action at law, this legal remedy is ample, and no recourse to equity is necessary.[3] When the patent has expired, and the entire claim of the plaintiff against the defendant rests upon infringing acts performed during the term, an action on the case for the recovery of damages often affords complete redress without the aid of equity.[4] Where the infringement is a breach of contract, by whose provisions the compensation of the plaintiff for the injury is determined, the sum due to the injured party is recoverable at law, and equitable interference cannot be invoked.[5] Of course, in many of these cases circumstances may arise, collateral to the main facts in the controversy, which require the interposition of a court of equity, but where these are absent, and the plaintiff's right to compensation and its amount can both be made manifest by the proceedings incident to a jury trial in a court of law, the remedy at law is adequate, and no occasion for the assistance of a court of equity exists.[6]

Greenwald (1857), 2 Fisher, 87; 1 Bond, 126.

[3] That equity has no jurisdiction over an action to recover profits where the account can be as readily settled at law, see Vaughn *v.* East Tennessee, Va., & Ga. R. R. Co. (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537; and cases cited in note 2, *ante*.

That equity has jurisdiction where an account can be more readily settled in equity than at law, see Vaughn *v.* East Tennessee, Va. & Ga. R. R. Co. (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

That in actions for an account of profits or receipts the remedy at law is less adequate than that in equity, see Kilbourn *v.* Sunderland (1889), 130 U. S. 505.

That the mere intricacy of an account does not give equity jurisdiction, see Creamer *v.* Bowers (1887), 30 Fed. Rep. 185; Adams *v.* Bridgewater Iron Co. (1886), 26 Fed. Rep. 324; 34 O. G. 1045; Lord *v.* Whitehead & Atherton Mach. Co. (1885), 24 Fed. Rep. 801; 33 O. G. 499.

As to whether an account of profits can be had at law in infringement cases, see § 1091, note 6, *post*.

[4] See § 1092 and notes, *post*.

[5] That equity has no jurisdiction over actions for breach of contract, see Magic Ruffle Co. *v.* Elm City Co. (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

[6] That where any necessity for equitable interference exists on any substantial ground equity will take jurisdiction, see Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112; Vaughn *v.* East Tennessee, Va., & Ga. R. R. Co. (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

§ 1087. No Adequate Remedy at Law against Future Infringements.

An adequate remedy at law does not exist in any case where future infringements are to be prevented, or where full compensation for past infringements is unobtainable in courts of law. Future infringements can be prevented only by an injunction issuing out of chancery, and to this relief the plaintiff is entitled whenever he has reason to apprehend a violation of his rights by the defendant.[1] In two cases an injunction is unnecessary; one where the plaintiff has an established license fee, which can be collected from the defendant in a suit at law if he should make the threatened use of the invention; the other where the infringement has been finally abandoned by the defendant, or has become impossible through the expiration of the patent.[2] But in every case where the patent is

§ 1088. [1] In Motte *v.* Bennett (1849), 2 Fisher, 642, Wayne, J.: (645) "The principle upon which courts of equity have jurisdiction in patent cases, and upon which injunctions are granted in them, is not that there is no legal remedy, but that the law does not give a complete remedy to those whose property is invaded; for if each infringement of the patent were to be made a distinct cause of action, the remedy would be worse than the evil. The inventor or author might be ruined by the necessity of perpetual litigation, without ever being able to have a final establishment of his rights. Hogg *v.* Kirby, 8 Ves. 223; Harmer *v.* Playne, 14 Ves. 132; Lawrence *v.* Smith, Jacob's R. 472. In addition to this consideration, the plaintiff could have no preventive at law to restrain the future use of his invention or the publication of his work, injuriously to his title and interest."

That where an infringement is expected, but has not yet occurred, equity will enjoin, though both parties live in the same State, see Sherman *v.* Nutt (1888), 35 Fed. Rep. 149.

That an existing infringement calls for equitable interference by injunction, and upon suit therefor damages will also be awarded, see Brooks *v.* Miller (1886), 28 Fed. Rep. 615.

That equity has jurisdiction whenever during the life of a patent damages and an injunction are asked for, see McMillin *v.* St. Louis & Miss. Valley Transportation Co. (1883), 18 Fed. Rep. 260; 5 McCrary, 561.

That no injunction will issue, under the Patent Law, against one who infringes pending the application for a patent, see Rein *v.* Clayton (1889), 37 Fed. Rep. 354.

That a court of equity will take jurisdiction and enjoin the defendant whenever the plaintiff's right requires it, see Brick *v.* Staten Island R. R. Co. (1885), 25 Fed. Rep. 553.

[2] That where plaintiff has an established license fee for all who choose to practise the invention no injunction is usually needed, see §§ 1171, 1198, and notes, *post*.

That where the defendant is no longer able to infringe no injunction is required, see §§ 1173, 1191, 1193, and

still in force, and the defendant is able and is apparently disposed to commit acts of infringement, if no established license fee exists, or if on account of the insolvency of the defendant or from any other cause this customary fee could not be collected, equity will restrain him from the use of the invention, and having thus acquired jurisdiction over the parties, and the subject-matter of the controversy, will afford such further relief as the plaintiff may require.[3]

§ 1089. No Adequate Remedy at Law where the Injured Party is not the Legal Owner of the Patent.

A court of law can give complete redress for past infringements only where the injured party is the legal owner of the patent, and where the compensation to which he is entitled can be measured by the actual damage that he has sustained.[1] A plaintiff, who is equitably interested in the patent but is not its legal owner, however he may suffer from an infringement, cannot maintain a suit for damages, but must resort to equity for the protection and enforcement of his rights.[2] Thus where he has contracted for the patent but has not yet received the instrument of conveyance, or where he has acquired rights in the patent by estoppel which he can vindicate against the legal owner, or where he is an heir or devisee for whom the personal representative of his deceased ancestor or testator holds the patent in trust, or where he is a licensee whose exclusive privileges the licensor himself invades, or in any other case where it is evidently impossible for him to secure complete relief without the assertion of his equitable interest

notes, *post;* and Potter *v.* Crowell (1866), 1 Abbott, 89; 3 Fisher, 112.

[3] That wherever the defendant may still infringe, equity will interfere, see Potter *v.* Crowell (1866), 1 Abbott, 89; 3 Fisher, 112.

§ 1089. [1] That only the holder of the legal title to the patent can sue at law, see § 937 and notes, *ante.*

[2] That the owner of an equitable title only must resort to equity for relief, see Rogers *v.* Reissner (1887), 30 Fed. Rep. 525; 41 O. G. 351; Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112.

That whenever the equitable owner can sue at law, and obtain an adequate remedy, in the name of the legal owner, equity has no jurisdiction, see Hayward *v.* Andrews (1883), 106 U. S. 272; 23 O. G. 533.

That the possession of two consistent titles does not warrant a resort to equity, see Hayward *v.* Andrews (1883), 106 U. S. 272; 23 O. G. 533.

against the infringer, equity may interfere in his behalf and administer complete relief according to the nature of his rights and the mode in which they are affected by the infringement.[3]

§ 1090. No Adequate Remedy at Law where a Discovery is Necessary or the Defence Rests on Equitable Grounds.

In many cases where the sole right of the plaintiff is to recover compensation for past infringements, it may be impossible to ascertain its measure or enforce its payment without recourse to those methods of investigation and compulsion which are peculiar to a court of equity. When data essential to the computation of the sum to which the plaintiff is entitled, or other facts material to his case, are within the personal knowledge of the defendant and cannot be ascertained except through his disclosure, equity may assume jurisdiction of the controversy in order to compel such a discovery as the plaintiff may require, and then retain it for all other purposes until entire relief has been afforded.[1] In the same manner, when the defence of the alleged infringer rests on equitable grounds, and when a suit at law would be enjoined upon his application if the plaintiff there pursued his remedy, equity will, in the first instance, entertain the plaintiff's claim in order to prevent the circuity of action which must otherwise ensue.[2]

[3] That one who has contracted to purchase the patent but has not perfected his legal title can sue only in equity, see § 938 and notes, *ante*.

That a licensee can sue only in equity in his own name, see § 938 and notes, *ante*.

§ 1090. [1] That where a discovery is needed equity may take jurisdiction, see Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112; Vaughn *v.* East Tennessee, Va., & Ga. R. R. Co. (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537; Perry *v.* Corning (1870), 7 Blatch. 195; Sickles *v.* Gloucester Mfg. Co. (1856), 1 Fisher, 222; 3 Wall. Jr. 196; Nevins *v.* Johnson (1853), 3 Blatch. 80.

That where an injunction or discovery is sought against a licensee, equity has jurisdiction, see Hat Sweat Mfg. Co. *v.* Porter (1888), 44 O. G. 1070.

[2] That where equitable rights are involved equity has jurisdiction, see Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112.

That equity will protect the equitable interest of the defendant although the plaintiff has the legal title, see Day *v.* Candee (1853), 3 Fisher, 9.

§ 1091. Whether Adequate Remedy Exists at Law when the Defendant's Gain from the Infringement Exceeds the Plaintiff's Loss.

Whether the mere fact that the defendant has derived pecuniary benefits from his wrongful use of the invention is sufficient to confer jurisdiction on a court of equity, in order to enforce an accounting and delivery of the profits to the owner of the patent, has been a most important and much disputed question. In favor of this ground of jurisdiction it has been often claimed, and sometimes held, that the defendant becomes by his infringement a constructive trustee, or trustee *de son tort*, for the plaintiff, and as such is accountable to him in equity for all the gains and savings which have resulted from his use of the invention.[1] This proposition has

§ 1091. [1] In Atwood *v.* Portland Co. (1880), 10 Fed. Rep. 283, Lowell, J.: (283) "The defendants contend that a suit in equity cannot be maintained because no injunction can now be issued, and they consider the account to be a mere incident to the injunction. In my opinion the account is no more incident to the injunction than the reverse. In Eureka Co. *v.* Bailey Co., 11 Wall. 488, which was an appeal from my decision, a bill was sustained for an account of royalties due by a contract concerning a patent; but the suit was not a patent suit, and an injunction against the use of the plaintiff's invention was asked and issued as incident to the accounting, — that is to say, until the defendants should pay the royalties. A similar case is Magic Ruffle Co. *v.* Elm City Co., 11 O. G. 501; 13 Blatch. 151, where the bill was sustained for an account under a contract relating to a patent, but without injunction, the patent having expired. Bills have been upheld and decrees rendered for an account, when the patent had expired during the progress of the cause, in Jordan *v.* Dobson, 2 Abb. (U. S.) 398; Sickles *v.* Gloucester Manfg. Co., 1 Fish. 222; 3 Wall. Jr. 196; 4 Blatch. 229, note; Imlay *v.* Nor. & Wor. R. Co., 4 Blatch. 227; Neilson *v.* Betts, L. R. 5 H. of L. 1; Seymour *v.* Marsh, 6 Fish. 115; affirmed, 97 U. S. 348. In this last case the point was not taken, but the fact was an obvious one, and the point was undoubtedly considered untenable. So where the patent had expired before suit was brought, or the defendant had died before or during suit, and there were no circumstances which authorized an injunction against his executor. (Howes *v.* Nute, 4 Fish. 263; American Wood Paper Co. *v.* Glens Falls Paper Co., 8 Blatch. 513; McComb *v.* Beard, 10 Blatch. 350; Smith *v.* Baker, 5 O. G. 496; Atterbury *v.* Gill, 13 O. G. 276.) In Draper *v.* Hudson, 1 Holmes, 208, Judge Shepley refused an account because an injunction could not be granted, but he cited none of the foregoing cases, and evidently overlooked the decision of Mr. Justice Clifford and myself in Howes *v.* Nute, 4 Fish. 263. As an authority in this court, therefore, his decision is not binding. It was made upon the supposed authority of Stevens *v.* Gladding, 17 How. 447, which, when carefully examined, is found not to decide this point. An injunction having been ordered in that

been declared erroneous by the Supreme Court of the United States, in a decision which asserts that a trustee *de son tort*

case, an account was given as incident thereto; but it was not, and, under the facts, could not be, decided that an account could never be ordered excepting as incident to an injunction. The question has lately been revived, and two judges have refused to sustain a bill after the expiration of the patent. (Vaughan *v.* Cent. P. R. Co., 4 Sawyer, 280; Sayles *v.* Richmond, &c., R. Co., 11 Chi. Leg. N. 281.) Two other judges, one of whom has had very great experience in patent causes, have upheld the equitable jurisdiction. (Vaughan *v.* East Tenn., &c. R. Co., 9 Chi. Leg. N. 255; 11 O. G. 789; Gordon *v.* Anthony, before Blatchford, J., April, 1879, an extract from whose judgment has been handed me. 16 Blatch. 234.) In the absence of a decision by the Supreme Court, I follow what I consider the preponderance of authority in the circuit courts. The statute of February 15, 1819 (3 St. 481), gave to the circuit courts of the United States 'original cognizance, as well in equity as at law, of all actions, suits, and controversies' arising under the Patent Laws. To this broad grant is added an express power to grant injunctions according to the course of courts of equity. This law was re-enacted in the two general acts revising and remodelling the Patent Law. (Statute July 4, 1836, § 17 (5 St. 124), and July 8, 1870, § 55 (16 St. 206).) This case arises under the law of 1870, and I have therefore no occasion to consider the effect of the provisions of the Revised Statutes upon this subject, though I should be surprised to find that they had changed the law. I do not see how it is possible to contend that this comprehensive grant of power can be construed to depend upon the added power to grant injunctions. In the following cases, very able and learned judges have said that the jurisdiction is statutory, and not dependent upon the general rules which govern what we may call customary equity, or have simply said that the plaintiff might elect his remedy. (Nevins *v.* Johnson, 3 Blatch. 80; Sickles *v.* Gloucester Manfg. Co., 3 Wall. Jr. 196; Imlay *v.* Nor. & Wor. R. Co., 4 Blatch. 227; Howes *v.* Nute, 4 Fish. 263; Hoffheins *v.* Brandt, 3 Fish. 218; Marsh *v.* Seymour, 97 U. S. 348, 349; Perry *v.* Corning, 7 Blatch. 195; Cowing *v.* Rumsey, 8 Blatch. 36, 38.) Add to these the several decisions before cited, and the point seems to be established; for those decisions can hardly rest upon a narrower foundation. Mr. Justice Grier, one of the first judges to lay down this broad rule, afterwards qualified its generality in certain dicta, but he was careful not to decide against the jurisdiction in equity. (See Livingston *v.* Jones, 3 Wall. Jr. 330, 344; Sanders *v.* Logan, 2 Fish. 170; and see Judge McKennan's explanation of these cases in McMillon *v.* Barclay, 5 Fish. 189, 194.) A constitutional objection might, perhaps, be raised to the denial of a jury trial in the case of a bill for the mere recovery of a definite sum of money if the plaintiff clearly required no equitable remedy or assistance whatsoever. That point has not been argued in this or any other case that I know of, and may be left for decision when it shall arise. Such cases must be rare, because the accounting in equity is a peculiar remedy, to which an action at law for damages can very rarely be adequate, unless the plaintiff chooses to consider it so. He may call for an account in equity, and if that proves unsatisfactory, may add damages in the same suit. This case might rest upon that basis." 5 Bann. & A. 533 (533).

can exist only where the property wrongfully appropriated was already subject to a trust, and that although when an account from an infringer is required the rules which govern it resemble those applied to a trustee, the duty of accounting rests on other grounds than those of a trusteeship between the infringer and the owner of the patent.[2] Another claim

[2] In Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112; Matthews, J., at great length argues and clearly demonstrates that equity has no jurisdiction where the remedy at law is adequate, and that though an infringer is treated in equity in some respects like a trustee, he is not really a trustee *de son tort* since the latter becomes such only by meddling with property already held in trust. No extract from this opinion could do justice to the subject or supply the place of the discussions and explanations therein contained.

In Sayles *v.* Richmond, Fredericksburg, & Potomac R. R. Co. (1879), 3 Hughes, 172, Hughes, J.: (178) "The question of jurisdiction did not arise in any one of these cases. Much less did the court in a single instance intimate, in the remotest manner, that notwithstanding the existence of an adequate common-law remedy equity could take jurisdiction of a bill for profits arising from the use of a patent, solely on the ground of constructive trusteeship. I have looked through the reports in vain for any direct authority for such a jurisdiction. There is such a thing known in equity jurisprudence as a trustee *de son tort*, but in every mention of such a trustee in the books, the property in respect to which a person has been regarded as a trustee *de son tort* has possessed, before the interference with it, the character of fiduciary property. I think it clear law that it is only in respect to property already subject to a trust and stamped with the fiduciary character that a person can become a trustee *de son tort*. In the present case, if the assignment of the patent from Tanner to Sayles had been in trust for the benefit of beneficiaries recognized in law as such, and Sayles were here suing for the trust funds for the benefit of such beneficiaries, the defendant might, I suppose, upon the teaching of the authorities on the subject, be treated as a trustee *de son tort*, and be sued in equity. But I think that it may safely be held that in any case of constructive trusteeship the character of trustee *de son tort* does not attach in such manner as to give equitable jurisdiction over him, unless the property with which he interfered was already trust property when the interference occurred." 16 O. G. 43 (44); 4 Bann. & A. 239 (245).

In Draper *v.* Hudson (1873), 3 O. G. 354, Shepley, J.: (355) "The record in this case shows the death of the defendant. No injunction can issue against the defendant, and, as there is no proof of infringement by the executor, none can issue against him. No discovery is prayed for against the executor and there is no presumption of any knowledge by him of his testator's acts. When the title to the principal relief which is the proper subject of a suit in equity — the injunction and discovery — fails, the incident right to an account fails, also. (Price's Pat. Candle Co. *v.* Beawans C. Co., 4 K. & J. 727; Bailey *v.* Taylor, 1 R. & M. 73; Smith *v.* London & S. W. R. R. Co., Kay, 415; Kerr on Injunctions, 435.) Although the jurisdiction of the Circuit court in equity, in patent causes, rests upon statute provisions, it is to be exercised

in support of such jurisdiction grows out of the alleged right of the plaintiff to recover in all cases the gains and savings of the defendant whenever these exceed the actual damages which he has sustained. Before the act of 1870, the plaintiff could at law recover only damages measured by his own loss, however great the profits of the defendant may have been, while in equity he could secure the entire profits of the defendant without reference to the extent of his own loss. Hence it was argued that as the law could not have intended to discriminate between owners of patents in reference to the amount of compensation for infringement, on the mere basis of their right to other equitable relief and irrespective of the injury they had actually received, it must be held that whenever the defendant's profits exceed the plaintiff's loss no adequate remedy exists at law and an accounting may be had in equity.[3] Whatever force resides in this argument was much increased by the act of 1870, which gave additional advantage to the plaintiff in equity by enabling him to recover not only the gains and savings made by the defendant, but damages also where his loss exceeded the defendant's profit. The principle from which this argument is deduced rests on sound reason and true public policy. The amount of compensation justly due to the owner of a patent for a past infringement cannot depend in any degree upon his present right to an injunction, a discovery, or other equitable remedies; and to limit his recovery to simple damages in one case and allow him damages and profits in another, where the circumstances and extent of the injury have been the same, is an unreasonable and unfounded distinction against plaintiffs who have not discovered, or have been unable to begin an action for, the infringement

according to the course and principles of courts of equity; and the Supreme Court of the United States having decided in Stevens *v.* Gladding, 17 Howard, 455, that 'the right to an account of profits is incident to the right to an injunction in copy and patent right cases,' it would seem to follow that in a case like the present, where the title to equitable relief fails, the general rule of equity applies that the incidental relief fails also." Holmes, 208 (209); 6 Fisher, 327 (328).

See also Brooks *v.* Miller (1886), 28 Fed. Rep. 615; Jenkins *v.* Greenwald (1857), 2 Fisher, 37; 1 Bond, 126.

[3] That where the defendant's profits exceed the plaintiff's damages there is no adequate remedy at law, see Perry *v.* Corning (1868), 6 Blatch. 134.

until an injunction or other equitable relief is no longer necessary. But whether in all cases, where the plaintiff seeks for compensation on the ground of gains and savings made by the defendant, he should be permitted to proceed in equity for an accounting, presents a different question. It has, indeed, been held that whenever the defendant's gains exceed the plaintiff's loss equity has jurisdiction to order an account and enforce payment of the excess, and some courts have decided that the existence of gains and savings is alone sufficient to authorize a court of equity to entertain an action for account without regard to any other element of controversy.[4] To this question, however, the Supreme Court has likewise given a negative answer, declaring that an account, in cases of infringement, is never *ipso facto* an equitable remedy, but is always incidental to an injunction or some other form of equitable relief, and hence that chancery acquires no jurisdiction from the fact that profits have been made by the defendant, whether these were less or greater than the damages sustained.[5] At the same time it suggested that where the nature of the account renders equitable interposition necessary chancery jurisdiction might exist, as if an account for gains and savings might in some cases be obtained at law. The true solution of the difficulty may perhaps be found by holding the defendant responsible for his

[4] See note 1, *ante*.

[5] In Root *v.* Lake Shore & Michigan Southern R. R. Co. (1882), 105 U. S. 189, Matthews, J.: (215) "Our conclusion is that a bill in equity for a naked account of profits and damages against an infringer of a patent cannot be sustained; that such relief ordinarily is incidental to some other equity, the right to enforce which secures to the patentee his standing in court; that the most general ground for equitable interposition is to insure to the patentee the enjoyment of his specific right by injunction against a continuance of the infringement; but that grounds of equitable relief may arise other than by way of injunction, as where the title of the complainant is equitable merely, or equitable interposition is necessary on account of the impediments which prevent a resort to remedies purely legal; and such an equity may arise out of and inhere in the nature of the account itself, springing from special and peculiar circumstances which disable the patentee from a recovery at law altogether, or render his remedy in a legal tribunal difficult, inadequate, and incomplete; and as such cases cannot be defined more exactly each must rest upon its own particular circumstances as furnishing a clear and satisfactory ground of exception from the general rule." 21 O. G. 1112 (1120).

profits in all cases where they exceed the damages sustained by the plaintiff, and by requiring the plaintiff to bring his action of account in a court of law whenever the number of the parties and the nature of the transactions will permit, and by allowing him to resort to equity, when the law cannot adjust the conflicting claims, under the general jurisdiction which chancery possesses over partners, bailiffs, and all others who are similarly related to each other.[6]

[6] In reference to this proposition the question first arises whether in pursuing a legal remedy for an infringement the plaintiff is by law confined to an action on the case for damages. That such has been the general opinion must be conceded. The acts of 1790, 1793, and 1800 imposed specific penalties on an infringer, and treated the right of action for these penalties as resting on the statute, and indicated trespass on the case as the form in which the right thereto might be enforced. The acts of 1836 and 1870 and the Revised Statutes prescribe that the plaintiff *may* recover actual damages in an action on the case, and are silent as to any other method of redress. That in several cases wrongs, which in their nature are true infringements, are remedied in different modes even in courts of law is evident, as, for example, when an infringer may be treated as a licensee and sued for royalties, or a licensee who has violated his contract and lost his right to its protection may still be held for damages for breach of his agreement. If the wrong done to the plaintiff by the unauthorized use of his invention be regarded as a wrong simply, and not a mere occasion for inflicting a statutory penalty, there would seem no reason why a patentee should not seek any redress known to the law in any form which might be appropriate therefor.

A second question relates to the nature of the wrong suffered by a patentee from an infringement. Actual damages are indeed measured by actual loss; but, as a fact, it is certainly true that the wrong committed against a patentee is often greater than the loss he has sustained by the unlawful use of his improvement. This fact is recognized by the constant practice of equity, confirmed and extended by statute, of giving to the plaintiff the entire benefit which the defendant has derived from the infringement. No servile adherence to equitable methods of procedure could preserve this rule, were it not founded in justice and in the universal conviction that the plaintiff is entitled not only to the profits of which the defendant has deprived him, but to all the advantage which has flowed from his invention. Now if the right to the defendant's profits is a right inhering in the plaintiff by reason of the infringement, as distinguished from a mere incident of equity procedure, why should not the plaintiff be allowed to treat the defendant as his agent or trustee, in law as well as equity, and where the nature of the transaction permits find his remedy by waiving the tort and suing in assumpsit or by the special action of account? See Steam Stone Cutter Co. *v.* Sheldons (1883), 24 O. G. 703; 21 Blatch. 260; 15 Fed. Rep. 608.

A third question has reference to the power of the court to remove this discrepancy, at least in part, under its authority to treble damages. In an action at law has the judge the right to take notice of the excess of the defendant's profits over the plaintiff's loss as a ground for increasing the amount awarded

§ 1092. Whether Adequate Remedy Exists at Law when the Patent has Expired before Suit is Commenced.

Upon the solution of this question depends in part that of another: Whether a court of equity can entertain an action for infringement which has been instituted since the expiration of the patent? An infringing act can be committed after the patent has expired only by the use or sale of patented articles which were made for that purpose during the life of the patent, and therefore an injunction can be necessary in these instances alone. In such cases equity has jurisdiction at whatever period the action may be brought, and may restrain the defendant in the same manner as in suits begun while the patent was still in force.[1] When the plaintiff has an equitable

by the jury? If so, relief exists in cases does not give jurisdiction in equity, see Adams *v.* Bridgewater Iron Co. (1886), 26 Fed. Rep. 324; 34 O. G. 1045; Lord *v.* Whitehead & Atherton Mach. Co. (1885), 24 Fed. Rep. 801; 33 O. G. 499.

where actual damages are rendered, and the defendant's profits are not more than twice the plaintiff's loss. But in other cases of actual damages, and in all cases of nominal damages, this resort would fail, and the plaintiff thus suffer in the amount of his recovery, solely because no ground for equitable interference could be discovered.—

In the absence of any authority directly bearing on these questions, allusions and suggestions of the courts become important. In Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112; and in Vaughn *v.* East Tennessee, Va., & Ga., R. R. Co. (1877), 1 Flippin, 621; 11 O. G. 789; 2 Bann. & A. 537,—the judges use language implying that in some form of accounting the plaintiff may have relief at law, and on that ground deny the jurisdiction of chancery unless the nature of the account is such that it cannot be as readily settled at law. But the subject is not yet sufficiently developed for the formation of a permanent opinion, nor can it be intelligently considered until the second question stated in this note has been decided.

That mere intricacy in the account

§ 1092. [1] That the use, after the patent has expired, of articles made for that purpose without authority during the life of the patent, is an infringement, see § 908 and notes, *ante*.

That the use of such articles may be enjoined after the patent expires, see New York Belting & Packing Co. *v.* Magowan (1886), 27 Fed. Rep. 111; 34 O. G. 1278; Toledo Mower & Reaper Co. *v.* Johnson Harvester Co. (1885), 23 Blatch. 332; 24 Fed. Rep. 739; 32 O. G. 1010; and cases cited in §§ 1171, 1191, 1193, and notes, *post*.

That an injunction will not be granted after a patent has expired to prevent the use or sale of articles which were made and sold during the life of the patent, the remedy being at law for the past infringement, see Westinghouse *v.* Carpenter (1883), 46 O. G. 244.

That an assignee of the damages after patent expires has adequate remedy at law and cannot sue in equity, see Hayward *v.* Andrews (1882), 12 Fed. Rep. 786.

That a bill cannot be maintained

interest without the legal title and cannot obtain adequate redress by a suit at law in the name of the legal owner, or when the defence rests upon equitable grounds, or for any reason a discovery is required, equity will also take cognizance of the action without reference to the expiration of the patent.[2] But when the only remedy to which the plaintiff is entitled consists in compensation for past infringements, and for these he could maintain a suit for damages at law, his right to proceed in equity for an account of profits must be determined by the answer given to the question discussed in the preceding paragraph. That such an accounting may be had in equity as incidental to other equitable relief, whether after or before the patent expires, is certain.[3] It is equally certain that where no other equitable relief can be afforded, and an account of profits can be obtained at law, no suit in equity can be commenced.[4] But

after the patent expires merely because it prays for an injunction against the use and sale of such infringing tools, &c., made during the patent, "as may be found in the defendant's possession," see Consolidated Safety Valve Co. *v.* Ashton Valve Co. (1886), 26 Fed. Rep. 319.

[2] That a bill for discovery will lie after the patent expires, see Sickles *v.* Gloucester Mfg. Co. (1856), 1 Fisher, 222; 3 Wall. Jr. 196; Nevins *v.* Johnson (1853), 3 Blatch. 80.

That where equitable relief of any form is necessary equity will have jurisdiction though the patent has expired, see Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112.

[3] That whenever any equitable relief is required an account or damages may be also awarded, see Burdell *v.* Comstock (1883), 15 Fed. Rep. 395; Magic Ruffle Co. *v.* Elm City Co. (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

[4] If it be conceded (as is here suggested only, but not claimed) that a plaintiff can recover the profits of the defendant by an action at law (otherwise than as they have already been shown to be a measure of his damages), his proper remedy must be not case but assumpsit or account. Still in these actions, according to their ordinary rules, the profits must be limited to gains received, and could not embrace those remote pecuniary benefits which are represented only by the difference between a lesser and a greater loss. The real difficulty appears to lie in the fact that under our decisions as to the items entering into "profits in equity," a patentee who can sue in equity can recover a more extended money compensation for the same infringement than he could at law, and the measure of his recompense is thus made to depend in part upon his right to other relief with which the amount of his recovery is neither in theory nor in fact connected. See § 1091 and notes, *ante*.

That equity has no jurisdiction where the bill shows on its face that the patent had expired before the suit began and merely prays for an injunction, account,

when the number and relation of the parties, or the nature of the account, renders it impossible that an adequate accounting can be had at law, it seems that equity may entertain proceedings of this character, in order to secure to the plaintiff that complete redress of which he must otherwise be deprived.[5]

§ 1093. Whether Adequate Remedy Exists at Law where the Patent Expires Pending Suit.

A suit commenced in equity in good faith, while the patent is in force, is not affected by its expiration.[1] Whatever relief

and damages, and not for any special relief, see Brooks *v.* Miller (1886), 28 Fed. Rep. 615; Campbell *v.* Ward (1882), 12 Fed. Rep. 150.

[6] That where the titles in controversy are equitable, or the nature of the account requires it, or any equitable relief is demanded, equity will take jurisdiction after the patent expires, see Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112; Campbell *v.* Ward (1882), 12 Fed. Rep. 150.

That more intricacy in the account does not give jurisdiction in equity, see Adams *v.* Bridgewater Iron Co. (1886), 26 Fed. Rep. 324; 34 O. G. 1045; Lord *v.* Whitehead & Atherton Mach. Co. (1885), 24 Fed. Rep. 801; 33 O. G. 499.

That a bill in equity cannot be sustained after the patent expires for the mere purpose of discovering the extent of the infringement and the recovery of profits, the procedure and remedy at law being adequate, see Lord *v.* Whitehead & Atherton Mach. Co. (1885), 24 Fed. Rep. 801; 33 O. G. 499.

That after a patent has expired equity will not enjoin an action at law unless there is a purely equitable defence not available at law, see Concord *v.* Norton (1883), 16 Fed. Rep. 477.

Under the views of equity jurisdiction formerly prevailing it was frequently held that a bill for an account of profits, without other equitable relief, could be entertained after the patent had expired. See Atwood *v.* Portland Co. (1880), 10 Fed. Rep. 283; 5 Bann. & A. 533; Gordon *v.* Anthony (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248; Stevens *v.* Kansas Pacific R. R. Co. (1879), 5 Dillon, 486; Sayles *v.* Dubuque & Sioux City R. R. Co. (1878), 5 Dillon, 561; Howes *v.* Nute (1870), 4 Fisher, 263; 4 Clifford, 173; Blank *v.* Mfg. Co. (1856), 3 Wall. Jr. 196; 1 Fisher, 222.

§ 1093. [1] That jurisdiction in equity over an action once properly instituted is not destroyed by the expiration of the patent, see Beedle *v.* Bennett (1887), 122 U. S. 71; 39 O. G. 1326; Clark *v.* Wooster (1886), 119 U. S. 322; 37 O. G. 1477; Adams *v.* Bridgewater Iron Co. (1886), 34 O. G. 1045; 26 Fed. Rep. 324; Brooks *v.* Miller (1886), 28 Fed. Rep. 615; Dick *v.* Struthers (1885), 25 Fed. Rep. 103; 34 O. G. 131; Burdell *v.* Comstock (1883), 15 Fed. Rep. 395.

That the expiration of the patent, pending suit, will not affect the jurisdiction if an injunction were granted or prayed for during the life of the patent, see Burdell *v.* Comstock (1883), 15 Fed. Rep. 395.

That equity will retain jurisdiction, once acquired, after the patent expires, if equitable relief were prayed for in the bill, though no injunction were asked or

was prayed for in the bill may nevertheless be granted, unless the cessation of the exclusive privilege has rendered it no longer necessary. Thus although no injunction can be issued, and though adequate redress at law might be obtained if an action for damages were now begun, the court of equity having once properly acquired jurisdiction will retain it for the purpose of an account and until the remedy of the plaintiff has been finally secured.[2] The interval which elapses between the institution of proceedings and the expiration of the patent is immaterial, except as bearing on the question of good faith.[3]

granted, see Dick *v.* Struthers (1885), 25 Fed. Rep. 103; 34 O. G. 131.

[2] In Adams *v.* Howard (1884), 19 Fed. Rep. 317, Wallace, J.: (319) "No doubt is entertained of the propriety of decreeing an accounting, although the patent has expired since the commencement of the suit, and although for that reason there should not be an injunction. The jurisdiction of a court of equity having been legitimately invoked by the complainant, he will not be sent away without redress merely because all the redress to which he was originally entitled cannot now be awarded to him. Under such circumstances, the court will retain the cause in order to completely determine the controversy." 22 Blatch. 47 (48); 26 O. G. 825 (826).

In Imlay *v.* Norwich & Worcester R. R. Co. (1858), 1 Fisher, 340, Ingersoll, J.: (342) "Exception has been taken by the defendants that, as an injunction cannot now be ordered, that the account and the other relief sought by the bill cannot be granted; that the ordering the account, and the granting the other relief, are ancillary to the granting of the injunction, and that an account cannot be ordered unless an injunction is also ordered. The Patent Act of 1836, in the 17th section thereof, provides 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. And it has already been expressly decided by Judge Grier, in a case tried before him, on the Sickles patent [Sickles *v.* Gloucester Manufacturing Co., *ante*, p. 222], where, between the time of filing the bill and the hearing, the patent had expired, that an account could be ordered, and other relief granted, though on account of the expiration of the patent an injunction to restrain the further use could *not issue*." 4 Blatch. 227 (228).

Further, that equity jurisdiction is not defeated by the expiration of the patent pending suit, but the court will give any relief that may be needed, see Gottfried *v.* Moerlein (1882), 14 Fed. Rep. 170; Jones *v.* Barker (1882), 11 Fed. Rep. 597; 22 O. G. 771; Bloomer *v.* Gilpin (1859), 4 Fisher, 50.

Contra: Draper *v.* Hudson (1873), Holmes, 208; 6 Fisher, 327; 3 O. G. 354.

That if one of two patents counted on in the bill expires pending suit an injunction may be granted in reference to the other, and an account for damages and profits on both, see Consolidated Safety Valve Co. *v.* Crosby Steam Gauge & Valve Co. (1884), 113 U. S. 157; 30 O. G. 991.

[3] That equity may take jurisdiction

A suit commenced without intent to ask for an injunction or other equitable interference, but merely to procure an accounting after the patent has expired in a case over which, if then brought, equity would have no jurisdiction, is an evasion of the law, and when the patent does expire will be dismissed.[4] But though a bill is filed and an injunction issues

where under the rules of the court an injunction can issue before the patent expires, however short the period when it can be effective, and may also grant such other relief as is required, see Singer Mfg. Co. *v.* Wilson Sewing Mach. Co. (1889), 38 Fed. Rep. 586; Westinghouse Air Brake Co. *v.* Carpenter (1887), 32 Fed. Rep. 484; Kittle *v.* Rogers (1887), 33 Fed. Rep. 49; Kittle *v.* De Graaf (1887), 30 Fed. Rep. 689; Beedle *v.* Bennett (1887), 122 U. S. 71; 39 O. G. 1326; Clark *v.* Wooster (1886), 119 U. S. 322; 37 O. G. 1477; Toledo Mower & Reaper Co. *v.* Johnson Harvester Co. (1885), 23 Blatch. 332; 24 Fed. Rep. 739; 32 O. G. 1010.

That where a bill is filed on several patents soon enough to issue an injunction as to all, the expiration of either will not oust equity of jurisdiction over it as far as needed in order to give proper relief, see New York Grape Sugar Co. *v.* Peoria Grape Sugar Co. (1884), 32 O. G. 138; 21 Fed. Rep. 878.

That the Supreme Court will not reverse a decree for want of jurisdiction in the court below if when the bill was filed the court had jurisdiction, though on narrow grounds, and the defendant did not then except, see Clark *v.* Wooster (1886), 119 U. S. 322; 37 O. G. 1477.

That a court does not acquire jurisdiction until the entire title is before it, and if some of the owners are not brought in until after the patent expires, equity has no further authority and the bill must be dismissed, see Hewitt *v.* Pennsylvania Steel Co. (1885), 31 O. G. 1686; 24 Fed. Rep. 367.

That if a bill in equity is amended after the patent expires and as amended shows ground for equitable relief, equity will retain jurisdiction, see Reay *v.* Raynor (1884), 26 O. G. 1111; 19 Fed. Rep. 308; 22 Blatch. 13.

That where a bill is filed too late for an injunction to issue before the patent expires, and adequate relief exists at law, jurisdiction in equity does not exist, see Clark *v.* Wooster (1886), 119 U. S. 322; 39 O. G. 1477; Mershon *v.* Pease Furnace Co. (1885), 23 Blatch. 329; 24 Fed. Rep. 741; 32 O. G. 1010.

That a bill filed too late for an injunction before the patent expires is to be dismissed with costs to the defendant, see Mershon *v.* Pease Furnace Co. (1885), 23 Blatch. 329; 24 Fed. Rep. 741; 32 O. G. 1010; Davis *v.* Smith (1884), 19 Fed. Rep. 823.

That a bill filed before the patent expires, but not praying for a preliminary injunction, may be amended by inserting such a prayer at any time, and if in good faith confers equity jurisdiction, see Adams *v.* Bridgewater Iron Co. (1886), 26 Fed. Rep. 324; 34 O. G. 1045.

[4] That where a bill was filed five days before the patent expired and no effort was made to obtain an injunction, the prayer for injunction will be held a mere pretext and the case not within equity jurisdiction, see Burdell *v.* Comstock (1883), 15 Fed. Rep. 395.

That where a patent is to expire in two months it is doubtful whether equity can take jurisdiction, see Racine Seeder Co. *v.* Joliet Wire-check Rower Co. (1886), 27 Fed. Rep. 367; 37 O. G. 452.

just before the expiration of the patent, the tardiness of the application, if the plaintiff has been guilty of no laches and in good faith brings his suit, cannot defeat his right to whatever equitable relief the court may at that time or thereafter be able to afford.

§ 1094. General Rules of Equity Jurisdiction.

From this review of the nature and extent of equity jurisdiction, over cases founded on the violation of a patent privilege, the following conclusions may be drawn:[1] (1) That primary jurisdiction over all suits for infringement resides in courts of law, and that whenever adequate redress can be obtained by an action on the case for damages, or other common-law proceeding, equity has no jurisdiction; (2) That where an adequate remedy at law does not exist, whatever may be the cause or the degree of such inadequacy, equity will take cognizance of the action, and will retain it until complete redress has been afforded; (3) That no adequate remedy exists at law in cases where future infringements are to be prevented, or a discovery is required, or equitable interests are to be protected, or equitable defences are to be urged, or perhaps where an account of profits cannot be obtained by methods known to courts of law, and therefore that in all these cases equity has jurisdiction to entertain original proceedings and to administer entire relief; (4) That in any case, in which the peculiar circumstances of the parties or the controversy render a just determination of the issues impos-

§ 1094. [1] For a history and discussion of the equity jurisdiction over actions for infringement, see Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112; Motte *v.* Bennett (1849), 2 Fisher, 642.

That equity will not entertain a case unless the prospect of affording ultimate equitable relief is reasonable, see Brooks *v.* Miller (1886), 28 Fed. Rep. 615.

That equity will not entertain a matter which a party has had a chance to litigate in another court, in a case there decided against him, unless something prevented him from urging it, see Brooks *v.* Moorhouse (1878), 13 O. G. 499; 3 Bann. & A. 229.

That in some cases legal and equitable jurisdiction are concurrent notwithstanding Sec. 723, Rev. Stat., see Spring *v.* Domestic Sewing Mach. Co. (1882), 22 O. G. 1445; 13 Fed. Rep. 446.

That the equity powers of the Federal Courts under the Patent Acts include all the incidents of equity jurisdiction, see Potter *v.* Dixon (1863), 2 Fisher, 381; 5 Blatch. 160.

sible at law, equity may interfere and apply such remedies as the cause demands.

§ 1095. Equity Jurisdiction not Conferrable by Waiver or Agreement of Parties.

A want of jurisdiction in equity, on account of the existence of an adequate remedy at law, cannot be waived by any acquiescence or agreement of the parties to the suit.[1] It is an incurable defect of which advantage may be taken at any stage of the proceedings; and whenever noticed by the court, whether or not insisted on by the defendant, the suit will be dismissed and the plaintiff will be left to the pursuit of his legal remedy.

§ 1096. Local Jurisdiction in Equity in General Identical with that at Law.

Actions in equity may be brought in any district within which the defendant can be personally and lawfully served with process. The rule on this point is the same as that in actions at law.[1] A service by the attachment of property con-

§ 1095. [1] In Spring *v.* Domestic Sewing Mach. Co. (1882), 13 Fed. Rep. 446, Nixon, J.: (448) "But it is never too late at any time, during the pendency of the proceedings, for the court to examine into its right and power to make a decree or enter a judgment in a case. In the Federal courts, especially, where there is no presumption in favor of jurisdiction, but where it rests solely upon the facts which appear in the record of the suit (*Ex parte* Smith, 24 U. S. 456), it has long been the practice of the judges, at any state of the proceedings, *sua sponte*, to decline jurisdiction and dismiss the case, when the want of authority to act becomes apparent. They do not wait for the question to be raised by demurrer or answer or plea, or to be suggested by the counsel. And they pursue this course for obvious reasons. It is not merely a matter of the form of procedure. To entertain a suit in equity, when the party has a plain and complete remedy at law, is to deprive the defendant of his constitutional right of trial by jury. The late Justice Baldwin, of this circuit, discusses the subject with much ability and research, in the case of Baker *v.* Biddle, 1 Bald. 394. See, also, the more recent cases of Hipp *v.* Babin, 19 How. 278; Lewis *v.* Cocks, 23 Wall. 466; Dumont *v.* Fry, 12 Fed. Rep. 21." 22 O. G. 1445 (1446).

That an evident defect in jurisdiction may be taken advantage of at the hearing, see Burdell *v.* Comstock (1883), 15 Fed. Rep. 395.

That want of jurisdiction over the subject-matter cannot be waived, see Gould on Pleading, ch. v. §§ 14–25; Cooley Const. Lim., pp. 398–407.

§ 1096. [1] That a suit in equity for infringement may be brought in any district where the defendant may be

fers no jurisdiction over the person, nor does a service on the defendant, while attending other legal proceedings under the protection of the court, compel him to answer and defend the suit in which such service has been made.[3] A corporation can be sued in any district in the State from which its charter was received, or in any foreign district in which it can be served with process according to the local law.[3] Service upon its officers within the district, in the absence of local provisions to the contrary, is not service on the corporation, nor is the objection waived though the officers served appear by attorney and plead to the jurisdiction.[4] When any defendant is sued out of his own district it must appear, by the marshal's return on the *subpœna*, that he was personally served in the district of suit.[5] A defendant, appearing by attorney, submits to the jurisdiction, and in all cases waives the objection unless he duly and seasonably urges it as a ground for the dismissal of the action.[6]

§ 1097. Local Jurisdiction in Equity, wherein Different from that at Law.

In one respect, however, this subject of local jurisdiction raises a different question in equity from that which it presents at law. A judgment in a court of law for damages ren-

found, though he resides in another district and infringes there, see Thompson *v.* Mendelsohn (1871), 5 Fisher, 187; but see § 934, note 3, *ante*.

That the local jurisdiction of a Federal court of equity over the person in patent cases is governed by the same rules as that of a court of law, see Sec. 739, Rev. Stat.; also Winter *v.* Ludlow (1859), 3 Phila. 464; Chaffee *v.* Hayward (1857), 20 How. 208; Day *v.* Newark Mfg. Co. (1850), 1 Blatch. 628; Allen *v.* Blunt (1849), 1 Blatch. 480.

[2] That service by attachment of property cannot confer jurisdiction, see Saddler *v.* Hudson (1854), 2 Curtis, 6; Day *v.* Newark Mfg. Co. (1850), 1 Blatch. 628.

That service on the defendant within the district while attending court or an examination of witnesses is not valid, see § 934 and notes, *ante*.

[3] For the rules governing service on corporations, see § 935 and notes, *ante*.

[4] As to service on the officers of a corporation, see § 935 and notes, *ante*.

[5] That the marshal's return must show that the service was legally made within the district, see Allen *v.* Blunt (1849), 1 Blatch. 480.

[6] That defect of service is waived by appearance unless immediate objection is taken, see Teese *v.* Phelps (1855), 1 McAllister, 17.

That a defect in signing the citation is cured by appearance, see Chaffee *v.* Hayward (1857), 20 How. 208.

ders the defendant liable to the plaintiff for the payment of a definite sum of money that can be collected out of his property wherever situated, without regard to the limits of the district in which the judgment was obtained. A decree in equity, on the other hand, can be enforced only against the person of the defendant, and within the territorial jurisdiction of the court by which it was passed. Hence where the relief prayed for in the bill cannot be wholly or in part afforded, without the exercise of authority over the person of the defendant beyond the limits of the district within which the suit is brought, the court can make no order that will benefit the plaintiff and must, therefore, decline to entertain the case.[1] Thus for the prevention of future infringements, or other similar redress which can be enforced only within a given district, the action in equity must be instituted in that district although a legal remedy might be obtained wherever the defendant could be found.[2] To this rule there is one exception, in favor of the district in which the defendant resides, the court of such

§ 1097. [1] That equity will not take jurisdiction where it has no power to enforce its decrees, see Goodyear *v.* Chaffee (1855), 3 Blatch. 268.

[2] In Locomotive-Engine Safety-Truck Co. *v.* Erie R. R. Co. (1872), 3 O. G. 93, Blatchford, J.: (97) "Under this bill, therefore, the plaintiffs, having proved an infringement by the use in this district of the engine referred to, are entitled to a decree for an accounting by the defendants in respect of all infringements committed in this district by making or using or vending therein, and to an injunction against making in this district, and against using therein, and against vending therein. If the plaintiffs desire to proceed for an account and an injunction in respect of infringements in the Northern District, they must proceed by bill filed there. The defendants are suable in the Circuit Court for that district, their legal existence, under their incorporation by the State of New York, being co-extensive with the territorial limits of that State." 10 Blatch. 292 (306); 6 Fisher, 187 (202). This case seems to have turned, however, on a special statute, as also the following: Hodge *v.* Hudson River R. R. Co. (1868), 3 Fisher, 410; 6 Blatch. 85.

That an infringement by sale takes place in the territory of delivery, see Hobbie *v.* Smith (1886), 27 Fed. Rep. 656.

That the defendant may waive the objection that the cause of action arose in another district, and does waive it unless he sets it up in his answer, see Black *v.* Thorne (1872), 5 Fisher, 550; 2 O. G. 388; 10 Blatch. 66.

That pendency of a suit in equity in one district is no bar to another suit in a different district, see Rumford Chemical Works *v.* Hecker (1874), 5 O. G. 644; 11 Blatch. 552; 1 Bann. & A. 120; Wheeler *v.* McCormick (1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334; Wheeler *v.* McCormick (1871), 4 Fisher, 433; 8 Blatch. 267.

district being presumed to have a continuing authority over the defendant, by virtue of his residence within its jurisdiction, and consequently able to enforce its decrees against him, to whatever wrongful acts they may relate. A suit may consequently be maintained against him in that district, though the infringing acts to be enjoined or compensated for would be or were committed beyond its territorial limits.[3]

§ 1098. Parties Plaintiff in Equity.

The parties to a suit in equity comprise all those persons, natural or artificial, who can be affected by the decree, without regard to their number or the diversity of their relations to the subject-matter of the controversy.[1] Any person having, at the time of the infringement, either a legal or an equitable interest in the patented invention, which has been or is capable of being prejudiced by the infringing act, may be a party plaintiff.[2] Legal and equitable owners may be joined as plaintiffs, and if no party plaintiff has a legal or an equitable interest the suit must be dismissed.[3] In whom an interest vests may be determined by the local law in pursuance of which the contract creating or transferring it was made.[4] The patentee possesses such an interest until he has finally and irrevocably parted with the entire monopoly, although his sole right may

[3] That equity has jurisdiction to enforce its decrees against a resident in the district wherever the infringement was committed, see Hatch *v.* Hall (1884), 22 Fed. Rep. 438; 30 O. G. 1096.

§ 1098. [1] That all persons to be affected by the decree must be made parties in equity, see Williams *v.* Bankhead (1873), 19 Wall. 563; West *v.* Randall (1820), 2 Mason, 181.

[2] That the legal owner may recover damages in equity, though he may have a partner in the business of making and selling the invention, see Yale Lock Co. *v.* Sargent (1886), 117 U. S. 536; 35 O. G. 497.

That an equitable title is as good in equity as a legal one, see Ruggles *v.* Eddy (1872), 5 Fisher, 581; 10 Blatch. 52; Continental Windmill Co. *v.* Empire Windmill Co. (1871), 4 Fisher, 428; 8 Blatch. 295.

That where the title is doubtful through many assignments, equity will take jurisdiction over all parties, see Bicknell *v.* Todd (1851), 5 McLean, 236.

[3] That the bill will be dismissed if the evidence shows that the complainant had no legal or equitable interest in the controversy, see Pelham *v.* Edelmeyer (1883), 15 Fed. Rep. 262; 25 O. G. 292; 21 Blatch. 188.

[4] That the local law may determine who are the parties in interest, see Lorillard *v.* Standard Oil Co. (1880), 17 O. G. 1507; 18 Blatch. 199; 2 Fed. Rep. 902; 5 Bann. & A. 432.

consist of a reversion expectant on the termination of some subordinate ownership or on the nonfulfilment of certain future conditions, or though he may have agreed to sell to others undivided interests in the patent.[5] An assignee is entitled to equal recognition with the patentee, even before the agreement to assign has been executed by the delivery of the written instrument of conveyance, provided he has fulfilled the conditions upon which the conveyance was to take effect, though where these conditions remain unfulfilled his right to be a party to the suit may be doubted.[6] Where an assignment has been made before the issue of the patent, and the patent has been granted to the assignee, the applicant or inventor has no interest which equity can protect in any action for infringement, whatever contract rights might be enforced between him and the owner of the patent. A grantee has within his territory the same ownership as a patentee or assignee possesses throughout the whole United States, and may appear as plaintiff whenever the infringement would affect his territorial

[5] That when the patentee retains any interest in the patent, present or expectant, he must be a party in equity, see § 939 and note 2, *ante*.

That a reservation of a share in the profits, or of royalties, does not entitle the grantor to sue, see Rude *v.* Westcott (1889), 130 U. S. 152; Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

That a patentee may sue at law in his own name though he is under contract to hold the patent for the benefit of others, but in equity the others may be made parties against the infringers, see Wheeler *v.* McCormick (1873), 4 O. G. 692.

That a licensor may sue though he has given an exclusive license to make and sell throughout the United States, see Freese *v.* Swartchild (1888), 38 Fed. Rep. 141.

That the assignee of an extension may have an injunction against licensees whose rights expired with the original term, see Mitchell *v.* Hawley (1873), 16 Wall. 544; 3 O. G. 241; 6 Fisher, 331.

That whether a person who has a right, upon performing certain conditions, to become the equitable owner of an extended term, but who has not yet fulfilled the conditions, ought to be made a party to a bill filed by the other equitable owners to restrain a third party from infringing, is doubtful, see Aiken *v.* Dolan (1867), 3 Fisher, 197.

That under an assignment of a patent, as security for a debt not due, the assignee should be made a party in equity, and a complete assignment to him pending suit does not change the legal status of the plaintiff, see Waterman *v.* McKenzie (1886), 39 O. G. 122; 29 Fed. Rep. 316.

[6] That assignees as well as inventors may invoke the equity powers of the courts, see Jenkins *v.* Greenwald (1857), 2 Fisher, 37; 1 Bond, 126.

rights.[7] A licensee, although unable to sue in his own name at law, may be a plaintiff in a court of equity, if the infringing acts of the defendant impair the value of his license, and may be joined as plaintiff with his licensor, the owner of the patent, or may sue alone when the licensor himself is the infringer.[8] The government, pending proceedings for repeal, has no such interest in the invention or the patent as warrants it in suing for infringement either at law or equity.[9]

§ 1099. Joinder of Plaintiffs in Equity.

All legal owners of the patent, and all equitable owners who have been or would be injured by the infringement, should be joined as plaintiffs, and if they refuse to sue as plaintiffs should be made defendants.[1] If the patentee

[7] That a part-owner may sue alone for the protection of his own interest, but must make his co-owners respondents, see Spring *v.* Domestic Sewing Mach. Co. (1882), 22 O. G. 1445 ; 13 Fed. Rep. 44., Sheehan *v.* Great Eastern R. Co. (1880), L. R. 16 Ch. D. 59.

[8] That a bill by a licensee, not joining the owner of the patent, is demurrable, see Bogart *v.* Hinds (1885), 33 O. G. 1268 ; 25 Fed. Rep. 484 ; Birdsell *v.* Shaliol (1884), 112 U. S. 485 ; 30 O. G. 261.

That a licensee to use for one purpose only cannot sue without joining the owner of the patent, see Cottle *v.* Krementz (1885), 25 Fed. Rep. 494.

Contra :

That a licensee may enjoin in a bill, in his own name, any one who infringes his rights under his license, see Bramer *v.* Jones (1867), 3 Fisher, 340 ; 2 Bond, 100.

That a licensee may sue in equity against the patentee for the infringement by the patentee himself of rights secured by the license, see Littlefield *v.* Perry (1874). 21 Wall. 205 ; 7 O. G. 964.

That a suit by the patentee alone with the consent of the licensee is a bar to a new suit against the same defendant though the licensee be then joined as plaintiff, see Birdsell *v.* Shaliol (1884), 112 U. S. 485 ; 30 O. G. 261.

[9] That no injunction can be granted at the prayer of the United States to restrain suits for infringement, pending proceedings for repeal, the United States having no interest in such suits, see United States *v.* Colgate (1884), 21 Fed. Rep. 318 ; 22 Blatch. 412.

§ 1099. [1] That all owners of the patent must be parties to a suit in equity for its infringement, see Jordan *v.* Dobson (1870), 4 Fisher, 232 ; 2 Abbott, 398 ; 7 Phila. 533.

That in equity the party injured by the infringement may be joined with the patentee as plaintiff, see Goodyear *v.* Allyn (1868), 3 Fisher, 374 ; 6 Blatch. 33.

That the proper parties to a bill for an injunction are the owner of the legal title to the patent and the person equitably entitled to the damages, these being the parties immediately injured by the infringement, see Goodyear *v.* Railroad (1853), 1 Fisher, 626.

That it is not essential in equity that the adverse parties be on opposite sides, see Campbell *v.* James (1880), 2 Fed.

retains any interest in the patent, whether it be present or reversionary, certain or contingent, he should join with his grantee or assignee.[2] All assignees, whether their rights are conditional or absolute, and whether or not they are evidenced by the required written conveyance, are also necessary parties.[3] Grantees, within whose territory and against whose exclusive privileges the infringement was committed;[4] licensees, to whose prejudice the defendant has wrongfully practised the invention;[5] the heirs or devisees of a deceased owner, in whose interest the executor institutes a suit;[6] *cestuis que trust* of any class, whose equitable rights could be affected by

Rep. 338; 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354.

[2] That if the patentee retains any interest in the patent he must be a party, see Wheeler *v.* McCormick (1873), 4 O. G. 692; Dibble *v.* Augur (1869), 7 Blatch. 86.

[3] That one claiming under a contract to assign must be joined, see Wheeler *v.* McCormick (1873), 4 O. G. 692.

[4] That a grantee must be a party when his rights are invaded, see § 941 and notes, *ante*.

[5] That a licensee cannot sue at law in his own name but in the name of the patentee only, while in equity he may be joined as plaintiff with his licensor, and if not joined at the outset the court may order him to be made a party, see Birdsell *v.* Shaliol (1884), 112 U. S. 485; 30 O. G. 261.

That the owner of a patent and the owner of an exclusive right to make and sell for use abroad may join as plaintiffs in a bill in equity against parties who make and sell for use abroad, see Dorsey Revolving Harvester Rake Co. *v.* Bradley Mfg. Co. (1874), 12 Blatch. 202; 1 Bann. & A. 330.

That in an action brought by a licensee the owner of the patent must be a party, see Gamewell Fire Alarm Telegraph Co. *v.* City of Brooklyn (1882), 14 Fed. Rep. 255; 22 O. G. 1978.

That one of two or more licensees may recover of the infringer his proportion of the profits and damages without joining the others, unless objection for nonjoinder is made, see Adams *v.* Howard (1884), 23 Blatch. 27; 22 Fed. Rep. 656.

That the licensee of an exclusive right to make a particular machine containing the patented device need not be joined, see Nellis *v.* Pennock Mfg. Co. (1882), 13 Fed. Rep. 451; 22 O. G. 1131; 15 Phila. 493.

That under Sec. 17, act of 1836, the licensor is a "party aggrieved," and may sue in equity without joining his licensees, see Hussey *v.* Whitely (1860), 2 Fisher, 120; 1 Bond, 407.

[6] That heirs for whom an administrator holds in trust must be made parties to a suit in equity on a patent, see Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co. (1874), 6 O. G. 34; 1 Bann. & A. 177; 10 Phila. 227; Stimpson *v.* Rogers (1859), 4 Blatch. 333.

That when an inventor during his lifetime assigns his interest his assignees, not his heirs, must be made parties, see Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co. (1874), 6 O. G. 34; 1 Bann. & A. 177; 10 Phila. 227.

an action brought by their trustee, — must in like manner be made plaintiffs or defendants.[7] A licensee can sue alone in equity when his licensor is the infringer and is made defendant, but not otherwise.[8]

§ 1100. Addition of New Plaintiffs Pending Suit.

Whenever necessary parties are omitted at the commencement of the action the court may order them to appear and be made parties, and until they do appear it may suspend proceedings and refuse to hear those who are already on the record.[1] When the licensor has sued alone the defendant may obtain an order that the injured licensee be joined.[2] A suit brought by the licensee alone may be corrected by a subsequent joinder of the actual owner of the patent.[3] An equitable owner, who has commenced his action in the name of the person holding the legal title, may be entered on the record as a co-plaintiff, on his own motion at any time before the final hearing.[4] These various additions may be made at the request

[7] That if one person has the legal and another the equitable title to the patent a suit in equity for infringement must make both parties, see Gamewell Fire Alarm Telegraph Co. *v.* City of Brooklyn (1882), 22 O. G. 1978; 14 Fed. Rep. 255.

That when all a patentee's right vests in a trustee by agreement with third parties, a suit must be brought by a bill joining the trustee and *cestuis que trust*, see Dibble *v.* Augur (1869), 7 Blatch. 86.

[8] That where the licensor is the infringer the licensee may sue alone in his own name, see Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964.

§ 1100. [1] That a defect of parties may be cured by amendment, see Harrison *v.* Rowan (1819), 4 Wash. 202.

That if a decree cannot be made until absent persons become parties, the court may order an amendment and suspend proceedings till they appear, see Wallace *v.* Holmes, Booth, & Haydens (1871), 5 Fisher, 37; 1 O. G. 117; 9 Blatch. 65.

[2] That a licensee, if equitably entitled to the damages, should be a party, see Goodyear *v.* Railroads (1853), 1 Fisher, 626.

That a mere licensee, as such, is not a necessary party, see Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 379; Hussey *v.* Whitely (1860), 2 Fisher, 120; 1 Bond, 407.

That the court may order the licensee to be joined if the defendant demands it, or his presence is necessary to a decree, see Birdsell *v.* Shaliol (1884), 112 U. S. 485; 30 O. G. 261.

That a patentee being plaintiff cannot afterwards join with him a licensee having the exclusive right to make and sell, though the defendant knew of the licensee's claim, see Goodyear *v.* Bourn (1855), 3 Blatch. 266.

[3] That a suit brought by a licensee may be amended by bringing in the real owner, see Gamewell Fire Alarm Telegraph Co. *v.* City of Brooklyn (1882), 22 O. G. 1978; 14 Fed. Rep. 255.

[4] That the owner of an equitable

of any party to the suit, or of the person who desires to be made a party, or when the court itself perceives that complete justice cannot otherwise be done. An order of the court directing such additions cannot be enforced unless the required party can be served with a *subpœna* within the jurisdiction, or voluntarily appears and enters as a plaintiff or defendant.[5] New parties cannot be added where the effect of the addition would be the institution of a new suit, both as to the parties and the rights of action.[6]

§ 1101. Plaintiffs in Equity Must Sue in their own Names.

The real parties in interest must bring their action in equity in their own names and not in that of any attorney or other delegate, since those who are to be affected by the decree must be in court and subject to its orders.[1] A corporation must sue in its corporate name, but an unincorporated association in the names of all its members.[2] An assignee should sue in his own name though his assignment is not yet recorded; and if the assignment covers the assignor's claims against past infringers, he can maintain an action in his own name for these as well as for future violations of the patent.[3] A grantee whose territorial rights have been

right, having begun a suit for his own benefit and at his own expense in the name of the legal owner, may be joined as plaintiff upon motion made after the answer has been filed, the evidence heard, and the case set down for final hearing, see Patterson *v.* Stapler (1881), 7 Fed. Rep. 210.

[5] That persons not within the jurisdiction cannot be made parties unless they voluntarily appear, see Sec. 737, Rev. Stat.

[6] That a new party cannot be added to the bill when the effect would be to institute a new suit both as to the parties and the rights of action, see Goodyear *v.* Bourn (1855), 3 Blatch. 266.

§ 1101. [1] That an action cannot be brought in the name of any attorney or delegate, see § 944, note 4, *ante*.

That a suit at law by order of chancery may be brought in the name of any one in the district who has an interest which the defendant has violated, see Woodworth *v.* Edwards (1847), 3 W. & M. 120; 2 Robb, 610.

[2] That an association must sue in the names of its members, see Metal Stamping Co. *v.* Crandall (1880), 18 O. G. 1531.

[3] That under Sec. 4919, Rev. Stat., an assignee of the patent and of all claims for damages can recover in his own name on claims for past infringements as well as for infringements since the assignment, see Adams *v.* Bellaire Stamping Co. (1885), 25 Fed. Rep. 270; 33 O. G. 623.

That an assignee may sue in his own name though his assignment was not recorded before his bill was filed, see

invaded must also sue in his own name.[4] Licensees cannot sustain an action in their own names alone, except when the licensor is the infringer, but must sue in the name of the owner of the patent from whom they derive their licenses and with whom they may join themselves as plaintiffs.[5]

§ 1102. Misjoinder of Plaintiffs.

The misjoinder of plaintiffs, not being real parties in interest, can be taken advantage of by the defendant on a demurrer to the bill for want of equity, and the bill as to such parties may then be dismissed.[1] But such misjoinder will not prevent the court from affording equitable relief to any party to the record who may be entitled to demand it.[2] After a final decree in the Supreme Court no objection for misjoinder will avail.[3] The nonjoinder of parties may be cured by adding the omitted parties to the record after the proper order and appearance, or by a disclaimer of their title, in favor of the actual plaintiff, on the part of those whom the defendant asserts should have been joined.[4] An objection on the ground of a nonjoinder is not favored when the defendant is an in-

Gay *v.* Cornell (1849), 1 Blatch. 506; Pitts *v.* Whitman (1843), 2 Story, 609; 2 Robb, 189. *Contra:* Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23.

[4] That a grantee may sue in his own name, see § 941 and notes, *ante.*

[5] That a licensee cannot sue in his own name alone even in equity, see Birdsell *v.* Shaliol (1884), 112 U. S. 484; 30 O. G. 261; Union Paper Bag Mach. Co. *v.* Nixon (1882), 105 U. S. 766; 21 O. G. 1275; Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964. *Contra:* Brammer *v.* Jones (1867), 3 Fisher, 340; 2 Bond, 100.

That where the owner of the patent is the infringer, the licensee may sue in his own name only, see Littlefield *v.* Perry (1874), 21 Wall. 205; 7 O. G. 964.

That a suit in equity for the benefit of the licensee may be in the joint names of the licensee and the owner of the patent, see Birdsell *v.* Shaliol (1884), 112 U. S. 485; 30 O. G. 261.

§ 1102. [1] That a misjoinder of plaintiffs, not interested parties, can be reached by a demurrer for want of equity, see Hodge *v.* North Missouri R. R. Co. (1869), 4 Fisher, 161; 1 Dillon, 104.

[2] That a misjoinder of plaintiffs will not prevent an injunction, if any of them are entitled to it, see Woodworth *v.* Hall (1846), 1 W. & M. 248; 2 Robb, 495.

[3] That an objection on the ground of misjoinder is too late after final decree in the Supreme Court, see Livingston *v.* Woodworth (1853), 15 How. 546.

[4] That nonjoinder may be cured by a disclaimer of title by the absent parties in favor of the record plaintiff, see Graham *v.* Geneva Lake Crawford Mfg. Co. (1880), 11 Fed. Rep. 138; 21 O. G. 1536.

fringer and has denied the title of the absent parties, or when the record plaintiff is the legal owner of the patent and the interest of the omitted parties rests upon an ancient and long dormant contract.[5] No objection for nonjoinder can be urged on the accounting unless it has been set up in the answer, or unless the court must have the absent parties before it in order to render a decree.[6] When the defendant sets up a nonjoinder in his answer or otherwise, he must name the parties of whose omission he complains.[7]

§ 1103. Effect of Conveyance pendente lite on the Rights of Parties: Collusive Suits.

Conveyances *pendente lite* do not affect the litigation as between the original plaintiff and defendant, but courts of equity will protect the rights of the real parties and secure to each his due proportion of the damages or profits resulting from the suit.[1] An assignment of the entire interest in the

[5] That objections for nonjoinder of plaintiffs are not favored when the plaintiff has the legal title and the other interests are derived from an old and dormant contract, see Graham *v.* McCormick (1880), 11 Fed. Rep. 859; 21 O. G. 1533; 10 Bissell, 39; 5 Bann. & A. 244.

That the objection that other parties are not joined as plaintiffs has not much weight when the defendant denies their title, and it is really doubtful whether they are parties and the objector is an alleged infringer, see Graham *v.* Geneva Lake Crawford Mfg. Co. (1880), 11 Fed. Rep. 138; 21 O. G. 1536.

[6] That a defendant who has litigated a case on its merits cannot at the hearing raise for the first time the question of defect of parties, unless indispensable parties are absent, and in that event the court will refuse to decree though the objection is not suggested, see Adams *v.* Howard (1884), 22 Fed. Rep. 656; 23 Blatch. 27; Wallace *v.* Holmes, Booth, & Haydens (1871), 5 Fisher, 37; 1 O. G. 117; 9 Blatch. 65.

That nonjoinder cannot be taken advantage of by objection to the decree, but by demurrer or answer, see Adams *v.* Howard (1884), 26 O. G. 825; 22 Blatch. 47; 19 Fed. Rep. 317.

[7] That when a defendant objects to a bill for want of parties he must set forth what parties are wanting, see Campbell *v.* James (1880), 18 O. G. 1111; 2 Fed. Rep. 338; 18 Blatch. 92; 5 Bann. & A. 354.

§ 1103. [1] That conveyances *pendente lite* do not affect the suit as between the original parties, but the court will protect the rights of the real owners to the fruits of the litigation, see Campbell *v.* James (1880), 2 Fed. Rep. 338; 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354.

That if a plaintiff goes into bankruptcy the suit is not abated, though a supplemental bill may be required, see Gear *v.* Fitch (1878), 16 O. G. 1231; 3 Bann. & A. 573.

That a plaintiff becoming bankrupt and purchasing the right of action from his assignee, cannot be met with a plea

patent, pending suit, may reserve the avails of the action to the assignor, and equity will award these to him, while protecting the assignee against future infringements by injunction; but such an assignment, reserving the right to an injunction, calls for no equitable interference, since an injunction cannot issue in favor of one who is no longer an owner of the patent.[2] After a decree and an accounting, the right to the computed profits may be transferred by the plaintiff, and the transferee will be permitted to receive them, and, if necessary, to invoke the assistance of the court for their collection.[3] Any person who pays the expenses of the litigation for his own benefit, under a contract with the plaintiff, in order to test the validity of the patent or the fact of infringement, or for any other legitimate purpose, has a sufficient standing in the court to enable him to control the suit;[4] but a collusive action, in which one person bears the cost of both parties, in order to obtain a judgment to be employed in enforcing settlements or procuring injunctions against others, will not be entertained.[5]

in abatement, see Gear *v.* Fitch (1878), 16 O. G. 1231; 3 Bann. & A. 573.

[2] That an assignment during a suit "reserving the right to profits and damages in said suit and to have the patent declared valid, and an injunction," gives the plaintiff the right to the profits and damages up to the time of conveyance, but not to an injunction, see Boomer *v.* United Power Press Co. (1875), 13 Blatch. 107; 2 Bann. & A. 106.

[3] That a bill will not be dismissed on account of the plaintiff's assignment of his interests, if it were made after the time when the computation of profits ended, see Dean *v.* Mason (1857), 20 How. 198.

That the court will enforce the rights of an assignee *pendente lite* to the avails of the suit, see Campbell *v.* James (1880), 2 Fed. Rep. 338; 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354.

[4] That a party bearing the expenses of a suit and prosecuting it for his own benefit, though in the name of another, has a right to control the proceedings, see § 938, note 5, *ante*.

[5] That collusive suits will not be permitted, see Barker *v.* Todd (1882), 23 O. G. 438; 15 Fed. Rep. 265; and § 1182 and notes, *post*.

That a collusive decree may be annulled on the application of a stranger, see Barker *v.* Todd (1882), 23 O. G. 438; 15 Fed. Rep. 265.

That an action in which one party bears the expense of both sides, in order to obtain a judgment influencing other suits, is collusive under whatever disguise, see Gardner *v.* Goodyear Dental Vulcanite Co. (1873), 6 Fisher, 329; 3 O. G. 295.

That an agreement to sue and pay all expenses for one half the results is champerty and cannot be upheld in equity where the party suing had entire

§ 1104. Parties Defendant in Equity.

All persons who participate in the infringement, whether by performing the infringing act, or by ordering it to be committed by their servants, or by directly sharing in its benefits, may be joined as defendants.[1] A corporation may be made defendant when it profits by the unlawful use of the invention, and with it may be joined the officers by whose direction the infringing device or process is employed; or either may be sued alone without reference to the other.[2] When several distinct individuals are made defendants, the plaintiff's bill must show how they are related to each other, and that all are connected with the same infringing act; and where a defendant is one of a group of persons, whose operations are carried on beyond the limits of the district of the suit by their collective authority, the bill must allege that this defendant has the entire control of the infringement and can promote it or prevent it at his pleasure.[3] The misjoinder of defendants does not impair the power of the court to afford relief against such of them as are found guilty of the infringement, though the bill as to the others will be dismissed.[4]

control of the claims, see Gregerson *v.* Imlay (1861), 4 Blatch. 503.

§ 1104. [1] For rules determining who may be defendants, see §§ 946, 947, and notes, *ante*.

That complicity between defendants renders them liable to be sued in equity for a joint infringement, see Wells *v.* Jacques (1874), 5 O. G. 364; 1 Bann. & A. 60.

[2] For the liability of corporations and their officers, etc., see § 912 and notes, *ante*.

[3] That a bill joining defendants should show how they are related to each other, whether as partners, etc., see Shickle *v.* South St. Louis Foundry Co. (1884), 22 Fed. Rep. 105.

That a bill alleging that the defendants were doing business as a company while infringing avers a joint infringement, see Kaolatype Engraving Co. *v.* Hoke (1887), 30 Fed. Rep. 444; 39 O. G. 585.

That if the defendant is one of several directors of a corporation, located and doing business in another district, it should appear that he has power alone to direct the use or disuse of the infringing device, or all or a majority of the directors must be made parties, see Jones *v.* Osgood (1869), 3 Fisher, 591; 6 Blatch. 435.

[4] That where a bill alleges that the defendants "jointly and collectively and also separately infringed," and no joint use is shown, but the bill is not demurred to and a final hearing is had without objection, a decree may issue against each separately, see Putnam *v.* Hollender (1881), 6 Fed. Rep. 882; 19 O. G. 1423; 19 Blatch. 48.

§ 1105. Nonjoindor of Defendants.

The nonjoindor of defendants is no ground of defence against the action, unless the account of profits is inseparable, or for some other reason the presence of the omitted parties is indispensable to a decree.[1] The absence of proper defendants must be taken advantage of by the demurrer, plea, or answer, and the objection must set forth the connection of such persons with the cause of action and allege that they are within the territorial jurisdiction of the court.[2] If the objection is sustained, the persons named may be ordered to appear and be made parties, and if this order cannot be enforced the court will stay proceedings indefinitely or dismiss the bill.[3] An amendment changing the capacity in which the defendants have been sued, and in effect creating a new defendant, cannot be allowed.[4]

§ 1106. Averments of a Bill in Equity in Actions for Infringement.

A bill in equity, in actions for infringement, must disclose the substantial groundwork of the case and contain aver-

§ 1105. [1] That nonjoinder of defendants is no defence unless their presence is necessary to enable the court to decree any effectual relief, see Florence Sewing Mach. Co. *v.* Singer Mfg. Co. (1870), 4 Fisher, 329 ; 8 Blatch. 113.

[2] That the objection that the bill does not allege a joint infringement by the defendants is to be taken by demurrer, see Fischer *v.* O'Shaughnessy (1881), 6 Fed. Rep. 92.

That a plea of nonjoinder must allege that the absent defendants are within the jurisdiction, see Goodyear *v.* Toby (1868), 6 Blatch. 130.

[3] That if the want of parties defendant is not objected to by demurrer, plea, or answer, it is too late to make the objection afterward, provided the court can make a decree concerning the actual parties separately from the others ; but where it cannot, the court will not proceed, though the absent parties are out of its jurisdiction, see Florence Sewing Mach. Co. *v.* Singer Mfg. Co. (1870) 4 Fisher, 329 ; 8 Blatch. 113.

That in a suit against a mere vendee his vendor may apply to be made a defendant, and if admitted he submits to the jurisdiction for all purposes though not originally within it, but cannot set up in a cross-bill any matter which the original defendant could not have alleged, see Curran *v.* St. Charles Car Co. (1887), 32 Fed. Rep. 835.

[4] That a bill against several defendants as copartners cannot be amended to charge them as separately the president, secretary, and directors of a company, this being unnecessary in a suit against them as individuals, and improper in a suit against the company as a whole, see Tyler *v.* Galloway (1882), 13 Fed. Rep. 477 ; 22 O. G. 1294 ; 21 Blatch. 66.

ments covering every material fact, the court having no authority to consider what is proved and not alleged, or what is alleged and not supported by the evidence.[1] The material facts in equity, as at law, relate to these five questions: (1) The performance by the alleged inventor of an inventive act resulting in the alleged invention; (2) The existence and validity of a patent protecting this invention; (3) The title of the plaintiff to that patent; (4) The infringement of that patent by the defendant; and (5) The damage sustained by the plaintiff, and the benefits accruing to the defendant, from the infringing acts. The averment of the inventive act may state the performance of the act and the resulting invention in general terms, sufficient to identify the invention with the subject-matter, and the inventor with the grantee, of the letters-patent, as these appear in the ensuing allegations.[2] The averment of the patent may describe it by its date and title with a *profert*, neither setting it out according to its terms,

§ 1106.[1] That the substantial groundwork of a case must be alleged in the bill or no decree can be rendered, see Pelham *v.* Edelmeyer (1883), 15 Fed. Rep. 262; 25 O. G. 292; 21 Blatch. 188.

That the bill must aver every material fact, for the court cannot consider what is proved and not alleged or what is alleged and not proved, see Blandy *v.* Griffith (1869), 3 Fisher, 609.

That a bill in equity under the act of 1870 must follow and be supported by the general doctrines of equity, see Root *v.* Lake Shore & Michigan Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112.

For the form and requisites of a bill in equity, see McCoy *v.* Nelson (1887), 121 U. S. 484; 39 O. G. 831.

[2] That a bill in equity must describe the invention, not merely by date and number of the patent, but so fully as to apprise the court of its nature and characteristics, see Post *v.* Richards Hardware Co. (1885), 25 Fed. Rep. 905.

That unless a clear description of the invention is given in the bill, the patent must be annexed or *profert* made, or the bill will be demurrable, see Wise *v.* Grand Ave. R. R. Co. (1888), 33 Fed. Rep. 277.

That the description of the invention is sufficient when the bill refers to and makes *profert* of the patent, or employs the language of the specification, or gives a full and accurate description in the pleader's own words, see Post *v.* Richards Hardware Co. (1885), 25 Fed. Rep. 905.

That the bill or declaration must allege that the invention was not in public use or on sale for more than two years before the application, see Blessing *v.* Steam Copper Works (1888) 34 Fed. Rep. 753.

That the history of the art being part of the controversy in a patent cause, the description of prior patents and the litigation thereon may be proper averments in the bill, see Steam Gauge & Lantern Co. *v.* McRoberts (1886), 26 Fed. Rep. 765; 36 O. G. 822.

nor in the case of a re-issue specifying the ground of the re-issue nor the concurrence of the owners of the original in its surrender.[3] The averment of title may allege the interest of the plaintiff in the patent without reciting the chain of title or declaring that the conveyance under which he claims has been recorded, but it must define the right in which he sues, and if this right is based upon or is to be established by reference to a former judgment such judgment must be also stated.[4] The averment of infringement need not describe the particular acts performed by the defendant, nor point out the portions of the invention which he has appropriated nor the articles produced by its unlawful use.[5] It must allege

[3] That the patent need not be set out in the bill, but a statement of title and a *profert* are enough, see American Bell Telephone Co. *v.* Southern Telephone Co. (1888), 34 Fed. Rep. 803; McMillin *v.* St. Louis & Mississippi Valley Transportation Co. (1883), 18 Fed. Rep. 260; 5 McCrary, 561.

That a bill on a re-issued patent need not aver that the grantee of a territorial right acted with the patentee in the surrender of the original patent, or that he concurred in the re-issue, see Meyer *v.* Bailey (1875), 8 O. G. 437; 2 Bann. & A. 73.

That a bill for the infringement of a re-issue need not aver the ground of re-issue, see Spaeth *v.* Barney (1885), 22 Fed. Rep. 828; 30 O. G. 997.

That a bill in equity, setting forth the issue of a patent and its re-issue with expanded Claims after two years and not explaining the delay, suggests sufficient to serve as a defence on demurrer, see Wollensak *v.* Reiher (1885), 115 U. S. 96; 31 O. G. 1301.

[4] That the bill need not state the entire chain of title, an averment that the title is in the complainants being sufficient, see Nourse *v.* Allen (1859), 3 Fisher, 63; 4 Blatch. 376.

That a plaintiff grantee need not aver the recording of his grant, but the defendant may claim to be the *bona fide* owner without notice, see Perry *v.* Corning (1870), 7 Blatch. 195.

That an allegation of an assignment of the whole patent except in certain specified counties, if not traversed in the answer or the evidence, cannot be otherwise objected to, see Washburn & Moen Mfg. Co. *v.* Haish (1880), 4 Fed. Rep. 900; 19 O. G. 173; 10 Bissell, 65.

That if the plaintiff relies on a former verdict and judgment to show his title, or his right to equitable relief, his bill must aver it, see Blandy *v.* Griffith (1869), 3 Fisher, 609; Parker *v.* Brant (1850), 1 Fisher, 58.

That a bill alleging the infringement of two claims and a judgment in a former suit on one of them does not imply that full relief has been obtained in the other suit, see Allis *v.* Stowell, (1883), 15 Fed. Rep. 242; 23 O. G. 1033.

That allegations of residence of parties are not necessary to confer jurisdiction, see Teese *v.* Phelps (1855), 1 McAllister, 17.

[5] In Thatcher Heating Co. *v.* Carbon Stove Co. (1878), 4 Bann. & A. 68, Nixon, J.: (69) "It was insisted that, unless the whole invention, as claimed, had been infringed, it was necessary for the complainant to specify in the bill the particular Claims of the violation of

infringing acts committed in violation of the plaintiff's rights, and disclose such circumstances of time, place, and method as show upon the face of the averment that these rights, as before described, have been invaded.[6] The allegation must be positive and certain, not stating the infringing acts hy-

which he complained. Perhaps that would have been the correct practice to have been established in suits for the infringement of patent rights, in analogy of what is required in courts of equity *in actions for relief against fraud.* In such cases it is not permitted to allege fraud generally. The party alleging it must s'.te the facts which constitute the fraud. (Small *v.* Boudinot, 1 Stockt. 391; Rorback *v.* Dorsheimer, 10 C. E. Green, 516.) But such is not the recognized practice in patent cases. A statement of the complainant's patent, and a general allegation that the defendant has infringed, is deemed sufficient to put the defendant upon his answer. (Turrell *v.* Cammerrer, 3 Fisher, 462.) . . . When the proofs are closed, and at the final hearing, the complainant is permitted to specify the Claims of the patent on which he will ask for a decree." 15 O. G. 1051 (1051).

In Turrell *v.* Cammerrer (1868), 3 Fisher, 462, Leavitt, J.: (463) "The question before the court arises upon a demurrer to a bill filed by the complainant for the infringement of letters-patent. It is objected that the bill does not state facts enough to enable the court to base a decree upon it, and it is insisted that, before the defendant can be called upon to answer, the complainant shall be required to set forth the precise infringement complained of, by some adequate description of the patented invention, and of the infringing machine or process. This he has never been required by the practice of this court to do. The general allegation of the bill that the defendant has infringed the letters-patent has been sufficient to put him upon his answer. It would obviously be a very inconvenient practice to require the complainant to set out at length in his bill the details of his invention and of the defendant's manufacture. The bill would be very voluminous and not necessarily more clear or explicit. The defendant is, by the general averment, put in possession of the allegation that he has infringed the complainant's patent. This he may deny by answer. The burden of proof is then upon the complainant to prove infringement and to show wherein it consists. If he fails to do this, he is not entitled to relief."

Further, that the bill may allege infringement generally without specifying particulars, see American Bell Telephone Co. *v.* Southern Telephone Co. (1888), 34 Fed. Rep. 803; Haven *v.* Brown (1873), 6 Fisher, 413.

That a bill for the infringement of a machine-patent need not state what articles the defendant has made by his machine, see Fischer *v.* Hayes (1881), 5 Fed. Rep. 76; 20 O. G. 239; 19 Blatch. 26.

[6] That no recovery can be had unless an infringement by making, using, or selling the invention, before the filing of the bill, is alleged and proved, see Slessinger *v.* Buckingham (1883), 17 Fed. Rep. 454; 8 Sawyer, 469.

That a bill alleging a grant to the plaintiffs and that the defendants are *now* making and using the invention against the interest of the grantees, although informal, is a sufficient charge of the infringement as occurring after the grant and within the granted territory, see Meyer *v.* Bailey (1875), 8 O. G. 437; 2 Bann. & A. 73.

pothetically, argumentatively, nor in the disjunctive;[7] and if the patent had expired before the date of the infringement it must aver that the infringing articles were unlawfully constructed while the patent was in force.[8] Where the plaintiff has conveyed assignable interests to others, which were outstanding when the infringement was committed, the averment of infringement must deny that the defendant used the invention under such conveyance.[9] If there is more than one defendant the relation which subsists between them must be sufficiently delineated to indicate that all participate in the infringing acts.[10] The averment of damages may be in general terms; that of profits must set forth such facts as to the mode in which the defendant has practised the invention, and the benefits he has thence derived, as in connection with the preceding averments will show that there have been pecuniary gains or savings for which the plaintiff is entitled to an account.[11] Where the advantage to the defendant

[7] That an allegation of infringement must not be in the disjunctive, as "making *or* selling," but if it alleges both making *and* selling it is sustained by evidence of either, see Locomotive Engine Safety Truck Co. *v.* Erie Railway Co. (1872), 6 Fisher, 187; 3 O. G. 93; 10 Blatch. 292.

That an allegation that the defendant "has built and is now using" does not aver that he uses what he built or built what he uses, see Locomotive Engine Safety Truck Co. *v.* Erie Railway Co. (1872), 6 Fisher, 187; 3 O. G. 93; 10 Blatch. 292.

That the allegation that the defendant is making and using devices "in some parts" substantially the same in construction and operation with those of the plaintiff, though objectionable, is still sustained as a sufficient statement of infringement, see McMillin *v.* St. Louis & Mississippi Valley Transportation Co. (1883), 18 Fed. Rep. 260; 5 McCrary, 561.

[8] That a bill to enjoin a device after the patent expires must aver that the device was made before the patent expired, see American Diamond Rock Boring Co. *v.* Rutland Marble Co. (1880), 2 Fed. Rep. 355; 18 Blatch. 147; 5 Bann. & A. 346.

[9] That in a suit by the owner of a patent, who has sold an exclusive right for a term of years, the bill must set out that the defendant is not operating under the licensee, see Still *v.* Reading (1881), 9 Fed. Rep. 40; 20 O. G. 1025; 4 Woods, 345.

[10] That where a corporation is sued for infringement and its officers are made parties, the fact that they are such officers should be averred, see Shickle *v.* South St. Louis Foundry Co. (1884), 22 Fed. Rep. 105.

[11] That the bill need not pray for damages *eo nomine*, but they may be awarded under the general prayer for relief, see Emerson *v.* Simm (1873), 3 O. G. 293; 6 Fisher, 281.

That the bill must state such facts as indicate that profits were realized by the defendant in order to support a prayer for an account, see Vaughn *v.* Central Pacific R. R. Co. (1877), 4 Sawyer, 280; 3 Bann. & A. 27.

can only be estimated as a whole, or from the nature of the invention or his method of infringement could not result in profits, no account in equity can be decreed.[12] But profits may be alleged as either general or special, and the actual profits appearing on the accounting will then be covered by the averment.

§ 1107. Prayers for Equitable Relief.

The bill must close with a prayer for the desired relief, and the relief sought must be, in part at least, of such a character as equity alone can grant. If the bill prays for damages only, and in most cases where it prays for profits only, it presents no ground for equitable interference.[1] With these petitions must be united one for an injunction, or a discovery, or some other remedy not obtainable at law, unless those portions of the bill relating to the parties or the title or the infringement or the profits make it apparent that out of equity the plaintiff has no adequate redress.[2] To each of these forms of relief special averments of the circumstances which require such relief are necessary, in addition to the ordinary allegations of the bill.[3] Thus where an injunction is requested, the bill must state that the defendant threatens to commit or re-

[12] That a bill claiming an account is improper where the advantage to the defendant is a general one and can only be estimated as a whole, see Sayles *v.* Richmond, Fredericksburg, & Potomac R. R. Co. (1879), 16 O. G. 43; 3 Hughes, 172; 4 Bann. & A. 239.

That a general allegation that profits were made by the defendant is not sufficient, and if from the nature of the invention it appears that profits were not obtainable, the bill will be dismissed, see Vaughn *v.* Central Pacific R. R. Co. (1877), 4 Sawyer, 280; 3 Bann. & A. 27.

That a bill averring an assignment of all right "for and to the past use of the invention and improvements under said letters-patent," and praying for an injunction, profits and damages and other relief, is sufficient basis for a recovery of damages for past infringements before the assignment, see Campbell *v.* James (1880), 2 Fed. Rep. 338; 18 O. G. 1111; 18 Blatch. 92; 5 Bann. & A. 354.

§ 1107. [1] That over a mere claim for damages or profits equity has no jurisdiction, see § 1087 and notes, *ante*.

[2] That a bill in equity will not lie for damages alone, but must pray for an injunction, a discovery, or an account, see Vaughn *v.* East Tennessee, Virginia, & Georgia R. R. Co. (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

[3] That the bill must aver such facts as show that the equitable relief prayed for is necessary, see Dunham *v.* R. R. Co. (1861), 1 Bond, 492; Harrison *v.* Nixon (1835), 9 Peters, 483.

fuses to desist from an infringement, and if the injunction is to precede the trial of the cause upon its merits a prior judgment sustaining the plaintiff's right, or long continued public acquiescence in the exercise of his exclusive privilege, must be averred.[4] When the bill prays for a discovery it must point out the facts concerning which the disclosure is required and allege the inability of the plaintiff to establish them by any evidence at his command.[5]

§ 1108. Joinder of Different Causes of Action Based on Several Patents: Multifariousness.

Where several patents belonging to the plaintiff are violated by the same infringement on the part of the defendant, these different causes of action may be united and relief for the entire injury may be afforded in a single suit.[1] A bill in equity, therefore, is not multifarious merely because it counts upon numerous patents, or alleges various infringing acts. A bill is multifarious when it joins matters perfectly distinct, or de-

[4] That if the bill contains a prayer for an injunction the facts which render it necessary must be set forth and the plaintiff's title shown, see § 1206 and notes, *post*.

That no allegation of a trial at law should be made as the foundation for an injunction unless there was a *bona fide* trial and judgment, see Doughty *v.* West (1865), 2 Fisher, 553.

[5] That a prayer for discovery must indicate the points for a disclosure and the absence of other evidence, see Vaughn *v.* Central Pacific R. R. Co. (1877), 4 Sawyer, 280; 3 Bann. & A. 27.

§ 1108. [1] That more than one patent may be embraced in the same suit, see Matthews *v.* Lalance & Grosjean Mfg. Co. (1880), 17 O. G. 1284; 2 Fed. Rep. 232; 18 Blatch. 84; 5 Bann. & A. 319; Parks *v.* Booth (1880), 102 U. S. 96; 17 O. G. 1089.

That several patents may be included in one suit when their subjects-matter are correlative and are embodied in the infringing process or device, see Nellis *v.* Pennock Mfg. Co. (1882), 22 O. G. 1131; 13 Fed. Rep. 451; 15 Phila. 493.

That suits on a patent for an original invention and on a patent for an improvement thereon are not divisible, if both patents belong to the same owner, see Case *v.* Redfield (1849), 4 McLean, 526; 2 Robb, 741.

That one who is sole owner of one patent and exclusive licensee under another may, joining his licensor, enjoin a device which infringes both patents, see Huber *v.* Myers Sanitary Depot (1888), 34 Fed. Rep. 752.

That where the plaintiff owns one patent in one State and the same with another patent in a second State, and on an infringement in the second State his bill counts on both patents, it is proper, see Gillespie *v.* Cummings (1874), 3 Sawyer, 259; 1 Bann. & A. 587.

That where all the Claims of several patents are infringed by one structure a suit on all is not multifarious, see Hayes *v.* Bickelhoupt (1885), 23 Fed. Rep. 183; 32 O. G. 135.

mands remedies of an independent character against separate defendants: for a defendant cannot be compelled to associate wholly different defences in his answer, to the confusion of the evidence and the protraction of the controversy, nor can the expense of proceedings against separate defendants on distinct issues be imposed upon him.[2] No universal test of multifariousness can be established; but whenever, in its sound discretion, the court perceives that the defendant is embarrassed by the multiplicity of the plaintiff's claims, the bill may be treated as defective and its reduction to a more simple form required.[3] In actions for infringement, as a general rule, the

[2] In Hayes *v.* Dayton (1880), 8 Fed. Rep. 702, Blatchford, J.: (703) "A bill is multifarious when it improperly unites in one bill against one defendant several matters perfectly distinct and unconnected, or when it demands several matters of a distinct and independent nature against several defendants in the same bill. The reason of the first case is that the defendant would be compelled to unite in his answer and defence different matters wholly unconnected with each other, and thus the proofs applicable to each would be apt to be confounded with each other, and delays would be occasioned by waiting for the proofs respecting one of the matters when the others might be fully ripe for hearing. The reason of the second case is that each defendant would have an unnecessary burden of costs by the statement in the pleadings of the several claims of the other defendants with which he has no connection." 18 O. G. 1406 (1407); 18 Blatch. 420 (421).

That in equity several causes of action may be joined between the same parties to avoid multiplicity of action, unless the defence may be embarrassed by confounding different issues and proofs, see Nourse *v.* Allen (1859), 3 Fisher, 63; 4 Blatch. 376.

[3] In Hayes *v.* Dayton (1880), 8 Fed. Rep. 702, Blatchford, J.: (704) "Where there is a joinder of distinct claims between the same parties it has never been held, as a general proposition, that they cannot be united, and that the bill is of course demurrable for that cause alone. Nor is there any positive, inflexible rule as to what, in the sense of courts of equity, constitutes a fatal multifariousness on demurrer. A sound discretion is always exercised in determining whether the subject-matters of the suit are properly joined or not. It is not very easy, *a priori*, to say exactly what is or what ought to be the true line regulating the course of pleading on this point. All that can be done in each particular case, as it arises, is to consider whether it comes nearer to the class of decisions where the objection is held to be fatal, or to the other class, where it is held not to be fatal. In new cases the court is governed by those analogies which seem best founded on general convenience, and will best promote the due administration of justice, without multiplying unnecessary litigation on the one hand, or drawing suitors into needless and oppressive expenses on the other." 18 O. G. 1406 (1407); 18 Blatch. 420 (422).

That whether a bill is multifarious depends on the circumstances of each case and the court must act on its discretion in sustaining it, see United States *v.*

bill will not be multifarious unless it charges several distinct violations of several independent patents. Where the same infringement, whether it be committed by one act or by a series of acts, invades the rights conferred on the plaintiff by numerous patents, he is not forced to divide the infringement into portions measured by the invention covered by each patent and pursue a separate remedy for every violated right.[4]

American Bell Telephone Co. (1888), 128 U. S. 315; Singer Mfg. Co. *v.* Springfield Foundry Co. (1888), 34 Fed. Rep. 393.

[4] In Hayes *v.* Dayton (1880), 8 Fed. Rep. 702, Blatchford, J.: (704) "We are not without cases on this subject, in suits on patents in this country. In Nourse *v.* Allen (4 Blatch. C. C. R. 376), in 1859, before Mr. Justice Nelson, a bill on four patents was held good on demurrer, where it alleged that the machine sued contained all the improvements in all the patents. The court thought that the convenience of both parties, as well as a saving of the expenses in the litigation, seemed to be consulted in embracing all the patents in one suit in such a case; and that although the defences as respected the several improvements might be different and unconnected, yet the patents were connected with each other in each infringing machine. In Nellis *v.* McLanahan (6 Fisher's Patent Cases, 286), in 1873, before Judge McKennan, it was held that where a suit in equity is brought for the infringement of several patents for different improvements not necessarily embodied in the construction and operation of any one machine, the bill must contain an explicit averment that the infringing machines contain all the improvements embraced in the several patents, or it will be held bad for multifariousness on demurrer. In Gillespie *v.* Cummings (3 Sawyer, 259), in 1874, before Judge Sawyer, the bill was founded on two patents for the manufacture of brooms. There was a demurrer on the ground of the joinder of two separate and distinct causes of action. It appearing by the bill that the defendant's broom, if infringing, must be an infringement of both of the patents, and that there was therefore a common point to be litigated, and much of the testimony must from the nature of things be applicable to both of the patents, the bill was held good. In Herman Patent Mfg. Co. *v.* Brooklyn City R. R. Co. (15 Blatch. C. C. R. 444), in 1879, before Judge Benedict, a bill in equity on two patents alleged that the defendant was using machines containing in one and the same apparatus the inventions secured by each of the two patents. It was demurred to on the ground that it did not allege that the devices were used conjointly or connected together in any one apparatus, but the demurrer was overruled. The court held that, as the bill did not show the controversy to be of such a character that prejudice to the defendant would result from the joinder in one action of the causes of action joined, the bill must be sustained. The court was of opinion that, in the absence of any other fact, the circumstance that the two transactions complained of were the use in a single machine of two patented devices connected with the mechanism of the machine warranted the inference that no prejudice would result to the defendant from the joinder of the two transactions. The decisions above cited all tend in one direction." 18 O. G. 1406 (1407); 18 Blatch. 420 (423).

That a bill counting on several pat-

The fact that the inventions are capable of a joint employment, and that the defendant has thus wrongfully employed them, entitles the plaintiff to regard this wrongful use as constituting a single injury, and to seek his redress for it in a single action, although the defences to each patent may be different and unconnected. In such cases, however, the bill must aver, and the evidence must prove, the joint employment of the several inventions; and even then the difficulties which attend the defendant's presentation of his claims may be so great as to demand a different method of procedure.[5] Where the inventions covered by the various patents are incapable of a united use, or are applied to separate uses by the defendant, the infringements are distinct and a bill counting upon more than one of them is multifarious.[6] A bill is not rendered

ents is not multifarious when all are alleged to be infringed by one machine, see Deering *v.* Winona Harvester Works (1885) 24 Fed. Rep. 90; 32 O. G. 654; Nourse *v.* Allen (1859), 3 Fisher, 63; 4 Blatch. 376.

[5] In Lilliendahl *v.* Detwiller (1883), 18 Fed. Rep. 176, Nixon, J.: (177) "A bill is not necessarily obnoxious to the charge of multifariousness because the suit is brought upon more than one patent. Courts encourage single suits upon a number of patents to avoid multiplicity of actions; but in such cases the bill of complaint, in order to be maintainable, must allege and the proofs must show that the inventions embraced in the several patents are capable of conjoint use, and are so used by the defendants."

Further, that a bill alleging the infringement of several patents must aver that the inventions are capable of joint use and are so used by the defendant, see Kaolatype Engraving Co. *v.* Hoke (1887), 39 O. G. 589; 30 Fed. Rep. 444; Griffith *v.* Segar (1887), 29 Fed. Rep. 707; Barney *v.* Peck (1883), 16 Fed. Rep. 413; 24 O. G. 101; Pope Mfg. Co. *v.* Marqua (1883), 15 Fed. Rep. 400; Gamewell Fire Alarm Telegraph Co. *v.* Chillicothe (1881), 7 Fed. Rep. 351; Hayes *v.* Dayton (1880), 8 Fed. Rep. 702; 18 O. G. 1406; 18 Blatch. 420; Nellis *v.* McLanahan (1873), 6 Fisher, 286.

That a bill alleging the infringement of five patents by one machine, when in fact each invention is capable of separate use and the trial as to each on the questions of validity and infringement must be separate and upon distinct issues, is multifarious, see Consolidated Electric Light Co. *v.* Brush Co. (1884), 20 Fed. Rep. 502; 22 Blatch. 206; 28 O. G. 544.

[6] That one bill cannot embrace infringements of two wholly separate patents for non-unitable inventions, see Hayes *v.* Dayton (1880), 18 O. G. 1406; 8 Fed. Rep. 702; 18 Blatch. 420.

That a bill will not lie for the infringement of several patents for machines unless all the machines have been used conjointly, see Shickle *v.* South St. Louis Foundry Co. (1884), 22 Fed. Rep. 105.

That where one device is used in one machine and the other in another, no joinder can be permitted, see Nourse *v.* Allen (1859), 3 Fisher, 63; 4 Blatch. 376.

multifarious by charging separate infringements of the different Claims of the same patent, nor by praying several forms of relief for the same injury.[7]

§ 1109. Process in Equity: Service: Appearance.

Upon the filing of the bill in the proper court, a *subpœna* issues and is served by the marshal, his deputy, or other person duly appointed for that purpose by the court.[1] Service must be made upon the defendant personally unless he resides within the district, when it may be made by leaving a copy of the *subpœna* at his usual place of abode, with any adult member of his family.[2] If he fails to appear within the time required the bill may be taken *pro confesso*, and where the relief desired by the plaintiff can be afforded without the presence of the defendant the hearing will proceed *ex parte*, and a final decree will be awarded.[3] If he appears, he must demur or plead or answer to the bill, and upon his neglect to do so a decree *pro confesso* may be entered and the cause be heard without him; or when an answer is essential to the plaintiff, as in bills for discovery or similar relief, an attachment may be issued to compel it.[4]

§ 1110. Demurrer in Equity.

A demurrer in equity is a pleading by which the defendant points out some defect in the bill, as a reason why he should not be compelled to answer further to its allegations.[1] This

[7] That separate infringements of different Claims of the same patent may be joined in one bill, see Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337; Kelleher *v.* Darling (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438.

That a bill to repeal an interfering patent and to recover for infringements is not multifarious, see Holliday *v.* Pickhardt (1887), 29 Fed. Rep. 853; Leach *v.* Chandler (1883), 18 Fed. Rep. 262.

That a bill averring an infringement by a corporation and its assignee in insolvency, and alleging that the assignee is about to distribute the corporate assets without regard to the plaintiff's rights, and praying for an injunction, decree, and account, is not multifarious and may be properly brought in the Federal courts, see Gordon *v.* St. Paul Harvester Works (1885), 23 Fed. Rep. 147.

§ 1109. [1] Equity Rules 7, 11, 15.

[2] Equity Rule 13.

[3] Equity Rule 18.

[4] Equity Rule 18.

§ 1110. [1] For the nature and effect of a demurrer in equity, see Story Eq. Pl. §§ 436–646; Equity Rules, 31–38.

That a general demurrer to a bill

defect must be apparent on the face of the bill, and may consist either in a want of jurisdiction in the court, or the incapacity of the parties to sue or be sued in the mode adopted by the plaintiff, or in the want of proper allegations in the bill itself. Thus where the averments show that the invention was not patentable, or that the patent sued on is invalid, as in a variance between an original and its re-issue, or that the plaintiff has no interest in the patent which has been prejudiced by the infringement, or that the infringements charged are distinct violations of different patents or are by different defendants, or that the remedy at law is adequate, objection may be taken by demurrer, and if sustained the bill must be amended or dismissed.[2]

containing the usual averments cannot be sustained, see McCoy *v.* Nelson (1887), 121 U. S. 484; 39 O. G. 831.

That objections to form must be taken by demurrer, and after the evidence is given the bill will not be studied to discover defects, see Pelham *v.* Edelmeyer (1883), 15 Fed. Rep. 262; 25 O. G. 292; 21 Blatch. 188.

[2] That the question of patentability cannot be decided on demurrer except in clear cases, see Blessing *v.* Steam Copper Works (1888), 34 Fed. Rep. 753; Dick *v.* Oil Well Supply Co. (1885), 25 Fed. Rep. 105.

That a demurrer does not admit that the invention is patentable, see Kaolatype Engraving Co. *v.* Hoke (1887), 30 Fed. Rep. 444; 39 O. G. 589.

That where the court can see from the light of common knowledge that a patent is void it may so decree on a demurrer, see West *v.* Rae (1887), 33 Fed. Rep. 45; Kaolatype Engraving Co. *v.* Hoke (1887), 30 Fed. Rep. 444; 39 O. G. 589.

That where recovery can be had only by extending the re-issue beyond the original the bill will be dismissed, see Covell *v.* Pratt (1880), 18 O. G. 301; 18 Blatch. 126; 2 Fed. Rep. 359; 5 Bann. & A. 380.

That a variance between the original and re-issue cannot be taken advantage of on demurrer unless the original is set out in the complaint or attached to it, or *profert* is made of it, see Adams & Westlake Mfg. Co. *v.* Meyrose (1882), 12 Fed. Rep. 440.

That whether delay in applying for a re-issue is reasonable is a question of law for the court, and may be raised by demurrer, see Wollensak *v.* Reiher (1885), 115 U. S. 96; 31 O. G. 1301.

That a demurrer denying the right of the Commissioner to extend a patent will be overruled, see New American File Co. *v.* Nicholson File Co. (1881), 8 Fed. Rep. 816; 20 O. G. 524.

That a demurrer to a bill for profits, filed one day before the patent expired, was sustained with costs to defendant, see Davis *v.* Smith (1884), 19 Fed. Rep. 823.

That a question of title raised by demurrer cannot be removed by amendment, see Steam Relief Valve Co. *v.* City of New Bedford (1884), 28 O. G. 283; 19 Fed. Rep. 253.

§ 1111. Demurrer to Part of the Bill: Proceedings on Demurrer.

The defendant may demur to one part of the bill, plead to another part, and answer the remainder, but he is not permitted to demur, plead, and answer to the entire bill at once, especially when the answer contains all the objections which are urged by the demurrer or the plea.[1] The plaintiff may, however, overlook this defect and cannot object to the proceedings upon that account, unless before the argument on the demurrer he moves to strike out the superfluous pleadings or compel the defendant to elect between them.[2] For the purposes of a hearing upon a demurrer the allegations of the bill are, by the demurrer, admitted to be true.[3] Where the demurrer covers the entire bill, a judgment thereon in favor of the defendant results in the dismissal or amendment of the bill.[4] If the bill is good in part, a demurrer to it as a whole will be overruled.[5] Where the demurrer objects to the entire

§ 1111. [1] That under rule 32 in equity a defendant may demur to the whole bill, or demur to a part and answer the rest, but cannot both demur and answer to the whole bill, especially when the answer sets up all that is in the demurrer, the demurrer being thereby waived, see Adams *v.* Howard (1881), 9 Fed. Rep. 347; 21 O. G. 264; 20 Blatch. 38; see also rule 37, as interpreted *contra* in Hayes *v.* Dayton (1880), 18 Blatch. 420; 18 O. G. 1406; 8 Fed. Rep. 702.

[2] That if a demurrer and answer are filed simultaneously the plaintiff waives the right to object under rule 37, if he goes to argument on the demurrer, see Hayes *v.* Dayton (1880), 18 O. G. 1406; 8 Fed. Rep. 702; 18 Blatch. 420.

[3] That after special demurrer to the bill the facts as alleged are taken as true on a hearing of the demurrer, see Woodworth *v.* Edwards (1847), 3 W. & M. 120; 2 Robb, 610.

That in a prayer for an injunction and a demurrer, the demurrer will be heard first, see Woodworth *v.* Edwards (1847), 3 W. & M. 120; 2 Robb, 610.

That a bill will not be dismissed for the reason that the complainant does not set down the demurrer for argument or take evidence within three months, if these are satisfactorily explained, see Adams *v.* Howard (1881), 21 O. G. 264; 20 Blatch. 38; 9 Fed. Rep. 347.

That where a demurrer is overruled the defendant is to answer over on terms and may contest the injunction, though if when ordered to file evidence he only filed a demurrer the judgment will not be opened for further hearing on the temporary injunction, but the case will be taken as confessed as to the facts, unless an affidavit is offered that delay was not the object, and a bond of indemnity is given, see Woodworth *v.* Edwards (1847), 3 W. & M. 120; 2 Robb, 610.

[4] Equity Rule 35.

[5] That if a bill is good in part a demurrer to the whole bill will be overruled, see Perry *v.* Littlefield (1879), 17 O. G. 51; 17 Blatch. 272; 4 Banu. & A. 624.

bill and also to some specific allegation, and the latter objection only is sustained, the bill may be dismissed as to the defective part and the defendant be required to plead or answer over as to the residue.[6] A failure to demur within the proper time, or at the prescribed stage of the proceedings, operates as a waiver of all defects which are not *ipso facto* destructive to the action.[7]

§ 1112. Plea in Equity: When Proper.

A plea in equity is a special answer, urging some particular defence by which the issue is reduced to a single point. Such particular defences are a want of jurisdiction over the controversy or the parties by reason of some fact not apparent in the bill, or some statute, record, or other matter which, if established, would defeat the action.[1] But, except in special cases, a plea must not anticipate the answer by denying the substantial allegations of the bill, — since, if this were allowable, the defendant, in his answer over after the plea is overruled, might revive and again contest the same issues which had been decided against him on his plea.[2] Thus while such special

[6] That on a demurrer to the whole bill, and also to part thereof, if the latter is sustained the bill will be dismissed as to the defective part and the rest answered, see Giant Powder Co. *v.* California Powder Works (1878), 98 U. S. 126; 15 O. G. 289.

[7] That an omission to swear to a bill is no ground of demurrer after the hearing and an order to file the evidence, see Woodworth *v.* Edwards (1847), 3 W. & M. 120; 2 Robb, 610.

That the bill may be verified by the equitable owner without the legal owner, see Goodyear *v.* Allyn (1868), 3 Fisher, 374; 6 Blatch. 33.

That if the bill is not duly sworn to the objection should be taken as soon as the defendant appears, and the court may order the oath if it deems it necessary, see Woodworth *v.* Edwards (1847), 3 W. & M. 120; 2 Robb, 610.

That on a plea to the jurisdiction *ex parte* affidavits which are introduced without notice or opportunity to cross-examine, as well as unauthenticated writings, are inadmissible, see Lilienthal *v.* Washburn (1881), 8 Fed. Rep. 707.

§ 1112. [1] For the nature and effect of a plea in equity, see Story Eq. Pl. §§ 647–837; Equity Rules, 31–38.

[2] That general defences not averring new matter cannot be made under a special plea, see Hubbell *v.* De Land (1882), 14 Fed. Rep. 471; 11 Bissell, 382; 22 O. G. 1883; Sharp *v.* Reissner (1881), 20 O. G. 1161; 9 Fed. Rep. 445; 20 Blatch. 10.

That in some cases the plea may deny an averment of the bill, see Matthews *v.* Lalance & Grosjean Mfg. Co. (1880), 2 Fed. Rep. 232; 17 O. G. 1284; 18 Blatch. 84; 5 Bann. & A. 319.

That the defendant cannot set up all his issues, except the issue as to infringe-

matters as the departure of a re-issued patent from its original may form the subject of a plea, defences which attack the patentability of the invention, or the fact of infringement, or other principal averment of the bill, can be set up only in the answer.[3] But a plea stating new matter, which displaces the equity of the bill, is proper though it may thereby attack the patent.[4]

§ 1113. Requisites of a Plea in Equity: Procedure Thereon.

A plea in equity must be single, clear, and unevasive.[1] Though it may cover several facts when all together constitute but one defence, if it embraces several defences it is fatally defective on account of the duplicity.[2] Double pleading in

ment, in pleas and try them separately, see Giant Powder Co. *v.* Safety Nitro-Powder Co. (1884), 10 Sawyer, 23; 27 O. G. 99; 19 Fed. Rep. 509.

[3] That the departure of a re-issue from the original can be set up in a special plea, see Hubbell *v.* De Land (1882), 14 Fed. Rep. 471; 11 Bissell, 382; 22 O. G. 1883.

That a plea may aver the expiration of the patent before suit and so dispute the jurisdiction of equity, see Edison Electric Light Co. *v.* United States Electric Lighting Co. (1888), 35 Fed. Rep. 134.

That the issue of infringement as well as other issues on the merits must be raised by answer, not by plea, see Korn *v.* Wiebusch (1887), 33 Fed. Rep. 50.

That a plea denying infringement only will be struck out on motion, since the same matter could be set up in the answer were the plea overruled, see Sharp *v.* Reissner (1881), 9 Fed. Rep. 445; 20 O. G. 1161; 20 Blatch. 10.

That a plea, denying that the defendant's structures are covered by the plaintiff's patent, denies an allegation of the bill and is bad in substance, see Matthews *v.* Lalance & Grosjean Mfg. Co. (1880), 17 O. G. 1284; 2 Fed. Rep. 232; 18 Blatch. 84; 5 Bann. & A. 319.

[4] That a plea setting up new matter, displacing the equity of the bill, will not be struck from the files or ordered to stand as an answer on the ground that it attacks the patent, see Hubbell *v.* De Land, (1882), 22 O. G. 1883; 14 Fed. Rep. 471; 11 Bissell, 382.

§ 1113. [1] That every pleading in equity must be single, clear, and unevasive, see Graham *v.* Mason (1869), 5 Fisher, 1; 4 Clifford, 88.

That a plea may be negative in form, see Edison Electric Light Co. *v.* United States Electric Lighting Co. (1888), 35 Fed. Rep. 134.

[2] That several defences cannot be made by plea, see Reissner *v.* Anness (1877), 12 O. G. 842; 3 Bann. & A. 148.

That a plea must present a single issue, see Giant Powder Co. *v.* Safety Nitro-Powder Co. (1884), 10 Sawyer, 23; 27 O. G. 99; 19 Fed. Rep. 509.

That though a plea must present a single issue it may embrace several facts, see Reissner *v.* Anness (1877), 12 O. G. 842; 3 Bann. & A. 148.

That the defences of fraud, new matter in the re-issue, and prior foreign patent are independent defences and cannot be embraced in one plea, see Reissner *v.* Anness (1877), 12 O. G. 842; 3 Bann. & A. 148.

equity is not permitted except by special leave of the court, and if without leave the defendant enters several pleas he may be compelled to elect one of them on which to stand, or to treat the pleas as an answer on which a final hearing may be had.[3] A plea may be interpreted, when necessary, by the exhibits thereunto annexed.[4] Unless in proper form the plea should not be answered by the plaintiff.[5] If on a trial of the issues it presents the defendant obtains judgment, the facts thus found in his favor will avail him as far as in law and equity they ought to do.[6] By setting down the plea for argument on its sufficiency the plaintiff admits the truth of its averments; by joining issue he admits its sufficiency as a defence; and therefore if its allegations are sustained the bill must be dismissed.[7] When upon argument or trial the

[3] That there can be no double pleading in equity unless special leave is given, see Giant Powder Co. *v.* Safety Nitro-Powder Co. (1884), 19 Fed. Rep. 509; 10 Sawyer, 23; 27 O. G. 99.

That delay in asking leave to file several pleas is not encouraged, see Giant Powder Co. *v.* Safety Nitro-Powder Co. (1884), 10 Sawyer, 23; 19 Fed. Rep. 509; 27 O. G. 99.

That a double plea may stand as an answer, or the defendant may disclaim all the defences except one, see Reissner *v.* Anness (1877), 12 O. G. 842; 3 Bann. & A. 148.

[4] That a plea in equity may be qualified by a paper annexed, the paper being treated as incorporated in the plea, see Wheeler *v.* McCormick (1871), 4 Fisher, 432; 8 Blatch. 267.

[5] That if the plea is insufficient as a defence it should be set down for argument on that question, not replied to, see Cottle *v.* Krementz (1885), 25 Fed. Rep. 494; Birdseye *v.* Heilner (1885), 26 Fed. Rep. 147; 34 O. G. 1392; 27 Fed. Rep. 289; Sharp *v.* Reissner (1881), 20 O. G. 1161; 9 Fed. Rep. 445; 20 Blatch. 10.

[6] Equity Rule 33.

[7] That the want of a certificate and affidavit to the plea under Rule 31 is waived by demurrer and argument on the merits of the plea, see Goodyear *v.* Toby (1868), 6 Blatch. 130.

That a replication to a plea admits its sufficiency both in form and substance, and if the facts pleaded are proved the bill must be dismissed, see Bean *v.* Clark (1887), 40 O. G. 1454; Cottle *v.* Krementz (1885), 25 Fed. Rep. 494; Birdseye *v.* Heilner (1885), 26 Fed. Rep. 147; 34 O. G. 1392; 27 Fed. Rep. 289; Reissner *v.* Anness (1878), 13 O. G. 7.

That where the plea merely denies an averment of the bill, a replication does not admit the plea to be valid, see Matthews *v.* Lalance & Grosjean Mfg. Co. (1880), 2 Fed. Rep. 232; 17 O. G. 1284; 18 Blatch. 84; 5 Bann. & A. 319.

That long neglect to join issue on a plea may admit its truth and sufficiency, see Keller *v.* Stolzenbach (1886), 28 Fed. Rep. 81; 37 O. G. 564.

That a decree against a plaintiff for failure to answer a plea or set it down for argument is not conclusive, see Keller *v.* Stolzenbach (1884), 27 O. G. 209; 20 Fed. Rep. 47.

That where a plea alleges a fact

plea is overruled the defendant may either file an answer to the bill or submit to a decree upon the merits.[8]

§ 1114. Answer in Equity, when Proper: Defences Peculiar to Equity: Laches: Estoppel.

An answer in equity is a denial, or a confession and avoidance, of the material allegations in the bill.[1] It is the method by which the defendant sets forth his general defences to the action. In cases of infringement all defences which are available at law may be resorted to in equity, and to certain of them equity attaches an especial significance. Those which deny the patentability of the invention, or the existence and validity of the patent, have the same weight and scope in either jurisdiction. But in equity the defendant may avail himself of any interest which he possesses in the patent whereby his use of the invention can be justified although the entire legal title may be vested in the plaintiff; and where a licensee is treated by his licensor as an infringer the former may defend himself on any ground open to infringers without regard to the conditions of his license.[2] In equity, also, the defence based on an estoppel is particularly favored, and here the laches of the plaintiff in enforcing his monopoly may often be sufficient to defeat his suit.[3] Delays which he cannot avoid,

which may serve one of the defendants it will not be overruled, but held until the evidence is in and then decided, see Williams & Albright *v.* Empire Transportation Co. (1878), 14 O. G. 523; 3 Bann. & A. 533.

[8] That the 34th rule in equity permits an answer even after plea overruled, see Wooster *v.* Blake (1881), 7 Fed. Rep. 816; 20 O. G. 158.

§ 1114. [1] As to the nature and scope of an answer in equity, see Story, Eq. Pl. §§ 838–876.

[2] That the defendant may set up his equitable rights against the legal title of the plaintiff, see § 1090 and notes, *ante*.

That in equity a licensee treated as an infringer may avail himself of any defence open to infringers, whatever covenants his license may contain, see Pelham *v.* Edelmeyer (1883), 15 Fed. Rep. 262; 25 O. G. 292; 21 Blatch. 188; White *v.* Lee (1882), 23 O. G. 1621; 14 Fed. Rep. 789. It would seem that this proposition can be true only when the licensee is sued as an infringer for doing the acts authorized by his license, the suit in such cases amounting to an eviction and releasing him from the license and its covenants.

[3] That a patentee may forfeit his right to past profits by his laches and acquiescence, see Kittle *v.* Hall (1887), 29 Fed. Rep. 508; 39 O. G. 707; Keller *v.* Stolzenbach (1886), 28 Fed. Rep. 81; 37 O. G. 564; New York Grape

or for a period so short as to raise no presumption of his acquiescence in the wrong, or during the pendency of other suits involving similar issues, or after the defendant has been duly notified or has discovered that his acts were violations of the patent, cannot affect the right of the plaintiff to complete redress.[4] But where the defendant is not conscious that his

Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519. See also § 1194, and notes, *post.*

That laches in obtaining a re-issue is a question of law when it appears on the face of the patent, and unless there explained by stating its reasons at length it may be raised by demurrer and may defeat the suit, see Wollensak *v.* Reiher (1885), 115 U. S. 96; 31 O. G. 1301.

That a delay of thirteen years in suing, if the bill does not show some good reason for it, is such laches as will prevent an injunction, though perhaps not a suit for damages, see McLaughlin *v.* People's Railway Co. (1884), 29 O. G. 277; 21 Fed. Rep. 574.

That laches is a good defence in equity and can be raised by demurrer if apparent on the bill, see McLaughlin *v.* People's Railway Co. (1884), 21 Fed. Rep. 574; 29 O. G. 277.

That a bill averring acts of infringement on "divers days and occasions" during twelve years does not allege continuous acts or show laches in the plaintiff, see Kaolatype Engraving Co. *v.* Hoke (1887), 30 Fed. Rep. 444; 39 O. G. 589.

That a delay not amounting to an estoppel will not prevent an injunction, though it may be a bar to a recovery of past profits, see New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519.

That an assignee of claims for past infringements is barred by the laches of his assignor, see New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1885), 32 O. G. 1356; 24 Fed. Rep. 604.

[4] In McMillin *v.* Barclay (1872), 5 Fisher, 189, McKennan, J.: (201) "I have failed to discover any evidence upon which an equitable estoppel in favor of the respondents can rest. It must necessarily grow out of some declaration or act of the applicant, by which they were induced to believe that they might rightfully or innocently use the invention now claimed by him. If they appropriated it without consulting him, and he was passive when he knew it because he was powerless to prevent them, he is not estopped from asserting his right when he is in a condition to enforce it. If they took the risk of using what they did not own, the owner's helplessness then will not shield them from accountability to him now. This is the only effect of the proof; for, although the applicant publicly used his invention after he applied for a patent, he did not intend to abandon it, as has been already shown; and as he had a clear right so to use it, the law does not presume from that fact that he assented to its use by others. (Ryan *v.* Goodwin, 3 Sum. 519.) Nor is this supposed estoppel invigorated by the fact that invasion of the patentee's rights has been widespread, and that all who may be found in that category may be held liable accordingly. Whoever reaps where he did not sow wrongfully appropriates what belongs to another, and equity will not stay the hand of the rightful owner of the harvest against him." 4 Brews. (Pa.) 275 (285).

That redress is promptly sought when

use of the invention is unlawful, and the plaintiff is aware of the infringement, the latter must take measures for his own protection with all reasonable diligence, or the delay will furnish a sufficient answer to his claim for an injunction if not for damages or profits on account of past invasions of his rights.[5]

§ 1115. Scope of Answer: Joinder of Defences.

The answer must include all matters of defence on which the defendant intends to rely, except such as are proper subjects for a plea or a demurrer.[1] Defences not inserted in the

action is brought within six months after the patent is granted, see Brick *v.* Staten Island Ry. Co. (1885), 25 Fed. Rep. 553.

That delay pending other suits is not laches, see Van Hook *v.* Pendleton (1846), 1 Blatch. 187; and §§ 1194, 1195, and notes, *post*.

That delay after due notice to the defendant is not laches, see City of Concord *v.* Norton (1883), 16 Fed. Rep. 477.

That seasonable notice to an infringer, followed by a suit within reasonable time, rebuts the claim of laches, see Seibert Cylinder Oil-Cup Co. *v.* Michigan Lubricator Co. (1888), 34 Fed. Rep. 33.

That the plaintiff is not guilty of laches by not suing infringers of whom he is ignorant, see Adams *v.* Howard (1884), 26 O. G. 825; 19 Fed. Rep. 317; New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519.

That a patentee who is diligently prosecuting infringers is not guilty of laches in not suing some particular one who knows of the other suits, see American Bell Telephone Co. *v.* Southern Telephone Co. (1888), 34 Fed. Rep. 795.

That laches of a plaintiff does not bar his rights where he gave such notice as he was able, see Kittle *v.* Hall (1887), 39 O. G. 707; 29 Fed. Rep. 508.

That where inaction of the patentee is due to the misrepresentations of the defendant it is not laches, see Wilson *v.* Keely (1888), 43 O. G. 511.

That a delay in suing infringers caused by the patentee's bankruptcy and the passing of the patent into the hands of his trustee, with ineffectual efforts of the patentee to regain it until shortly before suit, is not such laches as forfeits in equity the right to sue, if timely notice of an intention to prosecute were given to infringers, see Kittle *v.* Hall (1887), 29 Fed. Rep. 508; 39 O. G. 707.

[5] That if the plaintiff is aware of the infringement and the defendant acts in good faith notice must be given or the remedy by injunction may be lost by delay, see Mundy *v.* Kendall (1885), 23 Fed. Rep. 591; 32 O. G. 1237.

That equity will grant no relief to any one acting fraudulently, see Hoffheins *v.* Brandt, (1867), 3 Fisher, 218.

§ 1115. [1] That *in equity* as at law the foundation for evidence must be laid in the pleadings, see Wilson *v.* Stolley (1847), 4 McLean, 275.

That a general defence of "want of equity" will not be regarded, see Puetz *v.* Bransford (1887), 39 O. G. 1083; 31 Fed. Rep. 458.

That the issue must be raised by allegations in the bill and answer, and if defective they may be amended, see Doughty *v.* West (1865), 2 Fisher, 553.

That every material fact must be set

answer will not be noticed by the court.[2] Any number of defences may be joined in the same answer provided they are consistent with each other, and defences are consistent when they can all be true.[3] Inconsistent defences create a repugnancy which is fatal to the answer unless cured by an abandonment of one of the antagonistic claims. Each defence must be distinctly and affirmatively stated, with such particularity as to time, place, person, and circumstances that the plaintiff may be informed of the precise attack he has to meet.[4] The answer must apprise the plaintiff of the defendant's theory as to the scope and meaning of the patent, in order that he may perceive under what view of the invention the defences will be urged, for the defendant cannot set up hypothetical defences based upon possible constructions of the patent subsequently to be given by the court.[5] The defendant is concluded by

up in the pleadings, see Blandy *v.* Griffith (1869), 3 Fisher, 609.

That affirmative defences, especially that of prior knowledge, must be properly alleged as well as proved, see Searls *v.* Bouton (1882), 21 O. G. 1784 ; 12 Fed. Rep. 140 ; 20 Blatch. 426.

[2] That defences not set up in the answer will not be considered by the court, see Sessions *v.* Romadka (1884), 28 O. G. 721 ; 21 Fed. Rep. 124 ; Bates *v.* Coe (1878), 98 U. S. 31 ; 15 O. G. 337 ; Salamander Felting Co. *v.* Haven (1875), 9 O. G. 253 ; 3 Dillon, 131 ; 2 Bann. & A. 164 ; Howes *v.* Nute (1870), 4 Clifford, 173 ; 4 Fisher, 263.

That if the invention described in the patent is evidently not the result of inventive skill, the court will dismiss the bill though this defence is not urged in the answer, see Slawson *v.* Grand St., Prospect Park, & Flatbush R. R. Co. (1882), 107 U. S. 649 ; 24 O. G. 99.

[3] In National Mfg. Co. *v.* Meyers (1881), 7 Fed. Rep. 355, Swing, J. : (357) "In eqnity a defendant has the right to set up as many defences as he may have, providing they are not inconsistent. (Sharp *v.* Carlisle, 5 Dana, 488 ; Wood *v.* Wood, 2 Paige, Ch. 108 ; Hopper *v.* Hopper, 11 Paige, Ch. 46 ; Daniell's Ch. Pr. 727.) Defences are inconsistent where they cannot both be true ; but where there are different defences and they may all be true, though entirely different in their nature, they are not inconsistent."

[4] That if more than one defence is presented in the answer each must be distinct and unconditional, see Graham *v.* Mason (1869), 5 Fisher, 1 ; 4 Clifford, 88.

That substantial matters of defence as to the novelty of the invention must be set up in the answer with such particularity as to time, place, and person that the plaintiff may know what he has to meet, see Brown *v.* Hall (1869), 3 Fisher, 531 ; 6 Blatch. 401.

[5] That the answer must inform the plaintiff of the defendant's theory as to the construction of the patent, and cannot aver that if the plaintiff's patent be so construed as to cover the defendant's device he will then defend on the ground of prior use, see Graham *v.* Mason (1869), 4 Clifford, 88 ; 5 Fisher, 1.

his answer, which is regarded as embracing his actual and entire defence, and cannot depart from it except by an amendment under leave of the court, especially where the plaintiff is entitled to an answer under oath.[6]

§ 1116. Statement of Special Defences in the Answer.

Those special defences, which in actions at law must be set forth in a notice served on the defendant, in equity appear only in the answer.[1] Their statement is, however, governed by the same rules as to precision and completeness which are applicable to a notice.[2] If the answer asserts that the patentee or his assignor surreptitiously or unjustly obtained the patent for that which was in fact invented by another, it must also allege that the first inventor was using reasonable diligence in adapting and perfecting it.[3] When it denies the novelty of the invention, on the ground of prior use or knowledge, it must recite the names and residences of the persons using or having knowledge of the invention, and sufficiently describe the place of use to put the plaintiff in possession of the means of identifying such invention with his own.[4] When

[6] That a departure from the defence alleged in the answer is not allowed in equity when the plaintiff is entitled to an answer under oath, see Russell & Erwin Mfg. Co. *v.* Mallory (1872), 5 Fisher, 632; 2 O. G. 495; 10 Blatch. 140.

That an answer in equity is evidence as well as defence and cannot be made by attorney, though the objection is waived if not insisted on, see Wooster *v.* Muser (1884), 28 O. G. 286; 20 Fed. Rep. 162.

§ 1116. [1] That in equity the special defences are set up in the answer, not by a notice, see Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337; Pickering *v.* Phillips (1876), 10 O. G. 420; 4 Clifford, 383; 2 Bann. & A. 417; Agawam Co. *v.* Jordan (1868), 7 Wall. 583; Doughty *v.* West (1865), 2 Fisher, 553; Pitts *v.* Edmonds (1857), 2 Fisher, 52; 1 Bissell, 168.

That the defence that the invention was not patentable need not be set up in the answer, see Hendy *v.* Golden State & Miners' Iron Works (1888), 127 U. S. 370; 43 O. G. 1117.

[2] That the notice at law and the answer of special defences in equity are governed by the same rules, see Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796. Also §§ 993–1005, *ante*.

[3] That an answer alleging that the patentee surreptitiously obtained a patent for what he knew was the invention of another must also allege that the first inventor was using due diligence to perfect it, see Agawam Co. *v.* Jordan (1868), 7 Wall. 583. This refers to the defence described in the act of 1836, not that under the act of 1793. See § 960 and notes, *ante*.

[4] That the defence of want of novelty must be clearly and specifically set forth in the answer, see Loom Co. *v.* Higgins

it attacks the novelty of the invention, on the ground of a prior patent or a prior publication, it must disclose the name

(1882), 105 U. S. 580 ; 21 O. G. 2031 ; 21 O. G. 1784 ; 12 Fed. Rep. 140 ; 20 Guidet *v.* Barber (1873), 5 O. G. 149 ; Blatch. 426.

Jordan *v.* Dobson (1870), 4 Fisher, 232 ; 2 Abbott, 398 ; 7 Phila. 533 ; Graham *v.* Mason (1869), 5 Fisher, 1 ; 4 Clifford, 88 ; Pitts *v.* Edmonds (1857), 2 Fisher, 52 ; 1 Bissell, 168.

That the defendant in equity must give notice in his answer of the names and residences of the persons whom he intends to prove possessed the knowledge of the invention, and of the place where it has been used, see Seymour *v.* Osborn (1870), 11 Wall. 516.

That a defendant who relies on a defence of prior use must set out in his answer the names of those who have invented or used the anticipating device, but not the names of his witnesses, see Allis *v.* Buckstaff (1882), 22 O. G. 1705; 13 Fed. Rep. 879 ; Roemer *v.* Simon (1877), 95 U. S. 214 ; 12 O. G. 796.

That depositions as to prior use cannot be read unless the persons using were named in the answer, see Collender *v.* Griffith (1873), 3 O. G. 689; 11 Blatch. 212.

That where an answer merely alleges prior knowledge, and does not set forth where and by whom the invention was used, evidence of prior knowledge and use is not admissible, see Searls *v.* Bouton (1882), 12 Fed. Rep. 140 ; 21 O. G. 1784 ; 20 Blatch. 426.

That evidence of *prior* use, given by witnesses not named in the answer, can be considered only to show the state of the art, see Stevenson *v.* Magowan (1887), 42 O. G. 1063 ; 31 Fed. Rep. 824 ; Richardson *v.* Lockwood (1873), 4 O. G. 398 ; 6 Fisher, 454.

That an answer alleging knowledge by certain persons *of* a certain place, but not *at* any specified place, does not open the way for evidence of knowledge at any place, see Searls *v.* Bouton (1882),

That an allegation by the defendant of a prior use, on his knowledge and belief, amounts to nothing unless his information is disclosed, see Young *v.* Lippman (1872), 2 O. G. 249; 5 Fisher, 230 ; 9 Blatch. 277.

That evidence as to a prior rejected application of a third person, his use and knowledge, is not admissible in equity unless these facts are set up in the answer, see Union Paper Bag Mach. Co. *v.* Pultz & Walkley Co. (1878), 15 O. G. 423 ; 15 Blatch. 160 ; 3 Bann. & A. 403.

That where the answer mentions a person who made a prior application for a patent, but gave no residence, he could not be examined as to prior knowledge and use, see Decker *v.* Grote (1873), 3 O. G. 65 ; 10 Blatch. 331 ; 6 Fisher, 143.

That unless the answer denying priority of invention gives notice of the persons and places of the previous use, evidence of foreign patents and other evidence in support of the answer is not regarded, see Earl *v.* Dexter (1874), 6 O. G. 729 ; Holmes, 412 ; 1 Bann. & A. 400.

That an answer in equity may be sufficient for an order to try the issue at law though it does not set out the names of prior users and the place of use, but the answer in the suit at law must set them out, see Orr *v.* Merrill (1846), 1 W. & M. 376 ; 2 Robb, 331.

That evidence of prior use abroad is not supported by notice of use in this country, see Dixon *v.* Moyer (1821), 4 Wash. 68 ; 1 Robb, 324.

That the answer denying priority of invention must cover the whole invention, not a part of it, see Parks *v.* Booth (1880), 102 U. S. 96 ; 17 O. G. 1089.

That machines not set up in the an-

of the patentee and the date of the patent, and give the volume, page, and date of the publication.[5] An answer of abandonment must specifically aver the facts on which the defendant

swer cannot be offered in evidence nor considered on final hearing, see Howe *v.* Williams (1863), 2 Fisher, 395; 2 Clifford, 245.

That evidence of prior use, if taken without proper averments in the answer, and duly objected to, may be struck out on motion, see Bragg *v.* City of Stockton (1886), 27 Fed. Rep. 509; 11 Sawyer, 597; Decker *v.* Grote (1873), 6 Fisher, 143; 3 O. G. 65; 10 Blatch. 331.

That if evidence of prior use be taken without proper notice, the answer may sometimes be amended and the evidence may stand, see Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 379.

That evidence of prior use taken without proper notice will be allowed to stand unless a motion to strike it out is made, see Elm City Co. *v.* Wooster (1873), 4 O. G. 83; 6 Fisher, 452.

That evidence of prior use, taken under a general denial of priority without objection, is properly received both as to the state of the art and the priority of the invention, see Zane *v.* Soffe (1884), 110 U. S. 200; 26 O. G. 737; Loom Co. *v.* Higgins (1882), 105 U. S. 580; 21 O. G. 2031.

That evidence taken without due notice and against objections, but with full examination and cross-examination, may stand after amendment of the answer, see Allis *v.* Buckstaff (1882), 13 Fed. Rep. 879; 22 O. G. 1705.

That amendment after evidence taken under objection will not cure the defect unless the former omission was inadvertent and the plaintiff is not taken by surprise, see Roberts *v.* Buck (1873), 6 Fisher, 325; Holmes, 224; 3 O. G. 268.

That witnesses produced without proper notice must be objected to at the time or the defect will be waived, see Roemer *v.* Simon (1874), 5 O. G. 555; 1 Bann. & A. 138.

That the improper admission of evidence of prior use without due notice cannot be excepted to in the Supreme Court on appeal, unless objection were made at the proper time, see Loom Co. *v.* Higgins (1882), 105 U. S. 580; 21 O. G. 2031.

That if the evidence of prior use were admitted without due notice against the plaintiff's objection, the Supreme Court on appeal will reverse the judgment, though the appeal did not rest on that ground, see Blanchard *v.* Putnam (1869), 8 Wall. 420.

That the Supreme Court may consult the evidence contained in the record in order to determine the scope of the invention, though prior use is not set up in the answer, see Eachus *v.* Broomall (1885), 115 U. S. 429; 33 O. G. 1265.

[5] That defences of prior patent or prior publication must be set up in the answer, not by special plea, see Carnrick *v.* McKesson (1881), 19 Blatch. 369; 8 Fed. Rep. 807.

That copies of drawings of prior patents and evidence as to them are inadmissible to show priority unless set up in the answer, see Earl *v.* Dexter (1874), 6 O. G. 729; Holmes, 412; 1 Bann. & A. 400.

That the answer cannot allege any earlier date for a prior patent or publication than its actual issue, see Kelleher *v.* Darling (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

That a prior patent not set up in the answer can be used only to show the state of the art and so give a construction to the patent in question, see Grier *v.* Wilt (1887), 120 U. S. 412; 38 O. G. 1365.

That evidence of the state of the art

will rely, and if these facts consist of instances of public use and sale more than two years before the application they must be stated in a separate allegation from those which set up other methods of abandonment.[6] Where the defence rests, wholly or in part, upon the fraud of the patentee in attempting to mislead the public by an imperfect or redundant specification, or in obtaining by deceit the issue of the patent, the answer must charge the fraudulent acts in terms distinct, particular, and positive.[7] The departure of a re-issued patent from its original, or its unlawful grant by the Commissioner when the original was sufficient to protect the actual invention;[8] is admissible without notice at law or mention in the answer in equity, see Brown *v.* Piper (1875), 91 U. S. 37; 10 O. G. 417.

[6] That if abandonment is relied on it must be specially set up in defence, see Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23.

That an answer of use and sale before application must allege an abandonment, or that the use and sale were more than two years before the application, see Root *v.* Ball (1846), 4 McLean, 177; 2 Robb, 513.

That an answer alleging that the invention was in use two years before the application need not also aver that the inventor consented to such use, see Campbell *v.* New York (1888), 35 Fed. Rep. 504.

That an answer alleging two years public use and sale before the plaintiff's *invention* is improper, no such defence being known to the law, see Kelleher *v.* Darling (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438.

That public use and sale and abandonment may be set up in the same answer, but not in the same allegation, as they depend on different principles, see Jones *v.* Sewall (1873), 6 Fisher, 343; 3 O. G. 630; 3 Clifford, 563.

That where no question as to novelty is made by the pleadings, and the use relied on is a public use under the inventor or by him, there is no need to give notice of the persons using or the place where used, see American Hide & Leather Splitting and Dressing Mach. Co. *v.* American Tool & Mach. Co. (1870), 4 Fisher, 284; Holmes, 503.

[7] That fraud must be set up in the answer by distinct and special allegations, see Blake *v.* Stafford (1868), 3 Fisher, 294; 6 Blatch. 195.

That an allegation that a re-issue was obtained under false pretences must be made in distinct language without equivocation, and be the subject of distinct proof, see Doughty *v.* West (1865), 2 Fisher, 553.

That an averment in the answer that the patent was obtained by "false and fraudulent representations to the Commissioner," and "is void in law," is too general to raise an issue, see Clark *v.* Scott (1872), 5 Fisher, 245; 2 O. G. 4; 9 Blatch. 301.

[8] That the want of identity between an original and re-issue must be set up in the answer by distinct and special allegations, see Blake *v.* Stafford (1868), 3 Fisher, 294; 6 Blatch. 195.

That an answer in a suit on a re-issued patent, alleging that the original was not surrendered because it was inoperative or invalid or claimed too

the ambiguity of the Description or the Claim;[9] unreasonable delay in filing a disclaimer;[10] the failure of the plaintiff to stamp or label his patented articles when placed upon the market;[11] the issue of a joint patent for a sole invention;[12] the defendant's license or co-ownership;[13] each of these, if insisted on by the defendant, must be so fully and exactly declared in the answer as to forewarn the plaintiff of the precise line of attack and enable him to make the necessary preparation to repel it.

§ 1117. Denial of Plaintiff's Title or of Defendant's Infringement in the Answer.

When the defendant disputes the title of a plaintiff in whom, according to the records of the Patent Office, the legal ownership resides, the answer must reveal the facts which qualify the record title or create antagonistic or exclusive interests in others.[1] If he himself claims to own the patent, as an equitable assignee, he must state the consideration which he paid for it, both in nature and amount, in such

much, and that the re-issue claims were broadened, puts in issue the lawfulness of the enlargement and the scope of the original, see Searls *v.* Bouton (1882), 22 O. G. 946; 12 Fed. Rep. 874; 20 Blatch. 528.

[9] That an objection to the patent on account of an insufficient specification must be set up in the answer, or it will not be considered, see Jennings *v.* Pierce (1878), 15 Blatch. 42; 3 Bann. & A. 361; Wonson *v.* Peterson (1878), 13 O. G. 548; 3 Bann. & A. 249; Rubber Co. *v.* Goodyear (1869), 9 Wall, 788; Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351.

[10] That unreasonable delay in filing a disclaimer must be specifically alleged in the answer, see Worden *v.* Searls (1884), 21 Fed. Rep. 406; Burden *v.* Corning (1864), 2 Fisher, 477.

That an amendment of the application without authority need not be set up in the answer, see Eagleton Mfg. Co. *v.* West, Bradley, & Cary Mfg. Co. (1880), 2 Fed. Rep. 774; 17 O. G. 1504; 18 Blatch. 218; 5 Bann. & A. 475.

[11] That an objection that "patented" is not stamped on the plaintiff's articles must be set up in the answer, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

[12] That the defence that joint patentees were not joint inventors must be specially set up, see Butler *v.* Bainbridge (1886), 29 Fed. Rep. 142; 37 O. G. 1124.

[13] That in equity the defendant must specially allege his license or co-ownership, see Puetz *v.* Bransford (1887), 31 Fed. Rep. 458; 39 O. G. 1083.

§ 1117. [1] That if the defendant denies the title of owners of record he must set up in his answer the facts which affect their title, or produce the proper proof, see Washburn & Moen Mfg. Co. *v.* Haish (1880), 19 O. G. 173; 4 Fed. Rep. 900; 10 Bissell, 65.

form that its adequacy or good faith can be denied.[2] The answer must traverse the allegation of infringement positively and without equivocation.[3] This traverse may be couched in general terms, containing no precise description of the invention but referring to it as the one covered by the patent.[4] Where the defendant admits the use of the invention, but excuses his infringing act on the ground of his subjection to authority, the answer must disclose his principal.[5] If he justifies under a license, it must appear upon his answer that the license warrants the use that he has made of the invention.[6] Facts which constitute an estoppel *in pais* should be set out in the answer with sufficient detail to indicate that if established by the evidence, and unexplained by counter proof from the plaintiff, they must operate as an equitable bar to the further prosecution of the action.[7]

[2] That a defendant, claiming to be the owner of the patent in controversy by purchase, must set forth the consideration he paid for it in amount and in such form that it can be traversed and that its adequacy may appear, if the record shows the title to be in the plaintiff, see Secombe *v.* Campbell (1880), 2 Fed. Rep. 357; 18 Blatch. 108; 5 Bann. & A. 429.

[3] That if infringement is alleged in the bill the defendant must answer it distinctly and unevasively, see Jordan *v.* Wallace (1871), 5 Fisher, 185.

That the answer must deny infringement specifically in order to allow evidence against it, unless a stipulation between counsel takes the place of the answer, see Allis *v.* Buckstaff (1882), 13 Fed. Rep. 879; 22 O. G. 1705.

That unless the defendant in his answer contests the infringement very slight proof will sustain the allegation, see Spring *v.* Domestic Sewing Mach. Co. (1881), 9 Fed. Rep. 505; 21 O. G. 633; Goodyear *v.* Berry (1868), 3 Fisher, 439; 2 Bond, 189.

[4] That a denial that the defendants have practised the invention described is sufficient without particularly setting forth the invention, or specifically contradicting the allegation in the bill, see Miller *v.* Buchanan (1880), 18 O. G. 1532; 5 Fed. Rep. 366.

That where the bill alleges a covenant on the part of the defendant not to infringe, an answer giving the history of such covenant is not responsive, see Sargent *v.* Larned (1855), 2 Curtis, 340.

[5] That a claim that the defendant acted only as agent must disclose the principal, see Morse *v.* Davis (1862), 5 Blatch. 40.

[6] That a defendant may answer that he was acting under a license, and may impeach the patent unless the covenants of his license estop him, see National Mfg. Co. *v.* Meyers (1881), 7 Fed. Rep. 355.

That an answer by an infringing user, alleging recovery against his vendor, does not state a defence unless it also avers satisfaction of the judgment, see Fisher *v.* Consolidated Amador Mine (1885), 11 Sawyer, 190; 25 Fed. Rep. 201.

[7] That the answer must set out in

§ 1118. Effect of Admissions in the Answer.

Admissions in an answer are conclusive on the defendant, but have no effect beyond the necessary import of the words.[1] Thus the acknowledgment that the defendant has infringed admits but one act of infringement, and a joint answer containing such acknowledgment does not admit a joint infringing act, or a joint *status* on the merits of the case.[2] An indirect admission is as binding as one that is affirmatively expressed. An allegation in the answer that the defendant has patented the invention since the issue of the plaintiff's patent is a concession that it is both new and useful.[3] The omission to notice in the answer any positive material allegation in the bill is a confession that the matters thus alleged are true.[4] Admissions are not waived by the production of

detail the facts from which an estoppel is alleged to arise, see Puetz *v.* Bransford (1887), 39 O. G. 1083, 1427; 31 Fed. Rep. 458.

§ 1118. [1] That admissions in the answer are conclusive, but go no further than the necessary import of the language, see Jones *v.* Morehead (1863), 1 Wall. 155.

[2] That the admission of "making and selling" implies only the making and selling of one article, unless the plural is used, when it implies two, see Jones *v.* Morehead (1863), 1 Wall. 155.

That a joint answer does not admit a joint infringement or a joint *status* on the merits, see Elizabeth *v.* Pavement Co. (1877), 97 U. S. 126.

[3] That if a defendant in his answer avers that he has patented the invention, after the plaintiff's patent, as new and useful, he cannot claim that it is old, see Morse Fountain Pen Co. *v.* Esterbrook Steel Pen Mfg. Co. (1869), 3 Fisher, 515.

[4] That where the bill avers and the answer does not deny but merely demands proof of the title of the plaintiff corporation, its corporate capacity is admitted by the pleadings, see Stover *v.* Halsted (1875), 8 O. G. 558; 13 Blatch. 95; 2 Bann. & A. 98.

That an answer not denying infringement, but alleging that the defendant's device produces a different result from the plaintiff's, admits the infringement, see Stuart *v.* Shantz (1872), 6 Fisher, 35; 2 O. G. 524.

That if the bill avers, and the answer does not deny nor the evidence contradict, that the defendant uses a described device, the use is admitted, see Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64.

That an answer denying the use of the invention "with the full knowledge of the premises in the bill and in violation of the complainant's exclusive rights secured by the patent of 1864" is an implied admission of actual use, and no further proof thereof is needed, see Jordan *v.* Wallace (1871), 5 Fisher, 185.

That an admission in the answer that the defendants bought the business in which the infringing device was used, and describing it as the "machine used by the defendants," is, in the absence of all other evidence, enough to show *prima facie* an infringement by them,

evidence in support of the same position on the part of the plaintiff.[5]

§ 1119. Answer: Whether under Oath: Effect of Sworn Answer.

The plaintiff is entitled to an answer under oath; but since the act of 1864, by which all parties were made competent witnesses, it is in most cases wiser not to require it. The defendant is limited in his defences to the matters set up in his answer, and is also bound by its admissions, whether or not he swears to its correctness; and if the plaintiff needs his testimony in support of any averments of the bill, he can procure it at the trial in the ordinary method. The principal advantage, therefore, of the oath in modern practice, except in a few special cases, is to compel the defendant to confine the allegations of his answer to facts whose existence he can verify, and thereby save the plaintiff from some fruitless inquiry. The disadvantage, however, is a great one. A sworn answer is still regarded as equivalent to the evidence of one competent witness, and is sufficient to sustain its various averments unless met by proof of corresponding weight upon the other side. It is thus equal to the testimony of the plaintiff, and when to it is added the evidence of the defendant on the trial, the burden of overcoming both is often greater than the plaintiff can sustain.[1] Hence it is customary as well as

see Fischer *v.* Wilson (1879), 16 O. G. 455; 16 Blatch. 220; 4 Bann. & A. 228.

That if the defendant denies the infringement, it is not proved by one reply of his, while testifying in reference to another matter, in which he seems to imply that he has infringed, see Reay *v.* Rau (1883), 23 O. G. 1928; 15 Fed. Rep. 749.

That want of consent to use the device need not be proved when it was alleged in the bill and not denied in the answer, see Fischer *v.* Hayes (1881), 6 Fed. Rep. 76; 20 O. G. 239; 19 Blatch. 26.

That an admission of the defendants in their answer that they have made large profits is to be understood in its ordinary sense, and is entitled to weight in ascertaining the truth or falsehood of their showing before the master, see Troy Iron & Nail Factory *v.* Corning (1869), 3 Fisher, 497; 6 Blatch. 328.

[5] That the adverse party does not waive an admission by going into evidence on the same matter, see Jones *v.* Morehead (1863), 1 Wall. 155.

§ 1119. [1] In Slessinger *v.* Buckingham (1883), 17 Fed. Rep. 454, Sawyer, J.: (455) "The answer, so far as responsive to the bill, directly denying the matters alleged, not only makes an issue, but it is testimony in the case called for by complainant proving the issue for defendants; and it must be overthrown by the testimony of two

prudent for the plaintiff to dispense with this requirement, and to accept the answer as a simple pleading which gives him notice of the claims hereafter to be urged by the defendant. When an answer under oath is demanded the demand must be complied with, if the defendant has the capacity to take an oath. A bill against a corporation cannot contain this demand unless its officers are made parties, — the corporate body being unable to comply, although a corporation may be called upon to answer interrogatories and must give such replies as the knowledge of its officers permits.[2]

witnesses, or the testimony of one witness and circumstances equivalent to another, or, at least, sufficient to make a preponderance of testimony in favor of complainant. Solicitors, generally, in this circuit, seem to overlook the great disadvantages under which they often labor in not waiving an answer under oath in equity cases, now that the complainant and defendant are themselves both competent witnesses, and can be orally examined under Equity Rule 67, where the complainant can get the evidence of his opponent, fresh from him in person, under a sharp and pressing examination, instead of having it deliberately shaped by him, and cautiously arranged and shaded for him, by his solicitor at his leisure in his office. Besides, when examined orally as a witness, the defendant counts but one; and the complainant may offer himself in opposition as to matters within his knowledge, if he swerves in the least particular from the truth; while, if called upon to answer a bill of discovery under oath, the defendant's answer, if responsive to the allegations of the bill, must be overthrown by the evidence of two witnesses, or of one witness and other circumstances equivalent to a a second. Besides, if complainant has other evidence sufficient to overthrow defendant's answer under oath, he has no occasion for a discovery. It would seem that a discovery by answer under oath may now be advantageously waived by the complainant in at least a great majority of cases." 8 Sawyer, 469 (471).

[2] In Colgate *v.* Compagnie Francaise (1885), 23 Fed. Rep. 82, Wallace, J.: (83) "Undoubtedly, a corporation cannot be compelled to answer under oath to a bill in equity. It answers only under the seal of the corporation. It is for this reason the practice has obtained of making the officers of the corporation parties to the bill and requiring them to answer the interrogatories. This, however, does not excuse a corporation from answering, and the complainant is entitled to an answer from a corporation as well as from an individual, although the value of the answer as evidence may not be worth the expense of the experiment. Although no officer or agent is made a party to the bill, it is still the duty of the corporation to cause diligent examination to be made, and give in its answer all the information derived from such examination; and if it alleges ignorance without excuse a disposition on its part to defeat and obstruct the course of justice may be inferred which will justify the court in charging it with the costs of the suit. (Attorney General *v.* Burgesses of East Retford, 2 Mylne & K. 35.) There is nothing, therefore, in the fact that the defendant is a corporation to defeat the complainant's right to maintain a bill of discovery." 23 Blatch. 86 (88).

§ 1120. Answer Setting up Special Defences, when Filed: Joint Answers: Exceptions to Answer.

An answer, containing a statement of any defence of which special notice is required in actions at law, must be filed a sufficient time before the trial, or the plaintiff may insist on a continuance.[1] Each of the defendants may answer separately from the others, or where it can be done without confusion all may join.[2] A joint answer cannot be sworn to by a part of the defendants, though such an answer may be amended by erasing the non-juring parties and be allowed to stand as the reply of those who have made oath to its averments.[3] A defendant who has neither joined in the answer of his co-defendants, nor filed a separate answer of his own, cannot appear and answer after a final decree, though no decree *pro confesso* has been passed against him.[4] Objections to an answer on account of defects of form, or the omission of necessary allegations, or the insertion of scandalous and impertinent matter, must be taken by exceptions, and if these are sustained the answer must be amended by such alterations, expurgations, or additions as it may require.[5] The filing of the answer, and its amendment if excepted to, is followed by the general replication, which puts the cause at issue without rejoinder or further pleadings upon either side.[6]

§ 1120. [1] That a plea or notice at law setting up special defences under the statute must be served or filed at least thirty days before the term of trial or a continuance will be allowed, and that the rule in equity is substantially the same, see Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796; Seymour *v.* Osborn (1870), 11 Wall. 516; Phillips *v.* Comstock (1849), 4 McLean, 525; 2 Robb, 724.

That the rules as to defences and notices are the same in equity as at law, see Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796.

[2] That several defendants may answer severally, see Equity Rule 62; Story, Eq. Pl. § 848.

[3] That an answer of three defendants sworn to by two only must be erased or the third defendant omitted from it, see Bailey Washing Mach. Co. *v.* Young (1874), 12 Blatch. 199; 1 Bann. & A. 362.

[4] That where one of several defendants did not appear, but no decree *pro confesso* was taken, he was not allowed to file an answer after final hearing and decree, see Allen *v.* Mayor of New York (1880), 7 Fed. Rep. 483; 18 Blatch. 239; 5 Bann. & A. 461.

[5] Equity Rules 61, 63–65.

That objections to an answer for failure to name persons, &c., ought to be taken by exceptions, see Graham *v.* Mason (1869), 5 Fisher, 1; 4 Clifford, 88.

[6] Equity Rule 66.

That a replication cannot go behind

§ 1121. Cross-Bills.

Where the defendant, in an action in equity, is entitled to relief against the plaintiff, in some matter connected with the suit, he may file a cross-bill with his answer setting up his claims and praying for the relief required.[1] A cross-bill cannot introduce new parties, or a new and independent controversy, but may be used for purposes of discovery or for the determination of any issue subordinate to that involved in the original bill.[2] It must aver all facts that are essential to sustain the defendant's right to the desired relief, and disclose the relation between the remedy it seeks and that which forms the object of the principal suit.[3] Cross-bills cannot be filed without leave of the court upon due notice to the adverse party.[4]

the case made on the pleadings and new parties, see Sheilds *v.* Barrow (1854), 17 How. 130.

That a cross-bill must relate to matters contained in the original bill, see Forbes *v.* R. R. Co. (1872), 2 Woods, 323; Rubber Co. *v.* Goodyear (1869), 9 Wall. 807; Cross *v.* DeValle (1863), 1 Wall. 1.

That a bill claiming a set-off against one of several plaintiffs is not a cross-bill, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 807.

That a cross-bill is not the proper mode of raising a question as to the defendant's ownership of the plaintiff's patent, a demurrer covering such cases, see Puetz *v.* Bransford (1887), 32 Fed. Rep. 318; 41 O. G. 353.

That an excess in a replication is surplusage, and the rest may stand as a traverse, see Wren *v.* Spencer Optical Mfg. Co. (1879), 18 O. G. 857; 5 Bann. & A. 61.

That if the plaintiff instead of filing a replication sets down the case for a hearing on the bill and answer, it admits that all that is well pleaded in the answer is proved, see Parton *v.* Prang (1872), 2 O. G. 619.

That the want of a replication is waived by taking the evidence on both sides without objection, see Fischer *v.* Wilson (1879), 16 O. G. 455; 16 Blatch. 220; 4 Bann. & A. 228.

That a cross-bill must disclose the grounds of the defendant's claim, and the connection between the matters averred and the original bill, see Story, Eq. Pl. § 401.

That cross-bills cannot be filed without leave of court, see Loom Co. *v.* Short (1876), 10 O. G. 1019; Bronson *v.* LaCrosse R. R. Co. (1863), 2 Wall. 283.

That cross-bills cannot be filed without due notice, see Loom Co. *v.* Short (1876), 10 O. G. 1019.

That on a bill against the defendants, setting up a license to some of the

§ 1121. [1] Equity Rule, 72.

[2] That a cross-bill cannot introduce

After the original bill is answered the plaintiff must answer the cross-bill, and until this is done the cause will not be heard.[5] If the plaintiff withdraws the action after a cross-bill has been filed and served upon him, a decree *pro confesso* on the cross-bill may be taken by the defendant.[6]

§ 1122. Supplemental Bills.

Whenever any action in equity becomes defective after the filing of the original bill, whether by a change of the persons interested in the subject-matter of the suit, or by the occurrence of events enlarging or diminishing the rights of the parties, or whenever the plaintiff discovers facts essential to the proper decision of the controversy concerning which he had no information at the commencement of the action, he may file a supplemental bill alleging the new matter and thereby making it a part of his original claim.[1] A supplemental bill must not vary the character of the suit or the cause of action; and can be filed only by leave of the court, for sufficient reasons and upon proper notice to the defendant.[2] In actions in equity for infringement this method of amending the proceedings to suit the changing circumstances of the case is frequently employed. Thus where the plaintiff becomes bankrupt or assigns his interest in the patent and the compensation for past infringements, pending suit, a supplemental bill is necessary on behalf of the trustee in insolvency or the assignee.[3] Where

defendants as a measure of damages, if the licensed defendants file a cross-bill for a surrender of the license, there is no authority for a notice to non-residents by publication, see Loom Co. *v.* Short (1876), 10 O. G. 1019.

[5] Equity Rule 72.

[6] That a decree *pro confesso* will be entered on the cross-bill if the plaintiff, having been served or appearing to answer, withdraws the original bill, see Lowenstein *v.* Glidewell (1878), 5 Dillon, 325.

§ 1122. [1] Equity Rule 57.

That a bill in the nature of a supplemental bill is proper where there has been a change of interest in the subject-matter, see Tappan *v.* Smith (1863), 5 Bissell, 73; Hoxie *v.* Carr (1832), 1 Sumner, 173.

That matter subsequently occurring may be set up by supplemental bill, see Copen *v.* Flesher (1861), 1 Bond, 440.

[2] That the character of the suit cannot be changed after the hearing by a supplemental bill, see Snead *v.* McCoull (1851), 12 How. 407.

That leave of the court must be obtained and due notice given, see Equity Rule 57.

[3] That if the plaintiff becomes bankrupt pending suit, a supplemental bill may be needed unless the plaintiff has re-acquired the right of action, see Gear

other persons than those named in the original bill are found to have been participants in the infringing acts, or where new persons become interested in the infringing enterprise, a supplemental bill brings them before the court and joins them as defendants in the original action.[4] If the defendant has been guilty of additional infringements since the institution of the suit, these may be incorporated in the cause of action by a supplemental bill at any time before the plaintiff's evidence is closed.[5] When the patent is extended during the litigation, and the infringement continues under the extension, a supplemental bill based on the extension may be filed, and the plaintiff can then recover for the entire injury in the single action.[6] When the plaintiff obtains a rehearing after the dismissal of his bill, upon the ground of newly discovered evidence, a supplemental bill is necessary, setting up the evidence and showing that it is material and could not have been produced by reasonable diligence on the former trial.[7] Whether a supple-

v. Fitch (1878), 16 O. G. 1231; 3 Bann. & A. 573.

That if the original complainant and assignor dies, the assignee may file a supplemental bill, see Metal Stamping Co. *v.* Crandall (1880), 18 O. G. 1531.

[4] That when a plaintiff, on a motion for leave to file a supplemental bill to add a new defendant, avers that he is informed and believes that the new defendant has obtained an interest in the infringing devices and is using them it is sufficient, see Parkhurst *v.* Kinsman (1848), 2 Blatch. 72.

[5] That new matters concerning the original defendants, and a prayer for discovery thereon, may be inserted in a supplemental bill to bring in a new defendant, see Parkhurst *v.* Kinsman (1848), 2 Blatch. 72.

That a subsequent bill, alleging new infringements since the original bill was filed, may be received after the answer is made and the plaintiff's *prima facie* case is proved, and the evidence already in will then be applied as far as it is relevant, see Turrell *v.* Spaeth (1876), 9 O. G. 1163; 2 Bann. & A. 315.

[6] That a supplemental bill is proper when an extension is granted during the suit, see Reedy *v.* Scott (1874), 23 Wall. 352; 7 O. G. 463.

That where a patent expired during suit and was extended, and a supplemental bill was filed, and then the patent was re-issued, and a supplemental bill was filed on the re-issue, and on the latter bill a hearing was had, the proceedings were allowed, see Howe *v.* Williams (1863), 2 Fisher, 395; 2 Clifford, 245.

[7] That a supplemental bill, after the dismissal of the original, praying for a hearing on the ground of new evidence, etc., must allege and show that the evidence could not have been obtained before the former hearing with reasonable diligence, and that the evidence is material, see Spill *v.* Celluloid Mfg. Co. (1884), 22 Fed. Rep. 94; 22 Blatch. 441; 29 O. G. 773.

mental bill can be filed upon the re-issue of the patent, pending suit, has been disputed, — some decisions asserting that the action fails and an original bill on the new patent becomes necessary;[8] others declaring that although no damages or profits can now be recovered for the infringement of the original patent, the plaintiff may avail himself of the presence of the parties in the court, and continue the action under a supplemental bill.[9] The right to object to this mode of procedure, if such right exists, may, however, be waived by the defendant, and if he acquiesces in a hearing on the re-issue under a supplemental bill, he cannot afterwards take advantage of the error.[10] The supplemental bill need not repeat the allegations of the original, but may contain additional averments of the same general character, and state new matters constituting the same cause of action.[11] The defendant may demur, plead, or answer to a supplemental bill in the manner and for the reasons heretofore described in reference to the original.[12]

§ 1123. Amendments to Bill or Answer.

Before the filing of the replication amendments may be made, as a matter of right, in the bill or answer, but after replication no material alteration in either is allowed, except by leave of the court upon notice to the adverse party.[1] Leave

[8] That when a patent is re-issued pending suit, no supplemental bill can be filed on the re-issue, but the suit abates and a new bill must be filed, see Fry *v.* Quinlan (1875), 13 Blatch. 205; Reedy *v.* Scott (1874), 23 Wall. 352; 7 O. G. 463.

[9] That a supplemental bill, counting on a re-issue, may be filed after the original patent has expired, if the original bill was filed during the life of the patent, see Dental Vulcanite Co. *v.* Wetherbee (1866), 3 Fisher, 87; 2 Clifford, 555; Howe *v.* Williams (1863), 2 Fisher, 395; 2 Clifford, 245.

That a bill may be amended to count on the last re-issue, see Reay *v.* Rayner (1884), 19 Fed. Rep. 303; 26 O. G. 1111; 22 Blatch. 13.

[10] That when a patent is re-issued pending suit, a supplemental bill setting up the re-issue cannot be filed, a new original bill being necessary unless the defendant acquiesces in a different course; but if a supplemental bill is filed and the hearing goes on without objection, the proceedings are valid, see Reedy *v.* Scott (1874), 23 Wall. 352; 7 O. G. 463.

That where a disclaimer pending suit does not materially change the nature of the cause, a supplemental bill and new motion for an injunction are not required, see Libbey *v.* Mt. Washington Glass Co. (1886), 26 Fed. Rep. 757; 36 O. G. 572.

[11] Equity Rule 58.

[12] Equity Rule 57.

§ 1123. [1] Equity Rules 28, 29, 60.

That defects in a bill or answer must

to amend will not be granted where the proposed amendment could with reasonable diligence have been sooner introduced, nor where it changes the character of the pleading, or is evidently offered for the purpose of delay.[2] The authority to permit amendments is conferred upon the court for the furtherance of justice, and to relieve the parties from the consequences of their unavoidable ignorance or mistake, and this authority may be exercised at any stage of the proceedings when its necessity becomes apparent. Thus where the evidence discloses that the description of the parties in the bill is incorrect, or that a different re-issue is in force from the one recited in the bill, or where the allegations of a bill brought by an assignee are broad enough to embrace, but do not specifically mention, claims for past infringements, or where the answer and the defendant's proof set up new matter in avoidance of his liability for the infringing acts, the plaintiff may amend the bill by the correction of the error, the enlargement of the insufficient allegation, or the insertion

be cured by amendment not by special motion, see Doughty *v.* West (1865), 2 Fisher, 553.

That a bill counting on one of two patents which together cover the infringing invention may be amended to count on both and the evidence already taken will be applied thereto, see Underwood *v.* Gerber (1889), 37 Fed. Rep. 796.

[2] That a motion to amend the answer will be denied if the new matter is not relevant or material, or could by due diligence have been put in the original answer, see Richardson *v.* Croft (1881), 20 O. G. 372.

That there is no good cause for allowing an amendment, under the 60th and 29th rules in equity, so as to introduce a new defence into the answer, if the same matter could with reasonable diligence have been set up in the origiual, see India Rubber Comb Co. *v.* Phelps (1870), 4 Fisher, 315; 8 Blatch. 85.

That where the same search would have shown the same facts; before as well as since the original answer was filed, there is no ground for an amendment, see India Rubber Comb Co. *v.* Phelps (1870), 4 Fisher, 315; 8 Blatch. 85.

That an amendment changing the character of the bill is not usually allowed after a hearing, or after the case is set down for a hearing, see Tremaine *v.* Hitchcock (1874), 23 Wall. 518; 7 O. G. 1055.

That where the new defence rests on parol evidence only, the courts will disfavor an amendment to introduce it, as tending to encourage the manufacture of testimony, see India Rubber Comb Co. *v.* Phelps (1870), 4 Fisher, 315; 8 Blatch. 85.

That a motion to amend the answer and for a commission to take evidence abroad will not be granted when the proof before the court shows that no evidence to sustain the amendment can be obtained, see Hicks *v.* Otto (1883), 17 Fed. Rep. 539.

of new facts to meet the evidence and answer of the defendant.[3] In like manner, where the evidence shows that the answer is insufficient, as by its failure to state all the available defences, or to recite the names and residences of all the persons who made prior use of the invention, or that it contains unfounded admissions to the detriment of the defendant, amendments may be made to render the answer conformable to the proof, unless the other evidence clearly indicates that on the case, taken as a whole, the plaintiff cannot be defeated.[4] The amendment of the pleadings does

[3] That where the evidence shows that the *status* of parties has been misdescribed, it can be cured by amendment, see Needham *v.* Washburn (1874), 7 O. G. 649; 4 Clifford, 254; 1 Bann. & A. 537.

That where the bill set up one re-issue, but all the evidence and references were based upon a second re-issue, an amendment in the bill inserting the second re-issue will be allowed, see Tremaine *v.* Hitchcock (1874), 23 Wall. 518; 7 O. G. 1055.

That an assignee of the patent, in a suit against an alleged infringer, can move, before the signing of the interlocutory decree, to amend his bill so as to include the subject of assigned claims for damages and profits which were due to *mesne* assignors, where it appears that the bill was brought, answered, and tried on the theory that a recovery on those assigned claims was sought, see New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1884), 20 Fed. Rep. 505; 22 Blatch. 182.

That if the defendant pleads a license and the plaintiff claims that he has abandoned it, the plaintiff must amend his bill and set up the abandonment, see Wilson *v.* Stolley (1847), 4 McLean, 275.

[4] That an answer may be amended by inserting a new defence on a motion offered before final argument, and a decree may be entered subject to the finding on such new defence, see Snow *v.* Tapley (1878), 13 O. G. 548; 3 Bann. & A. 228.

That where the evidence clearly shows that the patent is invalid the court may permit the answer to be amended so as to give proper notice of it, see Geier *v.* Goetinger (1874), 7 O. G. 563; 1 Bann. & A. 553.

That a motion to insert new defences in the answer in equity will be denied after an answer has been made under oath and the evidence thereon is closed, unless the defendant is without fault, see Loom Co. *v.* Higgins (1876), 9 O. G. 965; 13 Blatch. 349.

That an answer failing to name the persons using, under a defence of prior use, may be excepted to and amended under special order, see Graham *v.* Mason (1869), 5 Fisher, 1; 4 Clifford, 88.

That an admission in the answer that the defendants had made certain articles which the plaintiff was seeking to enjoin may be struck out, if a denial of the validity of the patent is to be made and no testimony has yet been taken, and the defendants are not guilty of laches, see Morehead *v.* Jones (1860), 3 Wall. Jr. 306.

That a defendant having in a former stage of the suit defended on the ground that he owned the patent, and admitted its infringement and its extent, and

not render evidence admissible if when taken it was inadmissible and properly objected to; but evidence taken without objection in the presence of the adverse party may be received and considered under the amendment.[5]

§ 1124. Trial, Various Modes of.

Issues of fact, in actions in equity for infringement, are always determined by the court, in accordance with its own views as to the significance and weight of the evidence presented.[1] Various methods of investigating facts exist. The

been defeated, cannot amend his answer after account taken on the ground that such admission was a mistake, and contest the infringement or the extent of it before the master, see Ruggles *v.* Eddy (1874), 11 Blatch. 524; 1 Bann. & A. 92.

That a defendant who, in one suit between him and the plaintiff, has consented to a decree with substantial damages, and has given the plaintiff an agreement acknowledging the validity of the patent and the novelty and utility of the invention, cannot on the second suit amend his answer to insert a denial of novelty and attack the patent, see Pentlarge *v.* Beeston (1878), 15 Blatch. 347.

That after a verdict and refusal of new trial, a feigned issue may be ordered in equity on new evidence, and the answer may be amended to insert it, see Foote *v.* Silsby (1850), 1 Blatch. 545.

That where the evidence shows that the plaintiff's patent cannot be defeated on final hearing, a motion to amend the answer will be denied, see Richardson *v.* Croft (1880), 11 Fed. Rep. 800.

That evidence offered without notice and objected to may be admitted after amendment by agreement when the omission of notice was inadvertent and the plaintiff was not taken by surprise, see Roberts *v.* Buck (1873), 6 Fisher, 325; 3 O. G. 268; Holmes, 224.

That when evidence as to prior use was taken before the answer was amended to give proper notice of it, against objection but with full rebutting evidence and cross-examination, it was allowed to stand, see Allis *v.* Buckstaff (1882), 13 Fed. Rep. 879; 22 O. G. 1705.

That unless evidence not covered by the answer is objected to when offered, if the plaintiff is present, the defendant may amend his answer to cover it without costs, see Brown *v.* Hall (1869), 3 Fisher, 531; 6 Blatch. 401.

That an amendment of a plea making it double will not be allowed after long delay, see Giant Powder Co. *v.* Safety Nitro-Powder Co. (1884), 19 Fed. Rep. 509; 27 O. G. 99; 10 Sawyer, 23.

That a paper filed without leave to amend cannot be treated as an amendment of the original answer, see Dental Vulcanite Co. *v.* Wetherbee (1866), 2 Fisher, 87; 2 Clifford, 555.

[5] That an amendment of an answer under leave of court does not render evidence admissible which was properly objected to before the amendment, see Allis *v.* Buckstaff (1882), 22 O. G. 1705; 13 Fed. Rep. 879; Roberts *v.* Buck (1873), 3 O. G. 268; Holmes, 224; 6 Fisher, 325.

§ 1124. [1] This is equally true whatever be the mode of trial. If the court hears the evidence, either directly or through depositions, its decision upon the facts is at once primary and

court may hear the testimony of the witnesses orally, or it may be offered in the form of depositions.[2] Feigned issues may be framed and sent to a jury in a court of law, or submitted to a special jury impanelled in the court of equity.[3] If the witnesses are examined in open court before the judge alone, the procedure is the same as in any other *viva voce* trial. Depositions are taken before some proper officer, or other person appointed for that purpose by the court or by the parties, and transmitted in the usual manner to the clerk for publication and for presentation to the court in connection with the arguments of counsel.[4] The trial of feigned issues to a jury, whether in the court of equity or law, is a proceeding of a peculiar character, and in reference to patent cases is still of practical importance.

§ 1125. Trial by Jury on Feigned Issues.

In the earlier periods of patent litigation the courts of equity, in deference to the statute of Jac. I., referred all questions concerning the patentability of the invention, the validity of the patent, the title of the plaintiff, the fact of infringement, and the amount of damages, to the decision of the courts of law, and afforded equitable relief only for the protection of the plaintiff during the litigation and for the final. Where the facts are first passed upon by a jury, whether on a feigned issue at law or under the act of 1875, the verdict is merely advisory, and may be departed from by the court. See Watt *v.* Starke (1879), 101 U. S. 247; 17 O. G. 1092; Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351; Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64.

[2] That the court may hear the testimony directly, see Blease *v.* Garlington (1875), 92 U. S. 1; *In re* Clark (1872), 9 Blatch. 372.

That evidence may be taken by depositions, see Equity Rules 67–69.

That a secret trial of a patent suit cannot be allowed, see Opinion Atty. Gen. (1820), 1 Op. Att. Gen. 376.

[3] That a feigned issue may be ordered, see Gray *v.* Halkyard (1886), 23 Fed. Rep. 854; 38 O. G. 784; also § 1125 and notes, *post*.

That a special jury may be employed in patent cases in equity, see act of Feb. 16, 1875, Sec. 2.

That a jury trial under Sec. 2, act of 1875, is matter of discretion not of right, see Keyes *v.* Pueblo Smelting and Refining Co. (1887), 31 Fed. Rep. 560.

That priority and public use are questions of fact, and may properly be submitted to a jury by a court of equity, see Gray *v.* Halkyard (1886), 38 O. G. 784; 28 Fed. Rep. 854.

[4] Equity Rules 67–69.

enforcement of the judgment after it had been obtained.[1] When, at a later period, equity assumed a more immediate jurisdiction over this class of cases it still regarded a jury as the proper tribunal, and a court of law as the proper forum, for the investigation of the most important issues, and therefore, having framed these issues in a form to suit its purposes, sent them into the court of law for trial and received the verdict of the jury as the determination of the matters it embraced.[2] But even this modification of the ancient practice has, during the past half-century, almost disappeared, and at the present day equity usually conducts its inquiries within its own tribunals. When it requires the assistance of a jury, as in some cases it still may do, the act of 1875 enables it to summon and impanel one consisting of not less than five nor more than twelve persons, to present to them such issues as it deems expedient, and to proceed upon their verdict in the same manner as if the issues had been tried at law.[3] The submission of feigned issues to a jury is now a matter entirely within the discretion of the court, and no appeal will lie from its refusal, although on an appeal for other causes the court above may send the cause back for a jury trial, if it seems expedient.[4] It is not ordered at the

§ 1125. [1] As to the early relation of trials at law to equity proceedings in patent cases, see § 932 and notes, *ante*.

[2] As to the later relation of trials at law to patent cases in equity, see § 932, 1081–1084, and notes, *ante*.

[3] Act of Feb. 16, 1875, Sec. 2.

[4] In Brooks *v.* Norcross (1851), 2 Fisher, 661, Woodbury, J.: (662) "It is requested, as a preliminary favor or right, that the question of infringement in this case be tried by a jury. I am not aware of any trial of that kind which is allowed in any way in chancery, as a matter of right to a party, unless it be in case of a bill in chancery to abate a nuisance which is of a public character, and which some individual claims to injure himself specially. There, if the nuisance be denied, courts will usually decline to sustain a private complaint to abate it, if the question of nuisance be not first settled at law and by a jury. (Irwin *v.* Dixon, 9 How. 10, and in cases cited there.) Such is not the class to which the present case belongs. Another set of instances, where a jury is ordered in chancery, is to try particular facts, and not to settle at law a question of right. It is, too, with a view to settle facts on which the court feels doubt, and itself wishes the aid of a jury to do it, and not where the party applies for a jury either as a right or a favor. This is the most numerous class of cases where a jury is used. (7 How. 227, McLaughlin *v.* Bank of Potomac *et al.* 3 Story R. 746.) In the argument of counsel, it seems to be conceded that the allowance of a jury to settle at

request of the parties, nor until the court finds itself unable otherwise to ascertain the facts, and this may not occur before the evidence has been published.[5] It is more readily law the question of infringement is regarded not as a right, but a matter in the sound discretion of the court. This, too, is the adjudged law in instances of that character. (Pierpont *v.* Fowle, 2 W. & M. 25, 37; Saunders *v.* Smith, 3 Mylne & Craig, 735; Jacobs, 311.) But this discretion must, of course, be regulated by sound reasons. And though an English Chancellor has said he remembered no case where the trial at law was refused when wished, it is certain there have been many. The chief test is, whether the *chancery court* entertains any reasonable doubt as to the law or fact, and wants them ascertained for its aid. (Curtis on Pat. 383; Web. Pat. Cas. 473.) And if a trial is ordered at law, to remove doubts or settle contested rights, before a final decision in chancery, the latter court will still often issue the temporary injunction, founded on long possession of the patent, or other *prima facie* evidence, till a decision is had at law. (Web. Pat. Cas. 730; Curtis on Pat. 381; 14 Ves. 130; 8 Merivale, 622.) Most of the patent cases where the court has deemed it proper to dissolve an injunction, or refuse one till the parties' rights are settled at law, are those where the defendant denies the plaintiff's right in his answer, and the recoveries against other persons, and numerous sales and long possession, have not been such as to raise a strong presumption that the patent is valid. (Orr *v.* Littlefield, 1 W. & M. 13; Woodworth *v.* Edwards *et al.*, 3 W. & M. 120, and cases there cited, 2 Eden, Ch. 137; Curtis on Pat. 339; Web. Pat. Cas. 472; Hindmarch on Pat. 30–37.)" See also Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64.

That a feigned issue may be sent to a jury on mere questions of fact, see Gray *v.* Halkyard (1886), 23 Fed. Rep. 854; 38 O. G. 784.

That feigned issues are not favored in our courts, see Cochrane *v.* Deener (1876), 94 U. S. 780; 11 O. G. 687.

That in the Federal courts, the judge being the same at law and in equity, there is no such reason for sending cases to the jury as in England, see Brooks *v.* Norcross (1851), 2 Fisher, 661.

That it is a matter of discretion, not jurisdiction, whether chancery will send a case to be tried at law, and a decision thereon is no ground of appeal, though if an appeal be taken on other grounds, and it appears that the case ought to be tried otherwise, it can be sent back for that purpose, see Cochrane *v.* Deener (1876), 94 U. S. 780; 11 O. G. 687.

[5] That an issue at law will not be ordered on the mere request of the parties, see Brooks *v.* Norcross (1851), 2 Fisher, 661.

That an order for jury issues will not be granted when the truth of the matters in dispute can be conveniently and satisfactorily ascertained by the court itself, see Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351; Brooks *v.* Norcross (1851), 2 Fisher, 661.

That no jury issue as to infringement will be ordered unless the court has doubts as to the identity of the devices, see Van Hook *v.* Pendleton (1846), 1 Blatch. 187.

That a suit at law may be ordered on an answer which does not set out the names of the persons in prior use or knowledge, but the pleadings in the suit at law must set them out, see Orr

allowed when the patent is recent, the novelty of the invention doubtful, the identity of the infringing process or device with that covered by the patent uncertain, and the proof conflicting or the credibility of the witnesses disputed.[6] It is not often resorted to when the patent and the infringement have already been established by a verdict.[7]

§ 1126. Effect of the Verdict on a Feigned Issue.

During the trial of a feigned issue in a court of law equity will not interfere with the proceedings.[1] It may send with the record of such issues the depositions already taken to be used as evidence, but other depositions will not be admitted except when obtained in conformity with the ordinary rules of law.[2] The verdict of the jury is advisory only, and may

v. Morrill (1846), 1 W. & M. 376; 2 Robb, 331.

That an order for issues to the jury will not be made until the evidence is taken and publication has passed, see Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351.

[6] That equity grants a motion for jury issues when the patent is new and novelty uncertain, or when the case depends on conflicting evidence or the credibility of witnesses, see Howe *v.* Williams (1863), 2 Fisher, 395; 2 Clifford, 245.

[7] In Howe *v.* Williams (1863), 2 Fisher, 395; Clifford, J.: (398) "Such a motion is sometimes granted, where the patent is recent, and where the case shows that the originality of the invention is doubtful; or where the merits of the controversy chiefly depend upon contradictory evidence, involving the credibility of witnesses; but where the patent is of long standing, and the inventor has had an exclusive possession under it, the motion is seldom received with any favor. (Washburn *et al.* *v.* Gould, 3 Story C. C. 169; Hill *v.* Thompson, 3 Meriv. 622; Collard *v.* Allison, 4 Mylne & Cr. 487.) Other examples where such a motion was granted are also shown in some of the numerous cases cited by the respondent, but it is a sufficient answer to all such decisions, as applied to this case, to say that the motion ought not in general to be granted where it appears that a trial at law and a hearing in equity have already been had, and that both have resulted in favor of the complainant; and the motion is accordingly overruled. Goodyear *v.* Day, 2 Wall. Jr. 296." 2 Clifford, 245 (246).

§ 1126. [1] That when chancery suspends, in order to allow a case to be tried at law, it does not interfere with the proceedings at law, see Watt *v.* Starke (1879), 101 U. S. 247; 17 O. G. 1092.

[2] That on the trial of feigned issues, depositions *de bene esse*, taken without notice to the opposite party, are not admissible unless they are sent down with the record of the issues framed on the equity side of the court, see Cahoon *v.* Ring (1861), 1 Clifford, 592.

That after a decree ordering jury issues and the sending of the record to the court of law, the court of law will not order any depositions taken in equity to be removed to the law court unless they were sent down with the

be discarded in the court of equity and a contrary judgment rendered.[3] A motion for a new trial for a verdict against evidence must be made to the judge in chancery, and may be supported by the record and proof of the testimony as given in the court of law.[4] After the verdict the defeated party may proceed in the cause in equity, and introduce further evidence unless the time for taking evidence is past; and for this purpose, where an order for feigned issues is made before the time for taking evidence expires, the time will be extended until after the verdict is rendered and a sufficient opportunity has been afforded for additional testimony.[5]

record, nor will they be admitted as evidence, see Cahoon *v.* Ring, (1861), 1 Clifford, 592.

That on the trial of feigned issues as to novelty Office copies of the plaintiff's correspondence with the Patent Office, as to the re-issue or its construction, are not admissible evidence, see Cahoon *v.* Ring (1861), 1 Clifford, 592.

That a respondent cannot be asked a question on the trial of a feigned issue, if the reply which it calls for would contradict an admission in his answer, see Cahoon *v.* Ring (1861), 1 Clifford, 592.

That if feigned issues present no question of fraud or mistake, and the bill is based on a re-issued patent, the original is not admissible, see Cahoon *v.* Ring (1861), 1 Clifford, 592.

[3] That the verdict of a jury in a cause sent from chancery, being only advisory and never conclusive, may be disregarded, and a decree rendered contrary to it, see Watt *v.* Starke (1879), 101 U. S. 247; 17 O. G. 1092; Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351; Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64.

[4] That when chancery sends an issue to law for a trial on the facts, a motion for a new trial must be made to the court of chancery, and notes of the proceedings and evidence at law must be submitted to the chancellor, see Watt *v.* Starke (1879), 101 U. S. 247; 17 O. G. 1092.

That a bill of exceptions cannot be taken on the trial of a feigned issue directed by a court of equity, or if taken can only be used on a motion for a new trial, see Watt *v.* Starke (1879), 101 U. S. 247; 17 O. G. 1092.

That the proceedings and evidence at law may be brought to the notice of the chancellor either by having them reported with the verdict or by moving the chancellor to send to the judge at law for his notes or by any other proper way, and they then become part of the record, see Watt *v.* Starke (1879), 101 U. S. 247; 17 O. G. 1092.

[5] That the verdict on jury issues is never final, but the defeated party may proceed in the cause and if the evidence is not closed under the rules, or if the court grants leave, he may introduce further proof to support his claims, see Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351.

That when feigned issues are ordered before the time for taking the evidence expires, no decree after verdict on such issues will be ordered until further time for taking evidence is given, see Cahoon *v.* Ring (1861), 1 Clifford, 592.

§ 1127. Evidence Admissible in Equity.

The evidence admissible in equity upon the various issues created by the bill and answer is the same as that receivable at law upon the corresponding issues.[1] The burden of proof rests upon the plaintiff as to all the material averments of his bill, and upon the defendant as to matters of avoidance or estoppel or the subordination of a legal to his equitable rights.[2] The parties are competent witnesses on either side, and neither, by summoning and examining the other waives

§ 1127. [1] For the evidence admissible on each issue, see §§ 1022–1049, and notes, *ante*.

[2] That the court cannot notice what is merely alleged and not proved, see Blandy *v.* Griffith (1869), 3 Fisher, 609.

That the burden of proof on all matters necessary to sustain the action rests on the plaintiff, see § 1018 and notes, *ante*.

As to the *prima facie* evidence afforded by the patent, see § 1016 and notes, *ante*.

That whatever is averred in the bill and not denied in the answer is admitted, and need not be further proved, see §§ 1114–1118 and notes, *ante*.

That the burden of proof on the question of infringement rests on the appellant, and if he fails in it the decree will be affirmed, see Price *v.* Kelley (1881), 20 O. G. 1452; 13 Fed. Rep. 304.

That if the defendant denies infringement the plaintiff must prove it, see Francis *v.* Mellor (1871), 8 Phila. 157; 5 Fisher, 153; 1 O. G. 48.

That infringement may be found, as against the defendant's sworn denial in his answer, upon circumstantial evidence, though no direct act of infringement can be proved, see Peterson *v.* Simpkins (1885), 25 Fed. Rep. 486; 33 O. G. 1392.

That if the plaintiff does not object to the defendant's answer, on the ground that it merely denies information as to the validity of the patent and disputes the damages, the plaintiff takes the burden of proving the infringement, see Wooster *v.* Muser (1884), 20 Fed. Rep. 162; 28 O. G. 286.

That defences set up in the answer, if the burden is on the defendant, are not noticed unless some proof is offered in their support, see Cook *v.* Howard (1870), 4 Fisher, 269.

That the burden of proving an equitable against a legal title is on the affirmant, and his pleadings must deny that the plaintiff is a *bona fide* holder for value without notice, see Gibson *v.* Cook (1850), 2 Blatch. 144.

That in equity the court may inspect a model of the invention, and upon inspection declare it unpatentable, see Everett *v.* Thatcher (1878), 16 O. G. 1046; 2 Flippin, 234; 3 Bann. & A. 435.

That a court of equity has power to order an inspection of infringing or controverted inventions, see Wilson *v.* Keely (1888), 43 O. G. 511.

That the plaintiff's affidavits offered in rebutter must not strengthen his case as to the infringement, thus creating a danger of surprise to the defendant if allowed, see Union Paper Bag Mach. Co. *v.* Binney (1871), 5 Fisher, 166.

That exhibits not properly explained and applied will not be considered, see Miller *v.* Smith (1880), 5 Fed. Rep. 359; 18 O. G. 1047.

any claim against him.[3] The plaintiff may compel the defendant to produce the books by which infringing sales are evidenced, but cannot, under the preliminary proof, force him to disclose the details of his business and give the names of confidential customers.[4] One party, whose deposition is being taken by the other, has a right to decline to answer questions which he deems improper and his replies to which might prejudice his interests, and to refer his objections to the court to be decided before the examination can proceed.[5] An answer under oath, if responsive to the bill, not only makes but proves the issue and requires two witnesses, or their equivalent, to overthrow it.[6] An irresponsive answer is an admission of the truth of the averments of the bill, and an equivocal answer, especially on the question of infringement, affords such strong presumptions in favor of the plaintiff that little further evidence is necessary to support his allegations.[7] Direct admissions in the answer are conclusive evidence against the defendant.[8] A bill *in perpetuam* in one Federal court, with the

[3] That the plaintiff does not waive his rights against the defendant by making him his witness, see Jenkins *v.* Greenwald (1857), 2 Fisher, 37 ; 1 Bond, 126.

[4] That the books of the defendant may be ordered produced, see Roberts *v.* Wolley (1882), 14 Fed. Rep. 167.

That when the infringement and validity are denied the plaintiff cannot compel the defendant, on the preliminary proof, to give him the names of more than one of his confidential customers to whom he furnished articles covered by the patent, see Roberts *v.* Wolley (1882), 14 Fed. Rep. 167.

[5] That an examiner has no power to rule on the evidence, and the defendant, when a witness, has the right to take the opinion of the court in a doubtful case, and when he acts in good faith under the advice of counsel he cannot be punished for contempt, see Roberts *v.* Wolley (1882), 14 Fed. Rep. 167.

[6] For the effect of an answer under oath, see § 1119 and notes, *ante*.

[7] That an answer is not evidence as to matter not responsive to the interrogatories, and if the allegations of the answer are not responsive to the interrogatories or sustained by other evidence, the plaintiff has judgment, see Wren *v.* Spencer Optical Mfg. Co. (1879), 18 O. G. 857 ; 5 Bann. & A. 61.

That unless the denial of infringement in the answer under oath is positive and unequivocal, the testimony of a single witness, with corroborating facts, is sufficient proof of the infringement, see Goodyear *v.* Berry (1868), 3 Fisher, 439 ; 2 Bond, 189.

[8] As to the effect of admissions in the answer, see § 1118 and notes, *ante*.

That when the defendant by an answer in regard to date seemed to admit an infringement on which there was no other evidence, but denied the infringement constantly, the answer was not sufficient to prove it, see Reay *v.* Rau

evidence taken under it, may be received in any other.[9] Evidence admissible at law only under a special notice cannot be introduced in equity unless the same notice has been given by the answer.[10]

§ 1128. Method of Producing Evidence in Equity: Objections: Exceptions.

When the trial of an action in equity is conducted in open court, whether with or without a jury, the methods of offering and objecting to evidence follow those which are pursued in courts of law. But when the testimony is taken by deposition, according to the usual practice in courts of equity, different rules prevail. In such cases the court fixes a period within which each party shall complete his evidence, and appoints some proper officer or other person as an examiner to receive the testimony and transmit it to the court.[1] Under this order, if the plaintiff fails to take his evidence within the time prescribed, and does not apply for an extension, the court may proceed with the cause and determine it upon the pleadings as they stand.[2] Evidence taken after the appointed time will

(1883), 15 Fed. Rep. 749; 23 O. G. 1928.

That the defendant does not admit his infringement by accepting service of an injunction, giving bond, and acknowledging the validity of the patent and the plaintiff's title, but the presumption arising from these acts may be rebutted, see Byam *v.* Eddy (1853), 24 Vt. 666; 2 Blatch. 521.

[9] That a bill *perpetuam rei memoriam* to take evidence for the defendant of a witness over ninety on a matter twelve years before the patent issued, if the plaintiff will not sue at once, is proper, and the evidence thus taken in a Federal court is admissible in any other Federal court, see New York & Baltimore Coffee Polishing Co. *v.* New York Coffee Polishing Co. (1881), 20 Blatch. 174; 9 Fed. Rep. 578.

[10] That the statutory defences of which notice is required at law must be set up in equity in the answer, or evidence concerning them is inadmissible, *see* §§ 1114–1116, and notes, *ante*.

§ 1128. [1] Equity Rules, 67–71.

That affidavits cannot be entitled in the cause before the bill is filed though they may be taken, see Baldwin *v.* Bernard (1872), 5 Fisher, 442; 2 O. G. 320; 9 Blatch. 509, note.

That affidavits not entitled in the cause are mere extra-judicial oaths and not receivable, see Buerk *v.* Imhaeuser (1876), 10 O. G. 907.

That when expert evidence is desired an application to put it in must be made before the first hearing, see Hitchcock *v.* Tremaine (1872), 1 O. G. 633; 5 Fisher, 537; 9 Blatch. 550.

[2] That if the plaintiff fails to take evidence within the prescribed time, and does not apply for an extension, the court will proceed to determine the case on the pleadings as they stand,

be considered, unless a motion to suppress it is presented; but if objected to the court will ordinarily reject it, though where no injury could result to the opposing party, it may be allowed to remain.[3] Inadmissible evidence must be objected to when it is offered before the examiner, if the adverse party is then present, and the objection must be entered on the record of the testimony to be transmitted with it to the court.[4] Every

see Irwin *v.* Meyrose (1881), 2 McCrary, 244; 7 Fed. Rep. 533.

[3] That under Rule 69 no evidence taken after the time can be read at the hearing if the other party objects, see Wooster *v.* Clark (1881), 21 O. G. 264; 9 Fed. Rep. 854.

That when a defendant offers no evidence to sustain his defence of prior use, and after the evidence is closed and the plaintiff has made out his case, the defendant without amending his answer, or obtaining an extension of time, files affidavits of public use, they are too late and are not regarded, see Union Paper Bag Mach. Co. *v.* Nowell (1874), 5 O. G. 459; 1 Bann. & A. 118; 11 Blatch. 549.

That if evidence is taken and filed out of time without any motion to suppress it, it may be considered, see Matthews *v.* Spangenberg (1882), 19 Fed. Rep. 823; 23 O. G. 92; 20 Blatch. 482.

That evidence taken without objection may stand on an amended answer, see Babcock *v.* Pioneer Iron Works (1888), 34 Fed. Rep. 338.

That under Rules 66 and 69 the court has discretion to direct that a replication filed and evidence taken after the time named in Rule 66 shall stand as if filed and taken within the time, see Fischer *v.* Hayes (1881), 20 O. G. 239; 6 Fed. Rep. 76; 19 Blatch. 26.

That when depositions were taken in conformity with a special order as to notice, and the adverse party had no time to confer with his counsel and attend, they will be admitted on condition that the opposite party have a chance to take them over again and cross-examine, see Aiken *v.* Bemis (1847), 3 W. & M. 348; 2 Robb, 644.

[4] That objections must be distinctly made when the evidence is presented or they will be waived, see Barker *v.* Stowe (1878), 15 Blatch. 49; 14 O. G. 559; 3 Bann. & A. 337.

That if a party is present at an examination of witnesses, and does not object to the evidence on the ground of a want of averment in the answer, he cannot take advantage of the defect at the hearing, see Brown *v.* Hall (1869), 3 Fisher, 531; 6 Blatch. 401.

That witnesses produced as to prior use without notice must be objected to when the testimony is taken or the evidence will be admitted, see Roemer *v.* Simon (1874), 5 O. G. 555; 1 Bann. & A. 138.

That if the defence of prior invention is not set out in the answer as it should be, and no objection is made at the proper time, it cannot be excepted to in the Supreme Court after appeal, see Loom Co. *v.* Higgins (1882), 105 U. S. 580; 21 O. G. 2031.

That objections to the admissibility of evidence must appear on the record, or they will be considered as waived, see Fischer *v.* Neil (1881), 19 O. G. 603; 6 Fed. Rep. 89.

That if there is no objection on the record to hearsay evidence the objection will be waived, see Fischer *v.* Neil (1881), 6 Fed. Rep. 89; 19 O. G. 603.

objection must specifically state the grounds on which it rests, and every ground not stated will be waived.[5] Evidence not objected to can be employed only for purposes for which it is legally admissible.[6] Objections to the competency of witnesses, or to their introduction under the pleadings as they are framed, or to the authenticity of documentary evidence, must be fully disclosed in order that, if possible, the obstacle may be removed.[7] When the record of the testimony with the objections is returned to court, the inadmissible evidence may be struck out on motion; or if the inadmissibility arises from the want of proper averments in the bill or answer, the defects may be amended and the evidence may be then received or the cause sent back to the examiner for a repetition of the testimony.[8] A motion to suppress the evidence of a

[5] That a general objection to evidence is not considered unless the ground of objection is specified, and if the ground of objection is specified all other grounds are waived, see Fischer *v.* Neil (1881), 19 O. G. 603; 6 Fed. Rep. 89; Brown *v.* Hall (1869), 3 Fisher, 531; 6 Blatch. 401.

[6] That evidence not objected to can only be used for the purpose for which it is admissible, see Zane *v.* Soffe (1880), 2 Fed. Rep. 229.

That under a general denial of the patentee's priority evidence of prior use taken without objection is competent at the final hearing, both as to the state of the art and the priority of the patent, see Zane *v.* Soffe (1884), 110 U. S. 200; 26 O. G. 737.

[7] That an objection to the examination of a witness must state specifically the grounds of the objection so that it may be removed if possible, see Woodbury Patent Planing Mach. Co. *v.* Keith (1879), 101 U. S. 479; 17 O. G. 1031; 4 Bann. & A. 100.

[8] In Allis *v.* Buckstaff (1882), 13 Fed. Rep. 879, Dyer, J.: (884) "It was held in Roberts *v.* Buck, 6 Fisher, 325, that where evidence of anticipations not set up in the answer had been taken, and a motion was afterwards made to amend the answer, an amendment would not make that evidence admissible which was taken under objection before the amendment. After all, I suppose it to be discretionary with the court in such a case, especially after the objecting party has fully cross-examined the witnesses and taken rebutting proofs, either to let the testimony stand in the case, or to strike it out and permit the defence to take the testimony anew under the amended answer. So far as the state of the case in Roberts *v.* Buck is disclosed, in the opinion of the court there is ground for the inference that the objecting party stood on his objection and elected not to cross-examine the witnesses or to offer rebutting proofs. In the case at bar objection was made to the examination of the witnesses, but there was full cross-examination, and proofs in rebuttal of that particular evidence were offered, and I think it is a proper exercise of discretion to let the testimony, which is objected to as irregularly taken, stand in the case." 22 O. G. 1705 (1707).

Further, that the pleadings may be amended and the evidence allowed to

witness, on the ground that he was mistaken in its details, will not be entertained if the examination was in due form and after proper notice.[9] No evidence can be used in argument before the court unless presented to the examiner and appearing on the record, except such documents as are equally accessible to both parties, and whose connection with the controversy is so apparent that their production by one can operate as no surprise upon the other.[10] Upon the motion of either party, for sufficient cause, the court may refer the record back to the examiner for the introduction of additional evidence or the re-examination of the former witnesses, and in such reference the testimony must be limited to the points

stand, see Babcock *v.* Pioneer Iron Works (1888), 34 Fed. Rep. 338; Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 379.

That if a witness is objected to before the examiner on the ground that the notice is imperfect, the notice must be amended or the evidence though taken will not be considered, see Kiesele *v.* Haas (1887), 32 Fed. Rep. 794.

That evidence of prior use taken against objection before the examiner, without due notice or answer, will be struck out by the court, see Bragg *v.* City of Stockton (1886), 11 Sawyer, 597 ; 27 Fed. Rep. 509.

That where a witness's name was not stated in the answer but his application for a patent was referred to, a motion to strike out his evidence will be sustained, see Decker *v.* Grote (1873), 6 Fisher, 143 ; 3 O. G. 65 ; 10 Blatch. 331.

That evidence of prior use, &c., given by persons not named in the answer, will be considered on the hearing unless a motion is made to strike it out, although it was objected to when taken, see Elm City Co. *v.* Wooster (1873), 4 O. G. 83 ; 6 Fisher, 452.

That evidence of prior use taken without proper notice and objected to cannot be admitted under the answer when afterward amended on motion, unless the omission of notice was inadvertent and the plaintiff was not taken by surprise, see Roberts *v.* Buck (1873), 6 Fisher, 325 ; 3 O. G. 268 ; Holmes, 224.

[9] That a motion to suppress testimony, on the ground that the witness was mistaken as to the occasion named, is not allowed if the examination was in proper form and after due notice and on oath, see Fischer *v.* Hayes (1881), 20 O. G. 242 ; 6 Fed. Rep. 86.

[10] That a patent not offered as evidence before the examiner, and not set up in the answer, cannot be introduced in equity, even upon a question of title, as the plaintiff has no opportunity for explanation, see Grover & Baker Sewing Machine Co. *v.* Sloat (1860), 2 Fisher, 112.

That prior patents, though generally referred to in the answer cannot be first introduced after the hearing is closed, see Peterson *v.* Simpkins (1885), 25 Fed. Rep. 486.

That the defendant may offer the original at the hearing to show that the re-issue departs from it, though it was not put in before the master, if it works no surprise to the plaintiff, see Knapp *v.* Shaw (1883), 15 Fed. Rep. 115 ; 23 O. G. 2236.

designated by the court.[11] When the evidence is thus complete and printed, and the briefs of counsel are prepared, the cause is argued and submitted to the decision of the court. After the hearing and submission neither party has the right to file any paper in the case without leave of the court, upon motion and due notice to the adversary.[12]

§ 1129. Practice and Procedure in Equity in Actions for Infringement.

The practice in equity, in actions for infringement, follows that of the English chancery as it existed before the "New Rules" were adopted, except where changed by express regulations.[1] The rules in equity prescribed by the Supreme Court of the United States are binding on the Circuit Court.[2] These rules were framed to conduct the cause to a hearing and have no effect upon it after it has been heard, unless steps are taken to bring it again within their operation. All privileges which they confer upon the parties, and all objections on the ground of their violation, must, therefore, be made available

[11] That if the case is referred back to the master to take new proof, and it relates to the same subject, it does not make out a new case, see Wooster *v.* Simonson (1884), 20 Fed. Rep. 316; 28 O. G. 918.

[12] In Union Sugar Refinery *v.* Matthiesson (1868), 3 Clifford, 146, Clifford, J.: (148) "When a suit in equity has been heard and submitted to the court for decision, neither party has a right to file any paper in the cause except by leave of the court. Such prohibition commences at the date of the submission of the cause to the court, and continues throughout the period that it remains upon the docket thereafter. The master may report back the cause to the court at any time when he has completed his investigations; and it would be the duty of the clerk to allow him to file his report without any new order from the court, as the right to do so is implied from the decree referring the cause to him for the purpose specified in the decree."

§ 1129. [1] That equity practice, unless otherwise ordered by the Acts of Congress, or the Rules of the Supreme Court, is usually in accordance with the English chancery practice as it was before the "New Rules," see Goodyear *v.* Providence Rubber Co. (1864), 2 Fisher, 499; 2 Clifford, 351; Parker *v.* Sears (1850), 1 Fisher, 93; Motte *v.* Bennett (1849), 2 Fisher, 642.

[2] That the Circuit courts are bound by and cannot rescind the rules of equity made by the Supreme Court, see Jenkins *v.* Greenwald (1857), 2 Fisher, 37; 1 Bond, 126.

That Federal courts of equity follow the practice prescribed by the judiciary acts and their own rules, not the local law, see United States *v.* American Bell Telephone Co. (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

before or at the hearing, or they will be waived.[3] The stipulations of the parties, when properly evidenced, are recognized by the court, but parol stipulations made out of court, and concerning the terms of which dispute has arisen, will not be enforced.[4]

§ 1130. Decrees in Equity: Decrees Pro Confesso.

Decrees in equity in actions for infringement are of three kinds: Decrees *pro confesso*; Interlocutory Decrees; and Final Decrees. A decree *pro confesso* may be granted where the defendant, having been served with process, fails to appear within the time required, or having appeared fails to plead, demur, or answer according to the order of the court, or fails to answer after a former demurrer, plea, or answer has been overruled or declared insufficient.[1] Such a decree assumes the truth of the bill, and until rescinded is as binding as any solemn decree.[2] It concludes the defendant

[3] In Allen *v.* Mayor of New York (1880), 7 Fed. Rep. 483, Wheeler, J.: (484) "The rules in equity are framed for bringing a cause to a hearing, and do not apply after a cause has been heard unless some proceedings are taken to bring it within their operation again, and to start it anew towards a hearing. When the cause is heard, without objection by either party, all steps not taken by either, which the other had a right to insist upon for the orderly bringing the cause to a hearing, must be considered as waived. Any other course would lead to re-opening causes, after hearing, for technical and unimportant defects, and greatly embarrass the prompt administration of justice by the courts, which is for the good of the people." 18 Blatch. 239 (240); 5 Bann. & A. 461 (462).

[4] That written stipulations filed by the parties are recognized by the courts, see Allis *v.* Buckstaff (1882), 22 O. G. 1705; 13 Fed. Rep. 879.

That a stipulation cannot have the effect of a final decree until ratified by the court, see Roemer *v.* Neumann (1886), 26 Fed. Rep. 332.

That parol stipulations of counsel made out of court are not noticed by the court so far as to decide upon the accuracy of recollection, or the terms of the agreement, or whether the court ought to enforce it, especially when the stipulation was made before the examiner and should appear on the record, see American Saddle Co. *v.* Hogg (1872), 6 Fisher, 67; 2 O. G. 595; Holmes, 177.

§ 1130. [1] In Thomson *v.* Wooster (1885), 114 U. S. 104, Bradley, J.: (112) "By our rules a decree *pro confesso* may be had if the defendant, on being served with process, fails to appear within the time required; or if having appeared, he fails to plead, demur, or answer to the bill within the time limited for that purpose; or if he fails to answer after a former plea, demurrer, or answer is overruled or declared insufficient." 31 O. G. 913 (915).

[2] In Thomson *v.* Wooster (1885), 114 U. S. 104, Bradley, J.: (111)

as to the patentability of the invention, the validity of the patent, the title of the plaintiff, and the fact of his infringement, so far as those matters are supported by the allegations of the bill, in the same manner and to the same extent as if they had been proved, and cannot be questioned either in the Circuit court or on appeal, unless shown to be erroneous by other statements contained in the bill itself.[3] During the term at which it is entered it is a decree *nisi*, and may be revoked upon sufficient grounds at the discretion of the court,[4] but no such revocation will be ordered on account of

"We may properly say, therefore, that to take a bill *pro confesso* is to order it to stand as if its statements were confessed to be true; and that a decree *pro confesso* is a decree based on such statements, assumed to be true (1 Smith's Ch. Pract. 153), and such a decree is as binding and conclusive as any decree rendered in the most solemn manner. It cannot be impeached collaterally, but only upon a bill of review, or [a bill] to set it aside for fraud. 1 Daniell Ch. Pr. 696, 1st ed.; Ogilvie *v.* Herne, 13 Ves. 563." 31 O. G. 913 (915).

[3] In Thomson *v.* Wooster (1885), 114 U. S. 104, Bradley, J.: (109) "The bill, as we have seen, was taken *pro confesso*, and a decree *pro confesso* was regularly entered up, declaring that the letters-patent were valid, that Douglass was the original inventor of the invention therein described and claimed, that the defendants were infringing the patent, and that they must account to the complainant for the profits made by them by such infringement, and for the damages he had sustained thereby; and it was referred to a master to take and state an account of such profits and to ascertain said damages. The defendants are concluded by that decree, so far at least as it is supported by the allegations of the bill, taking the same to be true. Being carefully based on these allegations, and not extending beyond them, it cannot now be questioned by the defendants, unless it is shown to be erroneous by other statements contained in the bill itself. A confession of facts properly pleaded dispenses with proofs of those facts, and is as effective for the purposes of the suit as if the facts were proved; and a decree *pro confesso* regards the statements of the bill as confessed." 31 O. G. 913 (914).

That a decree *pro confesso* admits that the patent is valid for that suit, and the character of the inventive act cannot be attacked if the bill alleges infringement, see Dobson *v.* Hartford Carpet Co. (1884), 114 U. S. 439; 31 O. G. 787.

That after a decree *pro confesso* as to the validity of the patent, the defendant cannot deny its validity, or if it be a re-issue dispute the diligence of the plaintiff in obtaining it, see Thomson *v.* Wooster (1885), 114 U. S. 104; 31 O. G. 913.

That while a decree *pro confesso* stands unrevoked the defendant cannot set up anything in opposition to it either below or on appeal, except what appears on the face of the bill, see Thomson *v.* Wooster (1885), 114 U. S. 104; 31 O. G. 913.

[4] That an interlocutory decree *pro confesso* is not definitive nor appealable,

the existence of a good defence where the defendant has already had an ample opportunity to appear and answer, nor where the cost of further litigation would exceed the amount demanded by the plaintiff.[5] A decree *pro confesso* cannot be collaterally impeached, nor after it becomes absolute can it be reversed except by a bill of review or a petition to rescind it on the ground of fraud.[6] The relief afforded by the decree does not necessarily conform to that actually required or prayed for by the plaintiff, but must be awarded in a degree and kind appropriate to the circumstances stated in the allegations of the bill.[7] Whether, while a decree *pro confesso* remains in force, the defendant can appear before the master and be heard on the account for profits and the computation of damages, has been doubted; at all events, the inquiries of the master must be confined to the advantages derived by the defendant, and the loss suffered by the plaintiff, from the wrongful use of the invention.[8]

but lies in the control of the court, see Roemer *v.* Neumann (1886), 26 Fed. Rep. 332.

That after a decree *pro confesso* a motion to allow an answer to be filed is addressed to the discretion of the court, and there is no appeal from its refusal, see Dean *v.* Mason (1857), 20 How. 198.

[5] That the existence of a meritorious defence gives no right to have a decree *pro confesso* set aside unless equity requires it, see Andrews *v.* Denslow (1877), 14 Blatch. 182; 2 Bann. & A. 587.

That after a decree *pro confesso* and the filing of the accounts, if the defendant moves for leave to file an answer and to open the account, and the plaintiff offers to take a judgment for less than the expense to the defendant of a trial, and it appears that the defendant has ceased to use the invention, the motion will be denied and the judgment entered for that amount, see Andrews *v.* Denslow (1877), 14 Blatch. 182; 2 Bann. & A. 587.

[6] That an absolute decree *pro confesso* cannot be collaterally impeached, nor directly attacked except by bill of review or for fraud, see Thomson *v.* Wooster (1885), 114 U. S. 104; 31 O. G. 913.

[7] In Thomson *v.* Wooster (1885), 114 U. S. 104, Bradley, J.: (113) "It is thus seen that by our practice a decree *pro confesso* is not a decree as of course according to the prayer of the bill, nor merely such as the complainant chooses to take it; but that it is made (or should be made) by the court, according to what is proper to be decreed upon the statement of the bill, assumed to be true." 31 O. G. 913 (915).

[8] That whether after a decree *pro confesso* the defendant is entitled to an order, permitting him to appear before the master and be heard, is doubtful, see Thomson *v.* Wooster (1885), 114 U. S. 104; 31 O. G. 913.

That after a decree *pro confesso* the master cannot inquire into the cost of producing results by other inventions, the sole question being as to the profits

§ 1131. Interlocutory Decrees.

An interlocutory decree is a decree in favor of the plaintiff upon the issues created by the bill and answer, and referring the cause to a master in chancery for an account of profits and an award of damages. To such a decree the plaintiff is entitled if in the judgment of the court the evidence sustains the patentability of the invention, the validity of the patent, the title of the plaintiff, the alleged infringement by the defendant, and the necessity for equitable relief.[1] Where the bill counts on several patents or on several Claims of the same patent, and either patent or any Claim is found to be valid and to have been violated, a decree must be granted and an account ordered upon such Claim or patent, although the others are invalid or have not been infringed.[2] The presence

§ 1131. [1] That where the validity of the patent and the fact of infringement are admitted or proved, the plaintiff is entitled to a decree and account as a matter of course, see North American Iron Works *v.* Fiske (1887), 30 Fed. Rep. 622; 39 O. G. 1086; Western Electric Mfg. Co. *v.* Chicago Electric Mfg. Co. (1882), 14 Fed. Rep. 691; 11 Bissell, 427; Franz & Pope Knitting Mach. Co. *v.* Lamb Knitting Mach. Mfg. Co. (1881), 19 O. G. 1000; Cook *v.* Ernest (1872), 2 O. G. 89; 5 Fisher, 396; Carew *v.* Boston Elastic Fabric Co. (1871), 1 O. G. 91; 5 Fisher, 90; 3 Clifford, 356; Allen *v.* Blunt (1849), 1 Blatch. 480.

That any infringement, however slight, entitles the plaintiff to a decree, see Cary *v.* Wolff (1885), 23 Blatch. 92; 32 O. G. 257; 24 Fed. Rep. 139.

That where the defendant in his answer declines to contest the suit and offers to pay a royalty, the plaintiff is entitled to a decree sustaining the patent and finding infringement, see Globe Nail Co. *v.* Superior Nail Co. (1886), 27 Fed. Rep. 454.

[2] That a decree will be passed where one Claim only of the patent is infringed, see Tibbals *v.* Daby (1880), 11 Fed. Rep. 903.

That the first Claim of the patent being abandoned, and the allegations of the second Claim not being denied, the plaintiff has a decree on the latter Claim, see New York Coffee Polishing Co. *v.* Wilson (1880), 2 Fed. Rep. 904.

That on a bill based on several patents, and alleging that the infringing structures were each covered in part by each patent, and on a plea denying this allegation and issue joined and proof taken, if it appears that two of the patents were not infringed, the plaintiff is entitled to a decree on those that were infringed, see Matthews *v.* Lalance & Grosjean Mfg. Co. (1880), 17 O. G. 1284; 2 Fed. Rep. 232; 18 Blatch. 84; 5 Bann. & A. 319.

That where a bill for the infringement of three patents states that "these several patents are applicable to the same process and are so used by the defendants," and damages cannot be awarded on two patents without the third, and the third is so near its expiration that an injunction could not be granted on it, the bill will not be

of excessive Claims does not impair the right to a decree upon a proper Claim of the same patent, on filing a disclaimer of the excess, unless such a disclaimer has already been unreasonably delayed.[3] An interlocutory decree can cover only the patent and the patented articles in suit, though if the defendant justifies his use of the invention under a license, and succeeds in his defence, the court may order an account of overdue license fees instead of profits.[4] A decree for profits may be entered where the bill merely prays for general relief, and should direct the defendant to account for all the profits made in violation of the plaintiff's rights by the employment of the patented inventions described in the bill.[5] Where several defendants are charged

dismissed, the case differing from Betts Claims if there were no unreasonable delay, though the invalid Claims are not yet disclaimed, but no costs can be recovered, and the invalid Claims must be disclaimed before the decree will be granted, see Burdett *v.* Estey (1878), 15 O. G. 877; 15 Blatch. 349; 4 Bann. & A. 7.

That where a patent has several Claims, some of which are void, an action may be maintained on the valid Claims without previous disclaimer of the others, see Cahart *v.* Austin (1865), 2 Fisher, 543; 2 Clifford, 528.

[4] That a decree does not cover any other patented articles or patent except those in suit, see Buerk *v.* Imhaeuser (1876), 11 O. G. 112; 2 Bann. & A. 465.

[5] That under a prayer for general relief the court can decree an account of profits, see Stevens *v.* Gladding (1854), 17 How. 447.

That profits and damages may be decreed, though the right to an injunction may be lost, see Kirk *v.* Du Bois (1886), 28 Fed. Rep. 460; 37 O. G. 102.

That a decree for profits may be "for all the profits made in violation of the rights of the complainants under the patents aforesaid, by the respondents,

v. Gallais, L. R. 10 Eq. 393, see New York Grape Sugar Co. *v.* Peoria Grape Sugar Co. (1884), 21 Fed. Rep. 878; 32 O. G. 138.

[3] That where no unreasonable delay has occurred excessive Claims may be disclaimed and a decree entered on the valid Claims, see Hake *v.* Brown (1889), 37 Fed. Rep. 783; Tyler *v.* Galloway (1882), 12 Fed. Rep. 567; 20 Blatch. 445; 22 O. G. 2072; Christman *v.* Rumsey (1879), 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506; 58 How. Pr. 114; Myers *v.* Frame (1871), 4 Fisher, 493; 8 Blatch. 446; Aiken *v.* Dolan (1867), 3 Fisher, 197.

That unreasonable delay in disclaiming, or omission to disclaim, is a question of fact, and must be raised by the answer if it is to be made at all, see Burden *v.* Corning (1864), 2 Fisher, 477.

That where a patentee has assigned an undivided interest in the invention, and a joint suit in equity is afterward brought, a disclaimer by the patentee alone does not enure to the advantage of the parties to the bill, see Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23.

That a recovery may be had on valid

with joint and separate infringements, but no joint use is found, and the bill is not objected to for informality, a decree against each separately is proper, though where defendants, sued as partners, are proved to have been a corporation, the bill should be amended in order to warrant a decree against the corporation.[6] A decree passed after the decision of the court upon the merits relates back to the date of such decision.[7] An interlocutory decree for an account is always open to amendment upon motion, after due notice to the adverse party,[8] and may be stayed by the court for any inequitable conduct of the plaintiff which prevents the defendant from embracing proper claims in his account.[9]

§ 1132. Final Decrees.

A final decree is a decree which terminates the litigation, either by awarding to the plaintiff the profits, damages, and other permanent relief to which he is entitled, or by deciding the cause upon its merits in favor of the defendant. A final decree for the plaintiff cannot be granted, where an account is necessary, until the account has been taken by the master and reported to and accepted by the court.[1] A final

from the manufacture, use, or sale of any of the articles named in the bill of complaint," see Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

[6] That where defendants are sued as partners and proved to be a corporation, whether a decree can be entered against the corporation without amending the bill is doubtful, see Needham *v.* Washburn (1874), 7 O. G. 649; 4 Clifford, 254; 1 Bann. & A. 537.

[7] That a decree entered after the decision on which it is based relates back to the date of such decision, see Barker *v.* Stowe (1882), 22 O. G. 259; 11 Fed. Rep. 303; 20 Blatch. 185.

[8] That an interlocutory decree is always open to amendment and correction, see Bell *v.* U. S. Stamping Co. (1887), 32 Fed. Rep. 549; De Florez *v.* Raynolds (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140; Magic Ruffle Co. *v.* Elm City Co. (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

That a decree ordering an account on two patents one of which had expired before suit must be amended to exclude the latter, the court never having had jurisdiction, see Creamer *v.* Bowers (1887), 30 Fed. Rep. 185.

[9] That where a plaintiff has obtained a decree for an account, and has begun suits against the same defendants in other circuits, the court will on motion stay the account unless the other suits are abandoned, but it cannot enjoin the plaintiff from prosecuting such other suits, especially after they have been allowed to proceed as far as the final hearing, see Rumford Chemical Works *v.* Hecker (1874), 5 O. G. 644; 11 Blatch. 552; 1 Bann. & A. 120.

§ 1132. [1] That a decree with a ref-

decree for the defendant can be ordered at the conclusion of the hearing on the bill and answer, without further proceedings, and results in a dismissal of the bill. The defendant has a right to this decree wherever he sustains any one of his defences, whether against the patentability of the invention, the validity of the patent, the title of the plaintiff, the alleged infringement, or the equitable right of the plaintiff to maintain the action, except perhaps that of a license, where in some cases the court may still retain the cause and settle the account for unpaid royalties.[2] The court in rendering a decree for the defendant will not pass on such Claims of the plaintiff as in its judgment the evidence sustains, in order to establish precedents for future guidance, but will dismiss the bill and leave the plaintiff to his remaining remedies.[3] Where, on its face, the patent is evidently void, a decree is

erence to a master is not a final decree, see Reeves *v.* Keystone Bridge Co. (1876), 9 O. G. 885; 2 Bann. & A. 256.

That the overruling of a demurrer is not a final decree on the validity of the patent, see Wollensak *v.* Sargent (1888), 33 Fed. Rep. 840.

That a decree absolute in its terms in favor of the defendant determines the controversy and is a bar to a further suit; nor can its force be qualified by any statement of the clerk of the court in favor of either party, see Lyon *v.* Perin & Gaff Mfg. Co. (1888), 125 U. S. 698; 43 O. G. 983.

That an interlocutory decree may be made final if the complainant signs a release of the profits, damages, and costs, see Roemer *v.* Neumann (1886), 26 Fed. Rep. 332.

[2] That the defendant is entitled to judgment if he proves any one of his special defences, see Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337.

That the bill will be dismissed if the evidence shows that the claimed invention was anticipated, see Raymond *v.* Singer Mfg. Co. (1882), 11 Fed. Rep. 427.

That a bill based on void or expanded Claims in a re-issue will be dismissed, see Cowell *v.* Sessions (1883), 17 Fed. Rep. 450; 21 Blatch. 421.

That where on a suit based on five patents the court finds for the defendants on four, and is divided on the fifth, the bill will be dismissed without costs, see American Wood Paper Co. *v.* Heft (1867), 3 Fisher, 316.

That a bill counting on two patents cannot be discontinued as to one after evidence taken, but should be wholly dismissed and a new bill filed to which the evidence already taken may apply, see Brush *v.* Condit (1884), 28 O. G. 451; 20 Fed. Rep. 826; 22 Blatch. 246.

That a bill will not be dismissed without prejudice as to one defendant after proof taken in full, see Archer *v.* Annd (1887), 40 O. G. 1029.

[3] That if no infringement is found the court will not pass on the questions of novelty and validity, see Saxe *v.* Hammond (1875), Holmes, 456; 7 O. G. 781; 1 Bann. & A. 629.

granted to the defendant without reference to the defences set up in his answer.[4]

§ 1133. Rehearings.

A rehearing may be ordered at any time between the interlocutory and the final decree for the purpose of admitting new evidence or additional defences, or on any other sufficient grounds.[1] A rehearing after final decree must be granted at the same term at which such decree is rendered, if the case can be appealed to the Supreme Court, otherwise it may be permitted during the next succeeding term.[2] When the period for a rehearing has expired, a final decree can be annulled or set aside only by an appeal or bill of review.[3] The allowance of a rehearing is not a matter of right, but rests entirely in the discretion of the court.[4] Any person interested in the action and conducting it at his expense, though not a party to the record, may move for a rehearing, and if he does not, will be bound by the decree.[5]

[4] That if the patent is void on its face, as where the want of novelty is apparent, the bill will be dismissed without regard to the answer, see Slawson *v.* Grand St., Prospect Park, & Flatbush R. R. Co. (1882), 107 U. S. 649; 24 O. G. 99; Quirolo *v.* Ardito (1880), 1 Fed. Rep. 610; 17 Blatch. 400; 5 Bann. & A. 80.

§ 1133. [1] That a case may be reopened after an interlocutory decree for further hearing, or to amend the answer, or to introduce a new subject-matter of defence, upon a proper petition and affidavit, see Allis *v.* Stowell (1880), 18 O. G. 465; 5 Bann. & A. 458.

That a rehearing may be had at any time before final decree, see Reeves *v.* Keystone Bridge Co. (1876), 9 O. G. 885; 2 Bann. & A. 256.

[2] That under Equity Rule 88, an application for a rehearing must be made at the same term as the final decree is entered and recorded, such cases being appealable to the Supreme Court, see Barker *v.* Stowe (1879), 16 O. G. 807; 4 Bann. & A. 485.

[3] That a motion for a rehearing will not be granted unless presented within the time fixed by law, see Brown *v.* Deere (1881), 19 O. G. 1217; 6 Fed. Rep. 487; 2 McCrary, 425.

That due diligence is required for a motion to re-open a decree, and four years' delay is too long, see Bate Refrigerating Co. *v.* Gillett (1887), 40 O. G. 1029; 31 Fed. Rep. 809.

[4] That a rehearing after a decree for an injunction and account is in the discretion of the court, see American Diamond Rock Boring Co. *v.* Sheldon (1880), 1 Fed. Rep. 870; 18 Blatch. 50; 5 Bann. & A. 292.

That no rehearing will be allowed unless the matters presented would change the decree, see Brown *v.* Deere (1881), 19 O. G. 1217; 6 Fed. Rep. 487; 2 McCrary, 425.

[5] That a party who furnishes the money to carry on a suit may apply

§ 1134. Rehearing on the Ground of Newly Discovered Evidence.

The principal ground for a rehearing is the discovery of new evidence since the termination of the trial. No rehearing upon this ground will be granted where the alleged new evidence is immaterial or cumulative, or would not lead to a change in the decree, or was known to the party or his counsel at the former hearing, or could then have been discovered and presented by the exercise of proper diligence.[1] That the

for a rehearing, and if he does not he will be bound by the decree, see Miller *v.* Liggett & Myers Tobacco Co. (1881), 7 Fed. Rep. 91 ; 19 O. G. 1138 ; 2 McCrary, 375.

That a case will not be re-opened after the hearing, against the objection of the plaintiff, in the interest of other persons not parties, though new evidence may exist which renders the decision worthless to the plaintiff as a guide in future cases, see Schneider *v.* Thill (1880), 3 Fed. Rep. 95 ; 18 Blatch. 241 ; 5 Bann. & A. 509.

§ 1134. [1] That no rehearing will be granted to admit immaterial evidence, see Hoe *v.* Kahler (1885), 25 Fed. Rep. 271 ; 23 Blatch. 354 ; 34 O. G. 127 ; Spill *v.* Celluloid Mfg. Co. (1884), 29 O. G. 773 ; 22 Blatch. 441; 22 Fed. Rep. 94 ; Munson *v.* Mayor of New York (1882), 22 O. G. 586 ; 20 Blatch. 358 ; 11 Fed. Rep. 72; Collins Co. *v.* Coes (1881), 8 Fed. Rep. 517 ; 20 O. G. 1084 ; Reeves *v.* Keystone Bridge Co. (1876), 9 O. G. 885 ; 2 Bann. & A. 256.

That no rehearing will be ordered to admit cumulative evidence, see Pfanschmidt *v.* P. H. Kelly Mercantile Co. (1887), 41 O. G. 1501 ; 32 Fed. Rep. 667; Blandy *v.* Griffith (1873), 6 Fisher, 434.

That no rehearing will be granted unless the new evidence would change the result, see Starling *v.* St. Paul Plow Works (1887), 41 O. G. 818 ; 32 Fed. Rep. 290 ; United States *v.* Gunning (1885), 23 Fed. Rep. 668 ; 32 O. G. 1468 ; Munson *v.* City of New York, (1882), 22 O. G. 586 ; 20 Blatch. 358 ; 11 Fed. Rep. 72 ; Coburn *v.* Schroeder (1882), 22 O. G. 419 ; 20 Blatch. 392 ; 11 Fed. Rep. 425 ; Collins Co. *v.* Coes (1881), 8 Fed. Rep. 517 ; 20 O. G. 1084 ; McCloskey *v.* Du Bois (1881), 20 O. G. 1086 ; 9 Fed. Rep. 38 ; 20 Blatch. 7 ; De Florez *v.* Raynolds (1879), 16 Blatch. 397 ; 4 Bann. & A. 331 ; Buerk *v.* Imhaeuser (1876), 10 O. G. 907.

That no rehearing will be granted on the ground of newly discovered evidence of prior use, when the evidence is less persuasive than on the former trial, see American Bell Telephone Co. *v.* People's Telephone Co. (1885), 25 Fed. Rep. 725 ; 34 O. G. 561.

That a question of fact will not be reheard because the drawings first offered in evidence were defective, unless the new evidence is so clear and positive that an entirely different case is presented, see Hayes *v.* Dayton (1884), 20 Fed. Rep. 690.

That no rehearing will be granted where the evidence could have been before produced by proper diligence, see Hoe *v.* Kahler (1885), 25 Fed. Rep. 271 ; 34 O. G. 127 ; 23 Blatch. 354 ; Willimantic Linen Co. *v.* Clark Thread Co. (1885), 24 Fed. Rep. 799 ; 32 O. G. 1356; Spill *v.* Celluloid Mfg. Co. (1884), 29 O. G. 773 ; 22 Blatch. 441 ; 22 Fed. Rep. 94 ; Hitchcock *v.* Tremaine (1872), 5 Fisher 537 ; 1 O. G. 633 ; 9 Blatch. 550.

That a rehearing on the ground of

party was taken by surprise by the testimony offered by his adversary, but did not ask for a continuance in order to investigate and answer it, and has since discovered that it could have been successfully contradicted, or that expert evidence could have been but was not produced, or that new instances of prior use have been brought to his knowledge and can now be proved, does not warrant the opening of the decree and the rehearing of the testimony.[2] But where new facts have occurred since the former trial, which would have influenced the court in rendering its decree, or where material facts then existing, of which the party had no information or means of obtaining it until the former trial closed, have been since discovered, a rehearing will not be refused. Thus where a judgment has been rendered in another court between the same parties and on the same issues, since the trial of the present suit;[3] or where the jurisdiction of the court is ques-

newly discovered evidence will not be allowed where the evidence is conflicting and of late discovery, and the excuses for delay are vague and unsatisfactory, see Albany Steam Trap Co. *v.* Felthousen (1886), 26 Fed. Rep. 318.

That a rehearing will be denied where the evidence could as well have been obtained before the former trial, especially in the defence of prior use, where the defendant can always make it appear that he has discovered new evidence, see Hicks *v.* Ferdinand (1884), 20 Fed. Rep. 111.

That no rehearing will be granted for new evidence if it were known to the party or his counsel at the time of the former trial, see Colgate *v.* Western Union Telegraph Co. (1884), 19 Fed. Rep. 828; 22 Blatch. 118.

That on a motion for a rehearing or a new trial the knowledge and diligence of counsel are regarded as those of the party, see Ready Roofing Co. *v.* Taylor, (1878), 15 Blatch. 94; 3 Bann. & A. 368.

That no new trial will be allowed on the ground of new evidence where the evidence was not before offered because of the inexperience or ignorance of counsel, see De Florez *v.* Raynolds (1879), 16 Blatch. 397; 4 Bann. & A. 331.

[2] That if the plaintiff is surprised by the evidence of the witnesses, he may ask time to investigate on the ground that no notice had been given in the answer, but must not take the risk of a decision, see Barker *v.* Stowe (1879), 16 O. G. 807; 4 Bann. & A. 485.

That no rehearing will be granted on the ground that the defendant did not have proper expert evidence, unless the excuse is shown and the application is made before final hearing, see Hitchcock *v.* Tremaine (1872), 5 Fisher, 537; 1 O. G. 633; 9 Blatch. 550.

[3] That where a decree in a former suit between the same parties on the same issues was filed after the present suit was begun, the pending case may be opened to let a copy of the decree be filed, see Barker *v.* Stowe (1882), 22 O. G. 259; 11 Fed. Rep. 303; 20 Blatch. 185.

tioned and the new evidence will tend to settle that dispute ;[4] or where a prior patent offered to anticipate the invention of the plaintiff is now discovered to have actually been issued after his invention was conceived,[5] — the case will be re-opened to allow the testimony to be offered and considered by the court. After a final decree no rehearing is allowed on the ground of new evidence if the evidence were known or could have been known before the decree was entered, or if it would not have been available to the party on the final hearing.[6] The motion for rehearing must be signed by counsel, sworn to by the party, clearly allege the new evidence and its discovery, and state in detail the efforts which were made at the former hearing to ascertain and produce it.[7] Due notice must be

[4] That a decree may be opened and a rehearing granted after an interlocutory decree and a reference to the master, if the jurisdiction in equity is in question and new evidence has been discovered, see Spring *v.* Domestic Sewing Mach. Co. (1882), 22 O. G. 1445 ; 13 Fed. Rep. 446.

[5] That the case will be opened for further evidence and rehearing when a foreign patent, supposed to be prior to the one in question, had been relied on and was afterward found to be subsequent, see Baldwin *v.* Schultz (1871), 5 Fisher, 75 ; 2 O. G. 319 ; 9 Blatch. 494.

That no rehearing will be allowed on the ground that a patent earlier than the plaintiff's, which was offered in evidence on the hearing, has been discovered by the defendant to have been twice re-issued, the last time being since the hearing, as this fact is immaterial, see Hitchcock *v.* Tremaine (1872), 5 Fisher, 537 ; 1 O. G. 633 ; 9 Blatch. 550.

That a rehearing may be granted at the discretion of the court on a claim of newly discovered evidence, in order that the cases may be completed and all points relating to the patent decided, though the petitioners may not be entitled to a rehearing as matter of right, see Railway Register Mfg. Co. *v.* Broadway & Seventh Avenue R. R. Co. (1885), 32 O. G. 257.

[6] That a petition to re-open the case and for leave to file a supplemental answer, setting up newly discovered evidence after final hearing and decree, will be granted only when such evidence would have availed the defendant if offered on the final hearing, see Collins Co. *v.* Coes (1881), 8 Fed. Rep. 517 ; 20 O. G. 1084.

That a rehearing will not be granted on the ground that the court misquoted the testimony, the misquotation not affecting the decision, see Torrent *v.* Duluth Lumber Co. (1887), 32 Fed. Rep. 229.

[7] That a petition to re-open must be signed by counsel, sworn to before a disinterested magistrate, and must be clear in its allegations, fully disclose the new evidence and its discovery, and set forth the diligence used before the former hearing, see Allis *v.* Stowell (1880), 18 O. G. 465 ; 5 Bann. & A. 458.

That the petition must aver that due diligence was used, see Spill *v.* Celluloid Mfg. Co. (1884), 29 O. G. 773 ; 22 Blatch. 441 ; 22 Fed. Rep. 94.

That the petition must show why the evidence was not produced before,

given to the opposite party, and an opportunity to answer it afforded.[8] If the court is satisfied that proper diligence has been exercised, and that the motion should be granted, a supplemental bill is filed containing the new evidence, on which the additional testimony with its counter-proof is taken, and the case is then presented to the court to be decided on the whole evidence together.[9]

§ 1135. Rehearing on the Ground of Newly Discovered Defences.

Another ground for a rehearing, often recognized by the court in actions for infringement, is the existence of a defence not set up in the answer, and consequently not hitherto presented to the court.[1] A rehearing will be granted upon this

see Burdsall *v.* Curran (1887), 31 Fed. Rep. 918; 42 O. G. 1167.

That a rehearing will not be granted on the affidavit of counsel that to the best of his information and belief the new evidence could not have been obtained, some positive proof as to this point being required, see Page *v.* Holmes Burglar Alarm Telegraph Co. (1880), 2 Fed. Rep. 330; 18 Blatch. 118; 5 Bann. & A. 439.

That an affidavit in support of a motion for a rehearing is not sufficient if it merely states that the party "made every effort" to obtain the testimony, "but was not aware that he could do so," for it must state what efforts he made, see Barker *v.* Stowe (1879), 16 O. G. 807; 4 Bann. & A. 485.

That a petition to re-open a case on the affidavit of one of two joint patentees that he was the sole inventor, and those of third persons that they had heard him so declare, will not be granted, see Collins Co. *v.* Coes (1881), 8 Fed. Rep. 517; 20 O. G. 1084.

[8] That a petition for a rehearing after a decree is not *ex parte*, but requires a notice to the opposite party and a chance to answer, see Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 6 Sawyer, 508.

[9] That the practice in a rehearing is to petition for leave to file a supplemental bill setting out the newly discovered evidence, and for rehearing when the supplemental bill is in readiness to be heard, see Reeves *v.* Keystone Bridge Co. (1876), 9 O. G. 885; 2 Bann. & A. 256.

That in a motion for leave to file a new bill, after the case is once adjudged, on the ground that new facts have been discovered, the court will examine and consider the counter affidavits, and if the evidence is cumulative, or the application unreasonably delayed, the motion will be denied, see Blandy *v.* Griffith (1873), 6 Fisher, 434.

That the petitioner must satisfy the court that due diligence was used and that the new evidence is material, see Reeves *v.* Keystone Bridge Co. (1876), 9 O. G. 885; 2 Bann. & A. 256.

That where a rehearing is granted, and new evidence admitted, opening the whole record, the old and new evidence will be considered together, see Reed *v.* Lawrence (1887), 32 Fed. Rep. 228; Henry *v.* Francestown Soapstone Co. (1880), 17 O. G. 569; 2 Fed. Rep. 78; 5 Bann. & A. 108.

§ 1135. [1] That an interlocutory decree may be opened on motion, without

ground only when the defence has come to the knowledge of the defendant since the former hearing, or having been known was then withheld for reasons which the court approves. When the defence is newly discovered, the court in determining the question of a rehearing is guided by the principles applied to cases of newly discovered evidence. If the defence were known and purposely withheld, the equity of the decree in view of the alleged defence and the defendant's reasons for neglecting to present it will control the court.[2] Thus a defence which if maintained could not change the ultimate result, or a defence withheld in pursuance of parol stipulations which are now disputed, or a defence which would have been urged had not the defendant negligently mistaken the real issue, or a defence incapable of positive and prevailing proof, affords no ground for opening the decree.[3] The affidavits, which support the petition for a rehearing upon this ground, must state each of the new defences and account for the defendant's previous failure to present it.[4] A rehearing will

a bill of review, to let in a new defence, but the motion must be supported by the same proof as the same attempt after final decree, see Willimantic Linen Co. *v.* Clark Thread Co. (1885), 24 Fed. Rep. 799 ; 32 O. G. 1356.

[2] That a rehearing will be ordered when the vital points in the case are not fully opened up in the former evidence, see Rumford Chemical Works *v.* Lauer (1872), 5 Fisher, 615 ; 3 O. G. 349 ; 10 Blatch. 122.

[3] That a motion to re-open and let in a new defence based on a patent for a different invention will be denied, since it could not change the result, see Adair *v.* Thayer (1881), 20 O. G. 523 ; 7 Fed. Rep. 920.

That a case will not be re-opened to allow a defendant to put in a new defence not set up in his answer, when his claim so to do is based on an agreement with opposite counsel not entered of record and now disputed, see American Saddle Co. *v.* Hogg (1872), 6 Fisher, 67 ; 2 O. G. 595 ; Holmes, 177.

That ignorance or incapacity of counsel is no ground for new trial, see De Florez *v.* Raynolds (1879), 16 Blatch. 397 ; 4 Bann. & A. 331.

That a case will not be re-opened to admit the defence that a joint patent is invalid because the invention is sole, upon the claim of the sole inventor that he alone invented it, and where there is no admission to that effect by the other inventor and no proof except the statements of the alleged sole inventor to others, although another case is pending in which this defence may be set up and the patent adjudged void, see Collins *v.* Coes (1881), 20 O. G. 1084 ; 8 Fed. Rep. 517.

[4] That on a motion for a rehearing the affidavits must set forth the particular defences to be urged and the reasons why they were not before presented, see Day *v.* Schwab (1880), 2 Fed. Rep. 544 ; 17 O. G. 1348 ; 5 Bann. & A. 389.

That after a final hearing and decree for the plaintiff the defendant cannot

not be granted in order that the case may be prepared anew, nor because the counsel were neglectful of their duties or were surprised by unexpected claims of their antagonists, nor for defects in the preliminary stages of the trial when no injustice has been done.[5] Laches in applying for a rehearing will form a ground for its denial, even in cases where it might otherwise be granted.[6] When further argument on the same facts might lead the court to different conclusions, a new hearing for that purpose may be properly allowed;[7] and

have the case re-opened, and amend his answer by setting up a new defence of prior use, unless he alleges particular facts which show that he could not have discovered this defence by due diligence before the prior hearing, see Hicks *v.* Otto (1884), 22 Blatch. 122.

[5] That a case will not be re-opened to allow it to be prepared anew for trial, see Coburn *v.* Schroeder (1882), 11 Fed. Rep. 425; 22 O. G. 419; 20 Blatch. 392.

That the case was not attended to by counsel is no reason for a rehearing, see Day *v.* Schwab (1880), 2 Fed. Rep. 544; 17 O. G. 1348; 5 Bann. & A. 389.

That no rehearing will be allowed on the ground that the petitioner was surprised by the unexpected claims of opposing counsel, see Everest *v.* Buffalo Lubricating Oil Co. (1884), 22 Fed. Rep. 252; 22 Blatch. 524.

That a case will not be re-opened on account of mere technical and unimportant defects in its preliminary steps, when no injustice has been done, all such defects being waived, see Allen *v.* Mayor of New York (1880), 7 Fed. Rep. 483; 18 Blatch. 239; 5 Bann. & A. 461.

That a decree will not be opened for a rehearing where the change of issue by filing a disclaimer limited the issue, and a chance to try the question has been already had, see Coburn *v.* Schroeder (1882), 22 O. G. 419; 20 Blatch. 392; 11 Fed. Rep. 425.

That the issues are not changed on a rehearing by a disclaimer of part of a Claim set up at a former hearing, the disclaimer narrowing the issue, not broadening it, see Coburn *v.* Schroeder (1882), 11 Fed. Rep. 425; 22 O. G. 419; 20 Blatch. 392.

That a rehearing may be denied on the ground that the new matter alleged is not material, see Hoe *v.* Kahler (1885), 23 Blatch. 354; 25 Fed. Rep. 271; 34 O. G. 127.

[6] That a rehearing may be denied on the ground of laches, see Hoe *v.* Kahler (1885), 23 Blatch. 354; 25 Fed. Rep. 271; 34 O. G. 127.

That a delay of a year and a half after the new evidence is discovered before filing a motion for leave to offer it is too long, see Blandy *v.* Griffith (1873), 6 Fisher, 434.

That where a defendant, eleven months after paying the execution in full, moves to open the decree, he is too late, see Doubleday *v.* Sherman (1869), 6 Blatch. 513.

That when a decree has been entered by consent and the damages are paid, and after many terms the defendant applies for leave to file a supplemental bill on the ground of mistake of fact in giving such consent, the motion will be denied as being in effect a bill of review and too late, under rule 88, see *In re* Pentlarge & Beeston (1879), 17 Blatch. 306; 4 Bann. & A. 607.

[7] That a motion for rehearing may

an award of excessive damages from some error in their mode of computation may be similarly reviewed.[8] Evidence already taken under a decree may be ordered to stand for future use in case, upon rehearing, the decree should be affirmed.[9]

§ 1136. Profits in Equity Distinct from Profits at Law, both in Theory and in Mode of Computation.

The award of profits to the plaintiff in an action in equity for infringement rests upon an entirely different theory from an award of damages at law, though both are intended as a compensation for his injury.[1] It is true that in computing

be made on the ground of necessity for further argument and consideration, though no new facts are presented and the issues are unchanged, see Celluloid Mfg. Co. *v.* Chrolithion Collar & Cuff Co. (1885), 25 Fed. Rep. 482.

That a decree will not be reversed on rehearing upon the same facts and arguments, see Gage *v.* Kellogg (1886), 26 Fed. Rep. 242 ; 36 O. G. 234.

That a rehearing may be granted in view of recent decisions of the Supreme Court, but the testimony taken will stand for future use if necessary, see American Diamond Rock Boring Co. *v.* Sheldons (1885), 32 O. G. 1240 ; 24 Fed. Rep. 374 ; 23 Blatch. 286 ; Wooster *v.* Handy (1884), 28 O. G. 629 ; 22 Blatch. 307 ; 21 Fed. Rep. 51 ; American Diamond Drill Co. *v.* Sullivan (1884), 28 O. G. 811 ; 22 Blatch. 298 ; 21 Fed. Rep. 74.

That a rehearing will not be granted on the ground that a false allegation in the bill misled the defendant, after laches in applying, see Willimantic Linen Co. *v.* Clark Thread Co. (1885), 32 O. G. 1356 ; 24 Fed. Rep. 799.

That a rehearing will not be granted on the ground that the defendants were misnamed in the bill, were ignorant of the patent, or were mere nominal parties, if they appeared and answered without objection, see Bate Refrigerating Co. *v.* Gillett (1887), 40 O. G. 1029 ; 31 Fed. Rep. 809.

[8] That when an error has been committed in assessing damages a new hearing will be ordered, unless the plaintiff will remit the amount to nominal damages, see Cowing *v.* Rumsey (1870), 4 Fisher, 275 ; 8 Blatch. 36.

[9] That a rehearing on the merits being granted after decree for account and partial hearing thereon, an order may be made that the evidence already taken on the account shall stand for future use, if needed, see Campbell *v.* New York (1888), 35 Fed. Rep. 504 ; American Diamond Rock Boring Co. *v.* Sheldon (1885), 23 Blatch. 286 ; 24 Fed. Rep. 374 ; 32 O. G. 1240.

That where a rehearing was granted on condition that the proceedings in account should stand if the decree were sustained, and the bill was dismissed, the dismissal was without prejudice to the proceedings in account if the decree of dismissal were reversed on appeal, see American Diamond Rock Boring Co. *v.* Sheldon (1885), 25 Fed. Rep. 768 ; 33 O. G. 1598.

§ 1136. [1] That "profits" and "damages" are not convertible terms, see Goodyear Dental Vulcanite Co. *v.* Van Antwerp (1876), 9 O. G. 497 ; 2 Bann. & A. 252.

That "profits" refer to what the

damages the jury may refer to the defendant's profits as affording some indication of the loss sustained by the plaintiff; but even these profits in themselves are wholly distinct from profits when accounted for in equity; the former embracing only that pecuniary gain of the defendant which but for his infringement would have accrued to the plaintiff, the latter including all the benefits which the defendant has derived from the invention, without reference to the amount which the plaintiff might otherwise have received.[2] Scarcely a rule or doctrine belonging to the one idea of profits is thus fully applicable to the other; and each should therefore be examined and expressed as if the other never had existed, the interchange of propositions, in such cases of fundamental difference in theory, leading to hopeless confusion and perplexity.

§ 1137. Power of Equity to Compel an Infringer to Account for his Unlawful Gains.

The power of a court of equity to order the defendant to account for his unlawful gains by an infringement, in cases where on other grounds it had obtained jurisdiction over him, has never been questioned.[1] This power was exercised in the earli-

§ 1137. [1] In Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1879), 17 Blatch. 24, Wheeler, J.: (26) "There was nothing in the statutes relating to the patents, before the act of 1870, providing expressly for the recovery of the gains and profits of an infringement of a patent by suit in equity. The right must have been derived from the application of the general principles of justice as administered in courts of equity to the relations between the owners of patents and infringers, created by the Patent Laws. The patentee owns the monopoly of the patented invention. When an infringer converts any part of the monopoly into money, or into anything else, the owner has the right to follow his property in its new form. The person in whose hands it is, becomes his trustee, — not because he was

defendant has gained by the unlawful use of the invention, and "damages" refer to what the plaintiff has lost, see Goodyear Dental Vulcanite Co. *v.* Van Antwerp (1876), 9 O. G. 497; 2 Bann. & A. 252.

That a patentee cannot expect or receive a complete remedy, see Spaulding *v.* Page (1871), 4 Fisher, 641; 1 Sawyer, 702.

[2] For a discussion of the defendant's profits as a measure of the plaintiff's damages at law, see §§ 1062, 1063, and notes, *ante*.

That in equity both profits and damages are recoverable, see Williams *v.* Rome, Watertown, & Ogdensburgh R. R. Co. (1880), 17 O. G. 1447; 18 Blatch. 181; 2 Fed. Rep. 702; Goodyear Dental Vulcanite Co. *v.* Van Antwerp (1876), 9 O. G. 497; 2 Bann. & A. 252.

est actions for infringement which were brought before the English chancery, and has been unhesitatingly applied in our own courts of equity. No statute authorized it until the act of 1870, adopting and sanctioning the uniform judicial practice, provided that not only profits but damages might be recovered by a successful plaintiff. The mode in which this power has been and is exerted resembles that employed when a trustee is forced to render an account of the trust estate confided to his care, and hence expressions have sometimes fallen from the lips of judges representing the defendant as a true trustee subject at all times to the supervision of the court.[2] But the defendant is not a trustee, nor, as we have already seen, does any fiduciary relation subsist between him and the plaintiff.[3] He is a simple *tort feasor*, who having become amenable to equity is there compelled to recompense the plaintiff for the injury in the manner best suited to the circumstances of the parties and the exigencies of the case. No analogy exists between it and any other form of remedy. The nature of the property appropriated by the defendant, its inseparable intermixture with the results of his own labor or expenditure, the impossibility of ascertaining in most cases with any reasonable certainty the precise pecuniary loss of the plaintiff, — all render necessary some peculiar and arbitrary method by which the amount of compensation may be finally determined; and this, which has been univer-

ever a trustee of the invention or monopoly, or had any right whatever to dispose of it for the owner, but because he had the money or other thing in his hands which the owner of the invention had the right to claim because the invention brought it. It is what is received for the invention that belongs to the owner of the patent, and when that is not mixed with what is received for anything else, there can be no difficulty about how much the owner of the patent is entitled to; when it is, the difficulty lies wholly in making separation." 4 Bann. & A. 445 (447).

[2] That the rule in equity is to treat the defendant as trustee for the profits received, see Birdsall *v.* Coolidge (1876), 93 U. S. 64; 10 O. G. 748; Packet Co. *v.* Sickles (1873), 19 Wall. 611.

[3] That there can be no trustee *de son tort* and no account unless the property is trust property, see Sayles *v.* Richmond, Fredericksburg, & Potomac R. R. Co. (1879), 3 Hughes, 172; 4 Bann. & A. 239; 16 O. G. 43.

That equity may treat the infringer as a trustee though he is not truly such, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

For a discussion of the relation of the infringer to the patentee, as trustee or otherwise, see §§ 1086, 1091, and notes, *ante*.

sally employed in equity, is at least as certain and as just as that pursued at law. Resemblances, indeed, may be discovered between this mode of redress and others, both at law and equity, and in some cases these indicate a similarity in principle, as where one who has converted chattels and turned them into money is held accountable to the owner for the price received in the same manner as the defendant in infringement is compelled to pay the owner of the patent such a proportion of the results of his infringing sales as represents the value of the patented idea of means; but all these resemblances are misleading, and if on some occasions they give point to an argument or a decision, in others they obscure distinctions which reason and policy require to be preserved. The theory of profits in equity thus stands alone. It may be stated as follows: Equity, having acquired jurisdiction over the parties and the cause on other grounds, will give complete relief, including compensation for past infringements; in awarding this compensation it must pursue some method of computing and enforcing the payment of the amount which is in accordance with the established forms of equity procedure; and it has adopted the one now in use as that which is best fitted for the purpose, and which when properly employed preserves most perfectly the equitable rights of all the parties to the action. That this theory has in some instances been perverted, and this method abused, does not reflect upon the soundness of the one nor on the practical justice of the other. The mistakes which have been made, and the grounds of criticism which exist, relate to the details of practice and the significance given or denied to certain data of the account, rather than to the substantial principles on which the doctrine and the rule themselves are based.

§ 1138. Profits in Equity Defined: General Mode of Computation.

Profits in equity include all those pecuniary benefits which the defendant has derived from the infringement. These are regarded in equity as the property of the owner of the patent.[1]

§ 1138. [1] That the benefits derived by the defendant from the plaintiff's invention are a proper ground of recovery, see Sargent *v.* Yale Lock Mfg. Co. (1879), 17 O. G. 106; 17 Blatch. 249; 4 Bann. & A. 579.

That where no benefits are received by the defendant there are no profits to

To ascertain their amount, and to compel its payment to the plaintiff, the defendant is ordered in the interlocutory decree to render an account, and in the final decree to pay the sum thus ascertained to the plaintiff; and those orders are enforced against the defendant's person or property by the usual measures known to courts of equity.[2] The account is taken before a master, who after due investigation reports to the court the value of the profits to which the plaintiff is entitled. In making his investigation, and forming his estimate of the net amount, the master is bound by certain rules from which he is not permitted to depart.[3] These relate chiefly to the items with which the defendant must be charged, the items with which he must be credited, and the evidence by which the claims of the respective parties must be supported. With reference to these rules, all cases of infringement may be divided into two great classes: (1) Those in which the infringement consists in the unlawful use, or making and use, of the patented invention; (2) Those in which the infringement consists in the unlawful sale, or manufacture and sale, of the patented invention. These two classes are wholly distinct, — the items on each side of the account differing more

be accounted for, see Calkins *v.* Bertrand (1881), 8 Fed. Rep. 755; 10 Bissell, 445; Burdett *v.* Estey (1880), 3 Fed. Rep. 566; 19 Blatch. 1; 5 Bann. & A. 308; Elizabeth *v.* Pavement Co. (1877), 97 U. S. 126; Vaughn *v.* Central Pacific R. R. Co. (1877), 4 Sawyer, 280; 3 Bann. & A. 27.

That profits are not to be accounted for unless due to the invention covered by the patent, see Brady *v.* Atlantic Works (1878), 3 Bann. & A. 577; 15 O. G. 965.

That no profit can be decreed for the use of a void patent, see Kennedy *v.* Hazelton (1888), 128 U. S. 667.

That where the defendant has used the plaintiff's device it is presumed that there might have been some profits, and an account of them will be ordered, see Andrews *v.* Creegan (1881), 19 O. G. 1140; 19 Blatch. 113; 7 Fed. Rep. 477.

[2] That the plaintiff may recover the profits due to the use of his improvement on a bill praying for either general or special profits, see Graham *v.* Mason (1872), 5 Fisher, 290; 1 O. G. 609; Holmes, 88.

That an interlocutory decree directing an account of "gains, savings, and advantages," in addition to the profits, and awarding costs, is proper, see Coburn *v.* Schroeder (1881), 8 Fed. Rep. 521; 20 O. G. 1085; 19 Blatch. 493.

That a decree in an action for the infringement of a design-patent may order an account of the profits and damages resulting from making and selling the article containing the design, see Dobson *v.* Dornan (1886), 118 U. S. 10; 35 O. G. 750.

[3] For the mode of taking the account, see §§ 1156, 1157, and notes, *post.*

or less as the infringement has assumed one or the other of these forms.[4] They will therefore be considered separately, the few general doctrines applicable to both being noticed in their appropriate place in each discussion; and as the rules which govern the account for an infringing sale are fewer and more simple, and naturally aid in the comprehension of those which govern the account for an infringing use, the former will be first reviewed, although the logical order of the subject is thereby reversed.

§ 1139. Computation of Profits where the Infringement Consists in the Sale, or Manufacture and Sale, of the Patented Invention.

The pecuniary benefits derived by the defendant from the unlawful sale, or manufacture and sale, of the patented invention are represented by the profits actually received by him upon the patented articles which he has sold.[1] Upon articles made and not sold, or upon articles sold and yet unpaid for, or upon articles sold and paid for at a price not exceeding the cost of production, no profit can, of course, have accrued to the defendant or have become in equity the property of the plaintiff.[2] Upon articles actually sold at a profit and paid for the profit is measured by the difference between the cost of making and selling and the price obtained.[3] Hence in these cases the defendant must be charged with the amount received

[4] That the rule of profits is not uniform, see Graham *v.* Mason (1872), 1 O. G. 609; Holmes, 88; 5 Fisher, 290.

That if the invention is a product, the profits on the product will be allowed, see Burdett *v.* Estey (1880), 3 Fed. Rep. 566; 19 Blatch. 1; 5 Bann. & A. 308; Elizabeth *v.* Pavement Co. (1877), 97 U. S. 126.

§ 1139. [1] That only profits actually received are to be accounted for, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628; Burdett *v.* Estey (1883), 3 Fed. Rep. 566; 19 Blatch. 1; 5 Bann. & A. 308; Calkins *v.* Bertrand (1881), 8 Fed. Rep. 755; 10 Bissell, 445; Elizabeth *v.* Pavement Co. (1877), 97 U. S. 126; Vaughn *v.* Central Pacific R. R. Co. (1877), 4 Sawyer, 280; 3 Bann. & A. 27; also § 1146, note 2, *post*.

[2] That profits on sales arise only when the goods are actually sold and paid for is evident, since while the goods remain unsold they are liable to become a source of loss to the owner, and when sold, though at an advantageous price, and not paid for, the profit is still contingent and may never be realized.

[3] That profits are the difference between cost and yield, see Burdett *v.* Estey (1880), 3 Fed. Rep. 566; 19 Blatch. 1; 5 Bann. & A. 308; Piper *v.* Brown (1873), 6 Fisher, 240; 3 O. G. 97; Holmes, 196; Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

for each article sold in violation of the patent. Against this must be credited the cost of manufacturing and marketing each article, the difference indicating the defendant's gain.[4] Where these questions are uncomplicated with any others the only difficulty encountered pertains to the credits to be given to the defendant. Concerning these some difference of opinion has existed. That the cost of manufacture,[5] including the price paid for materials and labor,[6] the interest on the amount actually expended for machinery and power,[7] the value of the use of tools,[8] the loss occasioned by waste,[9]

[4] That where the invention infringes as a whole all profits belong to the patentee, see Ruggles *v.* Eddy (1877), 12 O. G. 716; 2 Bann. & A. 627.

[5] That profits can be ascertained only by deducting all elements of cost, see Troy Iron & Nail Factory *v.* Corning (1869), 3 Fisher, 497; 6 Blatch. 328.

That the cost of making the articles must be allowed, see Zane *v.* Peck Bros. (1882), 23 O. G. 191; 13 Fed. Rep. 475; Rubber Co. *v.* Goodyear (1869), 9 Wall. 788; Wilbur *v.* Beecher (1850), 2 Blatch. 132.

[6] That the price paid for materials must be allowed, see Gould's Mfg. Co. *v.* Cowing (1882), 105 U. S. 253; 21 O. G. 1277; Buerk *v.* Imhaeuser (1876), 10 O. G. 907; 14 Blatch. 19; 2 Bann. & A. 452; Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

That wages paid for actual service are allowed, see Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1879), 17 Blatch. 24; 4 Bann. & A. 445; American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

That charges for extra work and materials may be allowed to the respondents on condition that they will assign the charges to the complainant, see Brady *v.* Atlantic Works (1878), 15 O. G. 965; 3 Bann. & A. 577.

[7] In Herring *v.* Gage (1878), 15 Blatch. 124, Wallace, J.: (129) "Undoubtedly interest and cost of power enter into the account of profits to be ascertained from a given manufacture. Profit is the gain made upon any investment when both receipts and payments are taken into the account. Where interest has been paid upon the capital invested, or where it is to be paid upon borrowed capital, it should be allowed in estimating profits; but I am not aware of any rule which requires that it should be deducted where it has not been actually paid or incurred. The allowance for cost of power is to be determined by the same rule. If expense has been actually incurred for power, it should be deducted. But if interest or expense for cost of power has not been incurred, there is no more reason why there should be a deduction therefor from the profits than that there should be for the personal service of the infringer in conducting the business." 2 Bann. & A. 396 (401).

See also as to allowance of interest when actually paid, Rubber Co. *v.* Goodyear (1869), 9 Wall. 788; Wilbur *v.* Beecher (1850), 2 Blatch. 132.

[8] That the value of the use of tools must be allowed, see Gould's Mfg. Co. *v.* Cowing (1882), 105 U. S. 253; 21 O. G. 1277; Troy Iron & Nail Factory *v.* Corning (1869), 3 Fisher, 497; 6 Blatch. 328.

[9] That loss by waste should be allowed, see Gould's Mfg. Co. *v.* Cowing (1882), 105 U. S. 253; 21 O. G. 1277.

the rental of buildings necessarily occupied in the manufacture,[10] the reasonable salaries of superintendents or other higher employees,[11] the royalties paid upon machinery or processes used in producing the articles sold,[12] the decrease in cost of manufacture resulting from inventions made or owned by the defendant,[13] and other ordinary running expenses, should be allowed is undisputed. It is equally certain that the time and services of the defendant, or, when the defendant is a corporation, of its stockholders unless as regular *bona fide* employees, the interest on capital invested in the general business, and the insurance on the property employed, cannot be credited.[14] Whether the defendant may deduct the

[10] That the value of real and personal estate employed in making the device, including repairs thereon, is part of its cost and is to be allowed, see Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1879), 4 Bann. & A. 445; 17 Blatch. 24; Troy Iron & Nail Factory *v.* Corning (1869), 3 Fisher, 497; 6 Blatch. 328.

[11] That reasonable salaries to superintendents and workmen are allowed, see American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

That extraordinary salaries are not allowed, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

[12] That a royalty paid by the defendant on another patented invention, if reasonable in amount, will be allowed, see American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

[13] That where the defendant has cheapened the cost of producing the infringing device by an improvement of his own, he is entitled to a corresponding credit in ascertaining the profits, see Mason *v.* Graham (1874), 23 Wall. 261; 7 O. G. 833.

That where part of the selling price was due to an invention of the defendant, the profit thereon is not allowed to the plaintiff, nor its cost to the defendant, see Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1879), 17 Blatch. 24; 4 Bann. & A. 445.

That if the defendants used other improvements of their own invention, and claim deductions on that account, they must prove them affirmatively, see American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

[14] In Williams *v.* Leonard (1872), 5 Fisher, 381, Woodruff, J.: (383) "As to the 'salaries' of the defendants during the period in which they have been engaged in infringing, they have no title, as against the complainant. It would be very great injustice if the *quantum* of gains and profits recoverable by a complainant depended on the question how much of such gains and profits the defendants used for their own support, or the support of their families; or, as even more broadly claimed here by the defendants, how much they saw fit to appropriate to their own use. Infringers would rarely be required to pay over anything, if they could divide the gains and profits among themselves, under the name of salary, wages, or any other designation. Men work for gains and profits, but they are gains and profits still. [illegible] support themselves and their families

amount of the usual manufacturer's profit has been doubted.[15] The cost of marketing, comprising the price paid for freight, storage, commissions, the rental of warehouses and shops, the salaries of clerks, and the legitimate expense of collecting the amounts due for sales, should also be allowed.[16] Where

out of their gains and profits, but that does not change their nature. If it were not so, inventors might, by reason of infringements, fail to obtain anything, and the infringers obtain what they see fit to term adequate salaries out of their piracy. What, in good faith, the defendants pay to others, as expenses, may be taken as the cost to them of their manufacture. What they take to themselves are gains. They might perhaps have earned and gained as much, or perhaps more, by laboring in some other business, in no violation of the rights of their neighbor; but they cannot be permitted to gain either wages or salary by a violation of such rights." 9 Blatch. 476 (478).

That the time and services of the infringers are not allowed, see Piper *v.* Brown (1873), 3 O. G. 97; Holmes, 196; 6 Fisher, 240.

That the expense of maintaining the insane infringer while under guardianship cannot be allowed after his restoration to sanity, see Avery *v.* Wilson (1884), 20 Fed. Rep. 856.

That where the defendant is a corporation the salaries paid by it to its stockholders as employees, in good faith and not as a mode of dividing profits, are to be allowed, see Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1879), 17 Blatch. 24; 4 Bann. & A. 445; American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

That interest on capital stock is not allowed, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 788; *contra*, Wilbur *v.* Beecher (1850), 2 Blatch. 132.

That insurance on real and personal estate employed in the business, and local taxes, are not to be allowed, see Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1879), 17 Blatch. 24; 4 Bann. & A. 445.

[15] That the manufacturer's profit should be allowed, see Simpson *v.* Davis (1884), 22 Fed. Rep. 444; 22 Blatch. 113; Buerk *v.* Imhaeuser (1876), 10 O. G. 907; 2 Bann. & A. 452; 14 Blatch. 19; *contra*, Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

The manufacturer's profit occupies different positions in the account according to the mode of infringement. Where the infringement is by making and selling, the manufacturer's profit enters into the profit resulting from the sale, and is a direct advantage derived from and wholly dependent on the unlawful use of the invention. Like salaries or wages claimed by the infringer it should therefore be disallowed. But in cases where the infringement consists in the use of the invention and the sale of its products, the profits, under the present questionable doctrine, are represented by the difference in advantage between the invention used and that which the defendant had a right to use, and into this difference the manufacturer's profit does not enter unless it is greater or less when the patented invention is employed than it would otherwise be. In these cases, therefore, it may properly be allowed, either wholly or in part, as the evidence may show it to have been affected by the infringement.

[16] That the cost of marketing the articles is to be allowed, see Gould's Mfg. Co. *v.* Cowing (1882), 105 U. S. 253; 21 O. G. 1277; Zane *v.* Peck Brothers

the defendant is engaged in a general business, the patented invention constituting only one department of his sales, the expenses of the business must be apportioned in the ratio of the respective sales of the infringing and the non-infringing articles, and the proportion of the former charged as the expenses of their sale.[17] In this computation no allowance

(1882), 23 O. G. 191; 13 Fed. Rep. 475; Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

That if sales are large the cost of clerk hire, storage, freight, etc., are to be allowed, see Zane *v.* Peck Brothers (1882), 23 O. G. 191; 13 Fed. Rep. 475.

That commissions on the defendant's sales, where they have not paid any, cannot be allowed, see Piper *v.* Brown (1873), 3 O. G. 97; Holmes, 196; 6 Fisher, 240.

That a commission paid to an agent is a profit to be accounted for by the agent, not by the principal, see Steiger *v.* Heidelberger (1880) 18 O. G. 1463; 4 Fed. Rep. 455; 18 Blatch. 426.

That where the competition produced by the infringement increases the sales of the plaintiff by reason of the reduced prices, this fact is to be considered on the question of profits, see Ingersoll *v.* Musgrove (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304.

That where the defendants as makers sell to themselves as users, and are the largest users while other purchasers buy but little, it is proper to consider that the magnitude of the sales to themselves reduced the price below that to small buyers, see Troy Iron & Nail Factory *v.* Corning (1869), 3 Fisher, 497; 6 Blatch. 328.

[17] In Hitchcock *v.* Tremaine (1872), 5 Fisher, 310, Woodruff, J.: (311) "The defendants are dealers in musical instruments, including pianos, melodeons, and organs with and organs without the *tremolo* attachment, which has been decreed to be an infringement of the complainants' patent. (See Hitchcock *v.* Tremaine, 8 Blatch. C. C. 440; 4 Fisher, 508.) The conduct of their business necessarily involves certain general expenses, which are as truly expenses of dealing in one class of goods as of dealing in another class. Such expenses as general clerk hire, rent of store, salary of book-keeper, if any, and the like, concern the entire business, and in any estimate of gains and profits are properly apportionable to the several kinds of business done, or kinds of goods sold, when the profits of either are to be separately stated. . . . The gross proceeds of sales of each kind being ascertained, and a deduction from each being made of such special or peculiar expenses as in a *pro forma* account would be chargeable to each, there would remain for allotment to each account its proportionate share of the general expenses incurred for the benefit of all, — that is, for the maintenance and conduct of the business; and this distribution should be in the proportion of the several amounts of sales of each. It is not just to say, in respect to either, as is argued by the complainants here, that the general expenses are not increased by the presence of one class of goods, and would have been the same if the sales had been confined to the other classes. If that argument were supposed to prevail in an accounting for the profits of sales of one class, it would also prevail in each separate accounting, and so would be allowed in neither. In the present case, the dealing in organs having the *tremolo* at-

can be made for losses on infringing articles which have been sold at cost or less than cost, or which have not been paid for or remain unsold. The profits on articles sold at a profit and paid for are the only object of inquiry. Losses incurred by the defendant through his wrongful invasion of the patent are not chargeable to the plaintiff, nor can their value be deducted from the compensation which he is entitled to receive.[18] Nor where the defendant has expended money in

tachment was a part of the general business of the defendants. These were not sold without involving a part of the general expenses of the business. It may be true that in a given case it costs the defendants no more to sell an organ containing the infringing attachment than it would have cost to sell an organ not containing the attachment; but *non constat* that if the organ sold had not contained such attachment, it would have been sold at all. The complainants are here demanding the profits of that sale. They must take them burdened with the just allowance for those disbursements which enable the defendants to offer the attachments to the public in a salable form, and to keep them in the market, before the eye and within the reach of customers, and generally to properly conduct the business of selling, and keep due account thereof. . . . On the other hand, the master very properly refused to apportion these expenses according to the amount of profits on sales. Whether the defendants made any profits on their whole business or not, is quite immaterial to these complainants. They are not to be deprived of the gains made by selling the infringing attachments because the defendants made less profits, or even no profits, on the sale of pianos, or as the case may be, of some other musical instruments. To allow this, would permit the defendants to violate the rights of the complainants, and use the profits thereby gained to cover their losses on other sales." 9 Blatch. 385 (386).

See also Brady *v.* Atlantic Works (1878), 3 Bann. & A. 577; 15 O. G. 965; Tremaine *v.* Hitchcock (1874), 23 Wall. 518; 7 O. G. 1055.

[18] In Graham *v.* Mason (1872), 5 Fisher, 290, Shepley, J.: (293) "In making up the account of profits, the master sometimes takes into account the cost of the whole number of infringing mechanisms or contrivances made by the defendant, and the proceeds of all the sales, and gives the patentee the net profits on the whole amount manufactured. This would be a correct rule in some cases, but it would not be just to the patentee in cases where the infringer had made profits on one fraction of the whole number made and sold, and through defective manufacture or unskilful management of his business had met with losses on a larger fraction, so that a correct account of the whole operation would show a loss on the total manufacture. In such a case, if the patentee, with a full knowledge of all the facts, should bring his bill declaring specifically for the infringement only by the manufacture of those specified mechanisms in the making and selling of which the infringer had made profits, he would certainly be entitled to recover the profits thus made. It is not easy to see why he is not entitled to such profits in a bill counting generally against the infringer without offset or

protecting his vendees from the plaintiff, or securing their release from liability, or given them guaranties of unmolested *future enjoyment, can these expenses be considered* or set off against the profits actually made.[19]

§ 1140. Computation of Profits where the Infringement Consists in Selling Articles in which the Patented Invention is Embraced and Adds to the Profits of Each Sale.

The foregoing rule of computation is sufficient where the article sold is the exact patented invention. Where it embraces more than the patented invention, further distinctions become necessary. If the infringing article, as actually made and sold by the defendant, contains substantial features which contribute to its market value, but are not covered by the plaintiff's patent, it is evident that the price paid by the vendee is not based on the sole consideration of the patented invention, and that the difference between the price and the cost of manufacture is greater than the benefit derived by the defendant from his infringing act. In such cases an ad-

deduction for losses made in the manufacture and sale of other infringing mechanisms." 1 O. G. 609 (610); Holmes, 88 (90). See also Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

That where the defendant has made and sold some infringing devices at a profit, he must account for them though he sold others without profit and has some on hand which he cannot dispose of, see Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1879), 17 Blatch. 24; 4 Bann. & A. 445.

That where business is carried on for one season at a profit and for the next at a loss, and no connection existed between the two, and the accounts were kept separate, no deductions from the profits of the former on account of the losses in the latter are to be allowed, see Piper *v.* Brown (1873), 3 O. G. 97; Holmes, 196; 6 Fisher, 240.

That bad debts are sometimes considered in estimating profits, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 788; Wilbur *v.* Beecher (1850), 2 Blatch. 132. But not properly in an account for profits on sales, since no profits accrue except where goods sold are actually paid for, and since profits arising on sales where the price is collected are not diminished by losses on other sales.

[19] That money paid to protect defendant's vendees from the plaintiff is not to be allowed in the account of profits, see Mason *v.* Graham (1874), 23 Wall. 261; 7 O. G. 833; Graham *v.* Mason (1872), 1 O. G. 609; Holmes, 83; 5 Fisher, 290.

That liabilities for and guaranties of title given to purchasers by the defendant are not allowed, all claims of the plaintiff against them being extinguished by his recovery of profits, see Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1879), 17 Blatch. 24; 4 Bann. & A. 445.

ditional investigation is required. The price of the patented invention and its cost must be separated from the total expenses and receipts in order that the deduction of the latter from the former may indicate the profit due to the invention.'

§ 1140. [1] In Maier *v.* Brown (1883), 17 Fed. Rep. 736, Brown, J.: (736) "There is no doubt whatever of the general proposition that the patentee of an improvement is limited in his recovery to such profits as may be properly apportioned to the use of his improvement. He can only recover profits upon the entire article when such article is wholly his own invention, or when its entire value is properly and legally attributable to the patented feature. (Seymour *v.* McCormick, 16 How. 480; Mowry *v.* Whitney, 14 Wall. 620; Littlefield *v.* Perry, 21 Wall. 205; Elizabeth *v.* Pavement Co., 97 U. S. 126; Garretson *v.* Clark, 15 Blatch. 70; Zane *v.* Peck, 13 Fed. Rep. 475; Fitch *v.* Bragg, 16 Fed. Rep. 243.) The difficulty is in the application of this principle. Thus, if one discovers a new composition of matter, such as gun-cotton, nitro-glycerine, or vulcanized rubber, or invents some new machine, such as the telephone, or some new article of manufacture, such as barbed wire or a new pavement, he would obviously be entitled to damages arising from the manufacture and sale of the entire article. Upon the other hand, if his invention were limited to some particular part of a large machine, such as the cut-off of an engine, the axle of a wagon, or the seat upon a mowing machine, it is equally clear that his recovery must be limited to such profits as arise from the manufacture and sale of the patented feature. His damages, too, must be proved, and not left to conjecture; and the fact that it is impossible to separate the profits arising from the improvement from those incident to the manufacture of the whole machine, is an insufficient reason for awarding the plaintiff more than he is justly entitled to receive. (Philp *v.* Nock, 17 Wall. 460; Calkins *v.* Bertrand, 8 Fed. Rep. 755; Gould's Mfg. Co. *v.* Cowing, 12 Blatch. 243.) In case he is unable to prove how much of the entire profit upon the machine is due to his patent, he can recover only nominal damages. Blake *v.* Robertson, 94 U. S. 728."

Further, that the profits on the exact invention, as distinguished from profits due to other features of the article as a whole, must be separated and alone accounted for, see Fay *v.* Allen (1887), 30 Fed. Rep. 446; Roemer *v.* Simon (1887), 31 Fed. Rep. 41; 40 O. G. 1456; Everest *v.* Buffalo Lubricating Oil Co. (1887), 31 Fed. Rep. 742; Reed *v.* Lawrence (1886), 29 Fed. Rep. 915; Faulks *v.* Kamp (1882), 22 O. G. 2244; 10 Fed. Rep. 675; Gould's Mfg. Co. *v.* Cowing (1882), 105 U. S. 253; 21 O. G. 1277; Kirby *v.* Armstrong (1881), 19 O. G. 661; 10 Bissell, 135; 5 Fed. Rep. 801; Calkins *v.* Bertrand (1881), 8 Fed. Rep. 755; 10 Bissell, 445; Garretson *v.* Clark (1879), 16 O. G. 806; 4 Bann. & A. 536; Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1879), 17 Blatch. 24; 4 Bann. & A. 445; 24 O. G. 703; Garretson *v.* Clark (1878), 14 O. G. 485; 15 Blatch. 70; 3 Bann. & A. 352; Knox *v.* Great Western Quicksilver Mining Co. (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25; Brady *v.* Atlantic Works (1878), 3 Bann. & A. 577; 15 O. G. 965; Ingersoll *v.* Musgrove (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304; Buerk *v.* Imhaeuser (1876), 10 O. G. 907; 14 Blatch. 19; 2 Bann. & A. 452; Robertson *v.* Blake (1876), 94 U. S. 728; 11

The price paid for the patented invention is the price received for the whole article, less what it would have brought in open market had the patented invention been omitted. Its cost is the difference between the expense of making the article with it and without it. If the article is more expensive and brings a higher price when it includes the patented invention, the subtraction of the excess of cost from the excess of price will show whether a profit has been made, and its amount. When the price remains the same as if the patented invention were not used, and the expense of manufacturing the article is lessened, the profit is the decrease in its cost. If cost and price are unchanged by the introduction of the patented invention, or are increased or diminished in the same proportion, or the price decreases while the cost is still the same, there is no profit in the sale of any single article for which the plaintiff has a right to an account from the defendant, and whatever benefit exists must be occasioned by an increase of his sales. The rule, as thus far stated, presents certain difficulties, since if the presence of the patented invention adds nothing to the gains of the defendant, and the plaintiff has sustained no actual loss for which he can recover damages, the wrongful sale of the invention must go unredressed, except by nominal

O. G. 877; Ingels *v.* Mast (1875), 7 O. G. 836; 1 Flippin, 424; 2 Bann. & A. 24; Gould's Mfg. Co. *v.* Cowing (1874), 8 O. G. 277; 12 Blatch. 243; 1 Bann. & A. 375; Graham *v.* Mason (1872), 1 O. G. 609; Holmes, 88; 5 Fisher, 290.

That where part of the selling price was due to other matter than the plaintiff's invention, and he was allowed the whole profits, the cost of this other matter must be deducted, see Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1879), 17 Blatch. 24; 4 Bann. & A. 445.

That on a patent for a combination only the profits on the exact new features of the invention can be recovered, see Ingels *v.* Mast (1875), 7 O. G. 836; 1 Flippin, 424; 2 Bann. & A. 24.

That profits on the device alone, as sold separately, do not measure the damages when it is part of a machine and enhances the value of the machine itself if applied to it, see Gould's Mfg. Co. *v.* Cowing (1882), 105 U. S. 253; 21 O. G. 1277.

That profits are to be allowed though the defendant has improved the shape and effectiveness of the device, see Graham *v.* Mason (1872), 1 O. G. 609; Holmes, 88; 5 Fisher, 290.

That the invention being a unit, the profits of the monopoly cannot be divided among its parts arbitrarily, see Livingston *v.* Jones (1861), 2 Fisher, 207; 3 Wall. Jr. 330.

That profits due to an element not patented, which enters into the composition of patented articles, are sometimes allowed, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

damages and future prohibition. But this rule leaves the plaintiff in no worse position than he would have occupied at law, and equity does not aim to give a higher compensation than the law, although its methods of procedure often so result.

§ 1141. Computation of Profits where the Infringement Consists in Selling Articles in which the Patented Invention is Embraced and Increases the Number and Amount of Sales.

Where the presence of the patented invention, though adding nothing to the profits of the defendant on a single article, increases the number of his sales, and thus augments the gains which he derives from the manufacture and sale of the articles as a whole, another mode of computation must be followed. Here it is evident that all the profits on those articles, which would not have been sold had they not contained the patented invention, are due to the infringement;[1] and if these articles can be separated from the rest, their profits can be ascertained by deducting the cost of manufacture from the price received. In many cases this separation may be impossible, and if so, no profits can be computed or recovered. But where the introduction of the patented invention into the article makes it available for new uses and in new lines of business, those whose market has depended on the presence of the patented invention are easily distinguishable from those which might as readily have been sold without it, and the estimate of profits due to the invention can be as accurately and intelligibly made as if the entire article were covered by the patent.

§ 1142. Computation of Profits where the Infringement Consists in Selling Articles which Embrace the Patented Invention, and thence Derive their Entire Market Value.

Where the article, though embracing other features than those covered by the patent, so far derives its marketability

§ 1141. [1] That where no sale would take place were not the patented invention incorporated in the article sold, the sale and consequent profit are due to the invention, see § 1142 and notes, *post.*

from the presence of the invention that articles from which it is absent would be totally unsalable, the entire profit on the sales must be attributed to the infringement.[1] This may

§ 1142. [1] In Gould's Mfg. Co. *v.* Cowing (1882), 105 U. S. 253, Waite, C. J.: (255) "The rule applicable to this class of cases was well stated by Mr. Justice Strong, speaking for the whole court, in *Mowry v. Whitney* (14 Wall. 620). The subject-matter of that suit was a patent for an improvement in the process of manufacturing car-wheels, and in respect to the profits resulting to an infringer from the use of the patented process it was said, p. 651: 'The question to be determined . . . is, what advantage did the defendant derive from using the complainant's invention over what he had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result. The fruits of that advantage are his profits.' It does not necessarily follow from this that where the patent is for one of the constituent parts and not for the whole of a machine, the profits are to be confined to what can be made by the manufacture and sale of the patented part separately. If without the improvements a machine adapted to the same uses can be made which will be valuable in the market and salable, then, as was further said in that case, the inquiry is 'what was the advantage in cost, in skill required, in convenience of operation, or marketability,' gained by the use of the patented improvement? If the improvement is required to adapt the machine to a particular use, and there is no other way open to the public of supplying the demand for that use, then it is clear the infringer has by his infringement secured the advantage of a market he would not otherwise have had, and that the fruits of this advantage are the entire profits he has made in that market." 21 O. G. 1277 (1278); 11 Fed. Rep. 447 (447).

In Whitney *v.* Mowry (1886), 4 Fisher, 141, Swayne, J.: (145) "But it would seem to be very clear that if a party invents a machine, or anything else, that is perfectly valueless, having no salable commercial value, and which in every other respect is worthless because he cannot sell it, and then use in connection with that machine or structure, or article, whatever it may be, the invention of another, no matter how slight that invention may be, which gives it its entire market value, it would seem at first view that the amount to be recovered should be the entire amount of profit, because there is a proximate, inseparable connection between the old or useless article sold by means of the new invention which could not have been sold otherwise. In the case of a close monopoly, there is a profit made which, it would seem, at first view, is entirely due to the infringement of the patent right of another; and it would seem that the infringer ought not to be permitted to say, under such circumstances, that there should be an apportionment of the profits. But, on the other hand, take the case for instance of a railroad car, or anything else, the making of which involves a large expenditure of money; and then by the application of the invention of another, slight and trifling in its character, of very little cost, of no value except in connection with that structure, the application of that slight improvement is sufficient to turn the scale in the market so that nobody will buy the article except in connection with the patented invention. Suppose, in further illustration of this view of the subject, it be a

occur where an article previously in demand has been wholly superseded in the market by the same article containing a patented improvement. The original still preserves its former utility, and if marketable might become a source of profit to the seller. But if unsalable without the patented improvement no profit could arise, since in this form of infringement profits are the fruit of sales, not of utility, and, therefore, when made salable by the incorporation of the patented improvement, it is to this that both the sales and profits are due. Hence, in these cases, though with some hesitation on the part of certain judges, the entire profits on the sales are awarded to the plaintiff, notwithstanding the intrinsic value of the original invention, or its present usefulness to any one who might wish to employ it.[2]

railroad car, the cost of which is thousands of dollars, and some little invention is made in regard to the interior structure of the car or in its ornamentation, which is patentable under the act of 1861, yet the slight, the simple thing is such as to strike the public taste and judgment, and have such an effect in the commercial world that nobody will buy the article without that invention; yet it would seem to be a pretty hard measure of justice in a court of equity to say that the entire profits made on that large article should go into the pockets of the inventor and patentee of this small thing, which had been used without license or authority in connection with it."

Further, that where the plaintiff's device gives its entire value to the defendant's article, the profits of the entire article are to be accounted for, see Hurlburt *v.* Schillinger (1889), 130 U. S. 456; Callahan *v.* Myers (1888), 128 U. S. 617; Fifield *v.* Whittemore (1888), 33 Fed. Rep. 835; Welling *v.* La Bau (1888), 43 O. G. 115; Fay *v.* Allen (1887), 30 Fed. Rep. 446; Reed *v.* Lawrence (1886), 29 Fed. Rep. 915; Root *v.* Lake Shore & Mich. Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112; Zane *v.* Peck Brothers (1882), 23 O. G. 191; 13 Fed. Rep. 475.

That where the entire market value of a device depends on its infringing features, the profits are found by comparing the profits made by this device with those made by one not having the infringing features, see Garretson *v.* Clark (1879), 16 O. G. 806; 4 Bann. & A. 536.

[2] In reference to this point market value must not be confounded with salability. Market value is the price commanded by the article in open market. Salability may aid in fixing this price, and may determine what amount of profits may be derived from each sale and from all sales collectively. In infringements which consist in making and selling infringing articles all sales, and consequently all profits on sales, may depend upon the presence of the patented feature, however slight in itself the advantage thereby conferred. In the case of the railway car, used as an illustration in Mowry *v.* Whitney, *ante*, if the railway car were unsalable without the patented improvement, the sale itself, the price received, and the differ-

§ 1143. Burden of Proof Concerning the Amount of Profits Resulting from Infringing Sales.

The burden of proof concerning the receipt of profits by the defendant from the sale of the patented invention, and also concerning their precise amount, devolves upon the plaintiff.[1] While the defendant may be subjected to examination before the master, and while his books may be inspected and every other available method of investigation be pursued, it is still for the plaintiff to show by a preponderance of testimony the exact sum for which the defendant is accountable.[2] Profits are ascertained by computation, and computation requires certain data to which arithmetical processes may be applied with definite and invariable results. These are not a matter of speculation, or of compromise, or of arbitrary adjustment.[3] The price received for the patented invention

ence between price and cost, would all be directly attributable to the presence of the patented improvement, and the profits would properly be accounted for to the patentee. This is the result which would be reached in an action at law, if it were shown that the cars made and sold by the defendant would have been sold by the plaintiff, the profits of the sale being in that case the measure of the plaintiff's damages; and that the same is true in equity on an account of profits seems certain, notwithstanding the doubts of the learned judge.

§ 1143. [1] That the burden of proof as to the amount of damages or profits rests on the plaintiff, see § 1071 and notes, *ante*.

[2] That the defendant may be examined as a witness and his books inspected, see Equity Rule 77; Foote *v.* Silsby (1856), 3 Blatch. 507.

That the plaintiff must affirmatively show what profits are due to his invention, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628; Bell *v.* U. S. Stamping Co. (1887), 32 Fed. Rep. 549; Garretson *v.* Clark (1884), 111 U. S. 120; 27 O. G. 524; Schillinger *v.* Gunther (1878), 14 O. G. 713; 15 Blatch. 303; 3 Bann. & A. 491.

That every intendment is against a wilful infringer and the plaintiff's proof of loss should be liberally construed in his favor, see Bigelow Carpet Co. *v.* Dobson (1882), 15 Phila. 476; 10 Fed. Rep. 385; 21 O. G. 1200.

[3] That the evidence must show the amount of profits and not leave them open to conjecture, see Ingersoll *v.* Musgrove (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304.

That the right to recover profits rests on the principle that the defendant, having unlawfully appropriated benefits belonging to the plaintiff, is accountable for them, and these, being ascertainable by computation, do not rest in the discretion of the court or jury, see Jenkins *v.* Greenwald (1857), 2 Fisher, 37; 1 Bond, 126.

That an arbitrary award of one half the net profits on the whole article as due to the plaintiff's device is not proper, since the exact amount is to be ascertained by computation, see Calkins *v.* Bertrand (1881), 8 Fed. Rep. 755; 10 Bissell, 445.

That there is no presumption that

and the cost of producing it are the two factors which must affirmatively appear, that by the subtraction of one from the other the profit may be known. Thus when the article sold is entirely covered by the patent, or when though embracing other features it derives its marketability solely from the presence of the patented invention, the plaintiff must prove the amount of the receipts and the expenditures, the difference in that case being the profit due to the infringement. Where the article would be marketable without the patented invention, but sells for a higher price or is manufactured at less cost when it contains the features covered by the patent, the evidence must separate the patented invention from the other portions of the article, and disclose how much of the increased receipts or lessened cost arises from its presence, and what proportion of the profits on each article is properly attributable to its use.[4] When, in the latter case,

the defendant's percentage of profit is the same as that of the plaintiff, but the amount must be specifically shown, see Roemer *v.* Simon (1887), 31 Fed. Rep. 41 ; 40 O. G. 1456.

That when the profits cannot be determined by evidence they cannot be recovered as damages, see Blake *v.* Greenwood Cemetery (1883), 16 Fed. Rep. 676 ; 21 Blatch. 222.

That profits are not allowed unless capable of measurement, see Locomotive Safety Truck Co. *v.* Pennsylvania R. R. Co. (1880), 2 Fed. Rep. 677; 5 Bann. & A. 514 ; 14 Phila. 432.

That royalties paid by the defendant or others do not afford a measure of profits, see Tilghman *v.* Proctor (1888), 125 U. S. 136 ; 43 O. G. 628 ; Wooster *v.* Taylor (1878), 14 Blatch. 403 ; 3 Bann. & A. 241 ; Knox *v.* Great Western Quicksilver Mining Co. (1878), 14 O. G. 897; 6 Sawyer, 430 ; 4 Bann. & A. 25.

That if the defendant offers evidence to show that no profits were realized and the plaintiff does not prove the contrary, only nominal damages are allowed, see Calkins *v.* Bertrand (1881), 8 Fed. Rep. 755 ; 10 Bissell, 445.

[4] In Garretson *v.* Clark (1884), 111 U. S. 120, Field, J.: (121) "When a patent is for an improvement, and not for an entirely new machine or contrivance, the patentee must show in what particulars his improvement has added to the usefulness of the machine or contrivance. He must separate its results distinctly from those of the other parts, so that the benefits derived from it may be distinctly seen and appreciated. The rule on this head is aptly stated by Mr. Justice Blatchford in the court below. 'The patentee,' he says, 'must in every case give evidence tending to separate or apportion the defendant's profits and the patentee's damages between the patented feature and the unpatented features, and such evidence must be reliable and tangible, and not conjectural or speculative ; or he must show, by equally reliable and satisfactory evidence, that the profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine, as a marketable ar-

the relation between cost and receipts remains unchanged whether or not the article contains the patented invention, and whatever benefit may have accrued to the defendant from the infringement assumes the form of an increase in sales, the plaintiff must separate the sales due to the presence of his invention from those which would have taken place without it, and prove the amount of profits derived by the defendant from such separated sales. The evidence upon all these points must be direct; or, if circumstantial, the inferences drawn therefrom must be conclusive.[5] The fact that an article containing the patented invention practically commands the market does not of itself show that all sales or profits are necessarily attributable to the infringement; nor does the fact that the defendant sold, at the same time, [illegible] article, is properly and legally attributable to the patented feature.'" 27 O. G. 524 (524).

Further that the plaintiff must prove that the entire profits of the defendant are due to his invention or he must separate the profits due thereto from all others, see Tuttle v. Gaylord (1886), 28 Fed. Rep. 97; 36 O. G. 604; Calkins v. Bertrand (1881), 8 Fed. Rep. 755; 10 Bissell, 445; Kirby v. Armstrong (1881), 5 Fed. Rep. 801; 19 O. G. 661; 10 Bissell, 135; Schillinger v. Gunther (1878), 14 O. G. 713; 15 Blatch. 303; 3 Bann. & A. 491; Black v. Munson (1877), 14 Blatch. 265; 2 Bann. & A. 623.

That where the plaintiff's device is an improvement he must show what proportion of the profits were due to it and to the original device, or only nominal damages will be allowed, see Bostock v. Goodrich (1885), 25 Fed. Rep. 819; 34 O. G. 1047.

As to the application of this rule to the infringement of a design patent, see Dobson v. Hartford Carpet Co. (1885), 114 U. S. 439, where Blatchford, J., says: (445) "The rule in question is even more applicable to a patent for a design than to one for mechanism. A design or pattern in ornamentation or shape appeals only to the taste through the eye, and is often a matter of evanescent caprice. The article which embodies it is not necessarily or generally any more serviceable or durable than an article for the same use having a different design or pattern. Approval of the particular design or pattern may very well be one motive for purchasing the article containing it, but the article must have intrinsic merits of quality and structure to obtain a purchaser, aside from the pattern or design; and to attribute, in law, the entire profit to the pattern, to the exclusion of the other merits, unless it is shown by evidence as a fact that the profit ought to be so attributed, not only violates the statutory rules of 'actual damages' and of 'profits to be accounted for,' but confounds all distinctions between cause and effect." 31 O. G. 787, (789). See also Tomkinson v. Willetts Mfg. Co. (1888), 34 Fed. Rep. 536; Dobson v. Dornan (1886), 118 U. S. 10; 35 O. G. 750.

[5] That the evidence must afford all necessary data for the computation and be direct and positive, see § 1157 and notes, *post*.

profit, articles from which the patented elements were absent, determine that no portion of the profit on the infringing article was due to the unlawful use of the invention.[6] The burden thus imposed upon the plaintiff may be difficult to bear, and may involve a tedious research and considerable expense without available results, but no other rule would be just to the defendant, or tend in any manner to protect the equitable rights of either party. And since the power to award damages has been conferred on courts of equity, all the redress obtainable in any forum by the plaintiff can be afforded him, although he fails to make his claim to profits good.

§ 1144. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention.

In the second class of cases, where the infringing act consists in the unlawful use, or making and use, of the patented invention, the data for computation are less capable of definite ascertainment. The cost of using the invention may present little difficulty, but the benefit derived from its employment rarely assumes the form of a specific sum of money, like the price received for an article sold, and hence requires the application of different and more complicated rules for its detection. The benefit derived from the use of any art or instrument may manifest itself either in the increase of direct pecuniary receipts, or in the decrease of expenses. A process or machine whose products, though entailing the same cost of manufacture on the maker, command a higher price, confers upon its user an advantage measured by the increment of price received. An art or article whose use

[6] That the fact that the machine, with the improvements, commands the market does not show that all the profits are due to the improvement, see Garretson v. Clark (1878), 14 O. G. 485; 15 Blatch. 70; 3 Bann. & A. 352; Gould's Mfg. Co. v. Cowing (1877), 12 O. G. 942; 14 Blatch. 315; 3 Bann. & A. 75. That if the defendant sold the infringing device at a profit it is not affected by the fact that he sold other non-infringing devices at the same profit, as each stands by itself, see Simpson v. Davis (1884), 22 Fed. Rep. 444; 22 Blatch. 113.

results in lessening the expenses of a business, without increasing its receipts, is profitable to its employer in proportion to the saving it involves. Thus the profits from the unlawful use of a patented invention may assume different forms according to the nature of the invention and the circumstances under which it is used, and consist either in direct gains, or in savings, or in both together.

§ 1145. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Receipts and Savings Taken as the Minuend.

In computing the profits derived from the unlawful use of a patented invention, the entire amount received or saved by the defendant cannot be taken as one factor of the problem, except in a few peculiar cases. If the defendant is paid a definite sum for using the invention, or if the product which he makes and sells can be produced only by the infringing process or machine, or if the saving in expense can be accomplished neither in the whole nor in part by any other method, then may the total receipts for the use of the invention or the sale of its products, or the total savings, be taken as the minuend, from which the cost being deducted the remainder may be properly regarded as the profit due to the infringement.[1] But, under the present doctrine of our courts upon this subject, where the product is producible by other means, or the saving might entirely or in part result from the use of other arts or instruments, the advantage derived by the defendant from the unlawful use of the patented invention cannot be measured by the difference between the gross amount of his receipts or savings and his expenses. The value of the use of an invention is held to be the value of the use of that new idea of means which the inventor has embodied and expressed in his article or process, and to which only the protection of his patent is extended, since whatever inventions exist in the arts, open to the public at the date

§ 1145. [1] That when the article can be made only by the patented process the entire profits belong to the patentee, see Mulford *v.* Pearce (1877), 11 O. G. 741; 14 Blatch. 141; 2 Bann. & A. 542.

of his inventive act, may be employed by all, and to the whole community thus belongs already the entire benefit derivable from their unrestricted use. When any new invention is perfected, therefore, the benefit that it confers on its employer consists not of the whole advantage flowing from its use, but of the advantage it affords in excess of that obtainable by other means which have been previously bestowed upon the public.[2] Upon this doctrine rests the rule that where the defendant's savings or receipts could have been secured, to any extent, by the use of arts or articles which were open to the public at the date of the invention covered by the patent, the proportion of such savings or receipts which may enter into the computation of the profits due to the infringement is ascertained by deducting from their gross amount whatever would have been received or saved by the employment of such prior means.[3] In the application of this rule no attention is

[2] In Locomotive Safety Truck Co. *v.* Penna. R. R. Co. (1880), 2 Fed. Rep. 677, Strong, J.: (679) "This rule is founded upon the soundest reason. It is only that which was previously not known, or, in other words, it is only the addition to human knowledge and convenience which a patentee has made, that he can be said to own. The Patent Laws give him an exclusive right to that addition, and to the advantages resulting from it, and to nothing more. Undoubtedly it may be a benefit to the community to have two modes of doing certain work instead of one, both equally economical and convenient, accomplishing the same result, and each still patentable; but, as was well remarked by the master: 'Unless a patentee can show such an absolute advantage in the use of his patent over results which could be reached by other processes in common and unrestricted use, there has been nothing really gained, no advance made by his invention. In such a case, though he may maintain a monopoly over his patented machine, process, or combination, and exact such damages as he may be able to show he has suffered from an infringer, he cannot claim any portion of what has been realized as profits in any sense owing or due to him, for the reason that the infringer could just as well have obtained such product or result without his aid, or the benefit of his work or ideas.'" 14 Phila. 432 (432); 5 Bann. & A. 514 (515). But see § 1062, note 7, *ante*, where this doctrine is criticised and limited.

[3] That the profits derived from the use of a patented invention are measured by the advantage gained by the infringer in excess of what he would have obtained by using means already open to the public and able to produce the same results, see Coupe *v.* Weatherhead (1888), 37 Fed. Rep. 16; McMurray *v.* Emerson (1888), 36 Fed. Rep. 901; Shannon *v.* Bruner (1888), 33 Fed. Rep. 871; Creamer *v.* Bowers (1888), 35 Fed. Rep. 206; Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628; Turrill *v.* Illinois Central R. R. Co. (1880), 20 Fed. Rep. 912; Knox *v.* Great Western Quicksilver Mining Co. (1878), 14 O. G.

paid to the existence of other prior patented inventions which the defendant had or could have acquired the right to use, nor to any inventions subsequent to the one covered by the patent, whether or not they have been patented. The plaintiff's patent, if valid, secures to him the exclusive use of his invention, and those who use it without right cannot defend nor palliate nor in any wise escape the consequences of their unlawful acts upon the ground that they might, with equal advantage to themselves, have violated the rights of others, or have obtained other privileges under different patents, or have availed themselves of subsequent inventions.[4] Having

397; 6 Sawyer, 430; 4 Bann. & A. 25; Mers v. Conover (1876), 11 O. G. 1111; Ingels v. Mast (1875), 7 O. G. 836; 1 Flippin, 424; 2 Bann. & A. 24; Black v. Thorn (1874), 7 O. G. 176; 12 Blatch. 20; 1 Bann. & A. 155; Turrill v. Illinois Central R. R. Co. (1873), 5 Bissell, 344; Mowry v. Whitney (1872), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 402.

That no profits are recoverable where other methods in common use produce the same results with equal facility, see Black v. Thorn (1884), 111 U. S. 122; 27 O. G. 415.

[4] In Turrill v. Illinois Central R. R. Co. (1883), 20 Fed. Rep. 912, Harlan, J.: (914) "If the position of defendants' counsel be tenable, a prior patent may be practically destroyed, and the owner deprived of all profits arising therefrom, by obtaining from a junior patentee a license to use his invention. If the latter be equally useful with the former, the claim of the prior patentee for profits realized from the actual use of his invention by an infringer can always be defeated by showing that the infringer was at liberty to use, although he did not use, the subsequent invention, and might have made thereby the same or greater profits at less cost. Indeed, upon the principle or theory asserted by defendants' counsel, the junior patentee may himself use the invention of a prior patentee without liability to the latter for profits, provided he shows that had he used his own invention he would have accomplished the same or better results at the same or less cost. I do not believe such to be the law, although in several cases cited by counsel there are general expressions which seem to sustain that view. But, after close study of those cases, I am of opinion that in no one of them was the precise point now under consideration in the mind of the court, or necessarily involved in the decision."

In Herring v. Gage (1878), 15 Blatch. 124, Wallace, J.: (128) "In settling an account between a patentee and an infringer, the real inquiry is: What is the advantage which the infringer has derived from his use of the invention? If he has derived a profit attributable directly to the employment of the invention, that profit belongs to the patentee and is the measure of his recovery. Here the defendants saved a considerable quantity of flour by the use of the complainants' property, which, until they used it, had been lost. Their gain is directly traceable to the use of the invention. How is it important to ascertain what they might have saved, if, instead of using the complainants' property they had used some other device? How are they in a better position than

voluntarily selected his invention as their method of procuring receipts or effecting savings, they are accountable for whatever savings or receipts are due to its employment, though other means which might by wrong or by right have been acquired would have resulted in an equal or a greater benefit.

§ 1146. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Actual Receipts and Savings Alone Regarded.

Into this factor of the computation, moreover, no element can enter unless it has been actually saved or received by the defendant, either in money or in some form of property or they would be if there had been a different device which was patented, and they had acquired the right to use it from the patentee, but, instead of using it, saw fit to employ the complainants' device? Mowry *v.* Whitney was a case where the entire profit of the manufacture of an article made by the patented process was given upon an accounting, when that profit was largely due not to the advantage derived from the patented process, but from that of other processes actually used by the manufacturer, and which he had the right to use; and what was said in that case, pertinent to such a state of facts, is not to be assumed as the enunciation of the rule where the profit has been made directly by the use of the patentee's device. Such a rule would impose an extraordinary burden upon a patentee, because it would require him, when seeking for redress, to explore the whole realm of practical and theoretical mechanism, to ascertain and demonstrate that what was realized by the wrongful appropriation of his invention could not have been made by the use of any other device or substitute which the infringer might have employed. The infringer is, at the election of the patentee, treated as a trustee, and as such, required to account for the profits actually made by the use of the patentee's property. It would be a novel defence to permit a trustee who has made a profit by the use of the money or property of his *cestui que trust*, to show that he would have made an equal profit if he had used the money or property of a third person, or if he had used his own money or property. It was quite unnecessary, in my judgment, to enter into any investigation of the savings which the defendants might have realized if they had used some other than the complainants' device, and the exception to the master's finding upon the question cannot avail the defendants." 3 Bann. & A. 396 (400). See also Burdett *v.* Estey (1880), 3 Fed. Rep. 566; 19 Blatch. 1; 5 Bann. & A. 308; Knox *v.* Great Western Quicksilver Mining Co. (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25; American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

That the fact that an equally useful invention might have been obtained at a less royalty may be considered, see Ingels *v.* Mast (1875), 7 O. G. 836; 1 Flippin, 424; 2 Bann. & A. 24.

service which has a definite ascertainable money value.[1] What the defendant might have gained or saved by greater skill or diligence in the use of the invention, or with larger capital at his command, or if he had collected all his debts, is immaterial.[2] Equally unimportant is the fact that he enjoyed benefits of which no pecuniary estimate is possible, such as an increase in his physical comfort or his intellectual acquisitions.[3] These savings and receipts must also be di-

§ 1146. [1] In Vaughan *v.* Central Pacific R. R. Co., (1877), 4 Sawyer, 280, Sawyer, J.: (282) "But in order to maintain a suit in equity for an account of profits, there must be actual profits resulting to the infringer susceptible of computation or estimation, of which the patentee could be deprived and with which the infringer can be charged as trustee. If from the character of the invention there can be nothing in the nature of profits of which the patentee can be deprived, there is no basis for charging the infringer with receiving profits for his benefit, and nothing for which he can be called upon to account. As the defendant's counsel well observe, if one should invent and patent a more comfortable bed than any heretofore existing, and another should infringe the patent by using it, the use of the bed might well be more agreeable, and afford greater comfort and satisfaction to the infringer than any other; yet it would be absurd to say that he derived any pecuniary profits from its mere use with which he could be charged as the trustee of the holder of the patent; or that there is any basis of profits in the legal sense of the term for which he could be called upon in a court of equity to account. It would be impossible to predicate profits in any just sense upon such an infringement. It could furnish no element for the basis of an account. The same is true of many inventions." 3 Bann. & A. 27 (29).

That where the profits are not in money but in general advantage, and must be compensated for in an estimated sum, a bill for account is not proper, but the remedy is at law, see Sayles *v.* Richmond, Fredericksburg, & Potomac R. R. Co. (1879), 3 Hughes, 172; 4 Bann. & A. 239; 16 O. G. 43.

[2] That the exact profits or savings, as the defendant actually used the invention, are to be accounted for, see Williams *v.* Rome, Watertown, & Ogdensburgh R. R. Co. (1880), 17 O. G. 1447; 18 Blatch. 181; 2 Fed. Rep. 702; 5 Bann. & A. 423.

That where the profit consists in saving time, the question is not how much might have been saved but how much was saved, see Munson *v.* City of New York (1883), 16 Fed. Rep. 560; 21 Blatch. 342.

That profits are to be based on the actual production of the defendant's infringing articles, not on their productive capacity, see Webster *v.* New Brunswick Carpet Co. (1875), 9 O. G. 203; 2 Bann. & A. 67.

That no profits are recoverable where the defendant through his unskilfulness or unbusiness-like habits made none, see Conover *v.* Mers (1873), 6 Fisher, 506; 11 Blatch. 197.

That no profits should be charged on work for which the defendants cannot collect their pay, see American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

[3] That an increase in comfort or convenience is not a profit, see Vaughn *v.*

rectly traceable to the employment of the patented invention, excluding all contingent or remote advantages whose dependence upon the infringing act is open to a reasonable doubt, and, therefore, may be due to other causes.[4]

§ 1147. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Ascertainment of Receipts from the Unlawful Use of the Invention.

In estimating the proportion of receipts which are chargeable to the defendant as the profits arising from his use of the invention, the same general methods are pursued as in cases of unlawful sales. Such receipts consist either of compensation paid to the infringer for his use of the invention, or of prices obtained by him for products made by the infringing process or device. Where the receipts are compensation for his unlawful use of the invention, their gross amount less the expenses which attend the use are the profits due to the infringement.[1] Among these expenses are to be allowed

Central Pacific R. R. Co. (1877), 4 Sawyer, 280; 3 Bann. & A. 27.

[4] In Piper *v.* Brown (1873), 3 O. G. 97, Shepley, J.: (98) "Where profits are recoverable by the owner of a patented invention against an infringer, they are such profits or gains as result directly or immediately from the wrongful act of the infringer. Remote and contingent profits or gains, depending upon the result of successful schemes or investments, are never allowed. The resultant profits are, ordinarily, best arrived at by determining the difference between the actual ascertained cost and the actual ascertainable value to the infringer, which value, in case of sales by him is the price obtained or the market value of the thing sold. Profits contingent upon future bargains or speculations, or future states of the market, are not estimated and are not recoverable. The distinction between such profits as are direct and immediate and those which are remote and contingent is recognized in Masterton *v.* Mayor of Brooklyn, 7 Hill, 61, and the Philadelphia, W. and B. Railroad *v.* Howard, 13 Howard, 307." Holmes, 196 (197); 6 Fisher, 240 (241).

That where a large amount of merchandise is withdrawn from the market by the use of the patented process and the price of the remainder is thereby enhanced, the effect is too remote to be estimated upon as indicating profits, see Piper *v.* Brown (1873), 3 O. G. 97; Holmes, 196; 6 Fisher, 240.

§ 1147. [1] The profits made by the sale of an infringing article, and the profits made where an exact sum is received as compensation for an infringing use, are practically identical in character and in their relation to the patented invention. In the former the invention is used as a means of obtaining a compensation measured by the difference between cost and receipts, in

the cost of the infringing device or of the materials consumed in the process, the sums paid for power, labor, salaries, and shop-rent, the value of the use of buildings, tools, and other property necessary to the performance of the infringing act, the current running expenses of the enterprise, and the loss by waste; but not the value of the time and skill of the infringer, nor any loss he may sustain in other branches of his business or in other employments of the patented invention.

§ 1148. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Ascertainment of Receipts from the Sale of Products made by the Unlawful Use of the Invention.

*When the receipts consist of prices obtained by the defend*ant for products made by the infringing process or device, inquiry must be first directed to the degree in which the market value of the product depends on the employment of the patented invention. Where the complete product is produced in marketable condition by the infringing art or instrument, or where although containing other elements its entire market value is derived from those which have resulted from the infringing process or device, the total receipts are evidently due to the unlawful use of the invention. But where these elements bestow upon the product a mere fraction of its market value, a division of the price obtained for the whole product must be effected, in the ratio of the market values due to these and to the extraneous elements, and only the amount attributable to the former must be regarded as

the latter the act of using the invention is sold for a specific price. The cost of making and marketing the article is the equivalent of the cost of performing the act of using; the profit on the article sold is the equivalent of the price received for the infringing use. The rules governing the charges and allowances in the account are, therefore, the same, so far as the different methods of infringement permit. Whatever expense is incurred by the defendant in performing the act of using should be credited to him, and against it should be debited the specific sum received for the infringement. (See § 1139 and notes, *ante*, for these items in detail.) The only doubt attaches to the allowance of the cost of the infringing device, which still remains his property though he is unable to employ it, and which though an expense involved in the performance of the act of using is not one properly chargeable against the plaintiff.

received from the infringement.[1] Deducting from these receipts the expense of applying the invention to the manufacture of the product and its proportion of the cost of marketing, including the rental of the necessary buildings, the sums paid for machinery, power, materials, wages, storage, freight, and commissions, the value of the use of tools, repairs, waste, and a proper share of the current expenses of the business, the remainder constitutes that part of the receipts which may contribute toward the profits arising from the use of the invention.[2] If it appears at this stage of the computation that no profit has accrued to the defendant which can be carried to the credit of the patented invention, the inquiry into his receipts will terminate, unless the presence of the elements due to the infringing instrument or process has increased the sale of his products to a definitely measurable extent, in which case all the profit from such increment of sales must be attributed to the use of the invention.[3] The net amount received from the unlawful use of the invention having been thus ascertained, the present rule seems to require that a comparison next be instituted between this net amount and that which would have been received by the de-

§ 1148. [1] That the amount of the profits due to the use of the precise invention in question must be separated and distinguished from all others, see Faulks *v.* Kaup (1882), 22 O. G. 2244; 10 Fed. Rep. 675; Kirby *v.* Armstrong (1881), 19 O. G. 661; 10 Bissell, 135; 5 Fed. Rep. 801; Garretson *v.* Clark (1879), 16 O. G. 806; 4 Bann. & A. 536; Garretson *v.* Clark (1878), 14 O. G. 485; 15 Blatch. 70; 3 Bann. & A. 352; Buerk *v.* Imhaeuser (1876), 10 O. G. 907; 14 Blatch. 19; 2 Bann. & A. 452; Robertson *v.* Blake (1876), 94 U. S. 728; 11 O. G. 877.

That where the invention is an improvement the profits due to it must be separated from those due to the original, see Kirby *v.* Armstrong (1881), 19 O. G. 661; 10 Bissell, 135; 5 Fed. Rep. 801; Garretson *v.* Clark (1878), 14 O. G. 485; 15 Blatch. 70; 3 Bann. & A. 352; Gould's Mfg. Co. *v.* Cowing (1874), 1 Bann. & A. 375; 8 O. G. 277; 12 Blatch. 243; Graham *v.* Mason (1872), 1 O. G. 609; Holmes, 88; 5 Fisher, 290.

That if the plaintiff's patent covers all that is meritorious in the device used by the defendant, the plaintiff should recover all that the defendant has made, while if other improvements contributed to it an allowance must be made for them, see Hurlburt *v.* Schillinger (1889), 130 U. S. 456; American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

[2] For the items allowed as the cost of manufacturing, see § 1139 and notes, *ante*.

[3] For the rules governing profits arising from an increase of sales, see § 1062 and notes, *ante*.

fendant had he employed, in place of the infringing article or art, some instrument or process which was open to the public before the conception of the patented invention.[4] If no such open process or device existed by which the product could have been produced, the net amount, arrived at as above described, is chargeable to the defendant as a profit for which he must account to the plaintiff. But if this open process or device would have produced a product substantially identical with that already made and sold by the defendant and having market value, the difference between the net amount arising from the sale of such a product and the net amount received by the defendant indicates the profit which he has derived from the infringement, through the sale of products made by his unlawful use of the invention.[5]

§ 1149. Computation of Profits where the Infringement Consists in the Use, or Manufacture and Use, of the Patented Invention: Ascertainment of Savings.

The profit derived through savings is less susceptible of direct computation than that accruing through receipts. A saving in the expense of manufacturing and marketing a product is included in the estimate of the profits resulting from its sale.[1] If its cost and price are equal, as the product is actually made and sold, a saving in the cost is an escape from an amount of loss equivalent to the saving, and under the presumption that at all events the product would have been

[4] That the infringer of a process must account for the advantage derived from it over what he would have obtained without it, but not for all the profits of the manufacture, see Mowry *v.* Whitney (1872), 14 Wall. 620; 1 O. G. 492; 5 Fisher, 494.

See, also, as to the same subject, §§ 1062, 1145, and notes, *ante*.

[5] That the true rule would, in this case, give the entire net amount of profit to the plaintiff, unless the process or device were a mere improvement on the one open to the public, see § 1062, note 7, *ante*.

§ 1149. [1] That advantage in the reduction of cost is a profit, see Knox *v.* Great Western Quicksilver Mining Co. (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25.

That savings in cost by infringement may be recovered as profits, see Campbell *v.* James (1880), 18 O. G. 1111; 18 Blatch. 92; 2 Fed. Rep. 338; 5 Bann. & A. 354; Herring *v.* Gage (1878), 15 Blatch. 124; 3 Bann. & A. 396; Tilghman *v.* Mitchell (1871), 4 Fisher, 599; 9 Blatch. 1.

That a saving is not a profit unless it increases a gain or diminishes a loss, see Bell *v.* U. S. Stamping Co. (1887), 32 Fed. Rep. 549.

produced and put upon the market, is properly regarded as a profit.[2] But where the business carried on by the defendant is of a general character, consisting not in the manufacture of specific products but in service to the public, and the saving is distributed over numerous items in the cost of the whole enterprise, while it may be perfectly apparent that the defendant has been benefited largely by the use of the invention, the amount of his pecuniary advantage may be beyond the possibility of exact discovery or calculation. What can be shown in such cases, either by direct evidence or by fair inference from the nature of the enterprise and the general effect of the employment of the patented invention on its profits as a whole, to have been saved by the infringement, is to be credited to the plaintiff as his profit. And where the enterprise has been conducted at a loss, any excess of loss which would have been incurred without the use of the infringing art or instrument is also to be reckoned as a profit and accounted for by the defendant.[3]

[2] That profits are recoverable for the improvement though the whole device was unprofitable, see Graham *v.* Mason (1872), 5 Fisher, 290; 1 O. G. 609; Holmes, 88.

[3] In Elizabeth *v.* Pavement Co. (1878), 97 U. S. 126, Bradley, J.: (138) "But one thing may be affirmed with reasonable confidence, that if an infringer of a patent has realized no profit from the use of the invention, he cannot be called upon to respond for profits; the patentee, in such a case, is left to his remedy for damages. It is also clear that a patentee is entitled to recover the profits that have been actually realized from the use of his invention, although, from other causes, the general business of the defendant, in which the invention is employed, may not have resulted in profits,— as where it is shown that the use of his invention produced a definite saving in the process of a manufacture. (Mowry *v.* Whitney, 14 Wall. 434; Cawood Patent, 94 U. S. 695.) On the contrary, though the defendant's general business be ever so profitable, if the use of the invention has not contributed to the profits, none can be recovered. The same result would seem to follow where it is impossible to show the profitable effect of using the invention upon the business results of the party infringing. It may be added, that where no profits are shown to have accrued, a court of equity cannot give a decree for profits, by way of damages, or as a punishment for the infringement. (Livingston *v.* Woodworth, 15 How. 559.) But when the entire profit of a business or undertaking results from the use of the invention, the patentee will be entitled to recover the entire profits, if he elects that remedy. And in such a case, the defendant will not be allowed to diminish the show of profits by putting in unconscionable claims for personal services or other inequitable deductions. Rubber Co. *v.* Goodyear, 9 Wall. 788."

Further, that profits may exist though the business is generally unprofitable,

§ 1150. Burden of Proof on the Plaintiff to Show the Amount of Receipts or Savings.

Whether an estimate of profits proceeds upon the basis of receipts or savings, it is the duty of the plaintiff to establish their existence and amount by reliable and tangible proof. The difficulty in procuring testimony by which this can be done may be insuperable, but no dilemma of the plaintiff warrants the master or the court in arbitrarily assuming any other measure of the profits than that which is determined by the evidence.[1] Each stage of the computation must be reached by arithmetical processes employing data furnished by the testimony, and fixing that proportion of receipts or savings which is due to the infringing use of the invention; and what the plaintiff cannot thus disclose he cannot claim as profits.[2] The presumptions of law are, however, in his favor in all cases of wilful infringement, and the rule requiring complete proof will not be strained against him. If from the data furnished a reasonable calculation can be made, he will not be denied relief upon the ground that a higher degree

see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628; Knox *v.* Great Western Quicksilver Mining Co. (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25; Illinois Central R. R. Co. *v.* Turrill (1876), 94 U. S. 695; 12 O. G. 709; Mers *v.* Conover, (1876), 11 O. G. 1111; Conover *v.* Mers (1873), 6 Fisher, 506; 11 Blatch. 197; Hitchcock *v.* Tremaine (1872), 5 Fisher, 310; 9 Blatch. 385.

§ 1150. [1] As to the duty of the plaintiff in proving the amount of profits, and the evidence on which the computation must be based, see § 1143, and notes, *ante*, and § 1157 and notes, *post*.

[2] That the plaintiff must apportion the defendant's profits, and show how much resulted from his own invention by reliable and tangible proof, or else he must show that all the profits were due to his invention, see Calkins *v.* Bertrand (1881), 8 Fed. Rep. 755; 10 Bissell, 445; Kirby *v.* Armstrong (1881), 5 Fed. Rep. 801; 19 O. G. 661; 10 Bissell, 135.

That where the patent covers only one feature of the defendant's device the proof must separate the profit due to the patented invention, or only nominal damages can be awarded, see Tuttle *v.* Gaylord (1886), 28 Fed. Rep. 97; 36 O. G. 694; Garretson *v.* Clark (1884), 111 U. S. 120; 27 O. G. 524; Schillinger *v.* Gunther (1878), 3 Bann. & A. 491; 14 O. G. 713; 15 Blatch. 303; Black *v.* Munson (1877), 14 Blatch. 265; 2 Bann. & A. 623.

That on a suit for infringing one Claim of a patent the plaintiff must confine the profits to the Claim infringed, and cannot show that the invention as an entirety was better and more profitable than any other in use, unless its whole advantage resided in the feature embraced in this Claim, see Fischer *v.* Hayes (1884), 22 Fed. Rep. 529.

of certainty might be desirable, especially where the uncertainty arises from the defendant's concealment or neglect.[3]

§ 1151. Computation of Profits from Subordinate Methods of Infringement: Commissions on Sales: Repairs, &c.

Profits may be derived from the unlawful use of an invention in other ways, subordinate to those already noticed. A defendant who does not manufacture the infringing article or sell it on his own account, but on commission, receives therefrom a profit measured by the amount of the commission less that proportion of his general expenses which constitutes the cost of sale.[1] Wages received for the repairing of infringing articles or of their integral parts, deducting the expense incurred by the repairer, but not the value of his personal services, may leave a residue of profit which should be credited to the invention.[2] But where the purchaser of an infringing article pays to the wrongful maker and vendor the same price which the plaintiff would have charged, the advantages derived from its enjoyment contain no element of profit due to the infringement, the lawful and unlawful use of the invention resulting in the same measure of expense and benefit to the defendant, whose liability for the infringing use is therefore in the form of damages, and not of profits.[3]

[3] That reasonable certainty is all that is required from the plaintiff, where the facts are peculiarly within the defendant's knowledge, see Creamer *v.* Bowers (1888), 35 Fed. Rep. 206; Lewis *v.* Standard Laundry Mach. Co. (1883), 21 Blatch. 184.

That the doctrine of confusion of goods does not apply where there is mere confusion of accounts and the articles themselves cannot be mixed, see National Car Brake Shoe Co. *v.* Terre Haute Car Mfg. Co. (1884), 28 O. G. 1007; 19 Fed. Rep. 514.

That an infringer is liable for all the profits on an article used as an entirety unless he can show that a part resulted from the employment of something else, see Elizabeth *v.* Pavement Co. (1877), 97 U. S. 126.

§ 1151. [1] That one who sells upon commission is accountable for his commissions on his sales, and may be enjoined, when he makes a profit distinct from that of his employers, see Steiger *v.* Heidelberger (1880), 4 Fed. Rep. 455; 18 O. G. 1463; 18 Blatch. 426.

That a commission agent may be sued for infringement in one district though a suit may be pending against his principal in another, see Steiger *v.* Heidelberger (1880), 18 O. G. 1463; 4 Fed. Rep. 455; 18 Blatch. 426.

[2] That the profits made by repairing infringing devices, or on parts sold for such repairs, are to be accounted for, see Graham *v.* Mason (1872), 1 O. G. 609; Holmes, 88; 5 Fisher, 290.

[3] That where a city hired infringing contractors to pave, and paid them as

§ 1152. Computation of Profits as Determined by the Duration of the Infringement: Interest.

The plaintiff is entitled to recover all profits derived by the defendant through his infringing acts, from the date of the issue or re-issue of the patent to the date of the accounting, irrespective of the price paid by the plaintiff for the patent or the royalties due from him to his licensor.[1] Whether he can recover interest on such profits, and if so for what period it must be computed, depends upon the mode in which the profits have accrued. In certain cases where profits are taken as a measure of damages in a court of law they are treated as unliquidated until ascertained by verdict, and,

much as it would have had to pay the the invention after the first decision, plaintiff, it was held that the city had made no profit, and was liable for none, but might be liable in damages, see Elizabeth *v.* Pavement Co. (1877), 97 U. S. 126.

§ 1152. [1] That when the bill limits the time of the infringement the account cannot go beyond it, see Creamer *v.* Bowers (1888), 35 Fed. Rep. 206.

That profits are to be accounted for to the time of taking the account, however derived from the invention, see Knox *v.* Great Western Quicksilver Mining Co. (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25; Tatham *v.* Lowber (1857), 4 Blatch. 86.

That the value of an infringement is its value at the date of infringement, see National Car Brake Shoe Co. *v.* Terre Haute Car Mfg. Co. (1884), 28 O. G. 1007; 19 Fed. Rep. 514.

That when the patent was antedated under the Act of 1836, the defendant was liable for all profits after the time to which it was antedated, see Burdett *v.* Estey (1880), 3 Fed. Rep. 566; 19 Blatch. 1; 5 Bann. & A. 308.

That where the Supreme Court has held the patent invalid and has afterwards sustained it, the infringer is liable for profits arising from his use of see Tilghman *v.* Proctor, (1888), 125 U. S. 136; 43 O. G. 628.

That an account for profits accruing after the suit commenced will be ordered only where the infringement began before the suit and was continued afterwards, see Marsh *v.* Nichols (1888), 128 U. S. 605.

That an assignee can recover the entire profits whatever royalty arrangements he may have with the patentee, see Elizabeth *v.* Pavement Co. (1877), 97 U. S. 126.

That the amount paid by other persons for past infringements is no guide to the profits now to be awarded, see Rude *v.* Westcott (1889), 130 U. S. 152; Cornely *v.* Marckwald (1889), 131 U. S. 159; Westcott *v.* Rude (1884), 19 Fed. Rep. 830; 27 O. G. 719.

That the profits are to be accounted for without reference to the usual royalty, see Williams *v.* Rome, Watertown & Ogdensburgh R. R. Co. (1880), 2 Fed. Rep. 702; 17 O. G. 1447; 18 Blatch. 181; 5 Bann. & A. 423; Wooster *v.* Taylor (1878), 14 Blatch. 403; 3 Bann. & A. 241; Knox *v.* Great Western Quicksilver Mining Co. (1878), 14 O. G. 897; 6 Sawyer, 430; 4 Bann. & A. 25.

therefore, not subject to interest.[2] But in equity, profits are regarded as a debt due by the defendant to the plaintiff from the time when they appear as money or as money value in the hands of the defendant, and consequently bear interest from that time until the date of payment.[3] Thus where the defendant receives the price for products sold, such a proportion of that price as represents the profit due to the infringement is the property of the plaintiff, and interest should be allowed thereon while it remains in the possession of the defendant.[4] Where the profit results from savings which do not enter into the cost of products sold, and are not recognized as money or as its equivalent until the annual balance of accounts, the computation of interest on the savings may then properly begin.[5] Upon these questions the decisions are not uniform; but the principle is clear, and if the distinctions between the profits arising from different modes of infringement are kept in mind, its application presents little difficulty.[6] Interest on the entire sum found by the

[2] For the rule regarding interest on damages in actions at law, and on profits when taken as the measure of such damages, see § 1066 and notes, *ante*.

[3] That profits are not regarded as unliquidated damages, see Jenkins *v.* Greenwald (1857), 2 Fisher, 37; 1 Bond, 126.

That in equity the profits of an infringement are not damages, but money had and received, and are a claim against the bankrupt estate of the infringer, see Watson *v.* Holliday (1882), L. R. 20 Ch. D. 780; *contra*, Gordon *v.* St. Paul Harvester Works (1885), 23 Fed. Rep. 147; *In re* Boston & Fairhaven Iron Works (1885), 23 Fed. Rep. 880.

[4] That profits bear interest from the time they were unlawfully detained, see Burdett *v.* Estey (1880), 3 Fed. Rep. 566; 19 Blatch. 1; 5 Bann. & A. 308.

That interest on royalties is allowed from the date of the infringement to the date of the decree, see Locomotive Safety Truck Co. *v.* Pennsylvania R. R. Co. (1880), 2 Fed. Rep. 677; 5 Bann. & A. 514; 14 Phila. 432.

[5] That in some cases interest is to be computed each year on the profits, see Tilghman *v.* Mitchell (1871), 4 Fisher, 599; 9 Blatch. 1.

[6] Among the statements of the courts on this subject are the following, most of which will, however, be found reconcilable with the doctrine laid down in the text, if the exact facts in issue are carefully examined:

That interest is not allowed on profits any more than on unliquidated damages, see Illinois Central R. R. Co. *v.* Turrill (1884), 110 U. S. 301; 26 O. G. 917; Locomotive Safety Truck Co. *v.* Penna. R. R. Co. (1880), 14 Phila. 432; 2 Fed. Rep. 677; 5 Bann. & A. 514; Parks *v.* Booth (1880), 102 U. S. 96; 17 O. G. 1089.

That interest may be allowed as damages, though damages do not carry interest as such, as where a sum became

master to be due as profits is reckoned from the date of his report, or from the time at which the account is terminated.[7] Counsel fees and other expenses of litigation are not included in the estimate of profits.[8] Profits cannot be trebled by the court as damages may be.[9]

§ 1153. Liability of Infringer to Account: Partial Liability of Several Infringers: Corporate Liability.

The defendant is equally liable for the profits whether the invention is adapted to general use or is available only in his own personal or official occupation.[1] Though he is the mere

due properly before judgment, see Bates *v.* St. Johnsbury & L. C. R. R. Co. (1887), 32 Fed. Rep. 628.

That profits are really damages and are unliquidated until the decree, see Mowry *v.* Whitney (1872), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 492.

That interest is not to be computed on profits unless under special circumstances, see Parks *v.* Booth (1880), 102 U. S. 96; 17 O. G. 1089; Holbrook *v.* Small (1878), 17 O. G. 55; 3 Bann. & A. 625; Brady *v.* Atlantic Works (1878), 15 O. G. 965; 3 Bann. & A. 577; American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

That interest on profits is not allowed before the decree, especially when the defendant has acted in good faith under his own patent, see Mowry *v.* Whitney (1872), 14 Wall. 620; 5 Fisher, 494; 1 O. G. 492.

That interest is to be allowed on profits to the date of the master's report, see Tatham *v.* Lowber (1857), 4 Blatch. 86.

That interest is to be allowed on profits from the time of the interlocutory decree, see Steam Stone Cutter Co. *v.* Windsor Mfg. Co. (1879), 17 Blatch. 24; 4 Bann. & A. 445.

[7] That interest should be allowed on profits from the time the report is in proper form for exceptions, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628; Illinois Central R. R. Co. *v.* Turrill (1884), 110 U. S. 301; 26 O. G. 917; Turrill *v.* Illinois Central R. R. Co. (1880), 20 Fed. Rep. 912.

[8] That counsel fees are not allowed in assessing damages or profits, see Parks *v.* Booth (1880), 102 U. S. 96; 17 O. G. 1089; Philp *v.* Nock (1873), 17 Wall. 460; Teese *v.* Huntingdon (1859), 23 How. 2; Blanchard's Gun Stock Turning Factory *v.* Warner (1848), 1 Blatch. 258; Stimpson *v.* Railroads (1847), 1 Wall. Jr. 164; 2 Robb, 595; Boston Mfg. Co. *v.* Fiske (1820), 2 Mason, 119; 1 Robb, 320; Whittemore *v.* Cutter (1813), 1 Gallison, 429; 1 Robb, 28.

[9] That profits cannot be trebled as damages may, see Holbrook *v.* Small (1878), 17 O. G. 55; 3 Bann. & A. 625.

§ 1153. [1] That although the invention was useless except to the defendant, and he might use it or not as he chose without materially affecting his business, he is still liable for profits, see Campbell *v.* James (1880), 18 O. G. 1111; 18 Blatch. 92; 2 Fed. Rep. 338; 5 Bann. & A. 364.

That if an officer of the government voluntarily uses an invention, which is of no value except for governmental purposes, he must account for the

delegate of a superior authority, to whom all his receipts are payable, yet if the infringement is his voluntary act he must account for its advantages even where he has paid the entire sum to his superior.[2] Where there are several defendants, some of whom are interested in the enterprise during a portion only of the period of the infringement, their liability for profits is limited to the amount accruing while they were engaged in the infringing acts.[3] Profits received by one corporation are not collectible from its successor, whatever may be their identity of enterprise or membership.[4] The death of an infringer does not bar the right of the owner of the patent to an account from his estate, and if his death occur during the action a bill of revivor will continue the proceedings against his personal representative.[5] After a decree for profits the defendant cannot be enjoined from paying them to the plaintiff, at the suit of a third party who claims to be the owner of the patent.[6] A plaintiff, being the sole owner of

profits, see Campbell *v.* James (1880), 18 O. G. 1111 ; 18 Blatch. 92 ; 2 Fed. Rep. 338 ; 5 Bann. & A. 354.

That where the United States is the real defendant, and has made no profits to itself except by saving expense otherwise to be incurred, its officers are liable, see Campbell *v.* James (1880), 18 O. G. 1111 ; 18 Blatch. 92 ; 2 Fed. Rep. 338 ; 5 Bann. & A. 354.

[2] That although the defendant, as an officer of the United States, has paid over the savings to the government, he is still liable, see Campbell *v.* James (1880), 18 O. G. 1111; 18 Blatch. 92 ; 2 Fed. Rep. 338 ; 5 Bann. & A. 354.

But see as to the foregoing case James *v.* Campbell (1882), 104 U. S. 356 ; 21 O. G. 337.

[3] That if not all the defendants are infringing during the whole time, the profits are to be apportioned accordingly, see Tatham *v.* Lowber (1857), 4 Blatch. 86.

That when a copartnership consisted of three members profits were awarded against the three jointly, up to the time when one retired, then against the remaining two, though a new partner had been taken in who was not made a defendant, see Herring *v.* Gage (1878), 15 Blatch. 124 ; 3 Bann. & A. 396.

[4] That a defendant corporation is not accountable for the profits made by a preceding corporation, see Sayles *v.* Dubuque & Sioux City R. R. Co. (1878), 5 Dillon, 561 ; 3 Bann. & A. 219.

[5] That the estate of an infringer is liable for profits after his death, see Smith *v.* Baker's Adm'rs (1874), 5 O. G. 496 ; 10 Phila. 221 ; 1 Bann. & A. 117.

That a bill of revivor will lie where the infringer dies pending suit, see Hohorst *v.* Howard (1883), 37 Fed. Rep. 97 ; Kirk *v.* DuBois (1886), 28 Fed. Rep. 460 ; 37 O. G. 102 ; Smith *v.* Baker's Adm'rs (1874), 5 O. G. 496 ; 10 Phila. 221 ; 1 Bann. & A. 117.

[6] That a defendant, after a decree for profits, cannot be enjoined from paying such profits to the plaintiff, upon the motion of a third party who claims title to the patent adversely to the

the patent, may recover the whole profits, though they belong to him in common with his partners by virtue of the partnership agreement.[7]

§ 1154. Damages in Equity.

Damages, as such, were not recoverable in equity in cases of infringement until the act of 1870, which conferred upon the Circuit courts the power to award them in addition to the profits. The purpose of this act was to afford the plaintiff adequate compensation for his injury in actions in equity, although the evidence on the accounting might show that the defendant had made no profits, or that the profits which he had received were insufficient to cover the whole loss that the plaintiff had sustained, and thus relieve him from the necessity of discontinuing his equitable proceedings and seeking his redress in damages at law.[1] Construing the act in this

plaintiff, see Secombe *v.* Campbell (1880), 5 Fed. Rep. 804; 5 Bann. & A. 632.

[7] That the plaintiff may recover profits, though part of them may belong to his copartners in business, he being owner of the patent, see Sargent *v.* Yale Lock Mfg. Co. (1879), 17 Blatch. 244; 4 Bann. & A. 574; 17 O. G. 105.

§ 1154. [1] That prior to the act of July 8, 1870, profits and damages were not recoverable in a single suit, but the former might be obtained in equity, the latter at law, see Willimantic Thread Co. *v.* Clark Thread Co. (1886), 27 Fed. Rep. 865; Williams *v.* Leonard (1872), 9 Blatch. 476; 5 Fisher, 381; Perry *v.* Corning (1870), 7 Blatch. 195; Livingston *v.* Jones (1861), 2 Fisher, 207; 3 Wall. Jr. 330.

That the act of 1870 (Sec. 4921, Rev. Stat.), authorizes equity to give damages as well as profits, see Willimantic Thread Co. *v.* Clark Thread Co. (1886), 27 Fed. Rep. 865.

That the act of 1870 enlarged equity jurisdiction by allowing damages in addition to profits to be recovered, but did not restrict the right to recover for any gains, savings, or advantages recoverable before, see Coburn *v.* Schroeder (1881), 20 O. G. 1085; 8 Fed. Rep. 521; 19 Blatch. 493.

That Sec. 55, act of 1870, merely confers on a court of equity the power to award or multiply damages, in addition to its decree for an account, see Root *v.* Lake Shore & Michigan Southern R. R. Co. (1882), 105 U. S. 189; 21 O. G. 1112.

That the right to recover damages as well as profits does not rest wholly on Sec. 4921 of the Revised Statutes, see Coburn *v.* Schroeder (1881), 20 O. G. 1085; 8 Fed. Rep. 521; 19 Blatch. 493.

That on a bill in equity brought before July 8, 1870, no damages beyond the actual profits of the defendant could be recovered, see American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

That no damages are recoverable in a suit in equity begun before July 8, 1870, though a supplemental bill is filed and a re-issue granted after that date, see

spirit, the courts have held that wherever the plaintiff has suffered an injury by the infringement greater than the amount of profits made by the defendant, whether because the defendant has made no profits or less than a fair profit through his unskilfulness or unwise conduct of his business, or because the wrongs inflicted on the plaintiff lie outside the scope of the mere loss of profits on the patented invention, the plaintiff is entitled to recover in excess of profits such a sum in damages as, taken with the profits, will give him complete compensation for the injury.[2] The rule of damages in equity is otherwise the same with that at law.[3] Their amount must

Sarven *v.* Hall (1872), 5 Fisher, 415; 1 O. G. 437; 9 Blatch. 524.

That the provisions of the act of July 8, 1870, apply to suits begun after that date for injuries previously committed, see Union Paper Bag Mach. Co. *v.* Newell (1873), 6 Fisher, 582; 5 O. G. 173; 11 Blatch. 379.

[2] That profits and savings are still the measure of recovery in equity unless the extent of the plaintiff's loss requires an additional allowance of damages, see Willimantic Thread Co. *v.* Clark Thread Co. (1886), 27 Fed. Rep. 865; Birdsall *v.* Coolidge (1876), 93 U. S. 64; 10 O. G. 748.

That if the profits do not fully compensate the plaintiff, damages may be awarded in addition; see Simpson *v.* Davis (1884), 22 Fed. Rep. 444; 22 Blatch. 113; Brady *v.* Atlantic Works (1878), 3 Bann. & A. 577; 15 O. G. 965; Birdsall *v.* Coolidge (1876), 93 U. S. 64; 10 O. G. 748; Buerk *v.* Imhaeuser (1876), 10 O. G. 907; 14 Blatch. 19; 2 Bann. & A. 452; Carew *v.* Boston Elastic Fabric Co. (1871), 1 O. G. 91; 3 Clifford, 356; 5 Fisher, 90.

That damages may be recovered in equity though the defendant made no profit, see Yale Lock Co. *v.* Sargent (1886), 117 U. S. 536; 35 O. G. 497; Burdett *v.* Estey (1880), 19 Blatch. 1; 3 Fed. Rep. 566; 5 Bann. & A. 308.

That where the defendant conducts his business so carelessly as to make no profits, damages may be allowed, see Brady *v.* Atlantic Works (1878), 3 Bann. & A. 577; 15 O. G. 965; Marsh *v.* Seymour (1877), 97 U. S. 348; 13 O. G. 723.

That where the defendant made no profits because he reduced his prices in order to drive the plaintiff from the market, damages may be awarded, see Brady *v.* Atlantic Works (1878), 3 Bann. & A. 577; 15 O. G. 965.

That a decree for profits does not authorize the allowance of damages, see Livingston *v.* Woodworth (1853), 15 How. 546.

That where the plaintiff cannot show any advantage in the use of his invention over others which are open to the public, he cannot recover profits though he may recover damages, see Locomotive Safety Truck Co. *v.* Pennsylvania R. R. Co. (1880), 2 Fed. Rep. 677; 5 Bann. & A. 514; 14 Phila. 432.

That only net profits are allowed and no damages where the infringement was not wilful or malicious, see Ford *v.* Kurtz (1882), 12 Fed. Rep. 789; 11 Bissell, 324.

[3] For the rule of damages at law and evidence thereon, see §§ 1049–1071 and notes, *ante*.

be established by evidence, not conjectured; and the court, if it deem necessary, may treble them.[4] Interest cannot be reckoned till after the decree.[5] On a bill *pro confesso* nominal damages may be awarded, where neither damages nor profits can be proved.[6]

§ 1155. Account Ordered if Infringement Proved: By whom Taken.

The defendant may be ordered to account whenever he has been found guilty of infringement. The fact that he has practised the invention raises a presumption that its use was beneficial, and this presumption is not overcome by an assertion in his answer that the infringement was unprofitable. Having for his own advantage unlawfully appropriated the property of the plaintiff, he must now incur the trouble and expense of a full disclosure of the enterprise, since if no gains or savings have been made an estimate and award of damages may be required.[1] An account, when ordered, is

[4] That the damages must be proved by evidence, not left to conjecture, see Ingersoll *v.* Musgrove (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304.

That when the profits cannot be fixed by evidence they cannot be recovered as damages, see Blake *v.* Greenwood Cemetery (1883), 16 Fed. Rep. 676; 21 Blatch. 222.

That the court may treble the damages in equity as well as at law, see Carew *v.* Boston Elastic Fabric Co. (1871), 1 O. G. 91; 3 Clifford, 356; 5 Fisher, 90.

That where an infringement is flagrant the damages will be trebled, see Lyon *v.* Donaldson (1888), 34 Fed. Rep. 789.

That where the defendant evidently believed himself to be right, the court will not increase the damages on the ground that he fought vigorously, or refuse to increase them on the ground that the patent is apparently void where that claim was not made in due season in the defence, see Welling *v.* La Bau (1888), 35 Fed. Rep. 302.

That if the patent is really void, though no such defence were made, the damages will not be increased, see Welling *v.* La Bau (1888), 35 Fed. Rep. 302.

[5] That no interest is to be allowed on the damages until the date of the decree, see American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

That where a license fee is the measure of damages, interest on the amount may be allowed from the date of the interlocutory decree, see Graham *v.* Geneva Lake Crawford Mfg. Co. (1881), 24 Fed. Rep. 642; 32 O. G. 1603.

[6] That where the bill is taken *pro confesso*, and on the reference to the master no satisfactory proof of damages and profits is given, the plaintiff can recover only nominal damages, see Fisk *v.* West, Bradley, & Cary Mfg. Co. (1880), 19 O. G. 545.

§ 1155. [1] In Andrews *v.* Creegan

taken by a master appointed for that purpose by the court, who, having given notice to the parties or their counsel of the day fixed for the hearing, receives the evidence presented, and from it makes his computation of the profits which the defendant has received or the damage which the plaintiff has sustained. The failure of the defendant to appear at the day named for the accounting does not delay nor prevent the hearing, unless his evidence or his books are needed, in which case a continuance is granted and an order to be present at a certain future day is personally served upon him, followed by an attachment for contempt if he should then be absent.[2] When the master has arrived at his conclusions

(1881), 7 Fed. Rep. 477, Wheeler, J.: (478) "The defendant denies any profits, and insists that none are proved to lay the foundation of an accounting. None are proved beyond the presumption arising from the fact of the putting the well down so that it could be used. This would raise a presumption that there were, or might have been, some profits, and the allegation that the transaction was not profitable would not meet the presumption so as to defeat an accounting. The plaintiff would have the right to have the account taken, however it might result, left to him. Besides this, the act of 1870 (Rev. St. § 4921), provides for an accounting for damages as well as profits, and there may be damages to be accounted for in this case." 19 O. G. 1140 (1140); 19 Blatch. 113 (114). See also Urner *v.* Kayton (1883), 17 Fed. Rep. 539; 24 O. G. 1178; 21 Blatch. 428; Motte *v.* Bennett (1849), 2 Fisher, 642.

That an account may be ordered though no injunction or bond would be required, see Smith *v.* Baker's Adm'rs (1874), 5 O. G. 496; 1 Bann. & A. 117; 10 Phila. 221.

[2] In Kerosene Lamp Heater Co. *v.* Fisher (1880), 1 Fed. Rep. 91, Lowell, J.: (92) "The practice which we approve is this: The master appoints a day for proceeding with the reference, and gives notice, by mail or otherwise, to the parties or their solicitors. We think the solicitor should be notified, whether the party is or not; though probably, under Rule 75, notice to the party is a good notice. If the defendant does not appear, the master proceeds, *ex parte*, and makes out the profits and damages, if he can, from the evidence produced by the plaintiff. If it appears that an account of profits is necessary to a just decision of the cause, and is desired by the plaintiff, he makes an order that the defendant furnish an account by a certain day, and adjourns the hearing to that day. The defendant should be served personally with a notice of this adjournment, and of the order to produce his account, if it is intended to move for an attachment in case he fails to appear. The service may be made by any disinterested person, and need not be by the marshal. If the defendant then fails to appear and account, he will be in contempt." 5 Bann. & A. 78 (79).

That a disclosure of gains and profits is incidental to an accounting under a decree in an infringement suit, see Gordon *v.* Anthony (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248.

from the testimony they are embodied in a draft report, and filed in court or submitted to the parties. To this report the parties make objections as they deem advisable; and thereupon the master reconsiders the matter involved in such objections, modifies or affirms his previous conclusions, and in a final report presents them to the court. Either party may file exceptions to this report based on his previous objections, and may have the entire evidence as taken by the master laid before the court, and the court may then review the questions of fact as well as of law involved in the accounting, and recommit, or set aside, or alter, or reverse the report as in its judgment the law and evidence require.[3] Throughout this proceeding the master must be guided by the terms of the decree which orders the account, and if these are ambiguous he may call upon the court for more definite instructions.[4] It is his duty also to forward the accounting as rapidly as circumstances will permit, although the court may stay the hearing when the pendency of other suits in other jurisdictions between the same parties, or any facts within its knowledge, render such a stay desirable.[5]

[3] Equity Rules 73–84.

[4] That if the decretal order is ambiguous the master can report the case back for specific instructions, see Union Sugar Refinery *v.* Matthiesson (1868), 3 Clifford, 146.

That the master may act beyond the territorial jurisdiction of the court, and even in foreign countries, see Bate Refrigerating Co. *v.* Gillette (1886), 28 Fed. Rep. 673.

That the master must choose the best and cheapest method of taking evidence, see Bate Refrigerating Co. *v.* Gillette (1886), 28 Fed. Rep. 673.

[5] That in a proper case properly presented the court may suspend a suit against the users until the suit against the maker is ended, since if the maker pays the user is not liable, provided it appears that the thing used is the very one for which the maker is sued, see Allis *v.* Stowell (1883), 16 Fed. Rep. 783.

That a suit against the dealer who sells will not be kept open indefinitely to await the decision of an appeal from a judgment in favor of the manufacturer, see Grain Drill Mfg. Co. *v.* Reinstedler (1885), 25 Fed. Rep. 198.

That where priority is in issue and an interference was declared, and three different and variant decisions were rendered in the Patent Office and the District court, and a bill for repeal is now pending in the Circuit court, the present case will be retained until the latter suit is tried and decided, see Lockwood *v.* Cutter Tower Co. (1882), 11 Fed. Rep. 724.

That an accounting will not be stayed on the ground that another case is pending in the Supreme Court on different issues, or that another court has held the patent invalid on different facts, see Celluloid Mfg. Co. *v.* Comstock & Cheney Co. (1886), 27 Fed. Rep. 358; 36 O. G. 1356.

§ 1156. Procedure in Taking an Account.

In taking the account the master has no right to consider the question of infringement or the scope and meaning of the patent, but must accept these matters as they have been already settled by the court.[1] All inquiries into the damages or profits resulting from the infringement are within his powers, and in pursuing these he may be led into numerous investigations as to the state of the art at the time of the invention, or other kindred subjects, and may inspect the articles sold or used by the defendant in connection with those covered by the patent for the purpose of determining what proportion of the defendant's gains or savings is attributable to the latter; but otherwise he has no occasion to explore their history or origin.[2]

§ 1156. [1] That a master taking an account has no business with the question of infringement or the scope or extent of the patent, but must apply the principles laid down by the court, and though he may inspect the two devices he has no concern with their history, see Turrill *v.* Illinois Central R. R. Co. (1873), 5 Bissell, 344; Whitney *v.* Mowry (1870), 4 Fisher, 207.

That a decree finding infringement binds the master as to everything substantially like the infringing device, though he may inquire whether specific articles are covered by the decree, see Wooster *v.* Thornton (1886), 26 Fed. Rep. 274; 34 O. G. 560.

That a re-issue being sustained by the interlocutory decree or decree *pro confesso*, its validity or divergence from the original cannot be considered by the master, see Thomson *v.* Wooster (1885), 114 U. S. 104; 31 O. G. 913.

That in a suit on a re-issue the defendant cannot for the first time offer to the master, on the accounting, the original as evidence that the re-issue, if identical therewith, had not been infringed, see Wooster *v.* Thornton (1886), 26 Fed. Rep. 274; 34 O. G. 560.

That on a bill for infringement against a railroad company for using the invention on other roads than their own under a license to use on roads "owned or operated" by them, the legal right of the defendants to operate such other roads cannot be questioned, see Matthew *v.* Pennsylvania R. R. Co. (1881), 8 Fed. Rep. 45.

That a decree in equity for profits only does not authorize the allowance of damages, see Livingston *v.* Woodworth (1853), 15 How. 546.

[2] That on the question of profits the state of the art at the date of the invention is always material, see Locomotive Safety Truck Co. *v.* Pennsylvania R. R. Co. (1880), 2 Fed. Rep. 677; 5 Bann. & A. 514; 14 Phila. 432.

That evidence may be offered before the master on an accounting to show that certain articles of the defendant did not embrace the infringing features, see Welling *v.* La Bau (1885), 23 Blatch. 305; 32 Fed. Rep. 293.

That all questions as to whether gains or savings are due to the infringement, and are to be accounted for, arise

§ 1157. Evidence on the Accounting.

The evidence admissible before the master is indicated by the rules which are to govern his estimate of the profits and the damages. The plaintiff must furnish sufficient testimony to enable him to arrive at definite conclusions, and cannot rely upon him to suggest what proof may be required.[1] The master must receive all relevant and material evidence, and by collating and comparing it must ascertain the data for his computation, and formulate their result in the award of a specific sum as damages or profits.[2] The plaintiff may compel the presence of the defendant, and the production of his books, and subject them to examination, but if the books disclose the sale or use of various articles, some of which may not have been covered by the patent, the plaintiff must by other testimony separate those by which his rights have been infringed.[3] Admissions in the answer as to the extent

on the accounting, see Coburn *v.* Schroeder (1881), 20 O. G. 1085; 19 Blatch. 493; 8 Fed. Rep. 521.

That the confusion of accounts is not a confusion of the goods sold, and, as some may infringe while others do not, those which do must be separated by evidence, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514; 2 O. G. 1007.

That in taking the account the master is not limited to the date of entering the decree, but may extend it down to the time of hearing before him, see Rogers *v.* Reissner (1887), 39 O. G. 832; Rubber Co. *v.* Goodyear (1869), 9 Wall. 788.

That pending the accounting no suit at law for subsequent infringements by the same defendant can be brought without leave of the court, see Morss *v.* Knapp (1888), 35 Fed. Rep. 218.

§ 1157. [1] That the plaintiff must furnish evidence enough to enable the master to make the computation, see Brady *v.* Atlantic Works (1878), 15 O. G. 965; 3 Bann. & A. 577.

That neither the master nor the court are bound to suggest what proof is needed, but the plaintiff mus furnish enough to show the profits or damages, see Garretson *v.* Clark (1879), 16 O. G. 806; 4 Bann. & A. 536.

[2] That the master is to sift out the evidence and get at the profits as best he may, see Herring *v.* Gage (1878), 15 Blatch. 124; 3 Bann. & A. 396.

[3] That the master taking an account may examine the defendants and inspect their books, see Brady *v.* Atlantic Works (1878), 15 O. G. 965; 3 Bann. & A. 577.

That on a bill in equity for an account on a re-issue a *subpœna duces tecum* will issue to compel the defendants to produce all their books, etc., which can show the number of articles sold since the re-issue, see Turrell *v.* Spaeth (1875), 8 O. G. 986; 2 Bann. & A. 185.

That if the defendant's books are needed by the plaintiff he should move for them, or the case will not be sent back to the master for review, see Fischer *v.* Hayes (1883), 16 Fed. Rep. 469; 24 O. G. 304.

That where on the accounting the

of the infringement, and the benefits therefrom derived, are taken in their ordinary sense, and may be considered in determining the truth or falsehood of the testimony given by the defendant.[4] The evidence must be positive and certain.[5] The opinions of witnesses concerning the value of the invention to the defendant, or the amount of injury to the plaintiff, are of little weight.[6] Evidence of sums paid in settlement or as license fees by other parties does not tend to show the profit made by the defendant, nor does it serve as any guide to the loss suffered by the plaintiff, unless the settlement was voluntary on both sides and for an exactly similar infringement, or unless the license fee is universally established.[7] But the amount which the defendant has himself expended for other processes or instruments, performing

plaintiff testified to the cost of making and selling, the defendant has a right to the production of the plaintiff's books, though the plaintiff may refuse and withdraw the evidence already offered, see Wisner *v.* Dodds (1883), 14 Fed. Rep. 655.

[4] That admissions in the answer are taken as usually understood and may be considered by the master, see § 1118 and notes, *ante.*

[5] That the evidence must definitely fix the amount of profits, see Ingersoll *v.* Musgrove (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304.

That evidence not sufficiently definite to show the amount of profits will not warrant an award either of profits or of damages, see Blake *v.* Greenwood Cemetery (1883), 16 Fed. Rep. 676; 21 Blatch. 222.

[6] That the mere opinion and estimate of two witnesses may not be sufficient to show the value of the use of the invention to the defendant, see Sargent *v.* Yale Lock Mfg. Co. (1879), 17 O. G. 106; 17 Blatch. 249; 4 Bann. & A. 579.

That the report cannot be sustained where the only evidence was the opinion of a witness that the amount awarded could have been saved by the defendant, see Munson *v.* City of New York (1883), 16 Fed. Rep. 560; 21 Blatch. 342.

[7] That the amount paid by others for past infringements is no guide to the profits due on the present one, see Rude *v.* Westcott (1889), 130 U. S. 152; Cornely *v.* Marckwald (1889), 131 U. S. 159; United Nickel Co. *v.* Central Pacific R. R. Co. (1888), 36 Fed. Rep. 186; Westcott *v.* Rude (1884), 19 Fed. Rep. 830; 27 O. G. 719.

That the recovery of one dollar damages, on a stipulation leaving that matter to the court on the evidence taken, is no guide to the value of the invention, see Blake *v.* Greenwood Cemetery (1883) 16 Fed. Rep. 676; 21 Blatch. 222.

That where the evidence before the master does not show an established license fee, and his finding is based upon damages not upon profits, reference to a settlement in another suit with different circumstances cannot be allowed, see Greenleaf *v.* Yale Lock Mfg. Co. (1879), 17 O. G. 625; 17 Blatch. 253; 4 Bann. & A. 583.

That profits cannot be measured by a license-fee but must be accounted for, see Williams *v.* Rome, Watertown, & Ogdensburgh R. R. Co. (1880), 2 Fed.

the same work or effecting the same saving as the patented invention, is a fair measure of its worth to him, and may, therefore, be proved.[8] If the plaintiff's testimony supports his claims concerning the damages and profits, and the defendant has an opportunity to contradict or qualify it and he fails to do so, it is presumed to be impregnable.[9] During the hearing the case is pending before the master and all papers must be filed with him and not in court.[10] Objections to the evidence presented must also be taken to him as the evidence is offered, although he has no power to finally decide upon them, but must note both the objection and his ruling, to be reviewed in due time by the court.[11] Reference to the court as each question arises is improper.[12] The record of

Rep. 702; 17 O. G. 1447; 18 Blatch. 181; 5 Bann. & A. 423.

That damages may be shown by an established license fee, see Cary *v.* Excelsior Mfg. Co. (1889), 37 Fed. Rep. 354; United Nickel Co. *v.* Central Pacific R. R. Co. (1888), 36 Fed. Rep. 181; also § 1059 and notes, *ante*.

That where a license fee is established with reference to the entire patent, and only certain Claims are infringed, the master must apportion the license fee according to the value of the Claims, if possible, unless the remaining Claims are merely structural, and the burden of proof is on the plaintiff to show the value of the infringed Claims, see Willimantic Thread Co. *v.* Clark Thread Co. (1886), 27 Fed. Rep. 865.

That the master must determine whether a license fee is the fair measure of the value of the invention, where the infringement took place before the license fee was established, see Wooster *v.* Thornton (1886), 26 Fed. Rep. 274; 34 O. G. 560.

That on the question of profits evidence to show what open methods there are and their degree of advantage, is admissible, see Black *v.* Thorne (1874), 7 O. G. 176; 12 Blatch. 20; 1 Bann. & A. 155.

[8] That the amount afterwards paid by the defendant for another device answering the same purpose as the plaintiff's may show the value of the latter to him, see Sargent *v.* Yale Lock Mfg. Co. (1879), 17 O. G. 106; 17 Blatch. 249; 4 Bann. & A. 574.

[9] That where the plaintiff makes out a *prima facie* case as to the amount of profits and the defendant has an opportunity to vary it, but does not, the presumption is that he cannot, see Lewis *v.* Standard Laundry Mach. Co. (1883), 21 Blatch. 184.

[10] That after a reference to a master for account, papers are to be given to him, and not filed in court except by special order, see Union Sugar Refinery *v.* Matthiesson (1868), 3 Clifford, 146.

[11] That objections to the rulings of the master on the admissibility of evidence must be taken when the ruling is made, see Troy Iron & Nail Factory *v.* Corning (1869), 3 Fisher, 497; 6 Blatch. 328.

[12] In Lull *v.* Clark (1884), 22 Blatch. 207, Coxe, J.: (208) "He [the master] occupies, for the time being, the position of the court, and is not to be continually interfered with while discharging his duties to the best of his ability. It would create intolerable de-

the proceedings, which accompanies his report, must bring them all at once to the attention of the court, that at the hearing on the exceptions all may be determined.[13] After the draft report is filed no evidence can be received.[14]

§ 1158. Exceptions to the Report of the Master concerning the Amount of Profits.

Having submitted his draft report to the parties, and having heard their objections and reconsidered his conclusions, the master may file his final report at any time without an order from the court.[1] Exceptions to the final report cannot be made on any question which was closed by the decree referring the case to the master, nor on any ruling as to the admissibility of evidence, unless the objection was duly entered on the record, and was urged before the master after the filing of his draft report.[2] Errors not affecting the decisions

lays and confusion, besides putting an unnecessary burden upon the court, to hold that each time the master makes a ruling the aggrieved party may, by special motion, have it reviewed. The orderly, and it seems the generally accepted, procedure is to present all the questions arising before the master by objections and exceptions to his report." 20 Fed. Rep. 454 (455).

Further, that the rulings of the master, except in extreme cases, will not be reviewed by the court pending a reference, see Bate Refrigerating Co. *v.* Gillette (1886), 28 Fed. Rep. 673; Welling *v.* La Bau (1885), 23 Blatch. 305; 32 Fed. Rep. 293; Union Sugar Refinery *v.* Matthiesson (1868), 3 Clifford, 146.

That the examiner cannot rule on evidence, and the defendant if a witness has a right to the opinion of the court before he answers, and is not in contempt if acting under advice he refuses to answer till he has that opinion, see Roberts *v.* Walley (1882), 14 Fed. Rep. 167; 26 O. G. 107.

[13] That the master should finish his hearing and file his draft report, and objection can then be made, see Union Sugar Refinery *v.* Matthiesson (1868), 3 Clifford, 146.

[14] That no evidence can be introduced after the master has submitted a draft of his report to one of the parties, see Piper *v.* Brown (1873), Holmes, 196; 6 Fisher, 240; 3 O. G. 97.

§ 1158. [1] Equity Rule 83.

[2] In Troy Iron & Nail Factory *v.* Corning (1869), 3 Fisher, 497, Shipman, J.: (501) "But let us take the rulings of the master that were formal and peremptory, overruling or sustaining objections to the admission of evidence at the time they were made. What are the rules of practice to be observed by the party who desires to revise such rulings? First, we think an exception should always be taken on the spot to each ruling of the master which a party intends to contest. It need not then be drawn up in form, but it should be taken by giving notice to the master, and it is his duty to note the facts in his minutes. This is a familiar rule, constantly applied in other trials, and we see no reason why it

of the master afford no ground for exceptions, nor can exceptions be sustained when the report conforms to the decree,

should not be adhered to in hearings before masters. . . . The reason of this rule is founded in the interest of justice, as its observance tends to narrow the limits of controversy; for if the party in whose favor a ruling is made is notified that an exception is taken, and the question is to be revised, he can waive the point and admit or withdraw the evidence, as the case may be, and thus avoid future controversy and delay over it. It may be said that this can have no application to the instances on this hearing, where the master admitted evidence objected to, and reserved the questions arising on the objections. As we have already intimated, it is not always easy to determine what precise disposition was made by the master of many of these reserved questions. But if he omitted to decide them, or ultimately decided them incorrectly, the first opportunity should have been taken to except to his omissions or alleged errors in this particular. This opportunity, if not presented before, occurred when the draft report was served, and the parties filed their objections thereto. None of these errors are embraced in the objections then filed. Exceptions to these rulings appear for the first time among those presented to the master's final report, although some of them were made years before either the draft or final report was drawn up. It would seem from the authorities that if it is proper to except at all to the master's final report, for rulings admitting or rejecting evidence, this can only be done where objections of the same kind have been made to the draft report." 6 Blatch. 328 (331).

In Union Sugar Refinery *v.* Matthiesson (1868), 3 Clifford, 146, Clifford, J.: (148) "The better practice, as the court thinks, is for the master to complete his investigations under the rules prescribed by the Supreme court, and in accordance with the usual course of proceeding in equity cases in this circuit. The usual course is that the master allow both parties, if they desire, to introduce testimony upon the subject of damages. He hears them fully, and when he has taken all the testimony, heard the parties, and come to a conclusion, he makes a draft of his report in the premises, and shows it to the parties, or files it in the clerk's office, and gives time for the parties respectively, if they see fit, to make their objections to the drafted report. When those objections are made it becomes his duty to consider or reconsider, as the case may be, the questions involved in those objections; and if, upon full consideration, he is still of the opinion that he was right in the conclusions formed and stated in the drafted report, he then makes his final report, and the parties have a right to file their exceptions to the final report, founded upon the previous objections made to the draft report; and then the whole matter comes back to the Circuit court for adjudication upon the master's report. Either party may set down the case for hearing upon the exceptions to the master's report. Both parties may except; both may object in the first instance to the draft report, and both parties may afterwards except to the final report. They are entitled to be heard upon all the questions which have arisen before the master, provided they are embraced in their objections and in their exceptions. When the exceptions are filed, if either party desires the evidence to be reported, they request the master to report it in whole or in part, as the case may be. It is the usual course for the master to comply with such a request; but if

though the decree itself may be amended when erroneous, and the report then correspondingly corrected.[3] Exceptions must point out the defects in the report, and must direct the attention of the court to those portions of the evidence or the record in which they appear.[4] The conclusions of the master concerning matters of fact cannot be reviewed, unless the entire testimony is presented to the court.[5]

neither party makes the request, it is not incumbent upon the master to report the evidence at all. He may or may not, in his discretion, as he sees fit. If he does report the evidence at the request of one or both parties, it then becomes the duty of the court, if there be proper exceptions, to review the questions of fact embraced in the report as well as the questions of law. But if the evidence is not reported, the court does not review the facts, but simply re-examines the questions of law. Such has been the practice in this circuit as far back as the knowledge of the justices now holding the court extends; and there has been no departure from the practice since either of us came into the court, within the recollection of either member of it."

That an exception to a principal finding by a master is not waived by not making the exception before the master, see Jennings *v.* Dolan (1887), 29 Fed. Rep. 861; 38 O. G. 1018.

That where the master notified counsel that the draft reports were ready for inspection and verbal objections had been made but not written out, and the exceptions to the report are the same, these objections may be filed with the master *nunc pro tunc*, see Fischer *v.* Hayes (1883), 16 Fed. Rep. 469; 24 O. G. 304.

[3] That errors not affecting the conclusions of the master's report are no ground for exceptions, see Gottfried *v.* Crescent Brewing Co. (1884), 22 Fed. Rep. 433; 30 O. G. 892.

That the report of the master, being the deputy clerk of the court, will not be set aside on the ground that no "*special reason*" for his appointment is alleged under the act of March 3, 1879, if the appointment was made by consent of parties and acted on, but the consent will be entered of record as such "special reason" after the report is filed, see Fischer *v.* Hayes (1884), 22 Fed. Rep. 92; 22 Blatch. 505.

That evidence as to allowances not finally allowed is properly taken by the master and must be objected to by a motion to suppress the testimony, not by exceptions to the master's report, see American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

That no exception can be taken when the master's report conforms to the decree, but the decree if erroneous may be resettled, see Williams *v.* Leonard (1872), 5 Fisher, 381; 9 Blatch. 476.

That on a hearing on a master's report presented for acceptance or rejection, no matter will be considered which was closed by the decree referring the case to the master, see Whitney *v.* Mowry (1870), 4 Fisher, 207.

[4] That exceptions to the master's report must point out his errors, or the counsel must direct attention to the evidence showing them, or they will be overruled, see Turrill *v.* Illinois Central R. R. Co. (1873), 5 Bissell, 344.

[5] That questions of fact or computation which are for the master to decide will not be reviewed on exceptions to the report, see Hammacher *v.* Wilson (1887), 32 Fed Rep. 796.

That the report of the master will

§ 1159. Recommittal of Report for Further Hearing or Amendment.

The court has power to recommit the report to the master for a further hearing, or for an amendment, when it is erroneous in principle, or when the master takes a wrong view of the invention, or when it fails to complete the computation, or exhibits any other misconception in law or fact which an additional investigation may correct.[1] No recommittal will be ordered to allow either party to avail himself of objections

not be set aside on the ground that he erroneously decided a complicated question of fact where the evidence is doubtful, see Welling v. La Bau (1885), 32 Fed. Rep. 203; 23 Blatch. 305.

That the finding of the master on a question of fact will not be reviewed unless the whole evidence is reported, see Piper v. Brown (1873), 6 Fisher, 240; 3 O. G. 97; Holmes, 196.

§ 1159. [1] That the court has power to set aside the master's report for any error in law or in fact, or to recommit it for further proceedings, or correct it when there is anything to correct it by, see Steam Stone Cutter Co. v. Windsor Mfg. Co. (1879) 17 Blatch. 24; 4 Bann. & A. 445.

That proceedings before a master are of nearly the same solemnity as those before the court, and his finding will not be set aside unless against the weight of evidence, see Tilghman v. Proctor (1888), 125 U. S. 136; 43 O. G. 628; Welling v. La Bau (1888), 43 O. G. 117.

That on a supplemental accounting the master may use his report on the first accounting for all proper purposes without having it offered in evidence, see Reed v. Lawrence (1886), 29 Fed. Rep. 915.

That if the master's report is erroneous in principle it will be sent back for further hearing and correction, see Faulks v. Kamp (1882), 22 O. G. 2244; 10 Fed. Rep. 675.

That where the master takes a wrong view of the invention, and so mistakes the profits, the report will be sent back for further evidence, see Ruggles v. Eddy (1877), 12 O. G. 710; 2 Bann. & A. 627.

That a re-accounting will not be granted on account of trifling errors by the master as to the items of the account, see Zane v. Peck Bros. (1882), 23 O. G. 191; 13 Fed. Rep. 475.

That where the master's report shows the percentage of profit, but not the amount on which the percentage should be calculated, the case must be sent back for further evidence, see Conover v. Mers (1873), 6 Fisher, 506; 11 Blatch. 197.

That when the master's report shows that further investigation is needed, the court will order it, see Magic Ruffle Co. v. Elm City Co. (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

That a master's report may be recommitted in order that it may so complete the case as to raise all questions which might be found material, see McKay v. Jackman (1883), 24 O. G. 1177; 17 Fed. Rep. 641.

That on a reference of his report back to the master for excessive damages, he may find a license fee and report that as the measure, see Wooster v. Simonson (1884), 28 O. G. 918; 20 Fed. Rep. 316.

which he has already waived, or to produce testimony which he has once advertently omitted.[2] Before the hearing by the court on the report evidence properly objected to and inadmissible may be suppressed.[3] A report awarding to the plaintiff a substantial sum, but showing on its face that no account of damages or profits which can be taken will be legally sustainable, may be set aside.[4] When the report or the accompanying evidence discloses both the error and the means for its correction, the court may rectify the mistake without a recommittal.[5]

§ 1160. Acceptance of Report: Final Decree.

The acceptance of a report of the master, in favor of the plaintiff, is followed by a final decree awarding him the sum found by the master to be due to him as damages or profits, or both, and granting a perpetual injunction or such other equitable relief as may be necessary. Where there are several plaintiffs the decree also provides for the distribution to each of a share of the award proportioned to his interest in

[2] That the report of the master will not be referred back to him if there has been no inadvertence, and if no further evidence is to be had, and the objectionable evidence was duly excepted to, see Garretson *v.* Clark (1878), 14 O. G. 485; 15 Blatch. 70; 3 Bann. & A. 352.

That a finding of the master based in part on his personal examination of the apparatus at the request of the parties, and in their presence, will not be reversed, see Piper *v.* Brown (1873), Holmes, 196; 6 Fisher, 240; 3 O. G. 97.

That where the evidence as to extent of infringement is conflicting, and sufficient to warrant either conclusion, the finding of the master will not be disturbed, see Wooster *v.* Thornton (1886), 26 Fed. Rep. 274; 34 O. G. 560.

That a motion to recommit the report to the master, that he may take an account of the profits to the date of the final decree on machines enjoined subsequent to the interlocutory decree, is not granted, since it would hinder an appeal, but the decree is so drawn as to show to what date the account was taken, see Union Metallic Cartridge Co. *v.* United States Cartridge Co. (1881), 8 Fed. Rep. 446.

[3] That inadmissible evidence, duly objected to, may be reached by motion to suppress, see American Nicholson Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

[4] That before the act of 1870, where an interlocutory decree gave both damages and profits and the defendant excepted to the master's report concerning them, the exception was not allowed, but the damages were struck out, see Williams *v.* Leonard (1872), 5 Fisher, 381; 9 Blatch. 476.

[5] That if the evidence before the master does not sustain a charge allowed by him, it will be struck out, and such evidence must appear on the face of the report, see American Nichol-

the patent or the amount of his injury.[1] A report in favor of the plaintiff does not, however, bind the court nor compel it to ratify that finding on the merits which was contained in the interlocutory decree. The final decree may depart from both, and dismiss the bill for reasons apparent on the pleadings or in the evidence adduced before the master.[2] A final decree can be amended only during the term at which it was entered.[3]

§ 1161. Appeal to the Supreme Court.

Errors of law or fact committed by Federal courts of equity are corrected by an appeal to the Supreme Court of the United States.[1] This appeal lies only on a final decree dismissing the bill, or awarding damages or profits or other relief to the plaintiff after the acceptance of the master's report; but all prior orders and decrees, on matters not within the discretion of the court, are thereby brought up for review.[2] An appeal may be taken in any case arising under

son Pavement Co. *v.* City of Elizabeth (1874), 6 O. G. 764; 1 Bann. & A. 439.

§ 1160. [1] That the final decree should provide for the distribution of the profits or damages awarded to the respective parties in interest, see Campbell *v.* James (1880), 18 Blatch. 92; 5 Bann. & A. 354; 18 O. G. 1111; 2 Fed. Rep. 338.

That a decree will not issue against the officers of a corporation as individuals where the corporation is solvent, and they do not as individuals violate or threaten to violate the patent, see Howard *v.* St. Paul Plow Works (1888), 45 O. G. 1067.

That the defendant will not be ordered to deliver up the infringing articles to be destroyed, except perhaps in some peculiar cases, see American Bell Telephone Co. *v.* Kitsell (1888), 35 Fed. Rep. 521.

[2] That although an interlocutory decree is given for the plaintiff, yet if on the return of the master's report it appears that he ought not to recover, the final decree may be for the defendant, see Steam Stone Cutter Co. *v.* Sheldon (1884), 22 Blatch. 484; 21 Fed. Rep. 875; Spill *v.* Celluloid Mfg. Co. (1884), 22 Blatch. 441; 29 O. G. 773; 22 Fed. Rep. 94; Wooster *v.* Handy (1884), 22 Blatch. 307; 28 O. G. 629; 21 Fed. Rep. 51.

That if a re-issue is improper, the bill will be dismissed even after the report of the master on an interlocutory decree for the plaintiff, see American Diamond Drill Co. *v.* Sullivan Mach. Co. (1884), 22 Blatch. 298; 28 O. G. 811; 21 Fed. Rep. 74.

That the dismissal of a bill, after evidence taken, on the stipulation that such evidence may be used in any future suit on that patent, is allowable, and is not a dismissal on the merits, see Brush *v.* Condit (1884), 22 Blatch. 246; 28 O. G. 451; 20 Fed. Rep. 826.

[3] See Equity Rule 88.

§ 1161. [1] Sec. 692, Rev. Stat.

[2] That appeal lies only from a final

the Patent Laws without reference to the amount involved, unless the questions at issue relate merely to the taxation of costs, concerning which no appeal is entertained if the costs in controversy are less than two thousand dollars.[a] Any party aggrieved by the alleged error, and having a distinct interest, may move for an appeal within two years after the entry of the final decree; but if the appeal is to operate as a *supersedeas*, the motion must be made within sixty days, and security be given by the appellant sufficient to cover the award, if any, to the prevailing party, with his costs and damages for the delay.[4] A notice to the adverse party to appear

decree, see Hayes *v.* Fischer (1880), 102 U. S. 121.

That a decree cannot be appealed from until after the return of the master's report, see Potter *v.* Mack (1868), 3 Fisher, 428.

That a decree referring the case to a master for an account or damages, but not dismissing the bill or decreeing costs, is not a final decree from which appeal lies to the Supreme court, though a perpetual injunction was granted, see Barnard *v.* Gibson (1849), 7 How. 650.

That the decision of the Circuit court, affirming or denying simply, is a judgment from which an appeal lies to the Supreme court, see Barker *v.* Stowe (1882), 22 O. G. 259; 11 Fed. Rep. 303; 20 Blatch. 185.

That the damage caused by a perpetual injunction does not make it the subject-matter of an appeal, see Barnard *v.* Gibson (1849), 7 How. 650.

[3] That in patent cases an appeal lies without reference to the amount, see Philip *v.* Nock (1871), 13 Wall. 185; Wilson *v.* Sandford (1850), 10 How. 99; Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb. 530.

That the Supreme court will not examine into the merits of any decree, on an appeal by the plaintiff, where the only question is one of costs, see Elastic Fabrics Co. *v.* Smith (1879), 100 U. S. 110.

That an appeal will lie to the Supreme court on a question of costs, not involving the interpretation of the Patent Laws, only when the amount is over two thousand dollars, see Sizer *v.* Many (1853), 16 How. 98.

[4] That any party aggrieved may appeal though he has been added since proceedings commenced, see *Ex parte* Jordan (1876), 94 U. S. 248; *Ex parte* Cutting (1876), 94 U. S. 14; Sage *v.* Central R. R. Co. (1876), 93 U. S 412.

That any defendant can appeal to the Supreme court though the defendants in previous cases have not done so, see Potter *v.* Whitney (1866), 3 Fisher, 77; 1 Lowell, 87.

That after the Supreme court has passed on one case on its merits it will not hear arguments on technical points of pleading in another branch of the same case in another State, between those who were privies to the former case, see Smith *v.* Ely (1853), 15 How. 137.

That if an appeal does not operate as a *supersedeas*, security should be required of the appellant in twice the amount of the costs that the appellee may recover, but if the appeal does operate as a *supersedeas* then the security should be twice the value of all that is to be recovered unless it is otherwise secured, see American Nicholson Pavement Co. *v.* City of Elizabeth

is necessary, unless the appeal is taken in open court during the term at which the decree was granted.[5] No error of law will be considered in the court above except those apparent on the record and duly and specificially assigned.[6] Questions of fact are heard and determined upon the evidence sent up with the record from the court below;[7] or an agreed statement of facts may be submitted presenting the points on which the judgment of the court is sought.[8] Collusive appeals, how-

(1874), 6 O. G. 772; 1 Bann. & A. 463.

That an appeal may be taken within two years unless it is to operate as a *supersedeas*, see Sec. 1008, Rev. Stat.

That where an appeal operates as a *supersedeas* it must be moved for within sixty days, see Secs. 1007, 1012, Rev. Stat.

[5] That notice of the appeal must be given to the adverse party, see R. R. Co. *v.* Blair (1879), 100 U. S. 661.

That if the appeal is taken in open court at the same term no citation is necessary, see Milner *v.* Meek (1877), 95 U. S. 252.

[6] That on appeal no error can be assigned unless it is apparent on the record, see Bates *v.* Coe (1878), 98 U. S. 31; 15 O. G. 337; Roemer *v.* Simon (1877), 95 U. S. 214; 12 O. G. 796.

That an assignment of error that the "patent is invalid," without pointing out the defect, is insufficient, see Marsh *v.* Seymour (1877), 97 U. S. 348; 13 O. G. 723.

[7] That on an appeal a patent not introduced below cannot be offered, see Thomson *v.* Wooster (1885), 114 U. S. 104; 31 O. G. 913.

That on appeal to the Supreme court only the printed matters can be used at the hearing, and delay will not be granted for the printing of papers which ought not to have been sent up at all, see Craig *v.* Smith (1879), 100 U. S. 226; 17 O. G. 145.

That the lower court should send up what was read or inspected below, not what was merely presented, like the affidavits in support of a bill of review, see Craig *v.* Smith (1879), 100 U. S. 226; 17 O. G. 145.

That affidavits taken before the master or the court below as grounds of application to open proofs cannot be taken as evidence before the court on appeal, see Thomson *v.* Wooster (1885), 114 U. S. 104; 31 O. G. 913.

That copies only should be sent up and the originals kept in the court where they belong, unless in the opinion of the court below they require inspection above, see Craig *v.* Smith (1879), 100 U. S. 226; 17 O. G. 145.

That papers which ought to have been copied into the transcript and are sent up as originals will not be noticed, see Craig *v.* Smith (1879), 100 U. S. 226; 17 O. G. 145.

That the record for the Supreme court must set out the account of profits if any has been taken, see Illinois Central R. R. Co. *v.* Turrill (1876), 94 U. S. 695; 12 O. G. 709.

That the Supreme court may consult the evidence contained in the record in order to determine the scope of the invention, though prior use is not set up in the answer, see Eachus *v.* Broomall (1885), 115 U. S. 429; 33 O. G. 1265.

[8] That cases may be brought to the Supreme court on an agreed statement of facts, see Stimpson *v.* Baltimore & Susquehanna R. R. Co. (1850), 10 How. 329.

ever, are not tolerated; and if, pending an appeal taken in good faith, such compromises are effected between the parties as to leave no real contest subsisting, the court will refuse further cognizance of the appeal.[9] Unless dismissed on these or other grounds of impropriety, an appeal results in the affirmation of the decree of the Circuit court, or in its modification or reversal, whereupon a mandate issues to the court below, in pursuance of which further proceedings are conducted.[10]

§ 1162. Costs in Equity: when Taxed and in Whose Favor.

In equity costs are divided, awarded, or denied by the court as justice may require.[1] They do not follow the judgment as a matter of right, and, unless granted in the decree, they cannot be recovered.[2] *Prima facie*, however, the prevailing party is entitled to his costs, and the burden of proof rests upon his adversary to show that such allotment would be inequitable.[3] A full taxation of the costs cannot take

[9] That where the appellants, pending the appeal, purchased the opposing patents and gave the parties stock in the defeated corporation, but did not compromise the damages, the appeal was dismissed, there being no longer any real controversy, see Wood Paper Co. *v.* Heft (1869), 8 Wall. 333.

That when it appears that an appeal is collusive, the decree of affirmance in the Supreme court will be set aside, and the order to the Circuit court recalled, see Gardner *v.* Goodyear Dental Vulcanite Co. (1873), 3 O. G. 295; 6 Fisher, 329.

[10] That on an appeal if the Supreme court reverses the decision of the Circuit court, sustaining the patent, it may also reverse such orders and judgments for contempt as embrace an award of damages or profits to the plaintiff, see Worden *v.* Searls (1887), 121 U. S. 14; 39 O. G. 359.

That where no notice was given of the defence of priority and the evidence was heard as to it against the plaintiff's objection, judgment will be reversed in the Supreme court, though the plaintiff did not appeal on that ground, see Blanchard *v.* Putnam (1869), 8 Wall. 420.

That an appeal from a final decree providing for payment of the master's fees does not suspend the order for their payment, see Myers *v.* Dunbar (1874), 8 O. G. 321; 1 Bann. & A. 565; 12 Blatch. 380.

§ 1162. [1] That in equity the court will divide, award, or deny costs as justice requires, see Troy Iron and Nail Factory *v.* Corning (1872), 6 Fisher, 85; 10 Blatch. 223.

[2] That in equity costs do not follow as a matter of right, and must be awarded in the decree or they will not be recoverable, see Coburn *v.* Schroeder (1881), 8 Fed. Rep. 521; 20 O. G. 1085; 19 Blatch. 493.

[3] That costs are always awarded to the successful party unless his own con-

place until the final decree, though special costs may be allowed on interlocutory orders during the course of the proceedings.[4] Full costs will be decreed in favor of the plaintiff when the substantive issues raised on the accounting were decided in accordance with his claims; though where the defendant was willing, at the outset, to pay the net profits, and the costs of the accounting have thus been unnecessarily made by the plaintiff, each party is compelled to bear his own costs and one-half the master's fee.[5] The same division of the

duct would render it inequitable and unjust, see Bunker *v.* Stevens (1886), 26 Fed. Rep. 245; 36 O. G. 345.

That in equity costs are *prima facie* taxable to the prevailing party, but not if inequitable in whole or in part, though the burden of proof rests upon the party objecting to them, see Hovey *v.* Stevens (1846), 3 W. & M. 17; 2 Robb, 567.

That no costs will be taxed in equity when neither party fully prevails, see Hayes *v.* Bickelhoupt (1885), 29 O. G. 868; 21 Fed. Rep. 567.

[4] That costs cannot be fully taxed or execution issue until final decree, and an appeal or *supersedeas* will stay the execution, see Coburn *v.* Schroeder (1881), 20 O. G. 1085; 8 Fed. Rep. 521; 19 Blatch. 493.

That in taxing costs a "final hearing" is the submission of a case for judgment after issue, see Goodyear Dental Vulcanite Co. *v.* Osgood (1878), 13 O. G. 325; 2 Bann. & A. 529.

That equity may allow costs on interlocutory orders before final decree, see Avery *v.* Wilson (1884), 20 Fed. Rep. 856.

[5] That if the plaintiff prevails in the issues raised on the accounting, the defendant must pay the whole cost, see Urner *v.* Kayton (1883), 17 Fed. Rep. 845.

That where the plaintiff prevails on one of two patents in suit he must have a decree, but costs are at the discretion of the court, and may be apportioned, see Pennsylvania Diamond Drill Co. *v.* Simpson (1886), 37 O. G. 218; 29 Fed. Rep. 288.

That a bill being dismissed as to one patent and sustained as to the other, costs were allowed to neither party, see Schmid *v.* Scovill Mfg. Co. (1889), 39 Fed. Rep. 345; Fay *v.* Allen (1885), 24 Fed. Rep. 804; 32 O. G. 1355; Everest *v.* Buffalo Lubricating Oil Co. (1884), 28 O. G. 1101; 20 Fed. Rep. 848; Adams *v.* Howard (1884), 26 O. G. 825; 19 Fed. Rep. 317; 22 Blatch. 47.

That when a re-issue is held invalid in part, costs may be divided, see Yale Lock Co. *v.* Sargent (1886), 117 U. S. 536; 35 O. G. 497.

That if the defendants have infringed and there has been no unreasonable delay in disclaiming, a disclaimer may be filed, and an injunction issue, and an account be ordered, but no costs can be recovered, see Hake *v.* Brown (1889), 37 Fed. Rep. 783; Electrical Accumulator Co. *v.* Julien Electric Co. (1889), 38 Fed. Rep. 117; Hayes *v.* Bickelhoupt (1885), 23 Fed. Rep. 183; 32 O. G. 135; Myers *v.* Frame (1871), 4 Fisher, 493; 8 Blatch. 446.

That a plaintiff disclaiming pending suit cannot recover costs, but may have an injunction, each party paying his own costs, without previous record of the disclaimer in the Patent Office, see Aiken *v.* Dolan (1867), 3 Fisher, 197.

That one Claim being disclaimed, a

costs is ordered where the plaintiff, by exaggerating his demands, has wasted time in the accounting, and has finally recovered but a small amount.[6] When the master reports no profits or substantial damages, and nominal damages alone are, therefore, given to the plaintiff, costs are allowed him up to and including the interlocutory decree, while the costs of the accounting are awarded to the defendant; one being set off against the other, and the balance recovered by the proper party.[7] A similar disposition of the costs is made when a report of damages or profits is reversed.[8] The de-

decree without costs may be had on the others, see Christman *v.* Rumsey (1879), 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506; 58 How. Pr. 114.

That where one Claim of a re-issue is too broad, a decree may be had on the other without costs, on filing a disclaimer, see Tyler *v.* Galloway (1882), 20 Blatch. 445; 22 O. G. 2072; 12 Fed. Rep. 567.

That where the patent claims old features, the disclaimer must be filed before suit or no costs will be allowed, see Tuck *v.* Bramhill (1868), 3 Fisher, 400; 6 Blatch. 95; Singer *v.* Walmsley (1860), 1 Fisher, 558.

That if the defendants were willing at the outset to pay the net profits, and the plaintiff has made the costs, each party must pay his own costs and one half the master's fee, see Ford *v.* Kurtz (1882), 12 Fed. Rep. 789; 11 Bissell, 324.

[6] That where the plaintiff exaggerated his claims, and wasted much time, and recovered only a small amount, costs were allowed to fall on each party, and the master's fee was paid by both equally, see Troy Iron and Nail Co. *v.* Corning (1872), 10 Blatch. 223; 6 Fisher, 85.

That though the patent is sustained and an accounting is had, if the plaintiff knew that nothing could be allowed him as profits or damages, he must pay the cost of the accounting, see Hill *v.* Smith (1887), 32 Fed. Rep. 753.

[7] That where nominal damages are allowed, costs will be taxed for the plaintiff up to the reference to the master, after that for the defendant, see Kirby *v.* Armstrong (1881), 19 O. G. 661; 5 Fed. Rep. 801; 10 Bissell, 135; Ingersoll *v.* Musgrove (1878), 13 O. G. 966; 14 Blatch. 541; 3 Bann. & A. 304.

That when the master reports only nominal damages on a decree *pro confesso*, and the plaintiff excepts to the report, and the exceptions are overruled, costs will be allowed him only up to and including the interlocutory decree, and the defendant will be allowed costs thereafter, the one to be set off against the other and the balance only recovered, see Fisk *v.* West, Bradley, & Cary Mfg. Co. (1880), 19 O. G. 545.

That on an award of nominal damages the cost of the reference, the master's fees, and the hearing on the report, fall on the plaintiff, see Everest *v.* Buffalo Lubricating Oil Co. (1887), 31 Fed. Rep. 742.

That where nominal damages are allowed, costs will be awarded according to the circumstances of the case, see Calkins *v.* Bertrand (1881), 8 Fed. Rep. 755; 10 Bissell, 445.

[8] That when the assessment of dam-

fendant has his costs on the dismissal of the bill either at the interlocutory or the final hearing, unless the cause has been to his advantage by defining his rights and protecting him from future interference, and the action was in good faith instituted by the plaintiff.[9] No costs are thus taxed in his favor when the patent is found invalid, and the bill is dismissed, on the ground of the inventor's acquiescence in more than two years' public use or sale while ignorant of his legal rights.[10] When evidence not covered by the notice in the answer is admitted on amendment by agreement, and the defendant finally prevails, the costs which had accrued to him before the hearing cannot be recovered.[11] On the dismissal of a bill and cross-bill, the costs, being equal, are not taxed for either party.[12] All persons who are entered on the record as plaintiffs or defendants are liable for any costs that may be decreed against them. Claims not in issue will not be adjudicated merely to settle questions as to costs.[13]

ages is reversed the plaintiff will be allowed costs up to and including the interlocutory decree, and the defendant afterwards, see Dobson *v.* Hartford Carpet Co. (1885), 114 U. S. 439; 31 O. G. 787.

[9] That no costs will be allowed to the defendant when the bill is dismissed, if the defendant is really benefited by it, as when his own rights are definitely settled, see Smith *v.* Woodruff (1873), 4 O. G. 635; 6 Fisher, 476.

That costs may be denied the defendant where his own conduct led the plaintiff into the controversy, see Bunker *v.* Stevens (1885), 26 Fed. Rep. 245; 36 O. G. 345.

[10] That where the patent is found invalid, and the bill is dismissed on the ground of the plaintiff's acquiescence in the public use and sale of his invention, in ignorance of his legal rights and duties, no costs will be taxed against him, see Sisson *v.* Gilbert (1871), 5 Fisher, 109; 9 Blatch. 185.

[11] That where evidence not covered by the notice is admitted upon an amendment of the notice by agreement, the defendant can have no costs up to the hearing, see Roberts *v.* Buck (1873), 3 O. G. 268; Holmes, 224; 6 Fisher, 325.

[12] That no costs will be allowed on dismissing the bill and cross-bill, they being nearly equal, see Prime *v.* Brandon Mfg. Co. (1879), 16 Blatch. 453; 4 Bann. & A. 379.

[13] That claims not in issue will not be contested merely to settle costs, see American Bell Telephone Co. *v.* Spencer (1881), 20 O. G. 299; 8 Fed. Rep. 509.

That a decree will not be reviewed on appeal for the mere purpose of settling a question of costs, see Union Paper Bag Mach. Co. *v.* Nixon (1882), 105 U. S. 766; 21 O. G. 1275.

§ 1163. Items of Taxable Costs.

The items of costs recoverable in equity are substantially identical with those taxable at law, so far as the essential differences in procedure will permit. The fees of the clerk, the marshal, and the witnesses, the cost of the pleadings, the expenses incurred for models or copies of models in the Patent Office, or for transcripts of assignments when procured by the defendant, and for necessary telegraphing, are among the items usually allowed.[1] A docket-fee is taxed in every case where a final decree is entered after a replication has been filed, and though several cases are by agreement heard together and one decree is passed deciding all, a docket-fee in each case may be awarded.[2] Depositions taken in another case and in the present one admitted by consent, the cost of printing the pleadings, evidence, or arguments for the convenience of the court, the expense of making or procuring copies of models not on deposit in the Patent Office, or copies of patents or drawings obtained as evidence for his own use by the defendant, are not included in the items taxed.[3] The

§ 1163. [1] As to the usual items taxed as costs, see § 1080 and notes, *ante*.

[2] That any final decree after replication is a final hearing under Sec. 284, Rev. Stat., for the purpose of a docket-fee, see Goodyear Dental Vulcanite Co. *v.* Osgood (1877), 13 O. G. 325; 2 Bann. & A. 529.

That where several cases are heard together by agreement and one decree is entered for all, a docket-fee will be taxed in each case, see Goodyear Dental Vulcanite Co. *v.* Osgood (1877), 13 O. G. 325; 2 Bann. & A. 529.

That where a case is dismissed on motion of the plaintiff after issue and interlocutory decree on the merits, a docket-fee will be taxed, see Goodyear Dental Vulcanite Co. *v.* Osgood (1877), 13 O. G. 325; 2 Bann. & A. 529.

That no docket-fee will be taxed for an attorney who did not enter on the docket before the filing of the general replication, or who has not been admitted to the Supreme court or to some Circuit court, see Goodyear Dental Vulcanite Co. *v.* Osgood (1877), 13 O. G. 325; 2 Bann. & A. 529.

That no attorney's docket-fee is to be taxed for attendance on an order of reference to a master, see Doughty *v.* West, Bradley & Cary Mfg. Co. (1870), 4 Fisher, 318; 8 Blatch. 107.

That a docket-fee and certified copies of file-wrappers, &c., are not taxable for the defendant where the bill is dismissed after the cause was at issue and noticed for hearing, see Ryan *v.* Gould (1387), 41 O. G. 1392.

[3] That officers of an infringing corporation who appear as witnesses on an accounting, cannot have their mileage and attendance taxed as costs, see American Diamond Drill Co. *v.* Sullivan Mach. Co. (1885), 32 Fed. Rep. 552.

That when evidence is taken to be

master's fee is payable by the defendant on the return of the report, and may be recovered by him from the plaintiff if the bill is finally dismissed; though in some districts it is the custom to charge it to the plaintiff, and tax it in his costs against the defendant.[4]

used in two cases its cost will be divided between them, see Thayer *v.* Hart (1884), 20 O. G. 776.

That depositions taken in another case against other defendants and admitted in the present one by consent, though under the same patent, were not taxed, but a solicitor's fee of $2.50 was allowed in each, see Wooster *v.* Handy (1885), 23 Fed. Rep. 49; 23 Blatch. 113. See this case for several other rulings on items of cost.

That the expense of printing evidence for the convenience of the court will not be taxed against the losing party, see Spaulding *v.* Tucker (1871), 4 Fisher, 633.

As to other items not taxed, see § 1080 and notes, *ante*.

[4] That the master's fee may be collected, in the first instance, from the defendant by order of court, and by him recovered as costs on a final decree in his favor, see Urner *v.* Kayton (1883), 24 O. G. 1178; Myers *v.* Dunbar (1874), 8 O. G. 321; 12 Blatch. 380; 1 Bann. & A. 565.

That the order of court for payment of the master's fees and such other costs must be literally obeyed, see Myers *v.* Dunbar (1874), 8 O. G. 321; 12 Blatch. 380; 1 Bann & A. 565.

That the fees of the master are not to exceed the fees allowed by the statutes to a commissioner in a like reference, though in some difficult cases it may be greater, see Doughty *v.* West, Bradley & Cary Mfg. Co. (1870), 4 Fisher, 318; 8 Blatch. 107.

That ten dollars a day may be allowed the master in peculiar cases, see Doughty *v.* West, Bradley & Cary Mfg. Co. (1870), 4 Fisher, 318; 8 Blatch. 107.

That the clerk has no power to fix the compensation of the master, see Doughty *v.* West, Bradley, & Cary Mfg. Co. (1870), 4 Fisher, 318; 8 Blatch. 107.

That where the interlocutory decree for the plaintiff is set aside on rehearing or final decree, the master's fees paid by the defendant are taxable as costs against the plaintiff, but the court, not the clerk, should tax them, see American Diamond Drill Co. *v.* Sullivan Mach. Co. (1885), 32 Fed. Rep. 552.

That in Massachusetts the master's fee for taking the account is charged in the first instance to the plaintiffs, and recovered by him as costs against the defendant if he prevails, see Macdonald *v.* Shepard (1882), 10 Fed. Rep. 919.

That the master is an officer of the court and is entitled to his compensation irrespective of the result of the suit, see Myers *v.* Dunbar (1874), 8 O. G. 321; 1 Bann. & A. 565; 12 Blatch. 380.

That costs being once equitably taxed by consent, the consent cannot be withdrawn when the master's report comes in, see Holbrook *v.* Small (1878), 17 O. G. 55; 3 Bann. & A. 625.

That no costs will be taxed as to the exceptions to a master's report when all were overruled by the court, see Troy Iron & Nail Factory *v.* Corning (1872), 6 Fisher, 85; 10 Blatch. 223.

§ 1164. Bill of Review.

A final decree in equity, if unappealed from or affirmed upon appeal, permanently concludes the parties on all matters covered by its terms, unless reversed by a bill of review. A bill of review may be filed, by leave of the court, for errors of law apparent on the record, and without leave of the court for errors in fact disclosed by the discovery of new evidence.[1] When based upon alleged errors of law, the bill serves the same purpose, and is governed by the same general principles, as a writ of error, and must be filed within the time allowed for that proceeding.[2] If intended to correct errors in fact, and for that end to introduce new evidence, it occupies the same position and is guided by the same rules as an application for a new trial.[3] On such a bill the court may permit additional testimony to be offered, and new instances of prior use to be alleged and shown; but if the party, although duly notified, was voluntarily absent from the former trial, or if the new evidence suggested could have been discovered by diligent attention to the matters brought out in the previous hearing, the bill will be dismissed and the relief denied.[4] A decree by consent cannot be reversed on a bill of review, unless the consent has been obtained by fraud.[5] The bill must show that the new facts to be produced are material

§ 1164. [1] As to the nature and object of a Bill of Review, see Story Eq. Pl. §§ 403–428.

[2] That a bill of review based on errors of law follows the rules governing writs of error, see Clark *v.* Killian (1880), 103 U. S. 766.

[3] That a bill of review based on errors of fact is governed by the same rules as a petition for a new trial, see Story Eq. Pl. §§ 412–419.

[4] That courts may, in their discretion, allow newly discovered evidence to be introduced on a bill of review, but the power is to be exercised cautiously and only when necessary to justice, see Craig *v.* Smith (1879), 100 U. S. 226; 17 O. G. 145.

That on a bill of review new instances of prior use may be alleged and shown, if the bill is filed more than thirty days before the final submission, see Craig *v.* Smith (1879), 100 U. S. 226; 17 O. G. 145.

That if the plaintiff fails to appear at the trial and the court examines the pleadings, proofs, and exhibits, and decrees for the defendant, a bill of review cannot be sustained unless it alleges new matter or an error on the record, see Irwin *v.* Meyrose (1381), 2 McCrary, 244; 7 Fed. Rep. 533. This case contains a discussion of bills of review and decisions thereon.

[5] That a decree by consent cannot be set aside by a bill of review, see *In re* Pentlarge & Beeston (1879), 17 Blatch. 306; 4 Bann. & A. 607.

to some issue covered by the decree; that, if the testimony is received, the decree upon this issue will be more favorable to the petitioner; and that he had employed due diligence in the investigation and presentation of his evidence at the former trial.[6] If the bill is sustained, the decree is opened and a new hearing takes place, upon which the decision, and if necessary the new reference and accounting, will proceed.

§ 1165. Bill of Revivor.

When by the death of either of the parties a suit in equity becomes abated, a bill of revivor will restore it and permit the court to proceed to its determination.[1] A bill of revivor can be filed only by or against the personal representatives, as distinguished from the assignee or devisee, of the deceased party, and only when the death does not prevent the court from granting the desired relief.[2] Thus if the original bill prays for an injunction and account, and the defendant dies before the final decree, though an injunction is no longer possible, a bill of revivor will perpetuate the suit against his representatives and enable the plaintiff to secure his damages and profits against the estate.[3] A devisee, although

[6] That a petition for leave to file a supplemental bill in the nature of a bill for a review must show that the petitioner could not with reasonable diligence have discovered the alleged new matters before the hearing and decision, and that the new matter is material, see Spill *v.* Celluloid Mfg. Co. (1884), 22 Blatch. 441; 29 O. G. 773; 22 Fed. Rep. 94.

That a bill of review will not be granted when the petitioner could, by diligent attention to the exhibits attached to the original bill, have found out what he now relies on as new matter, or where the court is satisfied that the decree will be the same, see Rubber Co. *v.* Goodyear (1869), 9 Wall. 805.

§ 1165. [1] Equity Rule 56.

That where the defendant dies pending suit, a bill of revivor may be filed against his representatives, see Hohorst *v.* Howard (1888), 37 Fed. Rep. 97; Kirk *v.* Du Bois (1886), 28 Fed. Rep. 460; 37 O. G. 102; Smith *v.* Baker's Adm'rs (1874), 5 O. G. 496; 10 Phila. 221; 1 Bann. & A. 117.

[2] That a bill of revivor is not to be filed by the assignee of the original complainant, but only by the legal representatives of a deceased party, see Metal Stamping Co. *v.* Crandall (1880), 18 O. G. 1531.

That a bill of revivor will lie only where the cause of action would survive, see Story Eq. Pl. § 356.

[3] That where a decree fixing the liability of a defendant is rendered during his lifetime, the suit will survive, see Atterbury *v.* Gill (1877), 13 O. G. 276; 2 Flippin, 239; 3 Bann. & A. 174.

That on the death of a defendant, pending a bill for an injunction and account, a bill will lie against his rep-

unable to avail himself of a bill of revivor, may file an original bill of the same character, and obtain thereby the benefit of the previous proceedings.[4] An action abated by any other event than the death of a party, if the cause of action still exists, may be restored in a similar manner by a bill in the nature of a bill of revivor.[5]

§ 1166. Bill to Perpetuate Testimony.

Auxiliary to actions for infringement are two other equitable proceedings: a Bill to Perpetuate Testimony, and a Bill of Discovery. A bill to perpetuate testimony is required whenever it becomes apparent that on a future action, which the proper plaintiff refuses to commence or which he cannot yet begin, certain evidence will be important, and that, though now available, this evidence may at that time be beyond the reach of the petitioner.[1] Upon this bill, its allegations being sustained by proof, the court will cause the testimony to be taken in some suitable manner, and preserved among the records of the court, until it may be needed at the trial.[2]

§ 1167. Bill of Discovery.

A bill of discovery is a bill praying for the compulsory disclosure of certain facts within the knowledge of the re-

---

resentatives to revive the suit and obtain an account, see Smith *v.* Baker's Admrs. (1874), 5 O. G. 496; 1 Bann. & A. 117; 10 Phila. 221.

That under Rule 56 a bill of revivor filed by an administrator when the defendant died after the interlocutory decree against him, and while the case was before the master for an award, does not revive the case unless the court so orders, see Atterbury *v.* Gill (1877), 13 O. G. 276; 2 Flippin, 239; 3 Bann. & A. 174.

[4] That a devisee is unable to obtain a bill of revivor, though he may have relief and the benefit of the prior proceedings on filing an original bill in the nature of a bill of revivor, see Story Eq. Pl. §§ 377–379.

[5] Equity Rule 56.

That the death of a patentee after an appeal does not abate the suit, see Illinois Central R. R. Co. *v.* Turrill (1884), 110 U. S. 301; 26 O. G. 917.

§ 1166. [1] As to the object and nature of a Bill to Perpetuate Testimony, see 2 Story Eq. Jur. §§ 1505–1516.

That a bill for the perpetuation of testimony will not be granted where a suit can at once be brought by the petitioner, see New York & Baltimore Coffee Polishing Co. *v.* New York Coffee Polishing Co. (1881), 9 Fed. Rep. 578; 20 Blatch. 174.

[2] As to the form of and proceedings in a Bill to Perpetuate Testimony, see Story Eq. Pl. §§ 300–310.

spondent, or the production of certain documents or other articles within his custody or control.[1] It is ordinarily employed only in aid of suits at law, or as collateral or introductory to other equitable proceedings.[2] The bill must aver some right in the petitioner which the discovery might help to vindicate, and demand information which might constitute a ground for some claim or defence in the principal action.[3] The respondent named must be a party to such action, and not simply a witness.[4] A corporation may be called upon for a discovery by this proceeding and must answer; but if a disclosure under oath is to be ordered, its officers must also be made parties.[5] Under a mere bill of discovery, the petitioner can obtain no other assistance than the disclosure for which he asks; but if his bill contains a prayer for general

§ 1167. [1] As to the nature and object of a Bill of Discovery, see 2 Story Eq. Jur. §§ 689–691, 1480–1504; Equity Rules, 40–44.

For a discussion of the value and employment of bills of discovery, see Colgate *v.* Compagnie Française (1885), 23 Blatch. 86; 23 Fed. Rep. 82.

[2] That a bill of discovery of royalties due is not allowable except in aid of an action at law, the legal remedy being sufficient, see Perkins *v.* Hendryx (1885), 23 Fed. Rep. 418.

That a court of law cannot compel the defendant to allow an inspection of his methods as equity can, and thus a bill of discovery in aid of a suit at law is proper, see Colgate *v.* Compagnie Française (1885), 23 Fed. Rep. 82; 23 Blatch. 86.

That a bill of discovery will lie in the Circuit court, as ancillary to a suit for infringement, irrespective of citizenship, see Kendall *v.* Winsor (1860), 6 R. I. 453.

[3] That a bill of discovery must aver a title to be aided by the discovery, and if it is imperfect it cannot be treated as a bill for general relief, see Young *v.* Colt (1852), 2 Blatch. 373.

That a defendant cannot demand a discovery from the plaintiff as to his title and its source and validity by a cross-bill, unless he alleges title in himself, see Young *v.* Colt (1852), 2 Blatch. 373.

That discovery in patent cases is of the nature of an inspection, and is more effective than adverse testimony, see Colgate *v.* Compagnie Française (1885), 23 Blatch. 86; 23 Fed. Rep. 82.

For the requisites of a Bill of Discovery, see Story Eq. Pl. §§ 311–325.

[4] That discovery can be obtained only from one who is a party to the bill, see Equity Rule 40.

[5] That a corporation may be defendant on a bill of discovery in aid of a suit at law for infringement, and must make answer, though it cannot answer under oath, see Colgate *v.* Compagnie Française, (1885), 23 Fed. Rep. 82; 23 Blatch. 86.

That where a corporation is defendant in a bill of discovery the officers must be made parties, if the discovery is to be on oath, see Vaughn *v.* East Tennessee, Virginia, & Georgia R. R. Co. (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

relief, and the discovery is made, the court may grant whatever remedy the facts disclosed require.[6]

SECTION V.

OF INFRINGEMENT: INJUNCTIONS.

§ 1168. Value of Preventive Equitable Action in Cases of Expected Infringement.

The exercise of its preventive jurisdiction by a court of equity, in cases of infringement, is the most potent and most valuable of all the methods provided by the law for the protection of the owner of a patent.[1] It removes from him the danger of an irremediable injury, precludes the necessity of innumerable suits for his successive wrongs, and interposes in the path of the infringer an obstacle which he cannot overcome.[2] It is the proper complement of that legislative

[6] That under a bill for discovery only, the plaintiff is not entitled to an account, see Magic Ruffle Co. *v.* Elm City Co. (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

That a bill in equity, stating approximately the amount of the defendant's gains and praying for a disclosure, is not a bill of discovery or a bill praying for a discovery, see Gordon *v.* Anthony (1879), 16 O. G. 1135; 16 Blatch. 234; 4 Bann. & A. 248.

That the admission of counsel as to the object of a bill is disregarded, for if the bill appears to be a bill for a discovery, it is such, see Perry *v.* Corning (1868), 6 Blatch. 134.

That a bill praying for an answer on oath and an account, though it does not allege that a discovery is necessary or contain interrogatories, or pray for an injunction, is a bill for a discovery and account and is sufficient, see Perry *v.* Corning (1868), 6 Blatch. 134.

That where a discovery is necessary and granted, the court may take entire jurisdiction and give complete relief, see Magic Ruffle Co. *v.* Elm City Co. (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

That under a bill for discovery and other equitable relief, if the object of the plaintiff is to obtain damages, the discovery being had the court will give relief in damages, see Magic Ruffle Co. *v.* Elm City Co. (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506.

§ 1168. [1] That there can be no injunctions at law, see Motte *v.* Bennett (1849), 2 Fisher, 642.

That only equity can prevent an invasion of rights, see McMillin *v.* Barclay (1871), 5 Fisher, 189; 4 Brews. (Pa.) 275.

That a court of equity may decree a final remedy, and also protect property during litigation, see Potter *v.* Dixon (1863), 2 Fisher, 381; 5 Blatch. 160.

[2] That the purpose of an injunction is to prevent infringements and a multiplicity of suits, see Brooks *v.* Miller (1886), 28 Fed. Rep. 615; Brooks *v.*

action which confers upon the inventor his exclusive privilege,—the one prohibiting all interference with his monopoly, the other practically enforcing this prohibition against individual transgressors; and could the patentee be always forewarned of the intended invasions of his rights, and were he vigilant in seeking this form of relief, no other litigation would ever be required. An injunction is thus the strong arm of the court, at once prompt in its action and effective in its results,[3] never to be employed when other remedies are adequate, but applied unhesitatingly and without restriction wherever the plaintiff cannot otherwise escape irreparable or repeated injuries.[4]

§ 1169. Classes of Injunctions: Preliminary Injunctions and Perpetual Injunctions.

Injunctions in actions for infringement, as in other cases, may be either preliminary or perpetual. A preliminary injunction issues at the commencement, or during the pendency, of other proceedings in equity or at law. It is intended to compel the defendant to desist from his alleged infringing acts until it becomes evident that they do not invade the plaintiff's patent, and thus preserve affairs in *statu quo* while the necessary investigation is in progress in the courts.[1] A perpetual injunction is a decree upon the merits of the contro-

Norcross (1851), 2 Fisher, 661; Motte *v.* Bennett (1849), 2 Fisher, 642.

[3] That an injunction is the strong arm of equity and is never to be used unless the court is convinced of its real necessity, see Potter *v.* Schenck (1866), 3 Fisher, 82; 1 Bissell, 515.

[4] That an injunction will issue whenever it is needed to protect rights, see Wilson *v.* Barnum (1849), 2 Fisher, 635; 1 Wall. Jr. 347; 2 Robb, 749.

That it is the duty of the court to protect the plaintiff's clear rights by an injunction and thus prevent a multiplicity of suits, see Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64.

That an injunction is often the only available remedy, see Potter *v.* Muller (1864), 2 Fisher, 465.

§ 1169. [1] That the object of an injunction is to preserve matters *in statu quo* till the court has investigated them, and if it is of no importance thus to preserve them no injunction will issue, see Westinghouse Air Brake Co. *v.* Carpenter (1887, 32 Fed. Rep. 484; American Nicholson Pavement Co. *v.* City of Elizabeth (1870), 4 Fisher, 189.

That an injunction is granted to preserve the existing order of things, not to disturb it, even though rights may be doubtful, see Singer Mfg. Co. *v.* Union Button Hole & Embroidery

versy, after a trial in equity and a judgment for the plaintiff, permanently prohibiting the defendant from the performance of those acts which have been proved and adjudged to be violations of the patent. Its purpose is to put an end to the manufacture, use, or sale of the invention by the defendant, until the exclusive privilege of the inventor has expired.

§ 1170. Preliminary Injunction: Discretion of the Court in Granting it Guided by Established Rules.

A preliminary injunction is not, like a perpetual injunction, a matter of course, nor can its issue be governed by any formulated and established rules. Its allowance or refusal depends neither upon the plaintiff's right nor on the defendant's wrong, but upon innumerable qualifying circumstances of varying importance, affecting the minds of different judges in a different manner, and rendering each case emphatically a case by itself, whose decision rests entirely with the individual court to which it is presented.[1] Nevertheless, there are certain principles by which the courts are guided in the grant of these injunctions, and certain facts which operate as arguments for or against their issue. These facts and principles require detailed discussion, and in the following paragraphs their character and bearing on preliminary injunctions will therefore be considered. So far as the same principles or facts are applicable to perpetual injunctions they will be hereafter noticed.

Co. (1873), 4 O. G. 553; 6 Fisher, 480; Holmes, 253.

That the purpose of an injunction is to disturb the existing order of things and set them right, see Cook *v.* Ernest (1872), 5 Fisher, 396; 2 O. G. 89.

That an injunction does not impair the right of trial by jury, but merely aids the party having a legal title to protect it till such trial can be had, see Woodworth *v.* Rogers (1847), 3 W. & M. 135; 2 Robb, 625.

§ 1170. [1] That on a motion for an injunction the only question is whether the plaintiff presents an undebatable case, see Goodyear *v.* Hills (1866), 3 Fisher, 134.

That a motion for an injunction depends on its own facts, and the court must decide so as to accomplish the ends of justice and the purposes of its jurisdiction, see Potter *v.* Crowell (1866), 3 Fisher, 112; 1 Abbott, 89.

That on a motion for an injunction the court will carefully consider the rights of parties, and protect the patentee during the litigation, see Morris *v.* Lowell Mfg. Co. (1866), 3 Fisher, 67.

§ 1171. Preliminary Injunction: Grantable only to Prevent Prospective Injury where no other Adequate Remedy Exists.

A preliminary injunction is intended to prevent a prospective injury, and must be confined to the purpose for which it is designed.[1] It cannot be employed for the punishment of past infringements, nor as a method of compelling the defendant to compromise existing controversies, nor to restrain third parties from contracting with the alleged infringer.[2] It is exclusively an auxiliary and collateral remedy, applied only in cases where the right is probable and the invasion of the right apparent, and contemplates a trial of the principal action on its merits, in which the existence, nature, and extent of the infringement will be definitely ascertained.[3] Hence where the right is doubtful, or the wrong uncertain, or where some other mode of temporary protection is equally beneficial to the plaintiff and less injurious to the defendant, or where the object of the plaintiff is not protection to himself but punishment or coercion to the defendant, the injunction ought to be and is refused.[4]

§ 1172. Preliminary Injunction: Grant or Refusal not Subject to Appeal.

The issue or refusal of a preliminary injunction is always within the discretion of the court, and from its judgment

§ 1171. [1] In American Nicholson Pavement Co. *v.* City of Elizabeth (1870), 4 Fisher, 189, Strong, J.: (194) "A preliminary injunction is always an extraordinary exercise of judicial powers. Its purpose is to preserve the existing state of things until the rights of the parties can be fairly investigated. It is not to be used for any other purpose. It looks forward to a trial, and when it is of no importance to preserve things as they are, when the injunction is asked for, it will not be granted. It ought never to be issued unless the right of a patentee is an established or admitted one, and unless the alleged invasion of the right is proved beyond reasonable doubt."

[2] See § 1196 and notes, *post*.

[3] That the act of Feb. 15, 1819, does not alter the principles on which injunctions are granted, see Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477.

[4] That an injunction, though needed, is not to be granted without great caution before a final decree on the merits, see Goodyear *v.* Dunbar (1859), 1 Fisher, 472; 3 Wall. Jr. 310.

That an injunction will only issue *nisi* if the defendants are ready to stop infringing and the validity of the patent

there is no appeal.[1] The law presumes that, as the circumstances of cases differ, so judges will inevitably disagree in the views they take of the same circumstances, and in the significance which they attach to the particular facts which enter into their decisions. The widest liberty is necessarily conceded to the courts in the exercise of this authority, and action in accordance with their best discretion is all that is required.[2] Discretion is not, however, prejudice or arbitrary whim. It involves the obligation to determine each case by what has been done by equity in like cases, in conformity with the practice in equity and the principles on which equity decides.[3] To do exact justice between the parties, according to

is doubtful, see Margot *v.* Schuetzer (1883), 15 Fed. Rep. 118; 24 O. G. 101.

§ 1172. [1] That the grant of an injunction rests in the discretion of the court, see Irwin *v.* Dane (1871), 4 Fisher, 359; 2 Bissell, 442; Potter *v.* Whitney (1866), 3 Fisher, 77; 1 Lowell, 87; Ayling *v.* Hull (1865), 2 Clifford, 494.

That courts have, under Sec. 4921, Rev. Stat., a larger discretion as to injunctions in patent cases than in others, see Yuengling *v.* Johnson (1877), 1 Hughes, 607; 3 Bann. & A. 99.

[2] In Earth Closet Co. *v.* Fenner (1871), 5 Fisher, 15, Knowles, J.: (20) "The motion is one of that class addressed, in technical parlance, to the discretion of the court. For precedents, in any recognized sense of that word, it is, therefore, idle to search. By one judge an injunction may be granted to-day under a given state of facts, and by another be refused to-morrow upon identically the same state of facts, and yet neither functionary be chargeable with even error in judgment. The law makes the judge's discretion the rule, not unheedful that, in the qualities of mind which give character to an exercise of discretion, individuals differ scarcely less than in form and features. The judge is bound to decide a question of this kind as, in his judgment upon the particular case before him, the principles of equity, and the practice of its courts warrant or dictate, — and this, whether his decision be in accord or at variance with that of his brother officer, of whatever grade or whatever locality. The largest liberty imaginable is his, 'with no rules to restrain, no after reckoning to dread.' Neither upon appeal, nor by writ of error, nor even by petition for revisory action, can a judge's rulings or findings upon a motion for a preliminary injunction be subjected to correction or even criticism on the part of his superiors in official rank or in judicial acumen."

That the best exercise of discretion is all that can be expected, see Potter *v.* Whitney (1866), 3 Fisher, 77; 1 Lowell, 87.

[3] In Motte *v.* Bennett (1849), 2 Fisher, 642, Wayne, J.: (645) "By discretion, of course, is meant an obligation upon judges in chancery to determine each case, as nearly as it can be done, by what has been the course in chancery in like cases, as well as to prescribe the practice to be observed in each case, and the principles by which the right is to be determined between the parties in controversy. It never means will or authority in the

the condition of the litigation, the nature of the invention, the character and extent of the infringement, and the effect of the injunction on the interests of the plaintiff and defendant, must be the motive and endeavor of the court, and in the effort to accomplish this the analogy of precedents and the established rules of equity must be the acknowledged and controlling guide.[4] While these are followed, the weight of evidence, the bearing of the facts, and the justice of the antagonistic claims are for the judge alone.

§ 1173. Preliminary Injunction: Granted only when the Patent is Valid, the Title is in the Plaintiff, and there is Danger of an Infringement by the Defendant.

A preliminary injunction will be granted only when the court is satisfied: (1) That the patent is valid; (2) That the plaintiff is the owner of a legal or equitable interest therein; and (3) That the defendant is about to commit an act of infringement.[1] It will be denied if reasonable doubt exists on any one of these points, and even when they are established if other circumstances render its allowance inexpedient or inequitable. Upon an application for a preliminary injunction, an exhaustive hearing as to these essential points

judge, but both restrained by decided cases or long-standing rules."

[4] That though a preliminary injunction is a matter of discretion, not of precedent, the discretion is to be exercised as the rules of equity and the practice of the courts may require in the case at bar, see Earth Closet Co. *v.* Fenner (1871), 5 Fisher, 15.

§ 1173. [1] In Motte *v.* Bennett (1849), 2 Fisher, 642, Wayne, J.: (659) "In equity, where the case is clear and without reasonable doubt, where the bill states a clear right to the thing patented which, together with the alleged infringement is verified by affidavit, and where the plaintiff has been in possession of it by having sold or used 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. And the rule applies as well to a bill brought by an assignee as by the original inventor." See also Wise *v.* Grand Avenue R. R. Co. (1888), 33 Fed. Rep. 277.

Further, that an injunction will issue only when the validity of the patent, the right of the plaintiff, and infringement, actual or prospective, by the defendant, are shown to the satisfaction of the court, see Shelly *v.* Brannan (1870), 4 Fisher, 198; 2 Bissell, 315; Goodyear *v.* Hills (1866), 3 Fisher, 134; Potter *v.* Muller (1864), 2 Fisher, 465; Goodyear *v.* Day (1852), 2 Wall. Jr., 283.

That no injunction will issue on a theory unsupported by proof, see American Diamond Rock Boring Machine Co. *v.* Sullivan Mach. Co. (1877), 14 Blatch. 119; 2 Bann. & A. 522.

is not, however, usually permitted. The court will not anticipate the trial on the merits by an extended examination of the testimony then to be produced, but in cases involving obscure propositions of law, or disputed and intricate questions of fact, will refuse the injunction until these matters come up for investigation in their proper order.[2] This necessary attitude of the courts toward these applications has led to the adoption of peculiar rules of evidence, by which the plaintiff is required to furnish certain special forms of proof, or in their absence to await the final hearing before invoking this preventive power.

§ 1174. Preliminary Injunction: Proof of Validity of Patent: Prior Judgment in its Favor: Public Acquiescence: Admissions of Defendant.

Under these rules of evidence the validity of the patent must be proved either by the judgment of some competent tribunal, or by the long-continued acquiescence of the public in the exclusive privilege which it confers, or by some other act or fact equivalent thereto.[1] The judgment of a compe-

[2] That on a motion for an injunction the court will only examine far enough to see whether the plaintiff's equitable rights require such protection during the litigation, see Sickels *v.* Young (1855), 3 Blatch. 293.

That a motion for a preliminary injunction is not designed to adjudicate disputed points not previously discussed, see Gold & Stock Telegraph Co. *v.* Commercial Telegraph Co. (1885), 22 Fed. Rep. 838.

That on a motion for a preliminary injunction, the court is not bound to decide difficult questions of law or disputed issues of fact, nor to order an injunction till after a full hearing, see Parker *v.* Sears (1850), 1 Fisher, 93.

§ 1174. [1] In Brown *v.* Hinkley (1873), 3 O. G. 384, Longyear, J.: (384) "To entitle a patentee to the extraordinary writ of injunction, it is not sufficient for him merely to show his patent and an infringement of it. His right must be further substantiated in one of two ways: first, by a possession accompanied by an actual use and enjoyment of it for a sufficient length of time to afford a reasonable presumption of the acquiescence of the public in its validity; or, second, by a judgment in his favor in a trial at law. The latter, however, is never necessary where the former exists; but I understand it to be essential in all cases that there should be a trial at law in the absence of such use and enjoyment. This has been the rule in England for more than a century, and it has always been the rule in the United States. The decisions by which the rule is established, and the reasons upon which it is based, are too numerous to be cited here." 6 Fisher, 370 (373).

In Toppan *v.* National Bank Note Co. (1861), 2 Fisher, 195, Shipman,

tent tribunal sustaining a patent is the highest evidence of its validity. It is not only conclusive upon the parties to the

J.: (108) "This extraordinary relief is never granted as matter of course. It is never granted on filing a bill and producing a patent. The patent itself, although in a certain sense it is *prima facie* evidence of the validity of the grant, is never sufficiently strong *per se* to warrant the relief asked for in this motion. The title of the patentee must, in order to obtain this relief, always be strengthened by exclusive possession for some period of time, or by an adjudication in which the validity of the patent has been sustained." 4 Blatch. 509 (511).

In Grover & Baker Sewing Mach. Co. *v.* Williams (1860), 2 Fisher, 133, Sprague, J.: (135) "In such a hearing it is not sufficient for a plaintiff, in order to make out a *prima facie* case, merely to produce his patent. The court will not, upon the mere production of a patent, entertain this motion for a preliminary injunction. The *prima facie* right under the patent must be strengthened; and that is done in one of two ways, by a judgment or decree after a judicial investigation, or by exclusive possession for some time, or, in other words, by the acquiescence of the public in the claims which the plaintiff has set up under his patent to a monopoly."

In Orr *v.* Littlefield (1845), 1 W. & M. 13, Woodbury, J.: (15) "It is not enough that a party has taken out a patent, and thus obtained a public grant, and the sanction or opinion of the Patent Office in favor of his right, though that opinion, since the laws were passed requiring some examination into the originality and utility of inventions, possesses more weight. But the complainant must furnish some further evidence of a probable right; and though it need not be conclusive evidence, — else additional hearing on the bill would thus be anticipated and superseded, — yet it must be something stronger than the mere issue, however careful and public, of the patent conferring an exclusive right; as in doing that, there is no opposing party, no notice, no long public use, no trial with any one of his rights. The kind of additional evidence is this. If the patentee, after the procurement of his patent conferring an exclusive right, proceeds to put that right into exercise or use for some years without its being disturbed, that circumstance strengthens much the probability that the patent is good, and renders it so likely as alone often to justify the issue of an injunction in aid of it. . . . After that it becomes a question of public policy no less than private justice whether such a grant of a right, exercised and in possession so long, ought not to be protected until avoided by a full hearing and trial." 2 Robb, 323 (326).

Further, that no injunction will be granted unless the patent has been sustained by a judgment, or acquiescence in a long exclusive use, or its equivalent, see Edward Barr Co. *v.* New Haven Automatic Sprinkler Co. (1887), 43 O. G. 392; 32 Fed. Rep. 79; Foster *v.* Crossin (1885), 23 Fed. Rep. 400; Kirby Bung Mfg. Co. *v.* White (1880), 17 O. G. 974; 1 Fed. Rep. 604; 1 McCrary, 155; 5 Bann. & A. 263; Hockholzer *v.* Eager (1873), 2 Sawyer, 361; Doughty *v.* West (1865), 2 Fisher, 553; Orr *v.* Littlefield (1845), 1 W. & M. 13; 2 Robb, 323; Ogle *v.* Eye (1826), 4 Wash. 584; 1 Robb, 516.

That the decisions of the courts sustaining patents do not ratify the defects in them, see *Ex parte* Murray (1873), 3 O. G. 659.

controversy in which the judgment was rendered, but often constitutes so strong a general presumption in favor of the patent that, for the purposes of a preliminary injunction, no other persons are allowed to contradict it.[2] The universal recognition of the patent as creating a legitimate monopoly, and the consequent submission of the public, against their interest, to the claims which it asserts, is evidence in its support whose weight and value are surpassed only by those afforded by a judgment.[3] Admissions by the defendant acknowledging or implying an acknowledgment that the patent is valid, and other facts of similar significance and force, may be received when public acquiescence and judgments are both wanting.[4] All these forms of proof are definite, easily procured and presented, and usually preclude contradiction,—characteristics which render them especially suitable for the purposes of a preliminary hearing.[5]

[2] That a judgment sustaining the patent is evidence of its validity for the purposes of an injunction, see Putnam *v.* Keystone Co. (1889), 38 Fed. Rep. 234; Stuart *v.* Thorman (1888), 37 Fed. Rep. 90; Wells *v.* Gill (1872), 2 O. G. 590; 6 Fisher, 89. Also §§ 1175–1184, and notes, *post.*

That a current of decisions sustaining a patent is not to be departed from without good reason, see American Bell Telephone Co. *v.* Wallace Electric Telegraph Co. (1889), 37 Fed. Rep. 672; Hammerschlag Mfg. Co. *v.* Spalding (1888), 35 Fed. Rep. 67.

That an injunction will be granted on proof of infringement only, if the patent has been sustained by repeated judgments, especially where the defendant was interested in the prior defences, see Robertson *v.* Hill (1873), 6 Fisher, 465; 4 O. G. 132.

That an injunction will issue where a patent has but a short time to run, and has been fully sustained by judgments, see Cary *v.* Domestic Spring Bed Co. (1885), 27 Fed. Rep. 299.

That an injunction will issue under an extension, if the original had been established by adjudication, see Clum *v.* Brewer (1855), 2 Curtis, 506.

[3] That acquiescence in the monopoly is evidence to prove the validity of the patent, on a motion for an injunction, see McCoy *v.* Nelson (1887), 121 U. S. 484; 39 O. G. 831; Miller *v.* Androscoggin Pulp Co. (1872), 1 O. G. 409; 5 Fisher, 340; Holmes, 142; Goodyear *v.* Railroad (1853), 1 Fisher, 626.

Also §§ 1185–1188, and notes, *post.*

[4] That admissions by the defendant and other evidence may supply the place of judgments and acquiescence, see § 1189 and notes, *post.*

[5] In stating the evidence on which preliminary injunctions will be granted or refused, courts often combine two or more of these forms, or even assert that one without the other is insufficient. A number of these statements are here cited, not merely as illustrations of the practice, but that the cases themselves may be examined in connection with the more accurate enunciations referred to in the notes to this and the succeeding paragraphs.

That an injunction will be refused where the patent has not been adjudi-

§ 1175. Preliminary Injunction: Prior Judgment as Evidence of Validity: Circumstances Determining the Weight of Prior Judgments.

The weight to be attached to any judgment in favor of a patent, as evidence of its validity in future actions, depends

cated and patentability is doubtful, see ment or decree in his favor and an Baldwin *v.* Conway (1887), 32 Fed. Rep. 795.

That a jury trial has not been a prerequisite to an injunction in England since 1761, if the court is satisfied of the infringement, though the validity of the patent is disputed, see Motte *v.* Bennett (1849), 2 Fisher, 642.

That an injunction will be granted if there has been long acquiescence in the patent and judgments sustaining it, and clear infringement, see Schneider *v.* Missouri Glass Co. (1888), 36 Fed. Rep. 582; American Shoe Tip Co. *v.* National Shoe Toe Protector Co. (1877), 11 O. G. 740; 2 Bann. & A. 551.

That where many licenses had been taken, the invention fully examined in the Office, and a *quasi* judgment rendered in its favor in a neighboring circuit, an injunction was issued, the injury to the defendant being trifling as compared with plaintiff's if it were refused, see Hat Sweat Mfg. Co. *v.* Davis Sewing Mach. Co. (1887), 32 Fed. Rep. 401; 41 O. G. 1273.

That an injunction will issue if the patent is of long standing, has been extended in the face of opposition, and sustained by the Federal courts, unless some other tribunal has declared it invalid, see Putnam *v.* Weatherbee (1875), 8 O. G. 320.

That an injunction will issue if the patent has been used for eleven years, been sustained by the courts, and been extended, see Cook *v.* Ernest (1872), 2 O. G. 89; 5 Fisher, 396.

That an injunction may be granted when the infringement is clear and the plaintiff's right is evidenced by a judgextensive public acknowledgment, see American Nicholson Pavement Co. *v.* City of Elizabeth (1870), 4 Fisher, 189.

That an injunction will issue if there has been long possession, or frequent recoveries, unless the patent appears to be void, see Woodworth *v.* Hall (1846), 1 W. & M. 248; 2 Robb, 495.

That an injunction will be granted where there has been an infringement, a long enjoyment of the patent, and its validity is not disproved, see Miller *v.* Androscoggin Pulp Co. (1872), 5 Fisher, 340; 1 O. G. 409; Holmes, 142.

That an injunction will be granted where priority and infringement are not questioned, and where the public have generally acquiesced and admitted the novelty of the invention, though no prior judgment has sustained the patent, see Weston *v.* White (1876), 13 Blatch. 447; 2 Bann. & A. 364.

That an injunction will be granted where the patent, being supported by the oath of the inventor, the action of the Patent Office, and an undisturbed enjoyment, has also been sustained by judgments and enforced by prior injunctions, see Hussey *v.* Whitely (1860), 1 Bond, 407; 2 Fisher, 120.

That an injunction will be granted when there exist undisputed use and infringement, see Chase *v.* Wesson (1873), Holmes, 274; 4 O. G. 476; 6 Fisher, 517.

That if the novelty and infringement are clear, an injunction may issue though the patent has never been judicially sustained, see Foster *v.* Crossin (1885), 23 Fed. Rep. 400.

That no injunction will issue where

upon the identity of parties, the identity of issues, the identity of testimony, and the authority of the tribunal by which the former controversy was decided.[1] The judgment of a court of last resort, in a suit between the same parties, on the same issues, and on the same or equivalent evidence, is conclusive. The decision of an inferior tribunal, in a litigation between different parties or upon different issues, and without a full examination of the facts or law, is of slight or no importance. A judgment sustaining a patent may thus possess any degree of weight as proof of its validity, from absolute

there has been no judgment, and no acquiescence, unless the plaintiff's right is clear and the infringement proved, see North *v.* Kershaw (1857), 4 Blatch. 70.

That where the defendant denies the validity of the patent unless it is construed as he claims, no injunction will issue until the plaintiff shows a prior judgment or its equivalent, see Dickerson *v.* De La Vergne Refrigerating Mach. Co. (1888), 35 Fed. Rep. 143.

That an injunction will be refused unless there has been an exclusive possession or public acquiescence, or a trial at law, see Muscan Hair Mfg. Co. *v.* American Hair Mfg. Co. (1858), 1 Fisher, 520; 4 Blatch. 174.

That no injunction will issue until after a trial at law unless the plaintiff shows a clear and unquestionable right, or such an exclusive possession for so long a time as to raise a presumption of such right, see Thomas *v.* Weeks (1827), 2 Paine, 92, and notes.

That no injunction will be granted where there has been neither long exclusive possession, nor any judgment, nor irreparable injury, see Earth Closet Co. *v.* Fenner (1871), 5 Fisher, 15.

That where a patent is sustained only by acquiescence, no injunction will issue unless the infringement is palpable, see Burleigh Rock Drill Co. *v.* Lobdell (1875), 7 O. G. 836; Holmes, 450; 1 Bann. & A. 625.

These decisions are, for the most part, substantially correct, but are stated too broadly, or with unnecessary restrictions, or with indefiniteness, — rendering them unsafe guides except where interpreted by more accurate expressions of the law.

§ 1175. [1] That an injunction will be granted, after a judgment against the defendant, without any further proof of the right or its violation, see Poppenhusen *v.* New York Gutta Percha Comb Co. (1858), 2 Fisher, 74; 4 Blatch. 184.

That if a former suit on the same patent between the same parties, with the same prayer for relief and raising the same issues, was dismissed, the present one must also be, see Barker *v.* Stowe (1882), 11 Fed. Rep. 303; 22 O. G. 259; 20 Blatch. 185.

That after a judgment against the defendant in a former suit on an issue of novelty he cannot, in a second suit, raise the same issue, see Dubois *v.* Philadelphia, Wilmington, & Baltimore R. R. Co. (1871), 5 Fisher, 208.

That a decree in favor of the plaintiff in one suit is no proof of public acquiescence in another suit against a defendant who was a stranger to the first suit, though it may be considered on a motion for a preliminary injunction, see Matthews *v.* Iron Clad Mfg. Co. (1884), 19 Fed. Rep. 321; Buck *v.* Hermance (1848), 1 Blatch. 322.

demonstration to a mere suggestion, according as these attributes exist, concur, and co-operate to augment or reduce its value as a precedent.

§ 1176. Preliminary Injunction: Prior Judgment as Evidence of Validity: Identity of Parties.

The identity of parties is a question for the court before which the subsequent action is conducted.[1] Parties include not only those whose names appear upon the record, but all others who participate in the litigation by employing counsel, or by contributing toward expenses, or who in any manner direct the course of the proceedings, as well as those who derive their rights from persons primarily interested in the suit.[2] Thus where several defendants, by agreement, contest

§ 1176. [1] That the court trying a case is to determine conclusively who are parties and privies, see Miller *v.* Liggett & Myers Tobacco Co. (1881), 19 O. G. 1138; 7 Fed. Rep. 91; 2 McCrary, 375.

That the rules governing injunctions as to parties to suits at law are not the same as in patent cases, see Motte *v.* Bennett (1849), 2 Fisher, 642.

[2] That both parties and privies are concluded by a judgment, see Miller *v.* Liggett & Myers Tobacco Co. (1881), 19 O. G. 1138; 7 Fed. Rep. 91; 2 McCrary, 375.

That a person is bound by a decision when he has had all the rights of a party to it, see Miller *v.* Liggett & Myers Tobacco Co. (1881), 7 Fed. Rep. 91; 19 O. G. 1138; 2 McCrary, 375.

That a privy, to be concluded, must be privy in such sense that he can control the litigation by making motions, offering evidence, examining witnesses, and taking an appeal, see Miller *v.* Liggett & Myers Tobacco Co. (1881), 19 O. G. 1138; 7 Fed. Rep. 91; 2 McCrary, 375.

That a person who furnished money to pay counsel and carry on the suit, under contract with the party to the record, can protect his own interest in the suit and is bound by the decree, see Miller *v.* Liggett & Myers Tobacco Co. (1881), 7 Fed. Rep. 91; 19 O. G. 1138; 2 McCrary, 375.

That one who employs counsel and pays the expenses of a suit, though not a party thereto, is concluded by the judgment, see United States & Foreign Salamander Felting Co. *v.* Asbestos Felting Co. (1880), 19 O. G. 362; 4 Fed. Rep. 816; 18 Blatch. 310; 5 Bann. & A. 622.

That when the patent has been sustained, after great litigation, against a defendant who is intimately connected with the present defendant, an injunction will be granted unless such evidence is offered as would probably have changed the result in the other case, see Colgate *v.* Gold & Stock Telegraph Co. (1879), 16 O. G. 583; 16 Blatch. 503; 4 Bann. & A. 415.

That an injunction will be granted when the patent has already been sustained in a suit to the defence of which the present defendants contributed, although they now claim to have a new witness to prove prior use, see Birdsall *v.* Hagerstown Agricultural Implement

one of the actions in their joint behalf, all become thereby parties to the suit, and are equally concluded by the judgment; and in an application for an injunction against either, this decision has controlling weight upon the issues then determined, unless new evidence is offered, or the former court is of inferior authority.[3]

§ 1177. Preliminary Injunction: Prior Judgment as Evidence of Validity: Identity of Issues.

A judgment is a precedent only upon the issues which it expressly, or by necessary implication, has determined.[1] This

Mfg. Co. (1874), 6 O. G. 604; 1 Bann. & A. 426.

That an injunction will be granted where parties, whose defence was conducted by the present defendant, were found guilty of an infringement on the same issues, see Yale & Towne Mfg. Co. *v.* Consolidated Time Lock Co. (1889), 38 Fed. Rep. 917; United States & Foreign Salamander Felting Co. *v.* Asbestos Felting Co. (1876), 10 O. G. 828.

That one who takes an assignment of a junior patent, pending proceedings in another circuit, is bound by the judgment there rendered, see Tyler *v.* Hyde (1851), 2 Blatch. 308.

That a former judgment between the same parties as to title is *res adjudicata*, see Puetz *v.* Bransford (1887), 41 O. G. 353; 32 Fed. Rep. 318.

That a verdict for one grantee is not evidence in a suit by another, though it will be considered on a motion for an injunction, see Buck *v.* Hermance (1848), 1 Blatch. 322.

[3] That where there are several suits against different defendants, one of which is made a test case, and after its decision in favor of the plaintiff, and an appeal, the appeal is abandoned in pursuance of an agreement with the defendant by the plaintiff, and the other cases are dismissed, the other defendants are not bound by that decision, see McMillan *v.* Conrad (1883), 16 Fed. Rep. 128; 5 McCrary, 140.

That a servant or agent, separately sued, is not personally bound by a judgment against the principal, see Hayes *v.* Bickelhoupt (1885), 32 O. G. 136; 24 Fed. Rep. 806.

That where two different suits in different districts are brought on interfering patents under Sec. 4918, and the defendant in the second defended in the first, and the issues were the same, the former record is proper evidence and the former judgment is binding on the defendant, see United States & Foreign Salamander Felting Co. *v.* Asbestos Felting Co. (1880), 4 Fed. Rep. 813; 18 Blatch. 310; 5 Bann. & A. 624; 19 O. G. 363.

§ 1177. [1] That courts render judgments only on the issues presented and between the litigant parties, see Page *v.* Holmes Burglar Alarm Telegraph Co. (1880), 2 Fed. Rep. 330; 18 Blatch. 118; 5 Bann. & A. 439.

That prior judgments sustaining the patent avail only within the scope of the points decided, see Carey *v.* Miller (1888), 34 Fed. Rep. 392.

That precedents are to be read in the light of circumstances, and are not authoritative unless the facts are the same, see Wilson *v.* Coon (1880), 19

is especially true in patent litigation, since a decision in favor of a patent does not assert its validity in all respects, but in those merely which have been the subject of attack. When each of the sixteen distinct defences which can be set up against a patent is advanced, and the patent is sustained in spite of all, the judgment is a complete and final vindication of the patent between the contesting parties, unless new evidence is offered which leads the later court to different conclusions. But when the former judgment covered no question which is involved in the subsequent litigation, the fact that it upheld the patent is of no significance, although the parties were the same, except so far as it can be presumed that the defences now alleged would have been urged on that occasion had they not been known to be entirely destitute of merit.[2] A judgment offered as evidence to support a patent upon an application for an injunction must, therefore, either show upon its face, or be accompanied by written or oral testimony to prove, that it decided the same issues which are now in con-

O. G. 482 ; 6 Fed. Rep. 611 ; 18 Blatch. 532.

That the Circuit courts follow prior decisions, where the same questions are raised on the same evidence, see American Bell Telephone Co. *v.* Wallace Electric Telegraph Co. (1889), 37 Fed. Rep. 672 ; Spring *v.* Domestic Sewing Mach. Co. (1881), 9 Fed. Rep. 505 ; 21 O. G. 633; Edgarton *v.* Furst & Bradley Mfg. Co. (1881), 21 O. G. 261 ; 10 Bissell, 402 ; 9 Fed. Rep. 450.

[2] That the effect of a former judgment may be avoided by showing that the plaintiff's title was not then in controversy, or that some material fact was then unknown or overlooked, see Parker *v.* Brant (1850), 1 Fisher, 58.

That a decision in a former suit avails nothing on the question of infringement, when the same facts are not in controversy, see Worswick Mfg. Co. *v.* City of Kansas (1889), 38 Fed. Rep. 239 ; Clarke *v.* Johnson (1879), 17 O. G. 1401 ; 16 Blatch. 495 ; 4 Bann. & A. 403.

That the defendant, on a motion for an injunction, may show that a former judgment did not decide the point now in controversy, or that the point was not then fairly in dispute, or that material facts have been since discovered, see National Hat Pouncing Mach. Co. *v.* Hedden (1886), 38 O. G. 1129 ; 29 Fed. Rep. 147.

That a judgment of the Supreme court is not conclusive on a motion for an injunction, unless the points now in issue were therein decided, see Consolidated Safety Valve Co. *v.* Ashton Valve Co. (1886), 26 Fed. Rep. 319.

That only a direct and affirmative judgment, determining the validity of the patent, affects parties in other courts, see Tyler *v.* Hyde (1851), 2 Blatch. 308.

That when the validity of the patent was not contested, though threatened, in the former suit, and judgment was obtained without collusion, the presumption in favor of the patent is very strong, see Potter *v.* Holland (1858), 1 Fisher, 382 ; 4 Blatch. 238.

troversy.[3] Thus if the former suit were based on several patents, or on several Claims in the same patent, or upon an original which has been since re-issued with additional Claims, it must appear that those which were sustained embraced the one whereon the present judgment turns.[4] And where the defendant in the previous action confined himself to certain objections to the patent, making no effort to defeat it upon other grounds, the nature and extent of his objections, and their connection or identity with those now offered, must be proved.

[3] That a judgment is not *res adjudicata* unless the parties are the same, and the same precise matter was involved and determined in the judgment, and if this does not appear on the record it may be shown by extrinsic evidence, see Russell *v.* Place (1876), 94 U. S. 606; 12 O. G. 53.

That where several matters may have been litigated, and it is uncertain which have been decided, all are open to dispute, see Russell *v.* Place (1876), 94 U. S. 606; 12 O. G. 53.

That where a patent covered both a general and a special process, and it is uncertain on which Claim the former judgment was rendered, both are open to all defences, see Russell *v.* Place (1876), 94 U. S. 606; 12 O. G. 53.

That unless the prior judgment shows which Claim of the patent was contested, the scope of the patent and the fact of infringement are open for inquiry, see Coburn *v.* Clark (1883), 24 O. G. 899; 15 Fed. Rep. 804; 5 McCrary, 99.

That a judgment that a senior patentee is not the first inventor cannot affect the rights of a junior patentee, where the inventions are not identical, see Brush *v.* Naugatuck R. R. Co. (1885), 32 O. G. 894; 24 Fed. Rep. 371; 23 Blatch. 277.

That a decree sustaining re-issue Claims will not be followed as a precedent, if a stricter rule of law has been subsequently recognized, see National Wire Mattress Co. *v.* N. Y. Braided Wire Mattress Co. (1884), 28 O. G. 96; 20 Fed. Rep. 119.

[4] In Coburn *v.* Clark (1883), 15 Fed. Rep. 804, Treat, J.: (807) "A more searching inquiry is needed for preliminary injunctions than a mere perfunctory order covering, in an indefinite manner possibly, all the Claims of a patent, and all possible infringements of valid or invalid Claims, when it is impossible to determine from a final decree what was in detail decided. The true rule should require it to be shown what Claim was held to be valid; the validity of that specific Claim having been brought into question. It may be that the court on final hearing passed on only one of many Claims, and that the alleged infringement in such a case pertained only to that specific Claim. How is it as to other Claims on which no decision has been made? Must a court, on a motion for a provisional injunction for alleged infringement of some other Claim, deem itself concluded when no court has passed upon the specific inquiries? There should be a careful investigation of the precise points decided, and of the alleged infringement; otherwise great wrongs may be perpetrated against one or the other of the parties litigant. Preliminary injunctions are not to be granted, it may be destructively to defendants, merely

§ 1178. Preliminary Injunction: Prior Judgment as Evidence of Validity: Identity of Available Testimony.

The judgment of a court upon any issue of fact is always liable to error, and therefore always open to revision. Although the action in which it is rendered may be finally concluded, and no further contest be allowed on the same pleadings, yet the fact itself is never settled or beyond investigation. In other actions, even between the same parties, and sometimes in proceedings supplemental to the former action, it may be again examined, if the discovery of new evidence or any alteration in the attitude of the litigants toward each other should render it expedient.[1] Hence when a previous judgment upon such an issue is offered and accepted as a precedent, it is only on the supposition that on a new trial of the question the same testimony would be produced, and the same facts established.

because an indefinite decision has been made by some court whose views are not disclosed in its decree; and, on the other hand, when plaintiff's rights have been fairly determined, should piracy be tolerated *pendente lite?*" 24 O. G. 899 (900); 5 McCrary, 99 (102).

That one patent is not aided by acquiescence or judgments sustaining a different patent, unless they were so legally connected as to have been covered by the judgments, see Hovey *v.* Stevens (1846), 1 W. & M. 290; 2 Robb, 479.

That a judgment obtained without contest on several patents is not of as much weight as if only the one now in question had been sued on, see Grover & Baker Sewing Mach. Co. *v.* Williams (1860), 2 Fisher, 133.

That where the former judgment does not show what claims are held valid there are two questions open: (1) What does the patent cover? (2) Has the defendant infringed? see Coburn *v.* Clark (1883), 15 Fed. Rep. 804; 24 O. G. 899; 5 McCrary, 99.

That in citing patent cases the facts of the cases are especially to be considered, see Bevin *v.* East Hampton Bell Co. (1871), 5 Fisher, 23; 9 Blatch. 50.

That an injunction will be granted upon the plaintiff's bill averring infringement, supported by a judgment sustaining the patent, unless the defendant avers facts not passed upon by the former judgment, see Cary *v.* Domestic Spring Bed Co. (1886), 26 Fed. Rep. 38; 34 O. G. 1158.

§ 1178. [1] That circuit courts are guided by prior decisions only when the same questions were raised on the same evidence, see Edgarton *v.* Furst & Bradley Mfg. Co. (1881), 21 O. G. 261; 10 Bissell, 402; 9 Fed. Rep. 450; Spring *v.* Domestic Sewing Mach. Co. (1881), 21 O. G. 633; 9 Fed. Rep. 505.

That where a patent has been sustained by previous decisions against the same defendant, the patent will now be construed as it was in such former actions, and if its validity might then have been disputed on the same evidence as now offered the injunction will be granted, see Clarke *v.* Johnson (1879), 17 O. G. 1401; 16 Blatch. 495; 4 Bann. & A. 403.

duced and the same result be reached.[2] And if in opposition to the judgment the defendant urges that the former trial did not properly disclose the facts, or that evidence not then introduced has since become attainable, the court may hear the testimony anew, and if convinced that error was committed may disregard the judgment, and decide *de novo* on the question of validity.[3]

§ 1179. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments between Different Parties.

In the absence of identity of the parties, the value of the judgment as a precedent depends upon the nature of the questions it decides. Certain matters relating to the validity of a patent are governed by established rules of legal definition and construction, and their determination is the same in every case, without reference to the parties, and sometimes without reference to the testimony. Whether or not the patented invention has resulted from inventive skill, whether it is embraced in either of the classes protected by the statute, whether the Claims of a re-issue are identical with those of its original, whether the patent is formally sufficient, and what it claims as the invention patented, — are points which, once being carefully considered and decided, may be regarded as permanently settled for all purposes of future litigation. True, in these matters even, the judges are not bound to follow the decisions of tribunals of inferior or co-ordinate jurisdiction; but the judicial comity which always must prevail among courts representing the same government and

[2] That an injunction will be granted after an adjudication in favor of the patent upon final hearing and full consideration of exhaustive evidence, unless there is opposing and cogent evidence in addition to that offered on the former hearing, see Jones *v.* Merrill (1875), 8 O. G. 401.

[3] That where a former judgment against a different defendant is urged, it may always be shown that the same matters are not in controversy, or that material facts were not then known or considered, or that other relevant matters were not passed upon, see Page *v.* Holmes Burglar Alarm Telegraph Co. (1880), 2 Fed. Rep. 330; 18 Blatch. 118; 5 Bann. & A. 439.

That on a motion for an injunction the validity of the patent will be considered anew, although it has been sustained on similar hearings before other judges, if it is alleged that new facts are in proof and that the merits of the case were not fairly presented on the other hearings, see Blake *v.* Rawson

administering the same laws, requires that judgments upon points like these should not be departed from without grave reasons for declaring them to be erroneous.[1] On other questions, whose decision is necessarily contingent on the evidence produced, such as priority, novelty, utility, abandonment, the sufficiency of the description, or the good faith of the inventor, no party can or should be prejudiced by the imperfect presentation of the law or evidence except in cases over which he had control.[2] Judgments involving these points are

(1872), 3 O. G. 122; 6 Fisher, 74; Holmes, 200.

That where the court is convinced that a former judgment was radically erroneous, it will be disregarded, see Wells *v.* Gill (1872), 6 Fisher, 89; 2 O. G. 590.

That new and additional evidence on the same points may deprive a former judgment of its weight, see Lockwood *v.* Faber (1886), 27 Fed. Rep. 63.

§ 1179. [1] In Potter *v.* Whitney (1866), 3 Fisher, 77, Lowell, J.: (80) "Although it is the duty of the judge, in every case of this nature, where the defendant has not been a party to any former suits, to examine the case anew and exercise his discretion upon the questions presented, yet when questions are in fact the same as in former cases, he cannot but admit those decisions as having great weight, as much as in any other case arising for instance in admiralty or at common law, in which the point in controversy has been passed upon and decided." 1 Lowell, 87 (89).

That the judicial construction given to a patent by one court will usually be followed in another, see Consolidated Safety Valve Co. *v.* Kunkle (1883), 23 O. G. 630; 14 Fed. Rep. 732.

That all previously adjudicated matters are *prima facie* established against the defendant, see American Nicholson Pavement Co. *v.* City of Elizabeth (1870), 4 Fisher, 189; Goodyear Dental Vulcanite Co. *v.* Evans (1868), 3 Fisher, 390; 6 Blatch. 121.

That a judgment sustaining the patent in a contested case, and without collusion, is sufficient evidence of its validity on a motion for an injunction, see Coburn *v.* Brainard (1883), 16 Fed. Rep. 412; 5 McCrary, 215; Coburn *v.* Clark (1883), 15 Fed. Rep. 804; 24 O. G. 899; 5 McCrary, 99.

That a former judgment or decree sustaining the patent, though between other parties, raises a strong presumption that the patent is valid, see American Nicholson Pavement Co. *v.* City of Elizabeth (1870), 4 Fisher, 189; Potter *v.* Fuller (1862), 2 Fisher, 251.

That an adjudication on an original patent is no ground for an injunction on the re-issue where the inventions are different, or the re-issue is broader than the original, see Poppenhusen *v.* Falke (1861), 2 Fisher, 181; 4 Blatch. 493.

[2] That decisions in former cases, offered to prove priority, are not conclusive except between the same parties and privies, see Day *v.* Combination Rubber Co. (1880), 17 O. G. 1347; 2 Fed. Rep. 570; 5 Bann. & A. 385.

That the question of infringement cannot be regarded as settled by prior judgments, see Goodyear Dental Vulcanite Co. *v.* Evans (1868), 3 Fisher, 390; 6 Blatch. 121.

That no injunction will issue where the judgment by which the patent is supported was obtained on contradictory

indeed of weight where no effectual attempt is made to prove their error, but the defendant on an application for an injunction may claim a reconsideration of these questions upon the evidence and arguments which he presents.[3]

§ 1180. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments of Supreme Court.

The influence of the decisions of one tribunal over the conclusions of another depends mainly upon the relations established between them by the law. A judgment of the Supreme Court of the United States is binding on all other courts until reversed or modified; and its decision that a patent is valid must, therefore, be received as plenary proof of such validity between the same parties and on the same issues, unless it can be shown that the judgment was obtained by fraud, or that new evidence has been discovered which, if presented at the former trial, would have produced a different result. On questions of interpretation or definition the judgment of the Supreme Court must be followed even although the parties

claims, or where the plaintiff's title is in doubt, or where possession is vaguely stated in the bill, and is met by counter-claims and proofs for the defendant, see Parker *v.* Sears (1850), 1 Fisher, 93.

That an injunction will issue when the novelty of the invention is established, see Hussey *v.* Whitely (1860), 2 Fisher, 120; 1 Bond, 407.

That an injunction will be granted when the patent has been sustained after a full hearing and the infringement is clear, and especially when the very form of the device used by the defendant has been passed upon in the former case, although the defendant is responsible and willing to give security, see Conover *v.* Mers (1868), 3 Fisher, 386.

[3] In Page *v.* Holmes Burglar Alarm Telegraph Co. (1880), 2 Fed. Rep. 330, Blatchford, J.: (336) "It is well settled that even after the validity of a patent has been established in a suit, and notwithstanding the presumption thereby raised that the patent is valid, it may always be shown in another suit on the patent against another defendant, and even in answer to an application for a preliminary injunction in such suit, that the right claimed by the plaintiff in the new suit was not, either as to its nature or its extent, fairly in controversy in the former suit, or that material facts were not known or considered when the former suit was tried, or that there are relevant matters which were not adjudicated in the former suit. American Nicholson Pavement Co. *v.* City of Elizabeth, 4 Fisher's Pat. Cas. 189." 18 Blatch. 118 (125); 5 Bann. & A. 439 (446).

That where the defendant was not a party to the former suit he is entitled to a hearing *de novo*, but past decisions on the same facts have much weight, see Potter *v.* Whitney (1866), 3 Fisher, 77; 1 Lowell, 87.

may be different; and on all matters its determinations are entitled to the highest deference, in view of the wide research, the learned argument, and the careful scrutiny by which they are preceded.[1] Thus when, on any ground, this court sustains a patent, a presumption in its favor is created which only proof can overcome.

§ 1180. [1] In American Middlings Purifier Co. *v.* Christian (1877), 4 Dillon, 448, Miller, J.: (452) "The decision which is brought to our notice in this case is a decision of the Supreme court of the United States, the court whose judgments are final upon all questions of Patent Law; whether the parties in interest now were before it or not, its decision as to what is law in the case governs the decision of all the other courts in the United States. Where the question is one of complicated facts, and the facts may be controverted, and are controverted in the Supreme court of the United States, with regard to the validity of the patent, of course the decision of that court upon those facts is conclusive, so far as the facts are the same; and in addition to that it is a very fair presumption that wherever the validity of the patent is a question which is brought to the attention and consideration of the Supreme court of the United States, all the questions concerning that patent which could possibly be before the court were before it, and were fully and well considered, and received its full and careful attention." 3 Bann. & A. 42 (44).

That a patent sustained by the Supreme court of the United States is valid for the purposes of an injunction unless the decree is collusive, see American Middlings Purifier Co. *v.* Atlantic Milling Co. (1877), 4 Dillon, 100; 3 Bann. & A. 168.

That Supreme court decisions are binding though none of the parties are the same, see Richardson *v.* Lockwood (1870), 4 Clifford, 128.

That if a judgment has been acquiesced in, or has been affirmed by the Supreme court of the United States, any doubts as to the validity of the patent or the originality of the invention, which might arise in a new case, are removed, see Wells *v.* Gill (1872), 6 Fisher, 89; 2 O. G. 590.

That Supreme court decisions are binding though new evidence is offered, unless it affects the legal rights of the parties, see Richardson *v.* Lockwood (1870), 4 Clifford, 128.

That when the Supreme court of the United States has held the original patent invalid, no injunction will be granted on the re-issue as if it were a new patent, for if the original were void for want of novelty the re-issue must be, see Jones *v.* McMurray (1877), 2 Hughes, 527; 13 O. G. 6; 3 Bann. & A. 130.

That an injunction will be refused where the patent, having been held by the Supreme court not to cover the defendant's device, was re-issued to cover it and the plaintiff's judgment was based on the re-issue, see Wells *v.* Jacques (1871), 5 Fisher, 136.

That where the Supreme court has limited a doctrine since a decision involving it in a Circuit court on the same patent that decision may be departed from, see Rubber & Celluloid Harness Trimming Co. *v.* India Rubber Comb Co. (1888), 44 O. G. 343.

That on questions of Patent Law the decisions of the Circuit courts and the Patent Office are not binding on the Supreme court, see Andrews *v.* Hovey (1888), 124 U. S. 694; 42 O. G. 1285.

§ 1181. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments of Circuit Courts.

A judgment in the Circuit court of the same circuit, sustaining the patent between the same parties and upon the same issues, is sufficient evidence of its validity for the purposes of a subsequent injunction. Where the parties are different, the value of the judgment as a precedent depends upon the nature of the questions therein decided and the thoroughness with which they were examined. Matters which fall within the province of the court, either as involving legal definitions or the construction or comparison of written instruments, do not vary with a change of parties, and consequently, when once settled by the court, are not reviewed in future actions unless in cases of palpable mistake.[1] On other questions its determinations will be reconsidered whenever new evidence or new arguments indicate that they have been erroneous, though in the absence of good reasons to the contrary they raise a presumption in favor of the patent which is suffi-

§ 1181. [1] That doctrines once established will not be reconsidered except in special cases where justice requires it, see Tilghman *v.* Mitchell (1871), 4 Fisher, 615; 9 Blatch. 18.

That the former judgment of a Circuit court sustaining the patent will not be followed if the test of patentability as since defined by the Supreme court would make the patent invalid, see Rubber & Celluloid Harness Trimming Co. *v.* India Rubber Comb Co. (1888), 44 O. G. 343.

That if a patent has once been deliberately and carefully construed by a court and sustained, the court on motion for an injunction will adhere to that construction, see Mallory Mfg. Co. *v.* Hickok (1884), 20 Fed. Rep. 116.

That the judicial definition of a patent is usually a limited one, and looked at in another light the patent may be different, and hence such definitions cannot be final and binding in different cases, see Wilson *v.* Barnum (1849), 2 Fisher, 635.

That decisions as to the validity of a patent are binding in future cases in the same circuit on the same patent, see Meyer *v.* Goodyear's India Rubber Glove Mfg. Co. (1881), 22 O. G. 681; 11 Fed. Rep. 891; 20 Blatch. 91.

That one decision in a case is to be followed by other judges in deciding the same points in subsequent stages of the case, see Bate Refrigerating Co. *v.* Gillett (1887), 40 O. G. 1029; 31 Fed. Rep. 809.

That where it has once been decided in the same circuit that a re-issue is invalid because the same matter was covered by an earlier patent, no further argument against it will be heard, see Meyer *v.* Goodyear's India Rubber Glove Co. (1881), 11 Fed. Rep. 891; 22 O. G. 681; 20 Blatch. 91.

That a decision in the same court, though with other parties, on the same questions will not be disturbed without good reasons, see Odorless Excavating Apparatus Co. *v.* Clements (1878), 16 O. G. 854; 4 Bann. & A. 540.

cient for the grant of an injunction. The judgment of a Circuit court in another circuit has no controlling authority. All Circuit courts are of equal judicial rank, and each is entitled to decide its causes in accordance with its own conclusions.[2] The comity of courts, however, gives to the judgments in another circuit a degree of weight measured by the character and number of the judgments, the eminence of the judges, and the care with which the questions were considered.[3] A judg-

[2] That no Circuit court is bound by the decisions of other Circuit courts, see Blake *v.* Robertson (1874), 6 O. G. 297.

That a judgment in another circuit is not *res adjudicata*, unless the controversy is ended, and the decree finally settles all questions, leaving none open for future decision, see Rumford Chemical Works *v.* Hecker (1876), 10 O. G. 289; Beebe *v.* Russell (1856), 19 How. 283.

That although a court owes respect to the decisions of co-ordinate courts, it must decide on its own convictions, see Schillinger *v.* Crauford (1885), 37 O. G. 1349.

That an injunction may be refused where the court is in doubt as to infringement, though previous decisions have sustained the patent, see Hammerschlag Mfg. Co. *v.* Judd (1886), 28 Fed. Rep. 621.

[3] In Searls *v.* Worden (1882), 21 O. G. 1955, Brown, J.: (1956) "Upon general questions of law we listen to the opinions of our brother judges with deference and with a desire to conform to them if we can conscientiously do so; but we do not treat them as conclusive. In patent causes, however, where the same issue has been passed upon by the Circuit court sitting in another district, it is only in case of a clear mistake of law or fact, of newly discovered testimony, or upon some question not considered by such court, that we feel at liberty to review its findings." 11 Fed. Rep. 501 (502).

In American Middlings Purifier Co. *v.* Christian (1877), 4 Dillon, 448, Miller, J.: (451) "I think that the uniform course of decisions in the courts of the United States, where a previous decision has been had by a Circuit court with regard to the validity of a patent, has been to treat it as of the very highest nature, and as almost conclusive in an application for injunction in another case founded on the same patent. No one pretends, no one argues, that such a decision, even by a Circuit court, is absolutely conclusive on a final hearing on the merits of the case; but since patents are of such extensive and general operation all over the country, and since the litigation in regard to patents has been found so expensive and so wearisome to the courts, it has become almost a matter of necessity, after the validity of a patent, as distinguished from the question of infringement, has been passed upon by a competent tribunal upon a fair hearing, to treat that decision, in any future application in other courts and against other parties, as strongly persuasive of the validity of the patent; and this is especially so on the question of a preliminary injunction, and there is reason for it. The decision of the Circuit court (I am saying nothing about the Supreme court of the United States) in such cases is generally, — I may add always, except where there are cases of collusion, — the result of careful and deliberate consideration, either of a protracted trial before

ment in another circuit on the same issues and between the same parties, if rendered after due deliberation, is usually

a jury, or of a careful and full hearing upon depositions before a court. The presumption, therefore, that the title to the patent itself, and its validity (if *that were brought in question in one of* these suits), was more critically and more thoroughly looked into, and decided upon better hearing and more mature consideration, than it can be in a preliminary injunction, is very strong. Therefore I think I may state it, fairly and correctly, that wherever a patent has been established, even by the decision of the Circuit court, under a careful consideration, in a subsequent application, either before the same court or any other, for a preliminary injunction or for any preliminary relief, that decision is of very great weight." 3 Bann. & A. 42 (43).

In Goodyear Dental Vulcanite Co. *v.* Willis (1874), 7 O. G. 41, Emmons, J.: (41) "We think the learned counsel for the defendant much underrated the effect which it is our duty to give to judgments pronounced by co-ordinate courts, where precisely the same points are brought in litigation before us. The learning upon this subject is familiar, but the motives with which we discuss these matters at all will be subserved by referring to a few of the leading judgments upon this subject here. Those to which we refer have applied the principle in patent cases, but it is by no means peculiar to them. It is a principle of general jurisprudence, a disregard of which would produce a conflict of opinion in the Federal judiciary, alike unseemly and impolitic. In 3 Story, 133, Washburn *v.* Gould, Justice Story, sitting in the Massachusetts circuit, said: 'The rule of comity always observed by the Justices of the Supreme court in cases which admitted of being carried before the whole court was to conform to the opinions of each other, if any had been given.' Justice McLean had previously given a ruling upon the same point in the Ohio circuit in 3 McLean, 250, Brooks *v.* Bicknell, and Justice Story therefore said: 'Although his mind was not without much difficulty on this point, he should rule for the plaintiffs, in accordance with the opinion of Mr. Justice McLean.' In 3 Fisher, 363, Am. Wood Paper Co. *v.* Fibre Disintegrating Co., before Benedict, J., Eastern district of New York, there had been previous suits on the same five patents in other districts, and especially a suit in the Eastern district of Pennsylvania, which decided the points in issue as to two of the patents. Judge Benedict said, as to these two patents, 'The determination of the court in the case referred to furnishes an authority from which I should not feel at liberty, had I the inclination, to dissent.' In 3 Fisher, 443, Goodyear *v.* Berry, Leavitt, J., Southern district of Ohio, a patent had been sustained in several other circuits. Judge Leavitt says: 'In so far as principles involving the validity of these patents have been settled by these decisions, they will be regarded as final and authoritative on this court.' In 4 Fisher, 624, Tilghman *v.* Mitchell, Southern district of New York, Blatchford, J., quotes with approbation our remark in Tilghman *v.* Werk, Southern district of Ohio, 1868, in which it is said, 'Although the record in this case, in reference to some views which a superior court may possibly take, contains some material additional proofs, still they are not such as to authorize the same court to overrule its former deliberate adjudications, and to disregard the judgments of a coordinate one in a case in all respects

adopted unless evidently incorrect. A concurrence of judgments in other circuits on the same issues but between dif-

substantially like it.' In 6 Pat. Office Gaz., p. 154, Goodyear Dental Vulcanite Co. *v.* Root, Justice Hunt, sitting in the Northern district of New York, considers as authoritative the previous decisions in Massachusetts on the same patent. To the support of the generality sustained by these judgments it is unnecessary to say that numerous citations might be added, all showing that, in the opinion of the most enlightened jurists, we should be guilty of grossly violating well established judicial usage and propriety should we disregard the adjudications already made in reference to the validity of the patent before us. The principle which inclines a court to adhere to its own decision of a similar point although subsequently convinced it was erroneous, though not in all respects applicable here, furnishes a strong analogy, and a reason on which our own actions should be based. (See Ram on Legal Judgment, 203 *et seq.*) It there abundantly appears that the adherence to decisions is by no means confined to those which precede it in the same tribunal. Those of co-ordinate courts are equally influential. The Queen's Bench, Common Pleas, and the Exchequer, where there is a common appellate court to review the decisions of each, follow with the utmost respect each other's adjudications. Upon reasons having much influence here, appellate courts often follow a series of adjudications made by subordinate tribunals where they have been acquiesced in, and have become in some sense a rule of property. It is not because they are obligatory, but from the unfitness of shifting rules. This is by no means closely applicable here, where judgments are recent and refer to the individual rights of the complainant. But many of the evils, it is quite apparent, which this class of judgments seeks to avoid would be produced should we disregard the rule. In the elaborate treatment of this general subject in the book to which we have referred, both by the English and American authors, it is significant that they make no distinction between prior decisions of the same, and co-ordinate tribunals. It is enough to call for the application of the principle that the courts have the same jurisdiction under the same government to decide the same points, that there is a common appellate court finally to adjust the difference between them. If one system of co-ordinate courts more than another calls for the application of this general principle it is that of the Circuit courts of the United States. They all have similar special jurisdiction, and are all, in an eminent degree, looked to for all those rules of right and property created under the Federal statutes, and in reference to the subjects coming within the Federal Constitution. Although divided in jurisdiction geographically, they constitute a single system; and when one court has fully considered and deliberately decided a question, every suggestion of propriety and fit public action demand it should be followed until modified by the appellate court. The comment of the bar upon this subject assumed that the final decrees and elaborately reasoned decisions of Circuit judges, with full citations and criticisms of authorities, often involving the entire history of the law upon the subject discussed, are to be ranked with what are termed *nisi prius* decisions. They are in all respects judgments *in banc*. They not only have the deliberation and care of judgments in the high courts of chancery in England and this country, but the court of itself bears the same relation to the whole

ferent parties; the decision of any judge of recognized ability upon a question of legal definition or interpretation; a series

judicial system that such courts do to those in which they exist. There is but one appellate court above them. A superior tribunal also reviews the judgments of the English Chancery, and so of nearly all the like State tribunals. Although we would by no means confine our acquiescence in the decisions of our brother judges to cases where the particular patent has been adjudged to be valid, or that a particular device infringes upon it, still we think that eminently beyond other cases is the rule applicable to them. The right of the complainant is a special franchise granted by the political power. A special organism is created for the purpose of ascertaining his right to the grant. When issued, the several Federal courts are authorized to review the rectitude of this action, and from their determination an appeal lies to the court of last resort. It is an indivisible system for ascertaining the rightfulness and the limits of the patent, and when, in any co-ordinate department of it, judgment has been pronounced, that duty should be deemed performed until reversed by an appellate tribunal. It would present an unseemly spectacle for the same governmental grant to receive half a dozen different constructions in as many co-ordinate courts, all authorized to define it and inform the citizens what it means, and all having the force of law cotemporaneously under the same government. We cannot speak with great certainty, but do affirm with much confidence that the expenses paid in our country for patent litigations are rapidly approximating the entire sum demanded for royalties. Until some special tribunal is instituted for the determination of these questions, and some general mode of reviewing these public grants, which shall test definitely the rightfulness of the grants, it will result in a large saving of money to the great masses of our citizens who are using these improvements to let them and their advisers of the profession understand that a fair and full examination in one court, followed by a judgment, will, in the other co-ordinate tribunals, be acquiesced in as law, if there is no appeal and reversal." 1 Flippin, 388 (390); 1 Bann. & A. 568 (570).

That one court does not review or reverse the judgment of a court of co-ordinate jurisdiction, see Hayes *v.* Dayton (1884), 20 Fed. Rep. 690.

That the decision of a co-ordinate court will be followed, unless good reason for departing therefrom is shown, where the issues, pleadings, and evidence are the same, see Hancock Inspirator Co. *v.* Regester (1888), 35 Fed. Rep. 61; Worswick Mfg. Co. *v.* Philadelphia (1887), 30 Fed. Rep. 625; Steam Gauge & Lantern Co. *v.* McRoberts (1886), 36 O. G. 822; 26 Fed. Rep. 765; American Bell Telephone Co. *v.* National Improved Telephone Co. (1886), 27 Fed. Rep. 663; Cary *v.* Domestic Spring Bed Co. (1886), 26 Fed. Rep. 38; 34 O. G. 1158; Cary *v.* Lovell Mfg. Co. (1885), 32 O. G. 1009; 24 Fed. Rep. 141; Field *v.* Ireland (1884), 28 O. G. 284; 19 Fed. Rep. 835; Coburn *v.* Clark (1883), 24 O. G. 899; 5 McCrary, 99; 15 Fed. Rep. 804; American Ballast Log Co. *v.* Cotter (1882), 11 Fed. Rep. 728; 21 O. G. 1030.

That co-ordinate courts should be followed on questions of validity and construction until overruled by the Supreme court, see Hammerschlag Mfg. Co. *v.* Bancroft (1887), 40 O. G. 1339.

That the judgment of a co-ordinate court should be followed unless new evidence is offered or an obvious mistake was made in the law, see Cary *v.*

of decisions, or even one decision, sustaining the patent against attacks in which all conceivable objections have been urged,—each of these is of sufficient influence to govern future rulings until its error is discovered.[4]

Lovell Mfg. Co. (1887), 31 Fed. Rep. 344; 40 O. G. 1239.

That a decision sustaining the patent in another circuit will be followed on motion for injunction, unless such new evidence is presented as would have led the other court to a different conclusion, see Ladd *v.* Cameron (1885), 25 Fed. Rep. 37.

That prior decisions in other courts as to the validity of the patent are regarded as final, see Goodyear *v.* Berry (1868), 3 Fisher, 439; 2 Bond, 189.

That a former decision will be presumed correct though in another court, if no new evidence is introduced and no new question is raised, see Worden *v.* Searls (1884), 21 Fed. Rep. 406.

That where one Circuit court sustains a patent, after full discussion, another court should follow it on the same evidence, unless in cases of plain mistake, see Hammerschlag *v.* Garrett (1881), 9 Fed. Rep. 43; Goodyear *v.* Honsinger (1867), 3 Fisher, 147; 2 Bissell, 1.

That when the patent has been sustained by other courts the only open question is that of infringement, see Goodyear *v.* Rust (1868), 3 Fisher, 456; 6 Blatch. 229.

That a judgment rendered in one circuit is evidence in another where the matter in dispute is the same, and the defendant in the later suit paid the expenses and employed the counsel in the former, though he was not a nominal party, see United States & Foreign Salamander Felting Co. *v.* Asbestos Felting Co. (1880), 19 O. G. 362; 18 Blatch. 310; 4 Fed. Rep. 816; 5 Bann. & A. 622.

[4] That there is a strong presumption that former decisions are correct when four different Circuit courts have made the same ones without appeal, see Blake *v.* Robertson (1874), 6 O. G. 297.

That where the same issues have been often presented and decided, agreeing in the construction of the patent, such decisions will be accepted as final until the Supreme court overrules them, unless new features are presented, see Green *v.* French (1882), 11 Fed. Rep. 591; 21 O. G. 1351.

That where the patent has already been sustained in three cases, in one of which the defendant was interested, the validity of the patent is established and the only question open is infringement, see Robertson *v.* Hill (1873), 4 O. G. 132; 6 Fisher, 465.

That where four judgments have been rendered sustaining the patent, one of which was against the defendant, and an extension has also been granted, the validity of the patent and the infringement are taken as established for the purposes of an injunction, see Tilghman *v.* Mitchell (1871), 4 Fisher, 615; 9 Blatch. 18.

That a patent twice sustained by the courts will be regarded as valid for the purposes of an injunction, where there is no reason to doubt the correctness of the decisions, see Cary *v.* Lovell Mfg. Co. (1885), 32 O. G. 1009; 24 Fed. Rep. 141.

That an answer denying that a decision was rendered "after full consideration" contains no imputation on the court and is neither impertinent nor scandalous, see Miller *v.* Buchanan (1880), 18 O. G. 1532; 5 Fed. Rep. 366.

That a decision sustaining a patent, after a contest covering all the usual

§ 1182. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments of Circuit Courts: Judgments on Hearings, by Consent, by Collusion, etc.

The authority of a judgment in the Circuit court depends to some extent upon the mode in which its conclusions were attained. A decree based upon a hearing, in which all questions of fact as well as of law were submitted to the judge and by him were examined and decided, is of greater weight than one based on the verdict of a jury on a feigned issue, or than a judgment on a verdict in a court of law.[1] A decree by consent, if without collusion, binds the defendant in the same circuit, but has no effect on other parties, nor against him in other circuits, unless his first surrender is shown to have resulted from his knowledge that he had no adequate defence.[2]

defences, is almost conclusive, see Cary *v.* Domestic Spring Bed Co. (1885), 27 Fed. Rep. 299.

§ 1182. [1] That the decision of a court of equity on final hearing furnishes an authority for the action of courts of co-ordinate jurisdiction, see American Wood Paper Co. *v.* Fibre Disintegrating Co. (1868), 3 Fisher, 362; 6 Blatch. 27.

That the conclusions of a judge on a patent case are more reliable than those of a jury, see Buchanan *v.* Howland (1863), 2 Fisher, 341; 5 Blatch. 151.

That the discussion of a patent by the court in a former suit is of some weight on a motion for an injunction, see Consolidated Bunging Apparatus Co. *v.* Peter Schoenhofen Brewing Co. (1886), 37 O. G. 786; 28 Fed. Rep. 428.

That on a motion for an injunction a decree in chancery is of more weight than the verdict of a jury, see Goodyear *v.* Mullee (1868), 3 Fisher, 420.

That the final decree of a court, if without collusion, is good ground for an injunction, see Kirby Bung Mfg. Co. *v.* White (1880), 1 Fed. Rep. 604; 17 O. G. 974; 1 McCrary, 155; 5 Bann. & A. 263.

That a hearing before a master is not a final hearing, see Doughty *v.* West, Bradley & Cary Mfg. Co. (1870), 4 Fisher, 318; 8 Blatch. 107.

That a dismissal of the bill, for failure to prove infringement, is no bar to another suit between the same parties, see Steam Gauge & Lantern Co. *v.* Meyrose (1886), 36 O. G. 1477; 27 Fed. Rep. 213.

That a dismissal of a bill for repeal on its merits is not a judgment necessarily importing that the patents in question did not interfere, or that the earlier one was void, see Tyler *v.* Hyde (1851), 2 Blatch. 308.

[2] That a judgment, without contest, sustaining the patent in the absence of collusion, is equally good proof of validity with any other judgment, see McWilliams Mfg. Co. *v.* Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419.

That a decree by consent in a prior suit, declaring the patent valid and the complainant sole owner, is binding as to all questions determined thereby in the second suit between the same parties, see Tomkinson *v.* Willetts Mfg. Co. (1884), 23 Fed. Rep. 895; 31 O. G. 918; 32 O. G. 382.

That a decree by consent merely

Collusive decrees are of no value against any party.[3] A decision on an application for a preliminary injunction is of less weight than a decree.[4] The verdict of a jury in a court of

shows the acquiescence of that defendant in that decision, see Hayes *v.* Leton (1881), 5 Fed. Rep. 521.

That where the present device of the defendant differs only in form from that concerning which he consented to a decree, an injunction will issue, see United States Metallic Packing Co. *v.* Tripp (1887), 39 O. G. 1554; 31 Fed. Rep. 350.

That a defendant is estopped by a decree by consent in a suit where the present plaintiff's assignor was plaintiff, see United States Metallic Packing Co. *v.* Tripp (1887), 39 O. G. 1554; 31 Fed. Rep. 350.

That a decree by consent in one circuit does not lay the foundation for an injunction in another, see Warner *v.* Bassett (1881), 7 Fed. Rep. 468; 19 Blatch. 145.

That a decree *pro forma* on the merits is not ground for an injunction in other courts, see Kirby Bung Mfg. Co. *v.* White (1880), 17 O. G. 974: 1 Fed. Rep. 604; 1 McCrary, 155; 5 Bann. & A. 263.

That a decree by consent is not effective against others not parties thereto, and has very little weight in any other court in favor of the patent, see Spring *v.* Domestic Sewing Mach. Co. (1879), 16 O. G. 721; 4 Bann. & A. 427.

That an injunction will not issue against third parties on the ground of a former judgment by consent against others, or where the former defendants abandoned their case and a decree was entered without a hearing, see Hayes *v.* Leton (1881), 5 Fed. Rep. 521.

That an injunction will not be issued where infringement is denied, solely on the ground that a judgment was rendered in another circuit on a mere motion, see Sargent Mfg. Co. *v.* Woodruff (1873), 5 Bissell, 444.

[3] That collusive decrees are not ground for an injunction, see Kirby Bung Mfg. Co. *v.* White (1880), 17 O. G. 974; 1 Fed. Rep. 604; 1 McCrary, 155; 5 Bann. & A. 263.

That a suit is collusive if one party pays the fees of counsel on both sides, below and on appeal, though the fees were charged to the party primarily liable, see Gardner *v.* Goodyear Dental Vulcanite Co. (1873), 6 Fisher, 329; 3 O. G. 295.

That collusion in a former suit must be fully proved, not conjectured or suspected, see Seibert Cylinder Oil Cup Co. *v.* Beggs (1887), 32 Fed. Rep. 790.

[4] That a decision on a motion for a preliminary injunction is of no controlling authority in another circuit, see Cornell *v.* Littlejohn (1876), 9 O. G. 837, 922; 2 Bann. & A. 324.

That the denial of an injunction by one court is some ground for its denial by others, see Thompson *v.* Rand Avery Supply Co. (1889), 38 Fed. Rep. 112.

That the issue of injunctions by other courts may also be considered, see Schneider *v.* Missouri Glass Co. (1888), 36 Fed. Rep. 582.

That the decision of a motion for an injunction does not settle the identity of two machines, though it may be an admission of the parties that there was an infringement, see Florence Sewing Mach. Co. *v.* Singer Mfg. Co. (1870), 4 Fisher, 329; 8 Blatch. 113.

That a refusal to grant an injunction against a vendor by one court, though with leave to renew the motion, is a reason for its refusal by another court against his vendee, see Hicks *v.* Beardsley (1887), 41 O. G. 235; 32 Fed. Rep. 281.

That the user may be enjoined in one circuit though the maker is being sued

law is a sufficient warrant for the grant of an injunction, but may be disregarded by the court even when not so clearly contrary to the evidence that a new trial would have been allowed.[5] A pending bill of exceptions, or a writ of error, or

in another, see Thompson *v.* American Bank Note Co. (1888), 45 O. G. 347; 35 Fed. Rep. 203.

[6] In Wells *v.* Gill (1872), 2 O. G. 590, Strong, J.: (591) "Ordinarily a verdict and judgment sustaining a patent are controlling over the discretion of a judge when he is asked to award a provisional injunction. They relieve him from the necessity of inquiring into the validity of the patent, and if he is satisfied there has been an infringement, the injunction may be said to be almost a thing of course." 6 Fisher, 89 (91).

In Day *v.* Hartshorn (1855), 3 Fisher, 32, Pitman, J.: (36) "It was argued before me that if I was not satisfied with the verdict, yet if I would not have set it aside if a motion had been made for a new trial, that then I *ought to grant the injunction.* If I have the right, in a court of equity, to examine the evidence in a cause which is tried before me at law, and to draw my own conclusions when I am asked to grant an injunction, and ought to refuse it if I am not satisfied with the verdict, then, though I might hesitate to set the verdict aside because I was not satisfied with the same, especially after the modern decisions on this subject, yet it would not follow that I ought to grant an injunction. The jury draw their own conclusions from the evidence, and it is their right so to do; and because I might not draw the same conclusions, this of itself is not sufficient to justify me in setting the verdict aside, if they have evidence to judge from. If I should do so, I should substitute myself as judge of the facts, in a trial at law, which the parties and the law have submitted to the jury. But when I am applied to in equity, where I am judge of the facts as well as law, and required to perform an act which calls upon me to draw my own conclusions from the evidence which I heard upon the trial, there my own judgment upon the law and the evidence must determine my action, and not the judgment of the jury. I will not set aside a verdict because I differed from the jury upon the evidence, because the verdict is theirs, and they act upon their conscience. But when I have to act upon my own conscience, then I cannot suffer the jury to control me in my province, for the same reason that I should deem it improper for me to control them in their province. There are cases where, though I might be dissatisfied with the verdict, yet not so much so but that I *might* think it proper to suffer the verdict to be the basis for an injunction."

Contra, That when a judge disregards a former verdict his reasons for so doing should be sufficient to lead him to grant a new trial, see Parker *v.* Brant (1850), 1 Fisher, 58.

That the verdict of a jury is not conclusive on motion for injunction, but the court will examine the whole case, see Sickels *v.* Youngs (1855), 3 Blatch. 293; Many *v.* Sizer (1849), 1 Fisher, 31.

That a verdict in an uncontested case, without collusion, is of as great weight as one after a full trial, see Potter *v.* Fuller (1862), 2 Fisher, 251.

That a verdict on an issue out of chancery, and a trial for damages on an amended specification, are not the same matter, and the former is no bar

a petition for another trial impairs the force of such a verdict, and the court should not receive it as a ground for an injunction without a further inquiry into the merits of the case.[6]

§ 1183. Preliminary Injunction: Prior Judgment as Evidence of Validity: Judgments in the Patent Office.

A decision in the Patent Office, though not binding on the courts, has more or less weight according to the subject-matter of the judgment, and the violence of the contest by which it was preceded.[1] The award of a patent, without objection, is

to an injunction when no judgment was rendered on the verdict or on the merits of the bill, see Allen *v.* Blunt (1846), 2 W. & M. 121; 2 Robb, 530.

That on a motion for an injunction after a verdict at law, the facts found by the verdict will be considered as established for the purposes of the motion, see Poppenhusen *v.* New York Gutta Percha Comb Co. (1858), 2 Fisher, 74; 4 Blatch. 184.

[6] That an injunction will be refused where the judgment, on the strength of which it has been asked, has been appealed from and seems doubtful, see Many *v.* Sizer (1849), 1 Fisher, 31.

That an injunction may be denied when the judgment at law was followed by a bill of exceptions, see Furbush *v.* Bradford (1858), 1 Fisher, 317.

That after a judgment at law and a bill of exceptions the court must exercise its own judgment on the questions involved in the bill of exceptions, and determine whether the title is clear enough to warrant an injunction, see Furbush *v.* Bradford (1858), 1 Fisher, 317.

That a judgment is not conclusive on a motion for an injunction, if a writ of error is pending, see Wells *v.* Gill (1872), 2 O. G. 590; 6 Fisher, 89.

That an injunction will generally be refused if the case has been tried at law and motion was made for a new trial, or a bill of exceptions and writ of error have been filed, though even then the injunction may be ordered, see Morris *v.* Lowell Mfg. Co. (1866), 3 Fisher, 67; Day *v.* Hartshorn (1855), 3 Fisher, 32.

That when a new trial has been granted in a suit wherein the patent was held invalid, but on grounds not affecting validity, an injunction may be refused, see Keyes *v.* Pueblo Smelting & Refining Co. (1887), 31 Fed. Rep. 560.

§ 1183. [1] That a decision in the Patent Office is not binding on the courts, see Celluloid Mfg. Co. *v.* Chrolithian Collar & Cuff Co. (1885), 32 O. G. 383; 24 Fed. Rep. 275; Wilson *v.* Barnum (1849), 2 Fisher, 635; 1 Wall. Jr. 347; 2 Robb, 749.

That a decision of the Patent Office does not bind the courts when steps are taken to contest its validity, see Minneapolis Harvester Works *v.* McCormick Harvesting Mach. Co. (1886), 28 Fed. Rep. 565; 37 O. G. 566.

That a decision of the Patent Office, after long contest and full examination of the art, is of weight on a motion for an injunction, see Consolidated Bunging Apparatus Co. *v.* Peter Schoenhofen Brewing Co. (1886), 28 Fed. Rep. 428; 37 O. G. 786.

That the construction given to a patent in the Patent Office, and on the strength of which it was granted, will be followed in the courts, see Geis *v.* Kimber (1888), 36 Fed. Rep. 105.

of some authority, yet it alone does not empower the court to interfere for the protection of its owner.[2] But a judgment in an interference, awarding priority to one rival claimant, is sufficient ground for an injunction in his favor against the other;[3] a finding that the patented invention will accomplish

[2] In Yuengling *v.* Johnson (1877), 1 Hughes, 607, Hughes, J.: (613) "It is true that the issuing of patents is not conclusive upon the courts. Patents are subject to review by the courts. Suits in a very large proportion of patent cases are but means of appeal to the courts from the action of the Patent Office. Yet, while this is so, that action must always carry great weight with the courts. It is always very strongly persuasive with them. Patents are the results, generally, of contests between accomplished experts, and after such contests of the matured judgment of officers selected and appointed by the President for their extraordinary competency and skill, I think it is hardly going too far to say, following Mr. Justice Grier, in N. E. Car Company *v.* Dunbar, 1 Fisher, that the action of the Patent Office is sufficient to make such a *prima facie* case as to justify the action of a court on almost any motion for a preliminary injunction. If, indeed, in any case the general unanimous testimony of experts united in condemning the action of the Patent Office, in such case a court might well hesitate to treat that action as constituting a *prima facie* case for or against a preliminary injunction. But when, as in the present case, the weight of expert testimony is nearly evenly balanced, a court may safely presume that the action of the Patent Office, taken after a sharp contest between patent lawyers and experts, is *prima facie* correct." 3 Bann. & A. 99 (104).

That the grant of a patent is only an *ex parte* adjudication, see Potter *v.* Stevens (1861), 2 Fisher, 163.

That the decision of the Patent Office in issuing the patent has some weight but is not controlling, see Jones *v.* Merrill (1875), 8 O. G. 401. See also § 1016, and notes, *ante*.

That the action of the Patent Office in allowing a re-issue is of weight on a motion for an injunction, see Consolidated Bunging Apparatus Co. *v.* Peter Schoenhofen Brewing Co. (1886), 37 O. G. 786; 28 Fed. Rep. 428.

That a re-issue granted to correct a mistake made by an attorney in accepting an amended Claim is of too doubtful validity to aid an injunction, see Arnheim *v.* Finster (1885), 32 O. G. 256; 24 Fed. Rep. 276.

[3] That an interference judgment is *res adjudicata* between the parties, see Shuter *v.* Davis (1883), 24 O. G. 303; 16 Fed. Rep. 564.

That the action of the Commissioner of Patents on an interference makes a *prima facie* case for an injunction, see Yuengling *v.* Johnson (1877), 1 Hughes, 607; 3 Bann. & A. 99.

That an interference decision raises no presumption against any person except the defeated party and his privies, see Edward Barr Co. *v.* N. Y. & N. H. Automatic Sprinkler Co. (1887), 32 Fed. Rep. 79.

That an interference judgment, if appealed from, is not operative as a judgment, see Minneapolis Harvester Works *v.* McCormick Harvesting Mach. Co. (1886), 37 O. G. 566; 28 Fed. Rep. 565.

That a decision in interference, not appealed from, though not conclusive is strongly persuasive, see Kirk *v.* Du Bois (1887), 42 O. G. 297.

That an interference judgment will

practical results avails the plaintiff in his efforts to enjoin the party who denied it;[4] a decision that patentable differences exist between the patented invention and another art or instrument is a sufficient answer to the latter when urged against the novelty of the invention;[5] and an extension of

warrant an injunction against the defeated party, see Celluloid Mfg. Co. v. Chrolithian Collar & Cuff Co. (1885), 32 O. G. 383; 24 Fed. Rep. 275; Holliday v. Pickhardt (1882), 22 O. G. 420; 12 Fed. Rep. 147.

That a decision of the Patent Office on an interference is ground for an injunction, so far as the question of priority is concerned, see Smith v. Halkyard (1883), 16 Fed. Rep. 414; 23 O. G., 1833.

That an interference decision affects only the matter of priority and is not evidence of validity, see Dickerson v. De la Vergne Refrigerating Mach. Co. (1888), 35 Fed. Rep. 143.

That an injunction will be granted against the defeated party to an interference if he had knowledge of the state of the art at the date of his application, and is in bad faith, see Smith v. Halkyard (1883), 16 Fed. Rep. 414; 23 O. G. 1833.

That an injunction will be granted against the defeated party to an interference unless the want of novelty is clearly shown, see Smith v. Halkyard (1883), 16 Fed. Rep. 414; 23 O. G. 1833.

That an interference decision, though not conclusive on the parties, is sufficient to warrant an injunction, and any claim by defendant that both he and the plaintiff were anticipated by others will be disregarded if known at the time he was seeking a patent, unless now clearly established, see Celluloid Mfg. Co. v. Chrolithian Collar & Cuff Co. (1885), 24 Fed Rep. 275; 32 O. G. 383; Smith v. Halkyard (1883), 16 Fed. Rep. 414; 23 O. G. 1833.

That a defendant who acquiesced in an interference decision between himself and the plaintiff, and limited his own patent accordingly, is bound by it in the courts, and though he may set up priority in others against the plaintiff's patent, yet if this priority were known to him at the time of his application, the action of the Patent Office in allowing the plaintiff's patent is of great weight against him, see Peck, Stow & Wilcox Co. v. Lindsay, Sterritt & Co. (1880), 18 O. G. 63; 2 Fed. Rep. 688; 5 Bann. & A. 390.

That a judgment against a party in an interference is not conclusive upon him, see Smith v. Halkyard (1883), 16 Fed. Rep. 414; 23 O. G. 1833; Perry v. Starrett (1878), 14 O. G. 599; 3 Bann. & A. 485; Union Paper Bag Mach. Co. v. Crane (1874), Holmes, 429; 6 O. G. 801; 1 Bann. & A. 494.

That a party to an interference, not appealing, is bound by a decision on priority, for the purposes of an injunction, see Greenwood v. Bracher (1880), 1 Fed. Rep. 856; 17 O. G. 1151; 5 Bann. & A. 302.

[4] That a decision of the Patent Office, on an issue there raised between the same parties, that the invention is practicable is sufficient ground for an injunction, see Holliday v. Pickhardt (1882), 22 O. G. 420; 12 Fed. Rep. 147.

[5] That the court will consider the fact that the Patent Office found patentable differences between two devices, see Putnam v. Weatherbee (1875), 8 O. G. 320; Holmes, 497; 2 Bann. & A. 78.

That the decision of the Patent Office in an interference case, as to the identity of the inventions, is sufficient

the patent after persistent opposition is evidence of its validity which only *strong counter-proof* can overcome.[6]

§ 1104. Preliminary Injunction: Summation of Rules Concerning Prior Judgments as Evidence of Validity.

The foregoing doctrines concerning the effect of prior judgments sustaining the patent, as evidence on an application for an injunction, may be summed up as follows: *A judgment* of the Supreme Court, or of the Circuit court of the same circuit, upon the same issues and against the same defendant, is conclusive proof of the validity of the patent, unless *new* evidence has since been discovered or the judgment has been overruled or was originally obtained by fraud. *A judgment* in another circuit against the same defendant on the same issues is not conclusive, but is of high authority and can be overcome only by convincing evidence that the former tribunal was mistaken or insufficiently informed, — except where a decree was rendered by consent, which is without authority unless it also appears that no defence against the patent could have been maintained. *A judgment* in the Patent Office in a contested case, if well considered, is of great weight against the party there defeated, and in the absence of opposing testimony is sufficient proof of the validity of the successful patent. No judgment is conclusive against persons who were neither *parties* nor *privies* to the *suit*; but where in any of these tribunals certain questions of law relating to the existence, scope, or validity of the patent have been once decided, after full examination and careful scrutiny, these decisions command more or less respect in other courts and causes, although the defendant was not interested in the prior action. Such a decision rendered by the Supreme Court, or the same Circuit court, is not departed from without clear evidence of error. If emanating from the Circuit court of another circuit,

prima facie evidence that the makers of Faber (1875), 92 U. S. 347; 10 O. G. 71.

That a decision of the Commissioner is not conclusive as to novelty, utility, or inventive skill, see Reckendorfer *v.* Holliday *v.* Pickhardt (1882), 22 O. G. 420; 12 Fed. Rep. 147.

[6] That a special act of extension is conclusive on a motion for injunction, though alleged to have been procured by fraud, see Gibson *v.* Gifford (1850), 1 Blatch. 529.

except on decrees by consent, it has a value measured by the ability and experience of the judge, and the completeness of the presentation of the arguments against it. When it results from a contest in the Patent Office, it raises a presumption in favor of the patent on that question, which, in the absence of better reasons to the contrary, the courts will usually maintain. But in all cases where the prior judgment does not operate as an estoppel upon the defendant, the issue on the application for an injunction is open for fresh inquiry and determination, the judgment being merely evidence in favor of the plaintiff, and controlling the decision of the court only when not opposed by more convincing proof. Judgments against the patent are, for obvious reasons, of higher value and a wider influence, since a patent invalid upon any ground is invalid against all the world, and therefore any decision declaring it void, though in a different tribunal and between other parties, affords a presumption of its invalidity which the plaintiff can with difficulty overcome.[1] When conflicting judgments have been rendered, the court must follow those which, in view of all the tests of authority, appear to have the higher value, and if the question is still doubtful, and no other evidence is offered, it must decide in favor of the patent.[2] For though the patent, unsupported by a judgment, is

§ 1184. [1] That where the same term under penalty of an injunction, Claims have in a former suit been adjudged to have been anticipated the suit will be dismissed, see Crandall *v.* Dare (1881), 11 Fed. Rep. 902.

That a decree of invalidity in the Federal courts is conclusive on the parties, see Hawks *v.* Swett (1875), 4 Hun, 146; 6 Thomp. & C. 529.

That a decision in one circuit that a patent is void for want of novelty will be followed in others, see Kidd *v.* Ransom (1888), 35 Fed. Rep. 588.

That an injunction will not be granted after successive defeats at law, where the novelty and infringement are in dispute and no public acquiescence appears, unless the plaintiff makes out a clear case, but the defendant will be ordered to try the case at the next see Serrell *v.* Collins (1857), 4 Blatch. 61.

That an injunction will be refused when several suits were brought against several defendants, and were all defended by one party, and injunctions have already been denied in some of them, and the defendant's case is ready for trial, see Wooster *v.* Howe Mach. Co. (1879), 16 O. G. 314; 4 Bann. & A. 319.

[2] That an injunction may be granted where some judgments have sustained the patent though one has been adverse to its validity, see United States Stamping Co. *v.* King (1879), 17 Blatch. 55 4 Bann. & A. 469; 17 O. G. 1399; 7 Fed. Rep. 860.

That an injunction will be granted

not sufficient proof of its own validity for the purposes of an injunction, yet when sustained by judgments it outweighs all other judgments of an equal value.

§ 1185. Preliminary Injunction: Public Acquiescence as Evidence of Validity: Acquiescence Defined.

Where no judgment sustaining the patent upon the issues presented on the application for an injunction can be offered, or where if offered the judgment is of doubtful value, the deficiency may be supplied by proof of a public acquiescence in the claims of the patent of sufficient definiteness and duration to afford a reasonable presumption of its validity.[1]

though the patent has been declared invalid in one suit, if it has been sustained in several others and new evidence in its favor is now at hand, see United States Stamping Co. *v.* King (1879), 17 O. G. 1399; 7 Fed. Rep. 860; 17 Blatch. 55; 4 Bann. & A. 469.

That an injunction will be granted when the patent has been sustained in a former trial in the same circuit though other suits are still pending in the courts of other circuits, see Atlantic Giant Powder Co. *v.* Goodyear (1877), 13 O. G. 45; 3 Bann. & A. 161.

That where there have been an arbitration and award the court will presume them correct till the contrary is shown, see Reedy *v.* Scott (1874), 23 Wall. 352; 7 O. G. 463.

See also as to former judgments in the Federal courts § 1017 and notes, *ante*.

That no regard will be paid to the decision of a State court concerning the contract relations of the parties, see Oliver *v.* Rumford Chemical Works (1883), 109 U. S. 75; 25 O. G. 784.

That the judgment of a Probate court of competent jurisdiction confirming a sale is conclusive as to the right of the vendee, see May *v.* Mercer Co. (1887), 41 O. G. 815; 30 Fed. Rep. 246.

§ 1185. [1] In Kirby Bung Mfg. Co. *v.* White (1880), 5 Bann. & A. 263, Treat, J.: (265) "For the purposes of a provisional injunction under the Patent Law two things, or either of two things, may exist, — to wit, as in this case, a court, after full consideration of the matter, has rendered a final decree, upholding the validity of the patent. That is sufficient basis in itself for an injunction or some form of a restraining or accounting order, provided the party defendant in the particular case has infringed the patent. In other words, the court, on a motion for a provisional injunction, does not go into the merits to ascertain the validity of the patent. *Prima facie* the patent is valid. But under the uniform rulings of the courts of the United States for more than half a century, if there has been no decision as to the patent by a United States court on the merits, the party is driven to show that his patent went into use undisputed for a sufficient time to raise a *prima facie* case in his favor. But if the court, after a due consideration of the matter, has reached the conclusion that the patent is valid, on this provisional matter the inquiry is not open." 17 O. G. 974 (974); 1 Fed. Rep. 604 (606); 1 McCrary, 155 (157).

In Hockholzer *v.* Eager (1873), 2 Sawyer, 361, Hillyer, J.: (362) "Some-

Acquiescence, in reference to this subject, is a voluntary submission, against interest, to an asserted right. In the first

thing more than a grant of letters-patent must be shown; something which, in the absence of a trial at law, may take its place in establishing, or presumptively establishing, the validity of the patent. This may be done by showing an exclusive possession and exercise of the right granted. In proof of such possession it must appear that the patentee after the grant of his exclusive right has proceeded to exercise that right for some years without being disturbed. (Orr *v.* Littlefield, 1 W. & M. 13.) This he may prove by showing that he has manufactured and sold machines repeatedly, or has sold to others the right to make, vend, and use the thing patented, and if the public acquiesce in this exclusive exercise of his right, it affords some ground for presuming that the patent is valid."

In Potter *v.* Muller (1864), 2 Fisher, 465, Leavitt, J.: (467) "The rule as to granting or continuing injunctions in patent-right cases is now well settled by the modern usages of the courts of the United States. They are now granted without a previous trial at law in cases where the owner of the patent shows a clear case of infringement, and has been in the possession and enjoyment of the exclusive right for a term of years without any successful impeachment of its validity. Such possession and enjoyment, aided by the presumptions arising from the patent itself, are usually regarded as sufficient to warrant an injunction to restrain infringement."

In Orr *v.* Littlefield (1845), 1 W. & M. 13, Woodbury, J.: (16) "If the patentee, after the procurement of his patent conferring an exclusive right, proceeds to put that right into exercise or use for some years, without its being disturbed, that circumstance strengthens much the probability that the patent is good, and renders it so likely as alone often to justify the issue of an injunction in aid of it." 2 Robb, 323 (326).

See also Brown *v.* Hinkley (1873), 3 O. G. 384; 6 Fisher, 370; Miller *v.* Androscoggin Pulp Co. (1872), 1 O. G. 409; 5 Fisher, 340; Holmes, 142; Guidet *v.* Palmer (1872), 6 Fisher, 82; 10 Blatch. 217; Sargent *v.* Carter (1857), 1 Fisher, 277; Sargent *v.* Seagrave (1855), 2 Curtis, 553; Brooks *v.* Norcross (1851), 2 Fisher, 661; Thomas *v.* Weeks (1827), 2 Paine, 92 and notes; Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477; Isaacs *v.* Cooper (1821), 4 Wash. 259; 1 Robb, 332.

That acceptance by the public is evidence of patentability, see Strobridge *v.* Lindsay (1880), 18 O. G. 62; 2 Fed. Rep. 692; 5 Bann. & A. 411.

That acquiescence must indicate a recognition of the validity of the plaintiff's patent, and this, in the absence of a judgment of validity, is important, see Sargent *v.* Seagrave (1855), 2 Curtis, 553.

That an injunction will issue when sufficient acquiescence is shown if the plaintiff's interest requires it, though some doubt as to the validity of the patent may remain, see Sargent *v.* Seagrave (1855), 2 Curtis, 553.

That an injunction will issue where the plaintiff has been for years in the undisputed use of his patents with the acquiescence of the public, unless special facts take the case out of the general rule, see McKay *v.* Dibert (1881), 5 Fed. Rep. 587; 19 O. G. 1351.

That the use and sale of the invention by the plaintiff before he applied for a patent, and the acquiescence of the public in his exclusive claims, is to be

place, the right must be asserted. The issue of a patent is not, of itself, such an assertion. Where the patentee alone employs the invention, in secret or on his own premises, without competition or attracting public notice, or where he neither exposes his monopoly to violation nor vindicates it when it is attacked, there is no right asserted in which the public or an individual can acquiesce.[2] Again, the asserted right must be antagonistic to the public interest, at least to the interest of that portion of the public who are generally benefited by the use of such inventions. If the invention is without utility, or if through some mistake as to its character the public are convinced that it is worthless, and there is no demand for or desire to use it, their passive indifference to the exclusive claim of the inventor indicates no public rec-

considered on a motion for an injunction, see Sargent *v.* Seagrave (1855), 2 Curtis, 553.

That previous user by the inventor and others is not necessary where the patent has been sustained by the courts, especially where the patent is for a process, see American Middlings Purifier Co. *v.* Christian (1877), 4 Dillon, 448; 3 Bann. & A. 42.

[2] In Tappan *v.* National Bank Note Co. (1861), 2 Fisher, 195, Shipman, J.: (198) "The principle that exclusive possession for a time strengthens the title of a patentee is founded on the idea that as it is a claim of right adverse to the public, and the public acquiesce in that claim, such acquiescence raises a presumption that the claim is good. But no such presumption can be raised in this case. There is no evidence that the public, or that small portion of it who would be likely to avail themselves of this invention knew even of its existence, much less of the existence of an exclusive grant to this patentee or to any one else. Nor, in this view of the case, can I take into account the possession of the right and the use of the invention *before* the application or grant of the patent. This is sometimes done on the principle laid down in Sargent *v.* Seagrave, 2 Curtis, 555. But, of course, the use, in such a case, must be a *public* one under an avowed claim of a right to a patent; otherwise, there is no exclusive possession as against the public, and no claim in which the public can acquiesce." 4 Blatch. 509 (512).

That proof showing that the plaintiff, while manufacturing under his own patent in his own shop, met with no competition does not establish acquiescence, see Grover & Baker Sewing Mach. Co. *v.* Williams (1860), 2 Fisher, 133.

That on motion for injunction it is important that the invention has never been put in the market, nor the patent litigated, nor its validity accepted, see Irwin *v.* McRoberts (1879), 16 O. G. 853; 4 Bann. & A. 411.

That an injunction will be denied unless the scope of the patent has been defined by the courts, or by the acquiescence of that part of the public who are cognizant of the monopoly, see Steam Gauge & Lantern Co. *v.* Miller (1881), 8 Fed. Rep. 314; 20 O. G. 889.

ognition of its validity.[3] Moreover, the submission must be voluntary. There is no acquiescence where the monopoly is constantly invaded or the rights of its owner are respected only under the compulsion of adverse judgments or continual injunctions.[4] Submission after a single contest, which serves to define the limits of the patented invention, is stronger evidence of the validity of the patent as defined than if its scope were still undetermined, but the general resistance of the public to the patentee's demands, though provoking numerous actions in all of which he is successful, is inconsistent with the idea that they regard his patent as valid. His judgments may be evidence to prove the existence and the lawfulness of his monopoly; but the conduct of the infringing public is its perpetual denial.

[3] In Grover & Baker Sewing Mach. Co. *v.* Williams (1860), 2 Fisher, 133, Sprague, J.: (136) "Acquiescence is taken as evidence of the plaintiff's right, and may in some cases in a great degree strengthen the presumption created by the patent itself. If a party set up an exclusive right to the manufacture and use of an article which others are desirous of manufacturing or using, and it would manifestly be for their interest to do so, and they would do so did they not think themselves prohibited by the patent-right of another, then their acquiescence, their abstaining from making that which it is morally certain they would do but for such patent, shows the conviction of those who are interested adversely to it, and who, from being interested in it, may be presumed to have knowledge on the subject,—shows that they are convinced of the patentee's right, and that they have sacrificed their interest to their conviction. But if there be no adverse interest, no person who would be desirous of using it, whether it were patented or not, then their not using it cannot afford a presumption of the right and would not strengthen it. . . . (138) But it would not necessarily follow, because there were certain persons carrying on an art or manufacture at their own manufacturing establishment, and others did not enter into competition with them, that that abstaining from competition was owing to the belief that they had the exclusive right. It may be so, and it may not be. Persons set up the manufacture of a new article; others may not enter into competition because they do not believe it for their interest; they may not believe it to be profitable, and in that case there would be no evidence that they believed they were excluded from it by a monopoly in possession of those persons."

[4] That no injunction will issue where the patent has not been sustained by the courts, and there has been only a limited acquiescence, and the defendants have for years openly denied its validity, see Fish *v.* Domestic Sewing Mach. Co. (1882), 12 Fed. Rep. 495; 22 O. G. 1207.

§ 1186. Preliminary Injunction: Public Acquiescence as Evidence of Validity: Weight of such Evidence, how Measured.

As the fact of acquiescence depends on the assertion of the right, on the restriction which it places on the public interest, and on the willingness of their submission, so its value, as proof of the validity of the patent, is measured by the degree and the duration of such submission and restraint.[1] That a patent covering an invention of slight utility, or desirable by but a small fraction of the public, remains inviolate, affords little proof that the right of the inventor to its exclusive use was recognized; while if the invention were of great importance, affecting the whole course and practice of the art, the absence of infringement can be attributed only to a compliance with the prohibitions of the patent.[2] The significance of the duration of the acquiescence is not estimated by the mere lapse of time.[3] No period can be specified within which such submission shall be insufficient to establish the validity of the patent.[4] The public must have had an opportunity to

§ 1186. [1] In Potter *v.* Whitney (1866), 3 Fisher, 77, Lowell, J.: (79) "These cases being tried, as I have said, on *ex parte* evidence, must be decided on broad views of the rights of the parties. It is usual to present proof either of long and general acquiescence in the plaintiff's exclusive rights, or of their having been sustained by the courts. The ground on which acquiescence is important is that it shows exclusive possession, which, if it has been of long standing, open, and notorious, is a clear foundation of a presumption of title. It is not always, however, so satisfactory as positive adjudications, because it may have arisen from the comparatively small commercial value of the invention, and in that case shows only that no one has thought it worth infringing." 1 Lowell, 87 (89).

[2] That an injunction is seldom refused where there has been exclusive possession for some time, though not for a long period, and where large and numerous sales were had without dispute, and the defendant does not deny the validity of the patent, see White *v.* Heath (1882), 22 O. G. 500; 10 Fed. Rep. 291.

[3] That mere lapse of time shows no acquiescence, but facts must appear which indicate that the public would not have acquiesced had they not considered the patent valid, and the nature of the invention and all attendant circumstances must be regarded, see Guidet *v.* Palmer (1872), 6 Fisher, 82; 10 Blatch. 217.

[4] In Foster *v.* Moore (1852), 1 Curtis, 279, Curtis, J.: (286) "It is not possible to fix any precise term of years during which the exclusive possession must have continued. The reason for the presumption in favor of the validity of the grant is the acquiescence of the public in the exclusive right of the patentee, which, it may reasonably be

become acquainted with the merits of the invention, and to be informed of the asserted rights of the patentee, and must have voluntarily refrained, against their manifest interest, from appropriating the invention for such a time as makes it evident that their forbearance is the result of knowledge and deliberation.[5] All circumstances which tend to show the value of the invention to the public and their consequent motive to inquire into the validity of the patent which protects it are here important, — a short period of voluntary submission in reference to some inventions being of greater weight upon this question than years of acquiescence in regard to others.

§ 1187. Preliminary Injunction: Public Acquiescence as Evidence of Validity: Acquiescence, how Manifested.

The acquiescence of the public in the monopoly created by a patent may be manifested in different modes, corresponding to those which the patentee adopts for its enjoyment. Where he makes and uses the invention in his own business, or manufactures it for sale, the omission of infringing acts is a sufficient recognition of his patent.[1] When he grants li-

assumed, would not exist unless the right was well founded. And it is obvious that this public acquiescence is entitled to more or less weight according to the degree of utility of the machine, and the number of persons whose trade or business are affected by it."

That though the duration of enjoyment necessary to constitute possession and acquiescence cannot be fixed by rule, it must be long enough to raise a presumption that the patent is valid, see Potter *v.* Muller (1864), 2 Fisher, 465.

[5] That the length of time necessary for acquiescence depends on the duration and extent of the use and sale by the patentee, or the degree of utility, or the number of persons whose interest it is to infringe the patent, and the completeness of the acquiescence, see Sargent *v.* Seagrave (1855) 2 Curtis, 553.

That the exclusive possession for eight years of a device affecting the business of a large class of persons is enough to make an injunction proper, see Foster *v.* Moore (1852), 1 Curtis, 279.

That no injunction will be granted a few months only after the issue of the patent, when its validity is denied, the infringement is disputed, and the defendant is responsible, see McGuire *v.* Eames (1878), 15 Blatch. 312; 3 Bann. & A. 499; Jones *v.* Field (1875), 12 Blatch. 494; 2 Bann. & A. 39.

That a year is too short a period for a patent to acquire a construction by acquiescence, and an injunction based on any given construction will not be warranted thereby, see Johnston Ruffler Co. *v.* Avery Mach. Co. (1886), 28 Fed. Rep. 193; 36 O. G. 1043.

§ 1187. [1] That an omission to infringe, when the invention is of public

censes to others, the general acceptance of his licenses and the payment of substantial fees constitutes the requisite submission.[2] Licenses issued and received on nominal royalties, or without consideration, afford no indication of public acquiescence. The acknowledgment of his exclusive right to an article or process which embodies several inventions, each the subject of a different patent, does not admit the validity of either patent nor that all the patents are of equal force.[3] The departure of the defendant from the universal acquiescence of the public does not tend to weaken the presumption of validity, but rather adds to its importance, since it shows their knowledge of the value of the invention and the advantage they might gain by its infringement.[4] Acquiescence in an original patent avails the plaintiff on a re-issue for the same precise invention, but not where new claims are inserted of which the public could have had no previous notice.[5]

value, *indicates acquiescence, see* Grover & Baker Sewing Mach. Co. *v.* Williams (1860), 2 Fisher, 133.

That acquiescence may be shown by extensive manufacture, many licenses, the settlement of prior suits, and general recognition by the trade, see Hat Sweat Mfg. Co. *v.* Davis Sewing Mach. Co. (1887), 41 O. G. 1273; 32 Fed. Rep. 401.

[2] In Grover & Baker Sewing Mach Co. *v. Williams (1860)*, 2 Fisher, 133, Sprague, J.: (138) "If they [the public] had paid for licenses, that would be a palpable and manifest sacrifice of their interests to their conviction of the plaintiffs' right, because it shows a desire to make the machine and abstaining from it, paying the plaintiffs and thus making a pecuniary sacrifice for the sake of getting the right from the plaintiffs."

That an acquiescence by infringers, as shown by their taking licenses rather than contest the patent, is as strong evidence as voluntary submission, see Hat Sweat Mfg. Co. *v.* Davis Sewing Mach. Co. (1887), 32 Fed. Rep. 401; 41 O. G. 1273.

[3] *That acquiescence in a manufacture protected by several patents does not show that all the patents were supposed by the public to be equally valid, or that any particular one was conceded to be valid, especially if any one of them had been sustained by the courts,* see Upton *v.* Wayland (1888), 36 Fed. Rep. 691; Grover & Baker Sewing Mach. Co. *v.* Williams (1860), 2 Fisher, 133.

[4] *That an unsuccessful attempt to interrupt the patentee's possession strengthens the presumption in his favor,* see Sargent *v.* Seagrave (1855), 2 Curtis, 553.

That an injunction will be granted where the plaintiffs enjoyed the patent ten years, and were never interfered with except by the defendant, whom they promptly notified, see Collignon *v.* Hayes (1881), 20 O. G. 447; 8 Fed. Rep. 912.

[5] In Grover & Baker Sewing Mach. Co. *v.* Williams (1860), 2 Fisher, 133, Sprague, J.: (144) "Undoubtedly there may be cases in which the original patent relates to and covers probably the same

§ 1188. Preliminary Injunction: Comparative Weight of Prior Judgments and Public Acquiescence as Evidence of Validity.

The acquiescence of the public in the exclusive privilege of the patentee is of less weight, although usually of wider application, than a judgment.[1] Judgments, except in extraordinary cases, are confined to certain issues, and when they sustain a patent sustain it only on the grounds which have been made the subject of dispute. Acquiescence, on the other hand, is an admission of the validity of the patent as against all conceivable objections, and in its scope is therefore equal to a judgment upon all the issues which the law permits to be presented. Its weight, however, is by far inferior, since in the absence of all litigation it never can be known what causes might be shown for the avoidance of the patent, nor whether each defence might not be successfully maintained. It is received as evidence on applications for injunctions on account of its general nature and comparative facility of proof, and because, though not equal to a judgment, it may rank next to judgments as a basis for presumptions. Where it can be strengthened by a judgment, even in a coordinate or lower court, its value as evidence of validity is much increased.[2]

thing that is in the re-issued patent; and if it does, and the public have acquiesced in the claim made in the original patent for the same thing that is claimed in the re-issued patent, it is evidence to show that they believe that the patentee had an exclusive right to it. But if the original patent did not claim the same thing, and, therefore, the public had no notice that it was the patentee's invention, and, if it was his invention, had no notice that he claimed it, — or, at all events, that he had any exclusive right to it, — then the acquiescence in the original patent cannot be construed as acquiescence in that which he did not then claim, but which sometime afterward he did."

That on a motion for an injunction, a re-issue containing claims not in the original patent is treated as a new patent so far as the questions of acquiescence and public acceptance are concerned, see Irwin *v.* McRoberts (1879), 16 O. G. 853; 4 Bann. & A. 411.

§ 1188. [1] That public acquiescence is only important to show exclusive possession and create a presumption of title, and is of less weight than a prior adjudication, see McWilliams Mfg. Co. *v.* Blundell (1882), 11 Fed. Rep. 419; 22 O. G. 177; Potter *v.* Whitney (1866), 3 Fisher, 77; 1 Lowell, 87.

[2] That the presumption from acquiescence is aided by judgments either at law or in equity, see Potter *v.* Muller (1864), 2 Fisher, 465.

That where the plaintiff produced his patent, proved an uninterrupted use

§ 1189. Preliminary Injunction: Admissions of Defendant as Evidence of Validity.

Where neither judgments nor public acquiescence can be offered to support the patent, the conduct of the defendant may still furnish sufficient evidence to authorize the court to find this point in favor of the plaintiff. The failure of the defendant to deny the validity of the patent, in his answer to the application, is an admission which serves all the ends of proof.[1] Although he does deny it, his past acts may contradict his pleadings, and practically estop him from insisting upon his denial. The compromise of a previous action after expensive litigation, in which he has admitted his infringement of the patent; his express contract, unrescinded, obliging him to acknowledge its validity; his covenant on due consideration binding him not to urge his only possible defence; his former union with the plaintiff in the enjoyment

without infringement for eleven years, and had recovered a judgment in a trial at law, during which every defence known to the law could have been set up, and had also received an extension in spite of opposition, an injunction will issue, see McComb *v.* Ernest (1871), 1 Woods, 195.

That an injunction may be refused, though acquiescence be shown, if there is reasonable doubt as to validity, see Bradley & Hubbard Mfg. Co. *v.* Charles Parker Co. (1883), 24 O. G. 995; 17 Fed. Rep. 240.

§ 1189. [1] That an injunction will be granted when the defendant's answers are equivocal and evasive, or disclose facts which show that the conclusions from them are erroneous and founded on a mistake of law, see Parker *v.* Sears (1850), 1 Fisher, 93.

That an injunction will issue if the questions as stated admit the facts and their solution depends on the construction of the patent, see Goodyear *v.* Railroad (1853), 1 Fisher, 626.

That an injunction will be granted where the validity of the original patent is not disputed by the defendant, where capital is invested in the manufacture and a successful business has been established, and where large and numerous sales have taken place without dispute, and exclusive possession has for some time existed, see White *v.* Heath (1882), 10 Fed. Rep. 291; 22 O. G. 500.

That where an injunction has been granted against one defendant, and upon a new motion for an injunction against another the latter does not deny, either by his own affidavit or that of any expert, that his device is identical with that of the former defendant or that he infringes, and his counsel makes affidavit merely that his client and experts tell him there is no infringement, and asks time to show it, the injunction will be granted and the defendant's device be presumed to infringe, see Conover *v.* Mers (1868), 3 Fisher, 386.

That where a defendant abandons his case and confesses judgment, the judgment is sufficient unless collusive, see Goodyear *v.* Railroad (1853), 1 Fisher, 626.

of the monopoly and in enforcing it against all others, — such are some examples of the conduct which on an application for an injunction may be treated by the court as proof sufficient to sustain the patent.[2]

[2] That a compromise and admission of infringement after expensive litigation, coupled with the opinion of a circuit judge in another case giving a broad construction to the patent, goes far to answer the purposes of a prior adjudication on the question of a preliminary injunction, see Steam Gauge & Lantern Co. *v.* Miller (1881), 20 O. G. 889; 8 Fed. Rep. 314.

That a verbal admission of infringement and a promise to desist is a strong circumstance against the defendant on a motion for a preliminary injunction, see Morse Fountain Pen Co. *v.* Esterbrook Steel Pen Mfg. Co. (1869), 3 Fisher, 515.

That where a defendant in a suit at law agreed for a valuable consideration to cease making the device, and suffered judgment to be entered against him, but continued to sell a different and still infringing device, and upon a bill in equity being brought against him it appeared that all the defences set up were known to him at the time of the former suit, he was held bound by his agreement, and estopped from denying the validity of the patent, see Brooks *v.* Moorhouse (1878), 13 O. G. 499; 3 Bann. & A. 229.

That a defendant will be enjoined if he has covenanted not to further infringe, unless he can show reasons for a release from his covenants, see Sargent *v.* Larned (1855), 2 Curtis, 340.

That an injunction will be granted where the defendant is estopped by express contract from setting up the only defence he could make, see McKay *v.* McKnight (1881), 5 Fed. Rep. 593.

That where a firm is composed of the defeated and the successful applicants for a patent, and the firm sold and advertised the articles under the patent, and after the dissolution of the firm the defeated parties still made and sold the articles, their former acquiescence was held sufficient to warrant an injunction, see Pentlarge *v.* Beeston (1877), 14 Blatch. 352; 3 Bann. & A. 142.

That a defendant corporation whose officers until recently were occupying positions of trust under the plaintiff, asserting the validity of his patent and enjoying its benefits, may be held to stricter accountability than an ordinary infringer, see Steam Gauge & Lantern Co. *v.* Ham Mfg. Co. (1886), 28 Fed. Rep. 618.

That a former part-owner of a patent is estopped from denying its validity on a motion for an injunction against a firm of which he is now a member, if he assigned his interest in the patent to the plaintiff for value, see Parker *v.* McKee (1885), 24 Fed. Rep. 808; 32 O. G. 137.

That on a motion for an injunction the defendant cannot deny validity if he has been a licensee and owner of the patent, and has dealt extensively in the articles as patented under it, see Burr *v.* Kimbark (1886), 28 Fed. Rep. 574; 37 O. G. 1480.

That an inventor and assignor is estopped to deny that he was the true inventor, when defendant on a motion for an injunction, see American Paper Barrel Co. *v.* Laraway (1886), 28 Fed. Rep. 141; 37 O. G. 674.

That a defendant, by taking a license and acting under it, admits the validity of the patent for the purpose of an injunction, though no judgment exists, if the patent is not challenged, see

§ 1190. Preliminary Injunction: Proof of Plaintiff's Title.

The second point to be established by the applicant for an injunction is his ownership of a legal or equitable interest in the patent alleged to be infringed.[1] As this is a matter capable of direct proof and usually without extensive investigation, the courts require a higher degree of certainty in the evidence presented than is necessary in regard to the validity of the patent. If the plaintiff holds the legal title as patentee or assignee or grantee, the instruments themselves, or certified copies, must be offered, disclosing the precise condition of the ownership. When the interest of the plaintiff is merely equitable, it must be proved by the production of the written contract upon which it rests, or by parol testimony of the facts and circumstances out of which it grows.

§ 1191. Preliminary Injunction: Proof of Intended Infringement.

Upon the third point the plaintiff must satisfy the court that the defendant intends to make, use, or sell, or to authorize or directly profit by the manufacture, use, or sale, of some

Brown *v.* Lapham (1886), 27 Fed. Rep. 77; 23 Blatch. 475; 37 O. G. 676.

That a licensee openly repudiating his license and denying validity, cannot afterwards be enjoined on the ground of his former acquiescence in the patent, see Brown *v.* Lapham (1886), 23 Blatch. 475; 27 Fed. Rep. 77; 37 O. G. 676.

That a patentee cannot deny the validity of the patent or its re-issues in a suit against him by his assignee, though the re-issues were granted after the assignment, and the assignee ought to have known that they were void, see Burdsall *v.* Curran (1887), 31 Fed. Rep. 918; 42 O. G. 1167.

That a person who induced a plaintiff to acquire a patent and commence business under it is estopped to deny its validity on a motion for an injunction, see Time Telegraph Co. *v.* Carey (1884), 26 O. G. 826; 22 Blatch. 34; 19 Fed. Rep. 322.

That one who knowingly permits another to take out a patent for an invention, and then himself obtains a patent for a different invention, cannot claim that he is the inventor of the prior invention, see Fraim *v.* Keen (1885), 34 O. G. 1048; 25 Fed. Rep. 820.

That a defendant who has profited by an infringement cannot deny the utility of the invention, see La Rue *v.* Western Electric Co. (1887), 31 Fed. Rep. 80; 40 O. G. 576.

That a patentee cannot aver against his assignee that the invention was worthless or abandoned, see Many *v.* Jagger (1848), 1 Blatch. 372.

§ 1190. [1] That an injunction may issue notwithstanding a denial of the plaintiff's title, see Clum *v.* Brewer (1855), 2 Curtis, 506.

That an injunction will be refused where the plaintiff has only a doubtful equitable title and that is being contested in the local courts, see Continental Store Service Co. *v.* New York Store Service Co. (1885), 31 O. G. 1561.

art or instrument identical with that covered by his patent.[1] Where the identity has already been established in prior actions, the judgments therein rendered may be offered in the same manner as upon the issue of validity.[2] If the invention is an instrument, and the defendant has in his possession or under his control the alleged infringing articles, the court may personally inspect and compare them, and without further proof determine their substantial agreement or dissimilarity.[3] When these modes of investigation are unavailable, such evidence must be introduced as the plaintiff is able to obtain.[4] The intention of the defendant to practise the in-

§ 1191. [1] That no injunction will issue unless infringement clearly appears, see Brooks *v.* Miller (1886), 28 Fed. Rep. 615; Steam Gauge & Lantern Co. *v.* St. Louis Railway Supplies Mfg. Co. (1885), 25 Fed. Rep. 491; 33 O. G. 889; Allis *v.* Stowell (1883), 15 Fed. Rep. 242; 23 O. G. 1033; Coburn *v.* Clark (1883), 15 Fed. Rep. 804; 24 O. G. 899; 5 McCrary, 99; Hardy *v.* Marble (1882), 10 Fed. Rep. 752; 23 O. G. 438; Marks *v.* Corn (1881), 11 Fed. Rep. 900; 23 O. G. 94; Pullman *v.* Balt. & Ohio R. R. Co. (1881), 19 O. G. 224; 5 Fed. Rep. 72; 4 Hughes, 236; White *v.* Harris & Sons Mfg. Co. (1880), 3 Fed. Rep. 161; 5 Bann. & A. 571; American Middlings Purifier Co. *v.* Atlantic Milling Co. (1877), 4 Dillon, 100; 3 Bann. & A. 168; Burleigh Rock Drill Co. *v.* Lobdell (1875), 7 O. G. 836; Holmes, 450; 1 Bann. & A. 625; Dodge *v.* Card (1860), 2 Fisher, 116; 1 Bond, 393.

That no injunction will issue unless it has been shown that the defendant has used the invention, or employed others to use it, or has profited by its use, see Woodworth *v.* Hall (1846), 1 W. & M. 248; 2 Robb, 495.

That an injunction may be granted though infringement is not proved beyond reasonable doubt, see Doughty *v.* West (1865), 2 Fisher, 553.

That the question of infringement must be determined anew upon each motion for an injunction, though the validity of the patent be sustained by prior judgments, see Hammerschlag Mfg. Co. *v.* Judd (1886), 28 Fed. Rep. 621.

[2] That on a motion for an injunction all questions adjudicated in previous cases are regarded as settled, see Goodyear Dental Vulcanite Co. *v.* Evans (1868), 3 Fisher, 390; 6 Blatch. 121.

[3] That disputed infringement may be settled by inspecting the two devices without any prior adjudication, see Crowell *v.* Harlow (1878), 18 O. G. 466; 3 Bann. & A. 478.

That in case of a simple mechanism a bare inspection of the two machines is often enough to show an infringement for the purposes of a preliminary injunction, see Morse Fountain Pen Co. *v.* Esterbrook Steel Pen Mfg. Co. (1869), 3 Fisher, 515.

That the refusal of a defendant to exhibit his device raises a presumption of infringement, see Piper *v.* Brown (1873), Holmes, 196; 6 Fisher, 240; 3 O. G. 97; Union Paper Bag Mach. Co. *v.* Binney (1871), 5 Fisher, 166.

[4] That on a motion for an injunction the fact of a difference of expert opinions will be regarded, see American Nicholson Pavement Co. *v.* City of Elizabeth (1870), 4 Fisher, 189.

That affidavits of the makers of a

vention, in violation of the plaintiff's rights, may be shown from his past acts of infringement in reference to the same invention, or from his threats or preparations to infringe.[5] Where the defendant has once knowingly invaded the exclusive domain of the plaintiff, there is a strong presumption that the wrong will be repeated, although he may have since desisted and promised to refrain, or even sworn that it is his purpose no further to infringe.[6] This presumption arises,

composition outweigh those of mere dealers on the question of infringement, see Gutta Percha & Rubber Mfg. Co. *v.* Goodyear Rubber Co. (1875), 8 Sawyer, 542 ; 2 Bann. & A. 212.

[5] That an injunction will be granted before a wrong is committed when the right is clear and the wrong is threatened, or when the wrong has once been committed and there is good reason to fear its repetition, see Sherman *v.* Nutt (1888), 35 Fed. Rep. 149; Poppenhusen *v.* New York Gutta Percha Comb Co. (1858), 2 Fisher, 74 ; 4 Blatch. 184.

That an injunction will be granted where there have been no actual sales but only prospective ones, see White *v.* Heath (1882), 22 O. G. 500 ; 10 Fed. Rep. 291.

That where an injunction has been denied on the ground that the defendant before suit abandoned the infringement, and he since makes a different infringing device, a new injunction will be granted covering all the devices, see Odell *v.* Stout (1884), 22 Fed. Rep. 159 ; 29 O. G. 862.

[6] In Potter *v.* Crowell (1866), 3 Fisher, 112, Withey, J.: (115) "Perhaps as safe a criterion of what is to be apprehended from defendants as can be obtained is to look at that which they have done, and in their answer justify the right to do, rather than to look to the fact of their having discontinued the alleged injury, and their declaration of want of intention of renewing the same. The court is not prepared to say that no occasion for the exercise of its restraining power is shown in this case, when it is apparent that there was such occasion when the suit was commenced ; that it has but recently ceased ; that it may, if defendants feel disposed, be renewed at any time ; and that the complainants claim that they apprehend a continuance of the wrong." 1 Abbott, 89 (91).

In Jenkins *v.* Greenwald (1857), 2 Fisher, 37, Leavitt, J.: (43) "These authorities seem decisive on the point referred to. They establish the position that if the party proceeded against as an infringer of the exclusive right of the person having the title to the patent admits the infringement, but asserts that after notice or service of the injunction he had refrained from the use of the thing patented, and asserts that he will not afterward infringe, it is no reason why an injunction should not issue, and be made perpetual. The complainant in such a case is not obliged to rest his interests on the mere asseveration of the party that he will not repeat the act of infringement. Having once been a wrong-doer, the law supposes the possibility of his being so again, and will impose the proper restraint to prevent the repetition of the wrongful act." 1 Bond, 126 (133).

See also Facer *v.* Midvale Steel-Work Co. (1888), 38 Fed. Rep. 231 ; Celluloid Mfg. Co. *v.* Arlington Mfg. Co. (1888), 34 Fed. Rep. 324; 42 O. G. 828 ; North American Iron Works *v.*

whatever may have been the extent of the infringement or the damage thence resulting to the plaintiff.[7] An innocent infringement, abandoned upon notice of the patent, is of comparatively little weight as evidence of this intention, though not wholly disregarded by the court. Assertions of his right to practise the invention, the possession of infringing machines capable of operation or of marketable articles covered by the patent, or other indications of ability and readiness to enter into unlawful competition with the plaintiff, are also competent evidence of such intention.[8]

§ 1192. Preliminary Injunction: May be Granted on other Proof or Withheld though the Foregoing Proof is Presented.

The requirement of the foregoing modes of proof is not designed to exclude all others, or to prohibit the court from granting an injunction though none of these may be pre-

Fiske (1887), 39 O. G. 1086; 30 Fed. Rep. 622; Wollensak *v.* Reiher (1886), 38 O. G. 108; 28 Fed. Rep. 427.

That ceasing to use the device is no reason for denying an injunction, since the plaintiff is entitled to future protection, see Goodyear *v.* Berry (1868), 3 Fisher, 439; 2 Bond, 189; Sickels *v.* Mitchell (1857), 3 Blatch. 548.

That an injunction is not withheld on account of an assertion under oath by the defendant that he does not intend to infringe during the suit, see White *v.* Heath (1882), 22 O. G. 500; 10 Fed. Rep. 291.

[7] That for the purposes of a preliminary injunction the extent of the defendant's infringement is immaterial, see Brickill *v.* Mayor of New York (1880), 7 Fed. Rep. 479; 18 O. G. 463; 18 Blatch. 273; 5 Bann. & A. 544.

[8] That an injunction will issue where the defendants were owners of the device but had obtained no right to use it, see Porter Needle Co. *v.* National Needle Co. (1883), 17 Fed. Rep. 536.

That the possession and advertising of infringing devices warrant an injunction, though no actual infringement has been committed, see American Bell Telephone Co. *v.* Globe Telephone Co. (1887), 31 Fed. Rep. 729; 24 Blatch. 522.

That the use of an invention involving a patented process is a continuing infringement, see Beedle *v.* Bennett (1887), 122 U. S. 71; 39 O. G. 1326.

That a territorial grantee cannot be enjoined from advertising and selling within his territory, on the ground that his vendees take the articles elsewhere, see Hatch *v.* Hall (1884), 30 O. G. 1096; 22 Fed. Rep. 438.

That a vendee will not be enjoined from using the article purchased, on the ground that it infringes another patent of the vendor, if it could be used in no other way, see Roosevelt *v.* Western Electric Co. (1884), 28 O. G. 812; 20 Fed. Rep. 724.

That a defendant will not be enjoined from using an invention which he had in use when the patent was granted, see Dorlan *v.* Guie (1885), 25 Fed. Rep. 816; 34 O. G. 702.

sented. Whenever, upon such investigation as the court has opportunity or is disposed to make, it is apparent that the plaintiff has a right which the defendant threatens to invade, an injunction may be issued, — the rules which govern the discretion of the court being intended for the furtherance of justice, not for its denial. But where one or all of these three forms of proof are offered, it is still within the same discretion to withhold relief, for reasons which indicate that its application in the present instance would be inequitable. These reasons relate to the situation and conduct of the plaintiff or defendant, to the substance of the patent, or to the consequences which would follow from the grant of an injunction.

§ 1193. Preliminary Injunction: Grounds of its Refusal: No Irreparable Injury.

Among the reasons relating to the plaintiff which may induce the court to refuse an injunction is the fact that no irreparable injury would result from the infringement.[1] Thus where the patent is about to expire, or an established license fee exists and has been tendered by the defendant, or the damages resulting from the infringement could be easily computed and the defendant is pecuniarily responsible, or where the bill claims damages and profits only to some date already past, or an adequate remedy can be obtained at law, — the court may either deny the application of the plaintiff or grant it in such a modified form as will secure him the exact protection to which he is entitled.[2]

§ 1193. [1] In Pullman Car Co. *v.* Baltimore & Ohio R. R. Co. (1881), 19 O. G. 224, Bond & Morris, JJ.: (224) "It is not a matter of course, upon the presentation of a patent which *prima facie* establishes the right of the patentee to the thing patented, accompanied by an allegation that the defendant is violating it, that a preliminary injunction will issue; but it must appear likewise that if the writ of injunction does not now issue the complainants will be irreparably injured, and that no subsequent decree of the court can sufficiently ascertain and make good their damages." 5 Fed. Rep. 72 (73); 4 Hughes, 236 (237).

See also Westinghouse Air Brake Co. *v.* Carpenter (1887), 32 Fed. Rep. 484; Keyes *v.* Pueblo Smelting & Refining Co. (1887), 31 Fed. Rep. 560; Zinsser *v.* Cooledge (1883), 17 Fed. Rep. 538; Earth Closet Co. *v.* Fenner (1871), 5 Fisher, 15.

[2] That an injunction will not be issued in the last weeks of the term of

§ 1194. Preliminary Injunction: Grounds of Its Refusal: Plaintiff's Laches or Acquiescence.

Another reason is found in the plaintiff's acquiescence in the infringement, or his laches in the enforcement of his

the patent, when the plaintiff can be compensated in damages, except in peculiar cases, see Parker *v.* Sears (1850), 1 Fisher, 93.

That an injunction will issue after the patent has expired to prevent the use or sale of articles made without authority for that purpose while the patent was in force, see New York Belting & Packing Co. *v.* Magowan (1886), 27 Fed. Rep. 111; 34 O. G. 1278; American Diamond Rock Boring Co. *v.* Sheldon (1880), 1 Fed. Rep. 870; 5 Bann. & A. 292; 18 Blatch. 50.

That if a party knows that the articles being made by him during a patent are infringements, he will be enjoined against selling them after the patent expires, see New York Belting & Packing Co. *v.* Magowan (1886), 27 Fed. Rep. 111; 34 O. G. 1278.

That the sale of an article made under the patent with the consent of the patentee cannot be enjoined after the patent expires, see Reay *v.* Rau (1883), 23 O. G. 1928; 15 Fed. Rep. 749.

That the patent having expired an injunction may be refused, see Clark *v.* Wilson (1886), 36 O. G. 456; 28 Fed. Rep. 95; 24 Blatch. 38.

That where the plaintiff grants licenses the injunction may be refused and a license fee ordered, see Smith *v.* Sands (1885), 24 Fed. Rep. 470; 32 O. G. 1467; Hodge *v.* Hudson River R. R. Co. (1868), 6 Blatch. 165.

That where a license fee exists and is tendered, an injunction will be denied, see Blake *v.* Greenwood Cemetery (1877), 13 O. G. 1046; 14 Blatch. 342; 3 Bann. & A. 112.

That an injunction may be refused when the defendant will take a license, and this is the plaintiff's usual mode of profit, see Baldwin *v.* Bernard (1872), 5 Fisher, 442; 2 O. G. 320; 9 Blatch. 509, note.

That no injunction will issue where there is adequate remedy at law, as where a licensee refuses to pay his license-fee, see Blanchard *v.* Sprague (1859), 1 Clifford, 288.

That an injunction may be granted though the defendant is a mere user and the plaintiff grants licenses at a fixed price, see Howe *v.* Newton (1865), 2 Fisher, 531.

That where the damages would be measured by a license-fee no injunction will issue, see Smith *v.* Sands (1885), 24 Fed. Rep. 470; 32 O. G. 1467; Hoe *v.* Boston Daily Advertiser Co. (1883), 23 O. G. 1123; 14 Fed. Rep. 914.

That an injunction will be granted though the defendant offers to take a license, if the granting of a license would injure the plaintiff's business, see Baldwin *v.* Bernard (1872), 2 O. G. 320; 5 Fisher, 442; 9 Blatch. 509, note.

That where a bill claims profits and damages only up to a specified past date no injunction should be ordered, see Spring *v.* Domestic Sewing Mach. Co. (1882), 13 Fed. Rep. 446; 22 O. G. 1445.

That on a motion for an injunction it is a material question whether the defendant is responsible for profits and damages if any are recovered, see Morris *v.* Lowell Mfg. Co. (1866), 3 Fisher, 67.

That when the defendants are fully responsible, and the plaintiff can be adequately compensated, irreparable damage must be shown to warrant an in-

rights.[1] The unwilling submission of the plaintiff to injuries which he could not resist does not prejudice him in a court of equity.[2] But an intelligent and voluntary consent, even though manifested only by inaction, for any considerable period, if unexplained, is a fault that may deprive him of a remedy which otherwise he would have obtained. Thus, where he has abandoned the practice of the invention, and seen it go into general unlicensed use without attempting to restrain or punish the infringers, the court will not assist him, after a long interval, in the endeavor to reclaim his monopoly and interrupt the enjoyment of the public, except upon a full and final hearing of the cause.[3] The acquiescence of any

junction, see New York Grape Sugar Co. *v.* American Grape Sugar Co. (1882), 10 Fed. Rep. 835; 20 Blatch. 386; Pullman Car Co. *v.* Balt. & Ohio R. R. Co. (1880), 5 Fed. Rep. 72; 19 O. G. 224; 4 Hughes, 236.

§ 1194. [1] That acquiescence in an infringement may forfeit the right to relief in equity, see Kittle *v.* Hall (1887), 24 Blatch. 184; 29 Fed. Rep. 508; 39 O. G. 707; Magic Ruffle Co. *v.* Elm City Co. (1877), 11 O. G. 501; 14 Blatch. 109; 2 Bann. & A. 506; Union Mfg. Co. *v.* Lounsbury (1863), 2 Fisher, 389.

That laches in *obtaining* a re-issue may prevent relief in equity, see Wollensak *v.* Reiher (1885), 115 U. S. 96; 31 O. G. 1301; Tillinghast *v.* Hicks (1882), 23 O. G. 739; 13 Fed. Rep. 388.

That no injunction will issue where the plaintiff has been negligent in asserting his rights, see Keyes *v.* Pueblo Smelting & Refining Co. (1887), 31 Fed. Rep. 560; McLaughlin *v.* People's R. R. Co. (1884), 21 Fed. Rep. 574; 29 O. G. 277; Union Mfg. Co. *v.* Lounsbury (1863), 2 Fisher, 389.

That delay may or may not defeat the right to an injunction, see American Middlings Purifier Co. *v.* Christian (1877), 4 Dillon, 448; 3 Bann. & A. 42.

[2] That if the defendant infringes when the plaintiff is powerless to prevent it, that does not take away his right to protect his interest when he becomes able, see McMillin *v.* Barclay (1871), 5 Fisher, 189; 4 Brews. (Pa.) 275.

That a patentee is not guilty of laches while ignorant of the infringement, see Kilbourn *v.* Sunderland (1889), 130 U. S. 505; Adams *v.* Howard (1884), 26 O. G. 825; 19 Fed. Rep. 317; N. Y. Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519.

That a *delay in suing infringers* caused by the bankruptcy of the patentee and the vesting of the patent in his assignee, accompanied with fruitless efforts of the patentee to regain it until shortly before suit was brought, is not such laches as forfeits the right to sue, if timely notice were given to infringers, see Kittle *v.* Hall (1887), 29 Fed. Rep. 508; 39 O. G. 707; 24 Blatch. 184.

[3] In Green *v.* French (1879), 4 Banr. & A. 169, Nixon, J.: (170) "The general principle of equity jurisprudence which underlies applications of this sort is that the court will not lend its help by way of preliminary injunction in those cases where it appears that the complainant has acquiesced in

owner of the patent has the same effect upon the rights of his assignees and grantees as upon his own.[4] A similar result follows from the unreasonable delay of the plaintiff in instituting actions, though he has never intentionally submitted to an infringement.[5] The owner of a patented invention owes a

That an assignee of claims for past infringements is bound by the laches of his assignor, see N. Y. Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1885), 32 O. G. 1356; 24 Fed. Rep. 604.

[5] In McLaughlin *v.* People's R. R. Co. (1884) 21 Fed. Rep. 574, Brewer, J.: (574) "Under these circumstances, whatever action at law he may have for damages, I think his own laches such as prevents a court of equity from interfering by injunction. That the general principles of equity jurisprudence control in patent cases cannot be doubted. Rev. St. § 629, par. 9; also, section 4921, which last section contains these words: 'The several courts vested with jurisdiction of cases arising under the Patent Laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any rights secured by a patent, upon such terms as the court may deem reasonable.' Now, generally speaking, the laches of complainant is sufficient ground for non-interference on the part of a court of equity. Nearly all the lifetime of this patent the complainant has remained silent, by his silence consenting to, or at least acquiescing in, the acts of the defendant. To interfere now by injunction would seem manifestly inequitable. That this question of laches can be raised by demurrer, and that it is a good defence to a bill in equity, is abundantly sustained by the authorities." 29 O. G. 277 (277).

Further, that an injunction may be denied where suit is unreasonably delayed, see Ladd *v.* Cameron (1885), 25 Fed. Rep. 37; Green *v.* French (1879),

the infringement and unreasonably delayed suit against the infringers. When patentees sleep over their rights, without an excuse, they must not rely upon the extraordinary aid of the court when they awake from their slumbers, but must be satisfied with such relief as may be afforded by the ordinary course of practice after final hearing." 16 O. G. 215 (215). See also Jones *v.* Merrill (1875), 8 O. G. 401; Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23.

That an injunction will be refused if the plaintiff has acquiesced for two years in the infringement, see Spring *v.* Domestic Sewing Mach. Co. (1879), 16 O. G. 721; 4 Bann. & A. 427.

That no injunction will be granted where the plaintiff has long acquiesced in the infringement unless his acquiescence be explained, see Mundy *v.* Kendall (1885), 23 Fed. Rep. 591; 32 O. G. 1237.

That no injunction will issue if the plaintiff abandoned the invention, or abandoned his rights under the patent, see Wyeth *v.* Stone (1840), 1 Story, 273; 2 Robb, 23.

That the plaintiff can be prejudiced only by such acquiescence in the infringement as to induce the reasonable belief that he intended to dedicate the invention to public use, see Williams *v.* Boston & Albany R. R. Co. (1878), 16 O. G. 906; 17 Blatch. 21; 4 Bann. & A. 441.

[4] That the plaintiffs are chargeable with the laches of former owners of the patent, see Spring *v.* Domestic Sewing Mach. Co. (1879), 16 O. G. 721; 4 Bann. & A. 427. See also § 1220, note 6, *post*.

certain duty to known infringers, which obliges him to give them notice of the wrongful character of their use of the invention, unless they are already conscious of their violation of his patent.[6] Having given this notice without avail, he may postpone his suit during the pendency of other actions, or during any reasonable time upon sufficient cause, provided no intentional encouragement is afforded to the infringers.[7] But

16 O. G. 215; 4 Bann. & A. 169; Williams *v.* Boston & Albany R. R. Co. (1878), 16 O. G. 906; 17 Blatch. 21; 4 Bann. & A. 441; Jones *v.* Merrill (1875), 8 O. G. 401.

That a bill alleging thirteen years of infringement is demurrable unless it gives satisfactory reasons for the delay in suing, see McLaughlin *v.* People's R. R. Co. (1884), 21 Fed. Rep. 574; 29 O. G. 277.

That delay in bringing suit is not abandonment, see Williams *v.* Boston & Albany R. R. Co. (1878), 16 O. G. 906; 17 Blatch. 21; 4 Bann. & A. 441.

That delay in suing, if satisfactorily accounted for, is not laches, see Green *v.* French (1879), 16 O. G. 215; 4 Bann. & A. 169.

That delay in seeking relief is no bar to an injunction unless it works an estoppel, see N. Y. Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519.

[6] That diligence is required of the plaintiff when the defendant is not conscious of his infringement, see Merriam *v.* Smith (1882), 11 Fed. Rep. 588.

That silence is not laches, unless the defendant was misled, see Reay *v.* Raynor (1884), 26 O. G. 1111; 22 Blatch. 13; 19 Fed. Rep. 308; N. Y. Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519.

That a known infringer should be early notified of the plaintiff's rights and of his intention to enforce them, see Morris *v.* Lowell Mfg. Co. (1866), 3 Fisher, 67.

That if the plaintiff gave such notice as he was able it is sufficient, see Kittle *v.* Hall (1887), 39 O. G. 707; 29 Fed. Rep. 508; 24 Blatch. 184.

That mere delay in suing when the defendant knows he is infringing is no bar to a suit for damages, see Concord *v.* Norton (1883), 16 Fed. Rep. 477.

That all persons are bound to take notice of a patent duly issued, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 28 O. G. 1007; 19 Fed. Rep. 514.

[7] That a mere forbearance to sue, after notice given, cannot affect the right to an injunction, unless affirmative encouragement to the infringer was also given, see Collignon *v.* Hayes (1881), 20 O. G. 447; 8 Fed. Rep. 912.

That the bringing and pendency of a suit is notice to all other infringers that the rights conferred by the patent are to be maintained, see Colgate *v.* Gold & Stock Telegraph Co. (1879), 16 O. G. 583; 16 Blatch. 503; 4 Bann. & A. 415.

That a plaintiff may delay suing other infringers, while the validity of his patent is in question in a pending suit, without being guilty of laches, see Green *v.* Barney (1884), 19 Fed. Rep. 420; Green *v.* French (1879), 16 O. G. 215; 4 Bann. & A. 169; Van Hook *v.* Pendleton (1846), 1 Blatch. 187.

That an injunction will be granted, though not prayed for till the patent is about to expire, if the plaintiff has de-

any laches, either in commencing or in prosecuting his suit, which evidences culpable indifference to his rights, is a sufficient reason for the denial of that interference, which, if really needed, would more promptly have been sought.[8] Where there has been no laches, the lapse of time since the infringement was discovered becomes unimportant, and an injunction may be granted though the patent has almost expired.[9]

§ 1195. Preliminary Injunction: Grounds of Its Refusal: Estoppel.

Where the laches or acquiescence of the plaintiff has misled the defendant into enterprises which would be destroyed by an injunction, the court will recognize the estoppel and refuse the desired relief.[1] An effectual estoppel also exists

layed only in order to establish his patent in the courts and has but just succeeded, see Rumford Chemical Works *v.* Vice (1877), 11 O. G. 600; 14 Blatch. 179; 2 Bann. & A. 584.

That acquiescence cannot be inferred from the fact that the plaintiff does not sue all infringers at once, for this is at his option, see McWilliams Mfg. Co. *v.* Blundell (1882), 11 Fed. Rep. 419; 22 O. G. 177.

[8] That an injunction will be issued though the plaintiff did not file his bill till three months after the infringement was ascertained, see Union Paper Bag Mach. Co. *v.* Binney (1871), 5 Fisher, 166.

That an injunction will be refused when the plaintiff has delayed his motion for it for eighteen months after receiving notice of the infringement, see Hockholzer *v.* Fager (1873), 2 Sawyer, 361.

That when the plaintiff permits a suit at law against the *defendant* to remain three years unprosecuted, and the defendant is responsible, no injunction will issue, see United Nickel Co. *v.* New Home Sewing Mach. Co. (1883), 17 Fed. Rep. 528; 24 O. G. 1177; 21 Blatch. 415.

That an injunction will not be granted after a suit has been pending for many months, and no new facts have been shown since it was brought, and there were as good reasons for an injunction then as now, see Andrews *v.* Spear (1877), 4 Dillon, 472.

That a motion for an injunction will be denied where it has been already refused and the plaintiff waits till the defendant's evidence is closed before renewing it, see Wooster *v.* Howe Mach. Co. (1879), 16 O. G. 314; 4 Bann. & A. 319.

[9] In Green *v.* French (1879), 4 Bann. & A. 169, Nixon, J.: (171) "A delay in bringing actions against infringers, when satisfactorily accounted for, is not to be treated as laches. It would be a great hardship to require patentees, who are generally poor, to institute legal proceedings as soon as an infringement was ascertained, or lose the right to the protection which an interlocutory injunction affords." 16 O. G. 215 (215).

§ 1195. [1] See § 1194 and notes, *ante*.

That a plaintiff is not estopped by

where the plaintiff has violated his equitable obligations to the defendant, whether created by an express or implied contract, and has thereby placed the defendant in a situation where his self-preservation compelled him to infringe.[2] Thus if the defendant is a licensee and has been secretly under-sold by his licensor — the plaintiff, or if the value of his license has been impaired by the unwarrantable grant of licenses to others or their grant at lower royalties, or if any subsisting relation between the parties renders the interference of the court unjust, the application for an injunction will be denied.[3] Where the defendant, with the understanding that the only open question between the plaintiff and himself is one of compensation, enters in good faith into a contract with third par-

silence unless the defendant was misled by it, see Reay *v.* Raynor (1884), 26 O. G. 1111; 19 Fed. Rep. 308; 22 Blatch. 13; N. Y. Grape Sugar Co. *v.* Buffalo Grape Sugar Co. (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519.

That an injunction may issue on one patent although the suit has been abandoned as to another, unless the defendants have been misled, see Atlantic Giant Powder Co. *v.* Rand (1879), 16 O. G. 87; 16 Blatch. 250; 4 Bann. & A. 263.

That the release of an infringer from liability for the past is no bar to an injunction for the future, see Babcock & Wilcox Co. *v.* Pioneer Iron Works (1888), 43 O. G. 756.

That a defendant may be enjoined though he has been misled by the plaintiff into supposing that his present acts do not infringe, see Sarven *v.* Hall (1873), 6 Fisher, 495; 4 O. G. 666; 11 Blatch. 295.

[2] That an injunction will be refused if the plaintiff has violated his contract with the defendant, although the defendant has also broken the contract, see Crowell *v.* Parmenter (1878), 18 O. G. 360; 3 Bann. & A. 480.

That a breach of the license by the licensor does not justify an infringement by the licensee, see Willis *v.* McCollin (1886), 38 O. G. 1017; 29 Fed. Rep. 641.

That one who knowingly permits another to take out a patent for a certain invention, and then himself patents a different invention, is estopped to claim that he is the inventor of the former invention, see Fraim *v.* Keen (1885), 34 O. G. 1048; 25 Fed. Rep. 820.

[3] That an injunction will be denied to one who has acted fraudulently toward the defendant, as where a licensor has secretly undersold his licensee, see Washburn & Moen Mfg. Co. *v.* Scutt (1884), 22 Fed. Rep. 710; Hoffheins *v.* Brandt (1867), 3 Fisher, 218.

That an injunction will be denied to a licensor who fraudulently licensed others, and thus hurt the defendant's trade, see Washburn & Moen Mfg. Co. *v.* Cincinnati Barbed Wire Fence Co. (1884), 22 Fed. Rep. 712.

That no injunction will be granted where new and difficult questions are to be decided, or where there is anything in the relations of the parties which could cause it to operate unjustly, see Union Paper Bag Mach. Co. *v.* Binney (1871), 5 Fisher, 166.

ties, the injunction, although general in reference to all other uses of the invention, may except this contract from its operation and permit him to fulfil it.[4] Acts of bad faith toward the public may also furnish reasons for denying an injunction to the plaintiff.[5]

§ 1196. Preliminary Injunction: Grounds for its Refusal: Improper Purpose of Plaintiff in Requesting it.

The improper purposes for which the plaintiff intends to employ the injunction, should it be allowed, are also a sufficient ground for its refusal. An injunction is designed to preserve existing rights, not to punish past injuries nor indirectly prejudice the defendant by placing him within the plaintiff's power.[1] Where the main object to be effected is a proper one the court does not concern itself with the ulterior advantages to be derived from its employment. But if as a protection against infringements it is of small importance to the plaintiff, and is desired by him chiefly to compel the defendant to act or to refrain from acting in other matters, or to enforce a recognition of the plaintiff's rights from third parties, the court will ordinarily decline to interfere.[2]

[4] That where the defendant had entered into a contract with third parties in good faith, and with the understanding that the only question between himself and the plaintiff was one of compensation, and did not deny the patent nor the infringement but offered to pay reasonable sums for the privilege of completing his contract, an injunction was refused as to such contract and granted as to all other uses, see Smith *v.* Sharp's Rifle Mfg. Co. (1857), 3 Blatch. 545.

[5] That no injunction will be granted where novelty is denied, and before taking out his patent the plaintiff sold the goods marked "imported from Paris," see Booth *v.* Garelly (1847), 1 Blatch. 247.

That an injunction will be refused if the patentee has never used the invention, nor permitted others to use it, see Hoe *v.* Knap (1886), 27 Fed. Rep. 204; 36 O. G. 1244.

§ 1196. [1] That an injunction issues to protect a clear right from unjust injury, see Cook *v.* Ernest (1872), 2 O. G. 89; 5 Fisher, 396.

That an injunction is a remedial writ in the nature of a prohibition, intended to prevent the commission of future injuries, not to punish past ones, see Poppenhusen *v.* N. Y. Gutta Percha Comb Co. (1858), 2 Fisher, 74; 4 Blatch. 184.

[2] That an injunction is for the purpose of preventing multiplicity of suits or repeated infringements, not to stop litigation or force a compromise in the suit in which it is granted, see Morris *v.* Lowell Mfg. Co. (1866), 3 Fisher, 67.

That the object of an injunction is to prevent mischief, not to cause it by

§ 1197. Preliminary Injunction: Grounds of its Refusal: Defendant's Good Faith.

The good faith of the defendant is a matter which, in connection with other circumstances, may exercise a powerful influence upon the decision of the court. Mere innocence in the infringement, or in preparations to infringe, constitutes no reason why it should be permitted or go unredressed. But where a defendant, in the honest belief that his device is essentially different from that of the plaintiff, or in ignorance of the existence of the plaintiff's patent, enters into important contracts, or invests large amounts of capital, entailing heavy losses if his business should be interrupted, and the plaintiff can be otherwise sufficiently protected, an injunction may be properly withheld.[1] Where the defendant, notwithstanding the presumptions of infringement and validity raised by the plaintiff's evidence, insists that on the full hearing he can maintain his defence, and the court cannot yet determine whether such defence would or would not be fatal to the

aiding the plaintiff to coerce the defendant into a compromise, see Parker *v.* Sears (1850), 1 Fisher, 93.

That whether an injunction should ever be issued to compel a party to perform his contract is doubtful, see Smith *v.* Cummings (1852), 1 Fisher, 152.

That a preliminary injunction cannot be resorted to in order to compel the defendant city to give a contract to the plaintiffs rather than to their competitors, if the latter are the lowest bidders, see American Nicholson Pavement Co. *v.* City of Elizabeth (1870), 4 Fisher, 189.

That an injunction sought for the purpose of establishing an apparent title against all users, and thus induce them to pay tribute to the plaintiff, will be denied, see Western Union Tel. Co. *v.* Balt. & Ohio Tel. Co. (1885), 25 Fed. Rep. 30.

§ 1197. [1] That where the plaintiff can be otherwise protected, a defendant who has acted in good faith, and who would be seriously injured by an injunction, will not be enjoined, see Batten *v.* Silliman (1855), 3 Wall. Jr. 124.

That where the plaintiff's assignor has neglected to employ his invention in the State where the suit is pending during the extended term, and the defendant bought his machine in ignorance of the plaintiff's rights, and the same questions were never in issue in prior suits, an injunction will be refused unless the defendant is irresponsible, see Gear *v.* Holmes (1873), 6 Fisher, 595.

That an injunction will be refused where there has been no judgment sustaining the patent, unless there has been acquie·ence equivalent to an admission of its validity or some other strong reason, if the defendant defends in good faith, see Crowell *v.* Harlow (1878), 18 O. G. 466; 3 Bann. & A. 478.

That all persons are bound to take notice of a patent duly issued, see National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 28 O. G. 1007; 19 Fed. Rep. 514.

action, the good faith of the defendant may also turn the balance in his favor.[2]

§ 1198. Preliminary Injunction: Grounds of its Refusal: Defendant's Patent.

Where the defendant owns or acts under a patent which on its face authorizes the use of the process or device now claimed to be an infringement, an injunction may be withheld until after a final hearing, although the plaintiff's application is supported by the usual proof.[1] The existence of the defendant's patent may raise a doubt upon the question of identity between the infringing and the patented inventions, or upon the question of priority between him and the plaintiff, and this doubt is increased by any evidence of negligence upon the part of the plaintiff in the enforcement of his

[2] That an injunction will not be granted if the defendant shows that he believes he has a just defence, and is not a wilful pirate of the invention, unless his defence is an evident mistake of law or fact, see Goodyear *v.* Dunbar (1860), 1 Fisher, 472; 3 Wall. Jr. 310.

That a defendant acting in an honest belief that a re-issue with expanded Claims is void, will not be enjoined, see Western Union Tel. Co. *v.* Balt. & Ohio Tel. Co. (1885), 25 Fed. Rep. 30.

That a defendant will not be enjoined from using an invention which he employed before the patent was granted, see Dorlan *v.* Guie (1885), 25 Fed. Rep. 816; 34 O. G. 702.

§ 1198. [1] That an injunction will be refused when the defendant has a patent for the same invention, which is *prima facie* valid, the court comparing the two specifications to determine whether they are the same, see Sargent *v.* Carter (1857), 1 Fisher, 277.

That an injunction will not issue if the defendant is acting under letters-patent which cover his machine, see Goodyear *v.* Dunbar (1860), 1 Fisher, 472; 3 Wall. Jr. 310.

That an injunction will be granted though the defendant holds a patent for an improvement, since this patent cannot avail him beyond its proper scope, see Goodyear Dental Vulcanite Co. *v.* Evans (1868), 3 Fisher, 390; 6 Blatch. 121.

That an injunction will be granted though the defendant has a subsequent patent, if the infringement be clear, see Morse Fountain Pen Co. *v.* Esterbrook Steel Pen Mfg. Co. (1869), 3 Fisher, 515.

That an injunction will issue though the defendant has patented other improvements on the same subject, see Cook *v.* Ernest (1872), 5 Fisher, 396; 2 O. G. 89; McComb *v.* Ernest (1871), 1 Woods, 195; Goodyear Dental Vulcanite Co. *v.* Evans (1868), 3 Fisher, 390; 6 Blatch. 121.

That an injunction may issue though the defendant is suing to obtain a patent, see Minneapolis Harvester Works *v.* McCormick Harvesting Mach. Co. (1886), 37 O. G. 556; 28 Fed. Rep. 565.

rights.[2] The good faith of the defendant, the absence of concealment in reference to his operations, the extent of his enterprise, and the injury he would sustain from any prema-

[2] In Goodyear Dental Vulcanite Co. v. Gardner (1870), 4 Fisher, 224, Clifford, J.: (228) "Attempt is made to show that the rule does not apply in this case because letters-patent have also been granted to the respondent, but it is clear that the introduction of the respondent's patent does not change the burden of proof on the question of novelty. He must still prove the allegation of his answer that the original patentee was not the original and first inventor of his improvement. Serious doubts were formerly entertained whether the letters-patent of the respondent were admissible in any view of the case, and it is still the settled rule that the question of infringement cannot be controlled or materially affected by such consideration. (Blanchard *et al.* v. Putman, 8 Wall. 425; Corning *et al.* v. Burden, 15 How. 271). Since the decision of the case last named, the letters-patent of the defendant are admitted in evidence on the question of novelty, as entitled to some weight where the evidence is nicely balanced, but it is quite incorrect to suppose that a patent, subsequent in date, can have the effect as evidence to overcome the *prima facie* presumption otherwise afforded by the introduction of one of prior date, that the patentee was the original and first inventor of what is therein described as his improvement. Such a conclusion is without any foundation in principle, and finds no support in any analogy of the law or in any decided cases." 3 Clifford, 408 (413). The defendant's patent is proof that the experts in the Patent Office regarded his invention as substantially different from the one previously patented by the plaintiff (Westlake *v.* Cartter, 6 Fisher, 519), infringe. This is its entire effect.

In Blanchard *v.* Putnam (1867), 3 Fisher, 186, Leavitt, J.: (192) "I may remark here that both these parties are patentees, and the presumption equally applies to both in relation to the novelty and utility of their inventions. There is a presumption from the issuance of a patent to Morris, years after the date of the Blanchard patent, that he had invented something different from the invention for which a patent had been previously granted to Blanchard; for, if the Commissioner had come to a different conclusion, it would have been his duty to have rejected the application." 2 Bond, 84 (93).

In Corning *v.* Burden (1853), 15 How. 252, Grier, J.: (271) "It is evident that a patent, thus issued after an inquisition or examination made by skilful and sworn public officers, appointed for the purpose of protecting the public against false claims or useless inventions, is entitled to much more respect, as evidence of novelty and utility, than those formerly issued without any such investigation. Consequently such a patent may be, and generally is, received as *prima facie* evidence of the truth of the facts asserted in it. And in cases where the evidence is nicely balanced, it may have weight with a jury in making up their decision as to the plaintiff's right; and if so, it is not easy to perceive why the defendant who uses a patented machine should not have the benefit of a like presumption in his favor, arising from a like investigation of the originality of his invention, and the judgment of the public officers that his machine is new, and not an infringement of the

ture decision against his patent, are all elements to be considered by the court, unless his patent is evidently void, or his acts are unwarranted by its provisions, and it thus constitutes no answer to the plaintiff's claims.[3]

patent previously granted to the plaintiff. It shows, at least, that the defendant has acted in good faith, and is not a wanton infringer of the plaintiff's rights, and ought not, therefore, to be subjected to the same stringent and harsh rule of damages which might be justly inflicted on a mere pirate. It is true the mere question of originality or infringement generally turns on the testimony of the witnesses produced on the trial; but if the plaintiff's patent in a doubtful case may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his; *valeat quantum valeat*. The parties should contend on an equal field, and be allowed to use the same weapons."

That one patented article is presumed to differ from articles covered by other patents, see Buerk *v.* Imhaeuser (1876), 11 O. G. 112; 2 Bann. & A. 465.

That if the defendant has a patent it is evidence that the experts in the Patent Office did not consider his device identical with the plaintiff's, and this is entitled to consideration by the jury, see Westlake *v.* Cartter (1873), 4 O. G. 636; 6 Fisher, 519.

That where a defendant acts under another patent it is presumed that he does not infringe, and no injunction will issue unless the court can see from inspection that he does infringe, see Sargent Mfg. Co. *v.* Woodruff (1873), 5 Bissell, 444.

That an injunction will issue against the defeated party to an interference in favor of the successful party, if the former relies on his own prior patent, see Greenwood *v.* Bracher (1880), 17 O. G. 1151; 1 Fed. Rep. 856; 5 Bann. & A. 302.

That no injunction will issue where the defendants have manufactured under a patent of a date prior to the plaintiff's, which has expired without ever being tested by the plaintiff in a suit, see Whitney *v.* Rollstone Machine Works (1875), 8 O. G. 908; 2 Bann. & A. 170.

[3] That no injunction will be granted where the defendant is openly using a device made under other patents, in full competition with the plaintiff's and in good faith, unless the injury is irreparable or the defendant unable to respond in damages, see Burleigh Rock Drill Co. *v.* Lobdell (1875), 7 O. G. 836; Holmes, 450; 1 Bann. & A. 625.

That where the defendant claims to have acted under a patent and with the acquiescence of the plaintiff, and to have invested a large capital in the enterprise, no injunction will issue unless the case is clear, see North *v.* Kershaw (1857), 4 Blatch. 70.

That where the original patent has expired and a patent for improvements thereon, covering the same principle, has not been adjudicated, and it clearly appears that the latter patent has been infringed under a patent procured for that purpose, and the remedy is important to the plaintiff and there is no good reason to the contrary, an injunction will issue, see Plimpton *v.* Winslow (1880), 3 Fed. Rep. 333; 5 Bann. & A. 563.

That where the litigants claim under adverse titles, still undetermined in the Patent Office, an injunction will be refused, see National Feather Duster Co. *v.* Dearborn Duster Co. (1882), 24 O. G. 497.

That an injunction will be granted though the defendant operates under

§ 1199. Preliminary Injunction: Grounds for its Refusal: Doubts of the Court as to the Existence of Proper Conditions.

Where, notwithstanding the evidence offered by the plaintiff in support of his patent or his title or the allegation of infringement, the court is still in doubt upon either of these questions the injunction may be denied.[1] The keener scru-

a different patent with unlike Claims, if what he really does is an infringement, see Collignon *v.* Hayes (1881), 20 O. G. 447; 8 Fed. Rep. 912.

§ 1199. [1] In Sickels *v.* Young (1855), 3 Blatch. 293, Nelson, J.: (296) "As this is a motion simply for a preliminary injunction, and not a case upon pleadings and proofs for a final hearing, I shall not look further into the mass of papers before me, than to ascertain whether or not a case has been made which, upon established principles of equity, to prevent an irreparable injury requires the court to interfere pending the litigation, and restrain the defendants from the further use of the apparatus or machinery charged with infringement, until the right is finally determined. And, upon these principles, it is well settled that, unless the right is clear upon the papers and proofs presented, and upon which the motion is founded, in favor of the plaintiffs, the injunction will be withheld, and the rights of the parties be left unaffected and unchanged until the case is matured for the final hearing, and definitively disposed of."

In Isaacs *v.* Cooper (1821), 4 Wash. 259, Washington, J.: (260) "The practice of the court of equity, upon motions of this kind, is to grant an injunction upon the filing of the bill, and before a trial at law, if the bill state a clear right, and verify the same by affidavit. If the bill states an exclusive possession of the invention or discovery, for which the plaintiff has obtained a patent, an injunction is granted, although the court may feel doubts as to the validity of the patent. But if the defects in the patent or specification are so glaring that the court can entertain no doubt as to that point, it would be most unjust to restrain the defendant from using a machine or other thing which he may have constructed, probably at great expense, until a decision at law can be had." 1 Robb, 332 (334).

Further, that unless upon the whole evidence the court is reasonably satisfied that an injunction should issue it should be refused, see Norton Door Check & Spring Co. *v.* Hall (1889), 37 Fed. Rep. 691; Thompson *v.* Rand Avery Supply Co. (1889), 38 Fed. Rep. 112; Huber *v.* Myers Sanitary Depot (1887), 34 Fed. Rep. 48; Bradley & Hubbard Mfg. Co. *v.* Charles Parker Co. (1883), 17 Fed. Rep. 240; 24 O. G. 995; N. Y. Grape Sugar Co. *v.* American Grape Sugar Co. (1882), 10 Fed. Rep. 835; 20 Blatch. 386; Illingworth *v.* Spaulding (1881), 9 Fed. Rep. 154; Cross *v.* Livermore (1881), 21 O. G. 139; 9 Fed. Rep. 607; Wilson Packing Co. *v.* Clapp (1878), 13 O. G. 368; 8 Bissell, 154; 3 Bann. & A. 243; Burleigh Rock Drill Co. *v.* Lobdell (1875), Holmes, 450; 7 O. G. 836; 1 Bann. & A. 625; Wells *v.* Gill (1872), 2 O. G. 590; 6 Fisher, 89; Fales *v.* Wentworth (1872), 5 Fisher, 302; Holmes, 96; 2 O. G. 58; Jones *v.* Hodges (1871), Holmes, 37; American Nicholson Pavement Co. *v.* City of Elizabeth (1870), 4 Fisher, 189; Muscan Hair Mfg. Co. *v.* American Hair Mfg. Co. (1858), 1 Fisher, 320; 4 Blatch. 174; Winans *v.* Eaton (1854), 1 Fisher, 181; Goodyear *v.* Railroad (1853), 1 Fisher, 626; Parker *v.*

tiny of the present judge may detect infirmities in the patent hitherto not noticed or not fully appreciated, or may perceive substantial differences between the defendant's device and the patented invention which have previously escaped attention. In such a case he may decline to interfere, though prior judges have sustained the patent and determined the issue of infringement against the defendant. Where the construction of the patent is not inflexible, or where the monopoly is not invaded unless the interpretation claimed by the plaintiff is correct, and this interpretation can be questioned;[2] where the defendant offers counter-judgments in his favor, of sufficient number and authority to show that serious differences of opinion may exist on the same facts now submitted to the court;[3] where the respective assertions and denials of the parties disclose equities which cannot be examined and decided on a motion for an injunction, or terminate in issues of fact which the proof admissible on such a motion cannot properly elucidate;[4] where the patent is recent and no ade-

Sears (1850), 1 Fisher, 93; Brooks *v.* Bicknell (1845), 4 McLean, 70.

That an injunction will be refused where the question is one of fact only, and the affidavits are of equal weight, see Beane *v.* Orr (1875), 9 O. G. 255; 2 Bann. & A. 176.

That where validity is doubtful an injunction will be denied, see Fraim *v.* Sharon Valley Malleable & Gray Iron Co. (1886), 27 Fed. Rep. 457.

That where the validity of the patent is doubtful, and especially where it rests on the plaintiff's evidence and none is offered in opposition, an injunction will be refused, see Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477.

[2] That no injunction will be granted when the novelty of the plaintiff's invention is doubtful, where his patent is not sustained by a judgment or acquiescence in the plaintiff's construction of his claim, and there is no infringement unless the plaintiff's construction of his claim is correct, see Mowry *v.* Grand St. & Newtown R. R. Co. (1872), 5 Fisher, 586; 10 Blatch. 89.

That a construction by acquiescence cannot be established in a single year, and an injunction based on such construction is not warrantable, see Johnston Ruffler Co. *v.* Avery Mach. Co. (1886), 28 Fed. Rep. 193; 36 O. G. 1043.

[3] That where the novelty was denied, and the patent had been sustained in only one case out of three, an injunction was refused and an account and monthly report ordered, see Allen *v.* Sprague (1850), 1 Blatch. 567.

[4] In Potter *v.* Whitney (1866), 3 Fisher, 77, Lowell, J.: (78) "The principles which govern courts in granting or refusing preliminary injunctions in patent cases are well established. As a general rule, if the plaintiff has made out a clear title and the question of infringement presents no difficulty, an injunction will be granted. The hearing is had upon *ex parte* affidavits, and if

quate opportunity has been afforded for such an investigation of the patentability of the invention as renders the judgments sustaining it reliable;[5] where a re-issue has apparently attempted to extend the scope of the original, or the original has been judicially construed to be exclusive of the invention practised by the defendant,[6] — any of these conditions war-

the questions to be decided are difficult and complicated, especially if they involve disputed facts which have never been passed upon by a court or jury, then, although the court may be inclined to think the complainant is right, yet it will not interfere at this stage of the cause whether the questions relate to title or to infringement. And even when the title is clear, yet if there are peculiar circumstances which show that the defendant's interests would be very injuriously affected by an injunction, while those of the plaintiff would not be so affected by refusing it, it may be refused." 1 Lowell, 87 (88).

That if the plaintiff claims only an equitable title, and that is being contested in the local courts, no injunction will issue, see Continental Store Service Co. *v.* New York Store Service Co. (1885), 31 O. G. 1561.

That an injunction will be denied if there is a substantial controversy as to the equities of the parties, and the motion does not permit an inquiry into such equities, see Smith *v.* Cummings (1852), 1 Fisher, 152.

That no injunction will be granted after the patent has expired where the defendant has both a legal and an equitable defence, but the end of the suit at law will be awaited, see Concord *v.* Norton (1883), 16 Fed. Rep. 477.

[5] That an injunction will be refused if the patent is openly defective, see Isaacs *v.* Cooper (1821), 4 Wash. 259; 1 Robb, 332.

That no injunction will issue if the patent is recent and disputed, until after a trial at law, see Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477.

That when the patent has been issued only two months and no judgment or acquiescence sustains it, no injunction will be granted, see Brown *v.* Hinkley (1873), 3 O. G. 384; 6 Fisher, 370.

That where the patent is doubtful, the plaintiff sells licenses, and the defendant is responsible, no injunction will issue, see National Hat Pouncing Mach. Co. *v.* Hedden (1886), 29 Fed. Rep. 147; 38 O. G. 1129.

That no injunction will be granted where the plaintiff is guilty of laches and the defendant is responsible, or where novelty is denied and judgments against the patent are produced, though new trials have been granted on points not affecting validity, see Keyes *v.* Pueblo Smelting & Refining Co. (1887), 31 Fed. Rep. 560.

That an injunction will not issue where the patent is recent, the specification obscure, and the proof of infringement meagre, see Muscan Hair Mfg. Co. *v.* American Hair Mfg. Co. (1858), 1 Fisher, 320; 4 Blatch. 174.

[6] That an injunction on a re-issue will be denied where its Claims are evidently broader than those of the original, see Brewster *v.* Parry (1882), 14 Fed. Rep. 694.

That no injunction will be granted on a re-issue where the re-issue was delayed ten years, and its validity is disputed, and there has been no decision in its favor, no royalties or license-fees paid to the patentee, and no general

rants the court in overruling the presumption which the plaintiff's evidence may have created in his favor, and in refusing to allow a temporary injunction.

§ 1200. Preliminary Injunction: Grounds of its Refusal: Disastrous Consequences if Granted.

Reasons for withholding an injunction may also be found in its probable effect, if granted, either upon the interests of the plaintiff, or those of the defendant or the public.[1] Where an injunction would be useless to the plaintiff on account of the existence of another order of the same character or because no injury will result to him from its denial,

acquiescence by the public, and the defendant is not alleged to be irresponsible, see Tillinghast *v.* Hicks (1882), 13 Fed. Rep. 388; 23 O. G. 739.

That an injunction on a re-issue will be refused where it is doubtful whether the re-issue is broader than the original, until that question is settled, see Steam Gauge & Lantern Co. *v.* Miller (1882), 11 Fed. Rep. 718.

That no injunction will be granted on a re-issue to prevent the infringement of inventions previously disclaimed, see Leggett *v.* Avery (1879), 101 U. S. 256; 17 O. G. 445.

That an injunction will be granted when the valid Claims of a re-issue are infringed, see Starrett *v.* Athol Mach. Co. (1883), 14 Fed. Rep. 910; 23 O. G. 1729.

That an injunction will be granted though the Claims of the re-issue are expanded, see Lorillard *v.* McDowell (1877), 13 Phila. 461; 2 Bann. & A. 531; 11 O. G. 640.

That an injunction will issue on Claims reproduced from the original patent, though other Claims of the re-issue are invalid, see Duff *v.* Calkins (1883), 25 O. G. 601; Starrett *v.* Athol Mach. Co. (1883), 14 Fed. Rep. 910; 23 O. G. 1729.

That where the validity of the re-issue is doubtful, no injunction will be granted, see Arnheim *v.* Finster (1885), 24 Fed. Rep. 276; 32 O. G. 256.

§ 1200. [1] That an injunction will issue where worse mischief would ensue from denying than from granting it, see Hat Sweat Mfg. Co. *v.* Davis Sewing Mach. Co. (1887), 41 O. G. 1273; 32 Fed. Rep. 401; Covert *v.* Curtis (1885), 25 Fed. Rep. 43; Irwin *v.* Dane (1871), 4 Fisher, 359; 2 Bissell, 442.

That the standing of the plaintiffs in their trade is matter of importance and may be considered as a reason for an injunction, see Irwin *v.* Dane (1871), 4 Fisher, 359; 2 Bissell, 442.

That on a motion for an injunction it is a material question whether the defendant makes and sells or only uses the plaintiff's invention, the former being an increasing wrong, see Morris *v.* Lowell Mfg. Co. (1866), 3 Fisher, 67.

That an injunction will issue more easily against a mere seller than a maker, see Covert *v.* Curtis (1885), 25 Fed. Rep. 43.

That an injunction ought to be refused against the mere user, not being the maker or seller of the invention, if the case is doubtful or the balance of inconvenience is on the side of the defendant, see Howe *v.* Newton (1865), 2 Fisher, 531.

or where it is apparent that, if now allowed, it must on final hearing be dissolved, the court will reject the application.[2] Where the injury to the defendant would be out of all proportion to the benefit accruing to the plaintiff, or where the invention is a part only of some wider process or device whose use is essential to the business of the defendant and whose abandonment must prove the ruin of his enterprise, the court may, if he is responsible or tenders compensation to the plaintiff, refuse to interrupt his operations until the necessity therefor is made apparent on the final hearing.[3] If the cessation of the alleged infringing acts

[2] That an injunction will not be granted while another to the same effect is already in force in a different suit, see Gold & Stock Telegraph Co. *v.* Pearce (1884), 19 Fed. Rep. 419; 22 Blatch. 69.

That no preliminary injunction will issue to compel an act, when on final hearing the duty to perform it may be doubtful, see Westinghouse Air Brake Co. *v.* Carpenter (1887), 32 Fed. Rep. 484; International Tooth Crown Co. *v.* Mills Co. (1884), 22 Fed. Rep. 659; 30 O. G. 662; Parkhurst *v.* Kinsman (1847), 2 Halst. Ch. (N. J.) 600.

[3] That an injunction will be refused where it will do the plaintiff little good and the defendant much harm, see Hockholzer *v.* Eager (1873), 2 Sawyer, 361.

That an injunction will be refused where its allowance would injure the defendant more than it would benefit the plaintiff, see McCrary *v.* Pennsylvania Canal Co. (1880), 5 Fed. Rep. 367; Potter *v.* Whitney (1866), 3 Fisher, 77; 1 Lowell, 87; Morris *v.* Lowell Mfg. Co. (1866), 3 Fisher, 67; North *v.* Kershaw (1857), 4 Blatch. 70; Day *v.* Candee (1853), 3 Fisher, 9.

That an injunction will be refused where it would do great injury to the defendants, see Furbush *v.* Bradford (1858), 1 Fisher, 317; Barnard *v.* Gibson (1849), 7 Howard, 650.

That no injunction will be issued where it would work great hardship and other remedies are equally available, see Swift *v.* Jenks (1884), 19 Fed. Rep. 641; 27 O. G. 615; Guidet *v.* Palmer (1872), 6 Fisher, 82; 10 Blatch. 217.

That no injunction will be granted where the plaintiff and defendant are rival manufacturers, and the patent covers only part of a larger machine which cannot be dispensed with except at great loss, a royalty being tendered, see Hoe *v.* Boston Daily Advertiser Co. (1883), 14 Fed. Rep. 914; 23 O. G. 1124.

That where a defendant has acted in good faith and would be seriously injured, and the plaintiff has an established license-fee, no injunction will issue unless in a very clear case, or where the patent has been sustained by judgments, see Batten *v.* Silliman (1855), 3 Wall. Jr. 124.

That an injunction will be granted though it injures the defendant, especially where he was not ignorant of the plaintiff's invention, see Hussey *v.* Whitely (1860), 2 Fisher, 120; 1 Bond, 407.

That if the defendant erects works to carry on the business after notice that he infringes, he has no claim to consideration in equity, see Westinghouse Air Brake Co. *v.* Carpenter (1887), 32 Fed. Rep. 545.

would prove injurious to the public, whose safety or convenience depend upon the use of the invention by the defendant, this likewise constitutes a sufficient reason for the denial of the application.[4]

§ 1201. Preliminary Injunction: Granted without Reserve if the Plaintiff is Entitled to it.

Where, however, the validity of the patent, the title of the plaintiff and the intention of the defendant to infringe are fully proved, and neither the foregoing nor other circumstances render the grant of an injunction inequitable, the court will issue it without reluctance or evasion.[1] Though it

[4] That an injunction will not be granted where the device is needed for public use and the plaintiff can be otherwise protected, see Bliss *v.* City of Brooklyn (1871), 4 Fisher, 596; 8 Blatch. 533.

That an injunction will not be granted where it would occasion great public injury, unless in a case of absolute right, see Blake *v.* Greenwood Cemetery (1877), 13 O. G. 1046; 14 Blatch. 342; 3 Bann. & A. 112.

That an injunction will be denied where it would injure the public and not benefit the plaintiff, see Ballard *v.* City of Pittsburgh (1882), 12 Fed. Rep. 783.

That where the injunction would merely prevent the defendant from purchasing and using any fresh infringing articles it will not be withheld on the ground that the public will be inconvenienced, see Goodyear *v.* Railroad (1853), 1 Fisher, 626.

§ 1201. [1] In Poppenhusen *v.* N. Y. Gutta Percha Comb Co. (1858), 2 Fisher, 74, Ingersoll, J.: (76) "The writ prayed for is to act as a remedy against a threatened wrong, by preventing the commission of such wrong. And it is not necessary, before a writ to prevent a wrong issue, that the wrong should have actually been committed. If it were, the remedy by injunction would be a very inadequate one. When the rights of a party under a patent have been clearly and distinctly established, and an infringement of such rights is threatened, or when they have been infringed, and the party has good reason to believe they will continue to be infringed, an injunction will issue. It issues for the reason that there is good ground to believe that in future they will be infringed. And when a trial at law has been had, resulting in a verdict in favor of the patentee, in which the right to the improvement patented has been fully established to the satisfaction of the court, and the infringement of right made clear, such trial, resulting in such a verdict, is sufficient, without any other proof, to authorize the court to grant an injunction to prevent any future violation of right. Such trial, with such a result, affords sufficient proof that in future there will be an infringement unless such infringement is restrained by injunction." 4 Blatch. 184 (187).

Further, that where the validity of the patent is established, and the infringement by the defendant is clear, an injunction will be granted, see Foster *v.* Crossin (1885), 23 Fed. Rep. 400; Odorless Excavating Co. *v.* Lauman (1882), 12 Fed. Rep. 788; McWilliams

may work hardship to the defendant or to other parties, and though the defendant offers such security against future losses as the plaintiff may require, the infringement will not be permitted to continue to the manifest and injurious violation of the patent.[2] Nor can the defendant claim immunity

Mfg. Co. *v.* Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419; White *v.* Heath (1882), 22 O. G. 500; 10 Fed. Rep. 291; New York Grape Sugar Co. *v.* American Grape Sugar Co. (1882), 10 Fed. Rep. 835; 20 Blatch. 386; Steam Gauge & Lantern Co. *v.* Miller (1881), 8 Fed. Rep. 314; 20 O. G. 889; Cross *v.* Livermore (1881), 21 O. G. 130; 9 Fed. Rep. 607; Weeks *v.* Buffalo Scale Co. (1880), 11 Fed. Rep. 901; Kirby Bung Mfg. Co. *v.* White (1880), 17 O. G. 974; 1 Fed. Rep. 604; 1 McCrary, 155; 5 Bann. & A. 263; American Middlings Purifier Co. *v.* Christian (1877), 4 Dillon, 448; 3 Bann. & A. 42; American Shoe Tip Co. *v.* National Shoe Toe Protector Co. (1877), 11 O. G. 740; 2 Bann. & A. 551; Weston *v.* White (1876), 13 Blatch. 447; 2 Bann. & A. 364; Brown *v.* Hinkley (1873), 3 O. G. 384; 6 Fisher, 370; Chase *v.* Wesson (1873), 6 Fisher, 517; 4 O. G. 476; Holmes, 274; Robertson *v.* Hill (1873), 6 Fisher, 465; 4 O. G. 132; Wells *v.* Gill (1872), 2 O. G. 590; 6 Fisher, 89; Miller *v.* Androscoggin Pulp Co. (1872), 1 O. G. 409; 5 Fisher, 340; Holmes, 142; Mowry *v.* Grand St. & Newtown R. R. Co. (1872), 5 Fisher, 586; 10 Blatch. 89; McComb *v.* Ernest (1871), 1 Woods, 195; Thayer *v.* Wales (1871), 5 Fisher, 130; 9 Blatch. 170; American Nicholson Pavement Co. *v.* City of Elizabeth (1870), 4 Fisher, 189; Shelly *v.* Brannan (1870), 4 Fisher, 198; 2 Bissell, 315; Conover *v.* Mers (1868), 3 Fisher, 386; Goodyear *v.* Rust (1868), 3 Fisher, 456; 6 Blatch. 229; Hodge *v.* Hudson River R. R. Co. (1868), 6 Blatch. 165; Potter *v.* Whitney (1866), 3 Fisher, 77; 1 Lowell, 87; Goodyear *v.* Hills (1866), 3 Fisher, 134; Morris *v.* Lowell Mfg. (1866), 3 Fisher, 67; Doughty *v.* West (1865), 2 Fisher, 553; Potter *v.* Muller (1864), 2 Fisher, 465; Hussey *v.* Whitely (1860), 2 Fisher, 120; 1 Bond, 407; North *v.* Kershaw (1857), 4 Blatch. 70; Sickels *v.* Mitchell (1857), 3 Blatch. 548; Day *v.* N. E. Car Spring Co. (1854), 3 Blatch. 154; Goodyear *v.* Day (1852), 2 Wall. Jr. 283; Tracy *v.* Torrey (1851), 2 Blatch. 275; Gibson *v.* Van Dresar (1850), 1 Blatch. 532; Motte *v.* Bennett (1849), 2 Fisher, 642; Ogle *v.* Ege (1826), 4 Wash. 584; 1 Robb, 516; Isaacs *v.* Cooper (1821), 4 Wash. 259; 1 Robb, 332.

That whenever the plaintiff is found to be legally entitled to an injunction it is the duty of the court to grant it without evasion, see Blanchard *v.* Reeves (1850), 1 Fisher, 103.

That the court has no discretion to refuse an injunction where the patent has been established by a judgment and the infringement is clear, see Green *v.* French (1879), 16 O. G. 215; 4 Bann. & A. 169.

[2] In Morris *v.* Lowell Mfg. Co. (1866), 3 Fisher, 67, Lowell, J.: (69) "In granting or refusing a preliminary injunction, the court will carefully consider the situation of the parties. Its important office is to preserve the rights of the patentee pending the litigation of his title. If the title has already been fully established, or is otherwise so clear that no reasonable doubt of its validity remains, a court of equity would, in many cases, grant such an injunction as it would a final injunction notwithstanding the injury which

on the ground that the plaintiff infringes other patents, nor that other persons are engaged with him in the infringement of the plaintiff's patent, nor that he is under obligations to others which the injunction will compel him to disregard, nor that he owns the articles whose use or sale is held to be forbidden by the patent.[3] These circumstances, indeed, like the

might result to the defendant. But where there is no danger of loss to the plaintiff, and great loss will result to the defendant, the case must be substantially free from doubt to require such action."

That an injunction will issue though the injury to the defendant may be great, if the right of the plaintiff and the infringement are clear, see Hodge *v.* Hudson River R. R. Co. (1868), 6 Blatch. 165.

That where the injury to the plaintiff from refusing an injunction would be great, it may be granted, see Covert *v.* Curtis (1885), 25 Fed. Rep. 43.

That an injunction will issue where the plaintiff's right is clear, though it works hardship to the defendant and a conditional injunction would protect the plaintiff, see Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64.

That if the plaintiff's right is clear an injunction works no real hardship to the defendant, see Potter *v.* Schenck (1866), 3 Fisher, 82; 1 Bissell, 515.

That an injunction will be granted though it may cause injury to third parties, see Rumford Chemical Works *v.* Vice (1877), 11 O. G. 600; 14 Blatch. 179; 2 Bann. & A. 584.

That when the case is clear and the infringement proved the injunction will be granted without regard to private or public convenience, see Sickels *v.* Tileston (1857), 4 Blatch. 109.

That where the right is clear an injunction must issue whatever injury may result, see Morris *v.* Lowell Mfg. Co. (1866), 3 Fisher, 67; Potter *v.* Fuller (1862), 2 Fisher, 251.

That an injunction will issue where the plaintiff's loss by its refusal would far exceed the injury to the defendant by granting it, if the infringement is not disputed and acquiescence is proved, see Hat-Sweat Mfg. Co. *v.* Davis Sewing Mach. Co. (1887), 41 O. G. 1273; 32 Fed. Rep. 401.

That when the patent is valid and the infringement clear an injunction will be granted though bonds be offered, see McWilliams Mfg. Co. *v.* Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419; Tracy *v.* Torrey (1851), 2 Blatch. 275.

[8] That an injunction will not be refused on the ground that the plaintiff is violating some other patent, see Young *v.* Lippman (1872), 5 Fisher, 230; 2 O. G. 249; 9 Blatch. 277.

That an injunction will not be withheld in order to allow the defendant to fulfil a contract, since the contract is, in effect, only the apportioning of a license, which is not allowed, see Consolidated Fruit Jar Co. *v.* Whitney (1874), 10 Phila. 268; 1 Bann. & A. 356.

That when the defendant is a licensee, and is notified that the license was obtained by fraud, and asks the court to allow him to finish a contract, he must show that the contract was made before such notice was given, or an injunction will issue, see Consolidated Fruit Jar Co. *v.* Whitney (1874), 10 Phila. 268; 1 Bann. & A. 356.

That an injunction is not refused on the ground that the defendant owns the infringing articles, see Porter Needle Co. *v.* National Needle Co. (1883), 17 Fed. Rep. 536.

That an injunction will be more

preceding, may avail him where the principal questions are in doubt, or where the court, though disposed to allow the temporary injunction on the plaintiff's evidence, foresees that different conclusions may be reached upon the final hearing; but where the plaintiff's case is clear, and his injury is imminent, the court will never hesitate to grant the desired relief.[4]

§ 1202. Preliminary Injunction: Bond and Account Ordered in Lieu thereof.

Similar circumstances to those which lead the court to deny an injunction may induce it to modify the order, and require a bond and a continuing account from the defendant.[1]

readily granted against a merchant who merely sells the invention, than against a manufacturer who makes it, see Covert *v.* Curtis (1885), 25 Fed. Rep. 43.

[4] That an injunction will not be granted where final relief would on the same proofs be denied, see International Tooth Crown Co. *v.* Mills (1884), 22 Fed. Rep. 659; 30 O. G. 662; Parkhurst *v.* Kinsman (1847), 2 Halst. Ch. (N. J.) 600.

That an injunction will be refused if the patentee has never used the invention or permitted others to use it, see Hoe *v.* Knapp (1886), 27 Fed. Rep. 204; 36 O. G. 1244.

§ 1202. [1] That a bond may be ordered instead of an injunction, see Wetherill *v.* Passaic Zinc Co. (1872), 6 Fisher, 50; 2 O. G. 471; 9 Phila. 385; Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64.

That an injunction will be granted where infringement is probable and the patent has been sustained by the Supreme Court of the United States, unless the defendant gives a bond and keeps an account, see American Middlings Purifier Co. *v.* Christian (1877), 4 Dillon, 448; 3 Bann. & A. 42.

That where the patent is in doubt, though the infringement is clearly shown, an injunction may be refused and a bond ordered with an account to be taken at frequent periods, see New York Belting & Packing Co. *v.* Magowan (1884), 23 Fed. Rep. 596.

That a bond will be ordered instead of an injunction when the validity of the patent is in dispute, and has never been adjudged, and public acquiescence is denied and not proved, see Morris *v.* Shelbourne (1871), 4 Fisher, 377; 8 Blatch. 266.

That a bond will not be required of a defendant except in cases where an injunction would otherwise issue, see American Middlings Purifier Co. *v.* Atlantic Milling Co. (1877), 4 Dillon, 100; 3 Bann. & A. 168.

That a patentee, using the invention himself, has a right to an injunction, not merely a bond and account, see Consolidated Fruit Jar Co. *v.* Whitney (1874), 10 Phila. 268; 1 Bann. & A. 356.

That a motion to substitute a bond for an injunction in order that the defendant may fulfil his contracts will not be granted unless the plaintiff would be adequately protected thereby, see Westinghouse Air Brake Co. *v.* Carpenter (1887), 32 Fed. Rep. 545.

Thus where the patent is about to expire, or the plaintiff has been negligent in the assertion of his rights, or the legal remedy is adequate and the defendant responsible, or the invention has been so incorporated into the defendant's business that its extrication is impossible without causing him unwarrantable injury, or the defendant is a mere vendee whose manufacturer or vendor has not been attacked by the plaintiff, or facts and relations between the parties give rise to an equitable estoppel, or the practical effect of the injunction would be to destroy the value of other patents not in litigation, or an account and bond will afford temporary protection to the plaintiff, — in these cases, though his right cannot be questioned, the purposes of justice are accomplished when the payment of accruing damages and profits is secured.[2]

[2] That an injunction will be denied and a bond ordered where the patent has only six months to run, see Howe *v.* Morton (1860), 1 Fisher, 586.

That if a plaintiff has been negligent in enforcing his rights he is only entitled to compensation and future protection, and this can be secured by bond without an injunction, see Jones *v.* Merrill (1875), 8 O. G. 401 ; Goodyear *v.* Honsinger (1867), 3 Fisher, 147 ; 2 Bissell, 1.

That where the defendant's device is essential to his business, and is made under a later patent, an injunction will be refused and a bond ordered, though the plaintiff's patent is not disputed, if the defendant has acted in good faith, see United States Annunciator & Bell Telegraph Mfg. Co. *v.* Sanderson (1854), 3 Blatch. 184.

That an injunction will be refused and a bond ordered when the defendant has large capital invested and the plaintiff does not manufacture the invention, see Dorsey Harvester Revolving Rake Co. *v.* Marsh (1873), 6 Fisher, 387.

That a bond may be ordered where an injunction would do the defendant irreparable injury, see Eastern Paper Bag Co. *v.* Nixon (1888), 45 O. G. 1571.

That an account will be ordered instead of an injunction when the injunction would injure the defendant more than it would benefit the plaintiff, see McCreary *v.* Penn. Canal Co. (1880), 14 Phila. 441 ; 5 Fed. Rep. 367.

That a patentee should sue the infringing makers rather than their vendees, and when he attacks the latter first, a bond will be ordered rather than an injunction, see Irwin *v.* McRoberts (1879), 16 O. G. 853 ; 4 Bann. & A. 411.

That if the patentee has never used his invention or permitted others to use it, a bond will be ordered instead of an injunction, see Hoe *v.* Knapp (1886), 36 O. G. 1244 ; 27 Fed. Rep. 204.

That a bond may be ordered instead of an injunction where the patentee grants licenses, or does not use the invention, or is guilty of laches misleading the defendant, see Westinghouse Air Brake Co. *v.* Carpenter (1887), 32 Fed. Rep. 545.

That no injunction will be ordered where the plaintiff grants licenses, though an infringement is claimed and

A bond, when substituted in this manner for an injunction, should be sufficient in amount to cover all probable losses to the plaintiff, and the account must so describe the articles sold or used by the defendant that any person acquainted with the business can fix their value and compute their profits.[3]

the patent has been sustained by the courts, but a bond may be required, see McMillan *v.* Conrad (1883), 5 McCrary, 140; 16 Fed. Rep. 128; Greenwood *v.* Bracher (1880), 1 Fed. Rep. 856; 17 O. G. 1151; 5 Bann. & A. 302.

That a bond may be ordered instead of an injunction where the defendant is responsible and intends to contest the suit, see American Middlings Purifier Co. *v.* Christian (1877), 4 Dillon, 448; 3 Bann. & A. 42.

That where priority is doubtful, the plaintiff grants licenses, and the defendant is responsible, a bond will be ordered, see National Hat Pouncing Mach. Co. *v.* Hedden (1886), 38 O. G. 1128; 29 Fed. Rep. 147.

That where novelty is doubtful, a bond and account may be ordered, or an injunction may issue if the plaintiff gives bond, see Heysinger *v.* Dennison Mfg. Co. (1882), 15 Phila. 509.

That a bond may be ordered where a late decision of the Supreme Court renders the law of the case questionable, see Eastern Paper Bag Co. *v.* Nixon (1888), 35 Fed. Rep. 752.

That an injunction will be refused and a bond ordered when a licensor has sold the device at lower rates in self-defence against his licensee, who refused to pay royalties and also cut the price, though the infringement may be clear, see Washburn & Moen Mfg. Co. *v.* Scutt (1884), 22 Fed. Rep. 710.

That an injunction will be refused and a bond ordered when there are two patents, one valid and the other doubtful, and an injunction on the valid patent would operate as an injunction on the other, see Goodyear *v.* Hills (1866), 3 Fisher, 134.

That an injunction will be denied and a bond ordered where the defendant's machine embraces improvements which cannot be used without the original, see Howe *v.* Morton (1860), 1 Fisher, 586.

That an injunction will be denied and a bond ordered where the defendant's machine embraces valuable features not covered by the plaintiff's patent, see Stainthorp *v.* Humiston (1862), 2 Fisher, 311.

That a bond will be ordered and an injunction denied if the former answers the purpose as well, although the patent has been sustained by repeated judgments and the infringement is clear, see Blake *v.* Robertson (1873), 6 Fisher, 509; 11 Blatch. 237.

That an injunction will be refused and a bond ordered where there has been no adjudication, and no evidence is offered of the extent of public acquiescence, and no claim was made on the defendant for three years, but the patent is not denied and the infringement is clear, see Sykes *v.* Manhattan Elevator & Grain Drying Co. (1869), 6 Blatch. 496.

That a bond will be ordered rather than an injunction pending a writ of error in the Supreme Court, see Wells *v.* Gill (1872), 6 Fisher, 89; 2 O. G. 590.

[3] That the bond on an injunction should always be fixed at an amount sufficient to cover all possible damages, see Brown *v.* Shannon (1857), 20 Howard, 55.

That a monthly account ordered to

§ 1203. Preliminary Injunction: Who may be Enjoined: Public Corporations: Private Corporations: Copartners.

Any person, natural or artificial, who in the opinion of the court may be about to perpetrate or participate in an infringing act, or to derive a direct advantage from its performance, may be made defendant in an application for an injunction, and may be prohibited from committing or promoting the proposed infringement. A municipal corporation may be enjoined from practising the invention through its agents, or from permitting infringing contractors to violate the patent for its benefit.[1] Private corporations may be ordered to refrain from authorizing or accepting the results of an infringement; and the same prohibition may be extended to its stockholders or servants if they infringe jointly or aid in the infringement, although they are not liable for damages and profits.[2] The owner of a patent may enjoin his former partners after the dissolution of the firm, though during its continuance their right to use the invention was, by the partnership agreement, made equal to his own.[3]

be filed with the clerk need only so describe the articles that persons in the trade can determine their value in the market, and state the profits, see Wilder *v.* Gayler (1849), 1 Blatch. 511.

§ 1203. [1] That a city may be enjoined, see Bliss *v.* City of Brooklyn (1871), 4 Fisher, 596; 8 Blatch. 533.

That a city may be enjoined from permitting an infringing pavement to be laid by its contractors, see Elizabeth *v.* Pavement Co. (1877), 97 U. S. 126.

[2] That an injunction may restrain all persons, whether officers of a corporation or not, who are aiding in promoting the infringing sale or use, and whether they are liable for profits or damages or not, see American Cotton Tie Supply Co. *v.* McCready (1879), 17 O. G. 565; 17 Blatch. 291; 4 Bann. & A. 588.

That each stockholder of an infringing association is liable to be enjoined, and made a party to the suit, see Tyler *v.* Galloway (1882), 22 O. G. 1294; 13 Fed. Rep. 477; 21 Blatch. 66.

That officers of an infringing association are not liable to injunction unless they are stockholders, see Tyler *v.* Galloway (1882), 22 O. G. 1294; 13 Fed. Rep. 477; 21 Blatch. 66.

That defendants infringing in concert may be enjoined though they are stockholders and servants of a corporation, see Poppenhusen *v.* Falke (1861), 2 Fisher, 181; 4 Blatch. 493.

[3] That a patentee may enjoin his former partners after the firm is dissolved, see Pentlarge *v.* Beeston (1877), 14 Blatch. 352; 3 Bann. & A. 142.

§ 1204. Preliminary Injunction: Who may be Enjoined: Co-owners: Assignees: Licensees: Agents, etc.

An injunction may be granted at the instance of one owner of a patent against an infringing co-owner.[1] Where the patentee of an original invention and the inventor of an improvement obtain a joint re-issue, covering both inventions, each can restrain the other from using the improved invention except for their joint benefit.[2] The assignee of an enjoined infringer, taking his title with notice of the pending injunction, occupies toward the plaintiff the same position as his assignor, and is liable at once to be restrained, whatever injury he may thereby sustain.[3] Licensees who exceed the privileges conferred upon them by the license, or who practise the invention after repudiating their contract with the owner of the patent, may be enjoined from further wrongful acts;[4] though where a licensee transcends his rights through accident or mistake, and upon notice ceases to infringe, the court will ordinarily refuse to issue an injunction.[5] The licensee

§ 1204. [1] That an infringing co-owner is liable to the other owners like any other infringer, see Duke *v.* Graham (1884), 19 Fed. Rep. 647; Herring *v.* Gas Consumer's Association (1878), 9 Fed. Rep. 556; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253; and §§ 797, 913, and notes, *ante*.

[2] That when the patentee of an original invention and the inventor of an *improvement obtain a* re-issue, covering the two inventions in their joint names, each can enjoin the other from using the invention except for their joint benefit, see Duke *v.* Graham (1884), 19 Fed. Rep. 647.

[3] That a new party, taking under an infringer after injunction with notice, has the same rights in reference to the plaintiff as his vendor, and is not an independent infringer, but is liable at once to be enjoined, however great his loss, and cannot give a bond instead, see Parkhurst *v.* Kinsman (1848), 2 Blatch. 78.

That a grantee cannot be enjoined from selling within his territory, on the ground that his vendees take the articles elsewhere, see Hatch *v.* Hall (1884), 30 O. G. 1096; 22 Fed. Rep. 438.

[4] That a vendee may use the article purchased though it infringes another patent of the vendor, if it cannot be otherwise used, see Roosevelt *v.* Western Electric Co. (1884), 28 O. G. 812; 20 Fed. Rep. 724.

That an injunction will be granted against a licensee unless his acts are in accordance with his license, see Brooks *v.* Stolley (1845), 3 McLean, 523; 2 Robb, 281.

That a licensee will be enjoined if he uses the patent without paying his license fees, whether the license is voidable or not, and if he will not pay he must not use, see Day *v.* Hartshorn (1855), 3 Fisher, 32.

[5] That a licensee, who transcends his rights, may be enjoined unless he

of one joint-owner of a patent cannot be interfered with by another, unless his acts are an invasion of the rights of his own licensor.[6] The partner of a licensee enjoys the immunity bestowed on his copartner by the license, and is not subject to an injunction while the firm fulfils its obligations to the licensor.[7] Though a defendant proclaims himself to be the agent of another, he will be treated as a principal if the infringing article bears his name, and the other evidence points to him as the party primarily responsible for the infringement, and as such he will be enjoined.[8] Actual agents who sell infringing articles on behalf of their maker or owner are also liable to an injunction, although they have no interest in the vended articles nor in the proceeds of the sale.[9] Whether those who contribute to the infringing act by furnishing tools and materials therefor, in the due course of business and without participation in the act or its direct results, can be enjoined, is doubted; on principle, their connection with the infringement appears too remote to warrant the proceeding.[10]

acted under a misapprehension, and has ceased to infringe, see Wilson *v.* Sherman (1850), 1 Blatch. 536.

That a licensee to make a certain number of articles will not be enjoined until the whole number are made, see Aspinwall Mfg. Co. *v.* Gill (1887), 32 Fed. Rep. 702.

[6] That a licensee under one co-owner of the patent will not be enjoined at the suit of the other co-owner, see Clum *v.* Brewer (1855), 2 Curtis, 506.

[7] That where a firm being licensee assigned to one member, who used the invention in conjunction with a new party, an injunction against the new party will be refused, see Belding *v.* Turner (1871), 4 Fisher, 446; 8 Blatch. 321.

[8] That when an infringing article bears the name of the defendant, and the evidence points to him as the principal person engaged in its manufacture, he will be enjoined though he holds himself out as the agent of another, see McWilliams Mfg. Co. *v.* Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419.

[9] That a defendant who sells the device for its owner, and has no interest in it or in the sale, may be enjoined, see Maltby *v.* Bobo (1876), 14 Blatch. 53; 2 Bann. & A. 459.

That a salesman making a separate profit may be enjoined, though his employer is sued in another district, see Steiger *v.* Heidelberger (1880), 4 Fed. Rep. 455; 18 O. G. 1463: 18 Blatch. 426.

That defendants who sell as agents of a maker may be enjoined, and do not thereby sustain irreparable injury, see Potter *v.* Fuller (1862), 2 Fisher, 251.

[10] That whether a lessor can be enjoined from leasing his tools, etc., to an infringing lessee is doubted, see Starrett *v.* Athol Mach. Co. (1883), 14 Fed. Rep. 910; 23 O. G. 1729.

§ 1205. Preliminary Injunction: Who may be Enjoined: Defendant Ceasing to Infringe.

No injunction can be granted against a defendant whose interest in the infringing enterprise had expired before the filing of the application.[1] The presumption of an intention to infringe which arises from past infringements ceases when the defendant is no longer capable of violating the plaintiff's rights, and the probability of his regaining his former capacity is too slight to justify the issue of a prohibitory order. Where an infringer dies before or pending suit, there is no presumption that his personal representatives purpose to continue the infringement, and until they manifest that purpose they cannot be enjoined.[2]

§ 1206. Preliminary Injunction: Form of Application.

An application for a preliminary injunction pending a suit in equity may either be incorporated into the original bill or constitute a separate proceeding.[1] An injunction in aid of a suit at law must be applied for in an independent motion, as if it were the only equitable remedy required. In any case, however, the application must clearly state the plaintiff's right, and its intended violation by the defendant, and pray for the immediate interference of the court. In describing the right of the plaintiff the application must set forth the production of the invention by the patentee or his assignor, the issue of the patent, and the title of the plaintiff, in substantially the

§ 1205. [1] In Potter *v.* Crowell (1866), 3 Fisher, 112, Withey, J.: (115) "Where the injury is not only past, but cannot from the nature of the case be renewed or continued, no injunction would be granted; for the well-recognized principle should in such case prevail, that past injuries are not in themselves ground for injunction, and because the restraining power of a court of equity can only be evoked, not to remedy injuries already done, but to prevent injury." 1 Abbott 89 (91).

That an injunction will not issue against a defendant who, at the time of filing the bill, had parted with his interest in the infringing device, see Brammer *v.* Jones (1867), 3 Fisher, 340; 2 Bond, 100.

[2] That an injunction will not issue against personal representatives of a deceased infringer, unless they manifest an intention to infringe, see Draper *v.* Hudson (1873), Holmes, 208; 6 Fisher, 327; 3 O. G. 354.

§ 1206. [1] That pending suit an injunction may be obtained by supplemental bill, see *Allis v.* Stowell (1883), 23 O. G. 1033; 15 Fed. Rep. 242.

same manner as in an original bill for the recovery of damages or profits. It must allege that the plaintiff has himself practised the invention, and is at present in the enjoyment of his exclusive privilege except so far as the defendant or other infringers are concerned; and must set forth the judgments, public acquiescence, or equivalent facts, on which the presumption of his right is based.[2] In describing the threatened infringement of the defendant the particular acts intended must be specified, in order that the court may judge whether they are invasions of the patent, and are of sufficient consequence to warrant summary relief.[3] If the patent has expired, it must be averred that the alleged infringing articles were made during the term of the patent and in violation of its provisions.[4] It must also appear whether the infringement has already commenced or is merely apprehended. The application must be supported by the oath of the plaintiff, who must also swear that he or his assignor is the original inventor of the art or instrument protected by the patent.[5] The prayer for an injunction may be separately expressed, or may be inferred from the assertion of those facts which show that the plaintiff needs and has a right to such relief.[6] Where the

[2] That on a bill or motion for an injunction the averments must show former judgments sustaining the patent, or public acquiescence, or equivalent acts, see Gutta Percha & Rubber Mfg. Co. *v.* Goodyear Rubber Co. (1875), 3 Sawyer, 542; 2 Bann. & A. 212.

That it is sufficient in a bill to allege that the patent has been sustained in another Circuit court, that the defendant has infringed generally, and that the plaintiff has a patent, with a profert, see American Bell Telephone Co. *v.* Southern Telephone Co. (1888), 34 Fed. Rep. 803.

[3] That a motion for a preliminary injunction should set out the acts constituting the infringement so that the court may see whether the injunction is needed, general allegations not being sufficient, see Kirby Bung Mfg. Co. *v.* White (1880), 17 O. G. 974; 1 Fed. Rep. 604; 1 McCrary, 155; 5 Bann. & A. 263.

[4] That a bill to enjoin the use of the device after the patent expires, must aver that the device was made before it expired, see American Diamond Rock Boring Co. *v.* Rutland Marble Co. (1880), 2 Fed. Rep. 355; 18 Blatch. 147; 5 Bann. & A. 346.

[5] That the plaintiff seeking an injunction must swear that he is the inventor, his oath to his patent not being enough, see Sullivan *v.* Redfield (1825), 1 Paine, 441; 1 Robb, 477; Rogers *v.* Abbott (1825), 4 Wash. 514; 1 Robb, 465.

That false swearing in an affidavit, made before the bill is filed to be used on motion for an injunction, is perjury, see Baldwin *v.* Bernard (1872), 2 O. G. 320; 5 Fisher, 442; 9 Blatch. 509, note.

[6] That the plaintiff need not specially pray for an injunction if the bill shows a *prima facie* case for one, see Goodyear *v.* Mullee (1868), 3 Fisher, 420.

application is incorporated into the original bill the averments of the bill are regarded as relating to the application also, and therefore should not be repeated.[7] But where the application is an independent proceeding it must be complete in itself, and disclose all the matters upon which the court must pass in order to grant or to deny the temporary injunction.[8] New forms of apprehended infringement, discovered after the filing of the application, may be made the subject of a supplemental bill, and may be covered by the same injunction.[9]

§ 1207. Preliminary Injunction: Notice to Defendant of Application: Appearance: Answer.

Until the act of 1874 the Federal courts had no authority to grant injunctions without previous notice to the defendant, and a hearing on the points at issue if he so desired.[1] In cases of great emergency the court had power, under the act of 1872, to issue a restraining order against the defendant, pending the application for a preliminary injunction, which served all the purposes of an *ex parte* injunction, but without prejudice to the defendant on the merits of the application.[2] The act of 1874, however, has been interpreted as an abrogation of the rule requiring notice, and as therefore conferring on the Federal courts the general authority of courts of equity in reference to *ex parte* injunctions.[3] Whether this

[7] That where a bill was filed one week before the application for an injunction was made, the plaintiff, in his affidavit accompanying such application, need not renew his allegation that he believed the patentee to be the first inventor, see Young *v.* Lippman (1872), 2 O. G. 249; 5 Fisher, 230; 9 Blatch. 277.

[8] That matters not alleged in the bill cannot be urged as grounds for the injunction, see International Tooth Crown Co. *v.* Mills Co. (1884), 30 O. G. 662; 22 Fed. Rep. 659.

[9] That where a supplemental bill alleges new transactions of the defendant the injunction may be extended to them, see Parkhurst *v.* Kinsman (1848), 2 Blatch. 78.

§ 1207. [1] That no injunction will be granted without notice to the defendant and a chance to be heard on an answer, and proof and affidavits will be received on both sides, see Wilson *v.* Stolley (1847), 4 McLean, 272.

[2] Sec. 718, Rev. Stat.

[3] That since the act of June 22, 1874, no previous notice of a motion for an injunction is required, and the court may now grant an immediate restraining order to be in force till the motion is decided, see Yuengling *v.* Johnson (1877), 1 Hughes. 607; 3 Bann. & A. 99.

departure from principles so long established will be ultimately sustained is doubtful, — the evils resulting from *ex parte* injunctions, especially in cases of infringement, being out of all proportion to the benefits obtained by an abandonment of the ancient practice. If notice is required, it must be reasonable in view of all the circumstances of the parties, but may be waived by the appearance of the defendant.[4] When he appears, he may in his answer admit the truth of the averments contained in the application, or traverse or avoid them, wholly or in part. The answer to an application for an injunction is subject to the same general rules as an answer to an original bill.[5] It confesses whatever it does not deny, and where its denial relates to any point involving the validity of the patent it must set forth the particular facts on which the denial rests.[6] If the defendant does not appear, the hearing will proceed *ex parte* on the application and the evidence presented by the plaintiff.[7]

§ 1208. Preliminary Injunction: Questions Arising on the Application.

Among the material questions arising on the hearing are: the nature of the invention; the standing of the plaintiff in the trade; the character and extent of the infringement; whether the defendant makes and sells or only uses the invention, — the former being an increasing wrong; the responsibility of the defendant for the damages and profits, if recovered; and the inconvenience to the respective parties of denying or allowing the injunction.[1] Whether the plaintiff can enjoy his

[4] That an injunction will issue where the defendant has actual notice of the motion and appears, though the service of the subpœna on him was irregular, see Thayer *v.* Wales (1871), 5 Fisher, 130; 9 Blatch. 170.

[5] That on a motion to grant or continue an injunction an answer to the bill for injunction, though filed without a rule, will be treated as an answer, see Brooks *v.* Bicknell (1843), 3 McLean, 250; 2 Robb, 118.

[6] That the defendant cannot allege, in reply to a motion for an injunction, a prior use in general on his knowledge and belief, but must set out particulars of the information on which his allegation rests, see Young *v.* Lippman (1872), 2 O. G. 249; 5 Fisher, 230; 9 Blatch. 277.

[7] That a motion for an injunction is an *ex parte* proceeding, see Potter *v.* Whitney (1866), 3 Fisher, 77; 1 Lowell, 87.

§ 1208. [1] In Furbush *v.* Bradford (1858), 1 Fisher, 317, Curtis, J.: (318)

own invention without invading other patents, and whether his conduct has misled the defendant where no fraud or estoppel can be claimed, are immaterial.[2]

§ 1209. Preliminary Injunction: Hearing: Production of Evidence.

The evidence on the hearing is presented by affidavits. Those of the plaintiff usually accompany the application; those of the defendant follow with his answer; and the plaintiff closes in rebutter, no reply on behalf of the defendant being permitted.[1] Each party is allowed a reasonable

"In acting on applications for temporary injunctions to restrain the infringement of letters-patent, there is much latitude for discretion. The application may be granted or refused unconditionally, or terms may be imposed on either of the parties as conditions for making or refusing the order, and the state of litigation, where the plaintiff's title is denied, the nature of the improvement, the character and extent of the infringement complained of, and the comparative inconvenience which will be occasioned to the respective parties, by allowing or denying the motion, must all be considered in determining whether it should be allowed or refused, and if at all, whether absolutely or upon some and what conditions."

See also § 1200, note 1, and § 1202 and notes, *ante*.

[2] That on a motion for an injunction the fact that the plaintiff cannot use his invention without infringing a prior patent is immaterial, the two questions being wholly distinct, see Young *v.* Lippman (1872), 2 O. G. 249; 5 Fisher, 230; 9 Blatch. 277.

That an injunction will be granted though not all the grants of right in a patent are infringed, see Potter *v.* Holland (1858), 1 Fisher, 382; 4 Blatch. 238.

That under Sec. 4921 an injunction issues irrespective of any right to profits or damages, or other relief, see Colgate *v.* International Ocean Telegraph Co. (1879), 17 O. G. 194; 17 Blatch. 308; 4 Bann. & A. 609; American Cotton Tie Supply Co. *v.* McCready (1879), 17 O. G. 565; 17 Blatch. 291; 4 Bann. & A. 588.

That an injunction will be granted though the plaintiff has misled the defendant, unless there were fraud or estoppel, see Sarven *v.* Hall (1873), 6 Fisher, 495; 4 O. G. 666; 11 Blatch. 295.

See also § 1195 and notes, *ante*.

§ 1209. [1] That on a motion for an injunction affidavits may be read on both sides as to the matters in controversy in the bill, see Brooks *v.* Bicknell (1843), 3 McLean, 250; 2 Robb, 118.

That on a motion for an injunction, if the defendant's facts as set up are insufficient, it is immaterial whether their statement is called and received as an affidavit or an answer, see Goodyear *v.* Mullee (1868), 3 Fisher, 420.

That the practice of treating an answer to a motion for a preliminary injunction, when denying the bill, merely as an affidavit is a departure from the the rules of courts of equity, see Parker *v.* Sears (1850), 1 Fisher, 93.

That on a motion for an injunction the plaintiff may rebut the defendant's affidavits by any proper evidence, see

time to inspect the affidavits of the other and to prepare his own, and evidence not thus submitted to inspection cannot be regarded by the court. The proper evidence in support of the patent is the patent itself, with its renewals and extensions, judgments sustaining it at law or equity, the acquiescence of the public in the exclusive possession of the plaintiff, and special injunctions against the defendant or other infringers.[2] The evidence of the plaintiff's title consists of the written instruments by which his legal interest was created, or the contracts or other circumstances which confer on him his equitable rights.[3] The evidence of intended infringement must cover both the acts of the defendant and the identity of his device or process with that protected by the patent, — the former being proved by his past conduct, threats, or preparations; the latter by judgments, expert testimony, or the personal inspection of the court.[4] The defendant's evidence may be drawn from judgments, records, or any matters of fact which controvert or weaken the presumptions raised by the proof offered by the plaintiff.[5]

Goodyear *v.* Mullee (1868), 3 Fisher, 420.

That where the defendant on a motion for an injunction sets up new matter, as license, etc., the plaintiff may reply with more proofs, but the defendant cannot put in additional evidence to rebut such proofs, see Day *v.* New England Car Spring Co. (1854), 3 Blatch. 154.

That affidavits filed after the stipulated date cannot be considered on a motion for an injunction, see American Paper Barrel Co. *v.* Laraway (1886), 28 Fed. Rep. 141; 37 O. G. 674.

[2] That a motion for an injunction may be supported by the following classes of evidence: (1) Letters-Patent; (2) Renewal of Patent; (3) Recovery in Equity; (4) Recovery at Law; (5) Possession and use; (6) Special injunctions against other parties; (7) Special injunctions against the present defendant, see Woodworth *v.* Rogers (1847), 3 W. & M. 135; 2 Robb, 625.

[3] That where the right of a plaintiff to an injunction depends on a written instrument the court will construe it, and grant or refuse an injunction accordingly, see Hodge *v.* Hudson River R. R. Co. (1868), 6 Blatch. 165; Clum *v.* Brewer (1855), 2 Curtis, 506.

[4] See § 1191 and notes, *ante*.

[5] That where the plaintiff, on a motion for an injunction, offers extracts from certain documents to support his claims, the defendant may offer the whole documents in evidence upon the subsequent trial, see Western Union Telegraph Co. *v.* Baltimore & Ohio Telegraph Co. (1885), 23 Blatch. 419.

§ 1210. Preliminary Injunction: Ex Parte Hearings: Burden of Proof.

When the hearing proceeds *ex parte*, through the failure of the defendant to appear and answer, if the plaintiff's affidavits show the issue of the patent and a judgment in its favor or an acquiescence by the public, and a probable infringement by the defendant, an injunction will issue though the court may have some doubt concerning the validity of the patent;[1] but if the patent is defective on its face, or the title of the plaintiff is uncertain, an injunction will be refused.[2] When the application is heard upon opposing evidence, and the plaintiff's affidavits make a *prima facie* case for an injunction, the defendant must present testimony sufficient to overcome the presumptions thus created, or prove the existence of other circumstances rendering the allowance of an injunction inexpedient.[3] The application will be decided on broad views of the equitable rights of the parties. The court, from the nature of the proceeding, can examine only far enough to ascertain whether the plaintiff has or has not an apparent title to protection, and cannot, therefore, enter into inquiries concerning difficult questions of law or the

§ 1210 [1] That an injunction will be granted almost of course if the patent has been sustained by a judgment and infringement is shown, see Wells *v.* Gill (1872), 6 Fisher, 89; 2 O. G. 590; Thayer *v.* Wales (1871), 5 Fisher, 130; 9 Blatch. 170.

That where there has been long enjoyment under the patent an injunction will be granted although a trial at law has already been ordered, see Brooks *v.* Norcross (1851), 2 Fisher, 661.

[2] That an injunction will be denied if the patent is defective on its face, see Isaacs *v.* Cooper (1821), 4 Wash. 259; 1 Robb, 332.

That although on a prior suit the Claims of the patent were held to be too broad and invalid, yet disclaimer being filed, and an infringement now shown, an injunction and account will be ordered, see Terry Clock Co. *v.* New Haven Clock Co. (1879), 17 O. G. 909; 4 Bann. & A. 121.

That where a patent has never been passed upon by the courts the first question on a motion for an injunction is whether there has been sufficient public acquiescence to raise a presumption in favor of the patent, see Guidet *v.* Palmer (1872), 6 Fisher, 82; 10 Blatch. 217.

That no injunction will issue to restrain a patentee, nor will equity otherwise interfere with him, unless the plaintiff has a patent, see Hoeltge *v.* Hoeller (1870), 2 Bond, 386.

[3] That an injunction will be granted where the defence of prior use is not established, see Welling *v.* La Bau (1882), 12 Fed. Rep. 875.

That no injunction will be granted where validity and infringement are denied under oath unless the patent is sustained by a judgment or by long ac-

weight and value of conflicting evidence.[4] In some cases the absence of any right in the plaintiff is so clear that no further litigation will be permitted; in others, the matter is so doubtful that its determination is postponed until the final hearing; in others, though not entirely satisfied of the justice of the plaintiff's claim, the court allows the injunction, as on the whole more consonant with equity than its denial.[5]

§ 1211. Preliminary Injunction: Form and Scope of Injunction.

A preliminary injunction may contain a general or a limited prohibition, and may issue either alone or in connection with other special orders for relief.[1] When certain Claims of the patent are disputed, the injunction may be confined to those which are unquestionably valid; and when certain infringing articles already used by the defendant cannot be equitably enjoined, he may be forbidden to procure others and employ them.[2] When an injunction issues after the expiration of

quiescence, see Hovey *v.* Stevens (1846), 1 W. & M. 290; 2 Robb, 479. See also § 1199 and notes, *ante*.

[4] See § 1173 and notes, *ante*.

[5] That some cases are so clear that equity will not permit further litigation, while in others the plaintiff's rights so largely preponderate that he is entitled to an injunction whatever may be its consequences, see Morris *v.* Lowell Mfg. Co. (1866), 3 Fisher, 67.

That an injunction will not be denied for the non-joinder of parties, if the defendant is using the infringing device for purposes belonging exclusively to the plaintiff, see Bassett *v.* Malone (1880), 11 Fed. Rep. 801.

That a motion for an injunction is addressed to the discretion of the court, and the court may order an issue to the jury, see Ayling *v.* Hull (1865), 2 Clifford, 494.

That if the evidence on a motion for an injunction is conflicting the issue will be sent to a jury or master, to examine the device of the defendant and take further evidence and report, see Parker *v.* Hatfield (1845), 4 McLean, 61; Brooks *v.* Bicknell (1845), 4 McLean, 70.

Upon the entire matter of this paragraph, see §§ 1199, 1201, and notes, *ante*.

1211. [1] That an injunction is to protect the plaintiff without unnecessary injury to the defendant, and will be fitted to each case accordingly, see Kirby Bung Mfg. Co. *v.* White (1880), 1 Fed. Rep. 604; 17 O. G. 974; 1 McCrary, 155; 5 Bann. & A. 263.

That injunctions in the Federal courts vary with circumstances, and may be simple injunctions, or coupled with an order for a bond and account or for an account only, see Kirby Bung Mfg. Co. *v.* White (1880), 17 O. G. 974; 1 Fed. Rep. 604; 1 McCrary, 155; 5 Bann. & A. 263.

[2] That the defendant may be enjoined from infringing two Claims of the patent though other Claims are in dispute, see Colt *v.* Young (1852), 2 Blatch. 471.

That an injunction may issue on

the patent, it must be directed only against devices constructed while the patent was in force.[3] An injunction may be granted unconditionally, or upon such terms as the court may see fit to impose.[4] Where there is doubt in reference to its propriety, the plaintiff may be compelled to secure the defendant against the injury caused by the injunction by a bond of indemnity payable if the injunction should appear upon the final hearing to have been unwarranted.[5] In allow-

valid Claims though other Claims are not disclaimed, see Duff *v.* Calkins (1883), 25 O. G. 601.

That an injunction may be granted forbidding the employment of any other devices than those already in use, see Colgate *v.* Gold & Stock Telegraph Co. (1879), 16 O. G. 583; 16 Blatch. 503; 4 Bann. & A. 415.

[3] In American Diamond Rock Boring Co. *v.* Rutland Marble Co. (1880), 2 Fed. Rep. 356, Wheeler, J.: (356) "It is argued for the defendants that to continue the restraint upon such machines after the expiration of the term of the patent is in effect to extend the term of the patent. The grant to the patentee was of the exclusive right to make, use, and vend to others to be used, the invention during the term. The right to exclude others from making, using, and selling was the essential thing, and really all that was granted. He had the right to do all these himself, to any extent, without the grant. The exclusive right was his property. Any making for use during the term was taking from him what belonged to him. To permit any others to make or produce such machines during the term, and hold them till the expiration and then use them freely, as if made after, would be to permit them to make off with so much of his property that the law had guaranteed to him. To restrain the use after the term, without his consent, gives nothing to him that he was not entitled to, and takes nothing from them that they had any right to. It gives him no right acquired beyond his term, and merely secures to him the full right he was entitled to during the term. The law would be open to reproach if it would not allow a court of equity, by its usual methods, in a case properly before it to accomplish a result so just." 18 Blatch. 146 (146); 5 Bann. & A. 345 (345).

That an injunction prohibiting the use of a combination of old elements does not prevent the making and use of such combination after the patent expires, see Johnson *v.* Brooklyn & C. R. Co. (1888), 37 Fed. Rep. 147.

[4] That the court has a wide latitude in granting preliminary injunctions, and may order or refuse them either unconditionally or on terms, see Furbush *v.* Bradford (1858), 1 Fisher, 317.

[5] That an injunction will not be ordered without a bond from the plaintiff when his right is vague and the defendant might be injured, see Blake *v.* Boisselier (1880), 16 O. G. 854; 5 Bann. & A. 352.

That if the defendant is also an inventor he may claim bonds from the plaintiff to secure him against loss in case the plaintiff's suit fails or the injunction proves to be improper, see Consolidated Fruit Jar Co. *v.* Whitney (1874), 10 Phila. 268; 1 Bann. & A. 356.

That where an injunction issues upon the filing of a bond by the plaintiff and the defendant prevails he can sue on the bond, see Tobey Furniture Co. *v.* Colby (1888), 35 Fed. Rep. 592.

ing an injunction by consent, after the withdrawal of the defendant's opposition, the court will not pass on any question connected with the merits of the controversy, for the purpose of influencing future litigation.[6]

§ 1212. Preliminary Injunction: Effect of Injunction.

An injunction takes effect according to its terms, and operates only upon the persons and the actions named therein.[1] It remains in force as long as the patent is capable of infringement, unless previously recalled by the court or superseded by some other judgment in the suit.[2] It has no authority over acts or individuals beyond the local jurisdiction

See this case also for a rule of damages on such a bond.

That pending a suit against an infringing seller the plaintiff may be enjoined from suing the defendant's vendees, see Ide *v.* Ball Engine Co. (1887), 31 Fed. Rep. 901 ; 41 O. G. 1271.

That when there is a pending suit against the maker of a device the defendant may enjoin the plaintiff from suing the defendant's vendees though the plaintiff is not in the district where the injunction issues, as the court has jurisdiction over him through the pending suit, but the defendant must give bonds to secure the plaintiff, see Birdsell *v.* Hagerstown Agricultural Implement Mfg. Co. (1877), 1 Hughes, 64 ; 11 O. G. 641.

That until damages are paid by the maker no injunction will issue to restrain the patentee from pursuing the vendee and user, see Tuttle *v.* Matthews (1886), 28 Fed. Rep. 98 ; 36 O. G. 694 ; Fisher *v.* Consolidated Amador Mine Co. (1885), 11 Sawyer, 190 ; 25 Fed. Rep. 201.

That a patentee will not be enjoined from suing at law if the bill for an injunction shows a good defence at law, see Hapgood *v.* Hewitt (1886), 119 U. S. 226 ; 37 O. G. 1247.

[6] That no decision will be rendered for the mere purpose of affecting other cases, see American Middlings Purifier Co. *v.* Vail (1878), 15 Blatch. 315 ; 4 Bann. & A. 1.

§ 1212. [1] That an injunction must be restricted to the things named therein, see Welling *v.* Rubber Coated Harness Trimming Co. (1875), 7 O. G. 608 ; 2 Bann. & A. 1.

[2] That an injunction will remain in force as long as it may be needed, see Singer Sewing Mach. Mfg. Co. *v.* Union Button-Hole & Embroidery Co. (1873), 4 O. G. 553 ; 6 Fisher, 480 ; Holmes, 253.

That an injunction can run only during the life of the patent and should be so limited, see Nathan *v.* New York Elevated R. R. Co. (1880), 2 Fed. Rep. 225 ; 5 Bann. & A. 280.

That where the date of the expiration of the patent is in dispute the court will not limit the injunction, but the defendant can move for a dissolution when the date at which he claims the patent must expire has arrived, see Westinghouse Air Brake Co. *v.* Carpenter (1887), 32 Fed. Rep. 545.

That an injunction forbidding the use of an infringing machine does not expire with the patent, see American Diamond Rock Boring Co. *v.* Rutland Marble Co. (1880), 2 Fed. Rep. 356 ; 18 Blatch. 146 ; 5 Bann. & A. 345.

of the court, except when the defendant resides within the district and hence can there be held accountable for his infringements wherever they may be committed.[3] It may be modified from time to time, on application to the court, as the interests of the parties may require; and if it lapses through the surrender of the patent for re-issue, it may be continued under the re-issue by an order granted on a supplemental bill.[4] It may also be suspended temporarily in public emergencies, or when extraordinary necessity arises outside the private interests of the defendant.[5]

[3] That a defendant residing and infringing in one district cannot be enjoined by the court of another, such injunction being ineffective, see Goodyear *v.* Chaffee (1855), 3 Blatch. 268.

That process runs against the person, and the court will award it though it may give the plaintiff no effectual relief, and though the defendant may evade its operation, see Thompson *v.* Mendelsohn (1871), 5 Fisher, 187.

That a defendant who is within the jurisdiction may be enjoined though his acts are performed without it, see Boyd *v.* McAlpine (1844), 3 McLean, 427; 2 Robb, 277.

That a court can restrain the use of the invention in another district if it once obtains jurisdiction over the defendant's person; but if it is necessary to proceed against the infringing device the court can only act in the district where the device is located, see Wilson *v.* Sherman (1850), 1 Blatch. 536.

That where use in one district is shown the plaintiff is entitled to an account for all infringements by making, using, or selling in that district, and to an injunction against further infringements there, see Locomotive Engine Safety Truck Co. *v.* Erie R. R. Co. (1872), 3 O. G. 93; 10 Blatch. 292; 6 Fisher, 187.

That the citizenship of the infringer within the district where the suit is brought gives the right to proceed in such district against *him personally* to prevent infringement elsewhere, see Hatch *v.* Hall (1884), 22 Fed. Rep. 438; 30 O. G. 1096.

That if a motion for an injunction is heard outside the district where the suit is pending the order will not issue until the court is sitting within the district, see Putnam *v.* Weatherbee (1875), 8 O. G. 320.

[4] That an injunction can be modified where the court deems it proper, see De Florez *v.* Raynolds (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140; Goodyear *v.* Honsinger (1867), 3 Fisher, 147; 2 Bissell, 1.

That an injunction may be continued under a re-issue by a supplemental bill, see § 1122, notes 8–10, *ante*.

[5] That a motion to suspend the issue of an injunction will be denied where it does not appear from the affidavits that the infringement will cease, see Macaulay *v.* White Sewing Mach. Co. (1881), 21 O. G. 204.

That neither the fact that the patent has but a year to run, nor the fact that the defendants have made contracts while aware of their liability to the plaintiff, is sufficient reason for suspending an injunction and allowing the infringement to continue, see Brown *v.* Deere (1881), 19 O. G. 1217; 6 Fed. Rep. 487; 2 McCrary, 425. See also § 1221 and note 2, *post*.

§ 1213. Preliminary Injunction: Dissolution of Injunction.

A preliminary injunction may be dissolved by the court whenever it appears that its continuance would no longer serve the purposes for which it was originally granted. Where the evidence taken on the merits before the jury or the master shows that the patent is invalid, or the plaintiff without title, or the acts of the defendant justifiable, and, therefore, that upon the final hearing defeat awaits the plaintiff, the court will recall the order and deliver the defendant from its prohibitions.[1] Upon the application for a dissolution the defendant has the burden of proof, and if the injunction were granted on the oath of the plaintiff that he was the first inventor, fortified by the patent, judgments, acquiescence, and the issue of former injunctions, only the most conclusive evidence can prevail upon the court to reverse its former decree.[2]

§ 1213. [1] That a temporary injunction will not be dissolved after the evidence is in unless the defendant has made out a defence, see Union Paper Bag Mach. Co. *v.* Newell (1874), 5 O. G. 459; 11 Blatch. 549 ; 1 Bann. & A. 113.

That an injunction will be dissolved on evidence showing that the device was known in the United States before the patent, and on the production of the device itself, see Young *v.* Lippman (1872), 5 Fisher, 230 ; 2 O. G. 249 ; 9 Blatch. 277.

That where it appears that the defendant acts under a license from the plaintiff the injunction will be dissolved, see Goodyear *v.* Bourn (1855), 3 Blatch. 266.

That if the evidence shows that on the final hearing the plaintiff's patent will not be defeated, a motion to dissolve an injunction will be denied, see Richardson *v.* Croft (1880), 11 Fed. Rep. 800.

That evidence which would prevent the issue of an injunction should be sufficient to dissolve it, see Cary *v.* Domestic Spring Bed Co. (1886), 26 Fed. Rep. 38 ; 34 O. G. 1158.

That an injunction will be dissolved on new evidence raising grave doubts as to the validity of the patent, see Cary *v.* Domestic Spring Bed Co. (1886), 26 Fed. Rep. 38 ; 34 O. G. 1158.

[2] That on a motion to dissolve the injunction the defendant must overcome the equity of the bill and the evidence in its support, see Hussey *v.* Whitely (1860), 2 Fisher, 120 ; 1 Bond, 407 ; Sparkman *v.* Higgins (1846), 1 Blatch. 205.

That on a motion to dissolve the court must weigh the evidence, and if the balance is in favor of the plaintiff continue the injunction and allow an action at law to be brought, see Woodworth *v.* Rogers (1847), 3 W. & M. 135 ; 2 Robb, 625.

That where the defendants in equity dispute the validity of the patent, a suit at law must be brought at the next term, or the pending injunction will be dissolved, and on such suit the trial will be confined to the objections set up in the answer and affidavit, see Woolworth *v.* Edwards (1847), 3 W. & M. 120 ; 2 Robb, 610.

That an injunction ordered upon the

An injunction will not be dissolved on the ground of hardship to the defendant when he knowingly infringed, nor on account of a conditional license granted to him by the plaintiff, nor for informality in the notice if the defendant actually appeared, nor on doubts as to the powers of officials in the Patent Office when legislation is pending to remove them, nor on the same evidence which induced the court to grant it, nor on new evidence improperly omitted in the former hearing or which would have been rejected for want of proper allegations in the answer.[3] A dissolution may be ordered on the filing

oath of the patentee that he was the original inventor, the grant of the patent, an undisturbed enjoyment of exclusive rights, judgments sustaining the patent, and the issue of former injunctions, will not be dissolved unless the patent is impeached by most conclusive evidence, see Hussey *v.* Whitely (1860), 2 Fisher, 120; 1 Bond, 407.

That if the defendant's motion leaves no doubt that the patent is invalid, an injunction will be dissolved, see Hussey *v.* Whitely (1860), 2 Fisher, 120; 1 Bond, 407.

[3] That an injunction will not be dissolved on the ground that it is a hardship to the defendant, when he was not ignorant of the plaintiff's invention, see Hussey *v.* Whitely (1860), 2 Fisher, 120; 1 Bond, 407.

That an injunction by consent is not invalidated by granting a conditional license, see *Pentlarge v. Beeston* (1880), 1 Fed. Rep. 862; 18 Blatch. 38; 5 Bann. & A. 323.

That on a motion to dissolve an injunction, for informality in serving notice of the motion for injunction, the informality is considered as cured by the appearance of the defendant, see Brammer *v.* Jones (1867), 3 Fisher, 340; 2 Bond, 100.

That an injunction will not be dissolved on doubts as to the powers of officers in the Patent Office when legislation is pending to remove them, see Woodworth *v.* Hall (1846), 1 W. & M. 389; 2 Robb, 517.

That an injunction will not be dissolved on the same facts which induced another judge to grant it, see Hussey *v.* Whitely (1860), 2 Fisher, 120; 1 Bond, 407; Woodworth *v.* Rogers (1847), 3 W. & M. 135; 2 Robb, 625.

That the defendant cannot offer, on a motion to dissolve, the facts which he neglected to present on the motion for an injunction, unless his excuses are very satisfactory, see National School Furniture Co. *v.* Paton (1879), 16 Blatch. 563; 4 Bann. & A. 432; Woodworth *v.* Rogers (1847), 3 W. & M. 135; 2 Robb, 625.

That an injunction will not be dissolved after long delay on the ground that the patented invention is described in a prior patent to the plaintiff, see Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co. (1887), 31 Fed. Rep. 562; 40 O. G. 1242.

That where an answer alleges no names or residences of persons having prior knowledge, and no abandonment, but mere prior use generally, and the plaintiff having taken proofs and the defendant having taken none a preliminary injunction is granted, and the defendant without asking leave to amend his answer and after the time for taking proof has expired moves to dissolve the injunction on affidavits of prior use and abandonment, the motion will be denied

of the answer if its denial of validity or infringement is supported by sufficient *prima facie* evidence and no rebutting testimony is offered by the plaintiff.[4]

§ 1214. Preliminary Injunction: Obligation of Defendant to Obey.

An injunction, whether granted on an *ex parte* or a contested hearing, or by consent, is binding on the defendant, and must be obeyed until rescinded by the court.[1] The defendant has no right to construe it for himself, ceasing to use what he imagines is forbidden and continuing to employ the residue, but must desist wholly from the practice of the invention, and if he needs further instructions must make application for them to the court.[2] He cannot be permitted to experiment with other arts or instruments to see how nearly he can imitate the plaintiff's yet still escape infringement; and though he acts under the advice of counsel his liability to punishment for disobedience to the injunction will not be

because the defendant cannot avail himself of these facts at the final hearing, see Union Paper Bag Mach. Co. *v.* Newell (1874), 11 Blatch. 549; 1 Bann. & A. 113; 5 O. G. 459.

[4] That if the answer denies the validity of the patent and is supported by evidence, the injunction will be dissolved unless counter evidence is filed, see Woodworth *v.* Rogers (1847), 3 W. & M. 135; 2 Robb, 625.

That an injunction will not be dissolved upon a mere answer denying validity, if it were granted on proof of long possession and former judgments, but will be continued and a suit at law ordered, see Orr *v.* Merrill (1846), 1 W. & M. 376; 2 Robb, 331; Orr *v.* Littlefield (1845), 1 W. & M. 13; 2 Robb, 323.

That an injunction vacated on the ground that the patent being limited by a foreign patent had expired therewith, and then restored upon such foreign patent being declared void, may be again vacated if the judgment repealing the patent is reversed, see Bate Refrigerating Co. *v.* Gillett (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

§ 1214. [1] That a preliminary injunction is not to be violated though the patent is invalid or the injunction was improperly granted, but must be obeyed until dissolved, see Phillips *v.* City of Detroit (1877), 16 O. G. 627; 2 Flippin, 92; 3 Bann. & A. 150.

[2] That after an injunction issues the defendant has no right to stop using what he considers an infringement and use the rest, but must obey the order as it is granted and ask the court for further instructions if he needs them, see Hamilton *v.* Simons (1869), 5 Bissell, 77.

That where an injunction was broader than was intended the defendant, on being served with notice thereof, should take immediate measures to have it set aside, and not wait to object until a motion for attachment, see Sickels *v.* Borden (1857), 4 Blatch. 14.

diminished.[3] His own good faith affords him no protection, and while the court may consider it in affixing the penalty for his contempt, his violation of the injunction is complete if he intends to do and actually does the act which it prohibits, however fully he may have believed his conduct to have been consistent with submission to its terms.[4]

§ 1215. Preliminary Injunction: How Violated.

An injunction is violated by the participation of the defendant *in any manufacture, use, or sale of the invention*, contrary to the language or the spirit of the prohibition. No cover or subterfuge affords immunity, if the effect resulting from his acts is that which the injunction is intended to prevent. An injunction forbidding the defendant to make the invention is disobeyed whether he manufactures it as principal or agent or mere workman, and whether he completes it or, having par-

[3] That an injunction is to be obeyed whether the court is right or not, and the defendant cannot experiment to see how near he can come to an infringement and still escape, see Craig *v.* Fisher (1873), 2 Sawyer, 345.

That the advice of counsel is no excuse for contempt, for counsel have no right to advise, it being the duty of the court alone to construe the injunction, see Bate Refrigerating Co. *v.* Gillett (1887), 30 Fed. Rep. 683; Burr *v.* Kimbark (1887), 29 Fed. Rep. 428; 40 O. G. 246; Matthews *v.* Spangenberg (1883), 23 O. G. 1624; 15 Fed. Rep. 813; Hamilton *v.* Simons (1869), 5 Bissell, 77; Goodyear *v.* Mullee (1867), 3 Fisher, 209; 5 Blatch. 429.

That mistake in construing his license will not excuse the violation of an injunction by the licensee, see Iowa Barb Steel Wire Co. *v.* Southern Barbed Wire Co. (1887), 40 O. G. 578; 30 Fed. Rep. 615.

[4] In Atlantic Giant Powder Co. *v.* Dittmar Powder Mfg. Co. (1881), 20 O. G. 1380, Blatchford, J.: (1380) "The injunction in this case forbade the making, using, or selling certain powders described in it, and any powder substantially like any of said designated powders, and any infringement of said patent. What the defendants did, they did not do accidentally or unintentionally, but knowing fully what they did. They were therefore guilty of contempt. What they did is not the less legally a contempt because they did not think they were infringing or were advised that they were not. Any question of *animus* can bear only on the extent of punishment." 9 Fed. Rep. 316 (317).

That good faith, ignorance of law, and advice of counsel may affect the penalty, though they cannot excuse the violation of the injunction, see Morss *v.* Domestic Sewing Mach. Co. (1889), 38 Fed. Rep. 482; Bate Refrigerating Co. *v.* Gillett (1887), 30 Fed. Rep. 683; Matthews *v.* Spangenberg (1883), 23 O. G. 1624; 15 Fed. Rep. 813.

That a mistake as to the legal effect of a contract may affect the penalty, see Iowa Barb Steel Wire Co. *v.* Southern Barbed Wire Co. (1887), 30 Fed. Rep. 615; 40 O. G. 578.

tially constructed it, sends it to other persons to be finished.[1] An injunction not to use is violated by the practice of an evasive process, by employing colorable variations though the defendant believed the difference to be essential, or by operating under another patent whose owner had, within the knowledge of the defendant, already been enjoined.[2] The use of articles covered by different patents and not obviously identical with the enjoined invention, if in good faith, is not a contempt of the injunction, nor is the employment of devices made after the plaintiff's patent had expired.[3] An injunction

§ 1215. [1] That an injunction is violated if the defendant works as an employee in a factory where the infringing articles are made, see Goodyear *v.* Mullee (1867), 3 Fisher, 209; 5 Blatch. 429.

That parties enjoined are guilty of contempt, if they combine with others to encourage and defend infringers in their infringing acts, and in their denial of the validity of the patent, see Bate Refrigerating Co. *v.* Gillett (1887), 30 Fed. Rep. 683.

That a defendant, parting with his interest in the infringing business during suit, but without change of parties on the record, is bound by the decree, see Gloucester Isinglass & Glue Co. *v.* Le Page (1887), 30 Fed. Rep. 370.

That an injunction against making an invention is violated by partially making it and sending it to others to be completed, see Knowles *v.* Peck (1875), 42 Conn. 386.

[2] That a defendant violates an injunction by practising an evasive process, see Wetherell *v.* New Jersey Zinc Co. (1874), 5 O. G. 460; 1 Bann. & A. 105.

That an injunction is violated by the use of colorable variations though the defendant supposes the variations are substantial, see Atlantic Giant Powder Co. *v.* Dittmar Powder Mfg. Co. (1881), 20 O. G. 1380; 9 Fed. Rep. 316.

That a party under injunction is guilty of contempt if he uses another patent similar in principle, whose author had also been enjoined, and he can purge himself only by showing that he did not know of the injunction against its author, see Woodworth *v.* Rogers (1847), 3 W. & M. 135; 2 Robb, 625.

That it is a violation of the injunction to make articles embodying the same principle though varying in form, see Burr *v.* Kimbark (1887), 40 O. G. 246; 29 Fed. Rep. 428.

[3] That an injunction is not violated by the use of articles covered by different patents unless the articles are obviously the same, see Buerk *v.* Imhaeuser (1876), 11 O. G. 112; 2 Bann. & A. 465.

That to use a separately claimed part of the invention is a contempt, see Matthews *v.* Spangenberg (1883), 23 O. G. 1624; 15 Fed. Rep. 813.

That an injunction forbidding the use of devices made during the patent is not violated by the use of those made after the patent has expired, see American Diamond Rock Boring Co. *v.* Sutherland Falls Marble Co. (1880), 2 Fed. Rep. 353; 5 Bann. & A. 347; 18 Blatch. 148.

That the injunction is not violated unless the thing used is the patented invention, see Fetter *v.* Newhall (1884), 28 O. G. 285; 20 Fed. Rep. 113.

not to sell is disobeyed by any act which has the legal import of a sale. *An agreement to sell, without delivery or an intention to deliver, is not contempt.*[4] But any transaction which passes the ownership of the forbidden articles from the defendant to another person, whether alone or incorporated into other articles, whether under the form of a sale, a barter, a mortgage, or a judgment, whether the defendant acts as principal or agent, and whether the articles were made or procured before or after the grant of the injunction, if voluntarily entered into and performed by the defendant, is a defiance of the prohibition.[5] It is also a contempt of the injunction for the defendant to permit others to make or use or sell, contrary to its terms, on his behalf, or to confirm or recognize an agreement made before the allowance of the order, but whose execution the injunction now forbids.[6]

§ 1216. Preliminary Injunction: By Whom Violated.

An injunction may be violated, not only by the acts of the defendant himself, but by those of other persons who are rep-

[4] That a preliminary injunction is not violated by an agreement to sell without delivery or intent to deliver, see McKay *v.* Scott Sole Sewing Mach. Co. (1881), 20 O. G. 372.

[5] That where after the injunction the defendant took old devices, which were sold under the patent, and put them into his machines and sold the whole together, it was a contempt, see Craig *v.* Fisher (1873), 2 Sawyer, 345.

That where *infringing devices* were sold before the injunction, and were afterward returned to the defendant and again sold by him, there was probably a technical violation of the injunction unless the devices were included in the accounting, or had been paid for, see Allis *v.* Stowell (1881), 19 O. G. 727.

That a defendant, appearing and being enjoined against making and selling, violates the injunction by selling outside the jurisdiction of the court, whether the articles sold were ever in its jurisdiction or not, see Macaulay *v.* White Sewing Mach. Co. (1881), 9 Fed. Rep. 698; 21 O. G. 496.

That where a defendant who has been enjoined continues to sell either in his own name or as agent he is guilty of contempt, see Potter *v.* Muller (1865), 2 Fisher, 631; 1 Bond, 601.

That an injunction is violated by an agreement to furnish and the actual furnishing of an infringing device, though it was made before the injunction was issued, see *Colgate v.* Gold & Stock Telegraph Co. (1879), 17 O. G. 193; 4 Bann. & A. 559.

[6] That an injunction may be violated by confirming or recognizing an agreement existing before the injunction, see Colgate *v.* Western Union Telegraph Co. (1879), 17 O. G. 194; 4 Bann. & A. 562.

That an enjoined defendant, carelessly omitting to notify his agents of the injunction, becomes guilty of a technical contempt if they still infringe, see Mundy *v.* Lidgerwood Mfg. Co. (1888), 34 Fed. Rep. 541.

resenting him or are under his control.[1] An injunction against a city binds its public boards if they have notice, though no service has been made on them as parties; and their conduct in contempt of the injunction renders both the corporation and themselves amenable to punishment.[2] If the officers of a private corporation continue the infringement after the grant of an injunction, or a son or servant practises the invention while the father or the master is enjoined, all are alike guilty of contempt, though the subordinates acted in obedience to orders.[3]

§ 1217. Preliminary Injunction: Application for Attachment for Contempt.

The remedy of the plaintiff for the violation of an injunction is by an application to the court for an order of attach-

§ 1216. [1] That an injunction is violated by allowing persons, over whom the defendants have official authority, to infringe, see Phillips *v.* City of Detroit (1877), 16 O. G. 627; 2 Flippin, 92; 3 Bann. & A. 150.

[2] That an injunction against a city binds its boards of public works, if they have notice, though no service is made on them as parties, see Phillips *v.* City of Detroit (1877), 16 O. G. 627; 2 Flippin, 92; 3 Bann. & A. 150.

[3] That officers of an infringing corporation, if personally enjoined, are liable for contempt, see Iowa Barb Steel Wire Co. *v.* Southern Barbed Wire Co. (1887), 30 Fed. Rep. 123; 40 O. G. 577.

That officers of a corporation, having been individually enjoined, are guilty of contempt if they afterwards infringe as managers of a different corporation, see Iowa Barb Steel Wire Co. *v.* Southern Barbed Wire Co. (1887), 30 Fed. Rep. 123; 40 O. G. 577.

That where the defendant was a corporation, and the managing president was the contriver of the infringing process, he was held liable for the contempt, see Wetherell *v.* New Jersey Zinc Co. (1874), 5 O. G. 460; 1 Bann. & A. 105.

That it is no defence to a motion for an attachment that the defendant was the servant of a corporation and obeyed orders, see Sickels *v.* Borden (1857), 4 Blatch. 14.

That where a father was enjoined, and his son, living with him and under his control, violated the injunction, the father was held for contempt though the son received and spent his own wages, but the son filing an agreement not to violate further, the father was not punished but compelled to pay the master's fee, see Dunks *v.* Grey (1880), 3 Fed. Rep. 862; 5 Bann. & A. 634.

That a servant or agent, separately sued, is not bound by a judgment against his principal, see Hayes *v.* Bickelhoupt (1885), 32 O. G. 136; 24 Fed. Rep. 806.

That the vendee of the defendant's infringing business, pending suit, is not bound by an injunction afterwards obtained, unless he were made a party to the suit, see Bate Refrigerating Co. *v.* Gillett (1887), 30 Fed. Rep. 685; 39 O. G. 833.

ment against the defendant, upon which, if found guilty, he may be subjected to fine or imprisonment. This application is collateral to the proceeding in which the preliminary injunction was granted, and may be made at any time when the misconduct of the defendant renders it necessary.[1] The affidavits accompanying the application must state the specific acts or omissions which constitute the alleged contempt, and any interrogatories addressed to the defendant must be confined to these particular offences.[2] The defendant is not obliged to answer to matters charged on information and belief, but may demur to improper interrogatories and recover costs. Upon the hearing on the application no new evidence can be received to vary the construction already given to the patent, nor can the defendant attack the validity of the injunction, nor the correctness of its interpretation by the court.[3] The only point at issue is the performance by the defendant of the forbidden acts, and these may be examined either by the court in person or through the aid of experts or other proper witnesses.[4] When the alleged violation of the

§ 1217. [1] That a motion for attachment for contempt will be granted without a new suit if an injunction is violated, see Wetherell *v.* New Jersey Zinc Co. (1874), 5 O. G. 460; 1 Bann. & A. 105.

That where a patent is fully discussed and understood on the trial, and the case is not closed, but an account is being taken, a motion for attachment for contempt may be made, see Higby *v.* Columbia Rubber Co. (1883), 18 Fed. Rep. 601.

[2] That the affidavits accompanying a motion for attachment must state the specific acts or omissions which constitute the contempt, and the interrogatories addressed to the defendant must be confined to these specific offences, but the defendant need not answer to matters charged on information and belief, and if he demurs to improper interrogatories he can recover his costs, see Parkhurst *v.* Kinsman (1848), 2 Blatch. 76.

[3] That on a motion for attachment for contempt no evidence can be admitted to vary the construction already given to the patent by the court, see Burdett *v.* Estey (1879), 16 Blatch. 105; 4 Bann. & A. 141.

That a party in contempt will not be heard on the injunction till he has purged himself of the contempt, see Ready Roofing Co. *v.* Taylor (1878), 15 Blatch. 94; 3 Bann. & A. 368.

That a defendant consenting to a decree and an injunction must obey the injunction until it is dissolved, and cannot attack it on proceedings for contempt, see Roemer *v.* Neumann (1883), 19 Fed. Rep. 98.

[4] That on a motion for an attachment the court may, at its discretion, examine the fact of infringement by itself or may have experts, but its decision on this question does not prejudice the parties on the accounting, see Burdett *v.* Estey (1879), 16 Blatch. 105; 4 Bann. & A. 141.

injunction consists in acts in some respects dissimilar to those described in the injunction, and a new question of identity between the defendant's art or instrument and the patented invention is thus presented, the matter cannot be investigated on the application for attachment, but requires new pleadings and new evidence in a supplemental bill or in a separate action.[5] A like necessity exists where the defendant acts under a new patent, or under a contract whose validity is contested in another court, or where the defendant's justification demands a re-examination of the scope and meaning of the plaintiff's patent.[6] An attachment is intended only for summary relief in cases where the single issue raised relates to the commission by the defendant of the prohibited acts of manufacture, use, and sale, and is not a proceeding in which collateral or fundamental questions can be considered and

[5] That where the infringement is in dispute that question cannot be tried on a motion for attachment for contempt, but only on pleadings and evidence in a new suit, see Temple Pump Co. *v.* Goss Pump & Rubber Bucket Mfg. Co. (1887), 31 Fed. Rep. 292; Putnam *v.* Hollender (1882), 11 Fed. Rep. 75; Bate Refrigerating Co. *v.* Eastman (1881), 11 Fed. Rep. 902; Liddle *v.* Cory (1865), 7 Blatch. 1.

That after a decree has been rendered in a pending suit the court will not determine on contempt proceedings whether an infringement actually exists, and if the infringement is in dispute a supplemental bill or a new one must be filed, see Allis *v.* Stowell (1883), 15 Fed. Rep. 242; 23 O. G. 1033.

That no attachment will issue where the defendant denies that he is using the plaintiff's process and the court below is divided on that point, see California Artificial Stone Paving Co. *v.* Molitor (1885), 113 U. S. 609; 31 O. G. 1044.

That equity will never proceed for contempt unless the violation of the injunction is clear and proven, and the question whether the device used actually infringes is always open for evidence, see Birdsell *v.* Hagerstown Agricultural Implement Mfg. Co. (1877) 11 O. G. 420; 1 Hughes, 59; 2 Bann. & A. 519.

That a motion for attachment for contempt will not be granted if the claim that the injunction has been violated raises a new question as to the construction of the patent, for on that question the defendant has a right to be heard, see Poppenhusen *v.* New York Gutta Percha Comb Co. (1859), 2 Fisher, 80; 4 Blatch. 253.

[6] That where the defendant is acting under a new patent granted since the injunction issued there can be no attachment for contempt but a new hearing must be had, see Wirt *v.* Brown (1887), 30 Fed. Rep. 187; Onderdonk *v.* Fanning (1880), 2 Fed. Rep. 568; 5 Bann. & A. 431.

That no attachment will be ordered while the validity of an agreement under which the injunction was obtained is disputed in a State court, see Pentlarge *v.* Beeston (1880), 1 Fed. Rep. 862; 18 Blatch. 38; 5 Bann. & A. 326.

decided. When these arise the court is forced to deny the application, and leave the plaintiff to pursue his remedy against the defendant by a supplemental or an independent action.

§ 1218. Preliminary Injunction: Order of Attachment: when Issued.

An order for attachment will not issue unless the violation of the injunction is clear, nor even then if the injunction was procured by strategy, and its violation was induced by the fraud of the plaintiff for the purpose of entrapping and punishing the defendant.[1] Where the plaintiff believes that the

§ 1218. [1] That no attachment will be granted for contempt when there is reasonable ground to doubt the wrongfulness of the defendant's conduct, see Bate Refrigerating Co. *v.* Gillett (1887), 30 Fed. Rep. 685; 39 O. G. 833; California Artificial Stone Paving Co. *v.* Molitor (1885), 113 U. S. 609; 31 O. G. 1044.

That a clear case must be made out in proceedings for contempt or the court will not punish, and the court must have no substantial doubt that the defendant intended to violate the injunction, see Allis *v.* Stowell (1881), 19 O. G. 727.

That no attachment will be granted for contempt unless it is proved indisputably that the infringement still continues, see Celluloid Mfg. Co. *v.* Chrolithian Collar & Cuff Co. (1885), 24 Fed. Rep. 585; Smith *v.* Halkyard (1884), 19 Fed. Rep. 602; 26 O. G. 1020.

That a bond given by the defendant to the plaintiff four months before the injunction, acknowledging the validity of the patent and the plaintiff's right to all that was covered by it, is not evidence of a breach of the injunction except so far as it admitted that the defendant had infringed and it might thence be presumed that he still did so, a presumption that could be removed by proof, see Byam *v.* Eddy (1853), 2 Blatch. 521; 24 Vt. 666.

That no attachment will be ordered against one who was not a party to the suit with notice of the injunction, see Sickels *v.* Borden (1857), 4 Blatch. 14.

That an attachment for contempt will not be granted unless notice of the motion has been served on the defendant, and the infringement complained of is committed either by him or by persons under his control, see Bate Refrigerating Co. *v.* Gillett (1885), 24 Fed. Rep. 696; 32 O. G. 1466.

That after an injunction is ordered upon condition that the plaintiff file a bond, the defendant, if present in court when such order was made, must take notice at his peril that the condition has been fulfilled, see Burr *v.* Kimbark (1887), 29 Fed. Rep. 428; 40 O. G. 246.

That knowledge that an injunction is ordered is equivalent to service as a ground for an attachment for contempt, see United Telephone Co. *v.* Dale (1884), L. R. 25 Ch. D. 778.

That where the plaintiff, having obtained an injunction, by strategy procures its violation by the defendant, and the defendant was innocent, no attachment will be ordered, see Sparkman *v.* Higgins (1846), 2 Blatch. 29.

That after an injunction has been

defendant is defying the prohibition of the court, he may obtain evidence against him by employing others to deal with him in the infringing enterprise, provided he resorts to no artifice or falsehood to secure the commission of the infringing acts; but where his conduct leads to the infringement he is estopped from urging it against the defendant as a contempt of court.

§ 1219. Preliminary Injunction: Penalty for Contempt.

A defendant, having been found guilty of contempt in violating an injunction, may be punished by fine or imprisonment, in the discretion of the court.[1] The amount of the fine is measured in ordinary cases by the damage which the plaintiff has sustained through the defendant's disobedience,[2] to which the costs and legal expenses incurred by the plaintiff on the application for attachment may be added.[3] The amount

granted, the patentee may send persons to buy of the defendant in order to see if he is violating the injunction, and such sending is not an implied license to the defendant to sell, see Knowles *v.* Peck (1875), 42 Conn. 386.

That the plaintiff may show that he believed the defendant was violating the injunction, and took this method to find out, see Knowles *v.* Peck (1875), 42 Conn. 386.

That the report of a person sent by the plaintiff for this purpose is privileged and is no ground for an action of slander, see Knowles *v.* Peck (1875), 42 Conn. 386.

§ 1219. [1] That the order adjudging the contempt need not aver that the injunction was lawful, nor recite the offence where the affidavits and reports filed do so and the order refers thereto, see Fischer *v.* Hayes (1881), 20 O. G. 601; 6 Fed. Rep. 63; 19 Blatch. 13.

[2] That where a preliminary injunction is violated the defendants are not obliged to pay a royalty, if they were acting in good faith and in an official capacity and were deriving no personal benefit from the violation, see Phillips *v.* City of Detroit (1877), 16 O. G. 627; 2 Flippin, 92; 3 Bann. & A. 150.

[3] In Doubleday *v.* Sherman (1870), 4 Fisher, 253, Blatchford, J.: (254) "The question in these cases is as to the extent of punishment to be awarded against the defendant, Boas, for his contempt of court in violating the injunction issued by the court. It is not contended that he ought not to pay the taxed costs, which are nine hundred and seventy-nine dollars and eleven cents, but opposition is made to the item of two thousand seven hundred and twenty-three dollars and seventy cents for solicitors and counsel fees, and disbursements, as ascertained and adjusted by the clerk under the order of the court. The incurring of such fees and disbursements was made necessary by the resistance which the defendant, Boas, made to the application for the attachment, and in the course of the proceedings before the master on the reference to take testimony as to the violation of the injunctions. The fact of the violation is established and that it

of these may be determined by the court, or by agreement, or by reference to a master for evidence and computation.[4] Where the defendant has acted in bad faith or contumaciously, the penalty may be increased according to his ill deserts.[5] In mitigation, on the other hand, the court may consider his pecuniary situation, or domestic difficulties, or the motive of the plaintiff in praying for the order.[6] A committal for non-payment is incidental to the judgment for a fine, and is entirely distinct from imprisonment as a specific

was wilful, although the master reports that the extent of the violation was not shown by the proofs offered before him. The fact that the extent of the violation is not shown, — that is, the extent to which the plaintiffs were injured by the violation, is not a good reason for withholding the allowance of counsel fees and disbursements, which were made necessary to establish the violation itself, although it is a good reason for not imposing on the defendant a further pecuniary fine by way of indemnity to the plaintiff." 8 Blatch. 45 (46).

[4] That in proceedings in equity for contempt, the fine may be imposed by an order made in the original suit, see Fischer *v.* Hayes (1881), 20 O. G. 601; 6 Fed. Rep. 63; 19 Blatch. 13.

That an order adjudging the contempt, and directing the amount of the penalty to be ascertained, does not exhaust the power of the court and may be followed by an order fixing the fine, see Fischer *v.* Hayes (1881), 20 O. G. 601; 6 Fed. Rep. 63; 19 Blatch. 13.

That a defendant being in custody under attachment for contempt, the case may be referred to the master as to the intention of the defendant, in order to aid the court in fixing the penalty, see Goodyear *v.* Mullee (1867), 3 Fisher, 259; 5 Blatch. 463.

[5] That where the defendant acts in bad faith the penalty for contempt will be severe, see Craig *v.* Fisher (1873), 2 Sawyer, 345.

That the penalty is measured in part by the perseverance of the defendant in his wrongful conduct, see Potter *v.* Muller (1865), 2 Fisher, 631; 1 Bond, 601.

[6] That in fixing the penalty for contempt the situation of the defendant pecuniarily and domestically may be considered, see Goodyear *v.* Mullee (1867), 3 Fisher, 259; 5 Blatch. 463.

That the defendant, to mitigate the penalty for contempt, may show his inability to pay, but it must be clearly proved, see Doubleday *v.* Sherman (1870), 4 Fisher, 253; 8 Blatch. 45.

That where the violation of an injunction is not wilful and the object of the motion for attachment is to find out whether the defendant really infringes, he is liable only for the profits or damages and the costs of the motion, see Ready Roofing Co. *v.* Taylor (1878), 15 Blatch. 94; 3 Bann. & A. 368; Schillinger *v.* Gunther (1877), 14 Blatch. 152; 11 O. G. 831; 2 Bann. & A. 544.

That where the defendant has acted in good faith the penalty should be confined to the injury sustained by the plaintiff and costs, or to costs only, see Iowa Barb Steel Wire Co. *v.* Southern Barbed Wire Co. (1887), 30 Fed. Rep. 615; 40 O. G. 578; Matthews *v.* Spangenberg (1883), 23 O. G. 1624; 15 Fed. Rep. 813.

penalty.[7] When the fine is paid there can be no commitment, or if paid after commitment the defendant is entitled to be released. Over the penalty itself the court has no authority after the term at which the judgment was rendered has expired, but it may at any time discharge a defendant whose confinement is contingent on his payment or ability to pay a fine.[8] The order for commitment may be suspended for appeal on giving bonds with surety to pay the fine whenever the court may vacate the suspension, and reasonable time to file the bond will be allowed.[9]

[7] In Fischer *v.* Hayes (1881), 20 O. G. 601, Blatchford, J. : (603) "It is suggested that section 725 provides for the punishment of a contempt by fine *or* imprisonment, and that therefore a commitment for non-payment of the fine is unlawful, because such commitment is imprisonment. There is, however, no commitment or imprisonment if the fine be paid. There is not commitment and fine. The punishment by a fine is fully inflicted under the terms of the order, if the fine be paid as the order directs, and in such case there can be no commitment. So, if there be a commitment for non-payment of the fine there must be a discharge as soon as the fine is paid. The payment of the fine is the punishment. The awarding or infliction of the fine is no punishment. The commitment is an incident of the fine. It is not in any manner the "imprisonment" allowed by the statute. The payment of the fine and a commitment for not paying it cannot co-exist. The commitment is not a separate punishment of imprisonment added to the payment of a fine. It is in this view that it has always been held that where a statute authorizes or prescribes the infliction of a fine as a punishment either for a contempt of court or for a defined offence it is lawful for the court inflicting the fine to direct that the party stand committed until the fine be paid, although there be no specific affirmative grant of power in the statute to make such direction." 19 Blatch. 13 (21); 6 Fed. Rep. 63 (71).

[8] That a contempt of court is a specific criminal offence and a fine is a judgment, see Fischer *v.* Hayes (1881), 20 O. G. 601; 6 Fed. Rep. 63; 19 Blatch. 13.

That the court has no power to vary the judgment for contempt after the term has expired, see Fischer *v.* Hayes (1881), 20 O. G. 601; 6 Fed. Rep. 63; 19 Blatch. 13.

That an order for commitment for contempt by failing to pay money is a civil order, not a criminal sentence, and may be revoked by the court if the defendant is unable to comply, see Hendryx *v.* Fitzpatrick (1884), 19 Fed. Rep. 810.

[9] That an order of commitment for non-payment of a fine on contempt may be suspended for appeal, on giving bond with surety to pay the fine whenever the court may vacate the suspension, and reasonable time to file such bond may be allowed, see Fischer *v.* Hayes (1881), 7 Fed. Rep. 96; 20 O. G. 672; 19 Blatch. 184. For a form for carrying the above order into effect, see the case cited.

That no appeal lies to the Supreme court on a contempt proceeding, see Hayes *v.* Fischer (1881), 102 U. S. 121.

That when a judgment in contempt

§ 1220. Perpetual Injunction: when Granted.

A perpetual injunction issues, as a matter of course, at the conclusion of a suit in equity, whenever the plaintiff has sustained the allegations of his bill, provided the patent has not then expired.[1] It is granted irrespective of his right to profits or damages or any other form of relief, and though the infringement ceased at the allowance of the preliminary injunction and has not been since renewed, unless the court is satisfied that no further violation of the patent can be committed by the defendant.[2] When one of several patents which are joined in the same action, or one Claim of the patent, is found valid and the others void, an injunction on the valid Claim or patent will be ordered.[3] Even although the patent has expired, if the infringing acts consist in the employment of articles made in defiance of the patent during its existence, an injunction against the use of these specific articles will be decreed.[4] If the patent terminates between the interlocutory and the final decree, the subsequent extension of the patent entitles its owner to the exercise of these preventive powers.[5] An assignee of the patent and of the damages for past infringements can also be protected by this equitable

involves a decision on the validity of the patent, the proceeding is reviewable in the Supreme court, and if reversed the interlocutory order in contempt may be reversed also, without prejudice to future proceedings, see Worden *v.* Searls (1887), 121 U. S. 14; 39 O. G. 359.

§ 1220. [1] That if a decree finds an infringement a perpetual injunction will be ordered, see Potter *v.* Mack (1868), 3 Fisher, 428; Goodyear *v.* Berry (1868), 3 Fisher, 439; 2 Bond, 189.

[2] That the right to an injunction is independent of the right to profits or damages, see Colgate *v.* International Ocean Tel. Co. (1879), 17 O. G. 194; 17 Blatch, 308; 4 Bann. & A. 609; American Cotton Tie Supply Co. *v.* McCready (1879), 17 O. G. 565; 17 Blatch. 291; 4 Bann. & A. 588.

That although the infringement stopped when the injunction issued the court will decree a perpetual injunction and account, there being no disclaimer of the right to use the invention by the defendant, and it not appearing that there were no damages or profits, see Bullock Printing Press Co. *v.* Jones (1878), 13 O. G. 124; 3 Bann. & A. 195. See also §§ 1191, 1205, and notes, *ante*.

[3] See § 1211, note 2, *ante*.

[4] See § 1211, note 3, *ante*.

[5] That where a patent expires after the interlocutory decree, and hence no injunction is ordered on the final decree, the extension of the patent afterwards is a good ground for an injunction to be ordered, see Bliss *v.* City of Brooklyn (1871), 8 Blatch. 533; Tilghman *v.* Mitchell (1871), 4 Fisher, 615; 9 Blatch. 18.

means, however adequate may be the compensation which a court of law is able to afford.[6] Thus in all cases the remedy is measured by and fitted to the threatened wrong, and whatever the defendant is adjudged to have done or attempted in the past, contrary to the plaintiff's demonstrated rights, he will be prohibited from undertaking or performing in the future, during the continuance of the monopoly.

§ 1221. Perpetual Injunction: Duration: Suspension.

A perpetual injunction is operative only during the life of the patent, and should be expressly limited thereto, except in reference to infringing articles constructed while the patent was in force and capable of use after it has expired.[1] Where it would cause no special harm to the defendant it may be granted after the hearing on the merits, but may be suspended till the acceptance of the master's report in order to allow time for an appeal.[2] It will not be suspended on the ground

[6] That the rule as to injunctions applies to a bill by an assignee as well as to one by an inventor, see Motte *v.* Bennett (1849), 2 Fisher, 642.

That an injunction may be granted in favor of an assignee of the patent and of past damages, though for the latter he may be compelled to seek redress at law, see Merriam *v.* Smith (1882), 11 Fed. Rep. 588.

That an injunction will be granted in one State though the plaintiff's title in another State was derived from an assignor who had lost his rights by neglect, see Gear *v.* Holmes (1873), 6 Fisher, 595.

§ 1221. [1] In Nathan *v.* Elevated R. R. Co. (1880), 2 Fed. Rep. 225, Wheeler, J.: (229) "An injunction issued in pursuance of a final decree should, by its terms, be limited to the time it may properly remain in force; and an injunction to restrain infringement of a patent can, of course, properly continue only during the term of the patent." 5 Bann. & A. 280 (284). See also De Florez *v.* Raynolds (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140.

[2] In Potter *v.* Mack (1868), 3 Fisher, 428, Swayne, J.: (429) "The court decreed a perpetual injunction, and also a decree that the account should be taken. The case was referred to a master for that purpose, with a view to ascertain the amount of damages which were finally to be allowed to the plaintiff. An application is made that this final decree shall be suspended, as it regards the injunction, until the account shall be determined upon and the decree shall be finally made upon that account, and when the defendant, for the first time, will have the right to appeal. He cannot appeal from the decree as it at present stands, because, although the decision is final as to the merits of the case, it is in form an interlocutory decree only, and the rule established by the Supreme court is that an appeal can be taken only from a final decree. It has been held in this class of cases

that the patent is about to expire, nor that the defendant is bound by contracts with third parties if his obligations were assumed with knowledge of the plaintiff's claims, nor where the defendant has denied the usefulness of the invention and thus prevented the recovery of substantial damages.[3] A suspension after final decree rests in the discretion of the court which granted the injunction, and on allowing it the court must protect the interests of all parties and secure the immediate cessation of the infringement.[4] After a perpetual injunction has been ordered an appeal to the Supreme Court does not, of itself, suspend or supersede it.[5]

§ 1222. Perpetual Injunction by Consent.

The court may issue a perpetual injunction by consent of the defendant, as well as upon final hearing, unless the action or decree are evidently collusive; but in such cases it will not pass upon the patentability of the invention nor the validity of the patent in order to influence the course of future

that a decree is not to be considered final for the purposes of appeal until after the coming in of the master's report."

That an injunction is not to be suspended till final decree unless it would work some special hardship to the defendant, see Potter *v.* Mack (1868), 3 Fisher, 428.

[3] That an injunction will not be suspended on the ground that the patent is about to expire, see Brown *v.* Deere (1881), 6 Fed. Rep. 487; 19 O. G. 1217; 2 McCrary, 425.

That an injunction will not be suspended to enable the defendant to perform contracts entered into with knowledge of the patent, see Brown *v.* Deere (1881), 6 Fed. Rep. 487; 19 O. G. 1217; 2 McCrary, 425.

That a final injunction will *not* be suspended while the decree is unreversed, except in case of some public necessity or other extraordinary interest outside the parties, and the defendant cannot urge such reasons if he has denied utility and prevented the recovery of substantial damages, see Munson *v.* Mayor of New York (1884), 19 Fed. Rep. 313; 22 Blatch. 45.

[4] That the suspension of an injunction after final decree rests with the court which granted it, and in so doing the court must protect all interests and pay due regard to the difference between royalties, licenses, and monopolies, see Brown *v.* Deere (1881), 6 Fed. Rep. 487; 19 O. G. 1287; 2 McCrary, 425. See also § 1212 and note 5, *ante*.

That a decree and injunction will be issued before a reference for an account unless the defendant shows that equity requires otherwise, see Rumford Chemical Works *v.* Hecker (1877), 11 O. G. 330; 2 Bann. & A. 386.

[5] That a bond on an appeal after the final decree does not act as a *supersedeas* on the injunction but only on the money judgment and costs, see Whitney *v.* Mowry (1867), 3 Fisher, 157; 2 Bond, 45.

litigation.[1] Where the terms of the consent are afterward disputed the injunction will be recalled, and the entire action be re-opened for a final hearing.[2] An injunction by consent is not dissolved by the granting and acceptance of a conditional license.[3] When it appears, at any stage of the proceedings, that the action is collusive the case will be summarily dismissed.[4]

§ 1223. Perpetual Injunction: Violation: Dissolution.

A perpetual injunction may be violated by any of the acts which, under a preliminary injunction to the same effect, would be regarded as a contempt of court. The mode in which the plaintiff then obtains redress, and the measure of the penalty inflicted on the defendant, follow the rules already stated in reference to this offence. The dissolution of a perpetual injunction rests also on the principles before described, and may be ordered upon suitable application at any time within two years after the entering of the decree.[1]

§ 1222. [1] That a final injunction may issue upon a decree by consent, see Tomkinson *v.* Willetts Mfg. Co. (1884), 31 O. G. 918; 32 O. G. 382; 23 Fed. Rep. 895; McWilliams Mfg. Co. *v.* Blundell (1882), 22 O. G. 177; 11 Fed. Rep. 419.

That in granting a decree by consent no question upon the merits will be decided, see American Middlings Purifier Co. *v.* Vail (1878), 15 Blatch. 315; 4 Bann. & A. 1.

[2] That if on a motion for attachment for contempt of a decree by consent the terms of the consent are in dispute, the whole case will be opened and a final hearing had, see Roemer *v.* Neumann (1883), 19 Fed. Rep. 98.

That a decree by consent is not such a general decree as allows an attachment for contempt upon mere motion, but a bill must be filed and issues raised, see Higby *v.* Columbia Rubber Co. (1883), 18 Fed. Rep. 601.

[3] That a conditional license is not ground for dissolving an injunction by consent, see Pentlarge *v.* Beeston (1880), 1 Fed. Rep. 862; 18 Blatch. 38; 5 Bann. & A. 326.

[4] That a decree by collusion will be annulled and the case dismissed on the petition of strangers to it, see Barker *v.* Todd (1882), 15 Fed. Rep. 265; 23 O. G. 438.

That collusive suits are not entertained and proceedings thereon will be set aside, see Gardner *v.* Goodyear Dental Vulcanite Co. (1873), 3 O. G. 295; 6 Fisher, 329.

That suits are not to be prosecuted by agreement of both parties to carry out a compromise, one party paying all the expenses, see Gardner *v.* Goodyear Dental Vulcanite Co. (1873), 3 O. G. 295; 6 Fisher, 329.

§ 1223. [1] See §§ 1213–1219, and notes, *ante*.

CHAPTER IV.

OF WRONGS BETWEEN CONTRACTING PARTIES: AND THEIR REMEDIES.

§ 1224. Rights of Parties to Contracts concerning Patented Inventions Rest on the General Law of Contracts.

The reciprocal rights of Assignors and Assignees, of Grantors and Grantees, and of Licensors and Licensees, rest upon express or implied contracts between the parties. The law no otherwise creates them than as it permits the parties to enter into the agreements out of which they spring, and it protects them on the same grounds that it enforces other obligations. The subject-matter of these contracts being the patent privilege, or some immunity derived therefrom, the principles of patent jurisprudence form an important element in that body of law by which the contracts are interpreted and the relations and duties of the parties are determined. Apart from this element, however, the general law of contracts furnishes the measure by which their rights are ascertained, and the methods by which their wrongs may be redressed.[1]

§ 1224. [1] The collation and discussion of cases concerning these contract relations is rendered somewhat difficult by the failure of the courts to recognize and point out the similarities and differences which exist between the agreements of assignors and assignees, or grantors and grantees, on the one hand, and those of licensors and licensees on the other. As mere contracts relating to an interest in a patented invention all stand on the same footing, and the rules regarding their enforcement, or rescission, are practically the same. But in the nature of the rights which they confer they are essentially distinct, and hence the obligations they impose and the estoppels to which they give rise are very different. An assignment or grant conveys the whole or a part of the monopoly, creates or purports to create a property in the transferee in consideration of which he pays or promises to pay the purchase money, and is governed by the same rules as to warranty, fraud, failure of consideration, &c., as any other sale of personal or real estate. A license, on the contrary, conveys and creates nothing, but is in itself a simple agreement not to enforce

§ 1225. Wrongs against the Rights of the Parties to a Contract concerning Patented Inventions are Breaches of Contract, even where they Infringe the Patent.

Wrongs committed by these parties against each other, whatever else they may involve, therefore embrace a breach of contract. The infringement of a patent, contrary to the terms of an agreement with its owner, is not less the violation of a covenant because it is the invasion of a patented monopoly. While the same person may occupy a two-fold relation toward the owner of a patent, one as his assignee or licensee within the scope of the conveyance, the other as a stranger outside the conveyance, and in the latter capacity may commit wrongful acts for which no contract suit would lie, yet when as a contracting party he has bound himself to respect the reserved rights of his grantor, and then infringes, his liability rests on a double basis and he may be pursued either upon his broken contract or for his tortious interference with the property of his grantor.[1] So far as any wrong committed by the parties interested in a patented invention constitutes or includes an infringement of the patent, the nature of that wrong and of its remedy has been sufficiently discussed in the preceding chapter. It remains, in the present, to consider those injuries which simply violate the agreements of the parties, and the redress which courts of equity or law afford.

---

the prohibitions of the monopoly against the licensee. Every user of the invention has the option to practise it in defiance of the patent, at the risk of a suit for infringement, or to exempt himself from liability to suit by submitting to the patent and paying the license fee, and having exercised this option and having enjoyed the exemption, in consideration of the royalty paid or to be paid, occupies toward his licensor, on all questions of estoppel, payment, &c., an attitude entirely different from that of a mere vendee of property. In the discussion of the subject in the text, these distinctions are preserved and the cases are arranged in the notes, as far as was possible, to support and illustrate the doctrines thus formulated. But the real value of any case for either purpose cannot be estimated unless the classifications and principles given in the text are kept in mind, and these should, therefore, be examined in advance of any study of the notes.

§ 1225. [1] That a licensee exceeding the privileges conferred by his license both violates the contract and infringes the patent, see Pope Mfg. Co. *v.* Owsley (1886), 37 O. G. 781; 27 Fed. Rep. 100.

§ 1226. As Contracting Parties, Assignors and Assignees and Grantors and Grantees Enjoy the same Rights and are Subject to the same Wrongs.

In reference to the nature and obligations of their contracts, grantors and grantees occupy the same relations toward each other as assignors and assignees. The grant is an assignment of the patent within an area less than the entire territory of the United States, and in the district granted the rights and duties of the grantee are identical with those of assignees. Being subject to the same wrongs and entitled to the same remedies as those whose contracts cover the whole area within which the monopoly prevails, they require no separate attention, and the rules hereafter stated in reference to assignors and assignees may be regarded as equally applied to them.

SECTION I.

OF THE WRONGS COMMITTED BY ASSIGNORS AGAINST ASSIGNEES: AND THEIR REMEDIES.

§ 1227. Contract Rights of the Assignee against the Assignor.

Under his contract with the assignor, an assignee is entitled to the conveyance of a perfect legal title to a valid patent, without fraud or imposition and with an exact fulfilment of the express and implied warranties which the contract contains. The violation of his rights by the assignor, therefore, consists either: (1) In a neglect or refusal to convey the patent; or (2) In the conveyance of a defective title; or (3) In the conveyance of an invalid patent; or (4) In deceit or artifice inducing the assignee to enter into the transaction; or (5) In breach of warranty. For each of these wrongs an adequate remedy exists, either in law or equity.

§ 1228. Remedy of the Assignee when the Assignor Refuses to Convey the Patent.

The neglect or refusal of the assignor to convey the patent to the assignee may be voluntary or involuntary. If involuntary, the only remedy of the assignee is by an action at law

upon the breach of contract. If voluntary, the assignee may sue at law for damages or obtain specific performance in a court of equity. A contract for the assignment of a patent, or an undivided interest therein, belongs to that peculiar class of contracts which equity will compel the parties to perform according to its terms, on the ground that otherwise irreparable injury may be inflicted.[1] An oral contract to convey a future patent, collateral to a contract for a partnership between the inventor and the assignee, will thus be enforced after the patent has been granted, although the inventor has repudiated the partnership agreement.[2] But the performance of an agreement whose fulfilment would be inequitable, or contrary to public policy, or ineffective on account of the previous conveyance or expiration of the patent, will not be decreed.[3] Where the established principles of equity do not

§ 1228. [1] That an agreement concerning a patent can be specifically enforced, see Adams *v.* Messinger (1883), 147 Mass. 185; Fuller Co. *v.* Bartlett (1887), 68 Wis. 73; Hapgood *v.* Rosenstock (1885), 23 Blatch. 95; 23 Fed. Rep. 86.

That equity will decree specific performance of a contract to assign a patent or an interest therein, see Somerby *v.* Buntin (1875), 118 Mass. 279; Satterthwaite *v.* Marshall (1872), 4 Del. Ch. 337.

That an oral agreement to convey a patent will be enforced, see Searle *v.* Hill (1887), 73 Iowa, 367.

That an agreement to assign all future inventions relating to a certain art may be defined and enforced in equity, see Reese's Appeal (1888), 122 Pa. St. 392.

[2] That an oral agreement of one person to give his interest in a future patent, and of the other to put in funds, and of both to render their services, is a partnership agreement, and the patent will be partnership property, and specific performance by the inventor will be decreed, see Somerby *v.* Buntin (1875), 118 Mass. 279.

[3] That specific performance will not be decreed in favor of a party who has repeatedly broken the contract, though the other party was the first to break it, see Ohio Steel Barb Fence Co. *v.* Washburn & Moen Mfg. Co. (1886), 26 Fed. Rep. 702; 35 O. G. 1337; Foster *v.* Goldschmidt (1884), 28 O. G. 915; 22 Blatch. 287; 21 Fed. Rep. 70.

That if a party who has broken the contract has any remedy against the other, it is at law not in equity, see Ohio Steel Barb Fence Co. *v.* Washburn & Moen Mfg. Co. (1886), 26 Fed. Rep. 702; 35 O. G. 1337; Werden *v.* Graham (1883), 24 O. G. 101; 107 Ill. 169.

That equity will not decree specific performance where the order would be futile or afford imperfect relief, see Wollensak *v.* Briggs (1886), 37 O. G. 339; 20 Brad. (Ill.) 50; Werden *v.* Graham (1883), 24 O. G. 101; 107 Ill. 169.

That equity will not decree performance where the patent does not exist or defendant has no title, see Kennedy *v.* Hazelton (1888), 128 U. S. 667; Kennedy *v.* Hazelton (1883), 33 Fed. Rep. 293; 46 O. G. 973.

That specific performance of a contract to assign a patent may be decreed

permit the court to order a performance of the contract an indirect coercion may be exercised upon the assignor by an injunction, forbidding any transfer or enjoyment of the patent contrary to his agreement with the assignee.[4] A voluntary refusal of the assignor to convey the legal title after the equitable interest has been transferred, or to remove a cloud upon the legal title already vested in the assignee, also demands the interference of a court of equity, which may compel the

when the rights of *bona fide* purchasers have not intervened, see Whitney *v.* Burr (1885), 115 Ill. 289.

That equity will not decree specific performance of a contract on one part to assign a patent, and on the other to manufacture the invention, after long delay and where the plaintiff has not kept his own agreements, see Werden *v.* Graham (1883), 24 O. G. 101; 107 Ill. 169.

That specific performance of a contract to assign will not be decreed if the plaintiff has been guilty of laches unless the defendant has acquiesced in the delay, and where a subsequent assignment has occurred the plaintiff must show tender or performance on his part and notice to the assignee, see N. Y. Paper Bag Mach. Co. *v.* Union Paper Bag Mach. Co. (1887), 32 Fed. Rep. 783.

That equity will not decree specific performance of a contract to render personal services requiring skill and judgment, nor where the exact thing to be done cannot be described, nor where it would involve the disclosure of an inventor's secret, see Wollensak *v.* Briggs (1886), 37 O. G. 339; 20 Brad. (Ill.) 50.

That a contract which is unconscionable and in a measure against public policy will not be enforced, see Pope Mfg. Co. *v.* Gormully (1888), 34 Fed. Rep. 877.

That an assignee before patent, having notice of a prior unrecorded assignment, and with such notice procuring the patent to himself, holds it in trust for the former assignee and may be compelled to convey it to him, see Pontiac Knit Boot Co. *v.* Merino Shoe Co. (1887), 31 Fed. Rep. 286.

That a contract binds the persons who participate in it, though signed only by one representing the rest, see Bean *v.* Clark (1887), 40 O. G. 1454.

[4] In Singer Mfg. Co. *v.* Union Button Hole & Embroidery Co. (1873), 4 O. G. 553, Lowell, J.: (555) "I think the fair result of the later cases may be thus expressed: If the case is one in which the negative remedy of injunction will do substantial justice between the parties by obliging the defendant either to carry out his contract or lose all benefit of the breach, and the remedy at law is inadequate, and there is no reason of policy against it, the court will interfere to restrain conduct which is contrary to the contract, although it may be unable to enforce a specific performance of it. It seems to me that this case comes easily within this rule. The court cannot, perhaps, superintend the performance of a contract to manufacture machines, but it can restrain the defendants from selling in violation of their agreement." Holmes, 253 (253); 6 Fisher, 480 (485).

That the owner of a patent, who has contracted to sell it to the plaintiff, may be enjoined from selling it to any one else, though no specific performance may be decreed, see Adams *v.* Messinger (1888), 147 Mass. 185; Goddard *v.* Wilde (1883), 17 Fed. Rep. 345.

That courts of equity will not inter-

assignor to execute the necessary instruments unless the assignee prefers the remedy of damages at law.[5]

§ 1229. Remedy of Assignee when the Title Derived by him from the Assignor Proves Defective.

Where the title proves defective after the contract is completed, and the assignee has fulfilled his part of the agreement, equity may compel the assignor to make it perfect, if it is in his power to do so; if not, the contract may either be rescinded and the parties placed in their original position, or the assignee may seek redress at law.[1] Equity will set aside the contract when the consideration of the assignment consisted of specific articles of property which ought to be returned to the assignee, or of the assumption of personal obligations from which he ought to be released. It will also rescind the contract when the failure of title is partial, and adequate compensation for the injury thereby inflicted on the assignee cannot be obtained at law. In ordering a rescission, the court protects the rights of all parties; and where the title is not totally defective the assignee must reconvey the patent to the assignor and must account for the benefits received from its enjoyment during his period of ownership,

pret contracts for ordinary parties, no trust relation existing, see Florence Sewing Mach. Co. *v.* Singer Mfg. Co. (1870), 4 Fisher, 329; 8 Blatch. 113.

[5] That equity will compel one having the record title to convey to the true owner, see Annin *v.* Wren (1887), 51 Hun (N. Y.), 352; Berolzheimer *v.* Strauss (1884), 51 Sup. Ct. N. Y. 96.

That where a licensee conspired to acquire a prior patent and have it re-issued to cover the licensor's invention it is a fraud on the licensor, and equity may compel the licensee to assign to him the re-issued patent, see Hale & Kilburn Mfg. Co.'s Appeal (1883), 3 Pennypacker (Pa.), 378; Everitt *v.* Hale (1882), 15 Phila. 305.

That a cloud on the title to a patent may be removed in equity, see Goodyear *v.* Day (1856), 6 Duer, 154.

That a covenant to convey an extension is valid and enforceable in equity, see Goodyear *v.* Day (1856), 6 Duer, 154.

That equity will protect one to whom the patentee promises to assign the extended term, if after the extension he refuses or is unable to do so, see Day *v.* Candee (1853), 3 Fisher, 9.

§ 1229. [1] That equity may compel the perfecting of an incomplete title, see Goodyear *v.* Day (1856), 6 Duer, 154. See also § 1228 and notes, *ante*.

That if the defective title can be made perfect by the assignor, the assignee cannot rescind, see Marsh *v.* Scott (1888), 125 Ill. 114.

That the assignee cannot claim both an enforcement and a rescission but must elect between them, see Creighton *v.* Haggerty (1884), 50 Hun (N. Y.), 9.

unless the loss exceeded the advantage or the assignor originally acted in bad faith.[2] Where the consideration for the assignment was a specific sum of money which has been already paid, and the title to the patent wholly fails, the assignee may sue at law for the recovery of the price, after a tender of the patent to the assignor.[3] In all cases, whatever the consideration may have been, and whether the title is partially or entirely void, or the defect is curable or incurable by further conveyances from the assignor, an action for damages may be sustained upon the broken contract, their measure being determined by the loss which the defect of title has occasioned.

§ 1230. Remedy of the Assignee when the Patent Proves to be Invalid.

The conveyance of an invalid patent forms no consideration for a contract, and when an assignee has, in good faith and with due caution, parted with any property or assumed any obligation relying upon its validity, he is entitled on discovering the failure of consideration to a return of the property or a release from the obligation.[1] The ground of invalidity is immaterial. A patent void for want of novelty or practical utility in the invention affords as little consideration for a contract as one void for want of priority in the inventor, provided the assignee has exercised reasonable care in the exami-

[2] That the conveyance cannot be repudiated so as to free the vendee from the duty of paying the purchase money unless the invention be restored to the assignor, see Sherman *v.* Champlain Transportation Co. (1858), 31 Vt. 162.

[3] That if the vendor had no title there is no consideration for the sale, see Hardesty *v.* Smith (1851), 3 Ind. 39; Edwards *v.* Richards (1834), Wright, (Ohio), 596.

That if the assignor creates a legal title which defeats the equitable title of his prior assignee he must refund the purchase money, see Bellis *v.* Henwood (1888), 6 Pa. Co. (Pa.) 78.

That if the title to the patent fails, the vendee may recover the purchase money, see Holden *v.* Curtis (1819), 2 N. H. 61.

That the consideration expressed in the conveyance of a patent is not conclusive, and the true consideration may be shown, see Wheeler *v.* Billings (1868), 7 Transcript Ap. (N. Y.) 121.

§ 1230. [1] That the assignment of a worthless patent-right is no consideration for a contract, see Bierce *v.* Stocking (1858), 11 Gray, 174.

That an assignee cannot rescind the contract on the ground that a defect exists in the patent if the defect can be remedied by the assignor, see Marsh *v.* Scott (1888), 125 Ill. 114.

nation of the invention before the purchase.[2] But the absence of pecuniary value in the invention does not avoid the patent, nor can the assignee complain of any defect which must have been apparent to him at the time of purchase, since the law does not undertake to prohibit the transfer of invalid patents, nor to assist an intelligent and voluntary purchaser in his repudiation of the sale.[3] The remedy of the assignee of a void patent may be sought either in equity or at law. If the price paid was in money, the amount may be recovered in a suit at law, upon an offer to reconvey the patent to the assignor.[4] When specific property is to be returned, or an obli-

[2] That where the patent is void on account of a defective specification, there will be no consideration for a note given for the purchase money, see Keith *v.* Hobbs (1878), 69 Mo. 84.

That if the patent is void because the invention is useless, the note given for it is without consideration, see Rowe *v.* Blanchard (1864), 18 Wis. 441; Jolliffe *v.* Collins (1855), 21 Mo. 338; Fallis *v.* Griffith (1833), Wright (Ohio), 303.

That if the invention will not answer its purpose without alterations, the patent will be void, and the vendee may repudiate the sale for failure of consideration, see Cowan *v.* Dodd (1866), 3 Cold. (Tenn.) 278.

That a useless invention is no consideration for a note, though both parties believed it to be useful, see Lester *v.* Palmer (1862), 4 Allen, 145.

That if the invention can be improved and made operative without introducing a new principle, the contract will not be avoided, see Cowan *v.* Dodd (1866), 3 Cold. (Tenn.) 278.

That if the invention is useful when sold, there is no failure of consideration, though subsequent ones supersede it, see Harmon *v.* Bird (1839), 22 Wend. 113.

That uselessness is no defence where the vendee bought on his own judgment and without fraud, see Hardesty *v.* Smith (1851), 3 Ind. 39.

[3] That "want of value" and "want of utility" are not the same thing, see Burns *v.* Barnes (1877), 58 Ind. 436.

That an interest in or license under a valid patent is a good consideration for a note or other contract, whether the interest has any pecuniary value or not, see Nash *v.* Lull (1869), 102 Mass. 60; Howe *v.* Richards (1869), 102 Mass. 64, note.

[4] That money paid for a void patent can be recovered back, see Darst *v.* Brockway (1842), 11 Ohio, 462.

That when the vendee pays the purchase money, with full knowledge of all the facts, he cannot recover it, see Stevens *v.* Head (1837), 9 Vt. 174.

That if the vendee has derived benefit from the sale he cannot recover back the price paid, though the patent is void, see Holden *v.* Curtis (1819), 2 N. H. 61.

That in an action to recover back the price on the ground that the patent is invalid the patent must be re-assigned or tendered to the seller, see Dillman *v.* Nadelhoffer (1885), 19 Brad. (Ill.) 375.

That if the patent is void because the invention is not new and useful the note given therefor is void, and the vendee need not offer to re-assign, see

gation released, the contract must be set aside in equity, and the parties restored to their former condition. Where general damages will compensate the assignee, an action at law for these may be maintained. The conveyance of a patent for a different invention from that which forms the subject-matter of the contract is equivalent, in its effect, to the conveyance of an invalid patent. The assignee is not bound to accept it, but may rescind the contract and recover back the price, or have such other relief as the case requires. If he accepts the conveyance, however, and avails himself of the advantages of the invention therein described, he is estopped from setting up the departure from the contract, either as a cause of action or a defence against the assignor.[5]

§ 1231. Remedy of the Assignee when the Assignor Procured the Assignment through Deceit.

Where the assignor has by deceit or artifice induced the assignee to enter into the contract it may be set aside in equity, or the assignee may have his remedy for damages at law.[1] The distinction, which elsewhere prevails between the

National Bank *v.* Peck (1871), 8 Kan. 660.

That where benefits have been received the contract cannot be rescinded, but only an action for damages will lie, see Moore *v.* Bare (1860), 11 Iowa, 198.

[5] That the vendee of a patent-right may recover back his money if the patent-right was not what he agreed to buy, unless he has accepted a deed describing it, and if he has he cannot recover unless there was fraud or a warranty, see Foss *v.* Richardson (1860), 15 Gray, 303.

That if the right agreed to be assigned differs from that covered by the patent, the sale is void, and the purchase money, if paid, is recoverable, see Burrall *v.* Jewett (1830), 2 Paige, 133.

That if the patent is referred to by its date in the assignment it will be presumed that the vendor examined it, and the doctrine of *caveat emptor* will apply, see Myers *v.* Turner (1855), 17 Ill. 179.

That an assignment by the vendee to other persons does not estop him from claiming invalidity, see Hawks *v.* Swett (1875), 4 Hun (N. Y.), 146; 6 Thomp. & C. 529.

§ 1231. [1] That the assignee of a patent may have the assignment rescinded for fraud in the representations of the assignor as to the patented invention, see Hall *v.* Orvis (1872), 35 Iowa, 366; and cases cited in other notes under this paragraph.

That a corporation purchasing the right to sell an invention may rely on the statements of the vendors and is not bound by the rule *caveat emptor*, and may sue for fraudulent representations though they were made to the persons forming such corporation before it was

expression of an unfounded opinion and the avermont of a falsehood, is equally applicable to the vendor of a patent. Extravagant recommendations are to be expected from the owner of any commodity which he desires to sell, and buyers must be on their guard in order not to be misled. Thus representations of the assignor concerning the probable value of the invention to the assignee, though false, are not such fraud as warrants a rescission of the contract unless the vendor knew that the vendee was ignorant and was relying upon his opinion.[2] But statements affirming the validity of the patent, or the novelty or utility or salability or cost of the invention, if made with an intention to deceive the assignee and acted on by him, constitute a sufficient ground for the avoidance of the assignment in equity, or the recovery of damages at law.[3] These fraudulent assertions furnish the same occa-

organized, see Iowa Economic Heater Co. *v.* American Economic Heater Co. (1887), 32 Fed. Rep. 735.

That the assignee may rescind the assignment for fraud and recover the price paid or the property conveyed as the consideration, see Marsh *v.* Scott (1888), 125 Ill. 114.

That the assignee may sue the assignor for fraudulent statements which induced him to purchase the patent, see Bull *v.* Pratt (1815), 1 Conn. 342; and other cases cited in the notes to this paragraph.

[2] That false representations as to the amount already offered for the right are not such warranties of value as will avoid the contract of sale, or sustain an action *for deceit*, see *Dillman v.* Nadelhoffer (1885), 19 Brad. (Ill.) 375.

That a statement by the vendor that the invention would be useful to the vendee is a mere expression of opinion, not a fraud, see Louden *v.* Birt (1853), 4 Ind. 566.

That representations as to value are mere opinions, and cannot avoid the sale, since only falsehoods as to matters of fact can do that, see Neidefer *v.* Chastain (1880), 71 Ind. 363.

That a contract of sale will be rescinded for false representations of the vendor *as to the value* of the patent, the vendee being ignorant and relying on the vendor, see Page *v.* Dickerson (1871), 28 Wis. 694.

[3] That in an action for fraud the plaintiff may show that the patent is invalid on account of a prior patent, see Bull *v.* Pratt (1815), 1 Conn. 342.

That a sale may be avoided on account of false representations of the vendor that the invention was never before patented, and was never used except under the patent sold, see Morrow *v.* Brown (1869), 31 Ind. 378.

That a sale procured by false representations of the vendor as to the novelty and usefulness of the invention is void, see Johnson *v.* McCabe (1871), 37 Ind. 535.

That a vendee has a right to rely on the vendor's representations as to the salability of the invention, see Hull *v.* Fields (1882), 76 Va. 594.

That wilful falsehoods of the vendor as to the cost of making the invention are fraud, see Peffley *v.* Noland (1881), 80 Ind. 164.

That a vendor is not bound by his

sion for relief whether made in words or by the exhibition of false devices purporting to be the patented invention, and whether proceeding from the assignor himself or from his agents.[4] The consequences of the fraud are not averted by the ability of the assignee to have discovered the deceit by resorting to the records of the Patent Office, or by an inquiry of persons skilled in the art.[5] If the assertions of the assignor relate to matters of existing fact, and are intended to influence the action of the assignee, his reliance upon them without further investigation is not, as between the parties, evidence of undue credulity, unless the assertions were manifestly untrue or absurd, or the assignee has neglected such precautions as every prudent man would have observed.[6] A rescission of the contract on the ground of fraud must be made promptly after its discovery. The subsequent exercise of ownership over the patent, and the enjoyment of its benefits, will affirm the sale and deprive the assignee of his equitable remedy.[7] Nor can the advantages derived from the invention

representations as to the validity of the patent, or the novelty or priority of the invention, unless he was guilty of fraud, see Rawson *v.* Harger (1878), 48 Iowa, 269.

[4] That the vendee of a patent-right may rely on the representations of the vendor as to what the patent covers, and if the part shown to the vendee is not covered it is a fraud, see Rose *v.* Hurley (1872), 39 Ind. 77.

That a sale will be set aside for fraud of the vendor by falsehoods concerning the value and utility of the invention, and the employment of false devices in exhibiting it, see Gardner *v.* Trenary (1885), 65 Iowa, 646.

That statements as to utility, made in the presence of the vendor by one who travelled with him in selling the patent-right, are binding on the vendor, see Foster *v.* Trenary (1885), 65 Iowa, 620.

[5] That a vendee may sue the vendor for false representations as to what was covered by the patent, or not covered by an earlier patent, though by searching the records in the Patent Office he could have discovered the error, see David *v.* Park (1870), 103 Mass. 501.

That if the patent is void on account of a prior patent for the same invention, and the vendee was induced to purchase by the fraudulent statements of the vendor that it was valid, he may re-assign the patent and rescind the sale, though by searching the records of the Patent Office he might have discovered the fraud, see McKee *v.* Eaton (1881), 26 Kan. 226.

[6] That where both vendor and vendee have equal knowledge, or means of knowledge, equity will not relieve, if both parties were in good faith, see Rawson *v.* Harger (1878), 48 Iowa, 269.

[7] That if the vendee exercises ownership over the patent after he discovers the fraud, it will affirm the sale, see Dunks *v.* Fuller (1875), 32 Mich. 242.

That where a vendee, after he dis-

before the fraud was discovered be retained by the rescinding assignee. The contract becomes void from its beginning, and the mutual restoration of all its results, on either side, must follow.[8] A bill in equity to set aside the assignment, therefore, must allege that no benefits have been received since the discovery of the fraud, and must offer to return those which had previously accrued.[9] When the patented invention is entirely worthless, and the assignee has been induced to purchase it by the fraudulent representations of the assignor as to its value, the price may be recovered in a suit at law without a prior rescission of the contract or an offer to return the patent to the assignor.[10] But where the parties were of equal knowledge or in equal fault, or where the purchase money has been paid after a full acquaintance with the facts, no action to recover it will lie. A suit for damages, leaving the contract still in force so far as the ownership of the patent is concerned, can always be sustained when actual fraud has been committed by the assignor.[11] In proof of his guilty

covers the fraud, acquiesces in it and takes the benefit of the sale, other parties not interested in the sale cannot avoid it, that power being confined to him and those who share his rights, see Edmunds *v.* Hildreth (1854), 16 Ill. 214.

[8] That where the vendee has benefited by the assignment he cannot have it rescinded, and recover back the purchase money on the ground of fraud, unless he accounts for the benefits received, see Edmunds *v.* Myers (1854), 16 Ill. 207; Edmunds *v.* Hildreth (1854), 16 Ill. 214.

[9] That a bill to rescind an assignment on the ground of fraud must aver that the benefits were received before the fraud was discovered, and must offer to return the profits received, see Edmunds *v.* Myers (1854), 16 Ill. 207; Edmunds *v.* Hildreth (1854), 16 Ill. 214.

[10] That the purchase money may be recovered on the ground of the vendor's fraudulent representations as to the value of the patent, and if the patent is entirely worthless no tender to return it is necessary, see Hess *v.* Young (1877), 59 Ind. 379.

That where the vendor agrees to return the purchase money if the vendee fails to realize a certain sum within a given time, the vendee is bound to make reasonable efforts to sell, considering his ability and means, though if he has no means and does not speak English, he is not bound to embark in the manufacture of the invention, see Berger *v.* Peterson (1875), 78 Ill. 633.

That if the vendee, with a right to rescind if the enterprise is unsuccessful, makes reasonable efforts, and the vendor prevents sales from being made, the vendor must pay back the price with interest, though before the time was up the vendee had refused to reconvey, see Berger *v.* Peterson (1875), 78 Ill. 633.

[11] That a vendee of territory, some of which the vendor did not own, may sue for damages without offering to re-

knowledge, similar false assertions in other transactions relating to the same invention may be shown.[12]

§ 1232. Remedy of Assignee for Breach of Warranty.

An assignment of a patent raises an implied warranty of title, but not of the validity of the patent nor of the practical value of the patented invention.[1] An action for breach of warranty will, therefore, lie only where the title proves defective, unless the instrument of conveyance contains express covenants which have been broken by the assignor. Such covenants may relate directly to the patent or by necessary implication warrant its validity. In either case they create rights which can be vindicated by an action at law for damages. Where the assignor of the patent is himself an assignee, and both parties are in equal ignorance concerning the patentability of the invention, no question as to an implied warranty of validity can arise.[2]

assign, and will be allowed damages in proportion to the value of such unsold territory to the whole area, as shown by the price paid, see Moorehead *v.* Davis (1883), 92 Ind. 303.

[12] That fraud in effecting sales to others may be proved to show guilty knowledge in the same acts toward the vendee, see Foster *v.* Trenary (1885), 65 Iowa, 620.

§ 1232. [1] That the assignment of a patent carries an implied warranty of title, see § 783 and notes, *ante*.

That a vendee in an action against the vendor on an implied warranty must show that he has been disturbed in the enjoyment of the right, or that the vendor had no right which he could convey, see Stevens *v.* Head (1837), 9 Vt. 174.

That a warranty of the exclusive right within a given territory extends only to the specific inventions conveyed to the vendee, see Kingman *v.* Martin (1887), 24 Ill. Ap. 435.

That a covenant not to make, use or sell any device for the same purpose is too broad and against public policy, see Berlin Mach. Works *v.* Perry (1888), 71 Wis. 495.

That there is no implied warranty of validity in the sale of a patent right, see Hiatt *v.* Twomey (1836), 1 Dev. & Bat. Eq. (N. C.) 315.

That if the title to the patent passes to the vendee the consideration paid cannot be recovered back unless the contract has been rescinded, or was tainted with fraud, or there was an express warranty which has been broken, see Case *v.* Morey (1818), 1 N. H. 347.

[2] In Johnson *v.* Willimantic Linen Co. (1866), 33 Conn. 436, Butler, J.: (442) "It is not material to enquire whether or not generally, on the sale of a patent-right, there is an implied warranty of its validity. There is undoubtedly a strong current of authority in that direction. And the cases in this country where in actions for the price of a patent-right or patented machine the defendant has prevailed on the ground of a failure of consideration, are quite numerous. Where there was an ex-

SECTION II.

OF WRONGS COMMITTED BY ASSIGNEES AGAINST ASSIGNORS: AND THEIR REMEDIES.

§ 1233. Rights of Assignor against Assignee.

An assignor, under his contract with the assignee, acquires a right to an acceptance of the conveyance of the patent, to the performance of the conditions embraced in the assignment, and to the payment of the stipulated price. He also has the right, implied in every contract, to honesty and fair dealing on the part of the assignee. His rights are, therefore, violated when the assignee refuses to execute the contract, or to fulfil his obligations under it, or to pay the purchase money according to the terms of the agreement, or when he takes undue advantage of the ignorance or credulity of the assignor.

§ 1234. Remedy of Assignor when the Assignee Refuses to Accept the Assignment.

The wrong committed by the refusal of the assignee to accept the conveyance of the patent, when duly tendered by the assignor, can generally be redressed only in a suit at law for

press warranty, or the vendor by representation expressly professed to sell the patent as a valid one, and the purchaser relied on that profession, or where the vendor knew that there was a defect in the patent and that it was invalid and concealed the fact (although he made no express representation whatever), and in such concealment was guilty of fraud, the correctness of the decisions cannot be questioned. And one or another of these elements existed in a majority of the cases collected by Mr. Law in his Digest, many of which have been cited on this trial. But it is questionable whether as between two assignees of a patent-right, neither of whom has any opportunity to know whether it is invalid for want of novelty or not, especially since the re-organization of the Patent Office and a provision for a determination of that question by examiners before the patent is granted, and a series of Federal decisions holding such a patent *prima facie* evidence of novelty, the vendor who acts in good faith, in the absence of fraud, express warranty, or any representation or fact other than the mere fact of sale indicating that he sold the patent as valid, the vendor should be holden to an implied warranty and failure of consideration on that ground, if in fact invalid, or the vendor be permitted to defend upon the ground of a mutual misconception of a fact. The English courts would not now so hold on either ground; and I am inclined to think that, upon principle, a discrimination should be made here."

damages. The injury inflicted on the assignor by such refusal is not irreparable to a degree which calls for equitable interference, when it merely leaves the patent in his hands and withholds the service or the money which was to form the consideration for its transfer. There are, however, cases in which the obligations imposed by the contract on the assignee are of such a character that justice cannot be done to the assignor except by a specific performance of the agreement, and in these cases equity will compel its execution, not because the transaction related to a patent privilege, but on account of the peculiar circumstances of the parties and the necessity for this extreme relief.[1] Thus where the consideration to be given for the patent was the conveyance of real property, or the surrender of some right essential to the assignor, the terms of the agreement may be explicitly enforced, and the assignee may be obliged to transfer or release the stipulated property or claim.[2]

§ 1235. Remedy of Assignor for Breach of the Conditions in the Assignment.

For the injury inflicted on the assignor by the non-fulfilment of conditions imposed by the assignment on the assignee, a remedy in damages may be obtained at law. Where the conditions are made essential to the title of the assignee, or are in their nature necessary to the enjoyment of the reserved rights of the assignor, the failure to perform them forfeits the interest of the assignee in the patent, and on a proper application equity will decree a reconveyance.[1] Conditions embraced in the assignment, but which the assignee does not expressly or impliedly promise to perform, though working a forfeiture of his interest in the patent, can neither be enforced in equity nor made the basis of a suit at law.[2]

§ 1234. [1] See § 788 and notes, *ante*.

[2] See § 1229, *ante*.

§ 1235. [1] See § 788 and notes, *ante*.

That if the assignor rescinds for breach of contract he must return the purchase money or other consideration already paid, see Bellis *v.* Henwood (1888), 6 Pa. Co. (Pa.) 78.

[2] That an assignment on conditions, not containing any express agreement to perform the conditions, may be forfeited by not performing, but cannot be enforced, nor is the party liable in damages for non-performance, see Newell *v.* Wheeler (1866), 4 Rob. (N. Y.) 247; Newell *v.* Wheeler (1866), 2 Abb. Pr. 134.

§ 1236. Remedy of the Assignor when the Assignee has Procured the Assignment by Fraud.

The wrong committed by the fraud or unfair dealing of the assignee, in obtaining the conveyance of the patent, may be redressed either at law or equity. If the assignor prefers to treat the conveyance as effective and permit the assignee to retain the patent, he may have his remedy in damages commensurate with the value of the patent of which he has been deprived. But when he desires to rescind the sale equity will afford him this relief on his return of the consideration, and in addition will compel the assignee to account for the benefits which he has received. Where the assignee has not been guilty of actual fraud, but has obtained the patent for an inadequate price through the ignorance of the assignor as to its true value, the contract will be set aside upon the restoration of the purchase money and the payment of a reasonable compensation for the services and expenses of the assignee.[1]

§ 1237. Remedy of Assignor when the Assignee Refuses to Pay the Purchase Money.

Upon the neglect or refusal of the assignee to pay the purchase money for the patent, the assignor may recover the amount in assumpsit, debt, or covenant, according to the form of the contract.[1] To such an action several defences may be urged in addition to a general denial of the obligation, among which are the failure of the title conferred upon the assignee, the invalidity of the patent, and fraud or breach of warranty on the part of the assignor. Concerning each of these defences certain questions have arisen, and been decided, which demand especial mention.

§ 1236. [1] That where a vendor is ignorant of the value of the patent, and a vendee knowing its value purchases it at an inadequate price, and under suspicious circumstances, the sale will be set aside on payment to the vendee of his expenses and a reasonable compensation for his services, see Leonard *v.* Barnum (1874), 34 Wis. 105.

§ 1237. [1] That equity will not set aside the assignment of a patent on the ground that the purchase money has not been paid, see Perkins *v.* United States Electric Light Co. (1883), 24 O. G. 204; 21 Blatch. 308; 16 Fed. Rep. 513.

That the vendee, being bound to pay $1000 within a year or to re-assign the patent, may re-assign on a demand of the money a few days after the year expires, and must then either re-assign or pay, see Manvel *v.* Holdredge (1871), 45 N. Y. 151.

§ 1238. Defences of the Assignee against the Assignor's Action for the Purchase Money: Defective Title.

An assignor whose title, at the time of his conveyance, was defective, or who has failed for any other cause to confer upon the assignee a complete right to the patent, has not performed his own part of the contract and therefore cannot claim the stipulated price.[1] Thus where he is himself an assignee and his assignment is imperfect or remains unrecorded at the risk that a superior title may be gained by others, or where the instrument delivered to the assignee is insufficient to transfer the legal title to the patent, or where a cloud rests on the title affecting its validity or rendering its extent uncertain, the assignee may properly withhold the purchase money till these difficulties are removed, and meanwhile may employ them as a defence against an action brought for its recovery.[2] In this defence the burden of proof lies on the assignee, unless he has been actually disturbed in the enjoyment of the patent by the assertion of a superior title.[3]

§ 1238. [1] That want of title in the assignor is a good defence against his action for the purchase money, see Nye *v.* Raymond (1854), 16 Ill. 153.

That the vendee may show in his defence that there is no such patent as the one assigned to him, see Brown *v.* Wright (1856), 17 Ark. 9; Nye *v.* Raymond (1854), 16 Ill. 153.

That an agreement to procure and assign a patent never executed, and incapable of being executed because the invention is not patentable, is no consideration for a promise to pay money, and no price can be recovered, see Westervelt *v.* Fuller Mfg. Co. (1885), 13 Daly, 352.

That where an assignee re-assigned to the inventor in order that the inventor might take out a patent in his own name, and the inventor gave the assignee his note therefor, and afterward the assignee obtained a patent for part of the former invention as his own, and the inventor was refused a patent on the ground of the assignee's prior patent, the note of the inventor to the assignee is still collectible, it being presumed that the assignee had a right to the patent he obtained and that the inventor had no right to the patent for which he applied, see Clark *v.* Smith (1875), 21 Minn. 539.

[2] That an unrecorded assignment gives a vendor no such title as enables him to maintain an action against his vendee for the price, see Higgins *v.* Strong (1836), 4 Blackf. (Ind.) 182. This case assumes, however, that a record is essential to validity of title, which is untrue.

[3] That a vendee when sued for the price has the burden on him to show that the vendor had no title, unless he has been disturbed in his use of the invention, see Stevens *v.* Head (1837), 9 Vt. 174.

§ 1239. Defences of the Assignee against the Assignor's Action for the Purchase Money: Patent Invalid.

An assignee may defend against an action for the purchase money by showing that no patent answering the description of the assignment ever issued, or that the one described is void, either for want of novelty or utility in the invention or on account of its abandonment before the application, or by reason of a defective specification or excessive Claims, or for substantial variations in a re-issue, or any other cause which would defeat the patent in an action for infringement.[1] Under but one of these objections does any serious question of law arise. It has been urged in many cases that the art or instrument protected by the patent must possess pecuniary value in order to entitle the assignor to recover the price of the patent

§ 1239. [1] That the vendee may defend on the ground that there is no such patent as the one sold, see Brown *v.* Wright (1856), 17 Ark. 9; Nye *v.* Raymond (1854), 16 Ill. 153.

That the defence against an action for the price and a suit to recover back the purchase money stand on different grounds, see Stevens *v.* Head (1837), 9 Vt. 174.

That the invalidity of the patent is a defence on the ground of a failure of consideration, see Marston *v.* Swett (1876), 66 N. Y. 206; Nye *v.* Raymond (1854), 16 Ill. 153. See also § 1230 and notes, *ante*.

That notes given for a void patent are not collectible by the vendor, and their collection may be enjoined, see Darst *v.* Brockway (1842), 11 Ohio, 462.

That if a patent is found void on the ground of prior public use and abandonment, a note given for an interest therein is also void, see Earl *v.* Page (1834), 6 N. H. 477.

That no recovery of purchase money can be had where the patent is void for a defective specification, see Keith *v.* Hobbs (1878), 69 Mo. 84.

That if a patent for an improvement does not so describe the original that the improvement can be known, the patent is defective and the vendee is not liable for the price, see Cross *v.* Huntley (1835), 13 Wend. 385.

That the vendee of a patent void for excessive Claims is bound by the sale unless he repudiates it before the defect is cured by disclaimer, see Hotchkiss *v.* Oliver (1848), 5 Denio, 314.

That no rights of estoppel arise on a *nudum pactum*, and if the patent is void a note based thereon is *nudum pactum*, see Saxton *v.* Dodge (1870), 57 Barb. 84.

That in defending against an action on a note, on the ground that the patent is void, the patent is attacked only collaterally, by way of evidence, see Saxton *v.* Dodge (1870), 57 Barb. 84.

That where the vendor of the patent is himself an assignee, and both he and his vendee are on equal ground as to knowledge of the validity of the patent, and he is guilty of no fraud or concealment, he may recover the purchase money though the patent be invalid, see Johnson *v.* Willimantic Linen Co. (1866), 33 Conn., 436.

from the assignee. But the courts have drawn a broad and clear line of distinction between that uselessness of the invention which avoids the patent and that worthlessness in the market which makes its ownership unprofitable to the assignee. A want of pecuniary value in the invention is no defence to an action for the purchase money, in the absence of fraud or warranty on the part of the assignor.[2] That the patented article has been superseded in the market, or cannot be employed in certain territory, or is universally unsalable, does not prove nor tend to prove that the patent is invalid or that the assignee has not received the property for which the price was to be paid.[3] A want of utility in the invention itself, on the other hand, is a good defence to an action for the purchase money, since the patent being invalid there is no consideration for its payment.[4] Thus where the invention has not been or cannot be reduced to practice, or will not answer its intended purpose without such alterations as require inventive skill, the contract is not binding, although both parties acted in good faith, believing that the invention was available in its appropriate art.[5] But even here the as-

[2] That pecuniary worthlessness is no defence, see Miller *v.* Finley (1872), 26 Mich. 240.

That a note for the price is good, if the patent is valid, though the invention is of no great utility, see Green *v.* Stuart (1874), 7 Baxter (Tenn.), 418.

That if any value exists, however small, the notes given for the patent will be valid, see Myers *v.* Turner (1855), 17 Ill. 179.

[3] That the invention has been superseded is no defence, if it were useful when sold, see Harmon *v.* Bird (1839), 22 Wend. 113.

That the vendee cannot defend on the ground that there is no use for the invention in the territory sold to him, if it is *per se* useful, see Pottle *v.* Thomas (1838), 12 Conn. 565.

That when the specification calls for "water" simply, any water must answer the purpose, and if the water found in the territory sold will not answer the patent is void, see Keith *v.* Hobbs (1878), 69 Mo. 84.

That unsalability is no evidence of inutility, see Jolliffe *v.* Collins (1855), 21 Mo. 338.

[4] That the vendee in an action for the price can defend on the ground that the invention was neither new nor useful, though both parties were in good faith, see Jones *v.* Burnham (1877), 67 Me. 93; Midkiff *v.* Boggess (1860), 15 Ind. 210; McClure *v.* Jeffrey (1856), 8 Ind. 79; Geiger *v.* Cook (1842), 3 Watts & Serg. 266. See also § 1230 and notes, *ante*.

That "useful" means "lawfully useful," at least as far as the consideration for a note is concerned, see Pacific Iron Works *v.* Newhall (1867), 34 Conn. 67.

[5] That if the invention cannot be made practically operative without a

signee who buys on his own judgment, and who without fraud or misconduct by the assignor assumes the entire risk of the utility of the invention, must abide by his agreement and complete the purchase.[6] The utility necessary to sustain the patent is presumed from the existence of the patent, though it may be disproved by the assignee.[7] When this defence is set up by the assignee he should offer to return the patent and account for the profits made in its enjoyment, but when the patent is found void no actual return is necessary.[8] This

further exercise of inventive skill, the patent is void, and the price cannot be recovered, see Cowan *v.* Dodd (1860), 3 Cold. (Tenn.) 278.

That in an action to recover an amount agreed to be paid for future inventions of the plaintiff, the defendant may show that they are worthless, have not been reduced to practice, and were known as worthless before the plaintiff invented them, see McDougall *v.* Fogg (1858), 2 Bosw. (N. Y.) 387.

That uselessness is a defence only when the patent would be void for want of utility, see Wilson *v.* Hentges (1879), 26 Minn. 288.

That the entire uselessness of the invention is a full defence to an action for the price though the patent may be authentic, see Smith *v.* Hightower (1886), 76 Ga. 629; Clough *v.* Patrick (1865), 37 Vt. 421.

That a note given for a patent-right, if negotiable, can be collected by a *bona fide* holder, though the patent is worthless, see Woolen *v.* Ulrich (1878), 64 Ind. 120.

[6] That a vendee who buys on his own judgment cannot defend on the ground of inutility, see Hardesty *v.* Smith (1851), 3 Ind. 39.

[7] That the jury are to judge of utility, see Rowe *v.* Blanchard (1864), 18 Wis. 441.

That on an issue as to the validity of a patent, in a suit between the vendor and vendee, the court must instruct the jury though not all the points are argued before the court, see Bellas *v.* Hays (1819), 5 S. & R. 427.

That it is presumed that an invention is valuable until the contrary is shown, see Gerrish *v.* Bragg (1883), 55 Vt. 329.

That in an action on a note given for a patent-right the patent is not conclusive evidence of the utility of the invention, see Bierce *v.* Stocking (1858), 11 Gray, 174.

That in an action against the vendee for the price, the record of a report of an examiner in the Patent Office, on an application for an extension, is not competent evidence against the patentee to show that the patent was originally invalid, see McMahon *v.* Tyng (1867), 14 Allen, 167.

That evidence of the invalidity of the patent is not admissible in an action for the price unless the Federal courts have declared the patent invalid, see Elmer *v.* Pennel (1855), 40 Mo. 430; *contra*, Nash *v.* Lull (1869), 102 Mass. 60.

[8] That unless the vendee offers to return the patent, and account for the profits made by it, or avers that it had no value, he cannot defend an action for the purchase money on the ground of failure of consideration, see Burns *v.* Barnes (1877), 58 Ind. 436.

That where an assignment is made before the invention is tested, and there is no warranty of utility and no fraud, the vendees must pay the purchase money if they use it either in part or as a

defence is complete even when the assignor, besides conveying the patent, has also furnished materials to the assignee for the invention and given him instructions how to use them.[9] The assignee must, however, spread the facts which prove the invalidity upon the record, though the judgment of the court upon them is only collateral and introductory to that on the main question as to the existence of the debt.[10] Where the patent is found void as to a portion of its Claims and valid as to others, if the price can be apportioned the assignor can recover the amount which may be due for the conveyance of the valid Claims.[11] An assignee, who has transferred his interest in the patent to third parties, cannot avail himself of this defence unless his assignees rescind their contract with him, or refuse to pay, or have subjected him to other loss on this account; and if he does defend, he must return the patent to the assignor except perhaps in cases where its irremediable invalidity is fully proved.[12] The right

whole, though they cannot use it if it be useless, see Palmer's Appeal (1880), 96 Pa. St. 106.

That if the vendee has derived any benefit from the patent the plaintiff can recover the price unless there was a warranty or fraud, and evidence that the patent was of little value is not admissible, see Vaughan *v.* Porter (1844), 16 Vt. 266.

That a vendee cannot take the benefit of the transaction and refuse to pay the price, see Union Mfg. Co. *v.* Lounsbury (1864), 42 Barb. 125.

That it is doubted whether when a void patent is sold, and the purchaser has enjoyed the monopoly and there has been no fraud in the vendor and no liability exists toward others, the vendee can defend against an action for the price, see Marston *v.* Swett (1876), 66 N. Y. 206.

That an assignment or license grants only the right not to be sued or to sue others, which is a right resting wholly on the patent, and hence if the patent fails the right is gone, the sale has no consideration, and though the vendee has used or made the invention, it was only what all had a right to do, and the vendor cannot recover, see Hawks *v.* Swett (1875), 4 Hun (N. Y.), 146; 6 Thomp. & C. 529; Marston *v.* Swett (1875), 4 Hun (N. Y.), 153; 6 Thomp. & C. 534; overruled in Marston *v.* Swett (1876), 66 N. Y. 206.

[9] That the receipt of materials or instructions with the void patent does not impair this defence, see Bliss *v.* Negus (1811), 8 Mass. 46.

[10] That a vendee is not bound by the sale where the patent is void, but if he would defend against an action for the price on that ground, he must spread his equity on the record, see Bellas *v.* Hays (1819), 5 S. & R. 427.

[11] That the vendee must pay *pro tanto* if the patent is partly void, and the subject-matter is divisible, see Nye *v.* Raymond (1854), 16 Ill. 153.

[12] That a vendee who has sold his interest to another cannot defend against his vendor's action for the price on the ground of invalidity or uselessness, un-

to defend against an action for the purchase money, on the ground that the patent is void, may be waived by the parties in their contract, and where they have expressly provided in another manner for its possible invalidity, the assignee cannot allege it as an answer to the suit.[13] That the invention covered by the patent is an infringement upon earlier patents has been declared to be a defence, if the assignee was ignorant of this fact at the time of purchase, but the existence of a later patent for the same invention offers no bar to a recovery by the assignor.[14]

§ 1240. Defences of the Assignee against the Assignor's Action for the Purchase Money: Fraud in the Sale.

That the assignee was led to purchase the monopoly by the fraudulent representations of the assignor is another defence which may be urged successfully against an action for the price.[1] Such representations must have been averments of existing facts, as distinguished from mere expressions of opinion or exaggerated recommendations of the invention, but may relate either to the title of the assignor, the validity of the patent, or the utility and value of the patented process or device. An assignee, defending upon this ground, must offer

less there was a warranty or a fraud, nor can he restore the patent and rescind the sale, and he is also estopped by his own assignment based on that of the vendor, see Thomas *v.* Quintard (1855), 5 Duer, 80.

[13] That if both parties provide in the conveyance for the possible invalidity of the patent, the vendee cannot defend, in an action for the price, on the ground of want of consideration, see Johnson *v.* Willimantic Linen Co. (1866), 33 Conn. 436.

[14] That in a suit on a note given for a patent-right, evidence that the patent was void as being an infringement of a prior patent is not admissible unless that fact has been found by a competent Federal court, see Elmer *v.* Pennel (1855), 40 Me. 430. *Contra*, Nash *v.* Lull (1869), 102 Mass. 60.

That another patent has been granted to a later patentee for the same invention is no defence to a note for a prior patent, see Crow *v.* Eichinger (1870), 34 Ind. 65.

§ 1240. [1] That fraudulent representations by the vendor that the invention was never before patented, and never used except under the patent sold, will be a good defence to a note given therefor, see Morrow *v.* Brown (1869), 31 Ind. 378.

That a note for a patent, fraudulently obtained and void, is invalid though some materials were furnished and instructions given to the vendee, see Bliss *v.* Negus (1811), 8 Mass. 46.

to return the patent, and show that he derived no benefits therefrom, or render an account of those which he received.[2]

§ 1241. Defences of the Assignee against the Assignor's Action for the Purchase Money: Breach of Warranty.

A breach of warranty may constitute an entire or partial defence to an action for the purchase money, according to the nature of the broken covenant.[1] The implied warranty of title, and the express warranty of validity, are of the essence of the contract, and a breach of these relieves the assignee from all his obligations. Other covenants may have the same or a more limited effect, to be determined by the extent to which their non-fulfilment impairs the value of the patent to the assignee. If their infraction is equivalent to a total failure of the consideration for the promise of the assignee to pay the price, or if the price cannot be apportioned between the advantage he receives from the conveyance and that of which he is deprived by the breach of warranty, the action of the assignor must fail. But when he has derived and still retains a partial and separable benefit from the assignment, he may be compelled to pay a corresponding portion of the purchase money.

§ 1242. Defences of the Assignee against the Assignor's Action for the Purchase Money: Special Statutory Defences.

To guard against the perpetration of fraud upon assignees by the sale of invalid patents several of the States have

[2] That where a vendee defends an action for the price on the ground of fraud in the sale, he should aver that he made no profits and offer to reconvey, see Rose *v.* Hurley (1872), 39 Ind. 77.

That a vendee when sued for the price of a patent may show fraudulent representations of the plaintiff as to the usefulness of the invention, although he did not offer to return it after discovering its want of utility, see Groff *v.* Hansel (1878), 33 Md. 161.

§ 1241. [1] That a breach of warranty by the vendor is a defence against the notes given by the vendee, see Hawes *v.* Twogood (1861), 12 Iowa, 582.

That a vendee, who purchases an invention with an agreement from the vendor to pay any license fee which the vendee may be compelled to pay for the use of the invention, may defend against an action for the price *pro tanto*, on the ground that he has paid such license fee on demand of the agent of the patentee, see Orr *v.* Burwell (1849), 15 Ala. 378. See also § 783 and notes, *ante*.

enacted special laws, imposing certain restrictions on the sale, or prescribing certain forms for the expression of the contract. Statutes limiting the right to sell the patent privilege itself have been uniformly held unconstitutional, because impairing franchises conferred by Congress under the Constitution of the United States.[1] But the power of individual States to regulate the use or sale of patented articles, and to compel compliance with specific forms of contract, is unquestionable.[2] Those to which reference is here particularly made relate to negotiable paper given in payment by the assignee. Under the law-merchant such paper in the hands of a *bona fide* holder, who took it in the usual course of business before maturity, is good against the maker irrespective of any equities or possible defences between him and the assignor. The vendor of an invalid patent, or defective title, was thus enabled to deprive the assignee of all defence against an action for the price, by obtaining a negotiable note for the purchase money and negotiating it before the fraud or want of consideration was discovered.[3] To prevent this evil, statutes were enacted in a number of the States, requiring every note given for a patent to recite that fact upon its face and thus put every subsequent holder upon inquiry as to the existence of an adequate consideration. These statutes have been sustained by the courts of last resort, and under them an assignee whose note contains this information can set up any defence

§ 1242. [1] That a State has no power to enact laws impairing the value or affecting the mode of transfer of letters-patent, see People *v.* Russell (1883), 49 Mich. 617; 25 O. G. 504; Wilch *v.* Phelps (1883), 14 Brown (Neb.), 134; Crittenden *v.* White (1876), 23 Minn. 24; Patterson *v.* Com. (1875), 11 Bush (Ky.), 311; Hollida *v.* Hunt (1873), 70 Ill. 109; and other cases cited in § 46, note 4, *ante*.

That a State may require the vendor of patent-rights to file with the county clerk copies of the letters-patent, and an affidavit that the letters are genuine and unrevoked and that he has authority to sell, see Hankey *v.* Downey (1888), 116 Ind. 118; Pape *v.* Wright (1888), 116 Ind. 502; New *v.* Walker (1886), 108 Ind. 365.

[2] That the use or sale of patented articles may be regulated by State laws, see Hackett *v.* State (1885), 105 Ind. 250; Patterson *v.* Com. (1875), 11 Bush (Ky.), 311; and § 46, note 4, *ante*.

[3] That a note given for a patent is good in the hands of a *bona fide* holder though the patent were invalid, see Woolen *v.* Ulrich (1878), 64 Ind. 120.

That the note was procured by fraud is no defence against a *bona fide* holder, see Hereth *v.* Merchants National Bank (1870), 34 Ind. 380.

against the holder which could have been advanced against the assignor.[4] But a note given for a patent, in the usual form and making no disclosure as to its consideration, is not changed in legal character by these statutes. In some States it has, indeed, been decided that, by virtue of these statutes, negotiable paper which omits this notice is open to all defences, in the hands of a holder having knowledge of its consideration, that might have been made if the notice had been properly inserted.[5] But at the same time it is asserted that an innocent holder may rely upon the note when in the ordinary form, whatever may have been the actual consideration.[6]

[4] That a State has power to prescribe the terms of a note given for a patent, see Herdic *v.* Roessler (1888), 109 N. Y. 127; Hankey *v.* Downey (1888), 116 Ind. 118; Pape *v.* Wright (1888), 116 Ind. 502; Herdic *v.* Roessler (1886), 39 Hun (N.Y.), 195; New *v.* Walker (1886), 108 Ind. 365; Tod *v.* Wick Bros. (1881), 36 Ohio St. 370; Haskell *v.* Jones (1878), 86 Pa. St. 173; Domestic Sewing Mach. Co. *v.* Hatfield (1877), 58 Ind. 187; and § 46, note 4, *ante*. *Contra:* Castle *v.* Hutchinson (1885), 25 Fed. Rep. 394; Wilch *v.* Phelps (1883), 14 Brown (Neb.), 134.

That a State may fix a maximum charge for the use of an invention, see Central Union Tel. Co. *v.* Bradbury (1885), 106 Ind. 1.

That the buyer of a note with notice that it was given for a patent is not, as matter of law, chargeable with knowledge that it was obtained by fraud or without consideration, but if he bought it with notice of the fraud he cannot estop the maker from setting up such defences against him, see Sackett *v.* Kellar (1872), 22 Ohio St. 554.

That where it is a penal offence under State laws to take a negotiable note for a patent not containing a statement that it was given for a patent, it is not such offence to take a non-negotiable note, see State *v.* Brower (1876), 30 Ohio St. 101.

That in a suit on a non-negotiable note by the assignee against the maker, the want of consideration is a good defence, see Johnson *v.* McCabe (1871), 37 Ind. 535.

That notes given for the product of an invention, or for the patented article, need not state that fact, though the law requires such statement when the note is given for the patent-right itself, see State *v.* Peck (1874), 25 Ohio St. 26.

[5] That where a State law requires that a note given for a patent shall state that fact on the note itself, a note without it is open, in the hands of one having notice of its consideration, to all defences which could be made if it contained it, see De Long *v.* Barnes (1887), 45 Ohio St. 237; New *v.* Walker (1886), 108 Ind. 365; Weaver *v.* Frantz (1881), 1 Pennypacker (Pa.) 153; Tod *v.* Wick Bros. (1881), 36 Ohio St. 370.

That where a statute requires the note to give notice of its consideration, and it fails to do so, a holder of a note with notice that it was given for a patent is affected by the fraud if there were any, see Hunter *v.* Henninger (1880), 93 Pa. St. 373.

[6] That where a note is given for a patent without the notice required by statute, an innocent *bona fide* holder before maturity is not bound by the equities, see Tescher *v.* Merea (1888),

Where there are no such statutes, the knowledge of a holder that the note was given for a patent does not charge him with any notice of fraud or secret equities, nor does the statement of its consideration alter its effect as negotiable paper under the general law.[7]

SECTION III.

OF THE WRONGS COMMITTED BY LICENSORS AGAINST LICENSEES: AND THEIR REMEDIES.

§ 1243. Rights of the Licensee against the Licensor.

The only universal right of licensees against their licensors consists in the enjoyment of the privileges conferred by the license, without the assertion against them of the prohibitory powers of the monopoly. Their other rights grow out of the peculiar contracts into which they enter, and are incapable of complete classification. The most common among them have, however, from time to time been submitted to adjudication, and the appropriate remedies for their violation have thus been determined. As these remedies are few in number and distinct in character, the subject can be treated more conveniently and clearly by making them the principal topics of discussion and grouping under each the wrongs which can be thereby redressed. These remedies are four: (1) A specific performance of the contract; (2) A rescission of the contract; (3) An action for damages; and (4) An action to recover back money improperly paid to the licensor.

118 Ind. 586; Hunter *v.* Henninger (1880), 93 Pa. St. 373; Haskell *v.* Jones (1878), 86 Pa. St. 173.

[7] That it is presumed that a note given for a patent-right is on good consideration, and a purchaser before maturity is not put on inquiry, see Gerrish *v.* Bragg (1883), 55 Vt. 329.

That the knowledge that a note was given for a patent-right raises no suspicion as to its validity, see Borden *v.* Clark (1873), 26 Mich. 410; Miller *v.* Finley (1872), 26 Mich. 249.

That the words "given for a patent-right," in a note, do not import that there was fraud or give notice to the holder of any equities, see Hereth *v.* Merchants National Bank (1870), 34 Ind. 380.

That writing on a note "given for a patent-right" does not affect the character of the note under the law-merchant, and the maker cannot set up his equities against a *bona fide* holder, see Hereth *v.* Meyer (1870), 33 Ind. 511. *Contra:* Herdic *v.* Roessler (1888), 109 N. Y. 127; Herdic *v.* Roessler (1886), 39 Hun (N. Y.), 195.

§ 1244. Remedies of the Licensee against the Licensor: Specific Performance.

In certain cases equity will decree a specific performance of the contracts embraced in or collateral to the license; in others, it will afford an equivalent remedy by enjoining against conduct contrary to the rights thereby conferred. Where the licensor refuses to execute essential instruments, or where his contract binds him to reduce the license fees if subsequent licenses are granted at a lower rate, these obligations can be specifically enforced.[1] When he endeavors to invade the rights created by the license, as by improperly declaring it forfeited and warning the public against dealing with the licensee, or by licensing others contrary to the terms of an exclusive license; or where having agreed to supply the licensee with the patented articles for sale, he threatens to retire from business and assign the patent, to the destruction of the value of the license, — an injunction may be granted to restrain him from his contemplated wrong.[2] In all cases,

§ 1244. [1] That a parol contract for a license can be specifically enforced, see Nichols *v.* Marsh (1886), 61 Mich. 509.

That an implied contract can be specifically enforced, see Fuller Co. *v.* Bartlett (1887), 68 Wis. 73.

That a contract to reduce royalties if others are licensed at a less sum is enforceable in equity, see Washburn & Moen Mfg. Co. *v.* Chicago Galvanized Wire Fence Co. (1884), 109 Ill. 71.

That in a suit by a licensee against one of three joint licensors, to obtain a change of terms in the license, all must be made parties or there can be no decree, see Florence Sewing Mach. Co. *v.* Singer Mfg. Co. (1870), 4 Fisher, 329; 8 Blatch. 113.

That where the licensor agreed with the licensee not to license others at a less royalty without reducing his, and does so license, this *ipso facto* reduces his, see Florence Sewing Mach. Co. *v.* Grover & Baker Sewing Mach. Co. (1872), 110 Mass. 70.

[2] In Baker Mfg. Co. *v.* Washburn & Moen Mfg. Co. (1883), 5 McCrary, 504, McCrary, J.: (507) "We think that so much of the injunction as restrains the defendant from declaring a forfeiture of the complainant's license for non-payment of royalty at the rate originally fixed therein should remain in force. A public declaration of such a revocation might greatly injure the business of the complainant, and the damages could not readily be ascertained and compensated in money. It would destroy, in a great measure, confidence in the right and title of complainant, and thus disable it from making sales. Persons dealing in patented articles must be able to assure the public that they have a clear right to do so, in order to secure patronage, since both seller and buyer may be liable in damages if the article is sold in violation of the rights of the owner of the patent-right." 18 Fed. Rep. 172 (174).

That the licensor of an exclusive

however, the circumstances of the parties and the consequences of the wrongful act must govern. The license contract is eminently a personal one, and therefore if no ground for equitable interference exists, either in the subject-matter of the agreement or the irreparable injury which its violation will entail, the licensee must seek his remedy at law.[8]

§ 1245. Remedies of the Licensee against the Licensor: Rescission of the License.

The license, with its dependent contracts, may be rescinded by a court of equity on account of fraudulent representations of the licensor inducing the acceptance of the license by the licensee, or on account of flagrant breaches of the contract.[1] Where the licensor forbids the licensee to practise the invention, and especially where in an action for infringement he prevents him by an injunction from enjoying the privileges bestowed upon him by the license, the licensee is absolved from its obligations, and may obtain from equity its formal and final cancellation.[2] Whether a licensee can, under any

licensee to sell, having agreed to supply the licensee with articles for sale, may be enjoined from giving up his business and assigning his patents and so destroying the value of the license, see Singer Sewing Mach. Co. *v.* Union Button Hole and Embroidery Co. (1873), Holmes, 253; 6 Fisher, 480; 4 O. G. 553.

[8] That equity will not define the conditions in a license, nor save the licensee from the consequences of his mistakes of fact or construction, see Florence Sewing Mach. Co. *v.* Singer Mfg. Co. (1870), 4 Fisher, 329; 8 Blatch. 113.

That equity will not interfere to prevent the licensor from denying the licensee's right, or the licensor from revoking the license, see Florence Sewing Mach. Co. *v.* Singer Mfg. Co. (1870), 4 Fisher, 329; 8 Blatch. 113.

That on a deposit of a license fee, pending a motion to enjoin the licensor from interfering with the licensee, and the dismissal of the bill, the fee will be ordered paid to the licensor or be retained by the court till the whole case is decided, see Florence Sewing Mach. Co. *v.* Singer Mfg. Co. (1871), 4 Fisher, 348; 8 Blatch. 177.

That a party receiving a benefit from a contract may be restrained from violating it, though the other party be not bound, see Singer Mfg. Co. *v.* Union Button Hole & Embroidery Co. (1873), 4 O. G. 553; 6 Fisher, 480; Holmes, 253.

§ 1245. [1] That a license may be annulled on the ground of fraudulent misrepresentations of the licensor as to the salableness of the invention, see Hull *v.* Fields (1882), 76 Va. 594.

[2] That a licensor does not *ipso facto* dissolve the contract by prohibiting the licensee from using the patented article, see Union Mfg. Co. *v.* Lounsbury (1864), 42 Barb. 125.

That suing out and serving an injunction is a breach of the contract of license, see Sullings *v.* Goodyear Dental Vulcanite Co. (1877), 36 Mich. 313.

circumstances, so repudiate the license as to escape all liability for breach of its conditions may be doubted; but its rescission in a court of equity determines the relation between him and the licensor, and makes him thenceforward a stranger to the patent.[3]

§ 1246. Remedies of the Licensee against the Licensor: Action for Breach of Contract.

An action for damages may be maintained at law by the licensee for any breach of the license contract on the part of the licensor. Where an exclusive license has been granted, or a license containing stipulations not to license others in the future, a violation of these stipulations renders the licensor liable for all resulting injuries.[1] Such an exclusive right is invaded by every concession, by suit or otherwise, which operates as a recognition of the privilege in others, whether they are later patentees or not, and whether the invention which they practise is identical with or different in name and formal attributes from that covered by the license.[2] An agreement of the licensor to sue infringers, and to use due diligence in the protection of the licensee, subjects him to an action if he neglects this duty, though such agreements do not oblige him to attack those whose claims are based on adverse patents, or estop him from averring that his efforts would be fruitless on account of the invalidity of his own patent.[3]

[3] See §§ 819, 820, 822, and notes, *ante*.

§ 1246. [1] That a new license granted to others, in violation of the rights of an existing licensee, makes the licensor liable for all resulting damage, see Pitts *v.* Jameson (1853), 15 Barb. 310.

That where a royalty is based on the number of articles sold, if the licensee ceases to make and sell he abandons his license, and the licensor may then license to other parties, see Pitts *v.* Jameson (1853), 15 Barb. 310.

[2] That an agreement by the licensor not to license any other person is broken by every concession, by suit or otherwise, which operates as a recognition of the rights of others to make and use, whether they are later patentees or not, see Jackson *v.* Allen (1876), 120 Mass. 64.

That a licensor granting an exclusive territorial license excludes himself and all others from using any device, though different in name, which is substantially the same, see Ferree *v.* Smith (1877), 29 La. An. 811.

[3] That if a licensor who has agreed to prosecute infringers stops the infringement in any way, it complies with the agreement, see Foster *v.* Goldschmidt (1884), 21 Fed. Rep. 70; 28 O. G. 915; 22 Blatch. 287.

That a license with a covenant to sue

Acts of infringement by the licensor, within the territory of his licensee, may be treated as breaches of contract and the basis of an action for damages, or as infringements calling for an equitable remedy, at the option of the licensee.

§ 1247. Remedies of the Licensee against the Licensor: Action to Recover Back the Moneys already Paid.

An action will lie to recover license fees paid by mistake or on a contract procured by the fraud of the licensor. Where several patents are covered by one license, and the amount due to each can be apportioned, if the gross sum is paid in good faith after some of the patents have expired, the part received for the expired patents must be refunded.[1] Mistakes in computation, followed by erroneous payments, may be rectified in the same manner. Where license fees have been obtained by fraud, and no benefit whatever has resulted to the licensee, an action to enforce repayment may be maintained. But when the licensee has derived from the license advantages equivalent to the sum expended, although he may recover nominal damages in an action for the fraud, a restoration of the license fee cannot be claimed.[2] That the patent is adjudged invalid after license fees have been paid affords no ground for their recovery from the licensor.[3]

infringers, and not to license others, Stanley Rule & Level Co. *v.* Bailey (1878), 45 Conn. 464.

That where a receiver by agreement for three owners of a patent recovers the royalties for them and pays them over, and the licensee sues to recover them back as paid by mistake, the owners must be the defendants though no demand was made on the receiver, before distribution, by the licensees, see Florence Sewing Mach. Co. *v.* Grover & Baker Sewing Mach. Co. (1872), 110 Mass. 70.

and to use diligence in securing the licensee's rights, does not bind the licensor to protect the licensee against persons claiming under adverse patents, or warrant against them, or estop the licensor from denying the validity of the patent in a suit for damages for not suing or for licensing others, see Jackson *v.* Allen (1876), 120 Mass. 64.

§ 1247. [1] That where licensees under several patents continue to pay royalties on all after some have expired, without knowledge on their part or notice from the licensor, they can recover back what they should not have paid in assumpsit, if they are without fault and acting under a mistake of fact, believing that all the patents are still in force, see

[2] That a settlement made under threat of a suit is not void for fraud or intimidation, see Pope Mfg. Co. *v.* Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781.

[3] That money paid for license fees cannot be recovered back after the pat-

SECTION IV.

OF THE WRONGS COMMITTED BY LICENSEES AGAINST LICENSORS: AND THEIR REMEDIES.

§ 1248. Rights of Licensor against Licensee.

The rights of a licensor against his licensee are wholly governed by their private contracts, and can therefore assume *any form the parties may desire. In few, if any, cases are* these rights enforceable in equity, except by a rescission of the contract for their violation, — actions for damages and for unpaid license fees affording usually an ample remedy.

§ 1249. Remedies of Licensor against Licensee: Rescission of License.

A license may be rescinded in equity, on the application of the licensor, whenever the misconduct of the licensee renders its continuance prejudicial to the contract rights of the licensor. Thus where the licensee refuses to comply with the terms of the license, and thereby causes injury to the licensor, a bill in equity will lie to revoke it and to recover damages.[1] The same remedy exists when the licensee assigns to others a mere personal license, or when, having agreed to pay a license fee based on the number of patented devices which he makes and sells, he neglects to manufacture them in reasonable quantities and put them on the market.[2] A breach of covenant

ent is declared invalid, see Schwargenbach *v.* Odorless Excavating Apparatus Co. (1885), 35 O. G. 1339.

That a settlement under fear of suit cannot be rescinded on the ground that the patent has subsequently been held invalid in a suit by other parties, see Pope Mfg. Co. *v.* Owsley (1886), 27 Fed. Rep. 100; 37 O. G. 781.

It would seem that the doctrine of these cases should be so modified as to conform to that governing the right of the licensor to recover license fees, as set forth in § 1251 and notes, *post.*

§ 1249. [1] That where a licensee refuses to comply with the terms of his license a bill will lie to revoke his license and for damages, see Adams *v.* Meyrose (1882), 10 Fed. Rep. 671.

[2] That the assignment of a personal license is invalid, see § 823 and notes, *ante.*

That the failure of the licensee to manufacture and sell the articles on which royalties are payable is an abandonment of the license, see Pitts *v.* Jameson (1853), 15 Barb. 310.

That an agreement to pay the inventor a royalty until $5,000 has been paid, and then a lower one, is an agree-

does not, however, *ipso facto* annul the license, nor can this be accomplished by notice to the licensee to cease his use of the invention, though such notice must be given by the licensor if the terms of the agreement so require.[3] The licensee has a right to be heard by a competent tribunal before his privileges can be withdrawn, and if the licensor attempts to declare the license void, and in this manner interfere with the business of the licensee, he may be enjoined, on proper conditions, until the right to forfeiture can be determined.[4] Equity will not aid a licensor in enforcing his rights unless he has substantially fulfilled his own obligations, and the licensee in his defence may set up the same matters which would avail him if the suit were one at law for an infringement.[5]

§ 1250. Remedies of Licensor against Licensee: Action for Breach of Contract.

A licensee who violates the provisions of his license may be sued on the contract for damages. When his wrongful acts constitute also an infringement of the patent the licensor

ment to continue the business as long as it is reasonably profitable, see Wilson *v.* Marlow (1872), 66 Ill. 385.

[3] That a license is not forfeited by non-payment of royalties, unless the license so provides, and the licensor can sue only in the local courts for royalties, not in the Federal courts for infringement, see Consolidated Middlings Purifier Co. *v.* Wolf (1886), 37 O. G. 567; 28 Fed. Rep. 814.

That a license cannot be annulled by a mere notice to the licensee, see Union Mfg. Co. *v.* Lounsbury (1864), 42 Barb. 125.

[4] That a license can be rescinded only by mutual agreement of the parties or by a court of equity, see § 822 and notes, *ante*.

That an agreement that on failure of the licensee to perform his covenants the licensor may rescind the license by a written notice is valid, and if the license is so rescinded future uses will be infringements, see Hammacher *v.* Wilson (1886), 36 O. G. 233; 26 Fed. Rep. 239.

That where a licensor attempts to revoke the license and notifies the public of such revocation he may be enjoined, see Baker Mfg. Co. *v.* Washburn & Moen Mfg. Co. (1883), 5 McCrary, 504; 18 Fed. Rep. 172.

[5] That equity will not aid a licensor who has not kept his own covenants with the licensee, see Foster *v.* Goldschmidt (1884), 22 Blatch. 287; 21 Fed. Rep. 70; 28 O. G. 915.

That a licensee cannot justify his infringements by the licensor's breach of contract, see Willis *v.* McCollin (1886), 38 O. G. 1017; 29 Fed. Rep. 641.

That a licensor who has misrepresented his rights to his licensees and fails to protect them is not entitled to a specific performance of their contract, see Brewster *v.* Tuthill Spring Co. (1888), 34 Fed. Rep. 769.

may have his remedy either for the breach of contract or for the invasion of the monopoly; and if he adopts the former the measure of his damages will be the injury caused by the infringement.[1] When his violation of the agreement consists

§ 1250. [1] In Magic Ruffle Co. *v.* Elm City Co. (1875), 8 O. G. 773, Shipman, J.: (774) "If the licensee 'uses the patented invention beyond the limits of the license or grant, or in any way not authorized by the license or grant, then there has been a violation of a right secured to the patentee under a law of the United States, giving to him the exclusive right to use the thing patented, although such licensee performs, according to their terms, all the *covenants entered into by him.*' (Goodyear *v.* Union India Rubber Co., 4 Blatchf. C. C. R. 65; Wood *v.* Wells, Crittenden & Co., 6 Fisher's Patent Cases, 382.) And if the licensees have also expressly covenanted in their agreement of license that they will do, or will not do, a particular act, or will not use the invention for a particular purpose, a violation of such covenant is also a breach of contract, not arising under the laws of the United States but for which remedy may be sought in the Circuit court of the United States, provided the citizenship of the parties gives jurisdiction to such courts. (Goodyear *v.* Union India Rubber Co., cited, *supra;* Goodyear *v.* Congress Rubber Co., 3 Blatchf. C. C. R. 455; Wilson *v.* Sanford, 10 Howard, 99.) In this case it was competent for the complainants to take either one of the two remedies for the alleged injury which have been mentioned. They could bring a bill alleging an injury to their exclusive rights under the laws of the United States, or, as the residence of the party gave this court jurisdiction, could bring a proper suit setting up the breach of the contract as the gravamen of their action. The averments of their bill are sufficient to justify a court in holding it necessary that it is a bill for an injury to their patent-rights, but it is manifest from an examination of the stating part of the bill that the pleader intended to make the alleged breach of agreement the foundation of the action, and that he is seeking to recover damages for an injury to the complainants arising out of the violation of the contract. But the defendants insist that a bill in equity, based upon the contract, cannot be sustained, because for a breach of the contract there is complete and adequate remedy at law. There is undoubtedly a remedy at law for the alleged injury. The only question is whether it is complete and adequate. If the complainants were seeking to recover royalties which the defendants had agreed to pay, inasmuch as the account is particularly within the knowledge of the defendants, or if the patent was still in existence and the prevention remedy by injunction against future injuries could be administered, there would be no question that a bill in equity would be a proper remedy. (Eureka Co. *v.* Bailey, 11 Wall. 488; Goodyear *v.* Congress Rubber Co., 3 Blatchf. C. C. R. 449; Rich *et al. v.* Atwater, 16 Conn. 409.) In this case the defendants had not agreed to pay royalties, and an injunction cannot be granted inasmuch as the patent has expired. It is alleged that the defendants have violated the contract of license by manufacturing and selling a ruffle which they were not authorized to make, and which they had agreed not to make. By this violation the complainants say that they have been injured, and the redress which they ultimately seek is the payment of dam-

in mere omissions, — as where he fails to practise the invention and thus realize the stipulated royalties for the licensor, — the suit must be for damages alone.[2] The licensee, when sued for the breach of a covenant concerning his mode of using the invention, is not estopped by the covenant from averring that the patent of the licensor is void.[3]

ages. Although the suit is upon the contract the damage to the complainants, if any, is the damage which they have sustained from the injury to their patent-rights. The ascertainment of the facts from which such damages can be estimated is, in cases of injury to property in letters-patent, peculiarly within the province of a court of equity, because the facts from which damages are to be computed can only be ascertained by an account and a discovery of the number and amount of articles which have been sold by the defendants, facts which are exclusively within their knowledge. They alone have the evidence which can enable the complainants to recover either at law or in equity." 13 Blatch. 151 (156) ; 2 Baun. & A. 152 (157).

That a licensee, exceeding his license, may be sued either under the contract or as an infringer, see Pope Mfg. Co. *v.* Owsley (1886), 37 O. G. 781 ; 27 Fed. Rep. 100.

That in such cases the damages for the breach of contract are measured by the loss caused by the infringement, see Magic Ruffle Co. *v.* Elm City Co. (1875), 13 Blatch. 151 ; 2 Baun. & A. 152 ; 8 O. G. 773.

That after recovery in assumpsit or account no further damages for the infringement can be claimed, see Steam Stone Cutter Co. *v.* Sheldons (1883), 24 O. G. 703 ; 15 Fed. Rep. 608 ; 21 Blatch. 260.

[2] That mere non-payment of royalties does not make the licensee an infringer, see Consolidated Middlings Purifier Co. *v.* Wolf (1886), 37 O. G. 567 ; 28 Fed. Rep. 814.

That a contract to pay royalties *per* thing done obliges the licensee only to pay for what is actually done not on what might have been done, see Newell *v.* Wheeler (1867), 2 Trans. Ap. (N. Y.) 160.

That an agreement to pay a certain sum for each of the first four hundred machines made is not a contract to make that number, see Babcock *v.* Northern Pacific R. R. Co. (1886), 26 Fed. Rep. 756 ; 36 O. G. 942.

[3] That a covenant by the licensee as to the mode of use of the invention does not estop him from showing that the patent is void when he is sued thereon, see Bliss *v.* Negus (1811), 8 Mass. 46 ; Hayne *v.* Maltby (1789), 3 D. & E. 438.

That a covenant to aid in suppressing infringements is binding on the licensee personally, see Washburn & Moen Mfg. Co. *v.* Southern Wire Co. (1889), 37 Fed. Rep. 428.

That the covenants in a license cannot deprive the licensee of the right to show that his acts do not infringe the patent, see White *v.* Lee (1882), 23 O. G. 1621 ; 14 Fed. Rep. 789.

That a breach of the license by the licensor does not justify the licensee in infringing, see Willis *v.* McCollin (1886), 38 O. G. 1017 ; 29 Fed. Rep. 641.

That the revocation of a license before the alleged infringement leaves the former licensee to urge any defence open to ordinary infringers, see Wooster

§ 1251. Remedies of the Licensor against the Licensee: Action for License Fees for the Use of the Invention.

The refusal or neglect of a licensee to pay the stipulated license fees subjects him to an action at law for their recovery.[1] The obligation to recompense the licensor for the use of the invention is somewhat different in its nature and its consequences from the obligation to pay royalties on actual sales, and these two obligations must be, therefore, separately considered. The obligation to pay the license fee for the use of the invention arises on the acceptance of the license by the licensee.[2] It is immaterial whether he actually practises the invention or not, the consideration for his contract being his immunity against the prohibitions of the patent. It is also of no importance whether the invention has pecuniary value in the market, or eventually proves beneficial to the

v. Singer Mfg. Co. (1883), 23 O. G. 2513.

That equity may compel a discovery of the number of articles made under a license, if the licensee has covenanted to make such disclosures and fails to do so, see Pope Mfg. Co. *v.* Owsley (1886), 37 O. G. 781; 27 Fed. Rep. 100.

That a contract to arbitrate before suit is binding, and the plaintiff must show that he has made all reasonable efforts in that direction, see Perkins *v.* United States Electric Light Co. (1883), 24 O. G. 204; 21 Blatch. 308.

§ 1251. [1] That the remedy for a breach of contract to pay license fees is an action at law unless discovery or other equitable relief is needed, see Ball Glove Fastening Co. *v.* Ball & Socket Fastener Co. (1888), 36 Fed. Rep. 309; McKay *v.* Mace (1884), 23 Fed. Rep. 76; 17 Phila. 573; McMillan *v.* St. Louis & Miss. Valley Trans. Co. (1883), 18 Fed. Rep. 260; 5 McCrary, 561; Blanchard *v.* Sprague (1859), 1 Clifford, 288.

That equity has no jurisdiction of a suit to recover a license fee, see McMillin *v.* St. Louis & Miss. Valley Transportation Co. (1883), 18 Fed. Rep. 260; 5 McCrary, 561; Blanchard *v.* Sprague (1859), 1 Clifford, 288.

That equity has jurisdiction over a bill for discovery and account under a license for royalties, if the parties are of different citizenship, see McKay *v.* Mace (1884), 23 Fed. Rep. 76; 17 Phila. 573.

That equity has jurisdiction over a bill for an injunction, discovery, and account against licensees who fail to comply with continuing obligations, see McKay *v.* Smith (1886), 29 Fed. Rep. 295; 39 O. G. 959.

That a license may run after an extension and the royalty will be collectible, see Union Mfg. Co. *v.* Lounsbury (1869), 41 N. Y. 363; Union Mfg. Co. *v.* Lounsbury (1864), 42 Barb. 125.

That a use by the vendees of a licensee is a use by him and he is liable to pay license fees for such use, see Sherman *v.* Champlain Transportation Co. (1858), 31 Vt. 162.

[2] That the obligation to pay the license fee is implied from the acceptance of the license, see Paper Stock Disinfecting Co. *v.* Boston Disinfecting Co. (1888), 147 Mass. 318.

licensee. Until the license is repudiated, or the contract is rescinded, his liability continues and the payments must be made. When sued for license fees, however, he may defend on any ground which is equivalent to a failure of the consideration for his contract.[3] Thus he may set up a want of title in his licensor, and show that other parties own the same or a superior patent to whom he may be held responsible for its enjoyment, unless he knew of the defect of title when he accepted the license.[4] But where he is the owner of the rival patent, and took the license to quiet the dispute between himself and the licensor, and has received the benefit desired, he cannot in an action for the license fee attack the title which his conduct has admitted.[5] Nor can a title under a subsequent patent be urged by him in his defence, unless his recognition of the title of the licensor was fraudulently obtained.[6] It has sometimes been said that if the patent of the licensor is void there can be no consideration for the contract since a void patent creates no monopoly, and where there is no monopoly there can be no actual immunity.[7] This position

[3] That where the consideration for the license fees has wholly failed they cannot be collected, see Jenkins *v.* Abbotts (1874), 54 N. H. 447.

That a licensee cannot defend a suit for royalties on the ground that the licensor grants licenses to others at a less rate unless there was an express covenant that he would not do so, see McKay *v.* Smith (1889), 39 Fed. Rep. 556.

[4] That a licensee cannot show want of title in his licensor as a defence to an action for license fees, if he had due notice of the facts when the license was given, see Jones *v.* Burnham (1877), 67 Me. 93.

That a licensee taking his license with a full knowledge of the adverse claims against the patent, and enjoying the benefit of his license, cannot then attack the licensor's patent, see Parkhurst *v.* Kinsman (1849), 1 Blatch. 488.

[5] That a rival patentee, taking a license to quiet a dispute and receiving its benefits, cannot defend a suit for license fees by denying the right of the licensor, see Hall Mfg. Co. *v.* American Railway Supply Co. (1882), 48 Mich. 321.

[6] That a licensee when sued on the license cannot defend by setting up rights under a subsequent patent to justify his non-performance of duty, or question the validity of the plaintiff's patent, unless he alleges fraud in the plaintiff, see Forncrook Mfg. Co. *v.* Barnum Wire & Iron Works (1884), 54 Mich. 552.

[7] That the price for a license to use the invention is not recoverable if the patent is void or the licensor has no title, see Pacific Iron Works *v.* Newhall (1867), 34 Conn. 67.

That on a license to practise the invention, the royalty is not collectible if the patent is worthless, see Jenkins *v.* Abbotts (1874), 54 N. H. 447.

That in a suit by payees or endorsees with notice on a note for license fees,

is, however, incorrect, for while the patent remains unimpugned by a decree of invalidity the ability of the patentee to enforce it, and consequently the immunity from its prohibitions enjoyed by the licensee, are presumed to be legitimate and real. Hence it has been held, in other and better considered cases, that if the patent is apparently valid the licensee, under its assumed protection, has enjoyed advantages of which, without the license, he would have been deprived, and that his obligations under the license continue until he is disturbed in his enjoyment by a superior patent, or until the patent under which he acts has been declared invalid or annulled.[8] Upon

the defendant has the same rights as if the suit were for license fees direct, and if the patent is void the note is without consideration, see Saxton *v.* Dodge (1870), 57 Barb. 84.

That an exclusive license to make, with an agreement to assign after the license expires, is without consideration if the patent is invalid, and the license fee cannot be recovered, the licensee enjoying no rights which he did not already have, see Harlow *v.* Putnam (1878), 124 Mass. 553.

[8] That an assignment and a license stand on different ground as to the defence of want of consideration, since if the patent is invalid the assignee gets nothing, while the licensee may still have received benefits, see Jones *v.* Burnham (1877), 67 Me. 93.

That a licensee, receiving benefits under a license covenanting not to deny validity, is estopped from making such denial in a suit for license fees, see Magic Ruffle Co. *v.* Elm City Co. (1875), 8 O. G., 773; 13 Blatch. 151; 2 Bann. & A. 152.

That a licensee, after long delay and having enjoyed all possible benefits of the patent, cannot deny the consideration of the license, see Davis *v.* Gray (1867), 17 Ohio St. 330.

That a licensee who has had the benefit of exclusive rights under a patent cannot deny its validity, see Rogers *v.* Reissner (1887), 41 O. G. 351; 30 Fed. Rep. 525.

That where a licensee derives any benefit from the license, though it be not an exclusive one, there is no failure of consideration, see Laver *v.* Dennett (1883), 109 U. S. 90; 25 O. G. 882.

That a licensee may dispute a patent when he has repudiated it with full knowledge of the licensor, see Brown *v.* Lapham (1886), 37 O. G. 676; 23 Blatch. 475; 27 Fed. Rep. 77.

That a licensee covenanting not to dispute the patent, or the licensor's title, is estopped while the license remains in force, see Pope Mfg. Co. *v.* Owsley (1886), 37 O. G. 781; 27 Fed. Rep. 100.

That the vendor of a machine, sold with a right to use a patented article therewith, can recover the price of the machine without proving his right under the patent, unless it appears that the vendee has been interfered with by one whose rights are *prima facie* violated by its use, see Buss *v.* Putney (1859), 38 N. H. 44.

That until the patent is annulled, or adjudged invalid, a licensee receiving its benefit must pay the license fees, see White *v.* Lee (1882), 23 O. G. 1621; 14 Fed. Rep. 789; Marston *v.* Swett

his eviction or the overthrow of the patent his liability to pay for the further use of the invention ceases, and whether his license fees were payable at intervals, or in a gross sum which is yet unpaid, the licensor can collect only an amount sufficient to cover the period of liability. And when the license fees have been paid for the whole term of the patent by a gross sum in advance it would seem that the licensee should recover from the licensor such a proportion of the amount as the remainder of the term bears to the period of liability, since as to that part of the license fee the consideration must have wholly failed. The obligations of licensees, under licenses to use implied from the relations of the parties, are in most respects identical with those created by express licenses, though they are not bound by the same estoppels.[9] A licensee, under an implied license arising from the lawful purchase of a patented device, acquires a right to use it as long as its identity can be preserved. Into the price of the device, in such cases, the license fee also enters, and when sued for the price the vendee may defend by showing that the article is an infringement of a prior patent and is therefore practically useless, or may set off against the price a license fee which he

(1880), 82 N. Y. 526; Hilsen *v.* Libby, (1878), 44 Sup. Ct. N. Y. 12.

That where the licensee is estopped by his agreement the license is not affected by the fact that in a suit between other parties the patent has been held invalid, see Pope Mfg. Co. *v.* Owsley (1886), 37 O. G. 781; 27 Fed. Rep. 100.

That the vendee of a right to use cannot enjoin the vendor from suing for the price on the ground of a prior patent, unless there has been warranty or fraud, see Cansler *v.* Eaton (1856), 2 Jones Eq. (N. C.), 499.

[9] That assumpsit will lie to recover for use under an implied license, see Deane *v.* Hodge (1886), 35 Minn. 146.

That where an inventor was an officer of a corporation which used his invention with his consent, he can recover in assumpsit a reasonable compensation for such use unless it was implied to be without compensation, see Deane *v.* Hodge (1886), 35 Minn. 146.

That where two patents cover improvements on the same invention, and an action in assumpsit is brought on both, recovery may be had on the second as to so much of the invention as is not covered by the first, see Deane *v.* Hodge (1886), 35 Minn. 146.

That one who uses under an implied license cannot deny utility when sued for compensation, see Palmer *v.* U. S. (1885), 20 Ct. of Claims, 432.

That in an action to recover a royalty on an implied contract where the question of priority is raised, the patentee may show his efforts and achievements in the art in order to prove that he was the first inventor, see Hubbell *v.* U. S. (1885), 20 Ct. of Claims, 354.

has been compelled to pay in order to enjoy it.[10] A vendee, who has purchased with an option to return the article or pay the price inclusive of the license fee, must exercise his option within the stipulated or a reasonable time, or the sale will become absolute and the price can be recovered.[11]

§ 1252. Remedies of the Licensor against the Licensee: Action for Royalties on Sales.

The obligation to pay royalties on sales arises only when the sale is completed and the price received. Every voluntary act of the licensee which places the article beyond his own control has the legal effect of a sale, and is sufficient to create a liability for royalties.[1] Thus where he recovers dam-

[10] That a note for a device which the vendor represented to be covered by his patent, but which is in fact an infringement of the patent of another inventor, and has been enjoined as such, is void, see Pacific Iron Works *v.* Newhall (1867), 34 Conn. 67.

That the price of a patented machine cannot be recovered when the machine is an infringement on a prior patent and worthless, though its separate parts may be valuable, see Peck *v.* Farrington (1832), 9 Wend. 44.

That a vendee of a patented article cannot defend an action for the purchase money on the ground that he has been sued as an infringer and incurred expense thereby, though the vendor agreed to give him an indemnity bond and has failed to do so, but the failure to give the bond might be a complete defence by itself, see Horne *v.* Hoyle (1886), 27 Fed. Rep. 216; 36 O. G. 1248.

That a vendee may defend an action for the price on the ground that the invention infringes other patents, see Croninger *v.* Paige (1879), 48 Wis. 229.

[11] That if the vendee was to pay or return the device, he must return or tender a return within reasonable time or he will be liable to the payment, see Pottle *v.* Thomas (1838), 12 Conn. 565.

That the agreement by the licensee to deliver up the licensed article at the end of a year is not fulfilled by his leaving it on the licensor's desk in his office, but in his absence and in the absence of any one acting for him, and without waiting a reasonable time to see him, although a delivery may be made at his place of business as well as at his residence, see Wooster *v.* Sandman (1879), 8 Daly (N. Y.), 218.

That the attempt to exercise an option, in cases where it does not exist, does not affect the general remedies for breach of contract, see Weed *v.* Draper (1870), 104 Mass. 28.

§ 1252. [1] That any act which has the effect of a sale is a sale for the purpose of estimating royalties, see Wilder *v.* Adams (1860), 16 Gray, 478.

That where an article passes beyond the control of the licensee by his own act it is equivalent to a sale for the purposes of a royalty, see Wilder *v.* Stearns (1871), 48 N. Y. 656.

That where one licensee, who is bound to pay a royalty on each article sold by him, buys articles of another licensee whose liability is the same, and

ages against infringers and in this mode legitimates their sales, these become practically sales of his, and royalties on them are payable to the licensor.[2] This liability he cannot avoid by varying the form or name of the article while its substantial attributes remain, nor by disposing of it in an incomplete condition to another licensee, nor is it terminated by a revocation of the license.[3] Upon an action for the recovery of royalties, sales may be proved by evidence of the manufacture and shipment of the articles, and if the licensee refuses to disclose their number and amount it will be presumed that these have not decreased since the last account was rendered.[4]

then sells them, he is not bound to pay a royalty on them though the other licensee fails to pay his royalty on them, see Howe *v.* Wooldredge (1866), 12 Allen, 18.

That where a certain sum is to be paid for every article sold or caused to be sold by the promisor he must account for every transfer of the right to use the article, and for all settlements made with those who use it without right, these being, in effect, sales also, see Rodgers *v.* Torrant (1880), 43 Mich. 113.

[2] That where a licensee, in pursuance of an agreement to sue infringers, recovers damages against them and thus legitimates their sales, he must pay a royalty on these articles also, it being in effect a sale, see Wilder *v.* Adams (1860), 16 Gray, 478.

[3] That a royalty must be paid on devices which employ equivalent elements, as well as on those which conform to the letter of the specification, see Wilder *v.* Adams (1860), 16 Gray, 478.

That a royalty on each article made and sold or disposed of covers unfinished articles sold to a new company succeeding the licensee, see Marsh *v.* Dodge (1875), 4 Hun (N. Y.), 278; 6 Thomp. & C. 568.

That although a licensee has been notified by the licensor that the license is terminated for breach of condition, the licensor can recover his royalty for the articles made and sold as well after as before the service of such notice, see Union Mfg. Co. *v.* Lounsbury (1869), 41 N. Y. 363.

That where a licensor, having been notified of the licensee's intention to terminate his license to use certain machines *after* three months, permits the licensee to sell the machines to a third party, and knowingly acquiesces in such sale for two years, he cannot then demand royalties from the licensee, see Wilde *v.* Smith (1879), 8 Daly, 196.

[4] That in a suit for royalties on sales, manufacture and shipment are *prima facie* evidence of sale, see Marsh *v.* Dodge (1872), 5 Lans. (N. Y.) 541.

That where the defendant in an action for royalties on sales refuses to account and show his books, it may be presumed that he sold as many as the last account showed, see Smith *v.* Standard Laundry Co. (1882), 11 Daly (N. Y.), 154.

That where a yearly royalty is payable, and the licensee has exercised his option to terminate the license in the middle of a year, he is obliged to pay a *pro rata* portion of the annual royalty, see Gale *v.* Nourse (1860), 15 Gray, 300.

The licensee, in his defence, cannot attack the patent or the title of his licensor. In the price which he has charged and received for the articles sold the royalty has been computed and collected from the purchaser, and having derived this advantage from the license, he cannot be permitted to deny its obligations.[5] If the patent be in fact invalid his benefit is none the less on that account, and the apparent monopoly which it creates has at least served him in securing a market for his products and the profit on his sales.[6] But when the

[5] That a licensee in defence to an action for accrued royalties on sales cannot deny the validity of the patent, see Hyatt *v.* Ingalls (1883), 49 Sup. Ct. N. Y. 375; Jones *v.* Burnham (1877), 67 Me. 93; Marston *v.* Swett (1876), 66 N. Y. 206; *Marsh v. Dodge* (1875), 4 Hun (N.Y.), 278; 6 Thomp. & C. 568.

That an exclusive licensee to sell, having received the full benefit of his license, cannot in an action thereon deny the power of the licensor to license, nor question the validity of his patent, though he himself owns a rival patent and took a license to quiet disputes, see Hall Mfg. Co. *v.* American Railway Supply Co. (1882), 48 Mich. 331.

That on a suit for license fees for machines actually sold by the defendant, it is not a defence that the plaintiff is not the true inventor or that he has broken the contract, since if damages could be recouped against him, this would be no plea in bar, see Birdsell *v.* Perego (1865), 5 Blatch. 251.

That a licensee while receiving benefits under an apparently valid patent is obliged to pay his royalties, and the invalidity of the patent is no defence, see McKay *v.* Smith (1889), 39 Fed. Rep. 556; Covell *v.* Boatwick (1889), 39 Fed. Rep. 421; Marsh *v.* Harris Mfg. Co. (1885), 62 Wis. 276; Hyatt *v.* Ingalls (1883), 49 Sup. Ct. N. Y. 375; Patterson's Appeal (1882), 99 Pa. St. 521; Angier *v.* Eaton, Cole, & Burnham Co. (1881), 98 Pa. St. 594.

That the licensee is estopped to deny the validity of the patent only as to acts done while the license was in force, see Tibbe Mfg. Co. *v.* Heineker (1889), 37 Fed. Rep. 686.

That a licensee, knowing the patent to be of doubtful validity, is obliged to pay the royalties as long as he receives the benefit, and cannot deny the validity of the patent, nor the title of the patentee, while he is not interfered with, see Jones *v.* Burnham (1877), 67 Me. 93.

That it is doubtful whether a licensee under a re-issue, when sued for royalties, can show that the re-issue is void, see Washburn & Moen Mfg. Co. *v.* Wilson (1882), 48 Sup. Ct. N. Y. 159.

That where no fraud is practised, one who agrees with full knowledge to pay a royalty under a patent cannot afterwards deny its validity, see Eureka Co. *v.* Bailey Co. (1870), 11 Wall. 488.

That an agreement in a license that the licensee is estopped to deny the validity of the patent will bind him in a suit for royalties, see Marsh *v.* Harris Mfg. Co. (1885), 63 Wis. 276; Every *v.* Candee (1879), 17 Blatch. 200; 4 Bann. & A. 545.

That the liability of the licensee for royalties continues until he rescinds the license and gives notice thereof to the licensor, see Marston *v.* Swett (1880), 82 N. Y. 526.

[6] That royalties on sales are due and collectible although the patent is actually invalid, since benefit therefrom has

patent is repealed, or priority is awarded to other parties, or a superior title is asserted resulting either in the interruption of his business or in the creation of new liabilities to the paramount owner, he can repudiate the license, and refuse to pay the stipulated royalties.[7] Thenceforward if he practises the

accrued to the licensee, see Smith *v.* Standard Laundry Co. (1882), 11 Daly (N. Y.), 154; Marston *v.* Swett (1880), 82 N. Y. 526. *Contra:* Hawks *v.* Swett (1875), 4 Hun (N. Y.), 146; 6 Thomp. & C. 529. But see Marston *v.* Swett (1876), 66 N. Y. 206; and Wilson *v.* Hentges (1879), 26 Minn. 200, — a case which evidently misapprehends the nature of the benefits received by the licensee under a license to sell.

That although a patent may not be good for all it claims, a licensee having the benefit of it cannot take advantage of its invalidity in a suit for royalties, see Milligan *v.* Lalance & Grosjean Mfg. Co. (1884), 21 Fed. Rep. 570; 29 O. G. 367.

That a note given for the right to sell in certain places a machine which is practically valueless is without consideration, the availability of the machine for use being always warranted, see Smith *v.* Hightower (1886), 76 Ga. 629.

[7] In White *v.* Lee (1882), 14 Fed. Rep. 789, Lowell, J.: (790) "The question has been argued whether the defendant can resist an action for license fees, under a contract, by proving that the patent is void. In his very thorough brief the defendant cites all the important cases; and they in a cursory examination seem to present a difference of opinion, which on a more careful study will be found to disappear. Many of the decisions treat a licensor as a landlord, and a licensee as his tenant, who cannot dispute the title so long as he has the occupancy of the premises. Many of the cases, such as Bowman *v.* Taylor, 2 Adol. & E. 278; Smith *v.* Scott, 6 C. B. (N. S.) 771; Wilder *v.* Adams, 2 Wood. & M. 320, are actions at law, and turn upon the effect of a recital or covenant in a sealed instrument. The agreement in this case is not under seal, and this is not an action at law. Other cases state the general doctrine in a somewhat absolute and general way, hardly admitting exceptions. (See Crossley *v.* Dixon, 10 H. L. Cas. 203; Clark *v.* Adie, 2 App. Cas. 423.) On the other hand there are cases in the United States which seem to hold that the invalidity of the patent may always be proved, such as Harlow *v.* Putnam, 124 Mass. 553. But these were cases on either side which required no nice distinctions. The law is, I think, that a plea or answer that the patent is void is not of itself a sufficient defence, but that evidence of what may be called an eviction is such defence. The difficulty is to ascertain what amounts to an eviction in a patent case. It is easily discovered whether a tenant of a certain parcel of land has or has not been evicted; but if a patent is void, still the licensee may have had all the benefit of a valid patent, because his exclusive title may never have been disputed. In Lawes *v.* Purser, 6 El. & Bl. 930, 932, the counsel for the plaintiff admitted that if every one had publicly used the patented invention, that might be equivalent to an eviction; but contended that a simple plea that the patent was void might mean merely that the pleader, when he began to draw his plea, had discovered a technical flaw which no one else had thought of; and the judgment pursued this exact line of reasoning. In a case in Massachusetts, the defendants, who were licensees and

invention, the remedy of the licensor is by a suit for damages for breach of contract, or by an action for infringement. An assignment of the license does not relieve the licensee from his obligation to pay the proper royalties, the assignee being regarded as his agent and the sales made on his account.[8] A

had used the patent to keep off competition, were said by Thomas, J., to have had all the benefit of a valid patent. (Bartlett *v.* Holbrook, 1 Gray, 114.) In New York in a case which was twice brought before the Court of Appeals, it was held, — first, that mere invalidity of the patent was not a defence; and second, that a repeal of the patent was a defence. (Marston *v.* Swett, 66 N. Y. 206; s. c. 82 N. Y. 526.) These cases point to the true distinction, however difficult its application may sometimes be, that something corresponding to eviction must be proved if a licensee would defend against an action for royalties." 23 O. G. 1621 (1621).

In Marston *v.* Swett (1880), 82 N. Y. 526, Finch, J.: (533) "We think the true rule to be deduced from the authorities is this: Where the patent is apparently valid and in force the party using it, receiving the benefit of its supposed validity, is liable for royalties agreed to be paid and cannot set up as a defence the actual invalidity of the patent. The reasons for the rule are that the party has got what he bargained for; that he cannot be allowed at the same time to affirm and disaffirm the patent; and that he cannot in this way force the patentee into a defence of his right and compel him to try it in a collateral action. While the manufacture goes on under such an apparently valid patent it is presumed to be under and in accordance with the agreement to pay royalties. If the manufacturer does not so intend, and chooses to make the patented article, not under the patent, but in hostility to it, he must give notice of that intention, in order that the presumption may not attach or the patentee be misled. But if the patent is annulled or destroyed by due and effective legal proceedings, and priority of invention and a patent is awarded to another, no notice is necessary, for there is no presumption or inference of manufacture under a patent judicially avoided and annulled. It ceases to exist. The manufacture is either absolutely free, or an infringement upon the rights of the prior inventor, or in submission to his claims."

That a licensee must repudiate his license before he can defend against a claim for royalties by denying the validity of the patent, see Hyatt *v.* Ingalls (1883), 49 Sup. Ct. N. Y. 375.

That where a licensor sues the licensee for fees, the licensee cannot attack the patent unless he can prove eviction, see Rogers *v.* Reissner (1887), 30 Fed. Rep. 525; 41 O. G. 351.

That an exclusive licensee, in defence to an action for royalties on sales, may show that a prior patentee is in the market asserting his superior rights and supplying the market, and that the licensee is thus deprived of his exclusive use, and may be accountable for his use to the prior patentee, see Angier *v.* Eaton, Cole, & Burnham Co. (1881), 98 Pa. St. 594.

That the mere claim by third parties that the licensee infringes is no defence to an action for royalties on sales, see Davis *v.* Gray (1867), 17 Ohio St. 330.

[8] That an assignment of his license does not relieve the licensee from his obligation to pay royalties, see Wilde *v.* Smith (1879), 8 Daly (N. Y.), 196.

licensor will not be enjoined from suing to recover royalties although his claims exceed the fees named in the contract, since this as well as other elements of the controversy are capable of determination in a court of law; nor, on the other hand, can he prevent the licensee by an injunction from exercising his rights under the license, on the ground that license fees remain unpaid.[9]

SECTION V.

OF THE WRONGS COMMITTED BY JOINT-OWNERS AND OTHER CONTRACTING PARTIES AGAINST EACH OTHER: AND THEIR REMEDIES.

§ 1253. Rights of Co-owners against Each Other.

No relation is created between joint-owners of a patent by the mere fact of their common interest in the invention. Each is entitled, under the present condition of our law, to practise the invention and to license others, without accountability to his co-owner. If he exceeds the privilege conferred upon him by the patent, and employs an infringing art or instrument, he is to his co-owners like a stranger to the patent, and may be sued for the infringement in the usual mode.[1] To establish between joint-owners such relations as involve mutual responsibility within the limits of the patent special contracts are necessary, and these are construed and enforced in the same manner as between parties who are not co-owners.[2] In certain cases contracts are implied from the circumstances under which their joint interest has arisen.

[9] That a licensor will not be enjoined from suing for his license fees on the ground that he charges the plaintiff more than he agreed to, his true defence being at law, but he may be enjoined from declaring the license void and thus putting the licensee to great loss, see Baker Mfg. Co. *v.* Washburn & Moen Mfg. Co. (1883), 18 Fed. Rep. 172; 5 McCrary, 504.

That a failure to pay royalties does not make the licensee an infringer, see Consolidated Middlings Purifier Co. *v.* Wolf (1886), 37 O. G. 567; 28 Fed. Rep. 814.

§ 1253. [1] See §§ 797, 913, and notes, *ante*.

[2] See § 798 and notes, *ante*.

Thus where the patentee of an original invention and the inventor of an improvement united in a re-issue of the patent, covering the improved invention, and were therein named as joint patentees, their rights were held to have become inseparable, and either could restrain the other from employing the invention except for their joint benefit.[3]

§ 1254. Reciprocal Rights of Co-owners who are also Partners.

The principal relation formed by express contract between joint-owners of a patent is that of partnership in the business in which the patented invention is to be employed. While this relation subsists their rights as patentees are subordinated to their rights as partners. Neither is at liberty to use the invention, nor to license others to use it, contrary to the welfare of the common enterprise, and any attempt to do so may be met by an injunction.[1] At the same time their power under the Patent Laws to grant such licenses is not impaired, and parties purchasing from either, in good faith and without a knowledge of the partnership agreement, can exercise their privileges, leaving the other owner to his remedy for damages against their licensor for his breach of the contract. Where the articles of partnership require one of the owners to give his time to the joint enterprise, he is entitled to a rea-

[3] That where two patentees obtain separate patents for the same invention, and afterward a joint patent for it, they are estopped under the latter from asserting their title under the former, see Barrett *v.* Hall (1818), 1 Mason, 447 ; 1 Robb, 207.

That where the patentee of an original invention and the inventor of an improvement unite in a re-issue covering both, each can restrain the other from using it except for their joint benefit, see Duke *v.* Graham (1884), 19 Fed. Rep. 647.

§ 1254. [1] That a patent may be contributed to the capital stock of a partnership, see Rehfuss *v.* Moore (1889), 6 Pa. Co. (Pa.) 245 ; Farr *v.* Morrill (1889) 53 Hun (N. Y.), 30.

That the representative of a deceased partner may maintain a bill in equity to compel the surviving partner to sell letters-patent belonging to the firm, and to account for the use of the patent since the death of the deceased partner, see Freeman *v.* Freeman (1883), 136 Mass. 260.

That co-owners, being partners, are liable for acts in violation of the partnership agreement, see § 798 and notes, *ante.*

That a co-owner, not named as licensor, is entitled to his share of the royalties if the co-owners were partners when the license was granted, see Rogers *v.* Reissner (1887), 41 O. G. 351 ; 30 Fed. Rep. 525.

sonable compensation for his services, and if by their agreement his wages are to be deducted from the profits of the business and no profits are realized, he may assert them as a debt against the partnership.[2] Such partnership agreements are, however, void if the patent is invalid, and either, in a suit against him by the other on the contract, may set up invalidity in his defence.[3] Their violation of the partnership agreement subjects them to the same actions, whether at law or equity, which are available to other partners.

§ 1255. Reciprocal Rights of Joint Licensees: Third Parties.

Joint licensees also sustain relations to each other, through their express or implied contracts, from which arise peculiar rights whose violation demands a legal remedy. The most common form of these relations is that of partnership, in which the members of a licensed firm become jointly and severally liable to the licensor for the performance of the contract and the payment of the stipulated fees. Their relation as copartners is governed by the ordinary rules of partnerships, and their remedies against each other follow the usual course of partnership litigation. But as joint licensees each is a surety for the collective body to which all belong, and may be held responsible for the fulfilment of the obligations which it has assumed.[1] Each likewise has his remedy against the firm for payments made or conditions performed on its account, and in an action to enforce these rights the liability of the surety or the firm to the licensor is not open to inquiry, the fact that the surety has been damnified entitling him to a recovery.[2] Other relations between licensees,

[2] That under an agreement between the inventor and his co-owner of the patent that the time given to the invention by the inventor shall be paid for by a deduction from the royalties received on account of the other, wages may be claimed if no royalties are due, see Rice *v.* Garnhart (1874), 34 Wis. 453.

[3] That an agreement providing that the co-owner shall pay the inventor for devoting his time and skill to practising the invention is invalid if the patent is void, see Rice *v.* Garnhart (1874), 34 Wis. 453.

§ 1255. [1] That each member of a licensed firm is liable for the license fees and is surety for any assignee of the firm, see Sizer *v.* Ray (1881), 87 N. Y. 220.

[2] That a former member of a licensed firm, suing as surety for license fees paid by him on its account, cannot be defeated

of various character and obligation, may subsist, for wrongs against which actions lie in equity or at law. The rights and duties of third parties in reference to the different owners of the privileges created by letters-patent, with the single exception of the duty to respect the monopoly, rest upon the same principles and are enforced by the same methods as those arising out of ordinary contracts, express or implied.[3]

SECTION VI.

OF THE COURTS HAVING JURISDICTION OVER WRONGS BETWEEN CONTRACTING PARTIES.

§ 1256. Jurisdiction of Federal Courts over Contract Actions.

In actions upon contracts the jurisdiction of the Federal courts depends upon the citizenship of the parties, although the subject-matter of the contract is a right arising under the Patent Laws. When, therefore, the plaintiff and defendant reside in different States, any of the foregoing actions may be instituted in the Federal courts, and there pursued to a complete recovery. But when the parties are citizens of the same State the local tribunals alone have jurisdiction of the controversy. A State court, however, cannot decree an assignment of a patent on the ground that the petitioner is the true inventor, for this is indirectly an adjudication on the priority

by proof that the firm was not liable to the licensor, see Sizer *v.* Ray (1881), 87 N. Y. 220.

[3] That any person may make a contract to supply a patented article, taking his own risk of obtaining a license, see Hobart *v.* Detroit (1868), 17 Mich. 246.

That it is doubtful whether a city can reject the lowest bid on a contract, on the ground that the bidder has no rights under the patent, if he is willing to give proper bonds to carry out his contract, see Atty. Gen. *v.* Detroit (1872), 26 Mich. 263.

That where a patentee is the only bidder on a city contract, to be awarded, by law, to the lowest bidder, he will be the lowest bidder since others could have bid, see Hobart *v.* Detroit (1868), 17 Mich. 246.

That an injunction to refrain from trespassing on an exclusive license to sell a device may issue against parties who are not bound by and who do not have any notice of the contract, see Singer Mfg. Co. *v.* Union Button-Hole & Embroidery Co. (1873), 4 O. G. 553; 6 Fisher, 480; Holmes, 253.

That a contract not to make certain articles during the life of a patent is not in restraint of trade, see Billings *v.* Ames (1862), 32 Mo. 265.

of invention and the validity of an existing patent; nor can it entertain any suit by which the patentability of the invention or the fact of an infringement is to be determined.[1]

§ 1257. Jurisdiction of State Courts over Contract Actions.

Over all questions of pure contract a State court has undoubted jurisdiction.[1] It can compel specific performance, or set aside agreements.[2] It can protect the various parties by injunction against the invasion of their contract rights.[3] It can award damages for breach of warranty, for non-fulfilment of conditions, and for fraud.[4] It can enforce the payment of

§ 1256. [1] That a State court cannot enjoin infringements, see Kayser *v.* Arnold (1886), 41 Hun (N. Y.), 275; Continental Store Service Co. *v.* Clark (1885), 100 N. Y. 365; 7 N. Y. Code Pr. 183.

That a State court cannot decree the assignment of a patent on the ground that the petitioner is the real inventor, see Slemmer's Appeal (1868), 58 Pa. St. 155. See also as to this entire Section §§ 854–866, *ante*.

§ 1257. [1] That a State court has jurisdiction over actions on contracts though the validity of a patent, or fraud, may be in question, see Page *v.* Dickerson (1871), 28 Wis. 694.

That a State court can enforce a contract though the patent is contested by the same parties in the Federal courts, see Nichols *v.* Marsh (1886), 61 Mich. 509.

[2] That a State court has jurisdiction over the subject-matter of the patent, though not over its validity, see Maurice *v.* Devol (1883), 23 W. Va. 247.

That a State court can enforce a contract for a patent, and may collaterally pass on its validity, see Continental Store Service Co. *v.* Clark (1885), 100 N. Y. 365; 7 N. Y. Code Pr. 183; Slemmer's Appeal (1868), 58 Pa. St. 155.

That a State court has jurisdiction over an action to compel an inventor to assign the patent in pursuance of a former agreement, see Wrinn *v.* Annin (1888), 34 Fed. Rep. 435; Fuller Co. *v.* Bartlett (1887), 68 Wis. 73; Binney *v.* Annan (1871), 107 Mass. 94.

That a State court has jurisdiction to set aside a sale of the title and interest in a patent and extension on the ground of fraud on the part of the vendee, see Leonard *v.* Barnum (1874), 34 Wis. 105.

That a State court cannot rescind a contract to purchase a patent on the ground that the patent is invalid, that being a question for the Federal authority alone, see Cowan *v.* Mitchell (1872), 11 Heisk. (Tenn.) 87.

[3] That a State court has complete jurisdiction over an action on an express contract in regard to the use of the patent, though its validity is in question, see Williams *v.* Star Sand Co. (1888), 35 Fed. Rep. 369; Creighton *v.* Haggarty (1884), 50 Sup. Ct. N. Y. 9.

That in an action in a State court, for breach of a covenant that the patent is for a new invention and on a new principle, the plaintiff may attack the patent and show the contrary, see Wright *v.* Wilson (1857), 11 Rich. Law (S. C.), 144.

[4] That a State court has jurisdiction over an action for breach of warranty and of a covenant that the invention is

purchase money, license fees, or royalties.[5] It can enjoin against such torts and violations of agreement as would not find an adequate remedy at law.[6] These powers are ample for all actions, except those which involve the existence of the patent as a franchise granted by the general government, or seek direct redress for an infringement of the patented invention.[7]

§ 1258. Jurisdiction of the Court of Claims.

The Court of Claims occupies toward the United States, in some respects, the position of a State court toward its citizens. On this court Congress has conferred jurisdiction over all contract claims of individuals against the United States, and here the owner of a patent must seek his remedy when the govern-

new and on a new principle, see Wright *v.* Wilson (1857), 11 Rich. Law (S. C.), 144.

That a State court may inquire into the validity of a patent in a suit on a contract, when its invalidity will show a failure of consideration, see Rice *v.* Garnhart (1874), 34 Wis. 453.

That a State court has jurisdiction over an action for fraud in selling a patent-right, see Hunt *v.* Hoover (1868), 24 Iowa, 231; Lindsay *v.* Roraback (1858), 4 Jones. Eq. (N. C.) 124.

That a State court has jurisdiction over an action for fraud in the sale of a patent-right though the validity and construction of the patent are collaterally involved, see David *v.* Park (1870), 103 Mass. 501.

[5] That a State court has jurisdiction of a suit to recover the price agreed to be paid for an assignment, with a request for the issue of the patent to the assignee, see Lockwood *v.* Lockwood (1871), 33 Iowa, 509.

That State courts have exclusive jurisdiction over actions for royalties, see Hubbard *v.* Allen (1888), 123 Pa. St. 198; Dale Tile Mfg. Co. *v.* Hiatt (1888), 125 U. S. 46.

That a State court has jurisdiction over actions for royalties though the validity of the patent may be disputed by the defendant, see Hyatt *v.* Ingalls (1883), 49 Sup. Ct. N. Y. 375.

[6] That a State court may enjoin against the publication of a libel on a patent-right, see Emack *v.* Kane (1888), 36 Fed. Rep. 46; Bell *v.* Singer Mfg. Co. (1880), 65 Ga. 452.

[7] That where judgment on the issue will affect the right conferred by the patent, a State court has no jurisdiction, see Saxton *v.* Dodge (1870), 57 Barb. 84.

That a question as to the effect of an assignment of *one* third of an *invention* upon three divisional patents issued for such invention, is solely for the Federal courts, see Puetz *v.* Bransford (1887), 32 Fed. Rep. 318.

That a State court cannot enjoin a patentee from circulating notices warning people *not* to buy the patented article except from him, if the questions of validity and infringement are in issue, see Hovey *v.* Rubber Tip Pencil Co. (1871), 33 Sup. Ct. N. Y. 522.

ment has made use of his invention.[1] A wrongful invasion of his rights on the part of the sovereign who created and protects them cannot be contemplated by the law as possible, and therefore it is presumed that every appropriation of a patented invention for the use and by the authority of the United States is under a contract, express or implied, to pay

§ 1258. [1] In James *v.* Campbell (1882), 104 U. S. 356, Bradley, J: (358) "But the mode of obtaining compensation from the United States for the use of an invention where such use has not been by the consent of the patentee has never been specifically provided for by any statute. The most proper forum for such a claim is the Court of Claims, if that court has the requisite jurisdiction. As its jurisdiction does not extend to torts, there might be some difficulty, as the law now stands, in prosecuting in that court a claim for the unauthorized use of a patented invention, although, where the tort is waived and the claim is placed upon the footing of an implied contract, we understand that the court has in several instances entertained the jurisdiction. It is true it overruled such a claim on the original patent in this case, presented in 1867; but, according to more recent holdings, it would properly now take cognizance of the case. The question of its jurisdiction has never been presented for the consideration of this court, and it would be premature for us to determine it now. If the jurisdiction of the Court of Claims should not be finally sustained, the only remedy against the United States, until Congress enlarges the jurisdiction of that court, would be to apply to Congress itself. The course adopted in the present case of instituting an action against a public officer, who acts only for and in behalf of the Government, is open to serious objections. We doubt very much whether such an action can be sustained. It is substantially a suit against the United States itself, which cannot be maintained under the guise of a suit against its officers and agents except in the manner provided by law." 21 O. G. 337 (338).

That the Court of Claims has jurisdiction of a suit against the United States on a special contract with a patentee for the use of his invention at an agreed price, see Burns *v.* U. S. (1868), 4 Ct. of Claims, 113.

That the United States may be sued in the Court of Claims to recover for the use of an invention by its employees even when the right of the patentee is denied, the recovery being under the right of eminent domain for compensation, see Hollister *v.* Benedict & Burnham Mfg. Co. (1885), 113 U. S. 59.

That the use of an invention by the United States is not a "caption of property" and is not within the jurisdiction of the Court of Claims, see Pitcher *v.* U. S. (1863), 1 Ct. of Claims, 7.

That an official of the government, known to the patentee to have no authority to purchase the patent on behalf of the United States, cannot bind it by his contract to pay for the use of the invention, see Shavor *v.* U. S. (1868), 4 Ct. of Claims, 440.

That a contract between a patentee and the government for the use of his invention can be determined by the government only when it ceases to use the invention and it must pay while it uses, see Burns *v.* U. S. (1868), 4 Ct. of Claims, 113.

That whether a patentee can waive an infringement by the government and sue on the implied contract, *quere*, see

the established or a reasonable compensation.[2] This compensation may be recovered by a proceeding instituted in the Court of Claims, in form and nature similar to a suit in equity.

United States *v.* Palmer (1888), 128 U. S. 262.

That the United States has a right to use, without compensation, an invention made by its agent under its direction and at its expense, see Solomons *v.* United States (1886), 21 Ct. of Claims, 479; s. c. (1887), 22 Ct. of Claims, 335.

That an officer of the United States cannot claim a royalty for his use of his own invention in the public service, see Davis *v.* United States (1888), 23 Ct. of Claims, 329.

[2] That the Court of Claims has no jurisdiction of infringement suits, see Forehand *v.* United States (1888), 23 Ct. of Claims, 477; Fletcher *v.* United States (1875), 11 Ct. of Claims, 748.

That the Court of Claims has jurisdiction over actions against the United States for royalties, see United States *v.* Palmer (1888), 128 U. S. 262; McKeever *v.* United States (1878), 14 Ct. of Claims, 396; 23 O. G. 1525; 18 Ct. of Claims, 757.

That if the United States practises the invention without license it is liable to make compensation, and no provision of the Constitution exempts it from such liability, see Palmer *v.* United States (1885), 20 Ct. of Claims, 432; McKeever *v.* United States (1878), 14 Ct. of Claims, 396; 28 O. G. 1525.

That no contract can be implied from the mere use of the invention, see Forehand *v.* United States (1888), 23 Ct. of Claims, 477.

That when the government advertises for inventions for a certain purpose, and two similar but distinct inventions are submitted by different inventors, one of which is adopted, there is no implied contract in favor of the other inventor, see Fletcher *v.* United States (1875), 11 Ct. of Claims, 748.

That Congress may by special act direct the Court of Claims to ascertain what compensation should be paid to a patentee for the use of his invention by the government, see Dahlgren *v.* U. S. (1880), 16 Ct. of Claims, 30.

That the liability of the United States for the use of the invention is the same when the court inquires in pursuance of a reference by Congress, though the damages are limited by an amount named in the act of reference, see Hubbell *v.* United States (1869), 5 Ct. of Claims, 1.

That the validity of the patent may be denied in a suit against the United States for compensation on an implied contract, see Hubbell *v.* United States (1885), 20 Ct. of Claims, 354; Morse Arms Mfg. Co. *v.* United States (1880), 16 Ct. of Claims, 296.

That the claim of the inventor against the United States may be barred by the Statute of Limitations, see Butler *v.* United States (1888), 23 Ct. of Claims, 335.

That where the government has made and used an invention, but has not dealt in it nor made a commercial profit from it, damages are to be measured by the value of the invention to the government over other devices which it had a right to employ, see Dahlgren *v.* United States (1880), 16 Ct. of Claims, 30.

That the United States is not liable in damages for the unlawful issue of a patent to a rival inventor, see Thistle *v.* United States (1856), Devereux, Ct. of Claims, 130.

APPENDIX.

THIS appendix contains a digest of those cases decided and published since the body of the work went to press, which either state or illustrate propositions of law. Cases turning wholly upon questions of fact are not cited. A number of these cases have been added to the notes in the correction of the proof-sheets, but do not appear in all the paragraphs to which they are pertinent, and are therefore here repeated. Taken together with the notes, this appendix is intended to present a complete digest of all the cases, involving questions of Patent Law, in the Federal or State reports down to and including the following volumes, viz.: 133 U. S.; 40 Fed. Rep.; 49 O. G.; 24 Ct. of Claims; 24 Blatch.; 13 Sawyer; 11 Bissell; 5 McCrary; 6 Mackey; 87 Ala.; 51 Ark.; 81 Cal.; 12 Col.; 59 Conn.; 5 Dak.; 5 Del.; 5 Del. Ch.; 24 Fla.; 82 Ga.; 1 Idaho; 128 Ill.; 29 Ill. App.; 120 Ind.; 77 Iowa; 42 Kan.; 87 Ky.; 40 La.; 81 Me.; 70 Md.; 149 Mass.; 75 Mich.; 40 Minn.; 66 Miss.; 98 Mo.; 36 Mo. App.; 8 Mont.; 28 Neb.; 19 Nev.; 66 N. H.; 118 N. Y.; 56 N. Y. Sup. Ct.; 17 N. Y. Civ. Proc.; 14 Daly (N. Y.); 62 Hun (N. Y.); 67 How. Pr. (N. Y.); 23 Abb. (N. Y.); 5 Denio (N. Y.); 51 N. J.; 45 N. J. Eq.; 2 New Mex.; 104 N. C.; 46 Ohio St.; 17 Oregon; 129 Pa. St.; 3 Grant (Pa.); 2 Woodw. (Pa.); 6 Pa. Co. (Pa.); 4 Pennypacker (Pa.); 17 Phila. (Pa.); 15 R. I.; 30 S. C.; 87 Tenn.; 74 Tex.; 27 Tex. App.; 3 Utah; 61 Vt.; 84 Va.; 3 Wash.; 32 W. Va.; 74 Wis.; 2 Wy.; 5 Bann. & A.; 6 Fisher; 2 Robb. The English cases are also brought down to 14 L. R. App.; 42 L. R. Ch. D.; 23 L. R. Q. B.

ABANDONMENT OF APPLICATION.

See APPLICATION.

ABANDONMENT TO THE PUBLIC.

Invention must be Complete.

That a mere mental conception can be abandoned as to rival inventors, but only a completed invention can be abandoned to the public, see Webster *v.* Sanford (1888), 44 O. G. 567.

By Delay before Application.

That delay in applying for a patent is not *ipso facto* abandonment, see United States Electric Lighting Co. *v.* Consolidated Electric Light Co. (1888), 33 Fed. Rep. 869.

That laches in applying for a patent will defeat the first inventor in favor of a diligent later inventor, see Hubel *v.* Dick (1886), 24 Blatch. 59; 28 Fed. Rep. 132; 36 O. G. 939.

By Public Use or Sale.

That experimental sale and use is not public use, see Campbell *v.* City of New York (1888), 35 Fed. Rep. 504; 44 O. G. 1185.

That an experimental use by an inventor is not public use, though a profit is derived from such use, but if the use is mainly for profit and the experiment is only incidental, and the use is public and for more than two years before the application for a patent, it is an abandonment, see Smith & Griggs Mfg. Co. *v.* Sprague, (1887), 123 U. S. 249; 41 O. G. 1037.

That where an invention is put into public use without reserving rights in it or exercising control over it, or examining it to test its efficiency, the use is not experimental, see Root *v.* Third Ave. R. R. Co. (1889), 37 Fed. Rep. 673; 46 O. G. 1393.

That the burden rests on the patentee to show that a public use more than two years before the application was experimental, see Root *v.* Third Ave. R. R. Co. (1889), 37 Fed. Rep. 673; 46 O. G. 1393.

That a use in public being proved more than two years before application, the plaintiff has the burden to show that it was experimental, see Smith & Griggs Mfg. Co. *v.* Sprague (1887), 123 U. S. 249; 41 O. G. 1037.

That "two years before the application" means before the application is filed in the Patent Office, see Campbell *v.* City of New York (1888), 35 Fed. Rep. 504; 44 O. G. 1185.

That the assignment of a patent covering an invention is not a sale of the invention, nor can it be regarded as public use or sale upon the question of abandonment, see United States Electric Lighting Co. *v.* Consolidated Electric Light Co. (1888), 33 Fed. Rep. 869.

That to an abandonment by public use the knowledge and consent of the inventor is not necessary under the Acts of 1836 and 1839, see Andrews *v.* Hovey (1888) 124 U. S. 694; 42 O. G. 1285; Blessing *v.* Tragesar Steam Copper Works (1888) 34 Fed. Rep. 753; Andrews *v.* Hovey (1887), 123 U. S. 267; 41 O. G. 1162.

That public use or sale need not be with the "knowledge, acquiescence, or consent of the inventor," and an allegation to that effect is surplusage, see Campbell *v.* City of New York (1888), 35 Fed. Rep. 504; 44 O. G. 1185.

For a discussion and interpretation of Sec. 7, Act of 1839, see Andrews *v.* Hovey (1888) 124 U. S. 694; 42 O. G. 1285; Andrews *v.* Hovey (1887), 123 U. S. 267; 41 O. G. 1162.

That public use under a joint patent is a bar to a sole patent to one of the former joint patentees, see *Ex parte* MacLay (1889), 49 O. G. 1043.

By Application.

That when a patentee has full knowledge of all the facts, a failure to claim may be an abandonment to the public, see Huber *v.* N. O. Nelson Mfg. Co. (1889), 38 Fed. Rep. 830; 47 O. G. 1732.

That a failure to claim described matter is abandonment unless steps are taken to protect it by timely application, see Brush Electric Co. *v.* Fort Wayne Electric Light Co. (1889), 40 Fed. Rep. 826.

That to fully describe and not claim

is abandonment unless the right to a future patent is reserved, see Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co. (1887), 33 Fed. Rep. 254.

That the reservation in an application of matter to be covered by future patents is improper, the inventor's right to his invention and a patent for it being independent of any such precaution, see *Ex parte* Blair (1888), 43 O. G. 113.

That a described invention essentially distinct from the one claimed in the application, and which ought not to have been mentioned therein, is not dedicated to the public, see *Ex parte* Johnston (1889), 46 O. G. 1641.

That the description of an art in a patent for the apparatus does not dedicate the art to the public if a patent therefor is applied for within two years from the date of the other patent, see Eastern Paper Bag Co. *v.* Nixon (1888), 35 Fed. Rep. 752; 45 O. G. 1571.

After Application.

That an invention is not abandoned by abandoning the application, and does not become the property of the public until after two years' public use or sale, and hence abandoned applications are not open to the public, see *Ex parte* Fowler (1889), 49 O. G. 562.

ACTION IN EQUITY.

Parties.

That a person having an interest in the proceeds of the suit but not in the patent need not be a party to a bill in equity for infringement, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

That the grantee of the exclusive right to make, use, and sell, throughout the United States on payment of royalties, must be joined as plaintiff with his grantor in a suit to enjoin an infringement, see Clement Mfg. Co. *v.* Upson & Hall Co. (1889), 40 Fed. Rep. 471.

That the sole owner of one patent may join with the licensor and exclusive licensee of another patent in a suit for an act which infringes both patents, see Huber *v.* Myers Sanitary Depot (1888), 34 Fed. Rep. 752.

Bill.

That the court must determine, in its discretion, whether a bill is multifarious, see Singer Mfg. Co. *v.* Springfield Foundry Co. (1888), 34 Fed. Rep. 393.

That an averment in the bill that the plaintiff became interested in the patent before bringing the suit, by means of certain assignments of which profert is made, is sufficient, see Clement Mfg. Co. *v.* Upson and Hall Co. (1889), 40 Fed. Rep. 471.

That a bill describing the invention without sufficient certainty is demurrable, see Wise *v.* Grand Avenue R. R. Co. (1888), 33 Fed. Rep. 277.

That after decree for defendants the bill may be amended to count on an additional patent and further hearing and evidence be had thereon, see Underwood *v.* Gerber (1889), 37 Fed. Rep. 796; 48 O. G. 675.

That a bill counting on an original may be amended to count on the reissue, see Reay *v.* Berlin & Jones Envelope Co. (1887), 24 Blatch. 278.

Plea.

That matter of substantive defence cannot be urged on a plea, and if so set up the plea will be ordered to stand as part of the answer, see Edison Electric Light Co. *v.* Westinghouse (1889), 40 Fed. Rep. 666.

That a plea in equity cannot raise the issue of infringement, see Korn *v.* Wiebusch (1887), 33 Fed. Rep. 50.

That the question whether the term of the patent has expired may be raised by plea in equity, see Edison Electric Light Co. *v.* U. S. Electric Lighting Co. (1888), 35 Fed. Rep. 134; 43 O. G. 1456.

Answer.

That the defence of non-patentability for want of inventive skill need not be set up in the answer, see Heudy *v.* Golden State & Miners' Iron Works (1888), 127 U. S. 370; 43 O. G. 1117.

That an amendment of the answer will be allowed to cover evidence of prior patents which have been treated as regularly in the case for that purpose on the arguments, see Babcock & Wilcox Co. *v.* Pioneer Iron Works (1888), 34 Fed. Rep. 338; 43 O. G. 756.

Laches of Plaintiff.

That laches of the plaintiff in equity may be fatal to his claims, see Kittle *v.* Hall (1887), 24 Blatch. 184; 29 Fed. Rep. 508; 39 O. G. 707.

That a plaintiff is not guilty of laches while enforcing his claims against infringers in general in the courts, see American Bell Telephone Co. *v.* Southern Telephone Co. (1888), 34 Fed. Rep. 795.

Cross-Bill.

That the defendant cannot file a cross-bill to enjoin the plaintiff from infringing the defendant's patent, see McCormick Harvesting Mach. Co. *v.* Deering (1889), 47 O. G. 1222.

Evidence.

That an extension of time for taking new testimony will not be granted on a motion which does not set out the character of the testimony, see Strent *v.* Steinam (1889), 38 Fed. Rep. 548.

Rehearing.

That counsel are bound to anticipate and be prepared for every point that can be made on the evidence, see Timken *v.* Olin (1888), 37 Fed. Rep. 205.

That a rehearing will not be allowed on evidence already before the court and passed on adversely by another judge unless there is manifest error, see Rogers *v.* Reissner (1888), 34 Fed. Rep. 270.

That a rehearing will not be granted to enable defendants to take more evidence against the plaintiff's right to file a disclaimer, if notice had been given that one might be filed, or to offer cumulative and controverted proof as to the comparative utility of the patented invention and other devices, see Electrical Accumulator Co. *v.* Julien Electric Co. (1889), 39 Fed. Rep. 490.

That a hearing may be opened and new evidence taken on the ground of a recent decision of the Supreme Court, giving new views of the law, see Campbell *v.* Mayor of New York (1888), 36 Fed. Rep. 260; 45 O. G. 344.

That a rehearing in equity is at the discretion of the court and no appeal lies from its decision, see Roemer *v.* Bernheim (1889), 132 U. S. 103; 49 O. G. 1535.

That a court will not reverse its decision, after a full hearing on pleadings and proof, unless it is perfectly clear that an error has been committed, see Coupe *v.* Weatherhead (1889), 37 Fed. Rep. 16.

That the interlocutory decree and other proceedings are subject to revision until the final decree is passed,

see Celluloid Mfg. Co. *v.* Cellonite Mfg. Co. (1889), 40 Fed. Rep. 476.

Accounting.

That an accounting of profits can be had only when the infringement took place before the suit was commenced, see Marsh *v.* Nichols (1888), 128 U. S. 605; 46 O. G. 239.

That the accounting must be limited to the time fixed by the plaintiff as the period of infringement, see Creamer *v.* Bowers (1888), 35 Fed. Rep. 206.

That the validity of the Claims of the patent cannot be considered on the accounting, see Skinner *v.* Vulcan Iron Works (1889), 39 Fed. Rep. 870.

That where the master errs by rejecting evidence a motion should be made to the court at once to compel him to receive it, see Celluloid Mfg. Co. *v.* Cellonite Mfg. Co. (1889), 40 Fed. Rep. 476.

That an accounting will not be opened to receive evidence that might previously have been offered where all important testimony was actually presented, see Morss *v.* Union Form Co. (1889), 39 Fed. Rep. 468.

That evidence taken on an accounting at great expense may be saved for future use if the decree is opened on rehearing, see Campbell *v.* City of New York (1888), 35 Fed. Rep. 504; 44 O. G. 1185.

Draft Report.

That no objections to the final report will be considered unless they were urged against the draft report, see Celluloid Mfg. Co. *v.* Cellonite Mfg. Co. (1889), 40 Fed. Rep. 476.

That where objections to the draft report have been accidentally overlooked they may be sometimes made to the final report, see Celluloid Mfg. Co. *v.* Cellonite Mfg. Co. (1889), 40 Fed. Rep. 476.

Final Report.

That a master's report is to be set aside with almost as much reluctance as the verdict of a jury, see Welling *v.* La Bau (1888), 34 Fed. Rep. 40; 43 O. G. 117.

That objections to the master's report on matters of law may be made at any time, see Celluloid Mfg. Co. *v.* Cellonite Mfg. Co. (1889), 40 Fed. Rep. 476.

That the conclusions of the master on matters of fact are not departed from unless error or mistake is clearly shown, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

That the findings of fact by the master will not be reviewed when there was a fair conflict of testimony, see Celluloid Mfg. Co. *v.* Cellonite Mfg. Co. (1889), 40 Fed. Rep. 476.

That the master's report, made out as best he could from the evidence of the plaintiff, will not be disturbed where the defendant was a wanton infringer and could have shown the exact extent of his profits, see Creamer *v.* Bowers (1888), 35 Fed. Rep. 206.

That when the master's report is objected to because the infringement was not wilful and the reduction in plaintiff's prices was not due wholly to the infringement, the court can consider the entire subject of the computation of damages, see Boesch *v.* Gräff (1890), 133 U. S. 697.

Profits and Damages, See DAMAGES, PROFITS, *post.*

Bill of Review.

That a bill of review for errors on the face of the decree must be filed within two years from the date of the decree, see McDonald *v.* Whitney (1889), 39 Fed. Rep. 466.

Costs.

That a complainant who sues in equity on two patents and recovers on only one is entitled to costs, see Schmid *v.* Scovill Mfg. Co. (1889), 37 Fed. Rep. 345.

That the defendant will not be compelled to deliver up the infringing articles to be destroyed when he was in good faith and no further infringement is probable, see American Bell Telephone Co. *v.* Kitsell (1888) 35 Fed. Rep. 521. See also brief of counsel citing authorities *pro* and *con*, in above case.

ACTION AT LAW.

When forbidden.

That a suit at law cannot be brought without leave of the court, pending an accounting, for infringements since the decree, as the accounting may cover them, see Morss *v.* Knapp (1888), 35 Fed. Rep. 218.

Parties.

That an exclusive license to make and sell throughout the United States on payment of royalties on sales leaves the legal title in the licensor, and he may sue third parties for infringement, see Freese *v.* Swartchild (1888), 35 Fed. Rep. 141.

Declaration.

That the declaration must allege that the invention has not been in public use for more than two years before the application, and it is not sufficient to deny a public use "with consent of the inventor," see Blessing *v.* Trageser Steam Copper Works (1888), 34 Fed. Rep. 753.

Demurrer.

That a demurrer for non-patentability will be sustained if the court can see that the patent is void, see West *v.* Rae (1887), 33 Fed. Rep. 45.

That a demurrer for non-patentability will be sustained only when the matter is so clear that no question of fact can arise upon it, see Blessing *v.* Trageser Steam Copper Works (1888), 34 Fed. Rep. 753.

That a demurrer for want of novelty will be sustained only when the court, from its own knowledge, has no doubt that the device is well-known and in common use, see Eclipse Mfg. Co. *v.* Adkins (1888), 36 Fed. Rep. 554.

Pleadings.

That pleadings in patent cases follow the forms employed in the local courts, see Celluloid Mfg. Co. *v.* American Zylonite Co. (1888), 34 Fed. Rep. 744.

That the notice of special defences is not a pleading and cannot be demurred to, see Henry *v.* United States (1887), 22 Ct. of Claims, 75.

Evidence.

That the court may take judicial notice of want of novelty in clear cases, see Ligowski Clay Pigeon Co. *v.* American Clay Bird Co. (1888), 34 Fed. Rep. 328.

That lack of invention must fairly appear or the patent will prevail, see Marvin *v.* Gotschall (1888), 36 Fed. Rep. 314.

That the defendant's patent is *prima facie* evidence of the novelty and utility of his invention, see Worswick Mfg. Co. *v.* City of Kansas (1889), 38 Fed. Rep. 239; Deane *v.* Hodge (1886), 35 Minn. 146.

That the patent throws upon the defendant the burden of proof on the question of novelty, and if the evidence leaves it doubtful the patent will be sustained, see Frankfort Whiskey Process Co. *v.* Mill Creek Distilling Co. (1889), 37 Fed. Rep. 533.

That the patent is *prima facie* evidence of utility, and must be overcome by sufficient proof, see Kirk *v.* DuBois (1887), 33 Fed. Rep. 252; 42 O. G. 297.

That the original application and its amendments are admissible to show the character of the actual invention, see Consolidated Electric Light Co. *v.* McKeesport Light Co. (1889), 40 Fed. Rep. 21; 49 O. G. 1536.

That where two opposing experts conflict, one stating facts within his knowledge, and the other asserting a theory, the former will be followed, see Bènè *v.* Jeantet (1889), 129 U. S. 683; 47 O. G. 402.

That positive testimony will not be disregarded on account of the improbability that the same idea, even as to minute details, should have occurred to two persons on different continents at about the same time, see Bliss *v.* Merrill (1887), 33 Fed. Rep. 39; 42 O. G. 97.

That an infringement carried on secretly must be proved by the plaintiff, and he cannot rely on making out a case by examining the defendant or his workmen, or inspecting their devices, see Dobson *v.* Graham (1889), 48 O. G. 976.

That other devices adjudged to be infringements of the patent may be offered in evidence to show that defendant's device is an infringement, see Reed *v.* Smith (1890), 40 Fed. Rep. 882.

ALIEN.

That alien and citizen patentees are now on the same footing under our law, except as to fees and caveats, see Edison Electric Light Co. *v.* U. S. Electric Lighting Co. (1888), 35 Fed. Rep. 134; 43 O. G. 1456.

APPLICATION FOR PATENT.

Petition.

That the petition of the applicant must identify the specification, the oath concerning foreign patents must be specific, and the rules generally carefully observed, see *Ex parte* Muson (1888), 43 O. G. 627.

Oath.

That the application-oath is evidence against the patentee and may limit the construction of his patent, see Worswick Mfg. Co. *v.* City of Kansas (1889), 38 Fed. Rep. 239.

That an innocent false oath as to citizenship does not avoid the patent, see Tondeur *v.* Chambers (1889), 37 Fed. Rep. 333; 46 O. G. 1110.

Signatures.

That the full Christian name must be signed to the specification, see *Ex parte* Gentry (1888), 44 O. G. 822.

Subject-Matter.

That after one patent has issued, a second patent to the same person, either alone or with others, for the same invention though with broader Claims is unlawful, see Consolidated Roller-Mill Co. *v.* Coombs (1889), 39 Fed. Rep. 25; 48 O. G. 255.

That the grant of a subsequent patent to the same inventor raises a presumption that the later patent covers at least a patentable improvement on the former, see Putnam *v.* Keystone Bottle Stopper Co. (1889) 38 Fed. Rep. 234; 48 O. G. 113.

That a foreign patent with narrow Claims does not prevent the applicant from obtaining a domestic patent for a broader invention, see Faure *v.* Bradley (1888), 44 O. G. 945.

That an article which is the necessary product of a machine already patented is not the subject-matter of

a patent, see Dubois' Appeal (1887), 6 Mackey, 140. This position is correct if the article can be made in no other way, — being thus fully protected by the patent for the machine. But if it could be produced by other methods, known or yet to be discovered, how can it lose its patentable character by being described in the machine patent, without some act of abandonment on the part of its inventor?

That a patent cannot be obtained for the process of making an article after a patent has been granted for the article as made by that process, see Mosler Safe and Lock Co. *v.* Mosler (1888) 127 U. S. 354; 43 O. G. 1115.

That a patent may be granted on an earlier application, though since it was filed other patents have been granted on subsequent applications for improvements on the subject-matter of the earlier application, see *Ex parte* Edison (1889), 49 O. G. 1391.

That several applications for the same indivisible subject-matter cannot be entertained, but each application must be clearly distinguishable from the others, see *Ex parte* Smith (1888), 44 O. G. 1183.

Joinder.

That division of an application should not be required unless there is such a total want of interdependence as would render the inventions absolutely independent and distinct, see *Ex parte* McMahan (1889), 48 O. G. 255.

That a combination and its elements, a combination and improvements on its parts affecting its result as a whole, and a machine and such parts as are not recognized in the arts as distinct devices, may be joined in one application unless opposed to the Office classification, see *Ex parte* Willcox (1888), 45 O. G. 455.

That a separable element already in general use cannot be joined with the combination, see *Ex parte* La Bordo (1888), 44 O. G. 700.

That mere improvements on the old elements of a combination, not affecting the essence of the element, cannot be joined with the combination, see *Ex parte* Willcox (1888), 45 O. G. 455.

That two or more elements of a machine may be joined where one depends on and acts with the other to produce a single result, see *Ex parte* Coe (1889), 48 O. G. 1119.

That where the apparatus cannot operate without performing the process, and the process requires apparatus substantially identical with that in question, no division should be required, see *Ex parte* McMahan (1889), 48 O. G. 255.

That where a process and its product or apparatus can separately exist they require separate applications, see *Ex parte* Simonds (1888), 44 O. G. 445.

That a design patent can cover but one invention, see *Ex parte* Gerard (1888), 43 O. G. 1235, 1240.

Specification, see CLAIM, DESCRIPTION, *post*.

Drawings.

That drawings cannot make the patent cover a different invention from that described in the specification, either on an application for a re-issue or by a disclaimer, see Hailes *v.* Albany Stove Co. (1887), 123 U. S. 582; 42 O. G. 95.

That new figures cannot be added to the drawings after filing, without express permission from the Office,

see *Ex parte* Burt (1889), 49 O. G. 1986.

That the lettering of the drawings and specification must correspond, see *Ex parte* Borgfeldt (1889), 49 O. G. 132.

That where none of the elements of a combination are new or claimed separately, and other similar combinations are in use, the patentee is limited to the form of the elements shown by his drawings, see Heine Safety Boiler Co. *v.* Smith F. W. H. & P. Co. (1889), 47 O. G. 1634.

Examination of Application.

That the applicant must satisfy the Patent Office that his invention is operative and useful as well as new, see *Ex parte* De Baussett (1888), 43 O. G. 1583.

That it is the duty of the Patent Office to see that the applicant obtains a patent for whatever patentable subject-matter his application covers, and in all stages of the application to act as his friend and not his opponent, see *Ex parte* Donovan (1888), 44 O. G. 698.

That an examiner must advise the applicant how to so meet objections as to secure his real invention, see *Ex parte* Donovan (1888), 44 O. G. 698.

That an examiner should give to an applicant any information as to objections which will enable him to amend or appeal, see *Ex parte* Burt (1889), 49 O. G. 1986.

That the examiner can require the applicant to make the Claims definite and intelligible, but cannot in any manner hinder him from obtaining his full rights on appeal, see *Ex parte* Rogers (1889), 49 O. G. 1361.

Amendment.

That an amendment cannot introduce matter not substantially disclosed in the application as filed, see Steward *v.* Ellis (1889), 49 O. G. 1983.

That an amendment covering a distinct invention cannot be received, see *Ex parte* Zabel (1888), 43 O. G. 627.

That an amendment proposing a Claim not identical with the invention already disclosed or with a part thereof, should be admitted and rejected that an appeal may be taken; but if it covers an essentially distinct invention, so that if admitted a division must be ordered, it should not be received, see *Ex parte* Regan (1888), 45 O. G. 589.

That the oath of the applicant that the matter claimed by an amendment was part of the original invention is not conclusive, but the Office may determine the question by inspecting the whole application, see *Ex parte* Regan (1888), 45 O. G. 589.

That a Claim once erased should not be restored by amendment, see *Ex parte* Gillette (1888), 44 O. G. 819.

That a figure added in good faith to a drawing on file, without the permission of the Office will be erased, see *Ex parte* Cordrey (1889), 48 O. G. 397.

That after a second rejection the applicant cannot amend as a matter of right, see *Ex parte* Donovan (1888), 44 O. G. 698.

That an amendment presented nearly two years after rejection will not be received unless the delay is explained, see *Ex parte* Cordrey (1889), 48 O. G. 397.

That an application cannot be withdrawn from issue for purposes of amendment unless irreparable injury would otherwise result, see *Ex parte* Page (1888), 43 O. G. 1455.

That an allowed application may be withdrawn from issue for purposes of

amendment if irreparable injury would otherwise result, as where the matter of the amendment could not be inserted in a subsequent patent, see *Ex parte* Myers (1889), 49 O. G. 131.

That when an applicant, refusing to adopt an amendment suggested by the examiner, is defeated, and years afterward applies for leave to make such amendment, he is bound by the refusal, see *Ex parte* Gray (1889), 46 O. G. 1277.

Appeal in Uncontested Cases.

That a rejection, to be the subject of an appeal, must be a full and positive rejection, not a mere objection, see *Ex parte* Baker (1889), 49 O. G. 1303.

That all questions relating to patentability should be acted on before appeal, see *Ex parte* Burt (1889), 49 O. G. 1986.

That the appeal from a rejection for want of a proper oath lies to the examiners-in-chief, see *Ex parte* Boyer (1889), 49 O. G. 1985.

That an objection to a Claim as functional is not a rejection, nor does appeal lie to the examiners-in-chief, see *Ex parte* Barrett (1888), 45 O. G. 125.

That a functional Claim is necessarily indefinite, and is therefore objectionable in point of form, see *Ex parte* Barrett (1888), 45 O. G. 125.

That a rejection on the merits must be followed by an appeal to the examiners-in-chief, not by a petition to the Commissioner for a review, see *Ex parte* Edison (1889), 49 O. G. 1691.

That whether a device is a combination or an aggregation is a question of substance, and an appeal lies to the examiners-in-chief, see *Ex parte* Baker (1889), 49 O. G. 1363; *Ex parte* Gillette (1888), 48 O. G. 819.

That a Claim for an aggregation should be rejected and an appeal allowed instead of ordering a division, see *Ex parte* Willcox (1888), 45 O. G. 455; *Ex parte* Bullard (1888), 45 O. G. 1567; *Ex parte* Gillette (1888), 44 O. G. 819.

That the question of division does not fall within the cognizance of the examiners-in-chief, and their recommendation as to it is unwarranted, they having no concern with questions not before them on appeal or within their jurisdiction, see *Ex parte* Gillette (1888), 44 O. G. 819.

That where an application claims an aggregation and its distinct elements, a question of merits as well as form is raised, and appeal lies to the examiners-in-chief, see *Ex parte* Carter (1889), 46 O. G. 1391.

Division of Application.

That in ordering a division between process and product the examiner must give the applicant all the information on which he bases his judgment, see *Ex parte* Pastor (1887), 42 O. G. 95.

That an examiner may waive his requirement for cross-references between pending applications, see *Ex parte* Donovan (1888), 44 O. G. 698.

That divisional applications are treated as the same proceeding with reference to prior use, see Frankfort Whiskey Process Co. *v.* Mill Creek Distilling Co. (1889), 37 Fed. Rep. 533.

Abandonment of Application.

That unavoidable delay in prosecuting an application does not abandon it, see Ligowski Clay Pigeon Co. *v.* American Clay Bird Co. (1888), 34 Fed. Rep. 328.

That an application cannot be suspended at the request of the applicant for more than two years without aban-

doning it, see *Ex parte* Norton (1888), 42 O. G. 206.

That the "last action" of the Patent Office must be some regular and legal action for the preservation or obtaining of the right, not an irregular and illegal step taken by the applicant and a refusal of the Office to recognize it, see Kirk *v.* Commissioner (1886), 5 Mackey, 229; 37 O. G. 451.

That amendments filed in good faith but not important in character are such prosecution of the application as saves it from abandonment, see *Ex parte* Todd (1889), 49 O. G. 731.

That an informal amendment may be received by the Office to save the application from abandonment, upon condition that the amendment be subsequently made to comply with the rules, see *Ex parte* Sullivan (1888), 45 O. G. 709.

That amendments not removing objections nor changing the status of the application in the Office are not such prosecution as prevents its abandonment, see *Ex parte* Edison (1888), 45 O. G. 461.

That a second original application for the same invention can be filed after the first is abandoned by two years' neglect to renew after forfeiture, see *Ex parte* Barnitz (1888), 42 O. G. 1061.

That an abandoned application is no bar to a subsequent patent, see Beach *v.* Fowler (1889), 48 O. G. 821.

That an abandoned or rejected application cannot be cited as a reference, see Webster *v.* Sanford (1888), 44 O. G. 567.

That copies of abandoned cases in the Patent Office must be furnished on application if needed for purposes of evidence, but a motion to inspect such cases generally will be denied, see *Ex parte* Fowler (1889), 49 O. G. 562; United States *v.* Hall (1889), 48 O. G. 1263.

That an attorney at law may obtain a mandamus against the Commissioner in his own name to procure copies of abandoned applications from the Office, see United States *v.* Hall (1889), 48 O. G. 1263.

Continuous Applications.

That applications are not continuous unless they cover the same invention, see Green *v.* Hall (1889), 46 O. G. 1515.

That a new application filed at the suggestion of the Patent Office is a continuation of the old, see International Tooth Crown Co. *v.* Richmond (1887), 24 Blatch. 223; 30 Fed. Rep. 775; 39 O. G. 1550.

That a new application filed by the executor of a deceased applicant is a continuation of the former application and has the same status in the Patent Office, see *Ex parte* Smith (1888), 43 O. G. 504.

Forfeited Applications.

That an applicant has no right to forfeit an application and file a renewal at his option, see *Ex parte* Manny (1888), 44 O. G. 700.

Allowed Applications.

That an allowed application cannot be withheld when neither reference, publication, public use, nor interference can be urged against it, see *Ex parte* Atwood (1888), 44 O. G. 341.

Bill in Equity for Patent.

That in an *ex parte* case in the Patent Office the remedies by appeal must be exhausted before a bill in equity to obtain the patent can be filed, see Kirk *v.* Commissioner (1886), 5 Mackey, 229; 37 O. G. 451.

That the Secretary should not be made a party to a bill to obtain a patent, see Kirk *v.* Commissioner (1886), 5 Mackey, 220; 37 O. G. 451.

That on an appeal from a decree in equity granting a patent to one of two rival inventors on the sole ground of his priority, the defeated party may raise the question of the patentability of the invention and the Supreme Court may decide it, see Hill *v.* Wooster (1890), 132 U. S. 693.

ART.

That an art is as truly the subject of a patent as a machine or composition of matter, see The Telephone Cases (1888), 126 U. S. 1; 43 O. G. 377.

That a process consisting in the production and use of a change in the condition of an electrical current is patentable, see The Telephone Cases (1888), 126 U. S. 1; 43 O. G. 377.

That an art is new if the final step is new, though the other steps and the apparatus are old, see Frankfort Whiskey Process Co. *v.* Mill Creek Distilling Co. (1889), 37 Fed. Rep. 533.

That a new art may be produced by omitting one of the steps regarded as necessary in an old one, see Lawther *v.* Hamilton (1888), 124 U. S. 1; 42 O. G. 487.

That a process which is the mere function of a machine is not separately patentable, see *Ex parte* Simonds (1888), 44 O. G. 445.

That a mechanical process capable of being performed by other apparatus than the machine devised by its inventor for the purpose is separately patentable, unless dedicated to the public by the use of the machine, see *Ex parte* Young (1888), 46 O. G. 1035. See this case for a discussion of the relation of processes to machines.

ASSIGNMENT.

That the title to the patent, to whomsoever granted, vests on its issue in the ultimate assignee of record, see Consolidated Electric Light Co. *v.* McKeesport Light Co. (1888), 34 Fed. Rep. 335; 44 O. G. 110.

That a single Claim of a patent may be assigned, see Pope Mfg. Co. *v.* Gormully & Jeffrey Mfg. Co. (1888), 34 Fed. Rep. 893.

That an assignment of all the patentee's interest in the patent for the whole term, with all re-issues, renewals, and extensions, for one fourth of the future proceeds, transfers the entire title to the assignee, see Rude *v.* Westcott (1889), 130 U. S. 152; 48 O. G. 399.

That the transfer of an exclusive right to make, use, and sell, upon the payment of certain royalties, leaves an interest in the transferor and is not an absolute assignment, see Clement Mfg. Co. *v.* Upson & Hall Co. (1889), 40 Fed. Rep. 471.

That the transferee of an undivided interest in the invention for a certain part of the United States is not an assignee, and cannot join in prosecuting an application for a patent, see *Ex parte* Funston (1889), 49 O. G. 1044.

That an assignment made by attorney must be executed in the name of the principal, and sealed with his seal, see Machesney *v.* Brown (1886), 24 Blatch. 168; 38 O. G. 1130; 29 Fed. Rep. 145.

That an assignment of rights of action must be clearly expressed, and if procured pending suit by an assignee of the patent cannot be set up by sup-

plemental bill, see Emerson *v.* Hubbard (1888), 34 Fed. Rep. 327; 46 O. G. 976.

ATTORNEYS.

That patent attorneys and solicitors are not expected to be learned lawyers, and indulgence should be shown to applicants on that account, see Osgood *v.* Badger (1888), 44 O. G. 1065..

That the attorney of the inventor will be recognized by the Patent Office until the assignee asserts his rights, see *Ex parte* Baker (1889), 49 O. G. 1363.

CAVEAT.

That as a design cannot be incomplete no caveat for it is allowable, see *Ex parte* Carty (1888), 44 O. G. 570.

That when an application apparently conflicts with a pending caveat notice should be sent at once to the caveator without waiting to determine the patentability of the invention, see *Ex parte* Ward (1889), 46 O. G. 1513.

That a caveator after notice is not bound to file any application, nor can he excuse himself for lack of diligence in filing it, nor will an applicant be delayed to wait for an application from a caveator, see *Ex parte* Ward (1889), 46 O. G. 1513; Elges *v.* Miller (1889), 46 O. G. 1514.

CLAIM.

That matter not claimed is not covered by the patent, see Dickinson *v.* Parker (1889) 38 Fed. Rep. 411; Van Camp *v.* Maryland Pavement Co. (1888), 34 Fed. Rep. 740; 43 O. G 884.

That the patentee is bound by his Claim, see Electrical Accumulator Co. *v.* Julien Electric Co. (1889), 38 Fed. Rep. 117.

That the Claim should leave it to the Description to enumerate details of construction not essential to the invention, and the Claim cannot be limited to these details, see *Ex parte* Laskey (1889), 48 O. G. 539.

That a feature not alluded to in the Description cannot be covered by the Claim, though it appears in the drawings, see Gunn *v.* Savage (1887), 24 Blatch. 247; 30 Fed. Rep. 366.

That any perfectly clear expression of what the inventor intends to secure to himself in immediate connection with the Claim is virtually part of the Claim, see La Rue *v.* Western Electric Co. (1886), 24 Blatch. 18; 28 Fed. Rep. 85; 36 O. G. 453.

That the file-wrapper and contents may interpret the Claim, see Royer *v.* Coupe (1889), 38 Fed. Rep. 113.

That the inventor of an improvement only cannot claim the entire means, see *Ex parte* Miller (1888), 43 O. G. 1346.

That a patentee who has accepted a patent with Claims restricted by the Patent Office is not limited to the letter of his Claims, nor deprived of the right to equivalents, see Consolidated Roller-Mill Co. *v.* Coombs (1889), 39 Fed. Rep. 25; 48 O. G. 255.

That "as shown and described" will be implied by the courts in all Claims, but is usually required by the Patent Office, especially in design patents, see *Ex parte* Gerard (1888), 43 O. G. 1235.

That the words "means," "mechanism," "connections," are sometimes proper, see *Ex parte* Stoughton (1888), 43 O. G. 1345; *Ex parte* Stanbridge (1888), 43 O. G. 1345.

COMBINATION.

That the effecting a new result as distinguished from an aggregation of

old results is one test of a combination, see Shipman Engine Co. *v.* Rochester Tool Works (1888), 44 O. G. 1067.

That where no result is attained by grouping elements beyond their separate or collective result, the grouping is an aggregation, not a combination, see Richards *v.* Michigan Cent. R. R. Co. (1889), 40 Fed. Rep. 165.

That where the elements do not co-act to produce a new result, there is no patentable combination, see Brinkerhoff *v.* Aloe (1888), 37 Fed. Rep. 92; 46 O. G. 338.

That a combination must perform a function beyond that which is the sum of the functions of its separated elements, see Ide *v.* Ball Engine Co. (1889) 39 Fed. Rep. 548; 49 O. G. 283; Jones *v.* Clow (1889), 39 Fed. Rep. 785.

That a series of identical devices is not a combination, but each device is a complete thing by itself, see Morrison *v.* Canton Surgical and Dental Chair Co. (1889), 49 O. G. 733.

That the omission from a patented combination of one element, leaving the other elements to co-act just as they did before, is not a new invention, see McClain *v.* Ortmayer (1887), 33 Fed. Rep. 284; 42 O. G. 724.

That all claimed elements of a combination are thereby made essential, see Thompson *v.* Gildersleeve (1888), 34 Fed. Rep. 43; 43 O. G. 886.

COMMISSIONER OF PATENTS.

That the duties of the Commissioner are partly ministerial, partly judicial, see Daniel *v.* Morgan (1889), 47 O. G. 811.

That the Commissioner has no jurisdiction over conflicts as to title, nor can he recognize equitable or contract rights, see McDonough *v.* Gray (1889), 46 O. G. 1245.

CONCEPTION.

That conception is proved by description only when the description shows that the conceiver had not merely perceived the desirability of a result, but the way and means of effecting it, so that a listener to the description, if skilled in the art, could produce it, see Wherry *v.* Heck (1889), 49 O. G. 559.

That drawings and models are much higher evidence of conception than oral descriptions, see Wherry *v.* Heck (1889), 49 O. G. 559.

That an abandoned application may show conception, see Beach *v.* Fowler (1889), 48 O. G. 821.

CONSTRUCTION OF PATENTS.

That patents are to be construed in the light of common knowledge as to what was in use before, see Fornerook Mfg. Co. *v.* Iron Works (1886), 63 Mich. 195.

That a patent is to be construed in view of the state of the art and so as to protect the actual invention, if its language will permit, see Consolidated Roller Mill Co. *v.* Coombs (1889), 39 Fed. Rep. 25; 48 O. G. 255.

That a patent cannot be construed to cover parts not described or claimed, see Ball & Socket Fastener Co. *v.* Kraetzer (1889), 39 Fed. Rep. 700.

That a narrow Claim must be enlarged by re-issue, if at all, not by construction, see Becker *v.* Hastings (1884), 17 Phila. 580.

That a construction not contemplated when the Claim was drawn cannot be afterwards given to it, see Ladd *v.* Mooney (1884), 17 Phila. 571.

That the Claim of a patent defines what the Patent Office has determined to be the scope of the invention, and it cannot be enlarged by construction, see Day *v.* Fair Haven & Westville R. R. Co. (1889), 132 U. S. 98; 49 O. G. 1364.

That after the Claim has been modified in obedience to the Patent Office it cannot be enlarged by construction to cover the relinquished matter, see Phœnix Caster Co. *v.* Spiegel (1890), 133 U. S. 360; Roemer *v.* Peddie (1889), 132 U. S. 313; 49 O. G. 2151.

That the court in construing the Claims may examine the file-wrapper and contents, see Consolidated Roller-Mill Co. *v.* Coombs (1889), 39 Fed. Rep. 25; 48 O. G. 255.

That the construction put upon a Claim by the Patent Office in allowing it, as shown by the correspondence, will be followed, see Royer *v.* Schultz Belting Co. (1889), 40 Fed. Rep. 158; Geis *v.* Kimber (1888), 36 Fed. Rep. 105; 44 O. G. 108.

That where the Claim is clear the drawings need not be considered in construing it, see Kidd *v.* Horry (1888), 33 Fed. Rep. 712.

CONTRACTS.

Express or Implied.

That the right to use a patented invention may be the subject of a contract express or implied, and assumpsit will lie to recover reasonable compensation for its use, see Deane *v.* Hodge (1886), 35 Minn. 146.

That under an implied contract for the use of an invention the measure of recovery is a reasonable royalty, as custom or expert evidence as to utility and value may indicate, see Deane *v.* Hodge (1886), 35 Minn. 146.

Partnership.

That patents may be contributed to the capital of a partnership, see Rehfus *v.* Moore (1889), 6 Pa. Co. (Pa.) 245.

That where a patentee assigns a half-interest in the patent to a capitalist, and they unite in making and selling the invention, they are partners, and at the death of one the business should be settled up, the assets sold and proceeds divided, and a bill in equity may be brought by the executor of the deceased partner against the survivor for that purpose, see Farr *v.* Morrill (1889), 53 Hun (N. Y.), 31.

Warranty.

That a warranty guaranteeing the exclusive sale of one machine within certain territory is not broken by the sale of a different machine in the same territory under the same patent, see Pratt *v.* Marean (1888), 25 Ill. App. 516.

For Royalties.

That the acceptance of a license on condition of royalties is an agreement to pay the royalties, see Paper Stock Disinfecting Co. *v.* Boston Disinfecting Co. (1888), 147 Mass. 318.

That a licensee under a patent covering several inventions is liable for the stipulated royalty, whether he uses one or all of them, see Hubbard *v.* Allen (1889), 123 Pa. St. 198.

In Restraint of Trade.

That a contract regulating the mutual enjoyment of patent-rights is not "in restraint of trade," see Bowling *v.* Taylor (1889), 40 Fed. Rep. 404.

That a restriction in a transfer of rights under a patent being greater than is reasonably necessary to protect the purchaser is void as against public policy, see Berlin Mach. Works *v.* Perry (1888), 71 Wis. 495.

Failure of Consideration.

That an agreement to procure and assign a patent fails if the patent is not procured or procurable, and the purchase money may be recovered by the promisee, see Westervelt *v.* Fuller Mfg. Co. (1885), 13 Daly (N. Y.) 352.

Specific Performance.

That equity may compel the assignment of a patent by the legal owner to those equitably entitled to it, see Berolzheimer *v.* Strauss (1884), 51 Sup. Ct. (N. Y.) 96.

That State courts of equity will compel specific performance of contracts for assignment or license, see Fuller & Johnson Mfg. Co. *v.* Bartlett (1887), 68 Wis. 73.

That a parol agreement to assign a patent may be enforced in equity, and the court may direct the execution of the necessary papers, see Searle *v.* Hill (1887), 73 Iowa, 367.

That an oral contract for a license to use an invention may be enforced in equity, see Nichols *v.* Marsh (1886), 61 Mich. 509.

That an agreement to apply for and assign foreign patents will be enforced, see Adams *v.* Messinger (1888), 147 Mass. 185.

That an agreement by the owner of a patent to make and deliver the patented article will be enforced in equity, where no special skill is required to make it, see Adams *v.* Messinger (1888), 147 Mass. 185.

That specific performance of an agreement to convey a patent will not be decreed where the defendant has no title or the patent is void, see Kennedy *v.* Hazelton (1888), 128 U. S. 667; 46 O. G. 973.

That the specific performance of a void patent will not be decreed, see Kennedy *v.* Hazelton (1888), 33 Fed. Rep. 293.

That an unconscionable contract will not be enforced in equity, see Pope Mfg. Co. *v.* Gormully (1888), 34 Fed. Rep. 877.

That the owner of a patent may be enjoined against alienating or encumbering his title thereto, see Adams *v.* Messinger (1888), 147 Mass. 185.

Rescission.

That a contract to purchase a patent right obtained by the fraud of the vendor will be rescinded in equity, and the parties placed *in statu quo*, see Marsh *v.* Scott (1888), 125 Ill. 114.

That a party having the right to a rescission and an affirmance of a contract must make his election and abide by it, see Creighton *v.* Haggerty (1884), 50 Sup. Ct. (N. Y.) 9.

DAMAGES.

Must be proved.

That damages must be proved, not conjectured, see Rude *v.* Westcott (1889), 130 U. S. 152; 48 O. G. 399.

License Fee as Measure of Damages.

That license fees fixed by plaintiff and voluntarily paid by licensees, are evidence of an established fee, see United Nickel Co. *v.* Central Pac. R. Co. (1888), 36 Fed. Rep. 186.

That a license fee is established only where the payment of such fees is of frequent occurrence and shows the value of the license in similar cases, see Rude *v.* Westcott (1889), 130 U. S. 152; 48 O. G. 399.

That two instances are admissible to show an established license fee, see Cary *v.* Lovell Mfg. Co. (1889), 37 Fed. Rep. 654; 47 O. G. 525.

That irregular and uncertain rates

for licenses do not show a license fee, see United Nickel Co. *v.* Central Pac. R. Co. (1888), 36 Fed. Rep. 186.

That when a regular license fee exists it is not varied by occasional departures in cases of necessity, see Asmus *v.* Freeman (1888), 34 Fed. Rep. 902.

That an allowance of a sum *per* article by a court as damages does not fix a royalty or give a right to interest thereon, see Graham *v.* Plano Mfg. Co. (1888), 35 Fed. Rep. 597.

That payment of a sum in settlement of an infringement does not measure the value of the invention or the damages sustained in other cases, see Rude *v.* Westcott (1889), 130 U. S. 152; 48 O. G. 399; Cornely *v.* Marckwald (1889), 131 U. S. 159; 47 O. G. 1353; United Nickel Co. *v.* Central Pac. R. Co. (1888), 36 Fed. Rep. 186.

That a royalty paid for one right under a patent, or for all the rights, is not evidence of damages for infringing a single different right, see Colgate *v.* Western Electric Mfg. Co. (1886), 24 Blatch. 75.

That a royalty paid for several patents jointly does not show the license fee for either, see Vulcanite Paving Co. *v.* American Artificial Pavement Co. (1888), 36 Fed. Rep. 378; 45 O. G. 948.

Loss of Profits as Measure of Damages.

That where there is no license fee the measure of damages is the profits lost by the patentee by reason of the infringement, and he must show to what extent sales have been diverted from him, see Covert *v.* Sargent (1889), 38 Fed. Rep. 237.

That where the plaintiff does not grant licenses, the measure of damages for an infringing sale is the amount of profit he would have made if he had sold what the defendant sold, deducting a fair percentage in respect of sales due to the particular exertions of the defendant, but not taking into consideration that the defendant might have sold the same quantity without infringing the patent, or that the price of other goods sold by the plaintiff was reduced by the unlawful competition, see United Horse Shoe & Nail Co. *v.* Stewart (1888), L. R. 13 App. 401.

That the plaintiff may show by circumstantial as well as direct evidence that he would have sold the articles sold by the defendant, see Covert *v.* Sargent (1889), 38 Fed. Rep. 237.

That where defendants, before infringing, bought of the plaintiff, as also during the infringement to some extent, it is a fair presumption that they would have bought of him all they made and used, see Creamer *v.* Bowers (1888), 35 Fed. Rep. 206.

That a plaintiff who claims a loss by reduction of prices must show by sufficient data to what extent such reduction was due to the infringement, see Boesch *v.* Gräff (1890), 133 U. S. 697; Cornely *v.* Marckwald (1889), 131 U. S. 159; 47 O. G. 1353.

That when the plaintiff charged no more when he used his invention than when he did not use it, evidence that he lost valuable contracts through the defendant's competition is inadmissible, see Vulcanite Paving Co. *v.* American Artificial Stone Pavement Co. (1888), 36 Fed. Rep. 378; 45 O. G. 948.

Increase of Damages.

That for a flagrant injury damages will be trebled, see Lyon *v.* Donaldson (1888), 34 Fed. Rep. 789.

That a strenuous contest, if fair and *bona fide*, is no reason for increasing the damages, see Welling *v.* La Bau (1888), 35 Fed. Rep. 302.

That a court will not increase the damages merely because the defendant urged his goods on the plaintiff's customers, see Morss *v.* Union Form Co. (1889), 39 Fed. Rep. 468.

That the court may award damages in equity in excess of the profits and then treble them, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

That while after final decree the defendant may not be allowed to offer evidence, before carelessly omitted, to show that the patent is void, yet in view thereof the court may refuse to increase damages, see Welling *v.* La Bau (1888), 35 Fed. Rep. 302.

Nominal Damages.

That a plaintiff, not having any compromise in view, is bound by an offer to accept nominal damages, see Creamer *v.* Bowers (1888), 35 Fed. Rep. 206.

Interest.

That interest is allowed on royalties, but not on unliquidated damages, see Creamer *v.* Bowers (1888), 35 Fed. Rep. 206.

DATE.

Of Invention.

That a foreign patentee cannot claim an earlier date for his invention than that of his foreign patent, see Electrical Accumulator Co. *v.* Julien Electric Co. (1889), 38 Fed. Rep. 117.

That a statement in the domestic specification that the applicant has obtained a foreign patent does not prove that fact nor carry back the *prima facie* date of his invention, see Electrical Accumulator Co. *v.* Julien Electric Co. (1889), 38 Fed. Rep. 117.

Of Patent.

That the date of the American patent need not correspond with that of the foreign one by which its term is limited, see The Telephone Cases (1888), 126 U. S. 1; 43 O. G. 377.

DESCRIPTION.

Completeness.

That one pending application cannot refer to another for a fuller description, but each must be complete in itself, see *Ex parte* Borgfeldt (1889), 49 O. G. 132; *Ex parte* Everitt (1889), 49 O. G. 564.

Correctness.

That inaccurate statements concerning the good results of a patented process do not render the Description defective, see Michaelis *v.* Roessler (1888), 34 Fed. Rep. 325.

Fraudulent Concealment.

That the defence of fraudulent concealment is not supported unless an intent to deceive is shown, see Celluloid Mfg. Co. *v.* Russell (1889), 37 Fed. Rep. 676.

Addressed to those Skilled in the Art.

That the Description is addressed to those skilled in the art, see Celluloid Mfg. Co. *v.* Russell (1889), 37 Fed. Rep. 676.

That the Description of a scientific invention is addressed to those learned in the science, see Electrical Accumulator Co. *v.* Julien Electric Co. (1889), 38 Fed. Rep. 117.

That the Description of a process must describe it in a manner intelligible to those skilled in the art, and point out a way to make it practical, but it is not required that it be brought to the highest degree of perfection,

see The Telephone Cases (1888), 126 U. S. 1; 43 O. G. 377.

That the Description is sufficient if a skilled mechanic could from it construct the invention, see Pullman Palace Car Co. *v.* Wagner Palace Car Co. (1889), 38 Fed. Rep. 416.

That the specification of a chemical patent is addressed to those skilled in chemistry and is sufficient if intelligible to them, see Am Ende *v.* Seabury (1888) 36 Fed. Rep. 593; 47 O. G. 1354; Anilin *v.* Levinstein (1887), L. R. 12 App. 710.

DESIGN.

When Patentable.

That a design presenting a new appearance to the eye, and creating a demand for the goods on which it is impressed, is patentable though simple and resembling other designs, see Untermeyer *v.* Freund (1889), 37 Fed. Rep. 342; 47 O. G. 527.

That a design is not new unless it would appear to ordinary observers to be different from the old, but the difference may be small, see Redway *v.* Ohio Stove Co. (1889), 38 Fed. Rep. 582.

Combination.

That a patent for a combination of old designs is proper, see Whitman Saddle Co. *v.* Smith (1889), 38 Fed. Rep. 411; Redway *v.* Ohio Stove Co. (1889), 38 Fed. Rep. 582.

That every design is a finished and distinct entity, not a combination, nor a genus, nor a species, see *Ex parte* Gerard (1888), 43 O. G. 1235, 1240.

Design and Manufacture.

That a design may be also a manufacture, see *Ex parte* Gerard (1888), 43 O. G. 1235.

Identity of Designs.

That the identity of designs is measured by their appearance to ordinary observers, not to experts, see Redway *v.* Ohio Stove Co. (1889), 38 Fed. Rep. 582; *Ex parte* Gerard (1888), 43 O. G. 1235; Kraus *v.* Fitzpatrick (1888), 34 Fed. Rep. 39; 42 O. G. 1202.

DISCLAIMER.

Nature.

That secs. 4917 and 4922 Rev. Stat. concerning disclaimers are parts of one law and require the same conditions for amendment, see Hailes *v.* Albany Stove Co. (1887), 123 U. S. 582; 42 O. G. 95.

Cannot Change Invention.

That a disclaimer cannot change the character of the patented invention nor render further description necessary, but can only eliminate separable matter from the Claims, see Hailes *v.* Albany Stove Co. (1887), 123 U. S. 582; 42 O. G. 95.

That a patent for the apparatus cannot be changed into one for the process by disclaiming the apparatus except when used in the process, see Grant *v.* Walter (1889), 38 Fed. Rep. 594; 47 O. G. 1220.

Affects Claim, not Description.

That a disclaimer is not needed when the Description is excessive but not the Claim, — the Claim controlling the Description and limiting the patent, — see Brush Electric Co. *v.* Fort Wayne Electric Light Co. (1889), 40 Fed. Rep. 826.

Effect on Claim.

That a disclaimer of the separable excess may save the valid portion of the Claim, see Electrical Accumulator Co. *v.* Julien Electric Co. (1889), 38 Fed. Rep. 117.

That the patentee is bound by a Claim which has been narrowed to meet an unfounded objection in the

Patent Office, see Lapham Dodge Co. *v.* Severin (1889), 40 Fed. Rep. 762.

After Unreasonable Delay.

That a disclaimer to save an otherwise lost suit is not permissible after unreasonable delay, see Hake *v.* Brown (1889), 37 Fed. Rep. 783; 47 O. G. 1071.

As Evidence.

That a disclaimer cannot be put in evidence after decision on the merits in equity, except upon a rehearing and on such terms as the court may impose, see Roemer *v.* Bernheim (1889), 132 U. S. 103; 49 O. G. 1535.

EMPLOYER AND EMPLOYEE.

Assignment.

That the inventions of a person hired to invent, and to patent his inventions in the name of the employer, equitably belong to the employer, and if patented to the inventor he may be compelled in equity to assign his patent to the employer, see Annin *v.* Wren (1887), 44 Hun (N. Y.), 352.

That an employer may patent the inventions of his employees for his own benefit if they consent, see Dueber Watch-Case Mfg. Co. *v.* Dalzell (1889), 38 Fed. Rep. 597.

License.

That an employee disclosing his invention to the employer, and putting it to practical use in the employment, does not thereby transfer a right to the invention itself and the future patent therefor, but licenses the employer to use it, see Fuller & Johnson Mfg. Co. *v.* Bartlett (1887), 68 Wis. 73.

EQUIVALENTS.

Though not identical.

That devices may be equivalents though one answers the purpose better than the other, see Roosevelt *v* Law Tel. Co. (1887), 33 Fed. Rep. 505.

"Known" Equivalents.

That a "known equivalent" is such a substitute as is known to be able to accomplish the same result, see Morley Mach. Co. *v.* Lancaster (1889), 129 U. S. 263; 47 O. G. 267.

That equivalents are such though it could not have been known that they would be equivalents until after the device in which they are employed was invented, see Morley Mach. Co. *v.* Lancaster (1889), 129 U. S. 263; 47 O. G. 267.

Covered by Patent.

That a patentee is entitled to equivalents though he may have reformed his Claims under requirements of the Patent Office, see Rodebaugh *v.* Jackson (1889), 37 Fed. Rep. 882; 47 O. G. 658.

ESTOPPEL.

That an attorney in fact, conveying the patent under a power, is not estopped to deny validity, see H. Tibbe & Son Mfg. Co. *v.* Heineker (1889), 37 Fed. Rep. 686; 47 O. G. 1221.

GENUS AND SPECIES.

That the relation of an improvement to its original is not always that of species to a genus, — a species being created only when an original generic element is supplanted by a new or modified element, see *Ex parte* Smith (1888), 44 O. G. 1183.

That a process and its apparatus are not genus and species but distinct inventions, see *Ex parte* Atwood (1888), 44 O. G. 341.

IDENTITY.

That greater perfection in the result effected does not show want of identity, see Mac Donald *v.* McLean (1889), 38 Fed. Rep. 328.

INFRINGEMENT.

By Use.

That use of the invention for a different purpose is infringement, see Thompson *v.* Gildersleeve (1888), 34 Fed. Rep. 43; 43 O. G. 886.

By Sale.

That the sale of part of an invention to those who have a right to use it is not an infringement, see Morgan Envelope Co. *v.* Albany Perforated Wrapping Paper Co. (1889), 40 Fed. Rep. 577.

That the sale of an element capable of an innocent use, and without collusion, does not infringe the patent for the combination, see Winne *v.* Bedell (1889), 40 Fed. Rep. 463; 49 O. G. 2152.

By Joint or Collusive Acts.

That a joint infringement is one tort, and recovery of satisfaction against one tort-feasor is a bar to further proceedings, see Babcock & Wilcox Co. *v.* Pioneer Iron Works (1888), 34 Fed. Rep. 338; 43 O. G. 756.

That a patent may be infringed by the separate acts of different parties having a common purpose, though no one act is by itself an infringement, see Celluloid Mfg. Co. *v.* American Zylonite Co. (1887), 24 Blatch. 321.

Of several Patents.

That when the titles to two conflicting patents are united in one owner, one invention may be treated as an improvement on the other as against an infringer, see Putnam *v.* Keystone Bottle Stopper Co. (1889), 38 Fed. Rep. 234; 48 O. G. 113.

That where two patents cover in part the same field, a party who has used under both may be held liable for that in each which was not covered by the other, and cannot claim that the later was void because anticipated by the other, see Deane *v.* Hodge (1886), 35 Minn. 146.

Of Combination-patent.

That a combination-patent is infringed if the substance of the combination is taken, whatever equivalents, alterations, or omissions may be resorted to, see Proctor *v.* Bennis (1887), L. R. 36 Ch. D. 740.

That a combination is not infringed unless all its elements or their equivalents are used, see Perkins *v.* Eaton (1889), 40 Fed. Rep. 672.

That taking some of the elements with equivalents for the others infringes the combination, see Leary *v.* Hohenstein (1889), 37 Fed. Rep. 680; 46 O. G. 1518.

That the reconstruction of a combination after its patent has expired is not an infringement, see Johnson *v.* Brooklyn & C. R. Co. (1888), 37 Fed. Rep. 147.

Of Patent for an Art.

That a patent for an art is not infringed if some of its steps are omitted, see Royer *v.* Coupe (1889), 38 Fed. Rep. 113.

That a process is infringed by employing the essence of the invention, whatever apparatus may be used, see Morley Mach. Co. *v.* Lancaster (1889), 129 U. S. 263; 47 O. G. 267.

Of Machine-patent.

That a machine performing new functions is infringed by any mechanism which employs the same means to accomplish the same results, though its parts are individually improved, see Morley Mach. Co. *v.* Lancaster (1889), 129 U. S. 263; 47 O. G. 267.

Of Design-patent.

That a design may infringe though the infringer's name be coupled with

it, see Redway *v.* Ohio Stove Co. (1889), 38 Fed. Rep. 582.

By the Government or its Officers.

That in the absence of any special agreement the acts of the government in using an invention measure its liability under an implied contract, see Butler *v.* United States (1888), 23 Ct. of Claims, 335.

That the unauthorized use of an invention by a public officer does not raise an implied contract on the part of the government to pay for such use, see Forehand *v.* United States (1888), 23 Ct. of Claims, 477.

That when the government denies that the invention used is the property of the claimant, the use is not under a contract, see Schillinger *v.* United States (1889), 24 Ct. of Claims, 278.

By City.

That a city may be liable for an infringement committed by a contractor acting under its orders, see Asbestine Tiling & Mfg. Co. *v.* Hepp (1889), 39 Fed. Rep. 324; 49 O. G. 413.

By private Corporations, their Officers, etc.

That an officer of a solvent corporation is not liable for its infringements unless he personally participates therein, though he may be bound by an injunction, see Boston Woven Hose Co. *v.* Star Rubber Co. (1889), 40 Fed. Rep. 167.

That the officers of a corporation though made parties will not be individually enjoined or ordered to account when the corporation is solvent, unless they as individuals have violated or threaten to violate the patentee's rights, see Howard *v.* St. Paul Plow Works (1888), 35 Fed. Rep. 743; 45 O. G. 1067.

By Licensor.

That a licensor is liable in equity for infringing acts committed by his licensees when following his directions and working drawings, see Toppan *v.* Tiffany Refrigerator Car Co. (1889), 39 Fed. Rep. 420.

By Licensee.

That a licensee exceeding his license becomes an infringer, see Covell *v.* Bostwick (1889), 39 Fed. Rep. 421.

That a licensee under one Claim of a patent may be treated as an infringer of another Claim, though the infringement is accomplished by the use of the licensed Claim, see United Nickel Co. *v.* California Electrical Works (1885), 11 Sawyer 250.

By Workman.

That a mere workman having no pecuniary interest in the product of his labor is not an infringer, see Young *v.* Foerster (1889), 37 Fed. Rep. 203; 47 O. G. 1353.

Liability of Executor.

That an action in equity for infringement survives against the executor of the infringer, although no injunction can be granted, see Hohorst *v.* Howard (1888), 37 Fed. Rep. 97.

Must be Proved.

That infringement must be proved, not conjectured, see Winne *v.* Bedell (1889), 40 Fed. Rep. 463; 49 O. G. 2152; Morgan Envelope Co. *v.* Albany Perforated Wrapping Paper Co. (1889), 40 Fed. Rep. 577.

INJUNCTION.

Preliminary, when denied.

That an injunction will be refused in the absence of judgments, acquiescence, or success in an interference proceeding, see Edward Barr Co. *v.*

N. Y. & N. H. Automatic Sprinkler Co. (1887), 24 Blatch. 566; 43 O. G. 392.

That an injunction will be refused when there are no judgments or acquiescence, and infringement is doubtful, see Raymond *v.* Boston Woven Hose Co. (1889), 39 Fed. Rep. 365; 48 O. G. 1776.

That an injunction will be refused when there are no judgments or acquiescence, and defendant is solvent and would sustain great injury, and the plaintiff has been guilty of laches, see Hurlburt *v.* Carter (1889), 39 Fed. Rep. 802.

That an injunction will be refused where no judgments have been rendered, acquiescence is doubtful, the infringement is denied, and defendants are pecuniarily responsible, and have a long time carried on an extensive business, while plaintiff has owned the patent but a few months, see Johnson *v.* Aldrich (1889), 40 Fed. Rep. 675.

Judgments.

That a restraining order, pending suit, will be granted on one final judgment and several interlocutory orders for injunctions and a public acquiescence of several years, see Schneider *v.* Missouri Glass Co. (1888), 36 Fed. Rep. 582; 45 O. G. 1069.

That an injunction may issue without a prior judgment at law, but the court, if validity is doubtful, may order an issue at law before allowing an injunction, see Wise *v.* Grand Avenue R. R. Co. (1888), 33 Fed. Rep. 277.

That an injunction will be refused where the evidence of validity consists of a judgment from which an appeal is pending, and where the defendant is acting in good faith and in ignorance of the infringement and would sustain irreparable injury, while the plaintiff has an adequate remedy at law, see Consolidated Roller Mill Co. *v.* Richmond City Mill Works (1889), 40 Fed. Rep. 474.

That where there has been no judgment or its equivalent, and the defendants deny the validity of the patent if so construed as to prohibit their acts, an injunction will be refused, see Dickerson *v.* De La Vergne Refrigerating Mach. Co. (1888), 35 Fed. Rep. 143.

Acquiescence.

That acquiescence implies an interest adverse to the patent and a submission to the patent, see Raymond *v.* Boston Woven Hose Co. (1889). 39 Fed. Rep. 365; 48 O. G. 1776.

That acquiescence in the right of the inventor to an invention covered by several patents is not acquiescence in any one patent, see Upton *v.* Wayland (1888), 36 Fed. Rep. 593.

Validity Doubtful.

That an injunction will be denied where it is evident that the patent will be very narrowly sustained if at all, see Glaenzer *v.* Wiederer (1887), 33 Fed. Rep. 583.

That an injunction will not issue where patentability is doubtful, see Osborn *v.* Judd (1886), 24 Blatch. 167.

That an injunction will be denied where the novelty of the invention is fairly contested, see Upton *v.* Wayland (1888), 36 Fed. Rep. 593.

Infringement Doubtful, Threatened, Evidence of.

That where infringement is doubtful, and other courts have decided that there is none, an injunction will be refused, see Thompson *v.* Rand-Avery Supply Co. (1889), 38 Fed. Rep. 112; 46 O. G. 1112.

That if infringement is doubtful an injunction will be refused, see Norton Door Check & Spring Co. *v.* Hall (1889), 37 Fed. Rep. 691; Morss *v.* Knapp (1889), 39 Fed. Rep. 608; Russell *v.* Hyde (1889), 39 Fed. Rep. 614.

That infringement in the past is not conclusive proof that the infringer will repeat the wrongful act, see Proctor *v.* Bayley (1889), L. R. 42 Ch. D. 390.

That an injunction will issue though infringement has ceased, if it can be repeated, see Celluloid Mfg. Co. *v.* Arlington Mfg. Co. (1888), 34 Fed. Rep. 324; 42 O. G. 828; Facer *v.* Midvale Steel Works Co. (1888), 38 Fed. Rep. 231.

That an injunction may issue though no infringement has yet occurred, see Sherman *v.* Nutt (1888), 35 Fed. Rep. 149.

That an injunction will issue when the patented device has been made for sale and advertised though none have yet been used or sold, see Butz Thermo-Electric Regulator Co. *v.* Jacobs Electric Co. (1888), 36 Fed. Rep. 191; 45 O. G. 833.

That where the defendant has imported parts of the patented combination, and fails to disclose the purpose for which they are to be used, an injunction will issue, see Schneider *v.* Missouri Glass Co. (1888), 36 Fed. Rep. 582; 45 O. G. 1069.

Final Injunction Doubtful.

That an injunction ought not to be granted unless a final decree would be made for the plaintiff on the same evidence, see Challender *v.* Royle (1887), L. R. 36 Ch. D. 425.

Estoppel of Plaintiff.

That where the plaintiff has acquiesced in and countenanced the acts of the defendant an injunction will be refused, see Amazeen Machine Co. *v.* Knight (1889), 39 Fed. Rep. 612.

That an injunction may be refused where the plaintiff has been guilty of laches pending suit and a final decree will soon be rendered, see Pope Mfg. Co. *v.* Johnson (1889) 40 Fed. Rep. 584.

That an injunction will be refused to a licensor who has dealt unfairly to the prejudice of the defendant licensee, see Seibert Cylinder Oil Cup Co. *v.* Detroit Lubricator Co. (1888), 34 Fed. Rep. 216.

That non-user because of State interference with the amount of royalties collectible is no ground for refusing an injunction, see American Bell Telephone Co. *v.* Cushman Tel. & Service Co. (1888), 36 Fed. Rep. 488; 45 O. G. 1193.

Injury to Defendant or Public.

That an injunction will be refused when the defendant is solvent and has used the invention a long time without notice of infringement, and would suffer irreparable injury, and the public are benefited by his use, see Root *v.* Mt. Adams & Eden Park Inclined R. R. Co. (1889), 40 Fed. Rep. 760.

Patent Expired.

That an injunction to prevent the use or sale of articles after the expiration of the patent will not be allowed when the articles were wrongfully made before the patent expired, and a suit for damages therefor is pending, see Westinghouse *v.* Carpenter (1888), 46 O. G. 244.

Defendant's Vendor already Enjoined.

That the vendee and user may be enjoined in one court after the maker has been enjoined in another, especially when the maker was not sued for the profits on this sale, see Thompson

v. American Bank Note Co. (1888), 35 Fed. Rep. 203; 45 O. G. 347.

Bond and Account.

That a bond in lieu of an injunction will be ordered when former judgments sustaining the patent have been rendered doubtful by subsequent decisions of the Supreme Court, and the defendant would sustain irreparable injury, see Eastern Paper Bag Co. *v.* Nixon (1888), 35 Fed. Rep. 752; 45 O. G. 1571.

That a bond and account may be ordered in lieu of an injunction when infringement is disputed, and defendant avers that he was ignorant of the patent until the suit was brought and derived no real aid from the invention, see Eagle Mfg. Co. *v.* Chamberlain Plow Co. (1888), 36 Fed. Rep. 905.

Bill for Injunction.

That it is proper to aver in a bill for an injunction that the patent has been established by judgments, to describe the patent generally, and make profert of it, and to allege infringement without specifying details, see American Bell Telephone Co. *v.* Southern Telephone Co. (1888), 34 Fed. Rep. 803.

Bond of Plaintiff and Liability thereon.

That if the plaintiff gives bond on obtaining an injunction and fails in his suit he is liable on the bond for damages arising from loss of sales, depreciation of goods on hand, etc., see Tobey Furniture Co. *v.* Colby (1888), 35 Fed. Rep. 592.

Suspension of Injunction.

That an injunction will not be suspended after judgment on the merits, unless public interests are involved or large numbers of innocent persons would be injured, see Consolidated Roller-Mill Co. *v.* Coombs (1889), 39 Fed. Rep. 803; 48 O. G. 973.

For a review of the cases in which injunctions will be suspended, see Consolidated Roller-Mill Co. *v.* Coombs (1889), 39 Fed. Rep. 803; 48 O. G. 973.

Contempt.

That an enjoined defendant, neglecting to notify his agents of the injunction is liable in contempt for their violations, see Mundy *v.* Lidgerwood Mfg. Co. (1888), 34 Fed. Rep. 541.

That where an enjoined infringer acts under a patent granted since the decree and there is a fair question whether he infringes, he will not be adjudged in contempt on a motion, but the plaintiff must sue on the alleged infringement, see Penna. Diamond Drill Co. *v.* Simpson (1889), 39 Fed. Rep. 284; 48 O. G. 676.

That where the contempt is not wilful a nominal fine and costs only will be imposed, see Morss *v.* Domestic Sewing Mach. Co. (1889), 38 Fed. Rep. 482.

INTERFERENCE.

Jurisdiction of Examiner of Interferences.

That the Examiner of Interferences has exclusive jurisdiction over the issues when declared, but none over the matter of patentability, see Faure *v.* Bradley (1888), 44 O. G. 945.

That the question whether a foreign patent covers the same invention as a domestic application in interference rests exclusively with the Examiner of Interferences, see Faure *v.* Bradley (1888), 44 O. G. 945.

That the decision of the Examiner of Interferences on interlocutory motions will not be reviewed unless he abuses his discretion or disregards some rule of law, see Reynolds *v.* Haberman (1889), 49 O G. 130.

When Declared.

That an interference will be declared with an unexpired patent only when the applicant has been rejected on that specific patent, see *Ex parte* Boyer (1889), 49 O. G. 1985.

Patent Granted pending Interference.

That a patent issued pending a rival application is treated as an application also, see *Ex parte* Boyer (1889), 49 O. G. 1956; Beckman *v.* Johnson (1889), 48 O. G. 673.

Patentee, how far a Party.

That a patentee has no interest in an interference proceeding after the question whether the applicant shall have a patent is determined, see Beardslee *v.* Moeslein (1889), 46 O. G. 1640.

Priority of Application.

That an earlier application cannot benefit the junior party to an interference unless it appear on its face or is proved by evidence to have been filed by the same applicant, see Oliver *v.* Everitt (1889), 49 O. G. 731.

Dissolution.

That a motion to dissolve an interference cannot be based on any thing except the application, see Faure *v.* Bradley (1888), 44 O. G. 945.

That an interference will not be dissolved for irregularity unless it would defeat the purpose of the interference, see Steward *v.* Ellis (1889), 49 O. G. 1983.

That if a decision on a motion to dissolve an interference rests on the merits, and not on the question whether an interference exists or whether the proceedings are so begun that this question can be decided, no appeal lies to the Commissioner, see Manny *v.* Easley (1889), 48 O. G. 538.

That an interference may be dissolved on the ground of non-patentability and the case remanded after the time fixed by the rules where circumstances demand it, even though the same questions had been fully canvassed by the examiner before the interference was declared, see Reynolds *v* Haberman (1889), 49 O. G. 130.

Evidence; Witnesses; Burden of Proof.

That the matter of taking testimony for use in the Patent Office in interference cases is controlled by the Federal Court of the district where the evidence is taken, not by the Commissioner, see Wright *v* Daggett (1888), 44 O. G. 943; Osgood *v.* Badger (1888), 44 O. G. 1065.

That depositions taken for the interference hearing between parties substantially the same may be used in court on a suit to annul if the same evidence cannot be retaken, see Clow *v.* Baker (1888), 36 Fed. Rep. 692.

That evidence of foreign invention is not admissible in an interference unless it be a publication or a patent, see Green *v.* Hall (1889), 46 O. G. 1515.

That husband and wife are not competent witnesses for or against each other in the Patent Office, which follows the law of the District of Columbia, see Marsh *v.* Rein (1888), 43 O. G. 1453.

That when a later applicant in interference claims that the earlier copied the invention from his, and that he is the true inventor and was using reasonable diligence in reducing, he has the burden of proof and must establish his claim by a fair preponderance of legal evidence, see Wherry *v.* Heck (1889), 49 O. G. 559.

That on an interference between an application and a patent, the evidence

must be sufficient to overthrow the patent in the courts or obtain its repeal, see Beach *v* Fowler (1889), 48 O. G. 821.

Rehearing.

That a Commissioner may rehear an interference case already decided by his predecessor in office, see Daniels *v.* Morgan (1889), 47 O. G. 811.

That manifest error in law is ground for a rehearing in the Patent Office, see Green *v.* Hall (1889), 47 O. G. 1631.

That after judgment in interference a party who neglected to prepare and try his case cannot have a rehearing, see Beardslee *v.* Moeslein (1889), 46 O. G. 1640.

That motions for a rehearing by different parties to an interference should all be made and heard together, see Green *v.* Hall (1889), 47 O. G. 813.

Effect of Judgment.

That a judgment in interference concludes the issues according to the construction put upon them by the court, and parties who acquiesce in such judgment cannot be allowed afterward to claim for it a different effect, see *Ex parte* Gray (1889), 46 O. G. 1277.

That the examiner is concluded by a judgment in interference, see *Ex parte* Booth (1889), 49 O. G. 1841.

That a party to an interference may subsequently deny patentability in the courts, see Holliday *v.* Pickhardt (1887), 24 Blatch. 201; 29 Fed. Rep. 853.

Appeal.

That from a decision of an examiner that no interference exists, and that those declared must be dissolved, an appeal lies to the Commissioner, see Von Welsbach *v.* Lungren (1889), 48 O. G. 537.

That no appeal lies to the Commissioner from a decision of the examiner on a motion to dissolve an interference involving the right of one of the parties to make the Claim in issue, the Commissioner having no direct jurisdiction over that question, see Steward *v.* Ellis (1889), 49 O. G. 1983.

That an appeal may be signed by the attorney *nunc pro tunc*, see Pitney *v.* Smith (1889), 49 O. G. 129.

That the statement of the reasons for appeal on an interference is no part of the appeal itself and if omitted or defective the appeal may still be valid, and the statement afterward supplied or amended, see Pitney *v.* Smith (1889), 49 O. G. 129.

That where an appeal is seasonably taken the Commissioner cannot decide that it is taken for purposes of delay, see Pitney *v.* Smith (1889), 49 O. G. 129.

Bill for Patent by Defeated Party.

That the issue of a patent to the party prevailing in an interference cannot be delayed by the filing of a bill in equity by the defeated party, see Wells *v.* Boyle (1888), 43 O. G. 752.

That the unreasonable delay of one applicant in pursuing his rights cannot operate to delay action on contesting applicants, see *Ex parte* Lombard (1888), 43 O. G. 1347.

INVENTION.

That the application of a natural force may be a patentable invention, see Celluloid Mfg. Co. *v.* Frederick Crane Chemical Co. (1888), 36 Fed. Rep. 110.

That an invention reached by taking the one step in advance toward which the art was tending is new and patent-

able, see Anilin *v.* Lovinstein (1887), L. R. 12 App. 710.

That the idea of a method of soliciting custom is not an invention, see Bristol *v.* Equitable Life Assurance Soc. (1889), 52 Hun (N. Y.), 161.

INVENTIVE ACT.

Discovery, Inventive Skill.

That discovery is essential to patentability as well as novelty and utility, see *Ex parte* Devin (1888), 45 O. G. 709; *Ex parte* Gifford (1888), 45 O. G. 1457.

That an invention must be the product of an original conception, not merely the carrying forward of an original idea in degree, nor combining old devices without a new mode of operation, see Burt *v.* Evory (1890), 133 U. S. 349.

That inventive skill implies more than change of form, proportion, degree, use, or arrangement, see Worswick Mfg. Co. *v.* City of Kansas (1889), 38 Fed. Rep. 239.

That inventive skill requires thought, mechanical skill does not, see Butler *v.* Bainbridge (1886), 24 Blatch. 163.

That an inventor must perceive and be able to reproduce his invention and to communicate it to others, see McDonough *v.* Gray (1889), 46 O. G. 1245.

Evidence of Inventive Skill.

That coincidence in the conclusions of two or more alleged inventors indicates mechanical rather than inventive skill, see Falls Rivet Co. *v.* Wolfe (1889), 40 Fed. Rep. 465.

That failure to produce a long-needed and instantly accepted means shows that when produced it resulted from inventive skill, see Celluloid Mfg. Co. *v.* American Zylonite Co. (1888), 35 Fed. Rep. 301.

That a different and beneficial result, improving and cheapening the product, indicates that the change in the mode of production, which others were interested to discover but the patentee alone did discover, involved inventive skill, see Zinsser *v.* Kremer, (1889), 39 Fed. Rep. 111; 48 O. G. 114.

That the immediate adoption of a means which supplies a long felt want indicates novelty, see United Nickel Co. *v.* California Electrical Works (1885), 11 Sawyer, 250; 25 Fed. Rep. 475.

That acceptance by the public is evidence of patentability, see Tondeur *v.* Chambers (1889), 37 Fed. Rep. 333; 46 O. G. 1110.

That public acceptance indicates inventive skill, see Shipman Engine Co. *v.* Rochester Tool Works (1888), 44 O. G. 1067.

That a device is so useful as to obtain immediate public recognition indicates that if inventive skill were not needed to produce it, it would have before been in use, see Guarantee Trust and Safe Deposit Co. *v.* New Haven Gas Light Co. (1889), 39 Fed. Rep. 268; 48 O. G. 1661.

That acceptance by the public and its late production when long needed shows inventive skill, see Stegner *v.* Blake (1888), 36 Fed. Rep. 183; 45 O. G. 126.

That immediate acceptance by the public is better evidence of invention than the opinions of experts and judges, see Palmer *v.* Johnston (1888), 34 Fed. Rep. 336; 43 O. G. 758.

Inventor.

That "one who seeks to enforce the rights secured by a patent is an Ishmaelite, — his hand against every one, and every one's hand against him,"

see Underwood *v.* Gerber (1889), 37 Fed. Rep. 682; 48 O. G. 116.

That the earliest reducer is favored by the law, see Green *v.* Hall (1889), 46 O. G. 1515.

Joint Inventors.

That the burden of proof is on an employer claiming joint invention against the sole patent of the employee, see Locke *v.* Lane & Bodley Co. (1888), 35 Fed. Rep. 289.

That one of two joint patentees may afterward file a sole application and have an interference declared with the joint patent, and is not estopped by his former joint oath nor barred by a previous assignment, since the assignees would become the owners of the sole patent when granted, see Kohler *v.* Kohler (1888), 43 O. G. 247.

That a sole applicant is not estopped by his sworn preliminary statement, when previously one of two joint applicants, nor by his testimony then offered as to the date of public use, that question not being in issue, see Mead *v.* Brown (1889), 48 O. G. 397.

That the testimony of one of two joint patentees and alleged joint inventors that he was in fact a sole inventor is neutralized by his former oath taken to obtain the patent, see Schlicht & Field Co. *v.* Chicago Sewing-Machine Co. (1888), 36 Fed. Rep. 585; 46 O. G. 1394.

JUDGMENTS.

Supreme Court

That decisions of the Supreme and Circuit Courts will be followed where there is no new evidence, see American Bell Telephone Co. *v.* Wallace Electric Tel. Co. (1889), 37 Fed. Rep. 672.

That a judgment of the Supreme Court may be departed from when the facts are different, see American Bell Telephone Co. *v.* Southern Telephone Co. (1888), 34 Fed. Rep. 795.

That *prior judgments*, even of the Supreme Court, between other parties and on other facts may be departed from, see Worswick Mfg. Co. *v.* City of Kansas (1889), 38 Fed. Rep. 239.

Circuit Courts.

That a judgment in the same circuit by another judge, with the same parties and the same issues, will be followed, see Heysinger *v.* Rouss (1889), 40 Fed. Rep. 584.

That comity requires a judgment in a co-ordinate court in favor of validity to be followed where issues and evidence are the same, see Hancock Inspirator Co. *v.* Regester (1888), 35 Fed. Rep. 61; Hammerschlag Mfg. Co. *v.* Spalding (1888), 35 Fed. Rep. 67.

That one Circuit court will not reverse its own decisions out of deference to comity toward another, though it might have followed such other had its judgment been previously known, see Consolidated Roller Mill Co. *v.* George T. Smith Middlings Purifier Co. (1889), 40 Fed. Rep. 305.

That the comity of courts does not require a decision to be followed after the Supreme Court has defined more strictly the points by which the court was guided, see Rubber & Celluloid Harness Trimming Co. *v.* India Rubber Comb Co. (1888), 44 O. G. 343.

That the decision of co-ordinate courts that the re-issue does not depart from the original will be followed on a motion for an injunction, see Putnam *v.* Keystone Bottle Stopper Co. (1889), 38 Fed. Rep. 234; 48 O. G. 113.

Supreme Court of D. C.

That the judgments of the Supreme Court of the District of Columbia in patent cases are entitled to great respect, see Shannon *v.* Brunner (1887), 33 Fed. Rep. 289; 41 O. G. 697.

Patent Office.

That an interference decision concludes the parties as to priority even in the courts, but does not prevent the defeated party from denying validity on other grounds, see Lyon *v.* Donaldson (1888), 34 Fed. Rep. 789.

That a judgment in interference is no proof of validity and does not warrant an injunction, see Dickerson *v.* De La Vergne Refrigerating Mach. Co. (1888), 35 Fed. Rep. 143. See the above case as to the value of interference decisions generally.

Between Other Parties.

That a decree finding a patent invalid is not a judgment *in rem* and does not prevent the plaintiff from suing another defendant and establishing his patent on the same or further evidence, see Consolidated Roller-Mill Co. *v.* George T. Smith Middlings Purifier Co. (1889), 40 Fed. Rep. 305.

On Other Issues.

That a judgment sustaining a patent for a certain form or degree of an invention raises a presumption of validity only as to that form or degree, see Cary *v.* Miller (1888), 34 Fed. Rep. 392.

On the Same Evidence.

That where a patent has been twice sustained against a defence of public use the judgments will be followed unless new facts are shown, see Simonds Counter Mach. Co. *v.* Knox (1889), 39 Fed. Rep. 702.

JUDICIAL SALE.

That a patent cannot be taken on execution in a suit at law, though special proceedings under State statutes may subject them to the claims of creditors, see Wilson *v.* Martin-Wilson Fire Alarm Co. (1889), 149 Mass. 24.

That a license under a patent may be taken on execution by the licensor and sold to satisfy a judgment against the licensee, see Matthews *v.* Green (1884), 17 Phila. 540.

That where the owner of a patent conceals or withholds it from his creditors it is a fraud for which he may be sued and his body taken on execution, see Keene, petitioner (1886), 15 R. I. 294.

That a judgment debtor may be compelled by equity to assign his patent to the creditor, see Clan Ranald *v.* Wyckoff (1877), 41 Sup. Ct. (N. Y.), 527.

That a State has power to enact that the patents of the insolvent shall vest in his assignee, and the assignee may invoke the aid of equity to compel the execution of the necessary conveyance by the insolvent, see Barton *v.* White (1887), 144 Mass. 281.

JURISDICTION.

Law and Equity.

That a patentee may sue either in equity or at law according to the nature of the relief demanded, see Wise *v.* Grand Avenue R. R. Co. (1888), 33 Fed. Rep. 277.

That a patentee having a right to an injunction may sue in equity for it and an accounting, or at law for damages measured by license fee, see Bragg *v.* City of Stockton (1886), 11 Sawyer, 597; 27 Fed. Rep. 509.

That a bill for an injunction and

account may be entertained in equity though the patent has but a few weeks to run, see Kittle *v.* Rogers (1887), 33 Fed. Rep. 40.

That equity will take cognizance of a suit brought long enough before the patent expires to enable equity relief to be granted, see Singer Mfg. Co. *v.* Wilson Sewing Mach. Co. (1889), 38 Fed. Rep. 586.

That where equity will order a final injunction it may also direct an account of damages and profits, see Asbestine Tiling & Mfg. Co. *v.* Hepp (1889), 39 Fed Rep. 324; 49 O. G. 413.

That equity has jurisdiction of a bill filed to ascertain and administer the rights of the parties under a contract concerning the use of patented inventions, see Reese's Appeal (1888), 122 Pa. St. 392.

That equity has jurisdiction of an action by a licensor to obtain an account of royalties from his licensee and an injunction against unlicensed uses of the invention, see Ball Glove Fastening Co. *v.* Ball & Socket Fastener Co. (1888), 36 Fed. Rep. 309.

That equity has jurisdiction to enjoin a licensee who repudiates the license, conspires against the licensor, and still uses the patented invention, see Hat Sweat Mfg. Co. *v.* Porter (1888), 34 Fed. Rep. 745; 44 O. G. 1070

That equity has no jurisdiction over a suit by a licensee in the name of the patentee for damages for past infringements, see Ulman *v.* Chickering (1888), 33 Fed. Rep. 582.

That an objection to equity jurisdiction on the ground that the remedy at law is adequate must be taken by demurrer, plea, or answer, and not at the final hearing, see Consolidated Roller-Mill Co. *v.* Coombs (1889), 39 Fed. Rep. 25; 48 O. G. 255.

Federal Courts.

That the act of March 3, 1887, does not repeal the provisions of the Revised Statutes conferring jurisdiction of patent cases on the Federal courts irrespective of the amount in dispute, see Miller-Magee Co. *v.* Carpenter (1888), 34 Fed. Rep. 433; 43 O. G. 1118.

That a suit to prevent the making and selling of patented articles, whatever its apparent form or purpose, is within the exclusive jurisdiction of the Federal courts, see Kayser *v.* Arnold (1886), 41 Hun (N. Y.), 275.

That questions involving the legal validity of a patent cannot be considered by a State court, see Nichols *v.* Marsh (1886), 61 Mich. 509.

That an action on a license in which the validity and infringement of a patent are put in issue by the pleadings is a patent case of which the Federal courts have jurisdiction, see St. Paul Plow Works *v.* Starling (1888), 127 U. S. 376; 43 O. G. 1350.

That a controversy between parties claiming under different patents and involving the scope of either patent is within the exclusive jurisdiction of the Federal courts, see Garver *v.* Bement (1888), 69 Mich. 149.

State Courts.

That an action on contract is not within Federal jurisdiction, see Dale Tile Mfg. Co. *v.* Hyatt (1888), 125 U. S. 46; 43 O. G. 249; Felix *v.* Scharnweber (1888), 125 U. S. 54; 43 O. G. 251.

That a case based entirely on contract is not a patent case within the jurisdiction of the Federal courts, see

Brooklyn Watch Case Co. *v.* Leach (1888), 35 Fed. Rep. 2; Williams *v.* Star Sand Co. (1888), 35 Fed. Rep. 369.

That State courts have jurisdiction of actions arising out of express contracts though patent rights may come in question, see Creighton *v.* Haggerty (1884), 50 Sup. Ct. (N. Y.) 9.

That a State court may decide questions as to the title to letters-patent but cannot enjoin a party from suing for infringement in the Federal courts, see Childs *v.* Tuttle (1889), 54 Hun (N. Y.), 57.

That the State courts may take cognizance of an action to enforce a contract relating to a patent, pending an infringement suit between the same parties in the Federal court, see Nichols *v.* Marsh (1886), 61 Mich. 509.

That an action demanding the assignment of a patent and damages is not a patent case within the jurisdiction of the Federal courts, see Wren *v.* Annin (1888), 34 Fed. Rep. 435.

That State courts have jurisdiction of actions by licensors to recover royalties, see Hubbard *v.* Allen (1889), 123 Pa. St. 198.

That the Federal courts have no jurisdiction where the sole question at issue is the forfeiture of a license, though the suit is brought for infringement and the State courts have refused to entertain it, see McCarty & Hall Trading Co. *v.* Glaenzer (1887), 24 Blatch. 269.

That the Federal courts have no jurisdiction of an action to construe a license, and determine whether the licensee has complied with it, and if not whether the non-compliance works a forfeiture, see Densmore *v.* Three Rivers Mfg. Co. (1889), 38 Fed. Rep. 747.

That State courts have jurisdiction of a bill in equity to enjoin the defendant from slander of the plaintiff's invention, see Flint *v.* Hutchinson Smoke Burner Co. (1889), 38 Fed. Rep. 546.

Court of Claims.

That the Court of Claims has jurisdiction over claims of patentees for the use of their inventions by the United States with their consent, see United States *v.* Palmer (1888), 128 U. S. 262.

That the Court of Claims has no jurisdiction of a suit for the use of an invention by the government unless the facts imply a contract, see Schillinger *v.* United States (1889), 24 Ct. of Claims 278; Forehand *v.* United States (1888), 23 Ct. of Claims 477.

Local Jurisdiction.

That a defendant cannot be sued outside his own district under the Act of 1887 unless he consents, and if he appears specially and demurs the bill must be dismissed, see Halstead *v.* Manning (1888), 44 O. G. 344.

That a corporation cannot be sued for infringement outside the State of its creation merely because its factories are located and its business conducted by agents in the district of suit, see Preston *v.* Fire Extinguisher Mfg. Co. (1888), 46 O. G. 124.

That an objection to local jurisdiction may be made by demurrer or by motion to dismiss, see Miller-Magee Co. *v.* Carpenter (1888), 34 Fed. Rep. 433; 43 O. G. 1118.

That want of local jurisdiction under the Acts of 1887–88, can be waived by appearance, see McBride *v.* Grand de Tour Plow Co. (1889), 40 Fed. Rep. 162; Morrison *v.* Canton Surgical & Dental Chair Co. (1889), 49 O. G. 733.

LIBEL.

That equity will enjoin against malicious public threats to sue a patentee's vendees, but in such suit will not pass on the validity of the patent, see Emack *v.* Kane (1888), 34 Fed. Rep. 46.

That a patentee will not be enjoined from notifying an infringer's customers that he will sue them for the use of the invention, see Tuttle *v.* Matthews (1886), 24 Blatch. 16.

LICENSE EXPRESS.

What is.

That however exclusive the right conveyed and however unlimited the territory, if it leaves any interest in the monopoly in the patentee within the territory defined, it is a mere license, see Tuttle *v.* La Dow (1889), 54 Hun (N. Y.), 149.

That an agreement not to sue for future infringements on payment of certain royalties is in effect a license, and the licensor cannot treat the licensee as an infringer merely because the royalties are not paid, see Siebert Cylinder Oil Cup Co. *v.* Detroit Lubricator Co. (1888), 34 Fed. Rep. 216.

Exclusive License.

That an exclusive license is a leave to do a thing and a contract not to allow any one else to do it, but confers no interest in the thing and gives the licensee no right to sue in his own name, see Heap *v.* Hartley (1889), L. R. 42 Ch. D. 461.

License to Use.

That where an express license accompanies the sale of a patented article, the vendee is bound by the scope of the license, see Morgan Envelope Co. *v.* Albany Perforated Wrapping Paper Co. (1889), 40 Fed. Rep. 577.

That the right of a licensed user before patent to use the devices after patent extends to improvements on the devices, see Campbell *v.* City of New York (1888), 35 Fed. Rep. 504; 44 O. G. 1185.

That the licensee of a machine can repair it or replace parts, if its identity is not destroyed, see Young *v.* Foerster (1889), 37 Fed. Rep. 203; 47 O. G. 1353.

That each member of a machine may be covered by a different patent, and the replacing of one member may then be an infringement, see Singer Mfg. Co. *v.* Springfield Foundry Co. (1888) 34 Fed. Rep. 393.

License to Sell.

That the exclusive licensee of a grantee cannot sell the invention outside the granted territory, see Hatch *v.* Hall (1887), 24 Blatch. 355.

Covenant to Suppress Infringements.

That the contract of a licensor to prevent infringements binds him to act with reasonable promptness, see Forncrook Mfg. Co. *v.* Iron Works (1886), 63 Mich. 195.

That a licensor fulfils his stipulation to defend his licensee if he protects him in any manner, see Covell *v.* Bostwick (1889), 39 Fed. Rep. 421.

That a covenant of the licensee to aid the licensor in suppressing infringements is binding upon him though he ceases to enjoy the license, and his sale of his business to a known intended infringer is a breach of the covenant, see Washburn & Moen Mfg. Co. *v.* Southern Wire Co. (1889), 37 Fed. Rep. 428.

Assignability.

That a mere license is not assignable unless it contains express words

to that effect, see Tuttle *v.* La Dow (1889), 54 Hun (N. Y.), 140.

That the receiver of a firm may sell its assets though they consist of inventions made under patents owned by a member of the firm, see Montross *v.* Mabie (1887), 24 Blatch. 282; 41 O. G. 931.

That a license to a partnership does not enure to a corporation formed by the copartners, nor is it assignable to them in their corporate capacity, see Locke *v.* Lane & Bodley Co. (1888), 35 Fed. Rep. 289.

License to Common Carrier.

That where the owner of a patent grants a license for the public use of the invention to a common carrier he cannot restrict its benefits to any fraction of the public, see Commercial Union Telegraph Co. *v.* New England Telephone Co. (1888), 61 Vt. 241.

Estoppel of Licensee.

That a licensee cannot defend by attacking the patent while receiving its benefits, see Hyatt *v.* Ingalls (1883), 49 Sup. Ct. (N. Y.) 375.

That a licensee enjoying the benefit of his license must pay his license fee until eviction, and a liability to damages which the licensor assumes is not such eviction, see Covell *v.* Bostwick (1889), 39 Fed. Rep 421.

That a licensee cannot defend a suit for royalties on the ground that the licensor has granted licenses at lower rates to other persons unless there was some agreement to the contrary in the license, or on the ground that the patent is invalid unless there has been an eviction, see McKay *v.* Smith (1889), 39 Fed. Rep. 556.

That a licensee to sell is not estopped to deny validity after his license expires, see H. Tibbe & Son Mfg. Co. *v.* Heinecken (1889), 37 Fed. Rep. 686; 47 O. G. 1221.

That where a licensee, in defence to an action for royalties, claims that the patent is invalid on the ground of prior use, he must in his notice or answer state where and by whom the use was made, see Hat Sweat Mfg. Co. *v.* Reinoehl (1886), 40 Hun (N. Y.), 47.

LICENSE IMPLIED.

Vendees of Patentee.

That the sale of the patented article by the patentee without restrictions frees it from the monopoly, see Pratt *v.* Marcan (1888), 25 Ill. App. 516.

That after a grant of territory by the patentee his vendees of the patented articles, with notice of the grant, cannot use the articles within that territory, see Sheldon Axle Co. *v.* Standard Axle Works (1889), 37 Fed. Rep. 789; 48 O. G. 117.

That a vendee of the patentee without notice of a prior licensee's exclusive rights in a certain district may use the vended articles in such district, see Heap *v.* Hartley (1889), L. R. 42 Ch. D. 461.

That purchasers of the interest remaining in the patentee after a grant of territory, knowing of the grant, and afterward renouncing their interest, cannot use in the granted territory articles bought of the patentee, see Sheldon Axle Co. *v.* Standard Axle Works (1889), 37 Fed. Rep. 789; 48 O. G. 117.

That the vendee of a patented article acquires all the rights of the vendor, and if the vendor is licensee of the owner of the whole monopoly, the article is entirely freed from the monopoly and may be repaired or used by the vendee or his servants or sold by

him to others, see Morgan Envelope Co. *v.* Albany Perforated Wrapping Paper Co. (1889), 40 Fed. Rep. 577.

Vendees of Grantee.

That the vendee of a grantee has no right to sell the article in the way of trade in the territory of mother grantee, see Standard Folding Bed Co. *v.* Keeler (1889), 37 Fed. Rep. 693.

That the vendee of a grantee cannot sell the articles in course of trade outside the grantee's territory, see Hatch *v.* Adams (1884), 17 Phila. 566.

That the sale of a patented article by a grantee of the patent within his own territory carries the right to use it within territory owned by another, though both parties know that such a use is intended, see Hobbie *v.* Jennison (1889), 40 Fed. Rep. 887. In deciding this case the learned judge follows Adams *v.* Burke, 17 Wall. 453, but dissents therefrom and states the converse and true doctrine in the opinion, q. v. 40 Fed. Rep. 890.

That an agreement between two joint owners to divide the territory between them and respect the exclusive rights of each other is not binding on the subsequent purchaser of the patented article from either without notice, and if he bought without restrictions he may use it anywhere, see Pratt *v.* Marean (1888), 25 Ill. App. 516.

Vendees of Foreign Patentee.

That the vendee of a lawful vendor abroad under a foreign patent cannot use in the United States without permission of the domestic patentee, see *Boesch v. Gräff* (1890), 133 U. S. 697; Gräff *v.* Boesche (1887), 33 Fed. Rep. 279; 13 Sawyer, 17.

Vendees in General.

For a discussion of the scope of an implied license in favor of the vendee of a patented article, see Morgan Envelope Co. *v.* Albany Perforated Wrapping Paper Co. (1889), 40 Fed. Rep. 577.

That the vendee of a patented device may use it till it is worn out, see Martha Washington Co. *v.* Martien (1889), 47 O. G. 1488.

Vendee under Wrongful Sale.

That judgment against the maker and vendor without satisfaction is no defence for the user, his vendee, see Fisher *v.* Consolidated Amador Mine Co. (1885), 11 Sawyer, 190; 25 Fed. Rep. 201.

Vendee before Patent.

That a patentable machine constructed with the consent of the inventor before patent is free from the monopoly, see Wade *v.* Metcalf (1889), 129 U. S. 202.

Use in Employer's business.

That an exclusive licensee under a license from an employee, whom he knew to be making and using the invention in the employer's factory, is chargeable with constructive notice of the employer's rights, see Dueber Watch-Case Mfg. Co. *v.* Dalzell (1889), 38 Fed. Rep. 597.

That an employee of the government, inventing a device at its expense and engrafting it upon the business in which he is occupied, licenses the government to use it without compensation, and his assignee also takes subject to such license, see Davis *v.* United States (1888), 23 Ct. of Claims, 329; Solomons *v.* United States (1886), 21 Ct. of Claims, 479; Solomons *v.* United States (1887), 22 Ct. of Claims, 335.

Use by Corporation of Member's Invention.

That where a corporation uses an invention belonging to one of its officers with his acquiescence there may be an implied contract to pay him a reasonable compensation or not as the other facts may indicate, see Deane *v.* Hodge (1886), 35 Minn. 146.

LOCATION, CHANGE OF.

That to change the location of a part without substantial change in the mode of operation or result is not invention, see Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co. (1887), 33 Fed. Rep. 254.

MANUFACTURE.

That a manufacture is not new because produced in a new way, see Hake *v.* Brown (1889), 37 Fed. Rep. 783; 47 O. G. 1071.

That a product of nature is not patentable because obtained or prepared by a new process, unless it is substantially changed in character thereby, see *Ex parte* Latimer (1889), 46 O. G. 1638.

MATERIALS, CHANGE OF.

That a change in material is not patentable unless involving inventive skill, see *Ex parte* Odenheimer (1889), 49 O. G. 1693.

That change of materials, unless of the essence of the invention, is a mere change of form, see Brinkerhoff *v.* Aloe (1888), 37 Fed. Rep. 92; 46 O. G. 338.

That a mere change of materials, though improving the result, is not invention, see *Ex parte* Krell (1887), 44 O. G. 1504.

That the substitution of a more durable material performing no new function is not invention, see J. L. Mott Iron Works *v.* Cassidy (1887), 24 Blatch. 289.

That the substitution of one material for another may involve invention, see Celluloid Mfg. Co. *v.* Frederick Crane Chemical Co. (1883), 36 Fed. Rep. 110.

That a new material, made by combining other materials, may be a patentable invention, see Celluloid Mfg. Co. *v.* American Zylonite Co. (1888), 35 Fed. Rep. 417.

NOTES.

That a State statute may require a note given for a patent right to state that fact on its face and then make the note open to all equitable defences, see Herdic *v.* Roessler (1888), 109 N. Y. 127; Herdic *v.* Roessler (1886), 39 Hun (N. Y.), 198.

That a negotiable promissory note, fair on its face, is valid in the hands of an innocent holder for value though taken by the payee in violation of the statutes, see Tescher *v.* Merea (1889), 118 Ind. 586.

That a note given for an English patent is not void though the patent be invalid for want of novelty, see Chemical Electric Light Co. *v.* Howard (1889), 148 Mass. 352.

PATENT.

That a patent issued without the signature of the Secretary has no validity, but the omission may be corrected and the patent be thenceforth valid, see Marsh *v.* Nichols (1888), 128 U. S. 605; 46 O. G. 239.

That a patent issued without the signature of the Secretary is a nullity, but the right to a patent still exists and is assignable, and if the patent

has been sold and the defect subsequently cured, the sale will not be set aside, see Marsh *v.* Scott (1888), 125 Ill. 114.

That a patent is not multifarious because it asserts that a number of different substances may be used as equivalents, see Celluloid Mfg. Co. *v.* Frederick Crane Chemical Co. (1888), 36 Fed. Rep. 110.

PATENT OFFICE.

That the classification in the Patent Office rests on actual divisions in the arts, not on names or titles, see *Ex parte* Willcox (1888), 45 O. G. 455.

That an examiner is both an executive and judicial officer, and in his executive capacity is controlled by the orders of the Commissioner issued on the petition of an applicant, and in his judicial capacity is subject to the Commissioner through the right of appeal, see *Ex parte* Rogers (1889), 49 O. G. 1361.

PRIOR PATENT.

That if the description in a prior patent would enable any good mechanic to make the present device from the one there described, the defence is sustained, see United States Bung Mfg. Co. *v.* Independent Bung & Bushing Co. (1887), 24 Blatch. 406.

That an English patent is given to the public at the date of sealing, see Bliss *v.* Merrill (1887), 33 Fed. Rep. 39; 42 O. G. 97.

PRIOR PUBLICATION.

That an English provisional specification is not a publication until the completed specification is enrolled, see Ireson *v.* Pierce (1889), 39 Fed. Rep. 795.

That a publication in a foreign language placed in the free public library of the Patent Office is presumed to have become known to the public until the contrary is shown, and is a good defence to a subsequent patent for the same invention, see Harris *v.* Rothwell (1887), L. R. 35 Ch. D. 416.

PRIOR USE.

What is.

That prior use requires a practical working apparatus, see Peney *v.* City of Lakeview (1888), 35 Fed. Rep. 586.

That successful experiments may show prior use, see Electrical Accumulator Co. *v.* Julien Electric Co. (1889), 38 Fed. Rep. 117.

That secret use is not prior use, see Zinsser *v.* Kremer (1889), 39 Fed. Rep. 111; 48 O. G. 114.

That the abandonment of a thing greatly wanted indicates that it was an unsuccessful experiment, see Brush *v.* Condit (1889), 132 U. S. 39; 49 O. G. 1211.

Notice.

That prior use and public use are distinct defences requiring separate notices, and the notice of prior use must give names and residences of parties using or having knowledge of the use, see Meyers *v.* Busby (1887), 13 Sawyer, 33.

That evidence of prior use taken without due notice will be rejected by the court, see Bragg *v.* City of Stockton (1886), 11 Sawyer, 597.

EVIDENCE.

That prior use must be proved beyond reasonable doubt, see Stegner *v.* Blake (1888), 36 Fed. Rep. 183; 45 O. G. 126; Smith *v.* Davis (1888), 34 Fed. Rep. 783.

That prior use must be clearly proved, and indefinite testimony inconsistent with the ordinary current of human conduct and events is not sufficient for that purpose, see Electrical Accumulator Co. *v.* Julien Electric Co. (1889), 38 Fed. Rep. 117. See the above rule applied in this case.

PROFITS IN EQUITY.

Infringer liable for.

That an infringer is not a trustee *de son tort*, but is treated in an accounting in equity in the same manner, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

That though the plaintiff has an established license fee which would measure his recovery of damages at law he may still recover profits in equity without reference to the amount of the license fee, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

That an erroneous decision made in favor of a different infringer pending the present infringement does not affect the liability of the present defendant to pay full profits, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

Include Savings.

That the saving from a greater loss is a profit, see Celluloid Mfg. Co. *v.* Cellonite Mfg. Co. (1889), 40 Fed. Rep. 476; Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

Include Actual Profits only.

That the actual profit as the defendant has used the invention, not the possible profit from a different use, is to be accounted for, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

Must be due to the Plaintiff's Invention.

That a plaintiff cannot recover the entire profits unless the whole market value were due to his invention, see Fay *v.* Allen (1887), 24 Blatch. 275.

That where the entire profit of the defendant is derived from the plaintiff's invention, the plaintiff is entitled to recover it, see Hurlburt *v.* Schillinger (1889), 130 U. S. 456; 47 O. G. 1067.

That where the entire efficiency and salability of an invention depend on the patented feature the patentee is entitled to recover all the profits, see McDonald *v.* Whitney (1889), 39 Fed. Rep. 466.

That the burden is on the defendant to show what part of his profits was due to his own improvements, when the plaintiff's invention apparently gave the device its market value, see Morss *v.* Union Form Co. (1889), 39 Fed. Rep. 468.

Measured by Advantage over open Inventions.

That profits are the advantage derived by the infringer over what he would have obtained by adopting some other available method, see Shannon *v.* Brunner (1888), 33 Fed. Rep. 871.

That in estimating profits the advantage of using the infringing device is to be compared with that of using devices previously employed for the same purpose, see Coupe *v.* Weatherhead (1888), 37 Fed. Rep. 16.

That the profits of the defendant are what he made or saved over what could have been saved or made by using means free to the public, see McMurry *v.* Emerson (1888), 36 Fed. Rep. 901; 47 O. G. 815.

That profits are to be measured by the advantage received by the defend-

ant over what he would have enjoyed by using other means then open to the public, and adequate to obtain an equally beneficial result, see Webster Loom Co. *v.* Higgins (1889), 39 Fed. Rep. 462; 48 O. G. 1119; Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

That the defendant's profit may be measured by the amount charged by him when using the patented invention in excess of that charged when he does not use it, see Vulcanite Paving Co. *v.* American Artificial Stone Pavement Co. (1888), 36 Fed. Rep. 378; 45 O. G. 948.

From Use of Composition.

That when a patented composition is used in making a device and gives it its value, the patentee is entitled to the entire profit, see Welling *v.* La Bau (1888), 34 Fed. Rep. 40; 43 O. G. 117.

From Use of Design.

That the profits on a design are the difference between the profits of articles with it and without it, see Tomkinson *v.* Willcts Mfg. Co. (1888), 34 Fed. Rep. 536.

Interest.

That generally interest is not to be allowed on profits before the date of the submission of the master's report, see Tilghman *v.* Proctor (1888), 125 U. S. 136; 43 O. G. 628.

Profits not proved, Nominal Damages awarded.

That where on an accounting it does not appear what definite profits were due to the invention, only nominal damages can be allowed, see Roemer *v.* Simon (1887), 24 Blatch. 396; Everest *v.* Buffalo Lubricating Oil Co. (1887), 24 Blatch. 463.

That where the profits cannot be computed, nominal damages may be awarded, see Fischer *v.* Hayes (1889), 39 Fed. Rep. 613.

Not recovered as Damages.

That profits made by the defendant, in excess of those of which the plaintiff was deprived, cannot be recovered as damages, see Morss *v.* Union Form Co. (1889), 39 Fed. Rep. 468.

Computation.

That a rule for computing profits adopted in one part of a case will be followed in the future proceedings in that case, see Webster Loom Co. *v.* Higgins (1889), 39 Fed. Rep. 462; 48 O. G. 1119.

REDUCTION TO PRACTICE.

That filing a caveat is not reduction to practice, see Elges *v.* Miller (1889), 46 O. G. 1514.

That a working model designed and intended as such is not reduction to practice, see Green *v.* Hall (1889), 47 O. G. 1631; Green *v.* Hall (1889), 46 O. G. 1515.

That drawings are not reduction though filed in the Patent Office, nor do they show a practical embodiment sufficient to save the rights of the first conceiver as against a later rival, see Beach *v.* Fowler (1889), 48 O. G. 821.

That the Patent Office has no means of determining whether or not an invention has been reduced to practice, see Green *v.* Hall (1889), 47 O. G. 1631.

RE-ISSUE

Scope.

For a review and interpretation of the cases concerning the scope of a re-issue, see Parker & Whipple Co. *v.* Yale Clock Co. (1887), 123 U. S. 87; 41 O. G. 811.

That a re-issue can cover only what an examination of the original in the light of the re-issue shows that the original was intended to embrace, see Flower *v.* Detroit (1888), 127 U. S. 503; 43 O. G. 1348; Hoskin *v.* Fisher (1888), 125 U. S. 217; 43 O. G. 500; Parker & Whipple Co. *v.* Yale Clock Co. (1887), 123 U. S. 87; 41 O. G. 811.

That a re-issue cannot cover matter which the original did not describe or claim, after intervening rights have arisen, see Dunham *v.* Dennison Mfg. Co. (1889), 40 Fed. Rep. 607.

That the introduction into a re-issue of an invention radically different from the original after long delay is fatal, see Hubel *v.* Dick (1886), 24 Blatch. 130; 28 Fed. Rep. 656; 37 O. G. 1457.

That an assignee cannot so re-issue as to broaden the invention, see *Ex parte* Mahnken (1887), 41 O. G. 1269.

Of Combination Patent.

That the re-issue of a combination-patent within reasonable time may cover subcombinations and elements, see Hubel *v.* Dick (1886), 24 Blatch. 59; 28 Fed. Rep. 132; 36 O. G. 939.

Of Patent for an Art.

That a Claim for the process cannot be inserted into the re-issue of a patent for the apparatus or product, or *vice versa*, unless they are so related to each other as to constitute but one invention, see *Ex parte* Tainter (1889), 47 O. G. 135. See the opinion in this case for an extended discussion of the relations of processes, apparatus, and products toward each other.

Enlarging Claims.

That a re-issue cannot enlarge Claims unless there has been a clear mistake inadvertently committed in wording them, see Huber *v.* N. O. Nelson Mfg. Co. (1889), 38 Fed. Rep. 830; 47 O. G. 1732.

That a re-issue cannot enlarge a Claim by omitting an element previously claimed as essential, see Matthews *v.* Iron Clad Mfg. Co. (1888), 134 U. S. 347; 42 O. G. 827.

That a re-issue with enlarged Claims to cover matter already in public use after unreasonable delay is void, see Flower *v.* Detroit (1888), 127 U. S. 503; 43 O. G. 1348.

That where the first re-issue enlarged the Claims a second re-issue may repeat the Claims of the original patent, see Sawyer Spindle Co. *v.* Eureka Spindle Co. (1888), 33 Fed. Rep. 836.

Cannot cover Matter intentionally Excluded.

That a Claim restricted by direction of the Patent Office in the first re-issue cannot be enlarged by subsequent re-issues, see Yale Lock Co. *v.* James (1888), 125 U. S. 447; 43 O. G. 881.

That a re-issue to restore a Claim rejected by the Patent Office with the acquiescence of the applicant is invalid though applied for within two years after the original was granted, see Union Paper Bag Mach. Co. *v.* Waterbury (1889), 39 Fed. Rep. 389.

That a re-issue may correct errors occasioned by mistaken ideas of the objections raised in the Patent Office, see Hutchinson *v.* Everett (1887), 33 Fed. Rep. 502.

Unreasonable Delay.

That laches in applying for a re-issue is fatal to the re-issued patent, and may be taken advantage of by a demurrer, see Philadelphia Novelty Mfg. Co. *v.* Rouss (1889), 39 Fed. Rep. 273; 48 O. G. 1604.

That the Commissioner has no jurisdiction over an application for a re-issue unless it is filed within a reasonable time, see Hutchinson *v.* Everett (1887), 33 Fed. Rep. 502.

That whether delay in applying for a re-issue is reasonable is a question of law for the court, and the decision of the Patent Office on that point is not conclusive, see Hoskin *v.* Fisher (1888), 125 U. S. 217; 43 O. G. 509.

That delay in re-issuing to expand the Claims, if unexplained, is fatal, see Wollensak *v.* Sargent (1888), 33 Fed. Rep. 840.

That the plaintiff must explain the delay in obtaining a re-issue, see Hoskin *v* Fisher (1888), 125 U. S. 217; 43 O. G. 509.

Inadvertence, etc.

That inadvertence or mistake must exist in reference to the application, not the invention, and the re-issue must be confined to the invention inadvertently misdescribed or misclaimed in the original, see *Ex parte* Mahnken (1887), 41 O. G. 1260.

That a patentee taking his patent with full knowledge of the limitations imposed by the Patent Office and the consequent imperfection of his Claims, cannot set up inadvertence, &c., as a ground for a re-issue, see *Ex parte* Page (1888), 43 O. G. 1455.

That acquiescence in the rejection of a Claim by the Patent Office shows that the exclusion of the matter claimed was not inadvertent or accidental, see Union Paper Bag Mach. Co. *v.* Waterbury (1889), 39 Fed. Rep. 389.

That the decision of the Commissioner as to inadvertence, accident, or mistake, may be reviewed by the courts, see Huber *v.* N. O. Nelson Mfg. Co. (1889), 38 Fed. Rep. 830; 47 O. G. 1732.

That the oath of the inventor to his inadvertence, etc., is not perfunctory, though he has assigned his interest, see *Ex parte* Mahnken (1887), 41 O. G. 1260.

Effect of Surrender.

That no action can be maintained on a patent after its surrender and pending an application for re-issue, see Burrell *v.* Hackley (1888), 35 Fed. Rep. 833; 44 O. G. 1400.

Evidence of Validity.

That on the question of the validity of a re-issue the original patent is admissible evidence, and such question is raised when the answer denies all the allegations of a bill averring that the original and re-issue were for the same invention, see Oregon Improvement Co. *v.* Excelsior Coal Co (1889), 132 U. S. 215; 49 O. G. 1694.

REPEAL.

That the United States may sue in equity for the repeal of a patent obtained by fraud, see United States *v.* American Bell Telephone Co. (1888), 128 U. S. 315; 45 O. G. 1311. See the argument and opinion in this case for a full discussion of the subject.

That a bill in equity to repeal two patents to the same party and relating to the same subject is not multifarious, see United States *v.* American Bell Telephone Co. (1888), 128 U. S. 315; 45 O. G. 1311.

Secretary of the Interior.

That the Secretary has no appellate jurisdiction over the Commissioner as to the judicial or quasi-judicial duties imposed on him by law, but may direct him to perform the duties which the law devolves upon him, and may

be appealed to as to matters prescribed by the rules established by the Secretary himself for the direction of his department, see Houston *v.* Barker (1888), 44 O. G. 697.

That the decisions of the Commissioner as to the admissibility of evidence are not reviewable by the Secretary, see Houston *v.* Barker (1888), 44 O. G. 697.

STAMPING.

That an article covering new, valuable, unpatented matter as well as parts that are patented cannot be marked "patented" as a whole, see Deverall *v.* Banker (1888), 45 O. G. 591.

That the stamp "patented" means that the article is protected by a patent *at the time of sale, and if the* patent has expired the mark is false, and the intent to deceive will be inferred from the act of marking itself, see New York Card Co. *v.* Union Card Co. (1886), 39 Hun (N. Y.), 611.

That in marking "with intent to deceive" the intent to deceive is essential and must be proved, see Deverall *v.* Banker (1888), 45 O. G. 591.

That to mark an unpatented article with "Patent applied for" is not an offence, see Schwebel *v.* Bothe (1889), 40 Fed. Rep. 478; 49 O. G. 1696.

STATE POWERS.

That the right of an inventor to sell his invention is not derived from the Patent Law, and may be controlled by the State authorities, see Herdic *v.* Roessler (1888), 109 N. Y. 127.

That a State cannot tax the property in letters-patent, but may tax the proceeds thereof, see Herdic *v.* Roessler (1886), 39 Hun (N. Y.), 198.

That a statute requiring the vendor of a patent-right to file a copy of the patent with the county clerk, and to swear that it is genuine, and that a note given for such a right shall state that it is so given, is valid; but such statute applies only to the patent-right, not to the article made under it, see Hankey *v.* Downey (1888), 116 Ind. 118; Pape *v.* Wright (1889), 116 Ind. 502.

TERM OF PATENT.

Provable by Parol.

That the American patent need not declare its true term on its face, but the exact limit may be proved by parol, see Bate Refrigerating Co. *v.* Hammond (1889), 129 U. S. 151; 46 O. G. 689.

That the term of a patent, however it may be stated in the patent, may be inquired into as a matter of fact in view of foreign patents, see Edison Electric Light Co. *v.* Westinghouse (1889), 40 Fed. Rep. 666.

When limited by foreign Patents.

That an American patent may expire with the prior foreign patent when the American covers some improvements if the invention is substantially the same, see Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co. (1887), 33 Fed. Rep. 254; Siemen's Administrator *v.* Sellers (1887), 123 U. S. 276.

That a domestic patent expires with the foreign one, though the former includes other features which are not separable inventions, see Clark *v.* Wilson (1886), 24 Blatch. 39; 28 Fed. Rep. 95; 36 O. G. 456.

That the domestic patent will be limited by the term of the foreign if the foreign were first issued, though the domestic were first applied for, see Edison Electric Light Co. *v.* U. S.

Electric Lighting Co. (1888), 35 Fed. Rep. 134; 43 O. G. 1456.

That when an English patent is issued after the American, but is antedated to precede it, the term of the latter is not limited thereby, see Seibert Cylinder Oil Co. *v.* William Powell Co. (1888), 35 Fed. Rep. 591.

That the foreign patent will limit the term of the domestic whether it were granted to the same patentee or to some other person with his consent, see Edison Electric Light Co. *v.* U. S. Electric Lighting Co. (1888), 35 Fed. Rep. 134; 43 O. G. 1456.

Not enlarged by Extension of Foreign Patent.

That an American patent whose term is limited by that of a foreign patent expires when the foreign patent expires, see Bate Refrigerating Co. *v.* Hammond (1889), 129 U. S. 151; 46 O. G. 680.

That the extension of the term of a foreign patent by which that of the American patent is limited does not extend the latter, where the foreign extension is a matter of right, see Bate Refrigerating Co. *v.* Hammond (1889), 129 U. S. 151; 46 O. G. 689.

Effect of Forfeiture of Foreign Patent.

That the term of the domestic patent does not expire with the forfeiture of the foreign patent by failure to pay periodical taxes, see Paillard *v.* Bruno (1886), 24 Blatch. 177.

That an American patent cannot lawfully be granted after a foreign patent for the same invention has expired by forfeiture, see Huber *v.* N. O. Nelson Mfg. Co. (1889), 38 Fed. Rep. 830; 47 O. G. 1732.

That an American patent granted after the forfeiture of a foreign one is of too doubtful validity to warrant an injunction, see Huber *v.* Myers Sanitary Depot (1887), 33 Fed. Rep. 48.

That the same reasons exist for terminating an American patent by the premature failure of the foreign patent as for not extending it when the foreign patent is extended, see Huber *v.* N. O. Nelson Mfg. Co. (1889), 38 Fed. Rep. 830; 47 O. G. 1732. The contrary is true. When a foreign patent is extended, it is extended because of some merit peculiar to the foreign patentee. When it is forfeited, it is forfeited because of some demerit peculiar to the foreign patentee. If the merit resulting in an extension does not enure to the benefit of the American patentee, the demerit resulting in a forfeiture should not work him an injury.

That the term of a patent limited by that of a foreign patent expires when the limiting patent expires, whether by lapse of time, forfeiture, or other causes, see Huber *v.* N. O. Nelson Mfg. Co. (1889), 38 Fed. Rep. 830; 47 O. G. 1732; Pohl *v.* Anchor Brewing Co. (1889), 39 Fed. Rep. 782; 49 O. G. 1695; departing from preceding cases in deference to their interpretation of Refrigerating Co. *v.* Hammond (1889), 129 U. S. 151; 46 O. G. 689. If this doctrine is sustained the American patentee will be at the mercy of any foreign patentee or assignee who may choose to destroy the domestic patent by the sacrifice of his own; and in most cases a due regard to his interests would thus compel the American inventor, whom our law is supposed to favor and protect, to refrain from patenting his invention altogether in a foreign country, at least until after his patent has issued

in the United States. Such a consequence is directly opposed to the true intent of this provision of our statutes.

UNPATENTED INVENTION.

That an infringer before application for patent is not liable in damages in a suit on the patent, though he knew the plaintiff was the true inventor, see Lyon *v.* Donaldson (1888), 34 Fed. Rep. 789.

That the unlawful use of an invention will not be enjoined before a patent has issued, though an application be pending in the Patent Office, see Rein *v.* Clayton (1889), 37 Fed. Rep. 354. In this opinion, and the cases cited to support it, the distinction between the property in the invention and the property in the monopoly is not preserved; and the former is treated as if it had no legal existence apart from the latter, which is incorrect in fact as well as upon principle and authority.

That an inventor has a property in his invention, independent of any patent, until he makes it public, and it will meanwhile be protected against piracy by unfair means by the State courts of equity, see Tabor *v.* Hoffman (1889), 118 N. Y. 30.

That the patent grants to the patentee only the right to exclude others from practising the invention, not the right to make, use, or sell it himself, see Herdic *v.* Roessler (1888), 109 N. Y. 127.

That there is no property right in an invention until the patent issues, see Marsh *v.* Nichols (1888), 128 U. S. 605; 46 O. G. 230.

That one who discovers the inventor's secret by dishonorable means, but without a breach of trust, may use the invention before patent without liability, see Kortenhaus *v.* American Watch Co. (1884), 17 Phila. 134.

USES.

That the benefits of an invention belong to an inventor whether he has perceived them or not, see Brown *v.* District of Columbia (1889), 130 U. S. 87; 47 O. G. 398.

UTILITY.

That utility does not mean commercial success, see Anilin *v.* Levinstein (1887), L. R. 12 App. 710.

That an invention employed only for gambling is not useful or patentable, see National Automatic Device Co. *v.* Lloyd (1889), 40 Fed. Rep. 89.

That the efforts of others to accomplish a result may show that the means by which it is accomplished has utility, see Shannon *v.* Brewer (1887) 33 Fed. Rep. 289; 41 O. G. 697.

That one using an invention cannot deny its utility, see La Rue *v.* Western Electric Co. (1887), 24 Blatch. 392.

INDEX.

REFERENCES ARE TO SECTIONS.

ABANDONED EXPERIMENT, defined 346
not where intent to resume . . . . . 351 *n.* 2
cannot be revived after patent to rival . . . . . 389 *n.* 1, 600 *n.* 5
not invention . . . . . 80 *n.* 1, 2, 377 *n.* 3
shows inventive skill in successful inventor 123
not prior use 318
proof of 1026

ABANDONED INVENTION, defined 322, 346
evidence of . . . . . 390 *n.* 1, 1026
indicates want of success in the invention . . . . . 1030 *n.* 4
not prior use 321, 322, 323
a lost art 323

ABANDONMENT, its various meanings 346
of application for patent . . . . . 353 *n.* 2, 574–579
effect of . . . . . 574, 575 *n.* 2
(See APPLICATION FOR PATENT.)
to the public, defined 346, 965
discussed 346–360
under *English law* . . . . . 71 *n.* 1
our Acts of 1790, 1793, 1836, 1839, 1870 . . . . . 71 *n.* 2
a bar to a patent 71, 345
enures to benefit of public . . . . . 346 *n.* 1
impossible till invention complete . . . . . 346 *n.* 1
only by the inventor himself . . . . . 347 *n.* 1
not by one joint inventor . . . . . 347 *n.* 1, 402 *n.* 3
does not affect rival inventor . . . . . 388–390, 593 *n.* 2
a question for the jury . . . . . 347 *n.* 1, 350
of intention 347
presumed against . . . . . 345 *n.* 1, 351, 352 *n.* 1
various modes of 347, 349
by conduct 350–353
presumed against 351
by express declaration . . . . . 352 *n.* 1
not by mere casual words . . . . . 351 *n.* 2
by delay . . . . . 351 *n.* 1
possible at any time . . . . . 351 *n.* 1
before application, modes of 351
not by delay in applying for a patent . . . . . 346 *n.* 1, 389, 390
not by delay of attorney in filing application, if unknown to inventor . . . . . 551 *n.* 3
by delay of *prior inventor in applying* . . . . . 390 *n.* 3

References are to sections.

ABANDONMENT — *continued.*
to the public before application by public use . . . . . 348, 349 *n.* 1, 354–360
history of the doctrine 354
doctrine analyzed and stated . . . . . 357 *n.* 3
same defence as public use 365
affects all classes of inventions . . . . . 354 *n.* 2
must be of same exact invention 360
must make it accessible to public 356
experimental use is not 355
tortious use is not . . . . . 1030 *n.* 9
use in less than two years not . . . . . 351 *n.* 2
consent of inventor 357
not cured by assignment to user . . . . . 354 *n.* 2
by public sale . . . . . 348, 349 *n.* 1, 354–360
requisites of sale 359
invention sold must be complete and operative . . . . . 359 *n.* 2
must be same exact invention 360
must be sold without restriction 359
one sale enough . . . . . 359 *n.* 4
offer for sale enough . . . . . 359 *n.* 1
by application 352
describing and not claiming . . . . . 352, 465 *n.* 3, 506, 690, 691
after application, must be clearly proved 353
delays in Patent Office not 353
withdrawal of Claim as unnecessary not . . . . . 689 *n.* 1
public use or sale not . . . . . 353 *n.* 3
abandonment of application not . . . . . 353 *n.* 2, 574
after patent . . . . . 345 *n.* 2
holding under defective patent without notice of the defect not . 690 *n.* 1
lapse of time not . . . . . 692 *n.* 1
delay in suing not . . . . . 1104 *n.* 5
unreasonable delay in re-issue not 352
as a defence 995, 998, 1030
how proved 1030
pleadings at law must give notice of 998, 1005
bill in equity must deny . . . . . 1106 *n.* 2
decision of Commissioner on, not conclusive 578
governed by law in force at date of application . . . . . 347 *n.* 1

(See ACQUIESCENCE, ACTION IN EQUITY, ACTION AT LAW, APPLICATION FOR PATENT, CLAIM, DEFENCES, DELAY, DESCRIPTION, DILIGENCE, ESTOPPEL, EXPERIMENTAL USE, INVENTION, INVENTOR, LACHES, PIRATICAL USE, PUBLIC USE, RE-ISSUE, RIVAL INVENTORS, SALES, UNPATENTED INVENTION, UNREASONABLE DELAY.)

"ABOUT," IN DESCRIPTION, meaning of . . . . . 500 *n.* 3

ABSTRACTION not an invention . . . . . 140 *n.* 2

ACCIDENT, defined 658

ACCOUNT OF PROFITS from infringement, at law 1091
equity can compel 1137
remedy for, more adequate in equity than at law . . . . . 1086 *n.* 1
in equity, whenever infringement proved 1153, 1154
intricacy of, does not confer equity jurisdiction . . 1087 *n.* 3, 1091 *n.* 6, 1092 *n.* 5
in lieu of injunctions how kept 1202

(See ACCOUNTING, ACTION IN EQUITY, ACTION AT LAW, ASSUMPSIT, BOND AND ACCOUNT, DAMAGES, EQUITY, EQUITY JURISDICTION, INJUNCTION, JURISDICTION, MASTER, PROFITS, SALES.)

References are to sections.

ACCOUNTING IN EQUITY 1153–1160
granted only as incidental to other relief 1091
not where no profits could have been made 1100
suit at law not instituted pending . . . . . 956 *n.* 2, 1156 *n.* 2
(See ACCOUNT, ACTIONS IN EQUITY, DAMAGES, EQUITY JURISDICTION, MASTER, PROFITS, SALES.)

ACQUIESCENCE OF INVENTOR, effect of, on public use and abandonment . 357
exists when use is known and not forbidden 358
(See ABANDONMENT TO THE PUBLIC, and titles there cited; ACTION IN EQUITY, ESTOPPEL, INVENTOR, LACHES.)

ACQUIESCENCE OF PUBLIC IN PATENT, how shown 1187
evidence of validity 1016, 1174, 1185–1188
(See INJUNCTIONS, PATENT.)

ACT OF 1793, its rule that State patents must be surrendered when Federal patent issues . . . . . 45 *n.* 1

ACT OF 1839, its bearing on public use as abandonment . . . . . 357 *n.* 2

ACTS, special, conferring patents, effect of 46, 47
(See CONGRESS, PATENT LAW, PATENT PRIVILEGE, SPECIAL ACTS.)

ACTS OF CONGRESS concerning patents, abridgment of . . . . . 48 *n.* 1

ACTING-COMMISSIONER OF PATENTS, duty and authority of 424
(See COMMISSIONER, PATENT OFFICE.)

ACTION IN EQUITY, jurisdiction of (see EQUITY JURISDICTION).
local jurisdiction of 1096, 1097
for injunction brought only in district where defendant resides or infringes 933, *n.* 2
for account or damages brought in any district where defendant can be served with process . . . . . 933 *n.* 1
dismissed for want of jurisdiction at any time 1095
parties, all affected by decree must be 1098
adverse need not be on opposite sides . . . . . 1099 *n.* 1
plaintiffs, who must be 1098, 1099
joinder of all legal and equitable owners 1099
legal owner and person suffering from the infringement 1099 *n.* 1
grantees could be, under act of 1793 . . . . . 941 *n.* 2
holders of exclusive rights can be . . . . . 937 *n.* 2
misjoinder and non-joinder of 1102
objections for, when made 1102
added pending suit by order of court 1100
must sue in their own names 1101
not in name of attorney or delegate 1101
defendants, who may be 1104
officers of corporation must be, when bill prays discovery under oath . 1119
joinder of, reasons for must appear in the bill 1104, 1106
not necessary . . . . . 948 *n.* 2
non-joinder of, how cured 1105
misjoinder of 1104
capacity in which they are sued not changeable by amendment . . 1105
when needed, suit suspended till they appear . . . . . 1100 *n.* 1
amendment cures defect of 1100
not added where it would make practically a new suit . . . . . 1100 *n.* 6
outside the jurisdiction cannot be made to appear . . . . . 1100 *n.* 5
change of, may require supplemental bill 1122
during suit, effect of 1103
conveyance to new, during suit 781, 943, 1103
controlled by person for whose benefit it is brought 1103
process in, service of 1096, 1109
appearance of defendant 1109

References are to sections.

ACTION IN EQUITY — *continued.*
bill in 1100–1108
averment of inventive act, patent, title, infringement, profits, and damages 1106
that articles were stamped not necessary . . . . . 628 *n.* 3
must show relation of defendant to the infringement 1104, 1106
prayers for relief, discovery, injunction 1107
joinder of causes of action in 1108
what averments necessary 1108
multifariousness 1108
failure to swear to . . . . . 1111 *n.* 7
demurrer, what questions raised by 1110, 1111
sustained if remedy at law adequate . . . . . 1080, *n.* 1
laches apparent on the bill . . . . . 1114 *n.* 3
evident delay in re-issue . . . . . 1100 *n.* 3
bill shows laches in suing . . . . . 1104 *n.* 5
licensee sues alone in his own name . . . . . 1098 *n.* 8
not for bankruptcy of plaintiff . . . . . 1103 *n.* 1
admits truth of bill for purposes of demurrer only 1111
to part of the bill 1111
when waived 1111
procedure on 1111
judgment on 1111
overruling not a final decree . . . . . 1132 *n.* 1
pleadings, how differ from law . . . . . 999 *n.* 1
must raise the issues and set up every material fact . . . . . 1115 *n.* 1
lay a foundation for the evidence . . . . . 1115 *n.* 1
plea in, grounds of 1112
requisites of, faults in 1113
must not anticipate answer 1112
stating new matter may attack patent 1112
procedure and judgment on 1113
defences in 1114
laches, estoppel, favored 1114
of plaintiff 1114
equitable rights of defendant 1114
answer in 1114–1120
when several, when joint 1120
cannot be made by attorney . . . . . 1115 *n.* 6
not filed by one defendant after final decree against others 1120
defendant concluded by 1115
irresponsive, when an admission 1127
admissions in, as evidence 1127
examples of 1118
effect of 1118
waiver of 1118
must set up all the defences 1115
joinder of defences in 1115
defences, how stated in 1115
need not aver want of patentability . . . . . 1115 *n.* 2, 1116, *n.* 2
that the invention did not belong to a patentable class . 999 *n.* 2
averments in 1116, 1117
defendant's title 1117
invalidity of re-issue 1116
ambiguity, delay in disclaiming, neglect to stamp, license, etc. . . 1116
want of title in plaintiff 1117
absence or excuse for infringement 1117
license, estoppel *in pais* 1117
former recovery must allege satisfaction . . . . . 1117 *n.* 6

Reference are to sections.

ACTION IN EQUITY — *continued.*
answer in, objections to, reply to 1120
special matters, set up in answer not in plea or notice . . . 1000 *n.* 6, 1116
how stated 1116
same information to be given as in notice at law 1116
filed like notice 1120
prior use, patent, etc. 1116
abandonment, fraudulent specification, etc. 1116
insufficient notice may justify order to try the case at law . . 1116 *n.* 4
under oath, effect of 1119, 1127
advisability of 1119
how when joint 1120
of corporation only when officers are parties 1119
is evidence as well as defence . . . . . 1115 *n.* 6
needs two witnesses or equivalent to overcome it 1119–1127
replication, faults in . . . . . 1120 *n.* 6
amendment to bill or answer, when proper 1123
to contradict prior admission not allowed . . . . . 1123 *n.* 4
effect of, on evidence already taken . . . . . 1116 *n.* 4, 1123, 1128 *n.* 8
may save evidence improperly taken . . . . . 1116 *n.* 4
supplemental bill, grounds and requisites of 1122
cannot change character of suit 1122
may set up extension pending suit 1122
re-issue or disclaimer pending suit, disputed 1122
infringement pending suit 1122
procedure on 1122
cross-bills, requisites of, procedure on 1121
bill of revivor, suit abated restored by, when 1105
when proper, procedure on 1105
trial, modes of, to court or jury 1124
secret not allowed . . . . . 1124 *n.* 2
on feigned issues 1124–1126
history of 1125
not favored . . . . . 1125 *n.* 4
when allowed 1125
refusal of, *no ground for appeal* 1125
not the same as trial for damages at law . . . . . 1182 *n.* 5
procedure and evidence in 1126
verdict, effect of 1126
motion for new trial after 1126
procedure after 1126
allowed on new evidence after verdict and refusal of new trial 1123 *n.* 4
evidence in, burden of proof, etc. 1127
limited to issues created by the pleadings 1127
inadmissible without notice 1127
taken on insufficient answer struck out on motion . . . . . 1116 *n.* 4
by depositions, how taken 1124
mode of taking, objections, exceptions, etc. 1128
motion to suppress 1128
objections waived unless urged when evidence offered . . . . . 1116 *n.* 4
of plaintiff on rebutter cannot strengthen his case as to infringement 1127 *n.* 2
hearing and argument 1128
no new evidence filed after 1128
decrees, classes of 1130
pro confesso, when granted 1130
for non-appearance 1109
failure to plead 1109
effect of 1130
interlocutory, scope of, date of, amendment of, stay of 1131

References are to sections.

ACTION IN EQUITY — *continued.*
decrees, interlocutory, plaintiff entitled to 1131
on filing disclaimer 1131
when joint infringement is charged and not proved 1131
how made final . . . . . 1132 *n.* 1
final, what are 1132
reference to master not a 1132
defendant entitled to 1132
when patent void on its face whatever be his defence 1132
if no equitable relief needed when suit began or at present 1080 *n.* 2
if it appears that plaintiff has no legal or equitable interest 1098 *n.* 3
if too late for injunction and no other equitable relief needed 1093 *n.* 3
if no cause shown after accounting 1160
for defendant, no bar to new suit . . . . . 1182 *n.* 1
evidence already taken may stand for future use . . . . 1160 *n.* 2
will not decide questions not involved in the decree for future use 1132
may vary from interlocutory or from master's report on the accounting 1160
after accounting 1160
when amendable 1160
not granted against officers of solvent corporation unless they also infringe . . . . . 1160 *n.* 1
will not order defendant to deliver up infringing articles to be destroyed . . . . . 1160 *n.* 1
injunctions (see INJUNCTIONS) 1108–1223
rehearings, when and how granted 1133–1135
for new evidence 1134
requires supplemental bill 1122
new defences 1135
recent decisions in Supreme Court . . . . . 1135 *n.* 7
as to amount of damages 1135
not to cure ignorance or laches of counsel 1135
denied if applicant guilty of laches . . . . . 1135 *n.* 6
evidence already taken stands for 1135
re-argument, when permitted 1135
rules of practice and procedure 1129
made by Supreme Court bind Circuit Courts 1129
not affected by expiration of patent pending suit 1093
may be suspended pending other actions . . . . . 1155 *n.* 5
stipulations of counsel in 1129
account in, all infringers liable to 1137, 1153
may be ordered though no injunction required . . . . . 1155 *n.* 1
where defendant the only possible infringer 1153
how and before whom taken 1155
accounting, procedure on 1156
master may take in foreign countries . . . . . 1155 *n.* 4
to forward the taking 1155
to suspend or stay as court may order 1155
bound by orders and decrees of court 1155
may hear all questions of gains or savings 1156
cannot hear claim that re-issue is invalid . . . . . 1156 *n.* 1
decide collateral rights of defendant . . . . . 1156 *n.* 1
fact of infringement or scope of patent 1156
by several defendants 1153
when defendant fails to appear 1155
by government officers 1153
representatives of deceased infringers 1153
successive corporations 1153

References are to sections.

ACTION IN EQUITY — *continued.*
evidence on accounting, plaintiff must give sufficient data 1157
must be certain 1157
admissibility of 1157
burden of proof 1157
objections, exceptions 1157
presumed that defendant cannot overcome plaintiff's proof unless he does so . . . . . 1157 *n.* 9
neither court nor master to suggest what is needed . . . . 1157 *n.* 1
admissions in answer as 1157
inspection of defendant's books 1157
opinions of others 1157
amounts paid by defendant or others 1157
license-fees as measure of damages . . . . . 1157 *n.* 7
amounts paid in settlement or as royalties by others not . . . 1157 *n.* 7
inadmissible after draft report filed 1157
papers filed with master pending an 1157
draft report of master 1155
objections to 1155
final report of master, exceptions to and procedure thereon 1158
items not supported by evidence struck out . . . . . 1159 *n.* 5
erroneously awarding damages or profits set aside or corrected by the court 1159
recommitted, for amendment or further hearing 1159
for excessive damages . . . . . 1159 *n.* 1
not reviewed as to matters of fact 1158
acceptance of 1160
available on subsequent hearing . . . . . 1159 *n.* 1
recovery in, how differs from damages at law 1050, 1091
profits and damages both recoverable . . . . . 1136 *n.* 2
awarded under general prayer in the bill . . . . . 1138 *n.* 2
theory of . . . . . 1062 *n.* 7, 1136
account of, theory and history of 1137
must be pecuniary in character 1146
do not include remote or contingent benefits 1146
must be computed, not conjectured 1143
how computed 1138
when presumed . . . . . 1138 *n.* 1
rule of, not uniform 1138
mode of computation determined by form of infringement 1138
not measured by royalties . . . . . 1143 *n.* 3
amounts paid by others to settle suits . 1152 *n.* 1, 1157 *n.* 7
computation, covers what period 1152
how affected by the period of infringement 1152
cannot be increased by the court 1152
evidence of plaintiff favored 1150
liberally construed . . . . . 1143 *n.* 2
form of decree covering . . . . . 1138 *n.* 2
distribution *among* plaintiffs 1160
on infringing sales, how computed when the exact invention is sold . . 1139
data for computation 1143
measured by the difference between cost and yield 1139
burden of proof as to 1143
to be separated from those arising from other inventions 1140
arise only when the goods sold are paid for 1139
evidence as to 1143
items of cost allowable 1139
service and losses of infringers not allowed 1139

Reference are to sections.

ACTION IN EQUITY — *continued.*
how computed when the invention is embraced in the article sold and adds to the number or amount of sales 1141
gives it all its market value 1142
adds to the profits on each sale 1140
how computed on sale of articles containing an infringing design 1138 *n.* 2
from commissions on sales, repairs, use by vendees of infringer, etc. . 1151
for infringing use, how computed 1144
to be separated from all others 1148
of improvement to be separated from those of original . . . . 1148 *n.* 1
may be either gains or savings 1144
receipts and savings the minuend 1145
only actual regarded 1146
burden on plaintiff to show 1150
how far due to the patented invention 1145
how ascertained when infringer paid for using 1147
how ascertained where infringer sells product of use 1148
savings, how ascertained 1149
items of expense allowable 1147, 1148
interest on, when recoverable 1152
damages, right to, rule of, interest on 1154
additional to, not in lieu of, profits . . . . . 1154 *n.* 2
profits not capable of computation cannot be awarded as . . . . . 1143 *n.* 3
counsel fees not recoverable 1152
costs, rules governing allowance of 1080, 1162
items allowable 1163
master's fee, how and when payable 1163
bill of review, when proper, procedure on 1164
appeal to Supreme Court, effect of, procedure on 1116
(See ABANDONMENT TO THE PUBLIC, ACCOUNT, ACCOUNTING, ACQUIESCENCE, ACTION AT LAW, and titles appended thereto, ADMISSIONS, AFFIDAVIT, AMBIGUITY, APPEARANCE, APPLICATION, ASSIGNEE, ASSIGNMENT, ASSIGNOR, BILL, BURDEN OF PROOF, CHAMPERTY, CO-OWNERS, CORPORATION, COUNSEL FEES, COURTS, CROSS-BILLS, DAMAGES, DEATH, DECREE, DEFENDANT, DELAY, DEPOSITIONS, DISCOVERY, DOCKET FEES, EQUITABLE INTERESTS, EQUITY, EQUITY JURISDICTION, ESTOPPEL, EVIDENCE, EXCEPTIONS, EXECUTORS, EXPENSES OF SUIT, FEDERAL COURTS, GRANTEE, HEARING, HEIRS, IDENTITY, INFRINGEMENT, INFRINGER, INJUNCTION, INTEREST, INVENTION, INVENTOR, JOINDER, JUDICIAL NOTICE, JURISDICTION, JURY, LACHES, LICENSEE, LICENSOR, MANUFACTURER'S PROFITS, MARKET VALUE, NEW TRIALS, NONJOINDER, NOTICE, OBJECTIONS, PARTIES, PATENT, PATENT PRIVILEGE, PATENTABILITY, PATENTEE, PENDENCY OF SUIT, PENDENTE LITE, PLAINTIFF, PLEA, PROCESS CIVIL, PROFERT, PROFITS, PUBLIC USE, RECEIVER, REHEARING, RIGHTS OF ACTION, SALARIES, SALES, SAVINGS, SIGNATURES, STATE OF THE ART, STOCKHOLDERS, SUPPRESS MOTION TO, SUPREME COURT, TESTIMONY, TITLE, TRANSFER, TRUSTEE *de son tort.*)
ACTION AT LAW for infringement is an action on the case 931
in account or assumpsit for profits *quere* . . . . . 1091 *n.* 6, 1092 *n.* 4
no previous notice required . . . . . 931 *n.* 3
not instituted pending account in equity . . . . . 1156 *n.* 2
must be brought on the earliest of two identical patents to the same patentee 937 *n.* 1
not maintainable for damages after judgment in equity for the profits . 947 *n.* 6
jurisdiction over 934
in any district where defendant can be served with process . . . 933, 934
when circuit includes several districts 936
over joint-infringers 936
over domestic and foreign corporations 935, 936
under act of 1887 . . . . . 934 *n.* 3

Reference are to sections.

ACTION AT LAW — *continued.*
process in 949
service of 934
on domestic and foreign corporations 935
plaintiffs in, who may be 937–943
must be "party interested," who is . . . . . 937 *n.* 2
local law may determine 944
must have had the legal title to the patent when the infringement occurred, or be assignee of the right of action 937
must be patentee, assignee, or grantee 937
patentee when 939
though he has assigned or licensed since the infringement . . . 937 *n.* 2
assignor retaining no interest not . . . . . 938 *n.* 4
joined with assignee, if patent has expired . . . . . 943 *n.* 5
if still interested . . . . . 939 *n.* 2
assignors, assignees assignees in trust, co-owners 940
assignee of right of action for past infringement 943
grantees, grantors, co-grantees when 941
grantee of exclusive right to use . . . . . 941 *n.* 3
licensee not 938
licensor and legal owner must be 938
parties equitably interested not . . . . . 937 *n.* 2, 938
legal owner must be nominal, when suit brought to protect licensees and equitable owners 938
executor or administrator of deceased inventor 942
heirs or devisees of deceased owner not 942
receiver of corporation owner not . . . . . 940 *n.* 5
joint patentees when 939
must sue in his own name, not in that of an attorney or delegate . . . 944
married women, infants, corporations, associations sue how 944
nonjoinder or misjoinder of, objections for 945
waivor of 945
cure of 945
of licensees no ground of abatement . . 938 *n.* 1
when nominal, actual parties in interest control the suit 938
defendants, who must be 946
government officers, public and private corporations, and individuals of all classes may be 947
executor or administrator of deceased infringer . . . . . 947 *n.* 5, 948 *n.* 4
suable severally but only one compensation 948
nonjoinder and misjoinder of 948
declaration, contents and requisites of 949–955
on the case sufficient . . . . . 949 *n.* 1
may cover several patents when violated by same infringing act . . . 955
patents for original and improvement when . . . . . 955 *n.* 2
consolidation of causes, which may be covered by one, when . . . 955 *n.* 1
averments as broad as evidence needed . . . . . 949 *n.* 1
must tender an issue on every point essential to patentability . . . 949 *n.* 2
averment, of citizenship 949
inventive act 949
patent 950
when re-issued in divisions . . . . . 1031 *n.* 1
acquiescence in by public 952
description of invention in 949, 950
variance between and patent itself 966
of title of plaintiff and profert of conveyances 951
of infringement 952
several acts of 952
of damages 953

References are to sections.

ACTION AT LAW — *continued.*
averment of damages, verdict cannot exceed . . . . . 953 *n.* 2
claim for treble 953
disclosing license to plaintiff gives defendant the right to a judgment 951 *n.* 5
need not conclude "*contra formam statuti*" . . . . . 954 *n.* 2
formal requisites and defects of 954
cured by verdict 954
demurrer in 957
for want of patentability . . . . . 950 *n.* 2, 1000 *n.* 3
does not admit patentability . . . . . 950 *n.* 2
court may declare patent void on . . . . . 950 *n.* 2
dismissed by court *suo motu* if evident that no inventive act performed . . 959 *n.* 2
defences to, not limited to those named in the statutes . . . . . 958 *n.* 1
new arise, old disused . . . . . 958 *n.* 1
all may be urged unless defendant estopped 984
to each patent and Claim in dispute 985
enumeration and classification of 958
no inventive act 959
want of reduction before application not . . . . . 959 *n.* 1
no inventive act by patentee 960
surreptitious appropriation by patentee of another's invention . . . 960
patentee not the first inventor 961
invention not legally patentable 962
want of novelty, prior use, patent, or publication 963
utility 964
abandonment by public use or sale 965
distinct from prior use . . . . . 908 *n.* 1
not supported by proof of prior use . . . . . 965 *n.* 7
public use "before the invention" not . . . . . 965 *n.* 7
pending application not . . . . . 965 *n.* 7
no such patent 966
want of legal requisites to patent 967
signatures, correspondence with application, false oath or suggestion, invalidity of re-issue 967
notice to caveator 967
patent unintentionally issued not . . . . . 967 *n.* 3
fraud in issue of patent not 967
irregularity of re-issue when . . . . . 967 *n.* 5
joint patent for sole invention and *vice versa* 967
patented invention not patentable 968
fraudulent specification 969, 970
ambiguity of description though unintentional 970
raises no question of fraud 1035
excessive Claims 971
ambiguity of Claims 972
surrender of patent 973
repeal of patent 974
denial of plaintiff's title 975
equitable rights of third parties not . . . . . 975 *n.* 3
that third parties owned the territory of infringement under the original patent, not to suit on an extension . . . . . 975 *n.* 2
non-infringement, defendant's invention not covered by the patent . 976
acts of defendant not acts of infringement 977
patent not in force when acts performed 978
co-ownership of patent 979
license 970
statute of limitations 980
estoppel 981
release 982

References are to sections.

ACTION AT LAW — *continued.*
defences to, *res adjudicata* 983
liability in other forms of redress not 947
on renewed application the same as on a new one . . . . . 984 *n.* 1
pleadings in abatement, grounds for 950
bankruptcy or marriage of defendant not 948
want of corporate capacity . . . . . 975 *n.* 1
in bar 980–992
no rule to plead till after appearance . . . . . 950 *n.* 3
form and scope of in England 986
in the United States doubtful 986
how differ from equity pleadings . . . . . 999 *n.* 1
not governed by local law under 914 Rev. Stat. . . . . 992 *n.* 6
general issue, without notice covers what defences . . . . 988 *n.* 1, 999
its relation to special pleas . . . . . 992 *n.* 3
with or without notice covers all defences except statute of limitations 992
special, proper except for non-infringement 992
required for statute of limitations 992
plea of former recovery against defendant's vendor must aver payment . . . . . 1065 *n.* 3
notice, when required with general issue 986–998
under act of 1790 987
1793 988
1836 989
1870 and Rev. Stat. 990
rules of 991
special plea, when used as 992
not used with 992
form and service of 1000
that patentee not a true inventor 995
its requisites 1004
the first inventor 995
its requisites 1002
of prior use 997
its requisites 1004
to give names of users not witnesses 1004
by plaintiff not necessary 1004
prior patent or publication 996
its requisites 1003
state of art not required 1006
abandonment to the public 998
its requisites 1005
fraudulent specification 994
its requisites 1001
evidence in, governed by usual rules 1007
rules of, agree with those of State courts 1008
burden of proof on plaintiff, how satisfied 1018
judicial notice taken of what facts 1009
documentary, what admissible 1015
records of former judgments 1017
patent presumed valid 1016
weight of, increased by re-issue or extension 1016
patent shows that the grant was regular, the specification sufficient, and legal title in patentee 1016
of defendant presumed valid 1016
witnesses, competency of 1010
credibility of 1010, 1011
how determined 1011

References are to sections.

ACTION AT LAW — *continued.*
evidence in, witnesses, interested, who are 1010
expert, value and effect of 1012
classes of 1013
when admissible . . . . . 1013 *n.* 2, 1014
weight of 1014
excluded on ground of estoppel 1021
order of production in court 1072
under defence that invention did not result from an inventive act . . . 1022
patentee is not a true inventor 1023
the first inventor 1024
invention not legally patentable 1025
limited to the nature of the invention as described in the patent and construed by the court . . 1019
of prior use 1026
where patent covers several inventions 1026
not admissible without notice . . . . . 997 *n.* 6, 1004
under notice of public use 1005
after plaintiff's evidence in rebuttal . . 1026
without notice considered only as to state of the art 997 *n.* 6
discrepancies expected in 1011
prior patent 1027
patent not named in the notice not regarded by court though referred to in argument . . . . . 996 *n.* 2
may show date of patented articles . . . . 996 *n.* 2
may show when invention was in use . . 1006 *n.* 3
prior publication 1028
not admissible without notice . . . . . 996 *n.* 2
publication set up in special plea and struck out cannot be read . . . . . 996 *n.* 2
publication not named in notice not admitted to show knowledge of the author at a certain place . . 996 *n.* 2
non-utility 1029
abandonment to the public 1030
not admissible without notice . . . . . 998 *n.* 1
that no such patent exists 1031
variance exists between patents alleged and proved . 1031
the patent is illegal 1032
defendant must prove invalidity of re-issue by offering the original and showing the discrepancy 1032
the patent claims an unpatentable invention 1033
the specification is fraudulent 1034
the description is ambiguous 1035
the Claims are excessive 1036
ambiguous 1037
the patent has been surrendered 1038
repealed 1039
the plaintiff has no legal title 1040
the defendant's invention is not covered by the patent 1041
the defendant does not make, use, or sell 1042
patent not evidence of infringing acts 1016
infringing acts confined within period named in declaration . . . . . 1042 *n.* 1
the infringing acts not committed while patent in force 1043
of license or co-ownership 1044
Statute of Limitations 1045

References are to sections.

ACTION AT LAW — *continued.*
evidence in, under defence of estoppel 1046
release 1047
former judgment 1048
of damages 1049–1071
of state of art, admissibility and effect of 1020
purpose of 1006
admissible without notice 1006
what kinds admissible 1006
prior publication is not . . . . . 1006 *n.* 3
admitted without notice not considered for any other purpose . . . . . 1006 *n.* 2
damages 1049–1071
at law differ from recovery in equity how 1050
rule of, distinct from rules of evidence concerning 1051
rule of 1051
how proved 1051
burden of proof on plaintiff 1071
actual, rule of 1053
must be clearly proved 1053
recoverable only to date of writ . . . . . 1053 *n.* 3
rules of evidence concerning vary with the plaintiff's mode of enjoying his monopoly 1054
according as plaintiff grants licenses or preserves a close monopoly . . . 1055
where plaintiff preserves a close monopoly in himself or in specific licensees 1055, 1060–1064
license fee the measure of when plaintiff grants licenses to all who wish . 1055
rule of evidence concerning when plaintiff enjoys the monopoly by granting licenses 1050–1059
evidence that plaintiff enjoys the monopoly by granting licenses . . . 1057
as to establishment of license fee 1057
that defendant has impliedly accepted plaintiff's license . . . 1058
license fee the measure of only when defendant does the exact licensed act 1058, 1059
not the measure of when defendant's use differs in duration or extent from the licensed act 1058
when license fee is the measure of, defendant's profit and plaintiff's loss are immaterial 1059
interest, when allowed on license fees . . . . . 1059 *n* 1
rules of evidence concerning when plaintiff preserves a close monopoly 1060–1064
differ according as the plaintiff uses the invention and sells the product or makes and sells the invention . . 1060
where plaintiff uses invention and sells product, damages arise from reduction of prices or loss of sales 1061
rules of evidence of 1061, 1062
direct evidence of 1061
indirect evidence of 1062
defendant's profits as 1062
confined to exact invention 1062
how shown and computed 1062
inferential evidence of 1062
matters of aggravation 1062
where plaintiff makes and sells the invention, indirect evidence 1063
where defendant's infringing acts differ from plaintiff's mode of enjoyment, evidence of 1064
evidence of remote and contingent inadmissible 1061
nominal, rule of 1052
when awarded . . . . . 1068, 1071 *n.* 1

References are to sections.

ACTION AT LAW — *continued.*
damages, vindictive not allowed 1053
in suits by co-owners against each other 1070
executors enure to the estate 1070
distribution of among co-plaintiffs 1070
increase of by court 1053, 1060
interest on when allowed 1060
counsel fees and expenses of suit not allowed 1007
payment of, creates future license when 1005
trial, by court without jury, verdict 1077
questions for court or jury 1075
mistake as to is error 1075
continuance wherever party taken by surprise 1078
nonsuit not allowed, equivalent procedure 1073
charge to jury, requests, exceptions 1074
when *patent* void on its face must direct a verdict for defendant . . . . . 1009 *n.* 3, 1025 *n.* 1
verdict, requisites of, when set aside 1070, 1077
for defendant, ordered by court when . . . . 1009 *n.* 3, 1025 *n.* 1, 1073
order how enforced 1073
for excessive actual damages cured by *remittitur* 1068, 1078
actual damages, when only nominal proper, to be set aside, not curable by *remittitur* 1068
embracing counsel fees not set aside if court would then increase damages . . . . . 1007 *n.* 2
new trials, when ordered 1070, 1078
writ of error, grounds for, effect of 1079
costs, items allowable 1080
unreasonable delay in disclaiming, effect on 1080

(See also ACTION IN EQUITY and titles appended thereto, ADVERTISING, AGENCY, ASSUMPSIT, CHARGE, CLAIM, CONCEIVER, CONCEPTION, COPIES, DATE, DESCRIPTION, DILIGENCE, DISCLAIMER, DRAWINGS, ENGLISH PATENT, EQUIVALENTS, EXPERT EVIDENCE, FALSE SUGGESTION, FILE WRAPPER, FOREIGN PATENT, FOREIGN USE, FRAUD, FRAUDULENT CONCEALMENT, INVENTIVE ACT, INVENTIVE SKILL, JUDGMENTS, LETTERS-PATENT, LICENSES, LOST ART, MECHANICAL SKILL, NOVELTY, POSSESSION, PREREQUISITES, PRIOR PATENT, PRIOR PUBLICATION, PRIOR USE, PRIORITY, PUBLICATION, RECORD, RE-ISSUES, RELEASE, REMEDY, REPEAL, RES ADJUDICATA, SECRET USE, SKILLED IN ART, STAMPING, STATUTE OF LIMITATIONS, SUPERSEDEAS, TERM, UNREASONABLE DELAY, UTILITY, VERDICT, WITNESSES.)

ADEQUATE REMEDY AT LAW, exists when 1086–1094
(See also EQUITY JURISDICTION.)

ADMINISTRATION, letters of, presumed by Patent Office to be regular . . 404 *n.* 1
local not necessary to entitle administrator to patent . . . . . 404 *n.* 1

ADMINISTRATOR of deceased inventor (see EXECUTOR.)

ADMISSIONS, estoppel by 1021
of validity how manifested 1189
of defendant as evidence of validity 1174, 1189
(See ACTION IN EQUITY, ACTION AT LAW, ESTOPPEL, INJUNCTION.)

ADVERTISING infringing articles is evidence of sales 1042

AFFIDAVIT not entitled in cause till bill filed . . . . . 1128 *n.* 1

AGENCY, defence of must disclose principal 1042, 1117

AGENTS, infringement by 920
not by acts which would not be infringement in principal 920
infringing, when treated as principal 1204

References are to sections.

AGGREGATION not an invention 154
not a combination, difference between 154
in manufactures . . . . . 203 *n.* 1
(See COMBINATION.)
AGREEMENT, conceding priority to one not an inventor void 303
to sell results of inventive skill valid 414
(See CONTRACT.)
ALIEN may obtain patent 363
inventor formerly compelled to put his invention into market in the United States 632
ALTERNATIVE CLAIM, when improper 520
(See CLAIM.)
AMBIGUITY IN DESCRIPTION, when fatal 403
not unless fraudulent . . . 403 *n.* 2
contra . . 403
CLAIM avoids it, how caused 516
created by discrepancy between Description, drawings, and model 541, 546
(See ACTION AT LAW, CLAIM, DESCRIPTION, DRAWINGS, FALSE SUGGESTION, FRAUDULENT CONCEALMENT, MODEL, PATENT, RE-ISSUES.)
AMENDMENT, to application for patent (see APPLICATION FOR PATENT).
of letters-patent 633-715
by Patent Office 417
when allowed in England 16
under American Law 21, 22
to fully disclose the invention . . . . . 42 *n.* 10
abuses arising from 42
to bill or answer in equity 1123
(See ACTION IN EQUITY, CLERICAL ERRORS, DISCLAIMER, LETTERS-PATENT, PATENT, RE-ISSUES.)
AMERICAN AND ENGLISH LAW OF PATENTS, difference in . . . . 68 *n.* 2
ANALOGOUS AND NON-ANALOGOUS USES distinguished . . . . . 259 *n.* 1
ANIMALS, not invention to employ instinct of . . . . . 78 *n.* 2, 167 *n.* 2
may be the apparatus of an art 167
ANNUL INTERFERING PATENTS, actions to, jurisdiction of Federal courts over 860
ANSWER IN EQUITY, rules governing 1114-1120
admissions in, as evidence 1127
irresponsive, effect of as admission 1127
under oath requires two witnesses to overcome it 1127
(See ACTION IN EQUITY.)
APPARATUS OF AN ART, anything may be 167
improvement in is not a new process . . . . . 167 *n.* 1
joinder of with process (see JOINDER OF INVENTIONS).
(See ART.)
APPEAL in the Patent Office, in uncontested cases 566-572
not like writ of error but like appeal in equity or admiralty 572
to Commissioner, examiner must act twice before . . . . . 567 *n.* 1
character and effect of 572
questions open on, grounds of, dismissal of 572
presumption in favor of judgment appealed from . . . . . 572 *n.* 5
rejected applicant must appeal within reasonable time . . . . . 565 *n.* 3
from rejection of one Claim forfeits no right to others . . . . . 565 *n.* 3
relates to matter of form or matter of substance 566
matter of form and of substance defined 566
instances of matter of form and matter of substance 566
on matter of form lies to Commissioner 566
mode of procedure 567

References are to sections.

APPEAL — *continued.*
on matter of substance lies to examiners-in-chief 560
mode of procedure . . 568
powers of examiners . 568
mandamus not granted to compel Commissioner to allow when in his discretion . . . . . 568 *n.* 4
recommendation by examiners-in-chief as to matters not entering into the appeal 568
examples of such recommendations . . . . . 568 *n.* 3
leaves uncontested case in hands of primary examiner after appeal decided 568 *n.* 1
jurisdiction of examiner ceases during . . . . . 568 *n.* 1, 604 *n.* 2
second to examiners-in-chief allowed 568
from examiners in remanded cases 569
examiners-in-chief to Commissioner, procedure on 569
case when remanded to examiner with recommendations . . 569
Commissioner to Supreme Court of the District of Columbia, procedure 570
case when remanded to examiner 572
in interference proceedings 604
decision on, when re-opened 572
to Supreme Court in equity cases, effect of, procedure on 1161
when a *supersedeas* 1161
does not suspend payment of master's fees . . . . . 1161 *n.* 10
from grant or refusal of preliminary injunction not allowed 1172
collusive not recognized 1161
(See ACTION IN EQUITY, APPLICATION FOR PATENT, COMMISSIONER, INJUNCTION, INTERFERENCES, PATENT OFFICE, PRACTICE, PROCEDURE, REHEARING, SECRETARY.)

APPEARANCE, an invention (see DESIGN).
waives defects in process when 934

APPLICANT, title of, application evidence of . . . . . 450 *n.* 1
having power to amend or appeal must elect and abide by it . . . . . 568 *n.* 1
rejected may bring bill in equity to obtain patent 571
procedure on 571

APPLICATION FOR PATENT 420, 449–616
no patent without an . . . . . 452 *n.* 1
annual number of 52
kept secret when 553
as evidence . . . . . 1015, 1019 *n.* 4
of prior use 318, 1026
does not show reduction to practice 126
by whom made 449
proper applicant determined by Patent Office records 450
two concurrent by same inventor for same invention improper 467
not affected by later application for same invention by same inventor . . 563
must possess legal requisites 451
legal requisites of 452
of each part determined separately though all construed together . . . 548
grant of patent shows presence of 451
form of 449–458
written in English language 452
to contain petition, oath, specification, and sometimes drawings and model 452
changes of parties during proceedings 450
how signed by applicant 452
signed and sworn to in blank illegal . . . . . 452, 551 *n.* 2
the petition, its requisites 453
oath 454–458
necessity and requisites of 454

References are to sections.

APPLICATION FOR PATENT — *continued.*
the oath, omission of, does not invalidate patent 458
presumed from grant of patent 458
by and before whom made 454
averments of 455
its truth or falsehood 450
must be true as to each part of the specification 455
falsehood does not avoid patent when . . . . . 907 *n.* 4
avoids patent if material and wilful 456
how shown 1032
Patent Office cannot inquire into truth of, after grant of patent . . 456
renewed with each amendment which introduces new matter . . . 455
how far conclusive 457
subject-matter of 459–479
must be a patentable invention 459
not an invention already patented in the United States by the same inventor 460
may be an invention patented abroad by the same inventor or in the United States by a rival inventor 461
not to include inventions already patented in the United States by the same inventor 462
may be a new use of any patented invention 463
not an invention already covered by a defective patent to the same inventor. 464
may be a combination of inventions previously patented by the same inventor 465
may be part of an invention previously patented by the same inventor . 465
may be an invention described but not claimed in a former patent to the same inventor . . . . . 506, 656 *n.* 3, 690
may be an invention dependent on or collateral to a previously patented invention 466
not an invention already claimed in a pending application by the same inventor 467
may be an invention described but not claimed in a pending application by the same inventor . . . . . 467 *n.* 1
for matter described but not claimed in a former patent used instead of reissue . . . . . 656 *n.* 3
but must be filed when . . . . . 465 *n.* 3
the Description (see DESCRIPTION) 480–503
the Claim (see CLAIM) 504–539
covers all patentable matter shown in the specification, drawings, or model 541 *n.* 2
only the matter claimed 506
where two describe but only one claims the invention the patent issues on the latter . . . . . 564 *n.* 4
disclaimer in, must explain the Claim not contradict it . . . . . 513 *n.* 2
drawings (see DRAWINGS) 540–544
model (see MODEL) 545–548
when model and specimens ordered 557
true date of . . . . . 354 *n.* 1
date of filing, how shown . . . . . 1026 *n.* 15
on question of public use . . . . . 965 *n.* 7
continuous, takes date of original 580, 581
dependent on original 581
successive are when . . . . . 354 *n.* 1, 580
when amended by order of Patent Office . . . . . 561 *n.* 10
tests of continuity, examples . . . . . 580 *n.* 3–5
no presumption of priority between 590
filing and fees 550–554
filed when presented complete to Commissioner 551

References are to sections.

APPLICATION FOR PATENT — *continued.*
filing is the commencement of proceedings to obtain patent 550
filed at any time after invention complete unless it is abandoned 550
when delivered to Patent Office with the fee . . . . . 451 *n.* 4
not by filing model or writing application or putting the case in hands of solicitors 551
all parts must be within two years after filing petition 551
decision of Commissioner as to filing conclusive . . . . . 551 *n.* 2
delay in filing conclusive . . . . . 551 *n.* 3
not accepted by Patent Office till complete 452
acted on by Patent Office till all parts complete 548
parts separately filed must be accompanied with a letter connecting them with other parts 551
after filing known by title and number 552
specification not withdrawn 553
procedure on, governed by rules in force when commenced 573
in uncontested cases 555–585
examined in order of completion 555
how 53
as to sufficiency in form 555
examiner should require sufficiency in form . . . . . 555 *n.* 1
no decision on merits till all formal questions settled . . . . . 555 *n.* 4
objections to form, when and how made by examiner 555
notice of examiner to inventor as to defects in form 555
examiners must state objections definitely and the mode of avoiding them 555 *n.* 2
objections to form acted on by inventor, how 555
proceedings where the application shows that a different invention should have been applied for . . . . . 555 *n.* 3
objections for misjoinder, when made, procedure on 556
division, when ordered 479, 556
how made 556
cross-disclaimers in each 479
new oath to each 556
examination on merits not conclusive as to correctness of form . . . 555 *n.* 3
two questions involved: patentability of the invention; who is the inventor 558
examiner to decide patentability, from any data at his command 558
according to rules of courts and judgments of Commissioner . . . 558
not according to conclusions of former examiners 558
in view of matters of public knowledge . . . . . 558 *n.* 2
though he is in doubt 558
to reject application if invention evidently impracticable . . . . . 558 *n.* 2
rejection, notice of, to applicant 559
examiner must cite his references and give his reasons in the notice . . 559
grounds of, how stated in notice 559
what references may be cited 559
examiner not bound to suggest what Claims should be made 559
action of applicant after 560
how references of examiner may be overcome 560
on ground of public use, met by applicant, how . . . . . 560 *n.* 2
action of examiner after answer of applicant to 560
number of 53
not a judgment . . . . . 1017 *n.* 2
of Claims may be appealed from . . . . . 565 *n.* 3
same Claims not inserted in new application after . . . . . 565 *n.* 3
appeal from (see APPEAL).
amendment to, how and when made 561–563
subordinate to and dependent on the original 564
not allowed without sufficient reason . . . . . 561 *n.* 2

References are to sections.

APPLICATION FOR PATENT — *continued.*
amendment to must be accompanied with explanation showing how it avoids examiner's objections 565
may be partial or total 564
when improper, Claims not affected by must be examined on their merits 564 *n.* 3
in form made to any extent 561
in substance cannot embrace new matter 561
may include what subject-matter 561
agreement of, with original 561
to substance of Claim is new Claim . . . . . 561 *n.* 9
cannot enlarge the invention . . . . . 561 *n.* 4
substitute a different specific invention for the one claimed . 561 *n.* 6
by changing or inserting generic and specific Claims . . . . 561 *n.* 6, 11
cannot include Claims once withdrawn to avoid rejection . . . . 561 *n.* 6
numerous examples of . . . . . 561 *n.* 3–12
cannot prejudice intermediate inventors 561
requires new oath when 561
filed by executor . . . . . 561 *n.* 9
when new oath required, date of oath is date of application 561
not barred by new application covering matter of amendment . . 562 *n.* 1
when refused by examiner applicant may petition Commissioner for order to receive it, but examiner may then reject if new matter . . . 562 *n.* 1
when made . . . . . 561 *n.* 1
at what time made 562
while in interference 608, 609
not after final rejection when 565
presumed against from delay in filing 561
form of, how written 563
distinct applications not 564
each stands alone, not as amending the others 564
made by attorney without signature of applicant . . . . . 563 *n.* 1
not made by substituting new specification for the one sworn to by the applicant . . . . . 563 *n.* 1
erasing Claim should change the Description . . . . . 563 *n.* 1
examination of, rejection, notice 565
if propriety doubtful, how examiner proceeds . . . . . 561 *n.* 6
examiner's refusal to allow, appeal from 565
after rejection applicant must elect to amend or appeal or withdraw and is bound by his election . . . . . 560, 568, *n.* 1
appeal (see APPEAL).
withdrawal, and substitution of 580, 581
after, substitute may be filed 580
modes of . . . . . 580 *n.* 1
substitution, by whom made 581
unreasonably delayed shows abandonment to public, when 580 *n.* 2
abandonment of . . . . . 353 *n.* 2, 574–579
its effect . . . . . 574, 575 *n.* 2
no legal existence after 579
no revival after 580
not further noticed in Patent Office . . . . . 575 *n.* 2, 588
does not *ipso facto* abandon the invention to public 574
may result in abandonment to public 574
whether abandons to the public is question open to courts 578
may estop inventor from claiming the invention when . . . . . 574 *n.* 3
no bar to future application 574
revival by Congress . . . . . 574 *n.* 1
forfeits the right to benefit of date of application on questions of public use, etc. 574

References are to sections.

APPLICATION FOR PATENT — *continued.*
abandonment of by express acts or words 570
by cancellation of Claims . . . . . 570 *n.* 1
not by attorney . . . . . 570 *n.* 2
not by filing new application 570
not by delays and errors in Patent Office 578
in interference . . . . . 612 *n.* 4
by unreasonable delay in prosecuting . . . . . 354 *n.* 1, 574
delay unavoidable not unreasonable 578
burden of proof on applicant 575
decision of Commissioner that delay was reasonable is conclusive . 578
by two years' inaction after last action in Patent Office 575
"last action" defined 576
"suspension of action" not 576
"inaction" defined 577
"two years," how computed 577
by delay in suing in equity after rejection . . . . . 571 *n.* 2
effect of subsequent rival patents, publications, etc. . . . . 574 *n.* 2
allowance of, notice of 582
before, under examiner's control 582
after, patent not withdrawn from issue except by Commissioner . . . 582
not binding on Commissioner till patent issues 583
withheld by Commissioner after allowance, when mandamus lies 583
mandamus to Commissioner (see MANDAMUS).
pending till patent issues and is delivered 582
is recorded . . . . . 612 *n.* 4
final fees, payment of 585
failure to pay is forfeiture when 584
renewal of forfeited 584
rights of applicant after forfeiture 584
forfeiture and renewal not at option of applicant . . . . . 584 *n.* 2
disposition of, after forfeiture 584
after forfeiture no longer under jurisdiction of Patent Office 588
date of, on renewal after forfeiture 584
bill in equity by defeated applicant (see EQUITY) 571
procedure on 571
is part of the application . . . . . 577 *n.* 2
how related, as identical or otherwise 589
when conflicting 589
interferences deal with, not with applicants . . . . . 587 *n.* 1
interferences (see INTERFERENCES) 586-616
(See ABANDONMENT TO THE PUBLIC, ASSIGNEE, ASSIGNMENT, ATTORNEYS, CAVEAT, CAVILATOR, CLAIM, COMMISSIONER, CONCEIVER, CONCEPTION, DATE, DELAY, DESCRIPTION, DISCLAIMER, DRAWINGS, EVIDENCE, EXAMINERS, EXAMINATION, EXECUTORS, FEES, FORFEITURE, FORM, INFANT, INTERFERENCES, JOINDER, JOINT-INVENTION, JUDGMENTS, JURISDICTION, LACHES, LETTERS-PATENT, MANDAMUS, MARRIED WOMAN, MODEL, NEW MATTER, NEW TRIALS, NOVELTY, OATH, PATENT, PATENT OFFICE, PATENTEE, POWER OF ATTORNEY, PRACTICE, PREREQUISITES, RECORD, REFERENCES, REHEARING, RESERVATION, RIVAL INVENTORS, SECRETARY, SIGNATURES, SPECIFICATION, SUBSTANCE AND FORM, TERM, TITLE, UNREASONABLE DELAY.)

APPLICATION, new, of old force to old object is an art . . . . . 164 *n.* 3
"APPLICATION OF PRINCIPLE" a phrase of two meanings 142
in one sense is the idea of means itself 142
in another sense is reduction to practice 142
uses of the phrase explained 143
in what sense protected by the patent 143
(See PRINCIPLE.)

References are to sections.

ARBITRATION AND AWARD, presumed correct . . . . . 1184 *n.* 2
contract for is binding . . . . . 1250 *n.* 3
ARRANGEMENT, diversities of may be matter of form or of substance . . . 242
when change of affects identity . . . . . 242 *n.* 1
difference in does not show absence of infringement 804
(See DIVERSITIES.)
ART defined, synonymes of 150
essential attributes of 169
the most comprehensive of inventions 104, 284
distinguished from "principle" and from "force" 101
relation of to instrument and to function 284
must produce physical effects 100
three classes of, their essential distinctions 104
may be a "force applied," a "mode of application," or a "specific treatment of a specific object" 105
may consist in the application of a new force . . . . . 104 *n.* 1
force to a new object . . . . . 104 *n.* 2
new application of a force to an object . . . . . 104 *n.* 3
new use of old devices . . . . . 104 *n.* 8
removal of defects from an old art . . . . . 107 *n.* 3
doing by machinery what was done by hand in the same way not . . . 104 *n.* 3
mere employment of substances for the first time in an old art not . . . 172 *n.* 1
new use of old art not unless inventive skill exercised . . . . . 172 *n.* 1
distinguished from machine 174
its apparatus 167
does not vary with its apparatus 167
must exist independently of its apparatus . . . . . 150 *n.* 2
may be new though the apparatus is old 167
patentable though its product and apparatus are old . . . . . 103 *n.* 1
may employ any available apparatus 167
apparatus of may be natural or artificial 167
patent for not limited to the apparatus . . . . . 736 *n.* 3
operation of apparatus may be an . . . . . 172 *n.* 2
relation of to the function of its apparatus . . . . . 172 *n.* 2
cannot be the mere function of a specific instrument . . . . . 159 *n.* 2
protected by the patent for the specific instrument when it is its mere function, and is not separately patentable 172
the separate independent functions of two instruments not . . . . . 159 *n.* 2
not fully invented till its apparatus is constructed . . . . . 171 *n.* 1
rather than apparatus to be claimed if possible 172
distinct from product . . . . . 107 *n.* 1
identity of shown by identity of product . . . . . 925 *n.* 1, 927 *n.* 2
may be simple or a combination 168
simple, analysis of 285
essentials of 169
identity of, how determined 284–286
may be a combination of old arts . . . . . 168 *n.* 1, 287 *n.* 1
combination, essentials of 169
identity of how determined 287, 288
when new, essential variations in . . . . . 170 *n.* 1
unity of, unity how destroyed 170
not patentable unless reduced to practice 171
reducible to practice in many forms 172
to be patentable must be useful . . . . . 163 *n.* 1
patentability, once denied in English law 160, 161, 162
when recognized in English law . . . . . 160 *n.* 1
always recognized in American law 163
Description of 497
Drawings of for Patent Office, requisites of 543

ART — *continued.*
Claim for, requisites of 529
must be claimed as an art not as apparatus or product 511
patent for, covers all modes of practising it . . . . . 172 *n.* 1
Infringement of, what acts are 925
materials used in when "similar" . . . . . 170 *n.* 1
(See also ANIMALS, APPARATUS, CHEMICAL PROCESS, CLAIM, COMBINATION, DESCRIPTION, DOUBLE USE, EARTH, FORCE, IDENTITY, IMPROVEMENT, INFRINGEMENT, JOINDER, PROCESS, PRODUCT, SUB-PROCESS, USE, UTILITY.)
"ARTICLE OF MANUFACTURE" not a technical phrase 531
ARTICLES patented to be stamped (see STAMPING) 628–631
"AS HEREIN DESCRIBED" meaning of in patent 750
"AS SPECIFIED" meaning of in Claim . . . . . 517 *n.* 3
ASSIGN, agreement to becomes an assignment when price paid . . . . . 411 *n.* 2
ASSIGNABILITY OF PATENT governed by Patent Law 408
ASSIGNEE means assignee in any degree . . . . . 408 *n.* 1
and Grantee not synonymous . . . . . 760 *n.* 2
of inventor, rights of 408–414
rest on Patent Law . . . . . 408 *n.* 3
has all rights and powers of his assignor 767
cannot license others after his own forfeiture 788
has same rights as assignor against rival inventor 789
bound to same diligence as inventor . . . . . 575 *n.* 1
patent, grantable to 308
issue of to 619
last on record takes legal title to whomsoever patent issues . . . . . 411 *n.* 3
of two joint inventors owns the sole patent afterward issued to one of them 450 *n.* 2
of right to patent takes subject to prior equities 411
subsequent legal title of a *bona fide* purchaser 411
when bound by prior acts of assignor 789
judgments, disclaimers, etc., against assignor 789
of junior patent *pendente lite* bound by the judgment . . . . . 1170 *n.* 2
bound by interference judgment against assignor 789
laches of his assignor 1194
not bound by admissions and acts of assignor unknown to him 789
concession of priority . . . . . 789 *n.* 3
prior unrecorded equitable claim if he bought for value without notice . . . . . 789 *n.* 4
statement in the conveyance that the assignor owns the patent if the assignment has been rescinded . . . . . 787 *n.* 7
subsequent acts of assignor 789
of future patent not affected by subsequent licenses of assignor . . . . 411 *n.* 4
title of not affected by oversights in the Patent Office . . . . . 411 *n.* 3
of right of action takes subject to all equities . . . . . 790 *n.* 1
bound by laches of assignor . . . . . 1114 *n.* 3
when plaintiff in action at law for infringement 937, 940
must sue at law in his own name . . . . . 940 *n.* 1
of right of action when plaintiff at law 943
when plaintiff in equity 1098, 1099
of patent as collateral security, when plaintiff in equity . . . . . 1098 *n.* 6
must sue in equity in his own name 1101
entitled to injunction like patentee . . . . . 762 *n.* 2
of extension may enjoin licensees under original . . . . . 1098 *n.* 6
can recover entire profits though he pays the assignor a fixed royalty . 1152 *n.* 1
contract rights of against assignor 1227
remedy of when assignor refuses to convey the patent 1228

References are to sections.

ASSIGNEE — *continued.*
protected by injunction when specific performance impossible 1228
accepting patent other than that agreed to be assigned cannot claim the other 700 *n.* 2
remedy of when title assigned fails or proves defective 1220
in case of defective title must elect between rescission and enforcement 1220 *n.* 1
remedy of when patent proves invalid 1230
assignor procured the transfer by deceit 1231
for breach of warranty 1232
cannot take the benefit and refuse to pay the price . . . . . 1230 *n.* 8
action to recover back purchase money and defence to an action for it stand on different grounds . . . . . 1230 *n.* 1
in defence to action for purchase money may show defective title 1238
patent invalid 1239
fraud in the sale 1240
breach of warranty . . . 1241
statutory defences . . . 1242
no such patent . . 1239 *n.* 1
defending on ground of defective title has the burden of proof 1238
defending actions for infringement or purchase money may deny validity if he has repudiated the assignment 787
estopped from denying validity, while he receives the benefit 787
if he has covenanted not to 1230
cannot defend action for purchase money on the ground that a later patent has been granted to another for the same invention . . . . . 1239 *n.* 14
cannot defend action for purchase money on the ground that patent invalid if the assignor was himself an assignee . . . . . 1239 *n.* 1
may defend action for purchase money on the ground that the invention infringes prior patent when 1239
may defend action for purchase money on the ground of invalidity though he has assigned to others . . . . . 1230 *n.* 5
if his own assignee refuses to pay 1239
must pay *pro tanto* if patent divisible and partly void . . . . . 1239 *n.* 11
defending action for purchase money on the ground that patent invalid or for deceit, must offer to return it and account 1239, 1240
defending action for purchase money on ground of breach of warranty, must pay for what benefit he has received 1241
may defend action for purchase money on the ground of breach of covenants when 1241
on the ground that the contract violates State law 1242
on a note for purchase money on the ground that it does not give the notice required by statute 1242
(See also ACTION IN EQUITY, ACTION AT LAW, APPLICATION FOR PATENT, ASSIGNMENT, ASSIGNOR, ATTORNEYS, CLOUD ON TITLE, CO-GRANTEES, CONSIDERATION, CONTRACT, CO-OWNERS, DISCLAIMER, EMPLOYEE, EQUITABLE ESTOPPEL, EXTENSION, FORFEITURE, FRAUD, INFRINGEMENT, INJUNCTION, JUDGMENTS, LACHES, MONEY PAID, NOTES, PARTNERS, PURCHASE MONEY, RESCISSION, SPECIFIC PERFORMANCE, STATES OF THE UNION, TITLE, TRANSFER.)

ASSIGNMENT of letters-patent 420, 762–794
defined 762
of patented invention is a sale of personal property . . . . . 762 *n.* 2
patent rests on statutes . . . . . 761 *n.* 3
governed by statute and must comply with it . . . . . 768 *n.* 1
distinguished from grant 763, 791, 792
license . . . . . 763, 1224 *n.* 1
whether any transfer is, depends on its substance, not form . . 764, 768
conveys both the invention and the monopoly 762, 763
operates on the three rights, to make, use, and sell 763

References are to sections.

ASSIGNMENT — *continued.*
of patent may cover the trademark of patented articles . . . . . 780 *n.* 1
transfers only the monopoly created by American patents 778
may operate as a contract to assign foreign patents 778
throughout the entire United States 763
impossible after grant of sectional interest unless all sectional owners join 705
substitutes the assignee for the patentee or makes them co-owners . 762
must transfer the entire interest or an undivided part of it . . . 700 *n.* 1
of undivided interest makes assignor and assignee joint owners . 758 *n.* 2
transfers only such rights as assignor possesses 773
all re-issues at option of assignee 701, 778
motive for immaterial 768
made to deceive Patent Office is inoperative . . . . . 768 *n.* 7
by whom made 705
infants and married women governed by local law 705
made by guardian . . . . . 705 *n.* 7
executors 408
one co-executor gives good title unless others show a better 705 *n.* 6
In the interest of creditors 766, 803–805
by whom made when owner insolvent 766, 804, 805
to whom made 767
infants and married women lawful . . . . . 408, 767 *n.* 1
corporation valid 767
form of, general requisites 768
no particular necessary 410, 768
must be written and signed by assignors 768
parol, would be sufficient did not statutes require writing . . . 768 *n.* 2
no consideration for an agreement . . . . . 768 *n.* 2
evidence not admitted to vary terms of except in case of mutual mistake . . . . . 768, 773 *n.* 3
how executed by assignor through attorney . . . . . 768 *n.* 2
cannot be signed by attorney in his own name . . . . . 768 *n.* 2
by corporation, how executed . . . . . 768 *n.* 2
seal unnecessary 768
must contain operative words purporting to convey both invention and monopoly 768
transfer of all right under patent is, whatever its form . . . . . 775 *n.* 1
exclusive right to make and use and sell is . . . . 758 *n.* 3, 763
and sell is . . . . . 763 *n.* 4, 775 *n.* 1
all assignor's estate carries his patents . . . . . 410 *n.* 2
all property not exempt by law is not . . . 766 *n.* 3, 804 *n.* 1
certificate of assignor that another owns the patent is not . . . . 768 *n.* 1
irrevocable power of attorney may be 768
contract to sell in the future not 768
valid if the invention is so described in the assigned patent that those skilled in the art could make it . . . . . 768 *n.* 1
description of patent in, must be intelligible but need not set out specification . . . . . 768 *n.* 1
may be on consideration of royalties to be paid 764
cover several inventions 780
separate for each invention desirable 780
of several inventions to the same assignee does not consolidate the inventions 777
effect of, how determined 773
may purport to convey either the entire invention or only the assignor's interest 774
of exclusive right to make and sell in the United States for the whole term carries the entire invention . . . . . 775 *n.* 1

References are to sections.

ASSIGNMENT — *continued.*
transfers only the patented invention described in the assignment . . . 777
of a patent for the elements of a combination does not transfer the combination patent 777
circumstantial variance in its description of the patent does not show fraud or prevent title from passing . . . . . 768 *n.* 1
vendee in must use ordinary care to see what the assigned invention is 768 *n.* 1
transfer of all patents which the assignor has in his own right does not cover those held in trust 780
relation of legal and equitable titles arising from 786
in trust creates legal title . . . . . 780 *n.* 7
confers authority coupled with an interest . . . . . 768 *n.* 5
forged, may be ratified *in pais* . . . . . 768 *n.* 2
subject to all prior lawful conveyances 773
outstanding license no bar to 765
effect of, on existing licenses and powers of attorney 782
of an invention "now in use" puts assignee on inquiry as to rights of user . . . . . 776 *n.* 3
transfer of "all my right" puts assignee on inquiry as to rights of assignor 776
construction of 773
scope of, a question for Federal courts . . . . . 857 *n.* 1
by different instruments, conveying legal and equitable titles, construed together 773
construed to effectuate intent of parties 773
as the parties have construed it . . . . . 773 *n.* 4
on valuable consideration implies warranty of title and right to convey 774, 783
no parol warranty provable in connection with . . . . . 783 *n.* 4
transfer of "all rights" in the patented invention warrants a perfect title 775
carries any subsequently acquired title of the assignor needed to make the assignment valid . . . . . 783.
transfer of "all my right" purports only to cover the interest of the assignor and raises no implied warranty of title 776
transfer of "all my right" does not bind the assignor by any representation his assignee may make 776
raises no implied warranty that the patent is valid . . . . 783 *n.* 4, 1232
may be conditional and subject to forfeiture 764, 773
upon condition, reversionary interest of assignor 788
binds subsequent parties with notice . . . . . 788 *n.* 2
forfeiture of, a question for the courts not the Patent Office . . . 788 *n.* 1
assignee estopped to deny validity of patent when 787
by the assignee of an exclusive right estops him from preparing to flood the market when the patent expires . . . . . 793 *n.* 3
pendente lite does not affect the suit 781
effect of, notice of . . . . . 790 *n.* 2, 943, 1103
may reserve its avails but not the right to an injunction 1103
record of, notice given by 784
within time prescribed makes it good against all intervening transfers 786
without, assignee has no legal title which he can safely convey . . 1238
necessary to enable assignee to sue . . . . . 784 *n.* 4
without, not good against creditors . . . . . 784 *n.* 5
valid *inter partes* 784
to assignee for value against subsequent transfers without value . . . . . 784 *n.* 5
admissible in evidence 1040
to party having knowledge of a prior unrecorded assignment over three months old gives him the legal title and the prior assignee the equitable 786

References are to sections.

ASSIGNMENT — *continued.*
to *bona fide* purchaser, pending the record of a prior assignment which is completed in due time, leaves both legal and equitable title in prior assignee 780
transferring "all my right" is subject to prior conveyances though not recorded 776
transferring residuary right valid though prior assignment not recorded 768 *n.* 1
record good *inter partes* whenever made . . . . . 784 *n.* 5
date of . . . . . 1040 *n.* 3
how proved 1040
as evidence 1015
contract rights arising from, protected by law 849, 850
same nature as under a grant 1226
rescinded in interest of assignee when 1229
if patent invalid 1230
procured by fraud 1231
procured by deceit, remedy of assignee 1231
express warranties in, actions on 1232
transferring wrong patent, assignee not bound by unless he accepts . . 1230
consideration for fails if patent found to be invalid 1229, 1230
effect of . . . . . 1224 *n.* 1
no consideration for promises of assignee if patent invalid, unless he know the invalidity when promises made 1230, 1239
and license stand on different ground as to consideration, purchase money, etc. . . . . 1224, 1251 *n.* 8
not rescinded by assignor for failure to pay purchase money . . 1237 *n.* 1
of right to future patent 408–414
can operate only on an existing complete invention 771
favored in law 772
valid . . . . . 368 *n.* 1, 409 *n.* 1, 769
not the assignment of a lawsuit 772
inoperative if application finally rejected 772
after rejection valid, and assignee may re-apply 772
valid *inter partes* though no patent issues . . . . . 409 *n.* 2
various rules concerning . . . . . 769 *n.* 1–6
form and effect of 769
is a contract to assign patent when granted 411
various instances and forms of . . . . . 410 *n.* 2
enforceable against assignor in equity 411, 769, 1228
by parol, effect of . . . . . 410, 411 *n.* 3
by employee to employer 414
binds executors of deceased assignor 413
with all future improvements is valid and passes an equitable right to the improvements when made . . . . . 771 *n.* 4
transfers a right in all patents obtained for the invention whatever changes in it may be made . . . . . 769 *n.* 2
does not affect an independent invention 777
vests the patent in the assignee when it issues 769
without request that patent issue to assignee, gives him only an equitable title 411, 769
gives him no right to patent in his own name 411
is not recordable and if recorded gives no notice . . 410, 769 *n.* 3, 785
if patent issue to assignor gives him the legal title and assignee the equitable 786
cannot avail against subsequent transfer of legal title to *bona fide* assignee 769
recorded after patent issues gives assignee legal title where there are no intervening rights . . . . . 411 *n.* 2, 769

References are to sections.

ASSIGNMENT — *continued.*
without request, followed by assignment to innocent party with request, when patent issues gives the latter the legal and equitable titles 786
with request that patent issue to assignee, vests both legal and equitable title in him 769
gives him a right to a patent in his own name 411, 769
followed by patent to assignor vests legal title in assignee on recording his assignment . . . . . 786 *n.* 1
filed after final fee paid, recognized by the Patent Office . . . . . 450 *n.* 2
of future inventions, mere contract not true assignment 771
valid . . . . . 409 *n.* 1
at any stage of the inventive act 409
of extension, form and effect of 770, 770, 844
covered by assignment of future patent when 412, 770
carried by what words 770
instances of . . . . . 412 *n.* 3
not covered by transfer of patent unless expressly stated 770
takes effect when extension granted . . . . . 770 *n.* 2
of right of action for past infringements allowable 943
not affected by assignment of patent 781, 790, 943
transfers no interest in the monopoly . . . . . 790 *n.* 1
transfer of expired patent may operate as 781, 790
form of 790, 943
not recordable 785, 790
subject to all equities between original parties 943
of profits and damages after accounting 1103
(See ASSIGNEE and titles appended thereto, BANKRUPTCY, COURT, CORPORATION, CREDITOR'S BILL, COURTS, EMPLOYER, EQUITY, INFANT, INSOLVENT, JUDICIAL SALE, MARRIED WOMAN, PENDENTE LITE, PROBATE COURT, RECEIVER, RECORD, RE-ISSUES, RIGHTS OF ACTION, STATE COURTS, STATUTE OF FRAUDS, TRUSTEE, WARRANTY.)
ASSIGNOR can protect his reversionary or conditional interest 788
when plaintiff in equity 1098, 1099
must sue in his own name when 1101
estoppel of 1021
to deny validity of assigned patent . . . . . 787, 984, 1021 *n.* 2
though patent actually void . . . . . 787 *n.* 1
though assignee might have known the patent void . . . . . 787 *n.* 1
cannot buy in an older patent and set it up against his assignee 787
procuring the valid patent after assigning the invalid for value, the valid enures to the benefit of the assignee 787
joint-patentee assigning and then obtaining sole patent holds it for benefit of assignee . . . . . 787 *n.* 3
becoming part owner of a prior patent, his assignee becomes licensee of his co-owners . . . . . 787 *n.* 2
when member of a firm once owning the patent . . . . . 787 *n.* 1
cannot deny his own title to convey . . . . . 787 *n.* 1
not aided by equity to obtain a superior patent . . . . . 411 *n.* 3
none against an assignee in bankruptcy . . . . . 787 *n.* 1
binds his transferees . . . . . 787 *n.* 1
infringement by 914
contract relations of with assignee, governed by usual law of contracts . . 1224
breach of, may be also an infringement 1225
rights of assignee against 1227–1232
to recover back purchase-money when 1229–1231
obliged to refund if he creates a legal title destructive to the prior equitable one of the assignee . . . . . 1229 *n.* 3
rights of against assignee 1233
remedy of, when assignee refuses to accept the transfer 1234

References are to sections.

ASSIGNOR — *continued.*
remedy of, for breach of conditions in the assignment 1235
when assignee procured the assignment by fraud 1236
to recover purchase money 1237–1242
(See ASSIGNEE, and ASSIGNMENT and titles thereto appended.)
ASSOCIATION must sue in equity in the names of its members 1101
ASSUMPSIT for infringement the tort being waived . . . . 983 *n.* 1, 1001, 1002
ATTORNEYS PATENT 431–437
who may be 431
relation of to Patent Office 431
power of Commissioner over 431
appointed by special power of attorney 432
power of attorney, form of 432
revocation of 433
how affected by assignment of principal 433, 782
ratification of by assignee 433
authority of 425
confined to the application to which the power of attorney is attached . 434
how far principal bound by 435
not to delay to prejudice of principal 578
disclaim without consent of principal . . . . . 680 *n.* 6
cancel all Claims and abandon the application . . . . . 579 *n.* 2
acts of bind foreign principal ignorant of our language . . . . . 689 *n.* 6
rights and duties 435
letters-patent to be delivered to 585
compensation of, lien for 436
how disbarred 437
associate, subordinate, delegate 432
(See APPLICATION FOR PATENT, DISCLAIMER, POWER OF ATTORNEY.)

BANKRUPTCY COURT, no power over letters-patent 804
proceedings in do not affect letters-patent 766
that plaintiff in the, no ground of abatement 956
(See ASSIGNMENT, INSOLVENT, JUDICIAL SALES.)
BIDDER lowest, sole bidder is . . . . . 1255 *n.* 3
in contract work not rejected because he has no license to use necessary inventions . . . . . 1255 *n.* 3
BILL *in perpetuam* when allowed, procedure on 1166
with its testimony is evidence 1127
of discovery, when proper, procedure on 1167
of review, when proper, procedure on 1164
of revivor, when proper, procedure on 1165
if infringer dies pending suit 1153
(See also ACTION IN EQUITY, DISCOVERY, EXECUTOR.)
BOND AND ACCOUNT when ordered in lieu of an injunction 1202
amount of bond 1202
(See also INJUNCTIONS.)
BOOK may be a manufacture . . . . . 183 *n.* 1
BOOKS of plaintiff when produced on an accounting . . . . . 1157 *n.* 3
of defendant, inspection of as to profits 1143
when evidence for plaintiff 1127
(See also ACTION IN EQUITY.)
BURDEN OF PROOF in patent cases at law, how satisfied 1018
as to inventive skill, how satisfied 1022
on later patentee . . . . . 370 *n.* 1
as to prior use 1026
patent 1027

References are to sections.

BURDEN OF PROOF — *continued.*
as to prior patent, not changed by existence of prior foreign patent 1032
publication 1028
utility 1029
abandonment to the public 1030
on defendant to show that patentee not a true inventor 1023
the first inventor 1024
invention not legally patentable 1033
specification is fraudulent 1034
description is ambiguous 1035
Claims are excessive 1036
fraudulent . . . . . 644 *n.* 1
patent has been surrendered or repealed . . 1038, 1039
infringing acts not voluntary 1042
term of patent is limited by foreign patent . . . 1043
estoppel of plaintiff 1040
failure to stamp 1046
release 1047
on plaintiff to show that disclaimer filed in reasonable time 1036
infringement 1041
defendant not co-owner or licensee 1044
amount of damages 1071
profits in equity 1150
in actions in equity 1127
on assignee or grantee to prove title 1040
(See ACTION IN EQUITY, ACTION AT LAW, EVIDENCE, PATENT.)

CANADIAN PATENT, takes effect when . . . . . 623 *n.* 2
CAPACITY diversities of, may be matter of form or of substance 240
do not show absence of infringement 894
CASES PATENT, in citing, the facts must be considered . . . . . 1177 *n.* 4
CASES, DOCTRINE OF, CRITICISED:
Andrews *v.* Hovey (1888), 124 U. S. 694. Consent of inventor to public use 357 *n.* 2
(1887), 123 U. S. 267. Consent of inventor to public use . . . . 357 *n.* 2
(1883), 5 McCrary, 181. Consent of inventor to public use . . . . 357 *n.* 2
Attorney General *v.* Rumford Chemical Works (1876), 9 O. G. 1062. Repeal in interest of public . . . . . 725 *n.* 1
Bean *v.* Smallwood (1843), 2 Story, 408. Double use . . . . . 260 *n.* 1
Boulton *v.* Bull (1795), 2 H. Bl. 463. Patentability of Process . . . . 160 *n.* 1
Bray *v.* Hartshorn (1860), 1 Clifford, 538. Double use . . . . . 260 *n.* 1
Clark Pomace Holder Co. *v.* Ferguson (1883), 21 Blatch. 376. Aggregation and combination . . . . . 155 *n.* 1
Coupe *v.* Wetherhead (1883), 23 O. G. 1927. Machine not automatic . . 175 *n.* 1
Detmold *v.* Reeves (1851), 1 Fisher, 127. Patentability of a principle . . 134 *n.* 3
Detroit Lubricator Co. *v.* Lunkenheimer (1886), 30 Fed. Rep. 190. Public use 357 *n.* 2
Dunbar *v.* Albert Field Tack Co. (1879), 4 Bann. & A. 518. Double use . 260 *n.* 1
Earle *v.* Sawyer (1825), 4 Mason, 1. Inventive skill . . . . . 78 *n.* 3
Egbert *v.* Lippman (1878), 15 Blatch. 295. Consent of inventor to public use 357 *n.* 2
Gorham Mfg. Co. *v.* White (1871), 14 Wall. 511. Test of design . . . . 203 *n.* 1
(1870), 7 Blatch. 513. Nature of a design . . . . . 201 *n.* 1
Jones *v.* Sewall (1873), 3 Clifford, 563. Abandonment and public use differ 349 *n.* 1
Le Roy *v.* Tatham (1852), 14 How. 156. Patentability of principle . . . 134 *n.* 3
Long *Ex parte* (1883), 25 O. G. 1189. Matter described and not claimed not the subject-matter of new patent . . . . . 465 *n.* 3
Losh *v.* Hague (1837), 1 Web. 202. Double use . . . . . 260 *n.* 1, 271 *n.* 1
Manning *v.* Cape Ann Isinglass & Glue Co. (1883), 108 U. S. 462. Consent of inventor to public use . . . . . 357 *n.* 2

References are to sections.

CASES, DOCTRINE OF, CRITICISED — *continued.*
McKay *v.* Wooster (1873), 3 O. G. 441. Sale by grantee delivers articles sold from the monopoly . . . . . 824 *n.* 5
Matthews *v.* Flower (1885), 25 Fed. Rep. 830. Matter described and not claimed abandoned . . . . . 465 *n.* 3
Miller *v.* Brass Co. (1881), 104 U. S. 350. Scope of re-issues . . . . . 656 *n.* 2
Delay in re-issue . . . . . 690 *n.* 1
New claims not forbidden . . . . . 693 *n.* 2
New Process Fermentation Co. *v.* Maus (1884), 20 Fed. Rep. 725. Process 163 *n.* 1
Roberts *v.* Harnden (1865), 2 Clifford, 500. Combination equivalents . . 282 *n.* 1
Sands *v.* Wardwell (1869), 3 Clifford, 277. Combination equivalents . . 282 *n.* 1
United States *v.* American Bell Telephone Co. (1887), 41 O. G. 123. No repeal in interest of public . . . . . 725 *n.* 1
Wollensak *v.* Reiher (1885), 115 U. S. 96. Conclusions from Miller *v.* Brass Co. 690 *n.* 2

CASES, DOCTRINE OF, DISCUSSED:
Campbell *v.* James (1882), 104 U. S. 356. Patentability of matter described but not claimed in a former patent . . . . . 465 *n.* 3
Conover *v.* Roach (1857), 4 Fisher, 12. Double use . . . . . 260 *n.* 1
Gill *v.* Wells (1874), 22 Wall. 1. Re-issue of combination-patent to cover sub-combinations . . . . . 670 *n.* 2
Household Co. *v.* Neilson (1843), 1 Web. 673. Patentability of principle . 143 *n.* 2
Kay *v.* Marshall (1835), 2 Web. 36. Double use . . . . . 266 *n.* 1
Littlefield *v.* Perry (1874), 21 Wall. 205. Transfer of undivided sectional interest . . . . . 702 *n.* 1
Parker & Whipple Co. *v.* Yale Clock Co. (1887), 123 U. S. 87. Language of Seymour *v.* Osborne *de* re-issues . . . . . 663 *n.* 1
Pennock *v.* Dialogue (1829), 2 Peters, 1. Consent of inventor to public use 357 *n.* 1
Roberts, *Ex parte* (1887), 40 O. G. 573. Reservation of matter described and not claimed . . . . . 465 *n.* 3
Root *v.* Lake Shore & M. S. R. R. Co. (1882), 105 U. S. 189. Sphere of equity jurisdiction . . . . . 1084 *n.* 3
Simonds, *Ex parte* (1888), 44 O. G. 445. Joinder of art and apparatus . 473 *n.* 3
Seymour *v.* Osborne (1870), 11 Wall. 516. Re-issues . . . . . 663 *n.* 1
Tilghman *v.* Proctor (1881), 102 U. S. 707. Neilson's patent . . . . . 163 *n.* 1
Language of O'Reilly *v.* Morse . . . . . 163 *n.* 1
United States *v.* Butterworth (1884), 27 O. G. 717. Joinder of art and apparatus . . . . . 473 *n.* 1

CASES, EXTRACTS FROM:
Ackerman *v.* Archer (1879), 15 O. G. 562. Reduction to practice by prior inventor . . . . . 391 *n.* 1
Adams *v.* Burke (1873), 17 Wall. 453. Vendee of patented article may use it till used up . . . . . 826 *n.* 1
Lawful sale of patented article takes it out of the monopoly . . . . 824 *n.* 2
Adams *v.* Edwards (1848), 1 Fisher, 1. Identity of substance . . . . 236 *n.* 1
Adams *v.* Howard (1884), 19 Fed. Rep. 317. Equity jurisdiction when patent expires pending suit . . . . . 1093 *n.* 2
Adamson's patent, *In re* (1856), 6 De G. M. & G. 419. Experimental use not public use . . . . . 355 *n.* 3
Agawam Co. *v.* Jordan (1868), 7 Wall. 583. Right of prior inventor to the patent 370 *n.* 1
Right of principal inventor to inseparable ancillary inventions of employees 394 *n.* 1
Allen *v.* City of New York (1879), 17 O. G. 1281. City liable for infringement by its Board of Education . . . . . 911 *n.* 2
Allen *v.* Hunter (1855), 6 McLean, 305. Nature of Patent Privilege . . 11 *n.* 1
Allen *v.* Mayor of New York (1880), 7 Fed. Rep. 483. Waiver of objections to irregularities in practice and procedure . . . . . 1129 *n.* 3
Allis *v.* Buckstaff (1882), 13 Fed. Rep. 879. Requisites of notice of prior use . . . . . 1004 *n.* 5

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Evidence improperly taken received after pleadings amended . . 1128 *n.* 8
Allis *v.* Stowell (1883), 16 Fed. Rep. 783. Implied license to vendee from recovery of royalties from wrongful vendor . . . . . 830 *n.* 1
American Bell Telephone Co *v.* Dolbear (1883), 15 Fed. Rep. 448. Principle, as a force, not patentable . . . . . 134 *n.* 1
Principle reduced to practice is patentable . . . . . 130 *n.* 1, 141 *n.* 1
Patent covers all modes of reducing to practice . . . . . 130 *n.* 1, 141 *n.* 1
American Cotton Tie Supply Co. *v.* McCready (1879), 17 O. G. 565. Infringement by common carriers . . . . . 918 *n.* 1
American Cotton Tie Supply Co. *v.* Simmons (1878), 3 Bann. & A. 320. Implied license of purchaser in open market to use anywhere . . . . . 824 *n.* 9
American Diamond Rock Boring Co. *v.* Rutland Marble Co. (1880), 2 Fed. Rep. 356. Injunction after patent expires against use of infringing articles made under it . . . . . 1211 *n.* 3
v. Sheldon (1880), 1 Fed. Rep. 870. Infringement after patent expires 908 *n.* 1
American H. & L. S. & D. Mach. Co. *v.* American T. & M. Co. (1870), Holmes 503. Abandonment after application . . . . . 353 *n.* 1
Mechanical perfection not necessary to reduction . . . . . 120 *n.* 1
Meanings of "Abandonment" . . . . . 346 *n.* 1
Natural right of inventors to prevent others from using their inventions 28 *n.* 1
American Middlings Purifier Co. *v.* Christian (1877), 4 Dillon, 448. Effect of judgment of Supreme Court on subsequent cases . . . . . 1180 *n.* 1
Effect of judgment of Circuit Courts on subsequent cases . . . . 1181 *n.* 3
American Nicholson Pavement Co. *v.* Elizabeth (1873), 3 O. G. 522. Procedure on caveat . . . . . 444 *n.* 1
(1874) 6 O. G. 764. Increase of damages by the court . . . . . 1069 *n.* 5
(1870) 4 Fisher, 189. Purpose of preliminary injunction . . . . 1171 *n.* 1
American Pin Co. *v.* Oakville Co. (1854), 3 Blatch. 190. No infringement unless same means used . . . . . 893 *n.* 1
American Whip Co. *v.* Lombard (1878), 4 Clifford. 495. Meaning of "Equivalent" . . . . . 248 *n.* 1
Ames *v.* Howard (1833), 1 Sumner, 482. Description liberally construed 493 *n.* 4
Ambiguity in Description . . . . . 493 *n.* 4
Nature of patent privilege . . . . . 20 *n.* 1
Policy of protecting inventors . . . . . 33 *n.* 1
Andrews *v.* Carman (1876), 9 O. G. 1011. Monopoly of practical inventor 28 *n.* 2
Patentability of a principle as an idea of means . . . . . 140 *n.* 1
Necessity of reduction to practice . . . . . 125 *n.* 1
Prior use unrecognized by user . . . . . 319 *n.* 2
Andrews *v.* Creegan (1881), 7 Fed. Rep. 477. Profits presumed from infringement . . . . . 1155 *n.* 1
Andrews *v.* Hovey (1883), 5 McCrary, 181. Inventor's comprehension of the scientific principle of his invention . . . . . 82 *n.* 1
Form of Description . . . . . 495 *n.* 6
Anilin *v.* Cochrane (1879), 16 Blatch. 155. Inventive act may be instantaneous . . . . . 83 *n.* 1
Anthony *v.* Carroll (1875), 2 Bann. & A. 195. State statutes of limitation do not apply to patent cases . . . . . 980 *n.* 1
Arkell *In re* (1879), 15 Blatch. 437. Analogous use . . . . . 259 *n.* 1
Arkwright *v.* Nightingale (1785), 1 Web. 60. Right of inventor to letters-patent . . . . . 14 *n.* 5
Ashcroft *v.* Walworth (1872), 2 O. G. 546. Power of courts to compel owner of patent to convey it in the interest of creditors . . . . . 805 *n.* 1
Asmus *v.* Alden (1886), 27 Fed. Rep. 684. Inventive skill indicated by removal of serious defects . . . . . 113 *n.* 2
Atlantic Works *v.* Brady (1883), 107 U. S. 192. Nature of mechanical skill . . . . . 78 *n.* 2
Atlantic Giant Powder Co. *v.* California Vigorit Powder Co. (1880), 6 Sawyer, 508. Re-issue improper when original not invalid and inoperative . . 660 *n.* 3

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Effect of failure to claim clearly described matter . . . . . 600 *n.* 2
Effect of decisions of Commissioner . . . . . 714 *n.* 3
Conclusiveness of decisions of Commissioner on re-issues . . 714 *n.* 4, 7
v. Dittmar Powder Co. (1881), 20 O. G. 1380. Injunction violated whatever the intent . . . . . 1214 *n.* 4
v. Goodyear (1877), 13 O. G. 45. Equivalent may perform additional functions . . . . . 251 *n.* 1
v. Safety Nitro Powder Co. (1884), 10 Sawyer, 23. Re-issue allowed when original valid for one purpose, not for another . . . . . 660 *n.* 5
Decision of Commissioner as to fraud in re-issue final . . . 715 *n.* 1
Atwood *v.* Portland Co. (1880), 10 Fed. Rep. 283. Account ordered in equity though no injunction needed . . . . . 1091 *n.* 1
Aultman *v.* Holley (1873), 11 Blatch. 317. Eulogistic Description improper 487 *n.* 1
Variations in form between original and re-issue . . . . . 668 *n.* 2
Bainbridge *v.* Wigley (1810), 1 Carp. 270. Strict construction of letters-patent . . . . . 16 *n.* 3
Baker Mfg. Co. *v.* Washburn & Moen Mfg. Co. (1883), 5 McCrary, 504. Licensor enjoined from declaring license revoked . . . . . 1244 *n.* 2
Bancroft *Ex parte* (1881), 20 O. G. 1893. Joinder of inventions . . . 469 *n.* 1
Joinder of product with machine . . . . . 474 *n.* 4
Banks *v.* Snediker (1880), 17 O. G. 508. Relations of conflicting inventions . . . . . 589 *n.* 3
Barnes *v.* Clinton (1876), 9 O. G. 1158. Measure of reasonable diligence in reducing to practice . . . . . 387 *n.* 4
"Abandoned experiment" . . . . . 387 *n.* 4
v. Straus (1872), 2 O. G. 62. Combination patent infringed by making an element to be united to the rest by other persons . . . . . 924 *n.* 1
Barrett *v.* Hall (1818), 1 Mason, 447. Identity of machines and its test 178 *n.* 1
Joint invention by community of mental effort . . . . . 398 *n.* 1
"Principle of machine" defined . . . . . 135 *n.* 1
"Principle" defined . . . . . 173 *n.* 1
Combination-patent not infringed by use of part . . . . . 923 *n.* 4
Bartholomew *v.* Sawyer (1859), 4 Blatch. 347. Date of prior publication or prior use . . . . . 328 *n.* 1
Bean *v.* Smallwood (1843), 2 Story, 408. Double use . . . . . 260 *n.* 1
Bedford *v.* Hunt (1817), 1 Mason, 302. Distinction between original and first inventor . . . . . 58 *n.* 1
Bell *v.* Daniels (1858), 1 Bond, 212. Nature and effect of caveat . . . 439 *n.* 1
Birdsall *v.* Coolidge (1876), 93 U. S. 64. Distinction between remedies at law and in equity . . . . . 1050 *n.* 1
Measure of actual damages . . . . . 1053 *n.* 2
License fee not a measure of damages where duration of use differs . . . . . 1058 *n.* 3
v. McDonald (1874), 6 O. G. 682. Conclusiveness of decision of Commissioner on re-issues . . . . . 714 *n.* 1
Birdsell *v.* Shaliol (1884), 112 U. S. 485. Licensee must sue in name of legal owner, not his own . . . . . 938 *n.* 1
Patented article sold by licensee no longer within the monopoly . . 824 *n.* 6
Bischoff *v.* Wethered (1869), 9 Wall. 812. Jury to decide whether one patent anticipates another under direction of court and on evidence of experts . . . . . 1014 *n.* 4
Black *v.* Thorne (1884), 111 U. S. 122. Profits are what defendant made in excess of what he could have made by using another invention . . . 1062 *n.* 5
Blake *v.* Greenwood Cemetery (1883), 16 Fed. Rep. 676. No implied license to vendee from payment of nominal damages by vendor . . . . 830 *n.* 3
v. Rawson (1873), Holmes, 200. Equivalence resides in use not in nature . . . . . 249 *n.* 1
v. Stafford (1868), 6 Blatch. 195. Instantaneousness of inventive act . 83 *n.* 1
Combination of old elements . . . . . 155 *n.* 4

References are to sections.

CASES, EXTRACTS FROM—*continued.*

Blake *v.* Stafford (1868), 6 Blatch. 195. Re-issue may enlarge Claims . 650 *n.* 3
Conclusiveness of decision of Commissioner on re-issues . . . 714 *n.* 9
Blanchard *v.* Eldredge (1849), 1 Wall. Jr. 337. Divisibility and transfer of patent privilege . . . . . 61 *n.* 2
v. Puttman (1867), 3 Fisher, 186. Effect of defendant's patent . . 1198 *n.* 2
v. Sprague (1839), 3 Sumner, 535. Nature of patent privilege . . . 20 *n.* 1
Patent privilege as a means of securing the disclosure of inventions 38 *n.* 1
Patent privilege granted only to inventors . . . . . 40 *n.* 1
v. Whitney (1855), 3 Blatch. 307. Vendee of patented article can use it till used up . . . . . 820 *n.* 1
Blandy *v.* Griffith (1860), 3 Fisher, 609. Property in the patent privilege . 61 *n.* 3
Patents to be sustained by the courts if possible . . . . . 735 *n.* 2
Inventive and mechanical skill . . . . . 131 *n.* 1
Right of inventor to employ mechanics to reduce to practice . . . 131 *n.* 1
Suggestions of mechanics employed to reduce to practice . . . . 131 *n.* 1
Bliss *v.* City of Brooklyn (1873), 10 Blatch. 521. Improvement in combinations . . . . . 217 *n.* 2
Bloomer *v.* Stolley (1850), 5 McLean, 162. Nature of patent privilege . . 11 *n.* 1
5 McLean, 158. Creation of patent privilege by special acts of Congress . . . . . 40 *n.* 2
v. McQuewan (1852), 14 How. 530. Rights embraced in the patent privilege . . . . . 61 *n.* 1
Congress cannot restrict rights of vendee of patented articles by subsequent legislation . . . . . 828 *n.* 3
Blythe, *Ex parte* (1884), 30 O. G. 1321. Classes of patentable inventions 168 *n.* 1
Distinction between art and apparatus . . . . . 167 *n.* 1
Booth *v.* Lyman (1880), 17 O. G. 303. Priority of publication as *prima facie* proof of priority of invention . . . . . 42 *n.* 6
Boulton *v.* Bull (1795), 2 H. Bl. 463. "Principle" defined . . . . 135 *n.* 1
"Principle reduced to practice" defined . . . . . 140 *n.* 2
Patentability of principle as an idea of means . . . . . 139 *n.* 2
Patentability of an art . . . . . 160 *n.* 1; 161 *n.* 1
Double use . . . . . 271 *n.* 1
"Manufacture" and its meaning in Stat. Jac. 1 . . . . . 69 *n.* 1
Boyd *v.* Brown (1843), 3 McLean, 295. License to use machine authorizes the sale of its product anywhere . . . . . 813 *n.* 2
v. Cherry (1883), 4 McCrary, 70. Effect of delay of prior inventor in applying for a patent . . . . . 390 *n.* 1
v. McAlpin (1844), 3 McLean, 427. Machine patent not infringed by sale of its product . . . . . 926 *n.* 5
Boyden *v.* Burke (1852), 14 How. 575. Copies of Patent Office records 627 *n.* 3
Bradford *v.* Corbin (1874), 6 O. G. 223. Measure of reasonable diligence in reducing to practice . . . . . 387 *n.* 1
Brady *v.* Atlantic Works (1876), 4 Clifford, 408. Eminent domain over patented inventions . . . . . 910 *n.* 4
Bray *v.* Hartshorn (1860), 1 Clifford, 538. Double use . . . . . 260 *n.* 1
Brickill *v.* Mayor of New York (1880), 7 Fed. Rep. 479. City liable for infringement by its fire department . . . . . 911 *n.* 2
Broadnax *v.* Central Stock-Yard & Transit Co. (1880), 4 Fed. Rep. 214. Variations between original and re-issue . . . . . 668 *n.* 4
Brooks *v.* Bicknell (1843), 3 McLean, 250. Identity of machines and its tests . . . . . 179 *n.* 1
(1845), 4 McLean, 64. Assignment of original does not carry extension . . . . . 779 *n.* 9
(1844), 3 McLean, 432. Burden of proof on plaintiff to show infringement . . . . . 1041 *n.* 2
Brooks *v.* Jenkins (1844), 3 McLean, 437. Nature of patent privilege . . 11 *n.* 1
3 McLean, 432. Benefits conferred by inventor . . . . . 20 *n.* 3

References are to sections.

CASES, EXTRACTS FROM — *continued.*

Brooks *v.* Jenkins (1844), 3 McLean, 432. Principle of machine defined 173 *n.* 1
"Substance" and "substantial" in inventions defined . . . 229 *n.* 1
Power of executor to obtain extension . . . . . 406 *n.* 1
Description of machine . . . . . 408 *n.* 2
v. Norcross (1851), 2 Fisher, 661. Trial by jury in equity . . . 1125 *n.* 4
Brosnahan, *In re* (1883), 4 McCrary, 1. Invention originates in the inventive act, the monopoly in the grant of the patent . . . . . 763 *n.* 1
Brown *v.* Duchesne (1850), 19 How. 183. Territorial limits of patent privilege 46 *n.* 3
Statutory basis of patent privilege . . . . . 61 *n.* 3
Use on foreign vessels in American ports not infringement . . 909 *n.* 4
v. Hinkley (1873), 3 O. G. 384. Validity, on motion for injunction, provable by judgments or acquiescence . . . . . 1174 *n.* 1
v. Selby (1871), 4 Fisher, 363. Re-issue confined to matter attempted to be described and claimed in original . . . . . 663 *n.* 1
Burgess *v.* Wetmore (1879), 16 O. G. 765. Reduction to practice by prior inventor . . . . . 391 *n.* 1
Burns *v.* Meyer (1879), 100 U. S. 671. Effect of Claim as allowed by the Patent Office . . . . . 538 *n.* 3
Burr *v.* Cowperthwaite (1858), 4 Blatch. 163. Patent not infringed unless same means used . . . . . 803 *n.* 1
v. Duryee (1863), 1 Wall. 531. "Machine" defined . . . . . 173 *n.* 1
"Mode of operation" of machine not patentable . . . . . 174 *n.* 1
Bush *v.* Fox (1852), Macrory, 152. Double use . . . . . 271 *n.* 1
Butterworth *v.* Hoe (1884), 112 U. S. 50. Identity a difficult question . 314 *n.* 1
Cahill *v.* Brown (1878), 15 O. G. 697. Prior publication must communicate the invention to the public . . . . . 330 *n.* 1
Cahoon *v.* Ring (1861), 1 Clifford, 592. Diversity in size and proportions 239 *n.* 1
Calkins *v.* Bertraud (1875), 2 Bann. & A. 215. Re-issue may enlarge Claims 656 *n.* 3
Campbell *v.* Barclay (1870), 5 Bissell, 179. Evidence of established license-fee . . . . . 1057 *n.* 4
Relation of defendant's profits to plaintiff's damages at law . . 1062 *n.* 1
v. James (1882), 104 U. S. 356. Abandonment by describing and not claiming . . . . . 352 *n.* 1
(1880), 18 Blatch. 92. Operative words required in an assignment 768 *n.* 3
Jurisdiction of Federal courts over cases involving title to patent 857 *n.* 1
Transfers *pendente lite* do not affect the litigation . . . 943 *n.* 6
Campion *v.* Benyon (1821), 6 Moore, 71. Strict construction of letters-patent . . . . . 16 *n.* 3
Carlton *v.* Bokee (1873), 17 Wall. 463. Claims not to be unnecessarily multiplied . . . . . 521 *n.* 2
Carpenter *v.* Smith (1841), 1 Web. 530. Secret use not prior use . . . 320 *n.* 1
Carr *v.* Rice (1856), 1 Fisher, 198. Judicial construction of patent . . . 42 *n.* 8
Carter *v.* Baker (1871), 1 Sawyer, 512. "Equivalent" defined . . . 248 *n.* 1
Cartwright *v.* Arnott (1800), 11 East, 101. Contract theory of patent privilege . . . . . 15 *n.* 1
Carver *v.* Braintree Mfg. Co. (1843), 2 Story, 432. Patent construed as an entire instrument . . . . . 742 *n.* 1
Carver *v.* Hyde (1842), 16 Peters, 513. Means not end the subject of patent 377 *n.* 1
C. A. Yale Cigar Mfg. Co. *v.* Yale (1884) 30 O. G. 1183. Patent to be construed like other contracts . . . . . 735 *n.* 4
Chase *v.* Chase (1873), 4 O. G. 4. Joint invention by community of mental effort . . . . . 398 *n.* 1
Christman *v.* Rumsey (1879), 17 Blatch. 148. Re-issue of combination-patent may cover sub-combinations . . . . . 671 *n.* 1
Clark Patent S. & F. R. Co. *v.* Copeland (1862), 2 Fisher, 221. Degree of inventive skill required . . . . . 59 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*

Clark Patent S. & F. R. Co. *v.* Copeland (1862), 2 Fisher, 221. Simultaneous inventors . . . . . 29 *n.* 1
Clark Pomace Holder Co. *v.* Ferguson (1883), 21 Blatch. 370. Co-operation of elements in a combination . . . . . 155 *n.* 1
Clothworkers of Ipswich (1614) Godbolt, 254. Illegal Monopolies . . . 9 *n.* 5
Coburn *v.* Clark (1883), 15 Fed. Rep. 804. Preliminary injunction not granted on indefinite judgments . . . . . 1177 *n.* 4
Cochrane *v.* Anilin (1884), 111 U. S. 293. Substance produced by new means not a new substance . . . . . 187 *n.* 1
v. Deener (1876), 94 U. S. 780. "Art," "Process," defined . . . 159 *n.* 1
Coffin *v.* Ogden (1873), 18 Wall. 120. Experiments not prior use . . . 318 *n.* 3
Cohn *v.* National Rubber Co. (1878), 3 Bann. & A. 508. Licensee's right to his privileges . . . . . 819 *n.* 1
Licensee repudiating his license is liable as an infringer and cannot set up the license in defence . . . . . 819 *n.* 5
Colgate *v.* Compagnie Française (1885), 23 Fed. Rep. 82. Corporation cannot answer under oath . . . . . 1119 *n.* 2
Collar Co. *v.* Van Deusen (1874), 23 Wall. 530. Right of principal inventor to inseparable ancillary inventions of employees . . . . . 394 *n.* 1
Identity of original and re-issue shown by comparing specifications . 681 *n.* 1
Conclusiveness of decision of Commissioner on re-issues . . . . . 714 *n.* 1
Combined Patents Can Co. *v.* Lloyd (1882), 21 O. G. 713. Re-issue may enlarge Claims . . . . . 656 *n.* 3
Commissioner *v.* Whitely (1866), 4 Wall. 522. Effect on inventor of errors and delays in the Patent Office . . . . . 461 *n.* 4
Conklin, *Ex parte* (1874), 1 MacArthur, 375. Re-issue allowable only where error arose from inadvertence, accident, or mistake . . . . . 685 *n.* 1
Conover *v.* Roach (1857), 4 Fisher, 12. Nature of inventive act . . . 78 *n.* 1
"Equivalent" defined . . . . . 246 *n.* 1
Double use . . . . . 260 *n.* 1
Expert witnesses . . . . . 1012 *n.* 4
Consolidated Fruit Jar Co. *v.* Bellaire Stamping Co. (1886), 27 Fed. Rep. 377. Effect of abandonment to the public . . . . . 346 *n.* 1
Converse *v* Cannon (1873), 9 O. G. 105. Relation of improver to original inventor . . . . . 30 *n.* 1
Cook *v.* Ernest (1872), 2 O. G. 89. Utility is actual, not comparative . . 342 *n.* 1
Coon *v.* Wilson (1885), 113 U. S. 268. Re-issue not allowed unless defect arose from inadvertence, accident, or mistake . . . . . 685 *n.* 1
Corn Planter Patent (1874), 23 Wall. 181. Claim for combination must distinguish old and new . . . . . 525 *n.* 2
New and old how distinguished in the Claim . . . . . 513 *n.* 1
Corning *v.* Burden (1853), 15 How. 252. Invention is means, not end . . 90 *n.* 1
Function not patentable . . . . . 146 *n.* 1
Effect or result not patentable . . . . . 147 *n.* 1
"Art," "process," defined . . . . . 159 *n.* 1
Patent liberally construed . . . . . 736 *n.* 1
Effect of defendant's patent . . . . . 1198 *n.* 2
Cornish *v.* Keene (1835), 1 Web. 501. Prior use . . . . . 22 *n.* 2
Secret use not prior use . . . . . 320 *n.* 3
Prior patent . . . . . 331 *n.* 1
Cottier *v.* Stimson (1884), 10 Sawyer, 212. Circulation of prior publication 327 *n.* 1
Coupe *v.* Wetherhead (1883), 23 O. G. 1927. Automatism of a machine . 175 *n.* 1
Cowing *v.* Rumsey (1870), 4 Fisher, 275. Remedies at law and in equity distinguished . . . . . 1050 *n.* 1
Cox *v.* Griggs (1861), 2 Fisher, 174. Priority of publication . . . . . 42 *n.* 7
Measure of reasonable diligence in reducing to practice . . . . . 387 *n.* 1
Crandall *v.* Parker Carriage Goods Co. (1884), 20 Fed. Rep. 851. Duty of courts to sustain re-issue when honest and correct in its Claims . . . 684 *n.* 6

CASES, EXTRACTS FROM — *continued.*
Crandall *v.* Watters (1881), 20 Blatch. 07. Analogous use . . . . . 259 *n.* 1
Crane *v.* Price (1842), 1 Web. 393. Patentability of an art . . . . . 100 *n.* 1
Nature of patent privilege . . . . . 11 *n.* 3
Instantaneous inventive act . . . . . 83 *n.* 1
v. Whitehead (1875), 7 O. G. 219. Reduction to practice by prior inventor. 391 *n.* 1
Creamer *v.* Bowers (1888), 35 Fed. Rep. 200. Interest on damages . . 1066 *n.* 2
Crompton *v.* Belknap Mills (1869), 3 Fisher, 536. Effect of omitting application oath . . . . . 458 *n.* 1
Combination equivalents . . . . . 254 *n.* 1
v. Knowles (1881), 7 Fed. Rep. 199. Inventor presumed to be familiar with the state of the art . . . . . 112 *n.* 1
Equivalent known at date of patent . . . . . 256 *n.* 1
Crossley *v.* Beverly (1830), 1 Web. 112. Nature of patent privilege . . 11 *n.* 3
v. Potter (1853), Macrory, 240. Patentability of an art . . . . . 100 *n.* 1
Curtis *v.* Platt (1863), L. R. 3 Ch. 134. Means and end . . . 87 *n.* 1; 90 *n.* 1
Many distinct patentable means to same end . . . . . 117 *n.* 1
Equivalents in improvements . . . . . 257 *n.* 1
Darcy *v.* Allin (1602), Noy, 173. Illegal Monopolies . . . . . 9 *n.* 5
Patents to importers . . . . . 68 *n.* 1
Davis *v.* Palmer (1827), 2 Brock. 298. Diversity in shape . . . . . 238 *n.* 2
Day *v.* Hartshorn (1855), 3 Fisher, 32. Effect of verdict and judgment on subsequent cases . . . . . 1182 *n.* 5
v. Stellman (1850), 1 Fisher, 487. Parol evidence to aid court in construing patent . . . . . 732 *n.* 3
Dawson *v.* Follen (1808), 2 Wash. 311. Inventor must have been "the original" as against all the world . . . . . 58 *n.* 4
Dederick *v.* Cassell (1881), 20 O. G. 1233. Inventive skill in combinations 155 *n.* 4
DeFlorez *v.* Raynolds (1878), 14 Blatch. 505. Sale to patentee or his agent not infringement, though evidence of it . . . . . 905 *n.* 3
Densmore *v.* Scofield (1880), 102 U. S. 375. Property in patent privilege 61 *n.* 3
v. Schofield (1868), 4 Fisher, 148. Joinder of inventions in the courts 470 *n.* 1
Derby, *Ex parte* (1884), 26 O. G. 1208. Abandonment by describing and not claiming . . . . . 352 *n.* 1
Detmold *v.* Reeves (1851), 1 Fisher, 127. Reduction to practice necessary 125 *n.* 2
Property in scientific and philosophical truths common to all . . . 137 *n.* 1
Construction cannot change or extend language of patent . . . . 737 *n.* 3
Principle not patentable . . . . . 134 *n.* 3
Detroit Lubricator Co. *v.* Lunkenheimer (1886), 30 Fed. Rep. 190. Consent of inventor to public use . . . . . 357 *n.* 2
Dieckerhoff, *Ex parte* (1877), 12 O. G. 429. Identity of original and re-issue proved in the Patent Office by extrinsic evidence if there are no drawings or model . . . . . 683 *n.* 1
Dobson *v.* Hartford Carpet Co. (1885), 114 U. S. 439. Computation of profits on a design . . . . . 1143 *n.* 4
Dollond's Case (1766), 2 H. Bl. 470. Secret use not prior use . . . . 320 *n.* 3
1 Web. 43. Secret use no bar to patent . . . . . 17 *n.* 2
Dorsey Revolving Harvester Rake Co. *v.* Bradley Mfg. Co. (1874), 12 Blatch. 202. License to use may be restricted . . . . . 812 *n.* 3
License transferable or not, as parties choose . . . . . 823 *n.* 1
License to make and sell with restrictions carries right to use with restrictions . . . . . 813 *n.* 1
Patentee may restrict use of articles by his grantee's vendees to certain territory . . . . . 824 *n.* 8
Doubleday *v.* Sherman (1870), 4 Fisher, 253. Penalty for contempt . 1219 *n.* 3
Doyle *v.* Spaulding (1884), 19 Fed. Rep. 744. Foreign use not prior use . 320 *n.* 4
Draper *v.* Hudson (1873), 3 O. G. 354. Account incident to discovery or injunction, and not ordered without them . . . . . 1091 *n.* 2

Reference are to sections.

CASES, EXTRACTS FROM — *continued.*
Draper *v.* Potomska Mills (1878), 13 O. G. 276. Reduction to practice necessary . . . . . 125 *n.* 1
Drawings not sufficient reduction . . . . . 126 *n.* 2
Dryfoos *v.* Friedman (1884), 18 Fed. Rep. 824. Identity of designs . . 306 *n.* 1
Duke *v.* Graham (1884), 19 Fed. Rep. 647. Jurisdiction of Federal courts over cases involving the title to a patent . . . . . 857 *n.* 1
Dunbar *v.* White (1881), 4 Woods, 116. Re-issue of patent for composition may cover ingredients . . . . . 677 *n.* 1
Dunham *v.* Indianapolis & St. Louis R. R. Co (1870), 7 Bissell, 223. Relation and accountability of co-owners . . . . . 796 *n.* 1
Eames *v.* Cooke (1860), 2 Fisher, 146. Identity of machine and its uses . 178 *n.* 1
Earle *v.* Sawyer (1825), 4 Mason, 1. Nature of inventive skill required . 78 *n.* 3
requisites to patentability . . . . . 72 *n.* 1
Earth Closet Co. *v.* Fenner (1871), 5 Fisher, 15. Court at liberty to grant or refuse preliminary injunction . . . . . 1172 *n.* 2
Edgebury *v.* Stephens (1691), 1 Web. 35. Importer and inventor 42 *n.* 2, 57 *n.* 1, 68 *n.* 1
Edison, *Ex parte* (1875), 7 O. G. 423. Record title binding on Patent Office 450 *n.* 1
Egbert *v.* Lippman (1881), 104 U. S. 333. Public use is a use without restrictions, whether in public or not . . . . . 356 *n.* 1
Electric R. R. Signal Co. *v.* Hall Railway Signal Co. (1885), 114 U. S. 87. Invention is a means, not an end . . . . . 90 *n.* 1
Elizabeth *v.* Pavement Co. (1878), 97 U. S. 126. Abandonment may result at any time from acts of inventor . . . . . 351 *n.* 1
Experimental use, though in public and producing profit, not public use 355 *n.* 3
Profits may accrue from infringements, though whole business unprofitable 1149 *n.* 3
Ely *v.* Monson & Brimfield Mfg. Co. (1860), 4 Fisher, 64. Expert evidence may aid court in construing patent . . . . . 1014 *n.* 4
Emerson *v.* Hogg (1845), 2 Blatch. 1. Joinder of improvements . . . 478 *n.* 1
Court to construe patent, and jury to apply it . . . . . 732 *n.* 1
v. Howe (1881), 8 Fed. Rep. 327. Essential attributes of manufacture 188 *n.* 1
Eppinger *v.* Richey (1877), 14 Blatch. 307. Utility as indicative of inventive skill . . . . . 344 *n.* 1
Evans *v.* Eaton (1818), 3 Wheat. 454. Special acts granting patents . . 47 *n.* 1
(1818), 3 Wash. 443. Identity of machines, and its tests . . . . 178 *n.* 1
Relation of improvement to original . . . . . 213 *n.* 1
Description of improvement . . . . . 502 *n.* 2
(1816), Peters C. C. 322. Combination-patent not infringed by use of part . . . . . 923 *n.* 4
v. Hettick (1818), 3 Wash. 408. Description of improvement . . . 502 *n.* 2
v. Weiss (1809), 2 Wash. 342. Infringement by use of things made before patent . . . . . 907 *n.* 1
Ewart, *Ex parte* (1880), 17 O. G. 448. Joinder of generic and specific Claims 536 *n.* 5
Farmer *v.* Brush (1880), 17 O. G. 150. Conception completed . . . . 380 *n.* 1
Diligence in reduction connects it with prior conception as one inventive act . . . . . 380 *n.* 1
Effect of delay of prior inventor in applying for patent . . . . . 390 *n.* 1
Feather *v.* Queen (1865), 6 B. & S. 257. Patent privilege a conditional grant, not a contract . . . . . 15 *n.* 2
Fischer *v.* Hayes (1881), 20 O. G. 601. Commitment for contempt . 1219 *n.* 7
Flower *v.* City of Detroit (1888), 127 U. S. 563. Re-issue confined to matters attempted to be described and claimed in the original . . . . . 663 *n.* 1
v. Raynor (1881), 5 Fed. Rep. 793. Conclusiveness of decision of Commissioner on re-issues . . . . . 714 *n.* 6
Foote *v.* Silsby (1851), 2 Blatch. 260. Distinction between art and apparatus 167 *n.* 1
Use with new force . . . . . 265 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*

Foote *v.* Silsby (1849), 1 Blatch. 445. Requisites of notice of prior publication 1003 *n.* 2
Forbes *v.* Barstow Stove Co. (1864), 2 Clifford, 370. Jury to decide as to sufficiency of Description . . . . . 503 *n.* 1
Court to decide as to sufficiency of Claim . . . . . 503 *n.* 1
Revocation of surrender, and withdrawal of re-issue application . . 707 *n.* 3
Foss *v.* Herbert (1856), 2 Fisher, 31. "Equivalent" defined . . . . 248 *n.* 1
Identity of machines and its tests . . . . . 178 *n.* 1
Infringement of machine patent . . . . . 926 *n.* 1
Foster *v.* Crossin (1885), 23 Fed. Rep. 400. Identity of designs . . . . 306 *n.* 1
v. Moore (1852), 1 Curtis, 279. Equivalent a matter of judgment, not of inventive skill . . . . . 253 *n.* 1
Acquiescence shows validity only when of considerable duration and extent . . . . . 1186 *n.* 4
Francis *v.* Mellor (1871), 1 O. G. 48. Patent construed as an entirety . . 742 *n.* 3
French *v.* Rogers (1851), 1 Fisher, 133. Patent amendable to perfect the disclosure of the invention . . . . . 42 *n.* 10
Variations in form between original and re-issue . . . . . 668 *n.* 1
Successive re-issues allowable . . . . . 693 *n.* 3
Frevert *v.* Gahr (1873), 3 O. G. 660. Effect of patent issued without notice to caveator . . . . . 444 *n.* 2
Frick, *Ex parte* (1872), 1 O. G. 574. Effect of patent issued to one contestant during an interference . . . . . 603 *n.* 8
Funck, *Ex parte* (1878), 14 O. G. 158. Claim to distinguish old and new 513 *n.* 1
Fuller *v.* Yentzer (1876), 94 U. S. 288. Invention a means, not an end . 90 *n.* 1
Effect or result not patentable . . . . . 147 *n.* 1
Furbush *v.* Bradford (1858), 1 Fisher, 317. Matters considered by the court in granting or refusing injunctions . . . . . 1208 *n.* 1
v. Cook (1857), 2 Fisher, 668. Simultaneous co-operation of combination elements . . . . . 155 *n.* 5
Superiority of result indicates difference in means . . . . . 117 *n.* 2
Gage *v.* Herring (1882), 107 U. S. 680. Void Claims in re-issue do not affect valid ones . . . . . 684 *n.* 5
Galloway *v.* Bleaden (1839), 1 Web. 521. Experiments not prior use . . 318 *n.* 3
Gamewell Fire Alarm Tel. Co. *v.* Brooklyn (1882), 14 Fed. Rep. 255. Assignment and license distinguished . . . . . 763 *n.* 3
Gardner *v.* Herz (1886), 118 U. S. 180. Variation in materials . . . . 243 *n.* 1
Gardiner *v.* Howe (1865), 2 Clifford, 462. Territorial limits of patent privilege . . . . . 46 *n.* 3
Infringement by use on American ships . . . . . 909 *n.* 2
Garretson *v.* Clark (1884), 111 U. S. 120. Plaintiff must prove amount of defendant's profits . . . . . 1143 *n.* 4
Gayler *v.* Wilder (1850), 10 How. 477. Rights embraced in the patent privilege . . . . . 61 *n.* 1
Lost arts . . . . . 322 *n.* 1
Monopoly indivisible . . . . . 755 *n.* 1
Transfer of invention without the monopoly . . . . . 755 *n.* 2
Assignment, grant, and license distinguished . . . . . 759 *n.* 1
Geiger *v.* Cook (1842), 2 Watts & Serg. 266. "Improvement" defined . 210 *n.* 1
Gibson *v.* Braud (1842), 1 Web. 631. Patentability of an art . . . . . 160 *n.* 1
v. Campbell (1841), 1 Web. 627. Disclosure the consideration for the patent . . . . . 15 *n.* 2
v. Cook (1850), 2 Blatch. 144. Record of title in the Patent Office . 784 *n.* 2
Gilbert & Barker Mfg. Co. *v.* Walworth Mfg. Co. (1876), 9 O. G. 746. Variation in location . . . . . 242 *n.* 1
Gill *v.* Wells (1874), 22 Wall. 1. Knowledge of equivalent at date of patent 256 *n.* 1
Scope of re-issue of combination-patent . . . . . 670 *n.* 2
Re-issue of combination-patent may cover sub-combinations . . . . 671 *n.* 1
Glue Co. *v.* Upton (1877), 97 U. S. 3. Essential attributes of manufacture 188 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Godfrey *v.* Eames (1863), 1 Wall. 317. Withdrawal and substitution of application . . . . . 580 *n.* 4
Goldsmith *v.* American Paper Collar Co. (1880), 18 Blatch. 82. Plaintiff cannot sue in name of attorney or delegate . . . . . 944 *n.* 4
Goodyear *v.* Berry (1868), 3 Fisher, 439. Identity of compositions . . . 105 *n.* 1
Evidence of fraud in re-issue . . . . . 715 *n.* 2
v. Beverly Rubber Co. (1859), 1 Clifford, 348. Patented article lawfully sold released from the monopoly . . . . . 824 *n.* 2, 3
Vendee of patented article may sell it and his vendee may use it . 827 *n.* 4
v. Congress Rubber Co. (1856), 3 Blatch. 440. Licensee enjoined if he breaks conditions of license . . . . . 819 *n.* 3
v. Day (1852), 2 Wall. Jr. 283. Conception without reduction . . . 80 *n.* 1
Abandoned experiments . . . . . 80 *n.* 1
v. Hills (1866), 3 Fisher, 134. Abandonment of application . . . . 575 *n.* 1
v. Honsinger (1867), 2 Bissell, 1. Duty of licensor to prosecute infringers 819 *n.* 2
v. Hullihen (1867), 3 Fisher, 251. Executor need not qualify in district of suit . . . . . 942 *n.* 3
v. Phelps (1853), 3 Blatch. 91. Officers of corporation liable to injunction for its infringements . . . . . 912 *n.* 3
v. Railroad (1853), 1 Fisher, 626. Art and product distinguished . . 167 *n.* 1
Clearness of Description necessary . . . . . 490 *n.* 4
Description of composition . . . . . 500 *n.* 6
Goodyear Dental Vulcanite Co. *v.* Davis (1880), 102 U. S. 222. Combination equivalents . . . . . 254 *n.* 1
v. Gardiner (1870), 4 Fisher, 224. Effect of defendant's patent . 1198 *n.* 2
v. Smith (1874), Holmes, 354. Variation in materials . . . . . 243 *n.* 1
v. Van Antwerp (1876), 2 Bann. & A. 252. Profits and damages distinguished . . . . . 1050 *n.* 1
v. Willis (1874), 7 O. G. 41. Effect of judgments of Circuit courts 1181 *n.* 3
Gorham Mfg. Co. *v.* White (1871), 14 Wall. 511. Design a means of beauty, not utility . . . . . 200 *n.* 1
Identity of designs . . . . . 201 *n.* 1
Nature of design . . . . . 204 *n.* 1
Embodiment of design in drawings . . . . . 208 *n.* 1
Gottfried *v.* Phillip Best Brewing Co. (1879), 17 O. G. 675. "Equivalent" defined . . . . . 246 *n.* 1
Double use . . . . . 260 *n.* 1
Identity of machines . . . . . 290 *n.* 1
Prior publication must describe same invention . . . . . 329 *n.* 1
Joint invention by community of mental effort . . . . . 398 *n.* 1
Experiments not prior use . . . . . 318 *n.* 3
Gould's Mfg. Co. *v.* Cowing (1882), 105 U. S. 253. Measure of profits where the invention gives the infringing article its market value . . . . 1142 *n.* 1
Graham *v.* Johnston (1884), 21 Fed. Rep. 40. Power of Congress over the creation of the patent privilege . . . . . 46 *n.* 1
Power of Congress to create monopoly in inventions already in use 46 *n.* 2
v. Mason (1872), 5 Fisher, 290. Rule of damages at law . . . . 1051 *n.* 1
Losses of infringers not deducted from profits on sales . . . 1139 *n.* 18
Gramme Electrical Co. *v.* Arnoux & Hockhausen Electric Co. (1883), 17 Fed. Rep. 838. Term of patent limited by foreign patents . . . . . 623 *n.* 4
Grant *v.* Raymond (1832), 6 Peters, 218. Amendment of patent . . . . 21 *n.* 1
Patent privilege intended to secure the disclosure of inventions . . . 39 *n.* 1
Power of Secretary of State in issuing patents under the Act of 1793 . 49 *n.* 2
Amendment by re-issue before 1832 . . . . . 653 *n.* 1
Gray *v.* James (1817), Peters, C. C. 394. Identity of substance . . . . 236 *n.* 1
Ambiguity in the description . . . . . 493 *n.* 2
Greeley, *Ex parte* (1873), Holmes, 284. Variations in shape . . . . . 238 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*

Green *v.* French (1879), 4 Bann. & A. 109. Laches forfeits the right to an injunction . . . . . 1194 *n.* 3
Reasonable delay not laches . . . . . 1194 *n.* 9
Greenwood *v.* Bracher (1880), 1 Fed. Rep. 850. Defeated patentee in an interference may deny patentability of invention . . . . . 984 *n.* 7
Grover & Baker Sewing Mach. Co. *v.* Williams (1860), 2 Fisher, 133. Validity shown by judgments or acquiescence . . . . . 1174 *n.* 1
Acquiescence implies interests antagonistic to the patent . . . . 1185 *n.* 3
Acquiescence shown by taking licenses . . . . . 1187 *n.* 2
Acquiescence in original shows validity of re-issue . . . . . 1187 *n.* 5
Haaoz *Ex parte* (1873), 4 O. G. 610. Equivocal words like "equivalent" in the Claim . . . . . 516 *n.* 5
Hahn *Ex parte* (1875), 8 O. G. 597. Functional Claims . . . . . 518 *n.* 1
Hailes *v.* Albany Stove Co. (1887), 123 U. S. 582. Description not amendable by disclaimer . . . . . 649 *n.* 1
(1883), 16 Fed. Rep. 240. Description incidentally amendable by disclaimer . . . . . 649 *n.* 2
v. Van Wormer (1873), 20 Wall. 353. Aggregation not patentable . 154 *n.* 1
New result indicates new combination . . . . . 156 *n.* 1
Combination of old elements . . . . . 155 *n.* 4
(1870), 7 Blatch. 443. Co-operation of elements in a combination 155 *n.* 1
Hall *v.* Johnson (1883), 23 O. G. 2411. Suggestions of others to the inventor . . . . . 84 *n.* 1
Co-operation of elements in a combination . . . . . 155 *n.* 1
v. Wiles (1851), 2 Blatch. 194. Disclaimer needed only when the excess is a material part . . . . . 643 *n.* 1
Hammerschlag *v.* Scamoni (1881), 7 Fed. Rep. 584. Structural law of a machine . . . . . 175 *n.* 1
Hammond *v.* Pratt (1879), 16 O. G. 1235. Power of parties to concede priority by agreement . . . . . 363 *n.* 1
Hapgood *v.* Hewitt (1882), 11 Bissell, 184. Employee's right to his patents 414 *n.* 2
Harmar *v.* Playne (1809), 14 Vesey, 130. Contract theory of patent privilege 15 *n.* 1
Harmet *v.* Reese (1882), 21 O. G. 1875. Effect of delay by prior inventor in applying for a patent . . . . . 390 *n.* 2
Harrison *v.* Railway Co. (1860), 6 Jur. N. S. 993. Analogous use . . . 259 *n* 1
v. Taylor (1859), 4 H. & N. 815. Inspection the test of design . . 202 *n.* 1
Combination of designs . . . . . 205 *n.* 1
Embodiment of designs in drawings . . . . . 208 *n.* 1
Harwood *v.* Railway Co. (1865), 11 H. L. 654. Use with new object . . 266 *n.* 1
Haselden *v.* Ogden (1868), 3 Fisher, 378. Infringement by making, sale, or use . . . . . 897 *n.* 1
Hatchman *Ex parte* (1884), 3 Mackay, 288. Re-issue cannot include Claims once rejected by the Patent Office with the concurrence of the patentee . 689 *n.* 3
Hawley *v.* Mitchell (1871), 1 O. G. 306. License to use specific machine endures under an extension . . . . . 816 *n.* 5
Hayden *v.* Oriental Mills (1883), 15 Fed. Rep. 605. State statutes of Limitation apply to patent cases . . . . . 980 *n.* 1
v. Suffolk Mfg. Co. (1862), 4 Fisher, 86. Credibility of witnesses . 1011 *n.* 1
Abandonment of invention indicates that it is not complete . . 1026 *n.* 27
Identity an element in prior use . . . . . 1026 *n.* 5
Hayes *v.* Dayton (1880), 8 Fed. Rep. 702. Multifariousness . . . . 1108 *n.* 2
Test of multifariousness . . . . . 1108 *n.* 3
Joinder of causes of action in equity . . . . . 1108 *n.* 4
Heald *v.* Rice (1882), 104 U. S. 737. Identity of original and re-issue shown by comparing them . . . . . 665 *n.* 1
Heath *v.* Unwin (1852), 2 Web. 236. Knowledge of equivalent at date of patent . . . . . 256 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Hecker *v.* Rumford Chemical Works (1876), 9 O. G. 1062. Property in secret inventions . . . . . 24 *n.* 2
Heginbotham *Ex parte* (1875), 8 O. G. 237. Necessity of application-oath 454 *n.* 1
Hendrie *v.* Sayles (1878), 98 U. S. 546. Assignment of extension . . . 412 *n.* 3
Henry *v.* Francestown Soapstone Stove Co. (1880), 17 O. G. 569. Abandonment by sale . . . . . 359 *n.* 1
Abandonment by unrestricted sale . . . . . 359 *n.* 3
(1876), 9 O. G. 408. Experimental use not public use . . . . . 355 *n.* 3
Herring *v.* Gage (1878), 15 Blatch. 124. Items of cost allowable in computing profits on sales . . . . . 1130 *n.* 7
Profits not measured by the advantage of using the patented invention over others . . . . . 1145 *n.* 4
v. Gas Consumers' Association (1878), 9 Fed. Rep. 556. Infringement by co-owners . . . . . 707 *n.* 1, 913 *n.* 1
v. Nelson (1877), 12 O. G. 753. Variations in form between original and re-issue . . . . . 668 *n.* 2
Re-issue of combination patent may cover sub-combinations . . 671 *n.* 1
Hibbard *v.* Richmond (1880), 17 O. G. 1155. Determination of rights of rival inventors by the Patent Office . . . . . 586 *n.* 1
Hicks *v.* Kelsey (1873), 18 Wall. 670. Variation of materials . . . . 243 *n.* 1
Hill's Patent, *In re* (1863), 1 Moore P. C. C. N. S. 258. Nature of patent privilege . . . . . 11 *n.* 3
Hill *v.* Biddle (1886), 27 Fed. Rep. 500. Utility as evidence of novelty and inventive skill . . . . . 113 *n.* 2
v. Thompson (1818), 1 Web. 239. Use of less than all elements of a combination . . . . . 282 *n.* 1
v. Whitcomb (1874), 5 O. G. 430. Licensee cannot sue in his own name 941 *n.* 3
Hitchcock *v.* Tremaine (1872), 5 Fisher, 310. Expenses of general business as an item of cost in infringement cases . . . . . 1139 *n.* 17
Hockholzer *v.* Eager (1873), 2 Sawyer, 361. Acquiescence as proof of validity . . . . . 1185 *n.* 1
Hodge *v.* Hudson River R. R. Co. (1868), 6 Blatch. 85. Express license expires with the term of the patent . . . . . 816 *n.* 3
Hoe *v.* Cottrell (1880), 18 O. G. 59. Inventive skill in combinations . . 155 *n.* 4
Hoffmann *v.* Young (1880), 2 Fed. Rep. 74. Aggregation and combination distinguished . . . . . 154 *n.* 1
Simultaneous co-operation of the elements in a combination . . . . 155 *n.* 5
Hogg *v.* Emerson (1850), 11 How. 587. Rule of joinder of inventions in the courts . . . . . 470 *n* 1
Intent not to infringe may mitigate damages, but is no defence . . 901 *n.* 3
Holdsworth *v.* McCrea (1867), L. R. 2 H. L. 380. Inspection the test of design 202 *n.* 1
Hollister *v.* Benedict Mfg. Co. (1884), 113 U. S. 59. Nature of mechanical skill . . . . . 78 *n.* 2
Holt, *Ex parte* (1884), 29 O. G. 171. Patentability of matter described, but not claimed in former patent . . . . . 465 *n.* 3
Purpose of Description and Claim . . . . . 482 *n.* 2
Hopkins *v.* Le Roy (1880), 18 O. G. 859. Preliminary statement amendable 597 *n.* 4
Hornblower *v.* Boulton (1799), 8 T. R. 95. Public disadvantages of patent privilege . . . . . 14 *n.* 4
Patentability of an art . . . . . 161 *n.* 1
Horniball's patent, *In re* (1855), 2 Web. 201. Validating patents void for prior use . . . . . 17 *n.* 3
Horton *v.* Mabon (1862), 12 C. B. N. S. 437. Idea of means the essence of the invention . . . . . 77 *n.* 1
Hotchkiss *v.* Greenwood (1850), 11 How. 248. Variation of materials . . 243 *n.* 1
Household Co. *v.* Neilson (1843), 1 Web. 673. Nature of patent privilege 11 *n.* 3
Abandonment by public use . . . . . 71 *n.* 1, 348 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Household Co. *v.* Neilson (1843), 1 Web. 673. Accidental unperceived inventions 70 *n.* 1
Utility as evidence of novelty . . . . . 116 *n.* 1, 344 *n.* 2
Use with new force . . . . . 205 *n.* 1
Lost arts . . . . . 321 *n.* 2
Howe *v.* Underwood (1854), 1 Fisher, 160. Experiments not prior use . 318 *n.* 3
v. Williams (1863), 2 Fisher, 395. Trial by jury in equity cases . 1125 *n.* 7
v. Wooldredge (1866), 12 Allen, 18. Effect of assignment and license upon the monopoly . . . . . 763 *n.* 2
Patented article lawfully sold released from the monopoly . . . 824 *n.* 3
Howes *v.* Nute (1870), 4 Clifford, 173. Description construed with other parts of the specification . . . . . 480 *n.* 1
Howland, *Ex parte* (1877), 12 O. G. 889. Joinder of generic and specific inventions . . . . . 471 *n.* 1
Hubel *v.* Dick (1880), 28 Fed. Rep. 132. Effect of delay of prior inventor in applying for a patent . . . . . 390 *n.* 1
Huddart *v.* Grimshaw (1803), 1 Web. 85. Nature of patent privilege . . 11 *n.* 3
Existence and patentability of many means for same end . . . . . 117 *n.* 1
Hull *v.* Commissioner (1875), 7 O. G. 559. Power of Commissioner to withhold patent . . . . . 583 *n.* 1
Hunt, *Ex parte* (1878), 13 O. G. 771. Power of Commissioner to withhold patent . . . . . 583 *n.* 1
Hussey *v.* Bradley (1863) 2 Fisher, 362. Identity of original and re-issue proved in the Patent Office by extrinsic evidence if there are no drawings or model . . . . . 683 *n.* 1
Re-issue may restore matter disclaimed by mistake . . . . . 689 *n.* 1
Right to re-issue not lost by lapse of time . . . . . 692 *n.* 1
Hyatt *v.* Ingalls (1883), 49 Sup. Ct. (N. Y.) 375. Jurisdiction of Federal courts where title to patent involved . . . . . 857 *n.* 1
Jurisdiction of State courts where monopoly collaterally involved . . 865 *n.* 3
Imhaeuser *v.* Buerk (1879), 101 U. S. 647. Combination of old elements . 155 *n.* 4
Knowledge of equivalent at date of patent . . . . . 256 *n.* 1
Imlay *v.* Norwich & Worcester R. R. Co. (1858), 1 Fisher, 340. Variations in capacity . . . . . 240 *n.* 1
Jurisdiction in equity when patent expires pending suit . . . . 1093 *n.* 2
Innis *v.* Oil City Boiler Works (1885), 22 Fed. Rep. 780. Abandonment by unrestricted sale . . . . . 359 *n.* 4
Isaacs *v.* Abrams (1878), 14 O. G. 861. Variation of materials . . . . 243 *n.* 1
v. Cooper (1821), 4 Wash. 259. Description of improvement . . . 502 *n.* 1
Preliminary injunction denied if patent defective . . . . . 1199 *n.* 1
Jacobs *v.* Commissioners of Hamilton Co. (1862), 4 Fisher, 81. Infringement by contractor . . . . . 919 *n.* 1
James *v.* Campbell (1881), 104 U. S. 356. Art and apparatus distinguished 167 *n.* 1
Effect of former patent to same inventor . . . . . 337 *n.* 1
Re-issue of machine-patent cannot cover process . . . . . 675 *n.* 3
Re-issue of patent for an art may cover product . . . . . 675 *n.* 3
United States no right to practice an invention without consent of patentee . . . . . 910 *n.* 1, 2
United States suable in Court of Claims for use of invention . . . 1258 *n.* 1
Jenkins *v.* Greenwald (1857), 2 Fisher, 37. Past infringement as evidence of intent to infringe in the future . . . . . 1191 *n.* 6
v. Walker (1872), Holmes, 120. Description of composition . . . . 500 *n.* 2
Jennings *v.* Kibbe (1882), 20 Blatch. 353. Test of design . . . . . 203 *n.* 1
Johnsen *v.* Beard (1875), 2 Bann. & A. 50. Decision of Commissioner final as to fraud in re-issue . . . . . 715 *n.* 1
Johnson *v.* Root (1858), 1 Fisher, 351. Equivalent defined . . . . . 246 *n.* 1
Claims construed by entire description and extrinsic records . . 745 *n.* 2
v. Willimantic Linen Co. (1866), 33 Conn. 436. No implied warranty of validity in an assignment by an assignee . . . . . 1232 *n.* 2

References are to sections.

CASES, EXTRACTS FROM — *continued.*

Jones *v.* Pearce (1832), 1 Web. 122. Experiments not prior use . . . . 318 *n.* 3
v. Sewall (1873), 3 Clifford, 503. Public use with consent of inventor 357 *n.* 1
Relation of public use to abandonment . . . . . 965 *n.* 5
Jordan *v.* Dobson (1870), 4 Fisher, 232. Re-issue not allowed unless defect arose from inadvertence, accident, or mistake . . . . . 686 *n.* 1
Jurisdiction of Commissioner over re-issues how far conclusive . 714 *n.* 1
v. Overseers (1831), 4 Ham. (O.) 204. Right of public to inventions under natural law . . . . . 25 *n.* 1
Power of State over patented inventions . . . . . 46 *n.* 4
Judson *v.* Bradford (1878), 16 O. G. 171. License fee not a measure of damages when duration of use differs . . . . . 1058 *n.* 3
v. Cope (1860), 1 Bond, 327. Utility as evidence of novelty 110 *n.* 1, 344 *n.* 2
v. Moore (1859), 1 Fisher, 544. Suggestions from words and experiments of others . . . . . 84 *n.* 1
Suggestions consistent with inventive skill . . . . . 84 *n.* 1
Description intelligible to those skilled in the art . . . . . 492 *n.* 2
Jupe *v.* Pratt (1837), 1 Web. 145. Right of patentee to all applications of his principle . . . . . 30 *n.* 2
Patentability of a "principle reduced to practice" . . . . . 130 *n.* 2
Patent extended to cover all modes of embodiment . . . . . 130 *n.* 2
Patentability of a principle as an idea of means . . . . . 139 *n.* 2
Kay *v.* Marshall (1835), 2 Web. 36 Use with new object . . . . . 266 *n.* 1
Kells *v.* McKenzie (1881), 20 O. G. 1663. Jurisdiction of Commissioner over re-issues how far conclusive . . . . . 714 *n.* 1
Kendall *v.* Winsor (1858), 21 How. 322. Patent privilege intended to secure disclosure of inventions . . . . . 38 *n.* 1
Duty of inventor to disclose his inventions . . . . . 42 *n.* 1
Effect of delay by prior inventor in applying for a patent . . . . . 390 *n.* 1
Kent, *Ex parte* (1880), 17 O. G. 686. Right of patentee to all species of his genus . . . . . 30 *n.* 2
Joinder of generic and specific inventions . . . . . 471 *n.* 4
Kerosene Lamp Heater Co. *v.* Fisher (1880), 1 Fed. Rep. 91. Proceedings before master in taking account . . . . . 1155 *n.* 2
v. Littell (1878), 3 Bann. & A. 312. Variations in form between re-issue and original . . . . . 668 *n.* 2
Ketchum Harvester Co. *v.* Johnson Harvester Co. (1881), 8 Fed. Rep. 586. Making for sale or use abroad an infringement . . . . . 909 *n.* 3
Keystone Bridge Co. *v.* Phœnix Iron Co. (1877), 95 U. S. 274. Claim measures monopoly . . . . . 505 *n.* 3
Courts cannot aid defective Claim . . . . . 505 *n.* 3
Kirby *v.* Beardsley (1867), 3 Fisher, 265. Right of the inventor to benefit of the doubt as to existence of inventive skill . . . . . 109 *n.* 2
Difficulty of distinguishing inventive from mechanical skill . . 59 *n.* 1
v. Dodge & Stevenson Mfg. Co. (1872), 10 Blatch. 307. Patentability of an improvement . . . . . 210 *n.* 2
Kirby Bung Mfg. Co. *v.* White (1880), 1 Fed. Rep. 604. Judgment and acquiescence as proof of validity . . . . . 1185 *n.* 1
Knight *v.* Baltimore & Ohio R. R. Co. (1840), 3 Fisher, 1. Re-issue confined to matters attempted to be described and claimed in the original . . . 663 *n.* 1
Kook, *Ex parte* (1879), 16 O. G. 543. Distinction between generic and specific inventions . . . . . 471 *n.* 4
La Baw *v.* Hawkins (1874), 1 Bann. & A. 428. Variation in form between original and re-issue . . . . . 668 *n.* 2
Re-issue so construed as to sustain it if possible . . . . . 684 *n.* 2
Decision of Commissioner as to fraud in re-issue final . . . . . 715 *n.* 1
Lamenaude's patent, *In re* (1850), 2 Web. 164. Patent to importer . . . 68 *n.* 1
Latta *v.* Shawk (1859), 1 Fisher, 465. Identity of machine and its tests . 178 *n.* 1
Lauder *v.* Crowell (1879), 16 O. G. 405. Date of conception of foreign invention in the United States . . . . . 382 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*

Lee *v.* Blandy (1800), 2 Fisher, 80. Patent infringed if either of its Claims violated . . . . . 801 *n.* 4
Patent for combination infringed by use of elements or subcombinations . . . . . 923 *n.* 3
Leggett *v.* Avery (1870), 101 U. S. 256. Re-issue cannot cover Claims once rejected with acquiescence of patentee . . . . . 680 *n.* 7
Le Roy *v.* Tatham (1852), 14 How. 156. Patent covers all modes of embodiment . . . . . 134 *n.* 3
Principle being an abstraction is not patentable . . . . . 134 *n* 3
Definitions of "principle" . . . . . 135 *n.* 1, 137 *n.* 1
Result or effect not patentable . . . . . 147 *n.* 1
Liardet *v.* Johnson (1778), 1 Web. 53. Nature of patent privilege . . . 11 *n.* 3
Strict construction of letters-patent . . . . . 14 *n.* 4
Lightner *v.* Brooks (1864), 2 Clifford, 287. Employer not liable for infringing acts of contractor . . . . . 911 *n.* 3
Lilliendahl *v.* Detwiller (1883), 18 Fed. Rep. 176. Averments of bill in equity joining several causes of action . . . . . 1108 *n.* 5
Lindsay *v.* Stein (1882), 20 Blatch. 370. Date of new application after former one abandoned . . . . . 580 *n.* 3
Little *v.* Lillie (1876), 10 O. G. 543. Conclusiveness of application oath . 457 *n.* 1
History of interference proceedings . . . . . 587 *n.* 2
Livingston *v.* Jones (1861), 2 Fisher, 207. Remedy at law adequate when damages alone required . . . . . 1087 *n.* 1
v. Van Ingen (1812), 9 Johnson, 507. Power of States to grant patents 45 *n.* 1
Patents not granted to importers . . . . . 46 *n.* 1
Patents granted to inventors only . . . . . 57 *n.* 2
Locomotive Engine Safety Truck Co. *v.* Erie R. R. Co. (1872), 3 O. G. 93. Local jurisdiction in equity . . . . . 1097 *n.* 2
v. Penn. R. R. Co. (1880), 2 Fed. Rep. 677. Profits measured by the advantage of using the patented invention over all open inventions . . 1145 *n.* 2
Loutrell *v.* Mellor (1871), 1 O. G. 48. Identity of compositions . . . . 196 *n.* 1
Lowell *v.* Lewis (1817), 1 Mason, 182. Description must clearly distinguish between old and new . . . . . 490 *n.* 2
Description intelligible to those skilled in the art . . . . . 492 *n.* 2
Lull *v.* Clark (1884), 22 Blatch. 207. Objections to evidence not presented to court pending the accounting . . . . . 1157 *n.* 12
Lyman *v.* Maypole (1884), 19 Fed. Rep. 735. Experimental use not public use 355 *n.* 2
Magic Ruffle Co. *v.* Douglass (1863), 2 Fisher, 330. Public benefit from inventor's disclosure . . . . . 43 *n.* 4
Inventive act instantaneous . . . . . 83 *n.* 1
v. Elm City Co. (1875), 8 O. G. 773. Option of licensor to sue for infringement or on contract . . . . . 1250 *n.* 1
Mahn *v.* Harwood (1884), 112 U. S. 354. Re-issue not granted to enlarge Claims . . . . . 656 *n.* 2
Patentee must re-issue at once if his Claims are too narrow . . . . 690 *n.* 2
Delay over two years in re-issue unreasonable . . . . . 690 *n.* 5
Whether delay in re-issue unreasonable ascertained by court or Patent Office by inspecting the patent and the re-issue application . . . . . 690 *n.* 8
Reasonable time for re-issue how measured . . . . . 691 *n.* 6
Decision of Commissioner on re-issues how far conclusive . . . . . 714 *n.* 8
Maier *v.* Brown (1883), 17 Fed. Rep. 736. Profits due to the patented invention must be separated from all others . . . . . 1140 *n.* 1
Mallett *v.* Cogger (1879) 16 O. G. 45. Abandonment of invention by the earliest inventor and its effect . . . . . 389 *n.* 1
Manning *v.* Cape Ann Isinglass & Glue Co. (1879), 4 Bann. & A. 612. Abandonment by public use . . . . . 354 *n.* 2
Public use as conferring knowledge on the public . . . . . 356 *n.* 1
Manufacturing Co. *v.* Ladd (1880), 102 U. S. 408. Re-issue to include only the invention originally patented . . . . . 661 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Many *v.* Sizer (1849), 1 Fisher, 17. Utility as evidence of novelty 116 *n.* 1, 344 *n.* 2
relation of defendant's profits to plaintiff's damages at law . . . 1062 *n.* 1
Marsh *v.* Dodge & Stevenson Mfg. Co. (1873), 6 Fisher, 562. Change of location . . . . . 242 *n.* 1
v. Seymour (1877), 97 U. S. 348. Re-issue enlarging Claims . . . 656 *n.* 3
Marshall, *Ex parte* (1883), 25 O. G. 882. Combination defined . . . . 153 *n.* 1
Marston *v.* Swett (1880), 82 N. Y. 526. Licensee liable for royalties while he receives the benefit until the patent is repealed or adjudged invalid . 1252 *n.* 7
Masury *v.* Anderson (1873), 11 Blatch. 162. Claim measures monopoly 505 *n.* 1
Matthews *v.* Flower (1885), 25 Fed. Rep. 830. Former patent to same inventor . . . . . 337 *n.* 1
Two patents to same inventor for same invention . . . . . 465 *n.* 3
v. Machine Co. (1882), 105 U. S. 54. Re-issue of combination-patent to cover elements . . . . . 672 *n.* 5
May *v.* County of Fond du Lac (1886), 27 Fed. Rep. 691. Necessity of invention or discovery . . . . . 78 *n.* 1
Maynadier *v.* Tenney (1877), 2 Bann. & A. 615. Changes in elements of combination . . . . . 282 *n.* 1
McClintock, *Ex parte* (1880), 17 O. G. 267. Re-issue of generic patent cannot claim different species from original . . . . . 673 *n.* 1
McClurg *v.* Kingsland (1843), 1 How. 202. Retrospective acts creating patent privilege . . . . . 46 *n.* 2
McComb *v.* Brodie (1872), 2 O. G. 117. Reduction to practice necessary 125 *n.* 1
Principle, idea or abstraction not patentable . . . . . 134 *n.* 1
Principle reduced to practice patentable . . . . . 140 *n.* 1
Damages measured by loss of plaintiff's sales . . . . . 1061 *n.* 2
McCormick *v.* Manny (1855), 6 McLean, 539. Combination-patent not infringed by use of part . . . . . 923 *n.* 4
v. Seymour (1854), 3 Blatch. 209. License fee the measure of damages 1059 *n.* 1
Ascertainment of profits . . . . . 1063 *n.* 7
(1851), 2 Blatch. 240. Ascertainment of profits . . . . . 1063 *n.* 7
McCrea *v.* Holdsworth (1865), 5 B. & S. 495. Test of design . . . . 203 *n.* 1
McDougall, *Ex parte* (1880), 18 O. G. 130. Joinder of subprocesses . 473 *n.* 2
McKay *v.* Dibert (1881), 5 Fed. Rep. 587. Product may be protected by its patent though the machine-patent has expired . . . . . 908 *n.* 2
v. Wooster (1873), 3 O. G. 441. Patented article sold by grantee released from the monopoly . . . . . 824 *n.* 5
McKesson *v.* Carnrick (1881), 21 O. G. 137. Duration of the co-operation of combination elements . . . . . 155 *n.* 5
McLaughlin *v.* People's R. R. Co. (1884), 21 Fed. Rep. 574. Laches forfeits right to injunction . . . . . 1194 *n.* 5
McMillin *v.* Barclay (1871), 5 Fisher, 189. Public use by the inventor himself is an abandonment . . . . . 356 *n.* 2
Estoppel of plaintiff in equity by inaction . . . . . 1114 *n.* 4
McMurray, *Ex parte* (1875), 8 O. G. 943. Claim for improvement . . 534 *n.* 2
McTammany, Jr. *v.* Needham (1880), 18 O. G. 1050. Measure of reasonable diligence in reducing to practice . . . . . 387 *n.* 2
Merchant *v.* Lewis (1857), 1 Bond, 172. Costs taxed when verdict gives nominal damages . . . . . 1080 *n.* 4
Merrill *v.* Yeomans (1876), 94 U. S. 568. Description of improvement . 502 *n.* 1
Mers *v.* Conover (1876), 11 O. G. 1111. Measure of profits . . . . . 21 *n.* 3
Merserole *v.* Union Paper Collar Co. (1869), 3 Fisher, 483. State court has jurisdiction though monopoly collaterally attacked . . . . . 865 *n.* 3
Meyer *v.* Bailey (1875), 2 Bann. & A. 73. Assignment and grant distinguished . . . . . 763 *n.* 1
v. Maxheimer (1881), 20 O. G. 1162. Scope of amended patent . . 42 *n.* 11
Middletown Tool Co. *v.* Judd (1867), 3 Fisher, 141. Inventive act instantaneous . . . . . 83 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Miller *v.* Brass Co. (1881), 104 U. S. 350. Re-issue not to enlarge Claims 650 *n.* 2
Right to re-issue lost by unreasonable delay . . . . . 690 *n.* 2, 3
Unreasonable delay in enlarging Claims renders re-issue invalid 690 *n.* 4
v. Liggett & Myers Tobacco Co. (1881), 7 Fed. Rep. 91. Actual parties in interest control the suit . . . . . 938 *n.* 5
v. Smith (1880), 18 O. G. 1047. Infringement of patent for design 929 *n.* 1
Milligan & Higgins Glue Co. *v.* Upton (1874), 4 Clifford, 237. Process and product separately patentable . . . . . 184 *n.* 1
Novelty of manufacture . . . . . 184 *n.* 1
Identity between original and re-issue Claims shown by comparing them, excluding parol evidence . . . . . 665 *n.* 1
Decision of Commissioner on re-issue how far conclusive . . . . 714 *n.* 3
Millward *v.* Barnes (1877), 11 O. G. 1060. Race of diligence between rival inventors . . . . . 384 *n.* 1
Mitchell *v.* Hawley (1872), 16 Wall. 544. License to use specific machine endures under extension . . . . . 810 *n.* 5
Transfer of exclusive right to make and sell not a mere license 814 *n.* 2
Vendee of patented article can use it without limit as to time . 826 *n.* 1
Vendee of patented article can repair it . . . . . 827 *n.* 2
Vendee of patented article cannot rebuild it . . . . . 827 *n.* 1
v. Reynolds (1713), 1 P. Williams, 181. Monopoly in inventions . . 32 *n.* 1
v. Tilghman (1873), 19 Wall. 287. Patentability of an art . . . 163 *n.* 1
Very dangerous inventions not useful . . . . . 340 *n.* 2
Moffitt *v.* Gaar (1860), 1 Bond, 315. Application to conform to legal requisites 451 *n.* 3
Re-issue the basis of all subsequent rights and suits . . . . . 696 *n.* 4
Monce *v.* Adams (1872), 1 O. G. 1. Effect of delay of prior inventor in applying for a patent . . . . . 390 *n.* 1
Moody *v.* Fiske (1820), 2 Mason, 112. Combination-patent infringed by use of elements and subcombinations . . . . . 923 *n.* 3
Moore *v.* Marsh (1868), 7 Wall. 515. Assignees must sue jointly for infringement when . . . . . 940 *n.* 4
Morgan's patent, *In re* (1843), 1 Web. 737. Nature of patent privilege . 11 *n.* 3
Morgan *v.* Seaward (1836), 1 Web. 170. Nature of patent privilege . . . 11 *n.* 3
Disclosure the consideration for the monopoly . . . . . 15 *n.* 2
Substance and form in inventions . . . . . 229 *n.* 1
Utility, degree of, immaterial . . . . . 341 *n.* 1
(1837), 1 Web. 187. Utility necessary . . . . . 338 *n.* 1
Sales as a mode of abandonment . . . . . 359 *n.* 1
Morley Sewing Mach. Co. *v.* Lancaster (1885), 23 Fed. Rep. 334. Equivalents in improvements . . . . . 258 *n.* 2
Morris *v.* Bransom (1776), Buller N. P. 76. Improvement patentable . 210 *n.* 2
v. Lowell Mfg. Co. (1866), 3 Fisher, 67. Injunction issued whatever its consequences . . . . . 1201 *n.* 2
Morton *v.* New York Eye Infirmary (1862), 5 Blatch. 116. Unpatentable discoveries . . . . . 66 *n.* 2
Reduction to practice necessary . . . . . 125 *n.* 2
Principle, force, or discovery not patentable . . . . . 134 *n.* 1, 138 *n.* 1
Motte *v.* Bennett (1849), 2 Fisher, 642. Injunction necessary to prevent future infringements . . . . . 1088 *n.* 1
Discretion of court in granting or refusing injunctions not without limits . . . . . 1172 *n.* 3
Injunction granted if right is clear . . . . . 1173 *n.* 1
Mowry *v.* Whitney (1871), 14 Wall. 620. Measure of profits . . . . 21 *n.* 3
Description addressed to those skilled in the art . . . . . 488 *n.* 1
Description intelligible to those skilled in the art . . . . . 402 *n.* 3
14 Wall. 434. Repeal in the interest of the public . . . . . 725 *n.* 1
Cases in which repeal is proper . . . . . 726 *n.* 1
Repeal proper when patent obtained by fraud . . . . . 727 *n.* 1
Repeal procured by bill in equity . . . . . 729 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Muntz *v.* Foster (1844), 2 Web. 96. Use with new object . . . . . 200 *n.* 1
Murphy *v.* Eastham (1872), 2 O. G. 61. Claim for one form of the invention covers all forms . . . . . 514 *n.* 1
Murray, *Ex parte* (1873), 3 O. G. 659. Joinder of inventions . . . . 471 *n.* 2
Joinder of product with process or machine . . . . . 473 *n.* 4
Nagel, *Ex parte* (1880), 17 O. G. 108. Cases where interference is declared 501 *n.* 1
Nathan *v.* Elevated R. R. Co. (1880), 2 Fed. Rep. 225. Duration of perpetual injunction . . . . . 1221 *n.* 1
National Car Brake Shoe Co. *v.* Terre Haute Car & Mfg. Co. (1884), 19 Fed. Rep. 514. Evidence of established license-fee . . . . . 1057 *n.* 3
National Mfg. Co. *v.* Meyers (1881), 7 Fed. Rep. 355. Joinder of defences in answer . . . . . 1115 *n.* 3
Neilson *v.* Harford (1841), 1 Web. 331. Contract theory of patent privilege . . . . . 15 *n.* 1
Nevins *v.* Johnson (1853), 3 Blatch. 80. Law and equity jurisdiction concurrent . . . . . 1084 *n.* 1
New Process Fermentation Co. *v.* Koch (1884), 21 Fed. Rep. 580. Circulars not prior publication . . . . . 326 *n.* 2
Patent for apparatus may cover process also . . . . . 172 *n.* 2
v. Maus (1884), 20 Fed. Rep. 725. Chemical process, not its result, patentable . . . . . 149 *n.* 1
Art patentable . . . . . 163 *n.* 1
New combination of arts . . . . . 170 *n.* 1
New York *v.* Ransom (1859), 23 How. 487. Plaintiff to prove damages 1071 *n.* 1
New York Belting & Packing Co. *v.* Sibley (1883), 15 Fed. Rep. 386. Patentee bound by the patent as he accepts it from the Patent Office . . . . 689 *n.* 5
New York Pharmical Association *v.* Tilden (1882), 14 Fed. Rep. 740. Notice in lieu of stamping . . . . . 628 *n.* 4
Nichols *v.* Newell (1853), 1 Fisher, 647. Stamping in expectation of patent 630 *n.* 3
Nicholson *v.* Bennett (1879), 16 O. G. 631. Judgment of Patent Office between interfering patents . . . . . 54 *n.* 1
Niles Tool Works *v.* Betts Mach. Co. (1886), 27 Fed. Rep. 301. New result evidences new combination . . . . . 156 *n.* 1
Northwestern Fire Extinguisher Co. *v.* Phila. Fire Extinguisher Co. (1874), 6 O. G. 34. Written description not reduction . . . . . 126 *n.* 2
Rejected application as evidence . . . . . 1015 *n.* 9
Odell *v.* Stout (1884), 22 Fed. Rep. 159. Re-issue may enlarge the Claim but not the invention . . . . . 656 *n.* 3
Effect of decisions of Commissioner . . . . . 714 *n.* 3
Decisions of Commissioner on re-issues how far conclusive . . . 714 *n.* 8
Odiorne *v.* Winkley (1814), 2 Gallison, 51. Rights of inventors of separable ancillary means to their inventions . . . . . 395 *n.* 1
Tests of identity of machines . . . . . 178 *n.* 1
Oliphant *v.* Salem Flouring Mills Co. (1878), 5 Sawyer, 128. Stamping on patented articles . . . . . 630 *n.* 3
O'Reilly *v.* Morse (1853), 15 How. 62. Inventor may avail himself of suggestions, books, etc. . . . . 84 *n.* 1
Suggestions of others not inconsistent with inventive skill . . . . 84 *n.* 1
Invention a means not an end . . . . . 90 *n.* 1
"Principle" defined . . . . . 135 *n.* 1
Principle as a property of matter not patentable . . . . . 138 *n.* 1
Patentability of an art . . . . . 163 *n.* 1
Correctness of Description . . . . . 490 *n.* 1
Claim for all modes of effecting result void . . . . . 515 *n.* 6
Unreasonable delay in disclaiming . . . . . 646 *n.* 3
Disclaimer pending suit . . . . . 651 *n.* 1
Orr *v.* Littlefield (1845), 1 W. & M. 13. Validity shown on motion for injunction by judgments or acquiescence . . . . . 1174 *n.* 1
Acquiescence as proof of validity . . . . . 1185 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Pacific Bank *v.* Robinson (1881), 20 O. G. 1314. Power of equity to compel transfer of patent for benefit of creditors . . . . . 805 *n.* 1
Packard *v.* Sandford (1879), 16 O. G. 1182. Race of diligence between rival inventors . . . . . 385 *n.* 1
Effect of delay of prior inventor in applying . . . . . 390 *n.* 1
Page *v.* Ferry (1857), 1 Fisher, 208. Duty of patentee to disclose invention 42 *n.* 8
Patent as a contract . . . . . 481 *n.* 1
Description of machine . . . . . 498 *n.* 2
Patent construed in view of the nature of the actual invention . 739 *n.* 3
No infringement if invention be imperfectly described . . . 891 *n.* 3
Requisites of verdict . . . . . 1070 *n.* 1
v. Holmes Burglar Alarm Telegraph Co. (1880), 17 Blatch. 484. Right of Patent Office employee to patent . . . . . 363 *n.* 4
2 Fed. Rep. 330. Judgment not controlling unless same points in controversy . . . . . 1170 *n.* 3
Palmer, *Ex parte* (1881), 21 O. G. 1111. Prior publication to describe same invention . . . . . 329 *n.* 1
v. State (1883), 39 Ohio St. 236. Police power of State over sale of patented inventions . . . . . 46 *n.* 4
Park *v.* Little (1813), 3 Wash. 196. Ambiguity of Description . . . 493 *n.* 2
Parker *v.* Corbin (1848), 4 McLean, 462. Vindictive damages allowable 1053 *n.* 6
v. Haworth (1848), 4 McLean, 372. Nature of patent privilege . . . 11 *n.* 1
v. Hulme (1849), 1 Fisher, 44. Advantage of having court construe patents . . . . . 733 *n.* 1
Structural law of machine . . . . . 175 *n.* 1
Measure of actual damages . . . . . 1053 *n.* 2
v. Stiles (1849), 5 Mc Lean, 44. Patent as *prima facie* evidence . 1016 *n.* 2
Identity between patented and infringing inventions must be proved 1041 *n.* 4
Parker & Whipple Co. *v.* Yale Clock Co. (1887), 123 U. S. 87. Re-issue confined to matters attempted to be described and claimed in original . . 663 *n.* 1
Parks *v.* Booth (1880), 102 U. S. 96. Proper description necessary . . 483 *n.* 1
Patterson *v.* Commonwealth (1875), 11 Bush, 311. Power of State over patented inventions . . . . . 46 *n.* 4
v. Gas Light & Coke Co. (1877) L. R. 3 App. 239. Novelty essential to patentability . . . . . 315 *n.* 1
Peabody *v.* Norfolk (1868), 98 Mass. 452. Equity will protect unpatented invention against fraudulent disclosure . . . . . 873 *n.* 1
Pearl *v.* Ocean Mills (1877), 2 Bann. & A. 469. Inventive and mechanical skill distinguished . . . . . 85 *n.* 1, 122 *n.* 1
Re-issue of combination-patent may cover subcombinations . . . 671 *n.* 1
Peck *v.* Collins (1881), 103 U. S. 660. Re-issue the basis of all subsequent rights and suits . . . . . 696 *n.* 4
Entire patent avoided by surrender if re-issue refused for non-patentability or want of priority . . . . . 697 *n.* 3
Peek *v.* Frame (1871), 5 Fisher, 211. Effect of disclaimer on costs in actions at law . . . . . 1080 *n.* 1
Penn *v.* Bibby (1866), L. R. 2 Ch. Ap. 127. Analogous use . . . . 259 *n.* 1
Penna. R. R. Co. *v.* Locomotive Truck Co. (1884), 110 U. S. 490. Analogous use . . . . . 259 *n.* 1
Pennock, *Ex parte* (1874), 1 MacArthur, 531. Utility of result as evidence of novelty and inventive skill in the means . . . . . 121 *n.* 1
v. Dialogue (1829), 2 Peters, 1. True and first inventor . . . . . 58 *n.* 3
Effect of public use by rival inventor . . . . . 357 *n.* 3
People *v.* Russell (1883), 49 Mich. 617. Power of State to impose license on pedlers of patented inventions . . . . . 46 *n.* 4
Perkins *v.* Nashua Card & Glazed Paper Co. (1880), 2 Fed. Rep. 451. Prior use in public . . . . . 320 *n.* 1
Public use is use in ordinary way without restrictions . . . . . 356 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Perrigo v. Spaulding (1870), 13 Blatch. 389. Implied license to vendee from recovery of royalties against unlawful vendor . . . . . 830 *n.* 1
Perry v. Corning (1870), 7 Blatch. 195. Assignment unrecorded valid *inter partes* . . . . . 784 *n.* 5
Pettibone v. Derringer (1818), 4 Wash. 215. Patent construed as an entire instrument . . . . . 742 *n.* 3
Philada. & Trenton R. R. Co. v. Stimpson (1840), 14 Peters, 448. Evidence of conception . . . . . 380 *n.* 2
Patent evidence that all pre-requisities fulfilled . . . . . 451 *n.* 5
Declarations of inventor evidence of inventive act . . . . . 1026 *n.* 30
Philp v. Nock (1873), 17 Wall. 460. Relation of defendant's profits to plaintiff's damages at law . . . . . 1062 *n.* 2
Profits to be separated from others not due to the invention . . . 1062 *n.* 9
Pickering v. McCullough (1881), 104 U. S. 310. Co-operation of elements in a combination . . . . . 155 *n.* 1
Pierson v. Eagle Screw Co. (1844), 3 Story, 402. Public use with consent of inventor . . . . . 357 *n.* 2
Piper v. Brown (1870), Holmes, 20. Relation between process and apparatus . . . . . 172 *n.* 1
(1873), 3 O. G. 97. Profits do not include remote and contingent benefits 1146 *n.* 4
Pitts v. Hall (1854), 3 Blatch. 201. Co-owners not co-partners but co-tenants . . . . . 795 *n.* 1
(1851), 2 Blatch. 229. Inventor defined . . . . . 57 *n.* 2
Suggestions of others not inconsistent with inventive skill . 84 *n.* 1
Ascertainment of profits as a measure of damages . . . 1063 *n.* 10
v. Wemple (1855), 2 Fisher, 10. Patentee's power to suppress his invention . . . . . 31 *n.* 1; 43 *n.* 3
Claim measures monopoly . . . . . 505 *n.* 1
New means patentable though old means exists . . . . 117 *n.* 1
v. Whitman (1843), 2 Story, 609. Unrecorded assignment valid *inter partes* . . . . . 784 *n.* 5
Planing Mach. Co. v. Keith (1879), 101 U. S. 479. Abandonment of application . . . . . 575 *n.* 3
Plimpton v. Malcolmson (1876), L. R. 3 Ch. 531. Prior publication must communicate invention to the public . . . . . 330 *n.* 1
Priority shown by use, publication, or patent . . . . . 316 *n.* 1
Persons skilled in the art . . . . . 488 *n.* 1
v. Spiller (1877), L. R. 6 Ch. 412. Circulation of prior publication 327 *n.* 1
Poppenhusen v. Falke (1862), 5 Blatch. 46. Defects sometimes undiscoverable until patent judicially interpreted . . . . . 691 *n.* 5
v. New York Gutta Percha Comb Co. (1858), 2 Fisher, 62. Making for experiment infringement if maker profits by it . . . . 898 *n.* 2
Infringement by corporation through agents . . . . . 912 *n.* 1
Patent as *prima facie* evidence . . . . . 1016 *n.* 2
Damages implied from infringement . . . . . 1052 *n.* 1
2 Fisher, 74. Injunction issued whenever plaintiff's right clear 1201 *n.* 1
Porter's patent, *In re* (1855), 2 Web. 201. Nature of patent privilege . 11 *n.* 3
Potter v. Crowell (1866), 3 Fisher, 112. Past infringements as evidence of intent to infringe in the future . . . . . 1191 *n.* 6
Injunction not granted when further infringement impossible . 1205 *n.* 1
v. Dixon (1863), 5 Blatch. 160. Multiplicity of interferences . . 612 *n.* 1
v. Holland (1858), 1 Fisher, 327. Effect of disclaimer by owners of sectional interests . . . . . 647 *n.* 3
Effect of re-issue on grantees . . . . . 698 *n.* 5
Re-issue good in one section of the country, and original in others . . . . . 698 *n.* 6
Power of patentee to affect rights of assignees by re-issue 701 *n.* 4

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Potter *v.* Holland (1858), 1 Fisher, 327. Assignee defined . . . . . 762 *n.* 1
Assignment, grant, and license distinguished . . . . . 763 *n.* 1
1 Fisher, 382. Patent as *prima facie* evidence . . . . . 1016 *n.* 2
v. Mack (1868), 3 Fisher, 428. Suspension of perpetual injunction 1221 *n.* 2
v. Muller (1864), 2 Fisher, 465. Acquiescence as proof of validity . 1185 *n.* 1
v. Stewart (1881), 18 Blatch. 561. Variations in form between original and re-issue . . . . . 668 *n.* 3
v. Whitney (1866), 3 Fisher, 77. Effect on motion for injunction of judgments on questions of fact . . . . . 1179 *n.* 1
Acquiescence to show validity must be of some duration . . . 1186 *n.* 1
Preliminary injunction denied if difficult questions raised . . 1190 *n.* 4
Powder Co. *v.* Powder Works (1878), 98 U. S. 126. Re-issue confined to matter which the original attempted to describe and claim . . . . 663 *n.* 1
Pullman Car Co. *v.* B. & O. R. R. Co. (1881), 19 O. G. 224. Injunction denied except in case of irreparable injury . . . . . 1193 *n.* 1
Railroad Co. *v.* Mellon (1881), 104 U. S. 112. Nature and office of Claim 505 *n.* 1
Railway Co. *v.* Sayles (1878), 97 U. S. 554. Amendment of application 561 *n.* 13
Ransom *v.* Mayor of New York (1856), 1 Fisher, 252. Nature of inventive act . . . . . 59 *n.* 1; 78 *n.* 1
Accidental unperceived inventions . . . . . 79 *n.* 1
Diligence of earliest conceiver necessary from date of conception . 386 *n.* 2
Patent construed as an entire instrument . . . . . 742 *n.* 3
Read *v.* Miller (1867), 3 Fisher, 310. State statutes of limitation do not apply to patent cases . . . . . 980 *n.* 1
Reckendorfer *v.* Faber (1875), 92 U. S. 347. Burden of proof as to the patentability of the invention . . . . . 1018 *n.* 1
(1874), 5 O. G. 697. Aggregation and combination distinguished . 154 *n.* 1
Reed *v.* Cutter (1841), 1 Story, 590. First inventor . . . . . 58 *n.* 3
Diligence in reduction . . . . . 383 *n.* 1
Reeves *v.* Keystone Bridge Co. (1872), 5 Fisher, 456. Requisites of prior publication . . . . . 325 *n.* 1
Drawings and sketches not reduction . . . . . 380 *n.* 2
Evidence of complete conception . . . . . 380 *n.* 2
Date of prior publication must be proved . . . . . 1028 *n.* 5
Renwick *v.* Pond (1872), 10 Blatch. 39. Combination Claim not functional . . . . . 526 *n.* 2
Reutgen *v.* Kanowrs (1804), 1 Wash. 168. Inventor must be original as against all the world . . . . . 58 *n.* 4
Rex *v.* Arkwright (1785), 1 Web. 64. Nature of patent privilege . . . 11 *n.* 3
v. Metcalf (1817), 1 Web. 141. Strict construction of patent . . . 16 *n.* 3
v. Mussary (1738), 1 Web. 41. Strict construction of patent . . . 14 *n.* 3
v. Wheeler (1819), 2 B. & Ald. 345. Patentability of art . . . . 160 *n.* 1
Rice *v.* Winchester (1873), 3 O. G. 348. Effect of delay by prior inventor in applying for patent . . . . . 390 *n.* 2
Rich *v.* Close (1870), 4 Fisher, 279. Use of less than all elements of combination . . . . . 282 *n.* 1
Claims, when clear, control construction of patent . . . . . 745 *n.* 1
Roberts, *Ex parte* (1887), 40 O. G. 573. Patent for single unitary invention a bar . . . . . 464 *n.* 1
Roberts *v.* Dickey (1871), 4 Fisher, 532. Utility as evidence of inventive skill . . . . . 116 *n.* 1; 121 *n.* 1
Patentability of an art . . . . . 163 *n.* 1
v. Harnden (1865), 2 Clifford, 500. Combination equivalents . . 282 *n.* 1
Use of all elements in a combination . . . . . 282 *n.* 1
v. Schuyler (1875), 12 Blatch. 444. Verdict not set aside unless palpably erroneous . . . . . 1073 *n.* 4
v. Ward (1849), 4 McLean, 565. Principle of machine defined . . 173 *n.* 1
Utility actual not comparative . . . . . 342 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Robinson, *Ex parte* (1870), 4 Fisher, 186. Power of State over patented inventions . . . . . 46 *n.* 4
Roosevelt *v.* Western Electric Co. (1884), 20 Fed. Rep. 724. Vendee of patented article has no right to use other inventions unless inseparable in use . . . . . 825 *n.* 1
Root *v.* L. S. & M. S. R. R. Co. (1882), 105 U. S. 189. Equity will not grant an account except as incidental to other relief . . . . . 1091 *n.* 5
Rosenwasser *v.* Berry (1885), 22 Fed. Rep. 841. Necessity of inventive skill . . . . . 78 *n.* 1
Rowe *v.* Blanchard (1864), 18 Wis. 441. Utility defined . . . . . 339 *n.* 1
Rowell *v.* Lindsay (1881), 6 Fed. Rep. 200. Use of less than all elements in a combination . . . . . 282 *n.* 1
Combination patent not infringed if one element omitted . . . . 922 *n.* 4
Royer *v.* Schultz Belting Co. (1886), 28 Fed. Rep. 850. Essential elements of combination . . . . . 282 *n.* 1
Rubber Co. *v.* Goodyear (1869), 9 Wall. 788. Profits how computed . 1063 *n.* 5
Rude *v.* Westcott (1889), 130 U. S. 152. Evidence that plaintiff enjoys the monopoly by granting licenses . . . . . 1057 *n.* 1
Rumpff *v.* Köhler (1882), 23 O. G. 1831. Prior patent or publication . 327 *n.* 1
Russell *v.* Dodge (1876), 93 U. S. 460. Re-issue cannot cover new matter 668 *n.* 10
Jurisdiction of Commissioner over re-issues how far conclusive . . 714 *n.* 1
Ryan *v.* Goodwin (1839), 3 Sumner, 514. Combination of old elements 155 *n.* 4
Public use with consent of inventor . . . . . 357 *n.* 1
Sands *v.* Wardwell (1869), 3 Clifford, 277. Combination equivalents . 282 *n.* 1
Sanford *v.* Messer (1872), 5 Fisher, 411. License is any transfer not carrying the monopoly . . . . . 806 *n.* 2
Licensee cannot sue in his own name . . . . . 938 *n.* 7
Sawyer *v.* Edison (1853), 25 O. G. 597. Reduction to practice . . . 125 *n.* 1
Sayles *v.* Chicago & Northwestern R. R. Co. (1865), 1 Bissell, 408. Measure of reasonable diligence in reducing to practice . . . . . 387 *n.* 5
v. L. S. & M. S. R. R. Co. (1879), 9 Fed. Rep. 515. Federal statute of limitations runs from what time . . . . . 980 *n.* 3
v. Louisville City R. R. Co. (1881), 9 Fed. Rep. 512. Original and extension are two separate terms . . . . . 980 *n.* 3
v. Richmond, Fredericksburg & Potomac R. R. Co. (1879), 3 Hughes, 172. State statutes of limitations apply to patent cases . . . . . 980 *n.* 1
Infringer not a trustee *de son tort* . . . . . 1091 *n.* 2
Saxe *v.* Hammond (1875), 7 O. G. 781. Combination patent infringed by making or selling one part to be united to the rest by the vendee . 924 *n.* 1
Schillinger *v.* Gunther (1879), 17 Blatch. 66. Effect of fraudulent excessive Claim . . . . . 644 *n.* 1
Description incidentally amended by disclaimer . . . . . 649 *n.* 2
Schwarzel *v.* Holenshade (1860), 3 Fisher, 116. Increase of damages by the court . . . . . 1069 *n.* 4
Searls *v.* Worden (1882), 21 O. G. 1955. Effect of judgment of Circuit court . . . . . 1181 *n.* 3
Seibert, *Ex parte* (1879), 16 O. G. 262. Re-issue cannot cover subsequent inventions . . . . . 661 *n.* 2
Selden *v.* Stockwell Self-Lighting Gas Burner Co. (1881), 19 Blatch. 544.
"Assignee," in our statutes, means assignee to any degree 408 *n.* 1; 767 *n.* 3
Sewall *v.* Jones (1875), 91 U. S. 171. Patentability of principle reduced to practice . . . . . 130 *n.* 1; 143 *n.* 1
Patent covers all modes of reducing to practice . . . . . 130 *n.* 1
Seymour *v.* Marsh (1872), 2 O. G. 675. Mechanical perfection not necessary to reduction . . . . . 129 *n.* 1
v. McCormick (1853), 16 How. 480. License fee the measure of damages . . . . . 1059 *n.* 1
Relation of profits to damages . . . . . 1063 *n.* 2

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Seymour *v.* Osborne (1870), 11 Wall. 516. Amendment of patents . . . 21 *n.* 2
Identity of machines as affected by changes of parts, &c. . . . . 170 *n.* 1
Prior publication must describe a practical invention . . . . . 320 *n.* 2
Identity of original and re-issue shown by comparing specifications 681 *n.* 3
Jurisdiction of Commissioner over re-issues how far conclusive . . 714 *n.* 1
Sharp's Patent, *In re* (1840), 1 Web. 641. Abuse of amending power . . 16 *n.* 6
Shaw *v.* Cooper (1838), 7 Peters, 292. Abandonment to the public . . 352 *n.* 1
Shaw Relief Valve Co. *v.* New Bedford (1884), 19 Fed. Rep. 753. Right of executor to patents and inventions of decedents . . . . . 404 *n.* 2
Sickels *v.* Borden (1856), 3 Blatch. 535. Infringement of machine-patent 926 *n.* 1
v. Young (1855), 3 Blatch. 293. Preliminary injunction denied in case of doubt . . . . . 1199 *n.* 1
Silsby *v.* Foote (1852), 14 How. 218. Claim for combination applied by jury . . . . . 526 *n.* 2
Form of notice under general issue . . . . . 1000 *n.* 2
Requisites of notice of prior publication . . . . . 1003 *n.* 2
Simpson *v.* Davis (1882), 20 Blatch. 413. Combination of old designs . 205 *n.* 1
Singer *v.* Walmsley (1860), 1 Fisher, 558. Limits of power exercised by Congress as to classes of patentable inventions . . . . . 59 *n.* 5
Description construed with rest of specification . . . . . 489 *n.* 1
Unreasonable delay in disclaiming . . . . . 646 *n.* 2
Singer Mfg. Co. *v.* Union Button Hole & Embroidery Co. (1873), 4 O. G. 553. Injunction a substitute for specific performance . . . . . 1228 *n.* 4
Slawson *v.* Grand St. P. P. & F. R. R. Co. (1880), 4 Fed. Rep. 531. New result as evidence of new combination . . . . . 156 *n.* 1
Slessinger *v.* Buckingham (1883), 17 Fed. Rep. 454. Effect of sworn answer as evidence . . . . . 1119 *n.* 1
Smith *v.* Barter (1875), 7 O. G. 1. Right of earliest conceiver to patent if he was diligent reducer . . . . . 370 *n.* 1
v. Davidson (1857), 19 C. S. 697. Nature of patent privilege . . . 11 *n.* 3
Simultaneous inventors . . . . . 29 *n.* 3
v. Elliott (1872), 1 O. G. 331. Nature of mechanical skill . . . . 78 *n.* 2
v. Frazer (1872), 2 O. G. 175. Requisites of notice of prior use . . 1004 *n.* 4
v. Goodyear Dental Vulcanite Co. (1876), 93 U S. 486. Change of materials . . . . . 243 *n.* 1
Utility as evidence of inventive skill . . . . . 344 *n.* 1
v. Merriam (1881), 19 O. G. 601. Abuse of re-issues . . . . . 42 *n.* 11
Scope of re-issues . . . . . 56 *n.* 3
Jurisdiction of Commissioner on re-issue how far final . . . 714 *n.* 7
v. Nichols (1872), 2 O. G. 649. Utility as evidence of novelty 121 *n.* 1; 344 *n.* 2
v. Pearce (1840), 2 McLean, 176. Principle of machine defined . 173 *n.* 1
Smith & Griggs Mfg. Co. *v.* Sprague (1887), 123 U. S. 249. Experimental use not public use though resulting in profit . . . . . 355 *n.* 4
Snyder, *Ex parte* (1882), 22 O. G. 1975. Scope of amendments to application . . . . . 561 *n.* 7
Soames Patent, *In re* (1843), 1 Web. 729. Requisites of prior publication 325 *n.* 1
Slight inventive skill required . . . . . 85 *n.* 1
Spaeth *v.* Barney (1885), 22 Fed. Rep. 828. Re-issue *prima facie* valid 684 *n.* 1
Jurisdiction of Commissioner over re-issues, how far conclusive . . 714 *n.* 1
Spaulding *v.* Page (1871), 4 Fisher, 641. Damages vary with plaintiff's mode of enjoying the invention . . . . . 1054 *n.* 1
Implied license to vendee from recovery of royalties against unlawful vendor . . . . . 830 *n.* 1
License implied from payment of license fees as damages . . . . 1065 *n.* 1
License not implied from payment of damages if plaintiff preserves close monopoly . . . . . 1065 *n.* 2
Spent Madder Case (1851), 6 Exch. 607. Use with new object . . . . 266 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*

Sprague v. Smith & Griggs Mfg. Co. (1882), 12 Fed. Rep. 721. Experimental use not public use . . . . . 355 *n.* 2
Spring v. Domestic Sewing Mach. Co. (1882), 13 Fed. Rep. 446. Dismissal in equity for want of jurisdiction . . . . . 1095 *n.* 1
Stainthorp v. Humiston (1864), 4 Fisher, 107. Identity of machines and its tests . . . . . 179 *n.* 1
Stanley Rule & Level Co. v. Bailey (1878), 14 Blatch. 510. Jurisdiction of Federal courts over infringement suits by licensee against licensor . . 802 *n.* 3
Stanley Works v. Sargent (1871), 8 Blatch. 344. Utility as evidence of novelty and inventive skill . . . . . 117 *n.* 2, 344 *n.* 1
Starr v. Farmer (1883), 23 O. G. 2325. Application shows reduction to practice . . . . . 459 *n.* 1
State v. Telephone Co. (1880), 36 Ohio St. 296. Power of States over sale of patented inventions . . . . . 46 *n.* 4
Stead's Patent, *In re* (1846), 2 Web. 143. Validating patent void for prior use 17 *n.* 3
Stead v. Williams (1843), 2 Web. 126. Prior use not secret use . . . . 320 *n.* 2
(1844), 2 Web. 137. Requisites of prior publication . . . . . 325 *n.* 1
Circulation of prior publication . . . . . 327 *n.* 1
Steam Gauge & Lantern Co. v. St. Louis R. S. Mfg. Co. (1885), 25 Fed. Rep. 491. Device embodying principle patentable, not the principle itself . 143 *n.* 1
Steam Cutter Co. v. Sheldon (1872), 10 Blatch. 1. License may cover either or all the rights to make, use, or sell . . . . . 810 *n.* 1
License to make may cover right to sell . . . . . 811 *n.* 2
License to use implied from sale but limited to the invention sold . . 812 *n.* 1
Steam Stone Cutter Co. v. Sheldons (1884), 21 Fed. Rep. 875. License implied to user from payment of damages by seller . . . . . 1065 *n.* 3
Infringement a single wrong though composed of many tortious acts 906 *n.* 1
v. Windsor Mfg. Co. (1879), 17 Blatch. 24. License implied to purchaser from recovery of royalties against unlawful seller . . . . . 830 *n.* 1
Theory of profits in equity . . . . . 1137 *n.* 1
Steiger v. Heidelberger (1880), 4 Fed. Rep. 455. Infringement by salesmen on commission . . . . . 920 *n.* 3
Steiner v. Heald (1851), 6 Exch. 607. Use with new object . . . . . 266 *n.* 1
Stephenson v. Brooklyn R. R. Co. (1885), 114 U. S. 149. Patentability of combination . . . . . 155 *n.* 1
Stevens v. Gladding (1854), 17 How. 447. Sale of letters-patent on execution impossible . . . . . 803 *n.* 5
v. Keating (1847), 2 Web. 181. Construction of patent under contract theory . . . . . 15 *n.* 2
Substance produced by new means is a new substance . . . . 187 *n.* 1
Chemical equivalents . . . . . 254 *n.* 1
v. Pritchard (1876), 10 O. G. 505. Joinder of combinations, subcombinations, and elements . . . . . 472 *n.* 1
Variations in form between re-issue and original . . . . . 668 *n.* 1
Re-issue cannot cover new matter . . . . . 668 *n.* 10
v. Putnam (1880), 18 O. G. 520. Conception complete when idea ready for reduction . . . . . 379 *n.* 1
Stimpson v. Rogers, Smith, & Co. (1859), 4 Blatch. 333. Executor as trustee for heirs of inventor . . . . . 405 *n.* 1
Stitt v. Eastern R. R. Co. (1884), 22 Fed. Rep. 649. Prior knowledge or use of the invention . . . . . 226 *n.* 1
Identity an element in prior use . . . . . 1026 *n.* 5
Stover v. Clark (1877), 12 O. G. 188. Evidence of priority in interference proceedings . . . . . 600 *n.* 6
Stone v. Greaves (1880), 17 O. G. 397. Power of Commissioner to grant or withhold patent . . . . . 51 *n.* 3
Stutz v. Armstrong (1884), 20 Fed. Rep. 843. Co-operation of elements in combination . . . . . 155 *n.* 1
Delay unreasonable if over two years . . . . . 690 *n.* 5

References are to sections.

CASES, EXTRACTS FROM — *continued.*

Suffolk Co. *v.* Hayden (1866), 3 Wall. 315. Abandonment by describing and not claiming . . . . . 352 *n.* 1
Relation of defendant's profits to plaintiff's damages at law . . . 1062 *n.* 2
Swift *v.* Whisen (1867), 3 Fisher, 343. Re-issue may enlarge Claims . . 656 *n.* 3
Jurisdiction of the Commissioner over re-issues how far conclusive . 714 *n.* 1
Tappan *v.* National Bank Note Co. (1861), 2 Fisher, 195. Validity provable on motion for injunction by judgment . . . . . 1174 *n.* 1
Acquiescence impossible without assertion of right . . . . . 1185 *n.* 2
Tatham *v.* Le Roy (1852), 2 Blatch. 474. Nature of mechanical skill . . 78 *n.* 2
Identity of machines and its tests . . . . . 178 *n.* 1
Teese *v.* Huntingdon (1859), 23 How. 2. Counsel fees not allowed as damages 1067 *n.* 1
Tennant's Case (1802), 1 Web. 125. Prior use avoids patent . . . . . 17 *n.* 2
Thatcher Heating Co. *v.* Carbon Stove Co. (1878), 4 Bann. & A. 68. Averment of infringement in bill in equity . . . . . 1100 *n.* 5
Theberath *v.* Harness Trimming Co. (1883), 23 O. G. 1121. Design refers to beauty not utility . . . . . 200 *n.* 1
Thomas *v.* Reese (1880), 17 O. G. 195. Date of conception of foreign invention in the United States . . . . . 382 *n.* 1
v. Shoe Mach. Mfg. Co. (1878), 10 O. G. 541. Identity of original and re-issue shown by comparing them . . . . . 667 *n.* 2
Re-issue cannot cover new matter . . . . . 668 *n.* 10
Re-issue construed to sustain it if possible . . . . . 684 *n.* 2
Decision of Commissioner final as to fraud in re-issue . . . . 715 *n.* 1
Thompson *v.* Boisselier (1885), 114 U. S. 1. Discovery an essential element in the inventive act . . . . . 96 *n.* 1
v. Mendelsohn (1871), 5 Fisher, 187. Local jurisdiction in equity and at law over suits for infringement . . . . . 934 *n.* 2
Thomson *v.* Wooster (1885), 114 U. S. 104. Decrees *pro confesso* 1130 *n.* 1, 2, 3, 7
Tilghman *v.* Proctor (1881), 102 U. S. 707. Patentability of an art . . . 163 *n.* 1
Tomkinson *v.* Willetts Mfg. Co. (1884), 23 Fed. Rep. 895. Identity of designs 306 *n.* 1
Tomlinson *v.* Battel (1857), 4 Abb. Pr. 266. Jurisdiction of Federal courts when monopoly directly in issue . . . . . 858 *n.* 1
Traitel, *Ex parte* (1883), 25 O. G. 783. Nature of design . . . . . 204 *n.* 1
Treadwell *v.* Bladen (1827), 4 Wash. 703. Identity of substance in inventions . . . . . 235 *n.* 1
Troy Iron & Nail Factory *v.* Corning (1869), 3 Fisher, 497. Exceptions to report of master on accounting . . . . . 1158 *n.* 2
Tuck *v.* Bramhill (1868), 3 Fisher, 400. Disclaimer pending suit . . . . 651 *n.* 1
Tucker *v.* Spaulding (1872), 13 Wall. 453. Identity a question for the jury 1075 *n.* 1
v. Tucker Mfg. Co. (1876), 4 Clifford, 397. Object of specification . . 481 *n.* 2
Turnbull *v.* Weir Plow Co. (1880), 9 Bissell, 334. Effect of assignment of all rights under the patent . . . . . 775 *n.* 1
Turner *v.* Winter (1787), 1 Web. 77. Nature of patent privilege . . . 11 *n.* 3
Right of inventor to letters-patent . . . . . 14 *n.* 5
Strict construction of letters-patent . . . . . 14 *n.* 4, 16 *n.* 3
Turrell *v.* Cammerrer (1868), 3 Fisher, 462. Averment of infringement in bill in equity . . . . . 1106 *n.* 6
Turrill *v.* Illinois Central R. R. Co. (1883), 20 Fed. Rep. 912. Profits not measured by the advantage of using the patented invention over subsequently patented inventions . . . . . 1145 *n.* 4
Tuttle *v.* Loomis (1885), 24 Fed. Rep. 739. Re-issue allowable whenever defect discovered . . . . . 691 *n.* 1
Tyler *v.* Boston (1868), 7 Wall. 327. Description of composition . . . . 500 *n.* 2
v. Galloway (1882), 22 O. G. 1294. Shareholders liable for infringement by company . . . . . 912 *n.* 6
Tyne, *Ex parte* (1880), 17 O. G. 56. Joinder of product with process or machine 473 *n.* 4

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Underwood, *Ex parte* (1872), 1 O. G. 549. Conformity of language of re-issue specification to the original . . . . . 706 *n.* 1
Union Metallic Cartridge Co. *v.* United States Cartridge Co. (1884), 112 U. S. 624. Incidental amendments of Description by disclaimer . . . . . 649 *n.* 1
Union Paper Bag Mach. Co. *v.* Crane (1874), 1 Bann. & A. 494. Effect of judgments in Patent Office . . . . . 613 *n.* 3
v. Murphy (1877) 97 U. S. 120. Test of identity of machines . . . 178 *n.* 1
v. Pultz & Walkley Co. (1878), 15 O. G. 423. Inventor's knowledge of prior abandoned experiments . . . . . 84 *n.* 1
Invention by successful experiment . . . . . 381 *n.* 1
Inventor may start from the unsuccessful experiments of others . 381 *n.* 1
Union Paper Collar Co. *v.* White (1875), 11 Phila. 479. Use with new object 266 *n.* 1
Union Sugar Refinery *v.* Matthiesson (1865), 3 Clifford, 639. Combination of old elements . . . . . 155 *n.* 4
Classes of patentable machines . . . . . 176 *n.* 1
Tests of identity of machines . . . . . 178 *n.* 1
(1868), 3 Clifford, 146. Evidence not received in equity after hearing 1128 *n.* 12
Exceptions to report of master on the accounting . . . . 1158 *n.* 2
United Nickel Co. *v.* Anthes (1872), 1 O. G. 578. Suggestions from experiments of others . . . . . 84 *n.* 1
v. Worthington (1882), 13 Fed. Rep. 392. Officers of corporation not liable for damages for its infringements . . . . . 912 *n.* 4
United States *v.* Gunning (1883), 21 Blatch. 516. Repeal in the interest of the public . . . . . 725 *n.* 1
United States & Foreign Salamander Felting Co. *v.* Haven (1875), 9 O. G. 253. Re-issue cannot cover subsequent inventions . . . . . 661 *n.* 2
Re-issue cannot cover new matter . . . . . 668 *n.* 10
United States Rifle & Cartridge Co. *v.* Whitney Arms Co. (1877), 14 Blatch. 94. Delay as evidence of abandonment to the public . . . . . 351 *n.* 2
(1886), 118 U. S. 22. Abandonment after application . . . . . 353 *n.* 1
Unwin *v.* Heath (1854), 5 H. L. 505. Knowledge of equivalence at date of patent . . . . . 256 *n.* 1
Van Marter *v.* Miller (1879), 15 Blatch. 562. Patent construed in view of the actual invention . . . . . 739 *n.* 3
Vaughn *v.* Central Pacific R. R. Co. (1877), 4 Sawyer, 280. Profits not capable of computation are not recoverable . . . . . 1146 *n.* 1
Wade *v.* Metcalf (1883), 16 Fed. Rep. 130. Implied license in favor of employee and its duration . . . . . 832 *n.* 4
Implied license in favor of firm to use inventions of its members . 833 *n.* 1
Walker *v.* Hawxhurst (1867), 5 Blatch. 494. Stamping with intent to deceive 630 *n.* 2
Wallace *v.* Holmes, Booth, & Haydens (1871), 1 O. G. 117. Combination-patent infringed by making or sale of one part to be united with the rest . . 924 *n.* 1
Walton *v.* Bateman (1842), 1 Web. 613. Nature of patent privilege . . 11 *n.* 3
Patents to importers . . . . . 68 *n.* 1
Essentials of prior use . . . . . 317 *n.* 1
v. Potter (1841), 1 Web. 585. Disclosure the consideration of the monopoly 15 *n.* 2
Embodiment of another's idea . . . . . 112 *n.* 1
Existence and patentability of several distinct means to same end 117 *n.* 1
Substance and form in inventions . . . . . 229 *n.* 1
Washburn & Moen Mfg. Co. *v.* Fuchs (1883), 16 Fed. Rep. 661. Scope of re-issue of combination-patent . . . . . 670 *n.* 3
v. Griesche (1883), 5 McCrary, 246. Assignee of several patents owns the right separately from each other and cannot combine them . . . 777 *n.* 3
v. Haish (1880), 19 O. G. 173. Necessity of inventive skill . . . . 116 *n.* 1
Utility as evidence of novelty and inventive skill . 116 *n.* 1, 344 *n.* 1
(1879), 9 Bissell, 141. Stamping by infringers . . . . . 629 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*

Waterbury Brass Co. *v.* Miller (1871), 5 Fisher, 48. Use of less than all elements in a combination . . . . . 282 *n.* 1
Meaning of "substantially as described" in the Claim . . . . 750 *n.* 4
v. N. Y. & Brooklyn Brass Co. (1858), 3 Fisher, 43. Difference of result shows difference of means . . . . . 117 *n.* 2
Wayne *v.* Holmes (1856), 2 Fisher 20. Experiments not prior use . . . 318 *n.* 3
Webster Loom Co. *v.* Higgins (1882), 105 U. S. 580. New result evidence of new combination . . . . . 156 *n.* 1
Diversities of capacity . . . . . 240 *n.* 1
Welling *v.* Rubber Coated H. T. Co. (1875), 2 Bann. & A. 1. Re-issue may enlarge Claims . . . . . 656 *n.* 3
Wells *v.* Gill (1872), 2 O. G. 500. Effect of verdict and judgment on subsequent cases . . . . . 1182 *n.* 5
v. Jacques (1874), 1 Bann. & A. 60. Re-issue may enlarge Claims . 656 *n.* 3
Jurisdiction of Commissioner over re-issues, how far conclusive . 714 *n.* 1
Western Electric Mfg. Co. *v.* Odell (1883), 18 Fed. Rep. 321. Novelty and inventive skill in designs . . . . . 200 *n.* 2
Weston *v.* White (1870), 13 Blatch. 447. Continuity of applications . . 580 *n.* 5
Wetherell *v.* Passaic Zinc Co. (1872), 2 O. G. 471. License to use specific machines endures under extension . . . . . 816 *n.* 5
Wheeler *v.* Clipper Mower and Reaper Co. (1872), 10 Blatch. 181. Utility in connection with other devices sufficient . . . . . 341 *n.* 2
Re-issue may cover practicable form when that in the original was impracticable . . . . . 671 *n.* 2
Re-issue of combination-patent may cover subcombinations . . . . 671 *n.* 2
Re-issue of combination-patent may cover elements . . . . . 672 *n.* 1
Wheeler *v.* McCormick (1873), 11 Blatch. 334. Each division of a re-issue may describe the entire invention . . . . . 695 *n.* 3
White *v.* Allen (1863), 2 Clifford, 224. Reduction to practical art or instrument necessary . . . . . 126 *n.* 1
Diligence in reduction . . . . . 383 *n.* 1
Diligence required in earliest conceiver from date of conception . 386 *n.* 2
v. Dunbar (1886), 119 U. S. 47. Right to re-issue not affected by acts of third parties . . . . . 690 *n.* 1
v. Lee (1882), 14 Fed. Rep. 789. Licensee liable for royalties though patent invalid . . . . . 1252 *n.* 7
(1880), 3 Fed. Rep. 222. Forfeiture of license by breach of condition 822 *n.* 3
Failure to pay money, of itself no forfeiture of license . . . 822 *n.* 5
Forfeiture of license liberates both parties . . . . . 822 *n.* 8
Whitely *v.* Swayne (1865), 4 Fisher, 117. Jurisdiction of Commissioner over re-issues, how far conclusive . . . . . 714 *n.* 1
Whitney *v.* Emmett (1831), Baldwin, 303. Nature of patent privilege 20 *n.* 1, 2
Necessity of reduction to practice . . . . . 125 *n.* 2
Patentability of an art . . . . . 163 *n.* 1
Novelty . . . . . 222 *n.* 1
Universal novelty necessary . . . . . 223 *n.* 1
Experimental use not public use . . . . . 355 *n.* 3
Description construed with other parts of the specification . . . 489 *n.* 1
Ambiguity in description . . . . . 493 *n.* 2
v. Mowry (1868), 4 Fisher 141. Profits when the invention gives the infringing article its market value . . . . . 1142 *n.* 1
Whittemore *v.* Cutter (1813), 1 Gallison, 478. Result or effect not patentable 147 *n.* 1
Invention is a means, not an end . . . . . 90 *n.* 1
Principle of machine defined . . . . . 173 *n.* 1
Vindictive damages not allowed . . . . . 1053 *n.* 6
Measure of damages for making only . . . . . 1064 *n.* 2
1 Gallison, 429. Ambiguity in description . . . . . 493 *n.* 2

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Wicks *v.* Stevens (1870), 2 Woods, 310. Re-issue cannot cover Claims abandoned in Patent Office . . . . . 689 *n.* 7
Wilbur *v.* Beecher (1850), 2 Blatch. 132. Relation of profits to damages 1063 *n.* 2
Wilder *v.* Kent (1883), 15 Fed. Rep. 217. Sheriff's sale of patentee's assets releases them from the monopoly . . . . . 824 *n.* 7
v. McCormick (1846), 2 Blatch. 31. Patent as evidence that all prerequisites were fulfilled . . . . . 51 *n.* 3
Williams, *Ex parte* (1872), 1 O. G. 225. Description disparaging other inventions . . . . . 487 *n.* 1
v. Leonard (1872), 5 Fisher, 381. Salaries of infringers not allowed as expenses in infringing sales . . . . . 1139 *n.* 14
v. Rome, Watertown, & Ogdensburgh R. R. Co. (1879), 15 O. G. 653. New result indicates new combination . . . . . 156 *n.* 1
Wilson *v.* Coon (1880), 6 Fed. Rep. 611. "Specification" defined 655 *n.* 2, 750 *n.* 4
Re-issues under act of 1870 and Rev. Stat. . . . . 657 *n.* 1
Re-issue proper, when patent valid, for one purpose but not for another 660 *n.* 5
v. Simpson (1850), 9 How. 109. Vendee of patented article may repair or replace parts while identity of whole remains . . . . . 827 *n.* 3
v. Tindal (1841), 1 Web. 730. Equity jurisdiction in actions for infringement . . . . . 932 *n.* 3
Winans *v.* Denmead (1853), 15 How. 330. Diversities of shape . . . 238 *n.* 1, 2
Claim for one form of the invention covers all forms . . . . . 514 *n.* 1
Patent construed in view of the nature of the invention . . . . 739 *n.* 3
v. N. Y. & Harlem R. R. Co. (1855), 4 Fisher, 1. Abandoned experiments 80 *n.* 1
Conception without reduction . . . . . 80 *n.* 1
Wing *v.* Anthony (1882), 106 U. S. 142. Re-issue of machine patent cannot cover the process . . . . . 675 *n.* 3
Winternute *v.* Redington (1856), 1 Fisher, 239. Reduction to practice necessary . . . . . 125 *n.* 2
Principle reduced to practice patentable . . . . . 130 *n.* 1
Patent covers all modes of reducing to practice . . . . . 130 *n.* 1
Principle as truth of nature not patentable . . . . . 138 *n.* 1
Principle as idea of means patentable . . . . . 139 *n.* 2
Application of principle patentable . . . . . 143 *n.* 1
Executors not trustees but agents by law . . . . . 801 *n.* 3
Wirth's Patent, *In re* (1879), L. R. 12 Ch. 503. Patent to importer . . 68 *n.* 1
Wise *v.* Allen (1869), 9 Wall. 737. Requisites of notice of prior use . 1004 *n.* 4
Wollensak *v.* Reiher (1885), 115 U. S. 96. Re-issue cannot enlarge a clearly defective Claim after unreasonable delay . . . . . 690 *n.* 2
(1884), 22 Fed. Rep. 651. Duty of patentee to examine his patent and correct narrow Claims at once . . . . . 690 *n.* 2
Wood *v.* M. S. & N. I. R. R. Co. (1868), 2 Bissell, 62. License to use specific machine endures under extension . . . . . 816 *n.* 5
v. Packer (1883), 17 Fed. Rep. 650. Co-operation of elements in combination . . . . . 155 *n.* 1
v. Underhill (1847), 5 How. 1. Sufficiency of Description a question of fact for the jury . . . . . 503 *n.* 2
Court may hold patent void if Description insufficient on its face. 503 *n.* 2
v. Zimmer (1815), 1 Holt N. P. C. 60. Abandonment by sale . . . 359 *n.* 1
Wood-Paper Patent (1873), 23 Wall. 566. Manufacture must be new in itself . . . . . 184 *n.* 1
Woodman *v.* Stimpson (1866), 3 Fisher, 98. Difficulty of distinguishing between inventive and mechanical skill . . . . . 59 *n.* 1
Woodruff, *Ex parte* (1880), 17 O. G. 453. Unnecessary multiplication of Claims . . . . . 521 *n.* 1
Wooster *v.* Blake (1881), 22 O. G. 1132. Discovery an essential element of the inventive act . . . . . 96 *n.* 1

References are to sections.

CASES, EXTRACTS FROM — *continued.*
Wooster *v.* Calhoun (1873), 11 Blatch. 215. Manufacture must be new in itself . . . . . 184 *n.* 1
Worden *v.* Fisher (1882), 11 Fed. Rep. 505. Joint invention by community of mental effort . . . . . 308 *n.* 1
Worswick Mfg. Co. *v.* Steiger (1883), 17 Fed. Rep. 250. Prior use of same complete invention . . . . . 318 *n.* 1
Wyeth *v.* Stone (1840), 1 Story, 273. Temporary use as a favor not public use 356 *n.* 3
Rule of joinder of inventions in the courts . . . . . 470 *n.* 1
Form of Description . . . . . 405 *n.* 1
Yale & Greenleaf Mfg. Co. *v.* North (1867), 3 Fisher, 279. "Combination" defined . . . . . 153 *n.* 1
Yale Lock Mfg. Co. *v.* Scoville Mfg. Co. (1880), 18 Blatch. 248. Re-issue confined to matter attempted to be described and claimed in the original . 603 *n.* 1
Young, *Ex parte* (1895), 33 O. G. 1300. Rule of joinder of inventions in the Patent Office . . . . . 471 *n.* 1
Yuengling *v.* Johnson (1877), 1 Hughes, 607. Judgments in the Patent Office are *prima facie* correct . . . . . 1183 *n.* 2
CATALOGUES as evidence of prior use . . . . . 1020 *n.* 18
CAVEAT 438–448
purpose of 56, 438
nature and effect of 56, 439
when needed 426
who may file 440
inventor of design cannot file . . . . . 440 *n.* 1
form and contents of 441
secrecy of 442
duration of 443
proceedings on, when subsequent application filed 444
cannot be withdrawn 445
amendments to 445
copies of 445
as evidence, as estoppel 446, 1015
does not show whether invention complete or not . . . . . 446, 1020 *n.* 18
not assignable 447
does not bind caveator as to description of the invention 448
belongs to the history, not the description, of an invention . . . . . 489 *n.* 1
CAVEAT EMPTOR applied to assignees 789
licensees 815
CAVEATOR, notice of subsequent applications to 444
entitled to notice only of applications filed during life of caveat 444
patent granted without notice to, invalid against him . . . . . 444, 967 *n.* 4
CESTUI QUE TRUST when plaintiff in equity 1099
CHAMPERTY not upheld in equity . . . . . 1103 *n.* 5
CHANCE PRODUCTION not perceived or capable of reproduction by inventor not a true invention . . . . . 79 *n.* 1
CHARGE of court to jury, requisites of 1074
CHEAPNESS as evidence of inventive skill . . . . . 113 *n.* 2
increase of, not proof of want of identity . . . . . 240 *n.* 1
CHEMICAL PROCESSES, identity of . . . . . 286 *n.* 1, 288 *n.* 1
CHILDREN acting under their parents not infringers . . . . . 920 *n.* 4
CIRCUIT COURT, bound by equity rules of Supreme Court 1129
effect of judgments on subsequent cases 1181
judgments not binding on Supreme Court . . . . . 1180 *n.* 1
CITY suable for infringing acts of its officers, departments, boards, &c. . . . 911
CLAIM 504–539
purpose of 482, 504
requisites of 504
essential to specification 504
patent . . . . . 482 *n.* 1

References are to sections.

CLAIM — *continued.*
cancellation of all, abandons application . . . . . 570 *n.* 1
life of patent and measure of monopoly 505, 972
each in effect an independent patent . . . . . 504 *n.* 2, 985
patentee bound by 651
effect of failure to cover described matter by 362
as an abandonment to the public of matter not claimed 500, 1030
omission of described matter from, not *ipso facto* abandonment 500
sometimes admits it to be old 500
sometimes simply excludes it from the patent 500
withdrawn to avoid rejection or inconsistency with other Claims may be set up on new application . . . . . 501 *n.* 6
contents and scope of, strictly regulated 507
need not cover all inventions of the inventor 508
for entire invention covers the whole invention as described . . . . . 508 *n.* 2
valid for what it claims though not claiming entire invention . . . . . 537 *n.* 1
may be limited to the arrangement described . . . . . 515 *n.* 10
must claim a practically operative means 508
for principle improper . . . . . 509 *n.* 1, 515, 519 *n.* 2
how construed 748
force or natural property improper . . . . . 509 *n.* 1, 515, 519 *n.* 2
function void 518
Claim for arrangement of combination not . . . . . 520 *n.* 2
how construed 748
participial improper . . . . . 518 *n.* 2
for "so forming," "means of doing," "operating of," "imparting motion to," &c., are functional . . . . . 518, 519 *n.* 4
for mechanical process when functional and void . . . . . 518 *n.* 5
may set forth the functions of a properly claimed invention 518
functional construed to cover the means if possible 518
for effect or result void, how construed 519, 748
for all modes of effecting a result void . . . . . 515, 519 *n.* 2
for device of uniform operation improper if the operation is only occasional and accidental . . . . . 508 *n.* 3
for device useful only with things mentioned in the Description is valid . 523 *n.* 2
must be for concrete invention, not an abstraction 509
must be complete within itself, able to stand or fall alone . 510, 510 *n.* 1, 538 *n.* 3
confined to a single and distinct invention 510
cannot cover principal and subordinate inventions 510
a whole and its parts 510
must show the class to which the invention belongs 511
need not state in terms whether the invention is an "art," etc. . . . 511
must precisely define the invention claimed 512
how compared with the invention 643
for each essentially distinct form of the invention necessary . . . 512 *n.* 1
must include all essential features of the invention 512
though narrow may still protect the whole invention 515
must be limited to the actual patentable character of the invention 508 *n.* 3, 515
for specific arrangement of parts covers them only when so arranged 512 *n.* 3
must exclude all non-essential features 512, 515
for new use must exclude the invention used 512
must distinguish the invention used from all former ones 513
between new and old 513
for old matter fatally defective 513
covering old matter curable by disclaimer . . . . . 513 *n.* 2
must set forth the invention in its most perfect concrete form 514
cover all forms of the invention unless they are disclaimed 511
qualities of the invention . . . . . 514 *n.* 4

References are to sections.

CLAIM — *continued.*
must cover all colorable variations . . . . . 514 *n.* 1
modes of making . . . . . 514 *n.* 2
for additional forms of the invention improper . . . . . 514 *n.* 1
cannot embrace subsequent discoveries . . . . . 516 *n.* 5
having the same qualities . 514 *n.* 1
relation of, to Description 515
distinct from Description . . . . . 515 *n.* 1
must be more than a mere reference to the Description . . 515 *n.* 1, 516 *n.* 2
correspond with Description 515
covers all modes of use set forth in the Description . . . . . 523 *n.* 2
based on insufficient Description is void . . . . . 515 *n.* 2
must be for matter properly and sufficiently described . . . . . 508 *n.* 3
confined to matter so described that those skilled in the art could practise it . . . . . 515 *n.* 2
cannot cover matter described as auxiliary 515
for undescribed matter void 515
may cover both the parts and the whole 515
does not cover parts where the Description sets forth only the whole 743 *n.* 3
construed by Description . . . . . 750 *n.* 3
as attempting to cover the whole described invention . . 512 *n.* 1
cannot aid or impair the Description . . . . . 515 *n.* 1
not enlarged by the Description . . . . . 505 *n.* 3, 515 *n.* 1, 523 *n.* 1
controls when inconsistent with Description . . . . . 515 *n.* 1, 523 *n.* 1
contradicting Description, both may be void . . . . . 515 *n.* 1
form of 516
no particular, required 516
must assert not imply . . . . . 516 *n.* 2
various forms of instanced . . . . . 512 *n.* 1–4
not affected by casual misuse of words . . . . . 516 *n.* 2
ungrammatical valid 516
must clearly define the invention, ambiguity fatal 516
ambiguity in, how shown 1037
a question for the court 1037
no useless or equivocal words or unnecessary synonymes in 516
not to use the word "equivalent" 516
when the words "means," "mechanism," "connections," may be used in 516 *n.* 2, 4
technical phrases in 517
"as specified" . . . . . 517 *n.* 3
"in the manner . . . mentioned" defined . . . . . 517 *n.* 2
"substantially as described" defined 517
"substantially as and for the purpose set forth" defined 517
alternative improper when 520
use of disjunctive conjunction in 520
multiplication of, improper when 521
needless repetition creates ambiguity 521
not like counts in a declaration but conclusions from the Description . . 521
for same invention in different aspects or uses allowable 521
inseparable part of matter covered by another Claim . 521 *n.* 3, 522 *n.* 1
joinder of, for different inventions 522
construed by the court as matter of law . . . . . 503 *n.* 1, 732 *n.* 2
must stand or fall as a whole . . . . . 516 *n.* 1, 538 *n.* 3
all parts of the application considered 523
not interpreted to cover the same matter as another Claim . . . 521 *n.* 3
not aided by construction when defective . . . . . 505 *n.* 1
not enlarged by construction when too narrow . . . . . 737 *n.* 3, 738, 743
not expanded by omitting one part formerly claimed . . . . . 670 *n.* 2
void if incurably defective 537, 972

References are to sections.

CLAIM — *continued.*
void, when defects avoid it 537
may be disclaimed when void unless delay is unreasonable 537 *n.* 4, 642 *n.* 1
patentee can recover on, though no disclaimer is filed, if the patent has nearly expired . . . . . 661 *n.* 2
valid not affected by void 537, 672
good when void disclaimed 650
correct, duty of Patent Office to secure 538
examiner not obliged to suggest proper 559
when rejected, appeal or bill in equity, not re-issue, is the remedy . . 689 *n.* 7
proposal by applicant to limit not binding on him unless accepted by Commissioner . . . . . 689 *n.* 4
as allowed by the Patent Office determines the scope of the patented invention 538
sustained by courts though improperly allowed by the Patent Office . . 538 *n.* 2
and Description how written 539
excessive as compared with the actual invention is void . . . . . 537 *n.* 2
if wilful is a fraud on the public and avoids the patent 642, 671
presumption against from the issue of the patent 646
is a mixed question of law and fact 1036
ascertainment of excess 643
when claiming features discarded in practice . . . . . 643 *n.* 2
what a foreign patent to the same patentee formally disclaims 643
effects of, on patent 640, 642
a bar to recovery for infringement 651
not a defence unless disclaimer unreasonably delayed 651
with fraudulent intent, effect of 644
burden of proof as to fraud in . . . . . 644 *n.* 1
when curable and when void 643
cannot be cured by the courts . . . . . 642 *n.* 1
amendment of 971
necessary whenever defect discovered 642
causes no public injury 641
not allowed unless as amended it would cover a patentable invention 645
part may be useful though not distinguishable . . . . . 645 *n.* 1
allowed only when excess inserted by inadvertence, accident, or mistake, and without fraud 644, 658
by disclaimer . . . . . 537 *n.* 3, 640
delay in, effect of 646
for combination, requisites of 524, 525
for elements does not cover the combination 524
must separate the new and old 525
concedes all unclaimed matters to be old . . . . . 525 *n.* 2
confined to its essential elements . . . . . 525 *n.* 4
having certain motion covers only the means by which the motion is produced . . . . . 525 *n.* 1
stating parts not entering into it should disclaim them 525
not to embrace *connecting mechanism* 525
must be limited to the arrangement of old devices by which the combination is produced 525
of old elements confined to the exact combination . . . . . 525 *n.* 1
alternative, when valid . . . . . 525 *n.* 1
stated in any intelligible form 526
sufficient if claiming such a union of the elements as will produce a given effect 526
must embrace enough to produce a result though it be not the result aimed at . . . . . 526 *n.* 1
void if combination inoperative . . . . . 526 *n.* 1

References are to sections.

CLAIM — *continued.*
for combination, "substantially as described" in 520
"means," "mechanism," etc., in . . . . . 520 *n.* 2
"or other part" in . . . . . 520 *n.* 3
covers only the combination claimed 527
exact combination . . . . . 527 *n.* 2
of old elements, does not protect any combination in which one element is new . . . . . 527 *n.* 2
such as will produce a given result covers only the combination described 527 *n.* 2
limited to the specific arrangement named . . . . . 527 *n.* 2
covers neither the elements, subcombinations, nor the co-operative law . 527
makes essential all included elements 527
covers devices described as only useful in the combination . . . 527 *n.* 3
excludes from it all omitted elements 527
joined with Claims for elements and subcombinations when 528
cannot be joined with Claims for different combinations of the same elements . . . . . 528 *n.* 2
for an art, requisites of 529
proper when the effect is produced by a new use of natural forces . 529 *n.* 3
chemical action . . . . . 529 *n.* 3
improper if the real invention is the apparatus used . . . . . 511 *n.* 3
where the Description sets forth a machine 529
when the process is merely mechanical . . . . 529 *n.* 1, 530 *n.* 3
when applied to all substances known or unknown . . . 529 *n.* 4
joined with Claims for sub-processes when 529
does not cover sub-processes or the materials used . . . . . 529 *n.* 6
the product . . . . . 529 *n.* 5
if made in another manner 531
covers all ways of practising the art 529
cannot also claim the product . . . . . 529 *n.* 5
in combination covers only that combination 529
for a machine, its requisites 530
improper where Description sets forth an art 529
must not claim a "principle," a "mode of action," or an "idea" . 530 *n.* 1
as "a means of doing" improper . . . . . 530 *n.* 1
must not claim its function 530
joined with Claims for its subordinate parts 530
requisites of Claim for parts of a machine . . . . . 530 *n.* 2
Claim for parts of a machine in connection with the other parts covers them only in that connection . . . . . 530 *n.* 2
having certain capabilities covers it only when it has them . . . 530 *n.* 2
several, for a machine accomplishing several purposes, proper . . 530 *n.* 4
for a manufacture, its requisites 531
covers it only as described 531
not to set forth the process . . . . . 531 *n.* 1
as an "attachment" covers it, to whatever it is attached . . . . 514 *n.* 1
may claim it as the result of a certain process . . . . . 531 *n.* 3
resulting from the use of certain substances does not cover it when resulting from the use of substances afterward discovered 531
joinder of with Claim for means of making it 531
for a composition, its requisites 532
of chemical ingredients covers only equivalents . . . . . 514 *n.* 1
joinder of with Claim for less than all the ingredients 532
for a design, its requisites 533
joinder of 533
for an improvement, its requisites 534
must distinguish new and old 534
Claim for group of improvements void if any are old 534

References are to sections.

CLAIM — *continued.*
for the whole invention "as improved" when void 534
construction of 534
joinder of 534
for a generic invention, its scope 535
does not cover functions or effects . . . . . 535 *n.* 2, 536 *n.* 1
when required 536
requires generic Description 536
for a specific invention, when required 536
joinder of with Claim for generic invention . . . . . 471 *n.* 4, 536
(See also ABANDONMENT, ACTION AT LAW, AMBIGUITY, AMENDMENT, APPLICATION FOR PATENT, ART, COMBINATION, COMPOSITION, CONSTRUCTION, DEFENCES, DESCRIPTION, DESIGN, DISCLAIMER, ELEMENTS, ESTOPPEL, FUNCTION, GENERIC INVENTION, IDENTITY, IMPROVEMENT, INFRINGEMENT, INTERFERENCES, INVENTION, JOINDER OF INVENTIONS, LETTERS-PATENT, MACHINE, MANUFACTURE, NEW MATTER, PATENT, PATENT OFFICE, PATENTEE, RE-ISSUE, SPECIFICATION, SUBCOMBINATIONS.)

CLASS OF OBJECTS, Description of, improper unless each object will answer the purpose . . . . . 496 *n.* 1; 497 *n.* 2; 500 *n.* 1

CLERICAL ERRORS in letters-patent 637–639
(See LETTERS-PATENT.)

CLOUD on title of true inventor, unlawful rival patent is 426
assignee removable in equity 1228

CO-GRANTEES, rights and obligations 799

COLLOCATION of elements not combination . . . . . 154 *n.* 1

COLLUSIVE suit, what is . . . . . 1182 *n.* 3
not allowed . . . . . 1103, 1222 *n.* 4
decree in, annulled by court 1103, 1222

COMBINATION defined . . . . . 153, 156 *n.* 2, 277
essential qualities of 277, 281
an entirety . . . . . 155 *n.* 2
essence and existence depend on what . . . . . 155 *n.* 2
a new means, essentially distinct from its elements 155
belongs to the same class of inventions as its elements . . . . . 156 *n.* 2
when a new invention . . . . . 282 *n.* 2
not patentable unless the result of inventive skill . . . . . 156 *n.* 2
nature of inventive act in . . . . . 155 *n.* 3
not an aggregation, its difference 154
and aggregation distinguished by nature of results 156
must produce new result . . . . . 156 *n.* 1
producing new result must be new 156
general resumé of doctrine and rules of . . . . . 156 *n.* 2
elements of, defined 278
how related to its elements 155
a distinct unit from any of its elements 153, 155
a separate invention from its elements . . . . . 155, 465 *n.* 2
elements may be new or old . . . . . 155, 156 *n.* 2
of previously patented elements is patentable 465
of old elements when an invention 155
not formed by co-operation of machine and product . . . . . 176 *n.* 1
identity of elements . . . . . 278, 279 *n.* 1
co-operative law defined 280
elements may co-act successively or simultaneously 155
on each other or the common object . . . . 155 *n.* 1
variations in co-operative law, instances and application of the rule 282 *n.* 2
inventor not obliged to understand the scientific causes of the co-operation of the elements 526
subcombinations, relations of to the principal combination . . . . . 670 *n.* 2

References are to sections.

COMBINATION — *continued.*
relation of two or more to each other . . . . . 282 *n.* 2
comparison of actual 282
patented . . . . . 278 *n.* 1
identity of 277–282, 922
is identity of elements and co-operative law . . . . . 156 *n.* 2
identity of elements alone is not . . . . . 282 *n.* 2
use of new element in, makes a new . . . . . 282 *n.* 1
equivalents in . . . . . 279 *n.* 1, 282 *n.* 1
combination of equivalents is the same combination . . . . 282 *n.* 1
governed by peculiar rules 254
rules the same whether the elements are old or new . . . 254 *n.* 1
chemical and mechanical, rules of . . . . . 193 *n.* 1
variation of elements, instances and application of the rule . . . 282 *n.* 1
diversities of shape . . . . . 238 *n.* 2
proportions . . . . . 241 *n.* 1
arrangement . . . . . 242 *n.* 1
use . . . . . 207, 268, 282 *n.* 2
identity of subcombinations 279
improvements in 217
how effected . . . . . 311 *n.* 1
by changing elements or mode of co-operation . . . . . 217 *n.* 2
substantial change in elements is not a mere improvement . . 217 *n.* 2
Description of, in patent 496
Claim for 524, 525
does not cover its elements . . . . . 465 *n.* 2
cannot cover elements already patented 462
elements not claimed are regarded as old 923
claimed thereby become essential . . . . . 278 *n.* 1, 922 *n.* 1
not withdrawn by disclaimer . . . . 643 *n.* 2, 645 *n.* 1
not declared unessential by the courts . . . . 922 *n.* 1
regarded as material by the inventor so held against his transferees . . . . . 922 *n.* 1
covers the exact union of the exact elements . . . . . 156 *n.* 2
joinder of subcombinations and elements 472
what acts infringe . . . . . 282 *n.* 2, 922
use of less than all elements not . . . . . 282 *n.* 1, 922
defences must apply to entire combination . . . . . 1026 *n.* 3
anticipated when . . . . . 282 *n.* 2
not by prior use of elements . . . . . 318 *n.* 1
of arts, identity of 287, 288
of old arts is a new art . . . . . 168 *n.* 1
omission of essential steps makes a new art . . . . . 170 *n.* 1
alteration in essential steps makes a new art . . . . . 170 *n.* 1
machines, how distinguished from combinations of manufactures 185
identity of 291, 292
introduction of new elements an essential change in . . . . 179 *n.* 1
manufactures, identity of 298, 299
how affected by changes of elements 189
result a test 185
ingredients, identity of 195
old designs, patentable when 205

(See also AGGREGATION, ART, CLAIM, COMPOSITION, DESCRIPTION, DESIGN, DISCLAIMER, DOUBLE USE, ELEMENTS, EQUIVALENTS, IDENTITY, IMPROVEMENT, INFRINGEMENT, JOINDER OF INVENTIONS, MACHINE, MANUFACTURE, PATENT, PATENT OFFICE, RE-ISSUE, SUBCOMBINATIONS, SUB-PROCESS, UNITY OF INVENTIONS, USE.)

COMMISSION, infringing vendor selling on, liable for profits 1151
(See also INFRINGEMENT.)

References are to sections.

COMMISSIONER OF PATENTS, powers and duties of 51, 424
Secretary has authority over 424
cannot revise his judgments of priority . . . . . 604 *n.* 3
examiners, were agents of before 1861 . . . . . 51 *n.* 4
and examiners-in-chief related to him as one court to another 604 *n.* 2
power to make rules for Patent Office 422
of evidence for cases pending in the Patent Office . . . 601
cannot control the persons of witnesses . . . . . 601 *n.* 1
to determine necessity for and sufficiency of the drawings, model, specimens, &c. 540
decides petitions, motions, and appeals, on matters of form . . . 566 *n.* 1
on appeal as to matter of form 567
to act judicially . . . . . 51 *n.* 3
on appeal from examiner-in-chief 572
jurisdiction of, how far final 714
decision, on a question of law never final . . . . . 617 *n.* 3
courts may always review . . . . 907 *n.* 4
within his jurisdiction is final . . . . . 1032 *n.* 2
on sufficiency of formal requisites final . . . . . 451 *n.* 5
that delay in application was unavoidable is final 578
on appeal refusing to dissolve interference is binding till reversed 608 *n.* 1
on application for extension is final . . . . . 907 *n.* 6
binds his successor unless new facts are offered 572
that invention is abandoned to the public by abandonment of application is not final 578
on abandonment or other matter of defence in the courts never final . . . . . 353 *n.* 3; 617 *n.* 3
decision that re-issue applicant in good faith and the re-issue free from fraud, how far final . . . . . 686 *n.* 1
may withhold patent when 583
as his judgment dictates . . . . . 51 *n.* 3
must notice an objection to patentability however it may be brought to his notice . . . . . 569 *n.* 1; 610 *n.* 3
mandamus to issue patent lies when 583
suable only in District of Columbia . . . . . 571 *n.* 1
(See also APPEALS, APPLICATION FOR PATENT, EXAMINERS, EXTENSION, INJUNCTIONS, INTERFERENCES, JUDGMENTS, MANDAMUS, PATENT OFFICE, REHEARING, RE-ISSUES, SECRETARY.)

COMMON CARRIER, licensed to carry on business with one person may be compelled to deal with all . . . . . 806 *n.* 3
infringement by 918
(See also INFRINGEMENT, INJUNCTION.)

COMPLETENESS in Description defined 491

COMPOSITION, defined 192
essential attributes of 195
a true combination 193
distinct from its elements and mode of intermixture 194
relation to other combinations 300-304
character of, how determined 194
analysis of 301
intermixture of ingredients in 192
no special substance or mode of intermixture essential to 194
a unit, its unity how destroyed 196
identity of, how determined 195, 300-304
possessing same properties not necessarily identical 195
depends on identity of ingredients, of combination, and of properties . . 195
lost by addition or omission of ingredients . . . . . 196 *n.* 2
not affected by changes in shape, materials, &c. . . . . 195 *n.* 3; 238 *n.* 2
changes of proportions in, when destructive to . . . . . 241 *n.* 1

References are to sections.

COMPOSITION — *continued.*
identical, however produced 197
though made in a new way . . . . . 197 *n.* 1
natural and now made artificially 197
equivalents in . . . . . 193 *n.* 1, 302
governed by special rule . . . . . 254 *n.* 1
improvement in, how made 196
removal of defects in, is . . . . . 196 *n.* 2
reducible to practice in many forms, all covered by patent 199
not patentable until reduced to practice 198
Description of, in patent 500
Claim for 532
covers only equivalent ingredients . . . . . 514 *n.* 1
requires neither model or drawing 540
joinder of, with ingredients, process, or apparatus 476
infringement of patent for, what acts are 928
(See also APPLICATION FOR PATENT, CLAIM, COMBINATION, DESCRIPTION, EQUIVALENTS, IDENTITY, INFRINGEMENT, INGREDIENT, JOINDER, PROPORTIONS.)

CONCEIVER, not reducer, the true inventor . . . . . 375 *n.* 1
earliest, may be later reducer and *vice versa* 373
(See also CONCEPTION, DATE, DELAY, DILIGENCE, INTERFERENCES, INVENTION, INVENTOR, PATENT, PRIORITY, RACE OF DILIGENCE, REDUCER, RIVAL INVENTORS.)

CONCEPTION of an invention 376–382
defined 370
not reduced to practice not an invention . . . . . 375 *n.* 2
how differs from embodied conception . . . . . 87 *n.* 2
generates an idea of means 377
suggestion of an end to be served is not . . . . . 80 *n.* 2
generates an idea of practically operative means 378
ready for communication to the public 379
complete when ready for reduction 379
necessarily complete before reduction . . . . . 80 *n.* 1
experiment is not . . . . . 379 *n.* 1
date of is the date of complete conception 380
may be shown on the question of priority . . . . . 334 *n.* 2
may be contemporaneous with or precede reduction when 381
resulting from experiments, date of 381
of foreign invention, date of in the United States 382
joint invention, date of 400
prior, the test of priority between two who united in reducing . . . . 600 *n.* 4
how proved 380
(See also CONCEIVER and titles there cited; DISCOVERY, EMBODIMENT, END, FOREIGN INVENTIONS, IDEA, INVENTOR'S ACT, JOINT INVENTION, REDUCTION TO PRACTICE.)

CONFUSION OF ACCOUNTS is not confusion of goods and evidence must separate the infringing and non-infringing . . . . 1156 *n.* 2
GOODS, doctrine of not applied to confusion of accounts 1150 *n.* 3

CONGRESS has no power to grant patents except to inventors 363
power of, over patents to inventors unrestricted 46
to create patent privilege by retrospective acts . . . . . 46 *n.* 2
special acts 46

CONSIDERATION expressed in assignment not conclusive . . . . . 1229 *n.* 3
of assignment fails if assignee gets no title, and money paid recoverable 1229, 1238
assignment of invalid patent not 1230, 1239
failure of a defence to licensee when sued for license fees for use of invention 1251

References are to sections.

CONSTRUCTION, as part of the inventive act, defined 99
how evidenced 100
of letters-patent 731–761
measures the monopoly 410, 731, 1019
by court for jury not necessary in actions on contracts unless requested 732 *n.* 2
as matter of law 410, 732
advantages of 733
given by one court usually followed in others . . . . . 1170 *n.* 1, 1181
parol evidence where admissible in 732
expert evidence may aid in 1014, 1019
by Supreme Court is final . . . . . 733 *n.* 2
consists in applying words to subject-matter . . . . . 730 *n.* 3
governed by general and special rules 734
liberal in favor of patentee 735
to support intention of parties . . . . . 736 *n.* 4
where considered liberal 730
cannot depart from or cure defects in language 737
must tend to clear definition of invention 738
not alternative 738
to render Claim elastic or ambiguous 738
enlarge Claims . . . . . 737 *n.* 3
to be consistent with real nature of invention if possible 739
actual character of the invention may be shown 739
name given to invention how construed . . . . . 742 *n.* 4
should be the same that persons skilled in the art would give . . . 736 *n.* 1
adopted by patentee sustained if possible . . . . . 739 *n.* 3, 741 *n.* 1
general words limited by nature of invention . . . . . 743 *n.* 2
nature of invention shown by state of art at date of its creation . . 740
by proceedings in Patent Office 741
entire patent construed together 742
Description construed with other parts of specification 489
Claims govern when clear 742
Description if ambiguous . . . . . 743 *n.* 3
process not inferred by court from Description of the product 743 *n.* 3
explained or restricted, but not enlarged, by other parts of the patent or extrinsic evidence 743
construed by other parts of application 523
aid of parol evidence when 1037
so as not to render other Claims meaningless . . . . . 742 *n.* 5
so as not to make two Claims identical . . . . . 742 *n.* 5
so as not to divide entirety Claims or consolidate separate Claims 749
two patents or Claims not construed as one . . . . . 749 *n.* 3
for *combinations, improvements, joint inventions, etc.* 747
make all claimed elements material . . . . . 747 *n.* 1
for principle, function, effect 748
on questions of joinder always liberal . . . . . 746 *n.* 1
by the drawings and model 742
later not construed to cover earlier if avoidable . . . . . 461 *n.* 1
arrangement of words unimportant 744
words mean what the applicant intended by them 744
vary in meaning with context and subject-matter 744
have their usual meaning till the contrary appears 744
take the meaning they had at the date of the invention 744
general limited, and special extended, when necessary 744
interpreted by correspondence with Patent Office 741, 744
ambiguous rejected as surplusage 744
general rules of, how applied in practice 745
pioneer patent broadly construed 746
re-issue construed by original 746

References are to sections.

CONSTRUCTION — *continued.*
of letters-patent, where granted or confirmed by special act of Congress . . 746
foreign phrases, "substantially as described," "generic" 750
"specification," "manufacture" 750
special words how interpreted 751
terms of degrees, "in any convenient manner," "suitable materials," "making," "selling," "use," "jointly" 751
by acquiescence . . . . . 741 *n.* 3, 4
requires more than a year . . . . . 1180 *n.* 5, 1199 *n.* 2
(See also AMBIGUITY, CLAIM, DESCRIPTION, DISCLAIMER, DRAWINGS, INJUNCTIONS, LETTERS-PATENT, PATENT, RE-ISSUES, SUPREME COURT.)
CONTEMPT OF COURT a criminal offence 1219
no appeal from judgment of . . . . . 1219 *n.* 9
(See also INJUNCTIONS.)
CONTRACT, patent, a 481
theory of patent introduced in 1800 A. D. 15
under American law 20
of inventor and public set forth in the specification 481
concerning patents, State power over . . . . . 40 *n.* 4
rights of inventor and his transferees protected by law 849, 850, 851
relations of parties interested in patented inventions governed by the ordinary law of contracts 1224
cannot vary the existence or scope of the monopoly 804
binding on all parties though signed only by one representing the rest 768 *n.* 2, 1228 *n.* 3
rights arising under assignments or grants 850, 1227
to sell the invention, and all patents present or future, carries existing foreign patents and future domestic ones . . . . . 778 *n.* 2
to assign on a future contingency gives complete right when contingency happens . . . . . 769 *n.* 6
to sell letters-patent not recordable 785
for sale of invention before patent not a contract for goods under the Statute of Frauds . . . . . 768 *n.* 2
to assign, though oral, passes equitable title . . . . . 768 *n.* 2
and allow assignee to take patent in his own name may be oral . . 768 *n.* 2
to hold patent in trust for another may be oral . . . . . 768 *n.* 2
to assign, gives promisee power to license . . . . . 768 *n.* 2
specifically enforced when . . . . . 768 *n.* 2, 769 *n.* 6, 1228
when enforced against assignee 1234
protected by injunction where specific performance impossible . 786 *n.* 3, 1228
extension, when enforceable in equity 770
not interpreted in equity unless trust relations exist . . . . . 1228 *n.* 4
future inventions not a true assignment 771
specifically enforced 771
to sell a patented invention is not an assignment but may be enforced in equity, and meanwhile may operate as a license 768
rights arising under licenses 851
implied can be specifically enforced . . . . . 1244 *n.* 1
rescinded in equity if vendee fails to fulfil . . . . . 779 *n.* 9
in a suit on, the court need not construe the patent for the jury unless so requested . . . . . 732 *n.* 2
(See also ADMINISTRATOR, AGREEMENT, ASSIGNEE, ASSIGNMENT, ASSIGNOR, CONSIDERATION, CONTRACTOR, CO-OWNERS, EMPLOYEE, EMPLOYER, EQUITABLE INTERESTS, EXECUTORS, EXTENSION, LICENSES, LICENSEE, LICENSOR, MONEY PAID, NOTES, PARTNERS, PURCHASE MONEY, RECORD, RESCISSION, ROYALTIES, SALES, SPECIFIC PERFORMANCE, STATES OF UNION, TITLE, TRANSFER.)
CONTRACTOR, infringing, is liable if his employer is not . . . . . 911 *n.* 5
infringement by, public interest does not warrant 919

Reference are to sections.

CONTRACTOR — *continued.*
injunction against refused where public interest demands . . . . . 919 *n.* 2
for public corporation, when liable for infringement 911
(See also INFRINGEMENT, INJUNCTION.)
CO-OPERATING INVENTORS 392–395
defined 366, 392
conceivers of separable and united ideas are 395
inseparable ideas are not 394
suggestors as to mode of reduction are not 393
CO-OPERATIVE LAW defined 280
CO-OWNERS of letters-patent 795–799
may be any number of . . . . . 795 *n.* 1
how co-ownership created 795
relations between 795
not co-partners 795
have distinct interests in the invention 795
monopoly resides indivisible in all 796
each controls his own right, and can grant or license under it 795 *n.* 3, 795 *n.* 1, 796
license or assignment by one is good against all . . . . . 796 *n.* 1
not accountable to each other for use of invention . . . . . 796 *n.* 1
reciprocal rights and duties of 796
rights of against each other 1253
may subdivide the patent at pleasure . . . . . 798 *n.* 1
liability to account to each other for profits 796
barred by estoppel against a co-owner, who has already assigned an invalid patent for the same invention, and must look to him for recompense . 787 *n.* 2
issue of patent to one enures to benefit of all . . . . . 795 *n.* 1
not estopped to deny validity as against each other . . . . . 707 *n.* 1, 1254
when plaintiffs in equity . . . . . 1098 *n.* 7
damages recovered by, how distributed 798
when liable for infringement 797, 1253
measure of liability 913
when co-ownership a defence, evidence of 1044
partnership contracts between, obligations of 1254
void if patent invalid, when 1254
entitled to share of license fees on licenses granted by co-owners who are partners 1254
entitled to share in proceeds of transfer when . . . . . 798 *n.* 1
agreement of to account, not within the Statute of Frauds . . . . . 798 *n.* 1
effect of . . . . . 798 *n.* 1
when estopped from asserting their separate titles against each other . . . 1253
contracts between, rights as to third parties 798
implied contracts between 1253
(See also ACTION IN EQUITY, ACTION AT LAW, ASSIGNMENT, CO-GRANTEES, DISCLAIMER, ESTOPPEL, INFRINGEMENT, JOINT-PATENTEES, PARTNERS, PLAINTIFFS, RE-ISSUES.)
COPIES of patents, etc., as evidence 1015
of recorded patents how made, as evidence, etc. 627
of specifications only do not show that the invention was patented . . 1027 *n.* 5
from Patent Office, errors in how corrected . . . . . 627 *n.* 4
prima facie evidence that originals are genuine 1040
(See also ACTION AT LAW, APPLICATION FOR PATENT, ASSIGNMENT, EVIDENCE, FILE-WRAPPER, RECORD.)
COPYRIGHT compared with patent privilege . . . . . 26 *n.* 1
CORRECTNESS OF DESCRIPTION, defined 490
CORPORATION may be assignee of letters-patent 767
notice to stockholder not notice to . . . . . 786 *n.* 4
infringement by 911, 912

References are to sections.

CORPORATION — *continued.*
infringement by, not liable for profits of its predecessor in the enterprise 1153
whether its officers and stockholders liable for 912
officers and stockholders may be enjoined 912
retiring officers estopped from suing for infringements committed under their management . . . . . 981 *n.* 6
may sue where 934
in the district where its rights are violated though it is created by another State . . . . . 934 *n.* 1
local jurisdiction over domestic and foreign 935, 936
service of process on 935, 936
want of due organization or corporate capacity pleadable in abatement 956 *n.* 1
not a defence . . . 975 *n.* 1
must sue in equity in its own name 1101
when defendant in equity 1104
sued where in equity 1096
discovery by, not under oath 1107
(See ACTION IN EQUITY, ACTION AT LAW, DEFENDANT, INFRINGEMENT, INJUNCTION, JURISDICTION, PLAINTIFF, STATES OF THE UNION, STOCKHOLDERS.)

COSTS in actions at law, items allowable 1080
effect of disclaimer on 651, 1080
allowed though only nominal damages given 1080
in equity, rules governing allowance of 1162
(See also ACTION IN EQUITY, ACTION AT LAW, COUNSEL FEES, DISCLAIMER, DOCKET FEES, EXPENSES OF SUIT.)

COUNSEL FEES not allowed as damages at law 1067
may be covered by an increase of damages by the court 1067
not profits 1152
(See also COSTS, and titles there cited, DAMAGES.)

COUNTY, whether liable for infringement . . . . . 911 *n.* 4

COURTS, recent decisions subversive of patent privilege . . . . . 50 *n.* 2
power to repeal letters-patent 418
trial at law by, without jury 1077
questions of law for 1075
to interpret the patent 732
may refuse to receive evidence to aid in 1014
to decide sufficiency of Claim as matter of law . . . . . 503 *n.* 1
ambiguity of Claim usually a question for 1037
take judicial notice of want of inventive skill when 1022
may declare patent void if Description insufficient on its face 503

COURT OF CLAIMS, jurisdiction of 1258
sole jurisdiction over suits against the United States for the unauthorized use of the patented invention . . . . . 910 *n.* 5
no jurisdiction of infringement suits . . . . . 1258 *n.* 2
measure of damages against United States in cases in . . . . . 1258 *n.* 3
statute of limitations a defence in . . . . . 1258 *n.* 3
(See also EMINENT DOMAIN, INFRINGEMENT.)

COURTS, Federal and State, citizenship immaterial where subject-matter determines jurisdiction . . . . . 855 *n.* 2
jurisdiction of in patent cases 853, 854–866
Federal, have only the jurisdiction conferred by statute 854
jurisdiction where parties are citizens of different States 854
exclusive jurisdiction over all cases arising under the Patent Law . 855
jurisdiction conferred on in patent cases to secure uniformity . . . 855 *n.* 2
not affected by State laws . . . . . 861 *n.* 1
over patent cases not affected by amount involved . . . . . 855 *n.* 2
patent cases are cases affecting the existence or preservation of the monopoly 856

Referenced are to sections.

COURTS—*continued.*
cases affecting merely the invention or contract rights are not patent cases 856
cases attacking or defending the patent collaterally are not patent cases . . . . . 856 *n.* 1
cases of contract or tort to the patented article are not patent cases . 804
bill to subject a patent to execution is not a patent case . . . . 856 *n.* 2
cases involving the existence, validity or scope of the patent or the title of the patentee are patent cases 857
case involving the scope of an assignment is a patent case . . . 857 *n.* 1
cases not patent cases unless they put in issue and decide between the parties the existence, validity, or scope of the patent or the title of the patentee 858
controversies collateral to cases not involving the existence, validity, or scope of the monopoly or the title of the patentee are not patent cases 858
cases to annul interfering patents are patent cases 860
cases to repeal patents are patent cases 859
patent cases may collaterally involve questions of contract, etc. . . 862
cases of infringement are patent cases . . . . . 857 *n.* 1, 861
between licensor and licensee are patent cases 861 *n.* 1, 862
jurisdiction once acquired, complete relief given 862
where royalties and infringement both in issue . . 862 *n.* 4
not affected by consent of parties 863
vested in Circuit courts 866
question of always considered by court . . . . . 866 *n.* 3
sustained by Supreme Court though on narrow grounds if not excepted to at outset . . . . . 855 *n.* 2
will remand cases erroneously brought from State courts . . . . . 860 *n.* 3
State, have jurisdiction whenever the statutes do not give exclusive jurisdiction to the Federal courts 854
have no jurisdiction over patent cases 855
though parties consent 863
though parties able to testify under State laws . . . . 863 *n.* 1
may punish for contempt for interfering with a receiver by infringing on his rights . . . . . 865 *n.* 3
may entertain cases arising out of contract or tort to the patented article though the existence, validity or scope of the patent or the title to the patentee are collaterally involved 865
have jurisdiction over actions of slander or libel against the patented invention 889
cannot enjoin a suit for infringement in the Federal courts . . . . 861 *n.* 1
decisions of, cannot affect questions under the Patent Law when raised in the Federal courts . . . . . 861 *n.* 1
(See also ACTION IN EQUITY, ACTION AT LAW, ASSIGNMENT, CIRCUIT COURTS, CONSTRUCTION, CONTRACTS, CONTEMPT, CREDITOR'S BILL, EQUITY JURISDICTION, FEDERAL COURTS, INFRINGEMENT, JUDGMENTS, JURISDICTION, LICENSES, PROBATE COURT, REPEAL, RESCISSION, ROYALTIES, SPECIFIC PERFORMANCE, STATE COURTS, SUPREME COURT, UNITED STATES, UNPATENTED INVENTION, WARRANTY.)

CREDITOR'S RIGHTS how enforced against a patented invention . . . 766, 805

CREDITOR'S BILL to subject patents to payment of debts 805
cannot reach unpatented inventions or experiments . . . . . 805 *n.* 1
within jurisdiction of State courts . . . . . 856 *n.* 2
want of novelty or utility no defence to . . . . . 805 *n.* 1
(See also ASSIGNMENT, BANKRUPTCY, INSOLVENT, JUDICIAL SALE, RECEIVER, TRUSTEE.)

References are to sections.

CROSS BILLS, in equity, requisites of, procedure on 1121
bill claiming set-off not . . . . . 1121 *n.* 2
(See also ACTION IN EQUITY.)
CUSTOM HOUSE AGENTS, acts not infringements . . . . . 918 *n.* 1

DAMAGES in actions at law 1049-1071
implied from infringement 953
at law and recovery in equity distinguished 1050
not synonymous with profits . . . . . 1130 *n.* 1
and profits, liberality in doctrine of under American law 21
assessed irrespective of character and financial condition of parties . . 1052 *n.* 2
remote and consequential not allowable . . . . . 1053 *n.* 3
not punitive if defendant acts in good faith under later patent . . . 1041 *n.* 18
nominal, when awarded 1068
implied from infringement 1052
only, unless actual proved . . . . . 1068 *n.* 1, 2, 1071 *n.* 1
when plaintiff acts fraudulently . . . . . 1073 *n.* 1
where patent partly infringed, or for mere making, or defendant misled by plaintiff . . . . . 1068 *n.* 1, 2
unless articles stamped or defendant knew he was infringing . . . 628
payment of raises no future license . . . . . 1065 *n.* 2
amount of . . . . . 1052 *n.* 3
actual, how measured and proved 1053
not sustained by plaintiff who takes no advantage of the invention . . 1054
must be proved . . . . . 953 *n.* 2
burden of proof rests on plaintiff 1071
plaintiff's evidence liberally construed, when 1071
license fee, when the measure of . . . . . 1055 *n.* 1, 1056-1059
not unliquidated if license fee exists . . . . . 1059 *n.* 1
where plaintiff preserves close monopoly 1060-1064
uses the invention and sells the product 1061, 1062
makes and sells the invention itself 1061, 1063
through loss of sales, reduction of prices, goods made and not sold 1061, 1062
through disparagement of plaintiff's invention from defendant's publications . . . . . 1061 *n.* 2
confined to use of plaintiff's exact invention 1062
measured by duration of use after patent granted . . . . . 1062 *n.* 8
where the infringement varies in character from the mode in which the plaintiff enjoys his monopoly 1064
from sales where the plaintiff uses in his own business only 1064
use where the plaintiff makes and sells 1064
for making only, not measured by the profit of selling . . . . 1062 *n.* 14
not measured by amount of injunction bond . . . . . 1062 *n.* 14
lessened by payment for use shown by receipts, etc. . . . . 1062 *n.* 15
defendant's profits, when a guide to 1062
measured by profits on sales, when 1063
value of infringement at date of infringement . . . 1062 *n.* 8
from infringement of improvement, how measured . . . . . 1062 *n.* 7
of patent hotel register how measured . . . . . 1061 *n.* 2
by co-owner, measure of 913
not awarded unless invention of some utility . . . . . 1062 *n.* 15
recoverable by licensor against licensee in action for breach of contract are measured by same rule as if suit was for infringement 1250
for infringement of original and improvement owned by same party must be sought in same suit . . . . . 955 *n.* 2
payment of for infringing sale gives vendee a right to use, when . . . 1065
interest on, when allowed 1066
treble in discretion of court . . . . . 953 *n.* 3

References are to sections.

DAMAGES — *continued.*
actual, increase of, by court 1069
where defendant's gain exceeds plaintiff's loss . . . . . 1091 *n.* 6
to cover counsel fees 1067
cannot be decreased by the court . . . . . 1069 *n.* 5
excessive when . . . . . 1068 *n.* 4
cannot exceed amount claimed in declaration . . . . . 953 *n.* 2
verdict for set aside, when 1068, 1076, 1078
curable by *remittitur*, when 1068, 1078
recovered by co-owners, executors, etc. 1070
distribution of, among joint plaintiffs 1070
in equity, history of right to, rule of, interest on 1154
awarded in suit for injunction . . . . . 1088 *n.* 1
averment of, in bill in equity 1106
may be increased by the court 1154
(See also ACTION IN EQUITY, ACTION AT LAW, ASSIGNEE, ASSIGNMENT, ASSUMPSIT, BURDEN OF PROOF, CONTRACT, COUNSEL FEES, COURTS, EQUITY JURISDICTION, EVIDENCE, EXPENSES OF SUIT, INFRINGEMENT, INTEREST, JURY, LICENSE, LICENSEE, MASTER, NEW TRIALS, PROFITS, RELEASE, STAMPING, VERDICT, WARRANTY.)

DATE OF CONCEPTION, is the date of complete conception 380
when invention reached through experiments . . 381
of joint invention 400
a foreign invention in the United States 382, 1024 *n.* 7
how proved 380
date of application *prima facie* the true 380
of inventive act, evidence of . . . . . 132 *n.* 3, 1024, 1026, 1028
date of patent *prima facie* the true 372
is date of reduction to practice 232
between rivals, is date of conception 132, 375
in reference to legal novelty 132
of letters-patent 621
is date of patent privilege 428
(See also ABANDONED EXPERIMENT, ACTION AT LAW, APPLICATION FOR PATENT, CONCEIVER, CONCEPTION, CO-OPERATING INVENTORS, DEFENCES, DELAY, DILIGENCE, DISCOVERY, ESTOPPEL, EVIDENCE, FOREIGN INVENTIONS, IDEA, INTERFERENCES, INVENTION, INVENTIVE ACT, INVENTOR, JOINT INVENTION, LETTERS-PATENT, PRIORITY, RACE OF DILIGENCE, RIVAL INVENTORS.)

DEATH OF PARTIES IN EQUITY, effect of 1165

DECEASED INVENTOR, rights of vest in his heirs or devisees 403
representatives to patent 403–407
(See also ACTION IN EQUITY, ACTION AT LAW, ADMINISTRATOR, ADMINISTRATION, APPLICATION FOR PATENT, ASSIGNMENT, BILL OF REVIVOR, CESTUIS QUE TRUST, DEVISEE, EXECUTORS, EXTENSION, HEIRS, INFRINGEMENT, INJUNCTION, LETTERS-PATENT, LICENSE, PARTIES, PATENT, PLAINTIFF, PROBATE COURT, TITLE, TRANSFER.)

DECEIT IN PROCURING ASSIGNMENT, what is, proof of 1231
extravagant recommendations not 1231
remedy of assignee for 1231
by assignee, assignments rescinded when 1236
(See also ASSIGNEE, ASSIGNMENT, ASSIGNOR, EQUITY, FRAUD, MONEY PAID, NOTES, RESCISSION, WARRANTY.)

DECREES in equity 1130–1132
by consent as an estoppel . . . . . 984 *n.* 3
(See also ACTION IN EQUITY, COLLUSIVE SUIT, INJUNCTIONS, JUDGMENTS.)

DEFECTS, mode of removing from existing arts is a new art . . . . . 167 *n.* 3

DEFECTS — *continued.*
in letters-patent not curable by strained interpretation 737
amendment of 633–715
(See also AMBIGUITY, AMENDMENT, CLAIM, CONSTRUCTION, DESCRIPTION, DISCLAIMER, ERRORS CLERICAL, LETTERS-PATENT, RE-ISSUES, SUBSTANCE AND FORM.)
DEFENCES, strangers cannot show that the plaintiff's patent infringes an earlier patent . . . . . 806 *n.* 1
to actions at law or in equity 958–985
favored in equity 1114
to assignor's action for purchase money 1237–1242
to licensor's action for royalties 1251, 1252
(See also ACTION IN EQUITY, ACTION AT LAW, ASSIGNEE, ASSIGNMENT, CONSIDERATION, DECEIT, DEFENDANT, DELAY, ESTOPPEL, LACHES, LICENSE, LICENSEE, NOTES, ROYALTIES.)
DEFENDANT submitting to jurisdiction waives the defect 934, 1096
patent of, admissible in evidence . . . . . 1027 *n.* 2
prima facie evidence of novelty and utility . . . . 1041 *n.* 18
validity of, not in issue . . . . . 1041 *n.* 19
not to be compared with prior patents, but with the plaintiff's only . . . . . 1041 *n.* 19
disclaimers in, estop him 1041
issued pending prior application of plaintiff is no defence 1041 *n.* 19
effect of suppression of evidence by 1026
concealing his invention presumed to infringe . 1041, 1042, 1191 *n.* 3
estopped from urging certain defences 984
infringing both original and improvement cannot set up former against latter . . . . . 984 *n.* 5, 1027 *n.* 2
cannot deny utility if he used the invention . . 964, 984, 1029, 1062 *n.* 15
advertised the invention . . . 984 *n.* 5
good faith of, no defence . . . . . 1052 *n.* 2
when allowed to take license . . . . . 1065 *n.* 1
in equity, who may be 1104
where sued 1096, 1097
bill must show relation of to infringement 1106
misjoinder of 1104
nonjoinder of, how cured 1105
examined as to profits, and books inspected 1143
(See also ACTION IN EQUITY, ACTION AT LAW, ADMISSIONS, BURDEN OF PROOF, DEFENCES, ESTOPPEL, INFRINGEMENT, INJUNCTION, JUDGMENTS, LACHES, LICENSE, PATENT, PENDENTE LITE, PURCHASE MONEY, STAMPING.)
DEGREE, changes in not proof of want of identity . . . . . 240 *n.* 2
DELAY in applying for patent, effect of . . . . . 351 *n.* 2
not *ipso facto* abandonment to the public . . . . . 351 *n.* 2, 389, 390
does not make the invention a lost art 389, 390
effect of on rights of prior inventor 388–390
rival inventors . . . . . 346 *n.* 1
may estop the first inventor from claiming the patent as against a later rival 390
after application, not abandonment if unavoidable . . . . . 353 *n.* 2
in Patent Office cannot prejudice inventor . . . . . 451 *n.* 4
in disclaiming forfeits the right 640
in re-issue, if unreasonable, shows original abandonment 690–692
in suing when laches 1194
"unavoidable" defined . . . . . 578 *n.* 2
never unreasonable 578

References are to sections.

DELAY — *continued.*
(See also ABANDONED INVENTION, ABANDONMENT TO THE PUBLIC, ACTION IN EQUITY, APPLICATION FOR PATENT, ATTORNEYS, DILIGENCE, DISCLAIMER, ESTOPPEL, FORFEITURE OF APPLICATION, INJUNCTION, LACHES, NEW TRIALS, RE-ISSUES, RIVAL INVENTORS, UNREASONABLE DELAY.)
DEMURRER does not admit that invention is patentable . . . . . 1110 *n.* 2
(See also ACTION IN EQUITY, ACTION AT LAW, PATENTABILITY.)
DEPOSITIONS IN EQUITY, how taken 1128
objections to evidence on when referred to court 1127
(See also ACTIONS IN EQUITY.)
DESCRIBE, if the applicant cannot describe he cannot have invented 665
DESCRIBING AND NOT CLAIMING, when abandonment 352
not *ipso facto* abandonment 506
(See also ABANDONMENT TO THE PUBLIC, CLAIM, RE-ISSUES.)
DESCRIPTION AND CLAIM, both essential to patent . . . . . 482 *n.* 1
distinct . . . . . 515 *n.* 1
how written 539
must correspond 515
inconsistent, Claim controls . . . . . 515 *n.* 1
contradictory, both may be void . . . . 515 *n.* 1
not aided or impaired by the Claim . . . . . 515 *n.* 1
cannot enlarge the Claim . . . . . 515 *n.* 1
purpose of 482, 483
want of, not supplied by drawings . . . . . 523 *n.* 1
requirements of, under act of 1793 654
must set forth a new invention in fact . . . . . 491 *n.* 1
of result is not description of means . . . . . 484 *n.* 2, 495 *n.* 6
in words does not show that the invention was practical . . . 126
of invention in former patent no bar to a later one 465
of the invention must render it accessible to public 483
incurably defective makes patent void 483
must fully disclose the attributes of the invention 484
explain the mode of making the invention and its practical use . 484
may omit well known or formal parts 491
concealing anything to advantage of inventor makes patent void 485
must sufficiently set out state of art 484
must show the best mode of making the invention 485
of using the invention 486
sufficient if disclosing one mode of use 486
must not eulogize the invention or disparage others 487
sufficient if sufficient for persons skilled in the art 488, 491
competent mechanic can make the invention from it . . . 485 *n.* 2
of chemical process not addressed to those ignorant of chemistry 497 *n.* 1, 500 *n.* 7
defects in, immaterial if those skilled in the art could remedy them by their own knowledge . . . . . 490 *n.* 5
insufficient if workmen must try further experiments . . . . . 485 *n.* 2
sufficient if sufficient when construed by other parts of the specification . . 489
illustrated by the drawings and model 484
imperfect, not aided by imperfect drawings . . . . . 489 *n.* 1
caveat . . . . . 489 *n.* 1
must be correct, complete, and intelligible 490
possible, if inventive act really performed . . . . . 490 *n.* 3, 665
correctness of, defined . . . . . 484 *n.* 1, 490
definiteness varies with nature of invention . . . . . 484 *n.* 2, 490 *n.* 4
absolute precision impossible 490
incorrectness not excused by difficulty of stating it 490
may suffice for product where it would not for machine . . . . 499 *n.* 3
to describe a class, as such, improper unless each thing in the class will answer . . . . . 495 *n.* 9

References are to sections.

DESCRIPTION AND CLAIM — *continued.*
examples of immaterial defects in 400
completeness of, defined 401
must be complete as to each invention covered by the patent 484
must separate the new from the old . . . . . 484 *n.* 5
must include everything necessary to show the invention and its mode of use . . . . . 484 *n.* 2
sufficient if complete enough for those skilled in the art 401
need not set out the scientific principle . . . . . 405 *n.* 6
mere adjuncts, functions, or unnecessary elements . 484 *n.* 4
all that is necessary to the best effect if a good effect can be obtained as described . . . . . 401 *n.* 1
excessive may be sufficient when 401
intelligibility of, defined 402
unintelligible though inventor can understand it . . . . . 402 *n.* 2
sufficient if intelligible to those skilled in the art 402
ambiguous and fraudulent distinguished 970
ambiguity fatal though not fraudulent 403, 970
how proved 1035
defective or insufficient without inadvertence, accident, or mistake is void and not amendable 658
defects in, not curable by disclaimer 649
once sufficient cannot be made insufficient by later discoveries . . . . 488 *n.* 2
sufficiency of, admitted by claiming the invention as described, in an interference 614
false suggestion is fatal 404
form of 495
how written 539
not to be argumentative . . . . . 487 *n.* 1
ordinary meaning of words in, governed by general statements . . 495 *n.* 2
old and new, how distinguished 495
of a combination 496
an art 497
a machine 498
manufacture 499
product by describing its mode of production . . . . . 495 *n.* 6
composition, ingredients, etc. 500
design 501
an improvement 502
a genus should include one species . . . . . 495 *n.* 11
sufficiency a question for jury 503
determined by judgment of those skilled in the art 503
if insufficient on its face the court may hold the patent void 503
written not evidence of prior use . . . . . 318 *n.* 2
(See also AMBIGUITY, APPLICATION FOR PATENT, CLAIM, DISCLAIMER, DRAWINGS, FALSE SUGGESTIONS, FRAUDULENT CONCEALMENT, RE-ISSUES, SKILLED IN THE ART, SPECIFICATION.)

DESIGN defined 200
must affect the physical substance 200
an appearance imparted to a substance 203
analysis of 305
not a mere increase in beauty unless the physical substance affected 200
distinct from the substance in which it inheres . . . . . 200 *n.* 1
same article may be both a design and a manufacture . . . . . 183 *n.* 1
prior patent for, no bar to patent for same thing as a manufacture . 335 *n.* 2
abandoned by public use of the article exhibiting it . . . . . 360 *n.* 2
resides in the appearance, not the utility 200
producing utility is a manufacture not a design . . . . . 200 *n.* 2
and beauty may be both a design and a manufacture 200 *n.* 2

References are to sections.

DESIGN — *continued.*
is the appearance given to the substance, not the means by which the appearance is produced . . . . . 201 *n.* 1
distinct from the device producing it . . . . . 201 *n.* 1
consists in form, not in color or material . . . . . 204 *n.* 1
configuration or ornamentation 204
two may be exhibited by the same substance 204
not patentable unless new . . . . . 200 *n.* 1, 200 *n.* 1
utility in, defined . . . . . 200 *n.* 1
patentable though not more beautiful than others . . . . . 200 *n.* 1
a true combination 201
elements of 201
distinct from its component parts 201
essence of 201
distinct from the impression made by it on the mind of the observer . . . 202
tested only by the impression made on the mind through the eye 202
may be simple or a combination 205
aggregations of, not invention 205
combination of, whether patentable doubted . . . . . 200 *n.* 2
no genus and species in . . . . . 477 *n.* 1
essential attributes of 200
a unit, its unity how destroyed 207
remains though substance varied 206
doctrine of double use applies to . . . . . 259 *n.* 1
identity of, how determined 305, 306, 929
decided from inspection . . . . . 558 *n.* 2, 1041 *n.* 8
who competent to examine and judge . . . . . 203 *n.* 1
not patentable till reduced to practice 208
reducible to practice in many forms, all covered by patent 209
by mere drawing when 208
governed by usual patent regulations . . . . . 200 *n.* 2
how to be described in patent . . . . . 204 *n.* 1
joinder of 477
Description of 501
Claim for 533
application for, when manufacture is the true invention, how treated in the Patent Office . . . . . 555 *n.* 3
drawings of, for the Patent Office 543
model of 545
infringement of patent for 929
profits recoverable for making and selling the article in which the design appears . . . . . 1138 *n.* 2
(See also APPEARANCE, CLAIM, COMBINATION, DESCRIPTION, DRAWINGS, IDENTITY, INFRINGEMENT, REDUCTION TO PRACTICE.)

DESTRUCTION of infringing articles not ordered . . . . . 1160 *n.* 1

DEVISEE of deceased inventor, rights of 403–406
remedy of on death of plaintiff pending suit 1165
(See also DECEASED INVENTOR and titles thereto appended.)

DILIGENCE in reducing to practice 383–391
not required of sole inventor 383
of no importance unless later conceiver was first reducer 383
necessary to first conceiver 375
not necessary to later conceiver 384
no "race of diligence" 384
required of earliest conceiver from the date of his conception 385
connects later reduction with prior conception as one continuous inventive act . . . . . 383 *n.* 1, 386
reasonable diligence only required 387
measure of diligence 387

References are to sections.

DILIGENCE — *continued.*
in applying for a patent by earliest inventor 388–390
want of, may estop prior inventor from claiming the patent as against a later rival 390
(See also DATE OF CONCEPTION, and titles thereto appended.)
DIRECTION for working, not invention . . . . . 78 *n.* 2
DISCLAIMER 640–652
object and character of 650
under English law, after verdict under Stat. 5 & 6 W. IV. . . . . 10 *n.* 5
right to amend patents issued before 1837 by . . . . . 641 *n.* 1
twofold purpose of 640
distinction between 640
a mode of amending a defective patent 640
saving an otherwise lost suit 640
as a mode of abandonment 1030
statutes regulating 640, 641
to amend a defective patent, origin and nature of 641
its relation to a re-issue 641
does not admit that the patent is void . . . . . 640 *n.* 1
amends only an excessive Claim 642, 649
may relinquish one claimed method . . . . . 642 *n.* 1
may cure a misjoinder of improvements . . . . . 642 *n.* 1
may narrow a broad Claim or cancel a void one . . . . . 642 *n.* 1
may eliminate new Claim from re-issue . . . . . 642 *n.* 1; 1032 *n.* 16
cannot revive original patent by withdrawing all changes made by re-issue, but new re-issue is necessary . . . . . 642 *n.* 1
cannot remove an element from a combination . . . . 643 *n.* 2; 645 *n.* 1
cannot be used to explain matter not disclaimed . . . . . 650 *n.* 4
cannot correct a mistake as to the effect produced . . . . . 643 *n.* 2
when Claim excessive 643
how excess ascertained 643
disclaimer of old matter covered by the Claim . . . . . 513 *n.* 2
excessive Claim, when void, when curable 643
available only when defect arose without fraud 644
the amended Claim would cover a patentable invention 645
in favor of one who has produced a patentable invention 645
the part remaining would be distinguishable from that withdrawn . . . . . 645 *n.* 1
must be filed without unreasonable delay 646
unreasonable delay defined 646
a question for the court 646
when delay begins 646
no delay till excess known to patentee . . . . . 646 *n.* 3
a patentee may assume that Claims are not excessive till the contrary appears . . . . . 646 *n.* 3
proof of filing within reasonable time 1036
not after patent expires 646
after patent adjudged invalid . . . . . 646 *n.* 3
not necessary if patent declared invalid when about to expire . . 971 *n.* 4
by whom made 647
not by owner of undivided interest 647
patentee after parting with his entire interest 647
by owner of sectional interest 647
effect of, confined to territory owned by disclaimant . . . 647
by attorney not binding on owner . . . . . 647 *n.* 2
must state the interest of disclaimant . . . . . 648 *n.* 1
mode of 648

References are to sections.

DISCLAIMER — *continued.*
may relate to one figure of a drawing only . . . . . 648 *n.* 1
becomes part of original specification 648
Description not amendable by, except incidentally . . . . . 649, 650 *n.* 4
only immediate purpose is to cure excessive Claims 649
cannot enlarge scope of patent . . . . . 649 *n.* 1; 650 *n.* 2
may remove matter first set up in re-issue . . . . . 649 *n.* 2
may cure errors of fact . . . . . 644 *n.* 1
has no effect on matter not disclaimed 650
leaves patent as if originally issued in amended form 650
of species does not affect Claim for genus 650
of void Claims leaves valid Claims unchanged 650
of device except where used for certain purpose leaves disclaimant free to claim it for that purpose 650
matter disclaimed ceases to be part of the invention patented . . 650 *n.* 1
after filing, all questions relate to the patent as amended . . . . 971 *n.* 5
not rendered nugatory by subsequent interpretation . . . . . 650 *n.* 4
estoppel by 1021
as evidence 1015
to save an otherwise lost suit, origin and history of 651
before suit saves the costs . . . . . 651 *n.* 1
pending suit when allowable . . . . . 651, 1131 *n.* 3; 1162 *n.* 5
not essential to recovery . . . . . 651 *n.* 1, 2
as to Claims not sued on, unnecessary . . . . . 651 *n.* 2
if impossible because patent about to expire, recovery had on valid Claims . . . . . 651 *n.* 2
effect of on costs 1080
a nullity unless the Claim were excessive 652
if a nullity does not affect costs 652
proceedings in suit not recommenced . . . . . 651 *n.* 2; 971 *n.* 5
supplemental bill not required . . . . . 1122 *n.* 10
narrows the issue, not broadens it . . . . . 1135 *n.* 5
in a pending application must explain not contradict the Claim . . . 513 *n.* 2
of contested matter by applicant in interference 608
imposed by mistake in Patent Office, effect of . . . . . 689 *n.* 6
in the Patent Office by an attorney without authority, effect of . . . 689 *n.* 6
(See also ACTION AT LAW, AMENDMENT, APPLICATION FOR PATENT, ASSIGNEE, ATTORNEYS, CLAIM, COMBINATION, COSTS, DELAY, DESCRIPTION, ESTOPPEL, INTERFERENCES, LETTERS-PATENT, RE ISSUES.)
DISCLOSURE of the invention in the patent is the consideration of the grant . 663
DISCOVERIES of others how monopolized by practical inventor 27
DISCOVERY, essential to inventive act . . . . . 96 *n.* 1
as part of inventive act, defined 96
relates either to force, object, or mode of application 97
seven forms of 98
when performed 111
absent 112
how evidenced 99
by intrinsic novelty of the thing discovered 111, 113
by prior unsuccessful efforts of others 122
the same inventor 123
by oath of inventor if legal novelty exists 123
without construction is not invention . . . . . 96, 100 *n.* 1
no patent till construction and reduction complete (see also INVENTIVE ACT) . . . . . 125 *n.* 1
prayer for in bill in equity 1107
not obtainable at law . . . . . 1167 *n.* 2
when ordered of the number of articles made under a license . . . . 1250 *n.* 3
bill for after patent expires . . . . . 1092 *n.* 2

References are to sections.

DISCRETION of court, what is 1172
DISJUNCTIVE, use of in Claim 620
DISSOLUTION of preliminary injunction 1213
DIVERSITIES, which may affect either form or substance 237
of shape 238
size 239
capacity 240
proportions 241
arrangement 242
materials 243
parts 245
use 250
in form, however great, do not affect identity 244
of use, four possible 264
when new inventions 269
(See also CAPACITY, COMBINATION, DEGREE, DOUBLE USE, EQUIVALENTS, FORM, IDENTITY, INFRINGEMENT, INVENTION, MATERIALS, PROPORTIONS, SHAPE, SIZE, SUBSTANCE AND FORM, USE.)
DOCKET-FEES, taxation of 1163
DOUBLE USE, doctrine of 259–271
early misconceptions of . . . . . 271 *n.* 1
various statements and applications of . . . . . 259 *n.* 1
simple in itself 271
assumes the identity of the invention used 260
is analogous use . . . . . 259 *n.* 1
new use of patented invention not 463
may or may not be an improvement on the old . . . . . 259 *n.* 1
"specific treatment of specific object" not . . . . . 104 *n.* 1
applies to designs . . . . . 259 *n.* 1
practical discussion of . . . . . 259 *n.* 1
use of force applied with new object not 266
mode of application with new force or object not . . 265, 266
in combination not 267
out of combination not 268
(See also ANALOGOUS USE, COMBINATION, DIVERSITIES, FORCE, IDENTITY, USE.)
DRAWINGS for Patent Office 540–544
when required 540
necessity for and sufficiency of determined by Commissioner 540
must correspond with specification 541
cannot supply place of written Description . . . . . 523 *n.* 1
must be clear and full enough to supply place of model 542
must show every feature claimed . . . . . 541 *n.* 1
may show the invention where the specification fails to do it . . . . . 541 *n.* 2
imperfect may create fatal ambiguity 541
need not be working drawings nor on an operative scale 543
what degree of artistic perfection required 544
connected with the specification by references 541
requisites of in each class of inventions 543
signature of 544
cannot be amended in the Office . . . . . 561 *n.* 8
withdrawable after filing 553
not evidence that the invention was reduced to practice 126
of prior use 318
(See also AMBIGUITY, APPLICATION FOR PATENT, COPIES, PATENT OFFICE, REDUCTION TO PRACTICE, RE-ISSUES.)
DUDLEY'S PATENT, scope of . . . . . 68 *n.* 1

References are to sections.

EARTH, may be the apparatus of an art 107
new use of, is new art . . . . . 107 *n.* 2
ECONOMY, difference in does not show absence of infringement 804
EFFECT, defined 147
not an invention 88–90, 147
not the result of an inventive act 148
not capable of being monopolized 149
dependent on no special means 149
distinguished from function 232
Claim for void, how construed 519
(See also APPLICATION FOR PATENT, CLAIM, CONSTRUCTION, END, IDEA, IDENTITY, INFRINGEMENT, INVENTIVE ACT, LETTERS-PATENT, MEANS, RESULT.)
ELDON, Lord Chancellor, introduces contract theory of patent privilege in 1800 15
ELEMENTS OF COMBINATION, defined, identity of 278
distinct from the combination as inventions . . . . . 465 *n.* 2
unessential part not an element unless so claimed . . . . . 525 *n.* 4
useless parts are not . . . . . 496 *n.* 2
product while being produced is not . . . . . 278 *n.* 1
patentable though the combination is already patented 465
Description of 496
Claim for, makes them essential whether actually so or not 278 *n.* 1, 527, 670 *n.* 2, 4
unclaimed conceded to be old . . . . . 525 *n.* 2
once claimed cannot be disclaimed . . . . . 643 *n.* 2, 645 *n.* 1
not covered by Claim for the combination 527
may be joined with Claims for the combination and subcombination 472, 528
in re-issue of combination-patent 672
use of less than all not infringement . . . . . 282 *n.* 1
(See also APPLICATION FOR PATENT, CLAIM, COMBINATION, CO-OPERATIVE LAW, DESCRIPTION, DISCLAIMER, DOUBLE USE, EQUIVALENTS, IDENTITY, INFRINGEMENT, JOINDER, RE-ISSUES, SUBCOMBINATIONS.)
EMBODIMENT, all forms of belong to the inventor 130
(See also REDUCTION TO PRACTICE.)
EMINENT DOMAIN, title by to patented inventions 910
EMPLOYEE relation to employer as bearing on rights to and in patented inventions 414
assignment to employer of his right to patent 414
how shown 414
right to patent how affected by contracts with employer . . . . . 414 *n.* 2
ancillary inventions belong to employer, the principal inventor, when . . . 394
of corporations, whether liable for its infringing acts 912
EMPLOYER, no right to inventions of employee except under contract for a grant, assignment, or license 832
rights of to inventions under contract with employee . . . . . 769 *n.* 6
innocent, not liable for infringing acts of contractor . . . . . 911 *n.* 3
(See also ASSIGNOR, ASSIGNMENT, CONTRACT, CO-OPERATING INVENTORS, ESTOPPEL, LICENSE.)
END OR EFFECT, defined, not an invention 147
distinguished from function 232
proposed by the inventor is the satisfaction of a want 88
idea of, the inventor's first conception 231
often accomplished by different means 117
diversity of proves diversity of means 117
in character of may show diversity of means . . . . . 120 *n.* 1
improvement in, not evidence of new means . . . . . 117 *n.* 2
novelty of, how evidenced 118
shown by its comparative utility 121
shows inventive skill when . . . . . 119 *n.* 1

References are to sections.

END OR EFFECT — *continued.*
new when 118
when a want is for the first time filled 119
is supplied by new form of satisfaction 120
(See also EFFECT, and titles there cited.)
ENGLISH patent when complete . . . . . 623 *n.* 2
published . . . . . 1027 *n.* 7
specification as evidence . . . . . 600 *n.* 9
EQUITABLE interests, existence and nature of determined by local law . . . 1098
title as good in equity as a legal one . . . . . 1098 *n.* 2
owner cannot sue at law but in equity 938
must resort to equity for relief unless he can sue at law in the name of the legal owner 1089
rights of defendant protected in equity against plaintiff's legal title 1090
(See also EQUITY, and titles there cited, EQUITY JURISDICTION, TITLE.)
EQUITY, its distinctions from law not abolished by statute 1084, 1086
will compel one having record title to convey to true owner . . . . 1228 *n.* 5
will not aid a party who has broken the contract . . . . . 1228 *n.* 3
licensor who has violated the license 1249
interpret contracts unless trust relations exist . . . . . 1228 *n.* 4
power of to transfer patents in the interest of creditors 766
remedy of rejected applicant in *ex parte* cases 571
defeated party in interference cases . . . . . 604 *n.* 4
not afforded to an inventor who seeks to obtain a patent contrary to his agreement with others . . . . . 571 *n.* 2
to obtain patent, not a substitute for mandamus . . . . . 583 *n.* 3
authorizes but does not compel the Patent Office to issue a patent . . . . . 583 *n.* 3
where brought, procedure on 571
is part of the application . . . . . 577 *n.* 2
effect of delay in . . . . . 577 *n.* 2
delay in is "inaction" . . . . . 577 *n.* 2
judgment on conclusive only on the parties . . . . 571 *n.* 3
will lie only in the Circuit Court of the District of Columbia 571
(See also ACTION IN EQUITY, APPLICATION FOR PATENT, ASSIGNEE, ASSIGNMENT, ASSIGNOR, CLOUD ON TITLE, CONSIDERATION, CONTRACT, INJUNCTIONS, LICENSE, LICENSEE, RESCISSION, SPECIFIC PERFORMANCE.)
EQUITY JURISDICTION, general rules of 1094
in patent cases anciently denied . . . . . 932 *n.* 1
origin of and necessity for 932
in England 1081
the United States 1082
before the Act of 1819 . . . . . 932 *n.* 5, 1082, 1083
effect of Act of 1819 . . . . . 1083, 1084 *n.* 2
formerly exercised only in aid of suits at law 1081, 1082
complete without the aid of a court of law 1085
not dependent on statutes 1081
not concurrent with law, errors on this point 1084
remedies sometimes concurrent with law . . . . . 1094 *n.* 1
not conferrable by waiver or consent 1095
existing for one purpose, retained for all 1085, 1086
none where adequate remedy exists at law 1084, 1086
adequate remedy exists at law when 1087
no adequate remedy exists at law when 1088–1093
unless the legal remedy is equally efficacious and attainable . . . 1086 *n.* 1
none where license fee a complete remedy 1087, 1088
damages alone required 1087

References are to sections.

EQUITY JURISDICTION — *continued*.
none where suit is for breach of contract . . . . . 1087 *n.* 5
royalties . . . . . 1087 *n.* 1
unless discovery needed . . . . 1251 *n.* 1
assignee of rights of action sues . . . . . 1092 *n.* 1
complete whenever any equitable relief needed 1085, 1087
when future infringement to be prevented 1088
an injunction needed 1088
suit begun after patent expires 1092
rights of equitable owners to be vindicated 1089
plaintiff has not legal title 1089
defence rests on equitable grounds 1090
discovery necessary 1090
in aid of suit for royalties . . . . . 1087 *n.* 1
after patent expires . . . . . 1092 *n.* 2
defendant's gain exceeds plaintiff's loss 1091
title doubtful through many assignments . . . . . 1098 *n.* 2
over actions by licensors 1087
heirs or devisees or by licensee against infringing licensor 1089
for slander or libel against the patent 889
once vesting retained though patent expires pending suit 1093
retained if existing when suit began . . . . . 1086 *n.* 2
none where suit commenced too near the expiration of the patent to obtain an injunction unless other equitable relief needed 1093
none where no relief can be given . . . . . 1094 *n.* 1
local how differs from that at law 1097
how far dependent on locality 1096, 1097
none where judgment could not be enforced 1097
over residents in the district 1097
defect in may be waived . . . . . 1097 *n.* 2
(See also COURTS, CREDITOR'S BILL, DAMAGES, DEFENDANT, EQUITY and titles there cited, JURISDICTION, LICENSE, LICENSEE, REPEAL.)

EQUIVALENTS, doctrine of 245-258
different meanings of the word 246
are "obvious and customary interchanges" . . . . . 246 *n.* 2
basis of the doctrine . . . . . 107 *n.* 1
doctrine of, applicable to all inventions 258
characteristics of an 247
must be capable of being substituted for part of an existing invention . 248
must perform the same functions in the invention 248
must have been known as performing the same functions at the date of the patent . . . . . 247 *n.* 3
must not change the result . . . . . 248 *n.* 1
resides in use and effect, not in nature 249
may be entirely unlike in name and character . . . . . 249 *n.* 1
not necessarily an equivalent in other inventions 250
may perform additional functions 251
one thing may be an equivalent for two, or *vice versa* 252
combination may be an equivalent for its elements, and *vice versa* . 252 *n.* 1
must not change idea of means . . . . . 247 *n.* 1, 253
substitution of not the result of inventive skill . . . . . 253 *n.* 1
in combinations, peculiarities of 254
rule of . . . . . 279 *n.* 1, 282 *n.* 1
must perform same functions in same way 254
how differ in chemical and mechanical combinations . 193 *n.* 1, 254, *n.* 1
of old elements governed by same rule as in combinations of new elements . . . . . 254 *n.* 1
in simple inventions, rule of 255
manufactures 296

EQUIVALENTS — *continued.*
in compositions 302
governed by special rules . . . . . 254 *n.* 1
improvements . . . . . 257 *n.* 1, 258 *n.* 2
must have been known as such when patent granted . . . . . 250, 488 *n.* 2
are such where a skilful workman would have known one from the other . 247 *n.* 3
a question of fact for the jury . . . . . 240 *n.* 1
all covered by patent 257
Claim . . . . . 510 *n.* 5
use of may be infringement 804
word "equivalent" not to be used in the Claim 510
(See also COMBINATION, DIVERSITIES, IDENTITY.)
ERASURES and interlineations in the specification, how marked 530
ERRORS CLERICAL, in letters-patent (see LETTERS-PATENT) 627–630
effect of, amendment of 626
as to effect produced not curable by disclaimer . . . . . 643 *n.* 2
ESTOPPEL at law and in equity, doctrine of, acts of 981
when a defence in actions at law 981
a defence favored in equity 1114
as a defence, evidence under 1046
of defendant to set up certain defences 984
against one defendant does not bind the others 984
binds defendant not to deny utility when 904
prevents denial of existence of corporation through which title is derived 981 *n.* 12
by not stamping patented articles 981
prevents one falsely stamping from denying patent 631
by conduct, disclaimer, admissions, other patents, transfers, etc. 1021
not by admissions recalled before acted on . . . . . 981 *n.* 6
mistaken statement in application that the invention is covered by foreign patents . . . . . 981 *n.* 6
caveat as 446
by representation of identity between domestic and foreign invention . . 623 *n.* 1
not by preliminary statement in interference . . . . . 595 *n.* 3
by silence . . . . . 981 *n.* 2
by neglect to sue infringers 981
against evidence otherwise admissible 1021
by permitting known rival to obtain patent . . . . . 981 *n.* 6, 984 *n.* 2
of prior inventor by public use of rival inventor . . . . . 357 *n.* 3
in favor of later inventor by delay in applying for a patent 390
doctrine of applied in the Patent Office 614
Patent Office not estopped to deny its own grant . . . . . 451 *n.* 5
of assignor to deny validity of assigned patent 787
of licensee to deny validity of patent 820
as between employer and employee . . . . . 414 *n.* 3
by contract limited to exact subject-matter . . . . . 984 *n.* 9
(See also ABANDONMENT, ACQUIESCENCE, ACTION IN EQUITY, ACTION AT LAW, ADMISSIONS, ASSIGNEE, DEFENCES, DEFENDANT, DISCLAIMER, EQUITY, INJUNCTION, JUDGMENTS, LACHES, LICENSE, LICENSEE, PATENT OFFICE, RE-ISSUES, RIVAL INVENTORS, UTILITY.)
EVIDENCE direct and circumstantial, comparative value of . . . . . 1024 *n.* 10
negative, important when 1026
caveat as 446
rules of in Patent Office, same as in courts . . . . . 422 *n.* 4
do not govern uncontested cases . . . . . 558 *n.* 2
in interference proceedings, how and when taken 599
in actions in equity 1127
admissible at law only under a notice is inadmissible in equity unless notice is given in the answer 1127

References are to sections.

EVIDENCE — *continued.*
in actions in equity, when objections are too late . . . . . 1116 *n.* 4
not properly taken not available in argument 1128
motion to suppress . . . . . 601 *n.* 4, 1128
taken under a bill since dismissed may stand for future use . . . 1160 *n.* 2
in actions at law 1007–1072
order of introduction 1072
(See also ACTION IN EQUITY, ACTION AT LAW, ADMISSIONS, ADVERTISING, AFFIDAVIT, ANSWER, APPLICATION FOR PATENT, BURDEN OF PROOF, COURTS, DAMAGES, DEPOSITIONS, EXCEPTIONS, EXPERT, FILE WRAPPER, INJUNCTION, INTERFERENCES, JUDGMENTS, JUDICIAL NOTICE, JURY, NEW TRIALS, NOTICE, OBJECTIONS, PATENT, PATENT OFFICE, PROFERT, PROFITS, SUBPŒNA, SUPPRESS, TESTIMONY, WITNESSES.)

EXAMINER in equity, cannot rule on the evidence . . . . . 1127 *n.* 5
report of recommitted for further evidence 1128
(See also ACCOUNTING, ACTION IN EQUITY, CONFESSION, DAMAGES, EXCEPTIONS, MASTER, PROFITS.)

EXAMINERS in Patent Office, duties of 424
mere agents of Commissioner before 1861 . . . . . 51 *n.* 4
judicial officers since 1861 . . . . . 51 *n.* 4
must follow decisions of Commissioner on questions of law or fact as well as the rules of the courts . . . . . 558, 567 *n.* 3
when bound by conclusions of their predecessors 558
interviews of applicants with 573
-in-chief, on appeal to recommend matters not embraced therein 568
of interferences have exclusive jurisdiction over the issues when declared 594 *n.* 8
have no jurisdiction over patentability . . . . . 593 *n.* 3, 606 *n.* 1
public use . . . . . 606 *n.* 1
(See also APPEALS, APPLICATION FOR PATENT, COMMISSIONER, EXAMINATION, INTERFERENCES, PATENT OFFICE, REFERENCES.)

EXAMINATION of applications in the Patent Office 53
(See APPLICATION FOR PATENT.)

EXCELLENCE, or convenience, increase in does not show an inventive act . 240 *n.* 1

EXCEPTIONS to charge of court (see ACTION AT LAW) 1074
to evidence in equity when taken (see ACTION IN EQUITY) . . 1128

EXECUTION, patented invention not taken on (see JUDICIAL SALES) 766

EXECUTOR of deceased inventor, right to patent 403–407
in whom patent vests is the one appointed at domicil of deceased 800 *n.* 2
of domicil owns patent for entire United States . . . 404 *n.* 2, 800 *n.* 2
official character of not passed on by Federal courts . . . . . 800 *n.* 3
may sue anywhere without local State administration . . . . . 800 *n.* 3, 942
title of to patents derived from Patent Law, not local law . . . . 404 *n.* 1, 800
not limited by State laws . . . . . 404 *n.* 1, 800 *n.* 3
acts as owner in prosecuting applications or suits, or in making contracts or leases, but must account in equity to the heirs 802
patent grantable to . . . . . 367, 800 *n.* 2
to prosecute application pending at death of inventor 407
to apply for patent . . . . . 449, 800 *n.* 2
may withdraw application pending at inventor's death and file a new one without prejudice to third parties . . . . . 800 *n.* 2
must procure and assign extension if decedent so agreed 770
issue of patent to 619
takes patent in trust for heirs . . . . . 403 *n.* 1, 405
rights of deceased patentee vest in 800
title of identical with that of decedent 802
rather an agent of Patent Law than a true trustee 801
cestuis que trust of not named in the patent . . . . . 405 *n.* 1
not named as trustee in the patent . . . . . 801 *n.* 2

EXECUTOR — *continued.*
patent in his hands is not personalty of the estate, but a franchise in trust 405 *n.* 1, 801
not accountable to personal representatives of inventor 801
property in the patent managed by, though heirs or devisees the true owners 802
authority of over patents held in trust 406
of executor not entitled to patent . . . . . 404 *n.* 2
transfer of letters-patent by 800-802
may transfer decedent's patents 705
though co-executors do not join 705 *n.* 6, 802 *n.* 1
may assign right of action for past infringements, or sue on it himself . . 943 *n.* 1
of deceased licensee may sell the patented articles on hand . . . . . 916 *n.* 7
denial of right to sue, nonjoinder of, etc., must be pleaded in abatement . 956 *n.* 1
action against deceased infringer survives against his executor . . . . 948 *n.* 4
selling infringing inventions found in the assets does not render the estate liable for infringement 905
(See also ACTION IN EQUITY, ACTION AT LAW, ADMINISTRATOR, ADMINISTRATION, APPLICATION FOR PATENT, ASSIGNMENT, BILL OF REVIVOR, CESTUIS QUE TRUST, DECEASED INVENTORS, DEVISEE, EXTENSION, HEIRS, INFRINGEMENT, PATENTEE, PROBATE COURT, TITLE, TRANSFER.)

EXPENSES of suit not allowed as damages at law 1067
protecting vendees not allowed in estimating profits 1139

EXPERIMENTAL USE, what is, cases of . . . . . 855 *n.* 2
not a public use working abandonment 355
not public use though use be in public 355
profit results 355
(See also ABANDONMENT, and titles there cited.)

EXPERIMENTS not inventions . . . . . 80 *n.* 1, 2
unsuccessful, instances and proof of . . . . . 318 *n.* 3
of others *not* incompatible with exercise of inventive skill 84
show inventive skill in the one that succeeds 122
not evidence of prior use 318
(See also ABANDONED EXPERIMENTS, CONCEPTION, INVENTION, INVENTIVE ACT, INVENTIVE SKILL, PRIOR USE, SUGGESTIONS, UNSUCCESSFUL EXPERIMENTS.)

EXPERT evidence may aid in determining identity . . . . . 892 *n.* 1
as to identity between patented and infringing inventions . . . 1041 *n.* 10
witnesses, classes of, scientific and mechanical 1013
value and effect of in patent cases 1012
when admissible, weight of . . . . . 1013 *n.* 2, 1014
(See also ACTION AT LAW, CONSTRUCTION, EVIDENCE, WITNESSES.)

EXTENSION OF LETTERS-PATENT 421, 835-845
origin and history of 835
under English law 18
American law 22
intended for the benefit of the inventor, not of his assignees 779, 836
not affected by assignment or re-issue of original 836
granted to assignees only when inventor has received or is to receive some reasonable benefit from it 836
of joint-patent not granted unless all the joint inventors desire it 836
obtainable by executor of deceased patentee 406, 836
granted only when the inventor has not been already duly compensated for the benefit conferred on the public 837
value of the invention to the public, how shown 837, 841
want of due compensation to inventor, how shown 837, 841
denied if failure of inventor to receive due compensation arose from his own neglect 837, 841
must be confined to original invention 838
presumed to be for the same invention as the original . . . . . 838 *n.* 1

References are to sections.

EXTENSION OF LETTERS-PATENT — *continued.*
not granted on an unimportant part of the invention . . . . . 838 *n.* 2
rests on the last re-issue granted with consent of inventor 838
cannot perform the functions of a re-issue 838
though the original is limited by a foreign patent 838
of foreign patent does not extend the American . . . . . 838 *n.* 6
patent may be re-issued after 602, 838
of invalid patent improper 839
on application for, original patent presumed valid 839
validity of original may be examined 839
increases weight of patent as evidence 1016, 1041
in face of opposition strengthens the presumption of validity . . . 839, 1026 *n.* 2
of defective patent proper when defect amendable . . . . . 839 *n.* 2
procedure in cases in which the Patent Office had original jurisdiction . . . 840
referred to the Patent Office by Congress under the act of 1861 841
on hearings as to, the usual rules of evidence apply . . . . . 841 *n.* 3
denied where the same invention is covered by a prior patent to the same patentee . . . . . 840 *n.* 3
granted though Commissioner doubts the patentability of the invention or the priority of the inventor . . . . . 840 *n.* 3
decision of Patent Office on application for, final 842
after, the patent is still open to all defences in suits for infringement . . . 842
cannot be collaterally attacked for fraud 842
effect of on rights of assignees, grantees, licensees, etc. 843
vests absolute title in the grantee . . . . . 840 *n.* 4
owner of bound by acts of owners of original, when 843
by special act governed by general law 845
under special act of Congress cannot affect prior vested rights 845
pending suit in equity requires supplemental bill 1122
may be transferred, contracted for, etc. . . . . 412 *n.* 1, 770, 843, 844
before or after its grant 779
contract to assign a future, valid and enforceable in equity . . . 770, 1228 *n.* 5
bound in hands of executor by contracts of decedent 770
assignment of, form and effect 412, 779
when covered by assignment of original 412
what words do not cover 779
(See also ASSIGNMENT, LICENSE, PATENT, TERM, TITLE, TRANSFER.)

FALSE SUGGESTION in Description fatal 494
FEDERAL AND STATE COURTS, jurisdiction of 853-866
FEDERAL COURTS, jurisdiction over contract actions 1256
none over licenses . . . . . 1044 *n.* 2
possess all ordinary equity powers . . . . . 1094 *n.* 1
(See also CIRCUIT COURTS, COURTS, EQUITY, JURISDICTION, STATE COURTS, SUPREME COURT.)
FEES OF PATENT OFFICE on application, how payable 554
none for re-issue to correct Office mistakes 638
final, payment of 585
non-payment may forfeit application 584
non-payment does not render patent void . . . . . 554 *n.* 1
(See also APPLICATION FOR PATENT, CAVEAT, FORFEITURE, PATENT OFFICE.)
FEIGNED ISSUES (see ACTIONS IN EQUITY) 1124–1126
FIELD OF INVENTION constantly narrowing . . . . . 88 *n.* 2
FILE-WRAPPER, and contents as evidence . . . . . 1015, 1019 *n.* 4
of prior use . . . . . 1020 *n.* 16
absence of papers from, no evidence that such papers do not exist . . 1032 *n.* 6
(See also ACTION AT LAW.)

References are to sections.

FORCE, employed in an invention sometimes called a "principle" 135
of nature not an invention 130–138
not generated by the inventive act 92
cannot be claimed . . . . . 515, 519 *n.* 2
change in natural condition of, may be an invention . . . . . 92 *n.* 1
mode of controlling may be an art . . . . . 105 *n.* 1
use of new is a new art . . . . . 104 *n.* 1
applied, defined 101
essence of 102
is an invention . . . . . 101 *n.* 1
(See also ANIMALS, APPLICATION OF PRINCIPLE, ART, CLAIM, COMPOSITION, DESIGN, DISCOVERY, DOUBLE USE, IDEA, IDENTITY, IMPROVEMENT, INVENTOR, INVENTIVE ACT, MEANS, PRINCIPLE, PROCESS, REDUCTION TO PRACTICE, USE.)

FOREIGN INVENTIONS, date of in this country 600
their conception in this country 382
priority of . . . . . 603 *n.* 5
INVENTOR, may show when his inventions became known in the United States . . . . . 560 *n.* 1
bound by acts of his attorney though ignorant of our language . . 689 *n.* 6
PATENT, no bar to domestic 461
use under, when a bar . . . . . 360 *n.* 3
does not affect validity of American patent . . . . . 623 *n.* 1, 985 *n.* 4
effect of on term of American patent 622
of no effect unless issued to same patentee or his agent . . . 978 *n.* 4, 1043
date of . . . . . 623 *n.* 2
takes effect when 623
effect of assignment of 778
to be disclosed in application-oath 455
PATENTEE, may take out American patent . . . . . 363 *n.* 3
seeking American patent, how far bound by his foreign patent . . 461 *n.* 3
(See also ALIEN, APPLICATION FOR PATENT, CANADIAN PATENT, CAVEAT, CONCEPTION, DATE, ENGLISH PATENT, IMPORTER, INVENTOR, LICENSE, PATENT, PRIOR USE, PRIORITY, TERM.)

FOREIGN USE, not knowledge in the United States 226
not prior use 320
WORDS, how construed in patents 750
FORFEITURE OF APPLICATION (see APPLICATION FOR PATENT) . . . 584
FORFEITURE OF ASSIGNEE'S INTEREST, when decreed . . . . . 788 *n.* 2
FORM, sometimes synonymous with "shape," sometimes with embodiment . 238 *n.* 2
matter of, defined, instances 566
diversities of, do not affect identity however great 244
(See also DIVERSITIES, IDENTITY, INFRINGEMENT.)

FRAUD, threat of suit is not . . . . . 1247 *n.* 2
in sale of patent-rights, power of States to prevent . . . . . 46 *n.* 4
not a defence to a suit for infringement 967
in procuring patent not raised collaterally 715, 717
equity will not relieve one guilty of . . . . . 1114 *n.* 5
burden of proof on him who alleges . . . . . 644 *n.* 1
FRAUDULENT CONCEALMENT or redundancy in Description fatal . . . 494
"FREE FROM DEFECT," meaning of . . . . . 751 *n.* 5
FUNCTION defined 144
distinct from means, end, effect, etc. 145, 232
the measure of means 234
not an invention 146
the secondary idea in the inventive act 233
of one specific instrument not an art . . . . . 159 *n.* 2

References are to sections.

FUNCTION —*continued.*
difference in, shows difference of machine . . . . . 200 *n.* 1
Claim for, void 518
of machine, Claim for, when proper . . . . . 520 *n.* 1, 530
Claim for, construed to cover means if possible 518
(See also APPARATUS, ART, CLAIM, CONSTRUCTION, IDEA, IDENTITY, INFRINGEMENT, INVENTION, INVENTIVE ACT, MACHINE, MEANS, PATENT.)

GAZETTE OFFICIAL, origin and character of 55
GENERIC, meaning of "generic," "genus," etc. . . . . 471 *n.* 4, 750
invention, defined, illustrations of 535
not patentable after species patented . . . . . 462 *n.* 1, 535 *n.* 3
may be claimed by inventor of a species unless before invented . . 535 *n.* 3
patent for covers the species 535
must describe one or more species . . . . . 495 *n.* 11, 535 *n.* 3
(See also APPLICATION FOR PATENT, CLAIM, DESIGN, IDENTITY, IMPROVEMENT, INFRINGEMENT, JOINDER, PATENT, RE-ISSUES, SPECIFIC INVENTION, UNITY.)

GENUS AND SPECIES, distinct inventions . . . . . 471 *n.* 4, 536
not in designs . . . . . 477 *n.* 1

GRANT OF LETTERS-PATENT 422–632
defined, distinguished from assignment and license 763, 791, 792
of letters-patent, governed by statute and Patent Office rules 422
of sectional interest leaves the grantor the mere owner of the remaining sectional interest and no further assignment is possible 765
illegal unless prerequisites fulfilled 423
form of, signature, record, etc. 794
of "all patentee's right" carries an exclusive right . . . . . 792 *n.* 2
exclusive right not void as in restraint of trade . . . . . 793 *n.* 3
upon condition, or for specific period, or for a limited mode of enjoyment, valid if excluding all other rights 793
implied warranty in 794
of "all our right" implies that a patent exists, and if there is none the price is not recoverable . . . . . 794 *n.* 3
not affected by subsequent assignments . . . . . 794 *n.* 2
reserving special rights . . . . . 793 *n.* 3
and assignment, contract rights under are of the same nature 1226
protected by law 849, 850
as evidence 1015
(See also ASSIGNMENT, CONSIDERATION, CONTRACT, CO-OWNERS, GRANTEE, GRANTOR, LICENSE, LICENSEES, RESCISSION, SPECIFIC PERFORMANCE, TITLE, WARRANTY.)

GRANTEES and assignees not synonymous . . . . . 760 *n.* 2
estopped to deny title of grantor while enjoying benefits of grant . . . 794 *n.* 3
not parties to surrender and re-issue 698
transfer by, of their "right to use and sell" carries their whole interest 791 *n.* 2
do not unite rights by appointing common attorney . . . . . 799 *n.* 1
may restrict their individual powers by vesting their rights in a common agent to act for all . . . . . 799 *n.* 1
rights and obligations of joint-grantees 799
when plaintiffs in equity 1098, 1099
must sue in their own names 1101
infringement by 914
cannot make articles outside their own territory for use outside it . . 793 *n.* 3
cannot sell for use outside their own territory . . . . . 824 *n.* 5
vendees of may use the articles anywhere when 793
not enjoined from selling in their own territory though their vendees use elsewhere . . . . . 1191 *n.* 8, 1204 *n.* 3

GRANTEES — *continued.*
(See also ACTION IN EQUITY, ACTION AT LAW, ASSIGNEE, CO-GRANTEES, DISCLAIMER, GRANT, GRANTOR, INFRINGEMENT, MONEY PAID, PURCHASE MONEY, RE-ISSUES, VENDEE.)
GRANTORS, infringement by 914
cannot use or sell for use in grantee's territory . . . . . 703 *n.* 3
and grantees, contract relations of, governed by ordinary law of contracts . 1224
breach of contract between, may also be an infringement 1225
(See also ASSIGNOR, GRANTOR, GRANTEE, and titles there cited.)
GUILDS, English, described 3

HANSEATIC LEAGUE, described 2
HEARING final, hearing before a master is not . . . . . 1182 *n.* 1
HEIRS of deceased inventor, rights of 403–407
Congress can grant patent to, after forfeiture by delay . . . . . 405 *n.* 1
holding under special act after rejection of application of inventor are not subject to assignment he may have made 772
and devisees, when plaintiffs in equity 1099
(See also DECEASED INVENTOR, EXECUTOR, and titles there cited.)
HUSBAND, rights of in wife's patent governed by local law 363

IDEA of end, the primary idea of the inventor 231, 233
not part of the invention 88
of function, the secondary idea of the inventor 232, 233
of means, the tertiary and final idea of the inventor 233
the essence of the invention 87
includes whatever is necessary to perform the function 235
ideas of force, object, and mode of application 91
generated by inventive act 87–90, 377
without generating the ideas of force, object, or mode of application 92
unembodied not an invention . . . . . 140 *n.* 2
patentable 125
same art or article may embody two or more . . . . . 230 *n.* 1, 360 *n.* 2
to be fully set out in specification . . . . . 484 *n.* 2
(See also CONCEIVER, CONCEPTION, CO-OPERATING INVENTORS, DATE, DESCRIPTION, DISCOVERY, EFFECT, END, IDENTITY, IMPROVEMENT, INFRINGEMENT, INVENTION, INVENTIVE ACT, INVENTIVE SKILL, MEANS, PRINCIPLE, RIVAL INVENTORS.)
IDENTITY, a question of fact 272
in fact is identity at law . . . . . 272 *n.* 1, 892 *n.* 1
a subject of great difficulty in practice 314
is identity in effect, in function, and in means 236
requires identity in function 274
not proved by identity in function . . . . . 274 *n.* 1
is identity of means, not of theory . . . . . 229 *n.* 1
intention . . . . . 229 *n.* 1
embodiment 130, 230
name . . . . . 229 *n.* 1
form 229
is independent of variations in matter of form 244, 275
how determined 107
requires identity of force, object, and mode of application 276
of forces, objects, and modes of application, how determined 107
consistent with diversities of shape, size, capacity, proportions, arrangement, and materials 237
of parts 245–258
use 259–271

IDENTITY — *continued.*
of combinations 277–282
arts 284–288
machines 289–292
tests of . . . . . 178 *n.* 1
manufactures 293–299
compositions 300–304
designs 305, 306
improvements 307–313
essential to prior use . . . . . 318 *n.* 1
how proved 1026
value of different species of evidence concerning 1026
Claims compared, if inventions patented . . . . . 505 *n.* 1, 1041 *n.* 6
between patented and infringing inventions 1041, 1191
defendant's patent *prima facie* proof that there is no identity . . 1198 *n.* 2
expert evidence admissible . . . . . 892 *n.* 1
of two patented inventions presumed against 896
(See also ACTION AT LAW, APPLICATION FOR PATENT, ART, CLAIM, COMBINATION, COMPOSITION, DESIGN, DIVERSITIES, DOUBLE USE, ELEMENTS, EQUIVALENTS, IDEA, IMPROVEMENT, INFRINGEMENT, INGREDIENT, INTERFERENCES, INVENTION, INVENTIVE ACT, MACHINE, MANUFACTURE, MEANS, NOVELTY, PATENT, PRIOR USE, PRIORITY, REDUCTION TO PRACTICE, REISSUES, SUBSTANCE AND FORM, UNITY, USE.)

IMPORTER, on same footing with inventor under English law . . . . 42 *n.* 2, 68
less favored as to extensions, etc. . . . . 68 *n.* 1
not an inventor in the United States . . . . . 57 *n.* 1, 68
entitled to patent privilege in the United States . . . . 46 *n.* 1, 57 *n.* 1, 68

IMPROVEMENT defined . . . . . 210, 307 *n.* 1
implies an original 211
always related to and dependent on original . . . . . 211 *n.* 1
a distinct invention from its original . . . . . 218 *n.* 1, 894 *n.* 10, 896 *n.* 1
essence of an 218
a variation in the idea of means not destroying its identity 210, 213
a change *in* not *of* the force, object, or mode of application 214
not a mere change in reducing to practice 212
how distinguished from change *of* form and from independent inventions . . 215
may be improved upon 218
may be an original as to some subsequent improvement . . . . . 211 *n.* 1
a unit, its unity how destroyed 218
how created 311
in simple inventions and its combinations 217
may consist in change of shape only . . . . . 217 *n.* 1
may change structure and not capacity . . . . . 217 *n.* 1
indicated by cheapness . . . . . 217 *n.* 1
patentability of denied by Lord Coke . . . . . 69 *n.* 1, 210 *n.* 2
involving inventive skill patentable 210
not patentable till reduced to practice 219
reducible to practice in many forms, all covered by patent 220
scope of, how determined 930
analysis and classification of 307–312
of two classes 309
identity of, how determined 307–313
tests of drawn from its essential nature, its mode of operation, and its effects 216
rule of equivalents in . . . . . 257 *n.* 1, 258 *n.* 2
patent for cannot cover patented original 462
Description of 502
Claim for 534
joinder of 478

References are to sections.

IMPROVEMENT — *continued.*
drawings of for Patent Office 543
infringement of patent for 920
by owner of original . . 180 *n.* 1, 804 *n.* 10, 806 *n.* 1, 920
not available to its inventor without consent of owner of original 30
inventor of, obtains thereby no rights in the original . . . . . 218 *n.* 1
may be an infringement 804
(See also APPLICATION FOR PATENT, CLAIM, COMBINATION, DESCRIPTION, IDEA, IDENTITY, INFRINGEMENT, JOINDER, REDUCTION TO PRACTICE, RE-ISSUES, STATE OF THE ART, UNITY.)
INADVERTENCE defined 658
INDUSTRY not inventive skill 78
INFANT may obtain patent . . . . . 303 *n.* 8
be assignee of patent . . . . . 707 *n.* 1
power to transfer his patents governed by local law 765
must assign by guardian . . . . . 705 *n.* 7
INFRINGEMENT 890–930
and novelty not same questions though identity in each determined by same tests 892, 1041
defined 890, 946
a wrong against the use of, not the property in, the invention 43
when breach of contract is 1215
when patented invention taken by eminent domain it is not 910
few instances in proportion to the number of patents . . . . . 43 *n.* 1
a mixed question of law and fact . . . . . 890 *n.* 1
invention unlawfully used must be identical with that protected by the patent 891
identity how determined 892, 894
measured by Claims of patent not by actual invention 891
theory of patentee as to his invention unimportant 891
measured by valid Claims though other Claims void . . . 891 *n.* 4
no notice taken of matter not claimed 891
answering same purpose but not covered by the patent . . . . . 891 *n.* 1
when patent confined to one form other forms are not infringements . . . . . 891 *n.* 2, 894 *n.* 5
invention not to be used as pointed out in the patent is not an infringement . . . . . 891 *n.* 1
where the defendant's invention, if prior, would not anticipate, it cannot infringe . . . . . 891 *n.* 2
must be identity in means, not merely in purpose, function, or effect 893
identity exists where the patented invention is embraced in the infringing art or article . . . . . 893, 894 *n.* 10
none where effects, functions, or means differ 894
material parts are omitted . . . . . 894 *n.* 9
identity may exist in spite of differences in shape, size, capacity, arrangement, materials, equivalents, or uses 894
identity may exist in spite of differences in economy, number, or as original and improvement 894
identity may exist where the patented device is used in connection with others . . . . . 894 *n.* 10
identity may exist where the infringing invention becomes identical by using it and was so intended 895
two patented inventions presumed not to be identical 896
may be identical 896
by adopting the principle of the patented invention . . . . . 893 *n.* 2
though the infringing invention is, as a whole, a new invention . . . 893 *n.* 3
where owners of original and improvement use them contrary to their agreements . . . . . 894 *n.* 10

References are to sections.

INFRINGEMENT— *continued*.
none by a license to use improvements on the patented invention . . . 891 *n.* 1
where the invention is not fully disclosed in the patent 891
described is inoperative . . . . . 891 *n.* 3; 894 *n.* 10
of two patents, taken as one, not possible . . . . . 891 *n.* 4
nature of act of 897
committed by any act which promotes the unlawful making, use, or sale of the patented invention 897, 910
committed by any direct participation in the profits of an infringing enterprise . . . . . 897, 910, 911 *n.* 2
by landlord renting or tenant hiring when 897
by several, some making, some selling, is joint and several . . . 897 *n.* 5
must affect the pecuniary interests of the owner of the patent 898
making for experiment or curiosity or exhibition or without intent to use or sell is not, unless beneficially used by infringer 898, 903
making for use, if successful, is . . . . . 898 *n.* 3
or sale, though never used, is 903
possessing, exposing for sale, advertising, etc., is not 899
use of part not distinctly covered by the patent is not 900
making or selling part with intent that others shall complete it is . . 900, 901 *n.* 4, 903
such parts of a patented machine as express its structural law 900
disclaimed part is not . . . . . 900 *n.* 1
for sale abroad is 903
different article with intent that by use it shall become the patented invention is 903
parts to be united by the user is 903
by agents and workmen though they are paid by the piece is . . 903
parts with no intent to unite them is not 903
same article as embodiment of different idea is not 903
unlicensed repairing is 903
replacing of parts is 903
not unless covered by the patent 903
maker and seller not *ipso facto* liable for use by vendee . . . 903
unlawful using is 904
using for experiment not for profit is not 904
use unlawful in spite of formal changes in the article or in its mode of use, purposes, or adjuncts 904
though new uses added 904
whether or not made by user 904
partial use with intent that others shall complete it is 904
use involving a patented process is . . . . . 904 *n.* 1
use by vendee in a way forbidden to his vendor is not . . . 904 *n.* 1
use by vendee of product from known infringers of the process is not unless the sale is colorable . . . . . 904 *n.* 2
use by vendee of later enjoined inventor is . . . . . 904 *n.* 1
use through agents who furnish the product finished is 904
use by lessees in complicity with lessors is . . . . . 904 *n.* 2
making and selling do not infringe a patent for the use 903
unlawful sale is 905
sale and use distinct . . . . . 1060 *n.* 2
any transfer for value, however disguised, is a sale 905
sale takes place in the territory of delivery . . . . . 1097 *n.* 2
sale, unless collusive with vendees who use, does not infringe a patent for the use 905
sale of article which can be used only to infringe is . . . . 905 *n.* 2
sale of one device with intent that in use it shall become the patented device is 905

References are to sections.

INFRINGEMENT — *continued.*
unlawful sale, sale of parts to be united with other parts is 905
sale, by whomsoever the device was made, is . . . . . 905 n. 1
sale by agents without authority is not infringement by principal . 905
by sheriff, on process, of the materials of the invention is not . 905
by executors of inventions found in the assets is not infringement by the estate 905
to one who has license to use is not when . . . . . 905 n. 1
patentee or his agent is not though it may be evidence of other sales . . . . . 905, 1042 n. 1
of parts covered by different patent is not 905
without intent that they shall be united is not 905
motive for immaterial 901, 921
though public benefited by it . . . . . 901 n. 3
acts done with intent to infringe may violate the patent though in themselves they do not 901
intent how proved, when presumed 1191
must be clearly proved as well as the act in such cases . . 905 n. 2
though infringer insane 901, 921
ignorant of the patent 901, 921
if the articles were duly stamped . . 902
defendant denying stamping must set it up in his answer . 931 n. 3
unless patentee misled the infringer 981 n. 1
neglected his legal duty to prevent it . 981 n. 2
to use under a claim of ownership is . . . . . 901 n. 5
deliberate if infringer knew of the patent though in his own judgment acting rightfully under his own patent . . . . . 901 n. 5
a single tort and a single cause of action though embracing many acts of making, use, and sale 908
acts of different persons are distinct wrongs . . . . . 908 n. 2
where one makes and another sells, is joint and several . . . . . 908 n. 2
possible only while patent is in force 978
acts committed before the patent issues are not 907
after complete specification filed are, under English law . 907
reproducing device used before invention of patented device is not 900 n. 1
use of device innocently made before patent issues is not 907
which was in use before patent is not . . . . . 907 n. 2
acts committed before the grant of a re-issue are not 907
use of device which would not infringe the original does not infringe the re-issue . . . . . 907 n. 4
acts committed after the patent expires are not . . . . . 908, 1193 n. 2
when may be 908, 978, 1092
one of a group of patents may be infringed though the others have expired 925 n. 1
use of a device, after its patent expires, may involve the use of other devices still covered by their patents and so infringe 908
use or sale, after patent expires, of articles made up for that purpose, while patent was in force, are 908
possible only in the United States 909
use in England of articles purchased abroad is . . . . . 909 n. 1
use in the United States of articles lawfully purchased of the patentee abroad is not . . . . . 909 n. 1
making or sale of articles in the United States for use abroad or on foreign vessels is 909
acts done on American vessels are 909
foreign vessels in American ports are not 909
who may commit acts of 910–921

References are to sections.

INFRINGEMENT — *continued*.
United States cannot commit 1258
claims for against the United States must be urged in the Court of Claims . . . . . 910 *n.* 5
officers and employees of the United States 910
where the government obtains the entire benefit of the infringement 910
public corporations, their officers and agents 911
municipal corporations taking the benefit of the acts of its departments, over whom it has no control, liable for . . . . . 911 *n.* 2
municipal corporations not liable for acts of contractors 911
municipal corporations not made liable by any agreement to that effect between contractor and patentee 911
sub-corporations, acting as agents of municipal corporations, as Boards of Education, etc. 911
counties and other statutory organizations and their contractors or agents 911
private corporations their officers and stockholders 912
by corporations through acts of other corporations 912
by corporation does not create a "debt" for which its officers may be liable . . . . . 912 *n.* 4
co-owners and their licensees 707, 913, 978, 1044
using an infringing device 913
assignors, grantors, grantees, etc. 914
vendee of grantee selling outside grantee's territory . . . . . 914 *n.* 2
licensees 915–917, 979, 1044
licensee acting within the scope of his license cannot infringe . . . 915
acting under express license 916
any departure from license is 916
violation of restrictions in license is 812
licensee to sell may infringe by selling to those who have no right to use . . . . . 916 *n.* 2
licensee practising his own invention . . . . . 916 *n.* 3
non-payment of royalties not . . . . . 916 *n.* 1, 1250
licensee practising the invention after license expires . . . 915, 916 *n.* 5
is rescinded . 915, 1249 *n.* 4
when license invalid or never took effect 915
licensee acting through agents 916
assignee of express licensee 916
licensee's infringement a breach of contract . . . . . 916 *n.* 1
licensee under implied license 917
common carriers 918
transporting in collusion with infringing sellers 905
custom-house agents, acts of not . . . . . 918 *n.* 1
contractors 919
not justified by public interest 919
agents, salesmen, children, workmen, partners, etc. 920
sale through agents is 905
involuntary act of workman is not 577
private individuals 921
of combination-patent what acts are 922
of useless combination impossible 922
use of different elements, or fewer elements, or different grouping of same elements, or of elements selected from several combinations, is not . . 922
substitution of elements newly discovered . . . . . 256 *n.* 2, 922 *n.* 4
adding elements or using for new purposes 922
different combination not, though suggested by the one patented . . . 922
use of unclaimed elements and sub-combinations not 923
use of any claimed element is . . . . . 923 *n.* 4
use of any element invented by the patentee . . . . . 922 *n.* 4

References are to sections.

INFRINGEMENT — *continued.*
making or sale of one element with intent that it shall be united with the others 924
patent for element infringed by its use in combination 893
of patent for an art, what acts are 926
is a continuing infringement . . . . . 925 *n.* 2
use of less than all the steps not 925
use of apparatus after patent for it expires . . . . . 925 *n.* 1
sale of materials to be used in the art . . . . . 925 *n.* 2
use of product made by infringing art is not . . . . . 911 *n.* 3
of patent for a machine, what acts are 926
sale of product is not 926
of patent for a manufacture, what acts are 927
for a composition, what acts are 928
for a design, what acts are 929
may also infringe patent for the manufacture 929
for an improvement, what acts are 930
charge of, is a libel . . . . . 886 *n.* 1
remedies for 62
not complete . . . . . 1136 *n.* 1
patentee may resort to what means to discover 1218
actions for, jurisdiction of Federal courts over 861
exclusive though defendant pleads license . . 861 *n.* 1, 862
preventive remedy 1088
remedy in assumpsit, waiving tort . . . . . 983 *n.* 1
executor may bring 406
no suit against licensee till license repudiated or rescinded in equity . 915 *n.* 3
averment of infringement in bill in equity 1106
damages implied from infringement 953, 1052
vary with acts performed and plaintiff's mode of enjoyment . 906 *n.* 2
evidence as to 1041–1043
inferential admissible . . . . . 1127 *n.* 2
one act of infringement not presumed from another . . . . 1071 *n.* 1
accidental infringement to be clearly proved 1041
questions decided by the judgment 861
articles not ordered to be destroyed . . . . . 1160 *n.* 1
rights of action for, assignable with patent but require distinct words of conveyance 781
transferred by assignment of expired patent 781, 790
(See also ACCOUNT, ACCOUNTING, ACTION IN EQUITY, ACTION AT LAW, AGENCY, ART, ASSIGNEE, ASSIGNOR, CITY, COMBINATION, COMMON CARRIER, COMPOSITION, CONTRACTOR, CO-OWNERS, CORPORATION, COURTS, DAMAGES, DESIGNS, DIVERSITIES, DOUBLE USE, EQUITY JURISDICTION, EQUIVALENTS, IDENTITY, IMPROVEMENT, INFRINGER, INJUNCTION, INVENTION, LICENSE, MACHINE, MAKING, MANUFACTURE, PATENT, POSSESSION, PROFITS, SLANDER, STAMPING, STOCKHOLDERS, WORKMEN.)

INFRINGER, in law a tort-feasor, in equity treated like a trustee 1050, 1137
not really a trustee *de son tort* 1091, 1137
when to be treated as a licensee 1056–1059
defences sufficient though patent be not held void 717
services of, not allowed as cost of articles sold 1139
forbidden to stamp patented articles 629
repeal of patent not necessary to 717
(See also INFRINGEMENT and titles thereto cited, REPEAL, TRUSTEE.)

INGREDIENTS, defined 192
when identical 195, 302
Description of 500
joinder of with composition 476

References are to sections.

INJUNCTION 1108-1223
purpose of to prevent infringement and save multiplicity of suits . . . 1108 n. 2
value of to patentee 1108
when necessary 1088
not granted at law . . . . . 1108 n. 1
not granted where other relief adequate 1108
principles of not changed by Act of 1819 . . . . . 1171 n. 3
will not issue before grant of patent . . . . . 907 n. 2, 1088 n. 1
unless plaintiff has a patent . . . . . 1210 n. 2
granted to protect invention after patent applied for . . . . . 882 n. 1
contra . . . . . 1088 n. 1
uncopyrighted production . . . . . 882 n. 1
will not issue when defendant can no longer infringe 1088
to prevent use of articles used before patent granted 907 n. 2, 1191 n. 8, 1197 n. 2
assignee entitled to . . . . . 702 n. 2
will not issue to prevent payment of profits to plaintiff after accounting . . 1153
granted to restrain assignor from selling or using when specific performance impossible 1228
not granted to prevent licensor from suing for license fees 1252
granted to protect exclusive licensee . . . . . 1255 n. 3
granted to prevent licensor from publicly revoking license when . . . 1244 n. 2, 3
destroying value of license . . . . 1244 n. 2, 3
not granted to prevent licensee from selling if question of royalties alone involved 1252
issued against the party benefited by a contract though the other party be not bound . . . . . 1244 n. 3
not granted to prevent the patentee from notifying the public of his rights or that the complainant has been enjoined . . . . . 888 n. 2
not barred by failure to stamp . . . . . 628 n. 3
prayer for in bill in equity 1107
preliminary or perpetual 1169
preliminary, object of 1169
does not impair right of trial by jury . . . . . 1169 n. 1
rests in discretion of court . . . . . 1170, 1172, 1192, 1210 n. 5
discretion governed by established principles 1170
not mere whim or prejudice 1172
granted whenever rights need protection . . . . . 1170 n. 1
not granted unless protection needed 1171
even when needed not granted without great caution . . . . . 1171 n. 4
not granted when right doubtful or wrong uncertain 1171
not granted except to prevent prospective injury, and when no other adequate remedy exists 1171
not granted to punish infringers for past wrongs, or to compel settlements, or to prevent contracts 1171
granted only *nisi* if defendant ready to stop infringing and patent of doubtful validity . . . . . 1171 n. 4
confined to its intended purpose 1171
court has widest liberty in granting or refusing 1172
grant or refusal not subject to appeal 1172
court must do exact justice in granting or refusing, under guidance of equitable principles 1172
not granted if inequitable or inexpedient 1173, 1199
various instances of refusal on different grounds . . . . . 1199 and notes
granted only when patent valid, title in plaintiff, and danger of infringement by defendant 1173
not granted on an unproved theory . . . . . 1173 n. 1
on motion for, court will not go into an extended hearing, but rely on obvious facts 1173, 1210

References are to sections.

INJUNCTION — *continued.*
on motion for, court will examine only far enough to see what protection is needed . . . . . 1178 *n.* 2
evidence on, special kinds required 1178
validity provable by prior judgments, public acquiescence, or defendant's admissions 1174
prior judgments the highest evidence of validity . . 1174, 1184
if novelty and infringement clear, but no judgments, court may enjoin . . . . . 1174 *n.* 5
weight of prior judgments, how determined 1175
varied 1175
prior judgments of highest court conclusive when parties, issues, and evidence the same 1175
prior judgments of lower courts with different parties, issues, or evidence, of little weight 1175
prior judgments between same parties, effect of 1176
who are same parties 1176
judgments are evidence against persons intimately connected in the litigation with the parties . . . 1176 *n.* 2
judgments evidence against parties, privies, abettors of prior suit, co-grantees, assignees, etc. 1176
injunctions granted on such judgments . . . . 1176 *n.* 2
prior judgments between different parties, effect of . . . 1179
of little weight . . . . . 1175 *n.* 1
prior judgments not conclusive unless covering the same issues on the same Claims of the same patent . . 1177
judgments on same issues, effect of 1177
when issues are the same 1177
judgments sustaining the patent against all defences, effect of 1177
prior judgments not conclusive unless rendered on the same or equivalent evidence 1178
judgments on questions of inventive skill, legality, and scope of the patent, etc., always the same 1179
judgments on questions of priority, novelty, utility, abandonment, sufficiency of Description, good faith of inventor, and infringement, vary with the evidence presented 1179
judgments may be met with new opposing evidence when 1178
prior judgments of Supreme Court, effect of 1180
Circuit Courts, effect of 1181
on verdicts, hearings, motions for injunctions, by consent, by collusion, effect of 1182
effect of former judgments lessened by pending writ of error, bill of exceptions, or appeal 1182
answer denying that former judgment was rendered without full consideration is not scandalous 1181 *n.* 4
prior judgments in the Patent Office, effect of 1183
injunction issued on an interference judgment . . . 613
injunction issued against defeated party in interference if he stands on his own patent . . . . . 1198 *n.* 2
special act of extension conclusive . . . . . 1183 *n.* 6
public acquiescence in the patent, effect of 1174, 1185
acquiescence defined 1185
exists when 1185

Reference are to sections.

INJUNCTION — *continued.*
on motion for, weight of public acquiescence as evidence measured by degree and duration 1186
acquiescence, how manifested 1187
weight of, as compared with judgments 1188
judgments of weight only on points adjudged . . 1188
acquiescence of weight on any question of validity 1188
admissions of defendant as evidence of validity . . 1174, 1189
defendant when estopped to deny validity 1189
compromising suits, taking licenses, asserting rights under the patent, etc., are such admissions 1189
title of plaintiff 1190
injunction denied if a former judgment left title in doubt, or the bill vaguely stated possession, or the evidence conflicted 1170 *n.* 2
intended infringement by defendant 1191
previously decided points as to infringement regarded as settled . . . . . 1191 *n.* 2
injunction granted though no wrong yet committed . 1191 *n.* 5
irreparable injury must be threatened to the plaintiff 1193
none where patent about to expire 1193
remedy at law adequate 1193
license fee tendered . . . . . 1193 *n.* 2
granted where defendant insolvent, though damages a compensation 1193 *n.* 2
though past infringement released . . . . . 1195 *n.* 1
plaintiff must have been diligent in asserting his rights 1194
none granted where laches in plaintiff, or he has acquiesced unreasonably in the infringement 1194
plaintiff must have kept faith with the public 1195
none where plaintiff never used nor permitted the use of the invention 31 *n.* 1, 1195 *n.* 5, 1201 *n.* 4
none where it would work injustice . . . . . 1195 *n.* 3
plaintiff must have kept faith with the defendant 1195
none where plaintiff has misled the defendant, or violated his own contract with him 1195, 1208
none where defendant has entered into contracts understanding that a license fee was to be paid 1195
must be sought for proper purposes 1196
none where to be used as coercion in other matters 1196
of other parties 1196
may be granted against maker in one court and user in another 1182 *n.* 4
where defendant in good faith, when denied 1197
denied where defendant has in good faith invested large sums, and plaintiff can be otherwise protected 1197
denied if defendant in good faith claims a perfect defence 1197
granted though defendant had no evil intent 1197
refused where defendant acts under different patent 1198
granted notwithstanding defendant's patent when . . . . . 1198 *n.* 3
though defendant owns or is applying for other patents 1198 *n.* 1
refused pending contest in Patent Office . . . . . 1198 *n.* 3
denied where equity doubtful on the evidence 1199
denied where validity uncertain, judgments conflicting, patent open to various meanings, difficult questions raised, patent recent, or re-issue apparently too broad 1199
denied, and bond and account ordered if judgments conflict . 1199 *n.* 3
denied if title in litigation in local courts . . . . . 1199 *n.* 4
granted or refused on re-issues when . . . . . 1199 *n.* 6
though Claims of re-issue expanded . . . . . 1199 *n.* 6

References are to sections.

INJUNCTION — *continued.*
denied where patent has expired and legal defence exists . . 1199 *n.* 4
granted to prevent sale of patented articles after patent expires when 1193 *n.* 2
consequences to parties considered 1200
business interests of both parties kept in view 1200
consequences to defendant disregarded if plaintiff clearly entitled to injunction . . . . . 1200 *n.* 3, 1201
granted more easily against seller than maker . . . 1200 *n.* 1, 1201 *n.* 3
refused against mere user when . . . . . 1200 *n.* 1
not refused in order to allow defendant to complete a contract 1201 *n.* 3
refused against contractor on public works when . . . . . 910 *n.* 2
where public requires it and plaintiff otherwise protected 1200 *n.* 4
if consequences more disastrous to defendant or the public than useful to plaintiff 1200
granted though it may injure third parties . . . . . 1201 *n.* 2
plaintiff infringes other patents 1201, 1208
others join with defendant in infringing 1201
defendant thereby will break contracts 1201
owns the infringing articles 1201
refused if on the same proof it would be denied on final hearing . 1201 *n.* 4
if another is in force . . . . . 1200 *n.* 2
bond and account in lieu of 1202
substituted for, when . . . . . 1202 *n.* 1
not in lieu of in clear cases . . . . . 1170 *n.* 2
ordered when defendant has large interests at stake and is in good faith 1202
patent is about to expire 1202
defendant is a mere vendee 1202
plaintiff never uses the invention 1202
grants licenses 1202
guilty of laches 1202
priority is doubtful and honestly contested . . 1202 *n.* 2
law of the case uncertain . . . . . 1202 *n.* 2
injunction would affect rights under other patents . 1202
pending writ of error in Supreme Court . . . 1202 *n.* 2
may issue against public corporations 1203
city 1203
private corporations — their officers and stockholders 912, 1203
former partners of plaintiff 1203
infringing co-owners 1204
assignees, if infringers 1204
grantees, if infringers 1204
licensees exceeding license 1204
agents of infringers 1204
salesmen 1204
not issued against a licensee who ignorantly exceeds his license and stops on notice 1204
licensee of co-owner 1204
partner of licensee 1204
remote contributors to the wrong 1204
not issued if no further infringement is possible . . . . . 1205 *n.* 1
issued if defendant can repeat the infringement though he has now ceased 1205
not granted against representatives of deceased infringer unless they also infringe 1205
motion for, form of 1206
in aid of suit at law 1206

References are to sections.

INJUNCTION — *continued.*
motion for, in aid of suit in equity 1206
averments and prayer of motion 1206
in Federal courts, not granted without notice to defendant 1207
preceded by restraining order when 1207
notice of motion to defendant 1207
appearance of defendant 1207
answer of defendant, effect of 1207
evidence admissible on motion for 1208
how produced 1208
matters considered by the court on motion for 1208
hearing on motion for, procedure 1209
ex parte hearing 1210
contested hearing 1210
court may send issue to jury or master . . . . . 1210 *n.* 5
granted in spite of non-joinder of parties . . . . . 1210 *n.* 5
whether profits or damages recoverable 1211
though some Claims not infringed 1211
plaintiff misled the defendant unless it amounts to fraud or estoppel 1208
excessive Claims not sued on are not disclaimed . . . 651 *n.* 2
if defects are cured by disclaimer and the right is clear . . . 1210 *n.* 1
when defence of prior use fails . . . . . 1210 *n.* 3
denied if patent defective on its face . . . . . 1210 *n.* 2
may be issued *unconditionally or on terms* 1211
form and scope of 1211
may be fitted to each case 1211
may issue alone or with other orders for relief 1211
may confine the prohibition to future additions . . . . . 1211 *n.* 2
how limited when granted after patent expires 1211
when ordered by consent no other question decided 1211
bond of indemnity when required of plaintiff 1211
duration of effect 1212
effect outside local jurisdiction of court 1212
modifications of by court 1212
suspension of 1212
revival of when patent re-issued 1212
dissolution of 1213
application for, evidence on 1213
reasons for 1213
contempt of, unless obeyed till rescinded 1214
construction of for court, not parties 1214
defendant may ask the court for explanations of its scope 1214
not excused by good faith 1214
advice of counsel 1214
good faith may affect penalty 1214
what acts are 1215
whose acts are 1215, 1216
assignees of defendant 1204
principal through agents 1215, 1216
injunction against making 1215
using 1215
selling 1215
by doing or conspiring to do the forbidden act . 1215 *n.* 1
not by acts of assignee of defendant pending suit before injunction unless he was made a party . . . 1216 *n.* 3
by public boards disobeying injunction against city . 1216
by servants when master enjoined 1216
by officers when corporation enjoined 1216

References are to sections.

INJUNCTION — *continued.*
contempt of, attachment for, motion for, form of application 1217
hearing on 1217
evidence on 1217
issues open on 1217
defendant cannot attack patent when 1217
if new questions as to validity or infringement, new pleadings and evidence necessary 1217
procedure on 1217
evidence on . . . . . 1218 *n.* 1
knowledge of injunction equivalent to notice . 1218 *n.* 1
how defendant may discover 1218
violation procured by plaintiff not contempt 1218
order for when granted 1218
against whom . . . . . 1218 *n.* 1
only in clear cases 1218
penalty for 1219
how ascertained and applied by court 1219
subsequent control of court over 1219
no appeal from unless questions of law involved . . . . 1219 *n.* 9
effect of reversal on . . . . . 1219 *n.* 9
perpetual, when granted 1220
after patent expires 1220
extension 1220
scope of 1220
in favor of assignee 1220
right to not dependent on right to damages or profits 1220
duration of 1221
suspension of, grounds for 1221
not superseded by appeal 1221
when issued by consent, no other question decided 1222
effect of 1222
proceedings on when consent disputed 1222
not dissolved by conditional license 1222
dismissed if collusive 1222
contempt of 1223
attachment for 1223
dissolution of 1223
object of 1160
(See also ACTION IN EQUITY, BOND AND ACCOUNT, CONTEMPT, COURTS, DISSOLUTION, EQUITY JURISDICTION, ESTOPPEL, INFRINGEMENT, JUDGMENTS, JURISDICTION, LACHES, RESTRAINING ORDER.)

INJURIES to patented articles are simple torts remediable at law . . . . 884 *n.* 1
INOPERATIVENESS defined 660
INSANE PERSON, infringement by 921
INSOLVENT, patents of how reached by creditors 766
INSPECTION of defendant's invention ordered in equity . . 1041 *n.* 7; 1127 *n.* 2
INSTRUMENT defined 157
INTELLIGIBILITY of Description defined 492
INTENT to infringe may qualify acts otherwise innocent 901, 924
INTEREST in the patent, interest in proceeds of suit is not . . . . . 937 *n.* 2
on damages and profits when allowable 1066, 1152
when allowed on license fees . . . . . 1059 *n.* 1
capital in estimating profits 1139
INTERFERENCES 586–616
general sketch of 54
the only contested cases in the Patent Office 586

References are to sections.

INTERFERENCES — *continued.*
purpose of 580, 587
history of 587
deal with applications rather than applicants . . . . . 587 *n.* 1
patentee has no advantage over applicant unless he can show priority . 588 *n.* 4
priority the sole question in . . . . . 587 *n.* 1
title not in question in . . . . . 587 *n.* 1
when declared 426
decision of Commissioner as to necessity for is final . . . . . 591 *n.* 1
instituted only between pending applications or between them and unexpired patents 588
instituted in nine cases 591
"unexpired patent" defined . . . . . 590 *n.* 4
instituted whenever the Claims of a pending application conflict with those of another application or an unexpired patent . . . . . 588 *n.* 4
not instituted with unexpired patent until the applicant has been twice rejected thereon . . . . . 588 *n.* 4
instituted only between conflicting applications or an application and a conflicting patent 589
instituted though applicant has foreign patents older than rival patent . . 588 *n.* 4
not instituted between expired or conflicting patents or abandoned or forfeited applications 588
what applications are said to conflict 589
primary examiner must decide whether applications conflict . . 592 *n.* 1, 594 *n.* 1
instituted when applications are identical, or equivalent, or one embraces the other 589
instituted without reference to the names of the conflicting inventions . . . 589
not instituted with improper divisional applications . . . . . 589 *n.* 5
where record proves priority . . . . . 590 *n.* 1
when priority presumed 590, 591
instituted *nunc pro tunc* where one of the applicants improperly obtains a patent . . . . . 590 *n.* 4, 591 *n.* 1
instituted only when later applicant claims priority under oath 590
instituted between one application and two or more patents . . . . . 591 *n.* 1
sole inventor and his own joint patent . . . . . 591 *n.* 1
may cover what applications and patents . . . . . 594 *n.* 7
proceedings in 592–616
completion of specifications required when conflict discovered 592
notice to rival claimants of the existence of conflicting Claims 592
duties of claimants on receipt of notice 592
adverse parties may inspect files and conflicting specifications . . . 592 *n.* 1
conflicting applications first examined on their merits 593
questions of patentability settled when . . . . . 610 *n.* 1
no interference declared unless applicant found to be a true inventor 593
jurisdiction as to patentability or public use not vested in examiner of interferences . . . . . 606 *n.* 1
declaration of interference 594
no formal pleadings in . . . . . 594 *n.* 1
issues, definition of 594
scope of, notice of to applicants 594
jurisdiction of examiner of interferences over, is conclusive . . . 594 *n.* 8
preliminary statement, filing of 595
requisites of 595
disclaimer is not . . . . . 595 *n.* 4
need not fix exact date of invention . . . . . 595 *n.* 3
when conclusive as to dates 595
extension of time for filing 595
not returned to applicant after filing 595
amendment of 595, 597

References are to sections.

INTERFERENCES — *continued.*
preliminary statement, defects in when waived 597
necessary . . . . . 596 n. 1
effect of failure to file 596
judgment rendered in failure to file 596
what dates presumed for inventive act on failure to file 596
when conclusive 597, 600
examination of and action on 598
priority how determined by 598
evidence in how taken and when 599, 601
general rules of applied 600
rules of are those in force in the courts of the District of Columbia 601 n. 1
special rules of 601
power of Commissioner to make rules of 601
must conform to preliminary statement 600
what admissible 600
burden of proof 600
must affirmatively establish priority 600
of priority need not remove every reasonable doubt 600
weight of between applicant and patentee must be such as would defeat the patent in the courts . . . . . 600 n. 3
preliminary statement as 600
caveats and other records as 601
husband and wife not competent witnesses for or against each other in 601 n. 1
as to date of foreign invention 600
examiner of interferences decides all questions of . . . . . 600 n. 1
technical objections to disregarded 601
objections to how cured . . . . . 601 n. 4
motions to suppress . . . . . 601 n. 4
arguments of contestants 602
no hearing after argument 602
must result in judgment or dissolution 603
judgment of priority, who entitled to 603
does not affect a defeated patentee 603
rendered on evidence, or concession, or written abandonment . . . 603
requisites of concession 603
effect of concession 614
where neither party proves priority 603
rendered though patent already wrongfully issued to one contestant . 603
conclusive unless appealed from 604
appeal from 604
to whom taken, on what issues 604
procedure on 604
no appeal from Commissioner's judgment on appeal 604
Secretary cannot revise Commissioner's decision . . . . . 604 n. 3
not final except in Patent Office . . . . . 604 n. 4
bill in equity, will lie after appeal decided 604
does not stay other proceedings . . . . . 604 n. 4
dissolution of . . . . . 605, 606 n. 3
grounds for . . . . . 605, 608 n. 2
appeal from 605
suspension of 606
addition of new parties pending 606, 612
motions, practice, stay of proceedings 607
amendment of application by disclaiming the contested matter 608
contestant may withdraw from the contest and take a patent for his undisputed matter 608, 609
contestant may withdraw undisputed matter by amendment and contest the rest 609

References are to sections.

INTERFERENCES—*continued*.
remanded to examiner if non-patentability discovered by other officers . 610
effect of discovery of non-patentability 610
hearing re-opened as to novelty, how and when . . . . . 610 *n.* 2
new trials, grounds and rules of 611, 615
any number allowable 612
second not declared after judgment in same issues 611
when distinct from each other 612
consolidation of 612
estoppel in 614
judgment in, effect of . . . . . 54 *n.* 1, 611–613, 1183 *n.* 3
not binding on courts . . . . . 363 *n.* 2, 613
except as to priority . . . . . 613 *n.* 3, 1183 *n.* 3
as to patentability 984
defeated applicant may deny patentability 984
is evidence as to priority 1024
does not entitle the victor to a patent . . . . . 613 *n.* 2
no bar to an interference with other parties 612
affects only the applicants 588
parties to 616
assignees may institute 616
(See also APPEALS, APPLICATION FOR PATENT, CLAIM, COMMISSIONER, CONCEIVER, CONCEPTION, DATE, DESCRIPTION, DILIGENCE, DISCLAIMER, EXAMINERS, EXAMINATION, FOREIGN INVENTORS, IDEA, IDENTITY, INJUNCTION, INVENTION, INVENTIVE ACT, INVENTOR, JOINT INVENTION, JUDGMENTS, PATENT, PATENT OFFICE, PRIORITY, RACE OF DILIGENCE, REDUCTION TO PRACTICE, REPEAL, RIVAL INVENTORS.)

INTERFERING PATENTS, defined . . . . . 723 *n.* 3
INTERPRETATION of letters-patent (see CONSTRUCTION) 419, 731–751
"IN THE MANNER . . . MENTIONED," meaning of in Claim . . . . 517 *n.* 2
INVALIDITY, defined 660
INVENT, right to necessary and universal under natural law 28
restricted by patent privilege 28
INVENTION, relation to monopoly 753–756
fundamental theory of 103
its essential attributes fixed and unchangeable 74
Patent Law must conform to nature of 74
true nature of difficult to apprehend 73
but lately understood 75
defined, its essential attributes 59, 68, 150
not every new thing is . . . . . 78 *n.* 1
must be the product of inventive skill 68, 78, 109
essential attributes indicated by nature of inventive act 76
patentable may or may not be a vendible substance 160
may be an art or an instrument 133, 157
must produce physical effects 166
not a principle, a function, or an effect 133, 146
instances of what is and what is not . . . . . 78 *n.* 2
three groups of, — a force applied, a mode of application, a specific treatment of a specific object 101, 262
essence of ascertained by relegating it to its proper group 105
whether an art or an instrument, is a means not an end . . . . . 90 *n.* 2
narrows as the field of means narrows . . . . . 88 *n.* 2
nature of indicated by the want it satisfies . . . . . 88 *n.* 2
substance of includes whatever is needed to perform its function 235
form of includes whatever is not needed to perform its function 235
does not cover ideas not perceived by inventor . . . . . 79 *n.* 1
none made unless inventor comprehends it and can reproduce it 79

References are to sections.

INVENTION — *continued.*
abstract and concrete distinguished . . . . . 87 *n.* 2
unity of . . . . . 92 *n.* 1, 151
basis of the doctrine of . . . . . 92 *n.* 1
principal and subordinate are distinct units 152
may, as a concrete art or instrument, express different ideas of means 81 *n.* 3; 300 *n.* 2; 302
include joint and several inventions . . 401
conception of 376–382
perceiving a want and experimenting to relieve it is not . . 377 *n.* 3
idea that something could be done is not . . . . . 377 *n.* 2
not complete till reduced to practice 126
reduced to practice only when actually practised 127
though capable of improvement 120
inseparable, when . . . . . 471 *n.* 1
and subordinate of employee belong to employer when 304
simultaneous, probable frequency of . . . . . 20 *n.* 2
identity of two or more 589
equivalence, specific difference, generic difference 589
dependent on identity of force, object and mode of application . . 107, 270
forces, objects, and modes of application when identical 107
all inventions are either identical, or diverse, or related as original and improvement 273
exists when 229
a question of fact 272
exists in law when it does in fact . . . . . 272 *n.* 1
a question of grave difficulty 314
is in idea or substance, not in form 220
is identity of effect, function, and means 236
exists when same means produces same effect . . . . . 236 *n.* 1
absent if one could not be substituted for the other . . . . . 236 *n.* 1
if principle and result differ . . . . . 236 *n.* 1
if not identical in function 274
exists when same functions performed in same way . . . . . 236 *n.* 1
absent when same functions performed in different way . . . . 236 *n.* 1
consistent with diversity of form 275
of shape, size, capacity, proportions, arrangement, and materials 237
of use . . . . . 259 *n.* 1
of embodiment . . . . . 237 *n.* 1
exists if apparent when examined from inventor's point of view . . . 230
of patented inventions determined by the Claims . . . . . 505 *n.* 1
not involved in the question of double use 260
secret, is the property of the inventor 24
however used, belongs to inventor . . . . . 81, 259 *n.* 1
right to, dates from its discovery . . . . . 769 *n.* 1
unpatented, property in protected by law 847
wrongs and remedies (see UNPATENTED INVENTIONS) 867–883
public interest promoted by encouraging 36
rights of public under natural law 25
immediate disclosure, important to public 38
promoted by patent privilege 39
by patentee necessary 42
publication under American law . . . . . 42 *n.* 5
the chief merit under English law 42
after patent, property in protected by law 848
property in, consists of the exclusive right to use . . . . . 43 *n.* 2
nature and scope of . . . . . 408 *n.* 3
monopoly created by letters-patent 415

Reference are to sections.

INVENTION — *continued.*
not patentable, however valuable, unless covered by the law 66
unless new and useful 221
before 1836 unless new to the whole world 223
since 1836 patentable if new in United States 225
if patented, or published anywhere 226
to same inventor already 460
patentable though dependent on or collateral to a previously patented invention 466
accomplishing a new result must be new 117
new use of may be . . . . . 81 *n.* 3; 250 *n.* 1
re-organization of old one may be . . . . . 84 *n.* 1
utility of 338–344
absent when immoral or very dangerous 340
impracticable . . . . . 459 *n.* 1
it will not answer its purpose . . . . . 80 *n.* 2
not patentable if abandoned to public . . . . . 25 *n.* 2, 71, 345
once abandoned can never be recalled . . . . . 345 *n.* 1
not abandoned while application lies unfiled in the hands of attorney unknown to inventor . . . . . 551 *n.* 3
certain classes only patentable 59, 67, 69
classes of under acts of 1790 and 1793 . . . . . 69 *n.* 2
patentable classes 158
classification of in Patent Office . . . . . 53, 469 *n.* 2, 555
what may be covered by a patent (see APPLICATION FOR A PATENT).
to be treated as an art if possible 172
when simple or consisting of parts, radical differences in patents for 464
disclosure of, in patent before 1836 . . . . . 60 *n.* 1
best form of in patent 514
all forms covered by patent 514
joinder of in same patent 468–479, 522
dependency of on each other how determined 471
joint and sole, patents for, true rule of . . . . . 402 *n.* 3
priority shown by use, publication, or patent 316
date of on question of priority . . . . . 334 *n.* 1
novelty a question of priority 315
is *prima facie* proved by priority of publication . . . . . 42 *n.* 6
abandoned and forgotten is not prior use 323
future, not assignable but contracted for with right to specific performance . 771
increase in number under patent system of United States 63, 64
(See also ABANDONMENT, ABSTRACTION, AGGREGATION, APPLICATION OF PRINCIPLE, ART, CHANCE, CHEAPNESS, CLAIM, COLLOCATION, COMBINATION, COMPOSITION, CONCEIVER, CONCEPTION, DATE, DESCRIPTION, DESIGN, DISCOVERY, DIVERSITIES, DOUBLE USE, EFFECT, EMBODIMENT, END, EQUIVALENTS, FORCE, FOREIGN INVENTIONS, FUNCTION, GENERIC INVENTION, IDEA, IDENTITY, IMPROVEMENT, INVENTIVE ACT, INVENTIVE SKILL, INVENTOR, JOINDER, JOINT INVENTIONS, MACHINE, MANUFACTURE, MONOPOLY, NOVELTY, PACKING, PATENT, PATENTABILITY, PATENTED INVENTIONS, PRINCIPLE, PRIORITY, REDUCTION TO PRACTICE, RESULTS, SECRET INVENTION, UNPATENTED INVENTIONS, USE, UTILITY.)
INVENTIONS, agreement to assign not an assignment 771
INVENTIVE ACT, nature and elements of 108
how performed 959
two parts of, — mental or conception, physical or reduction 77
mental part defined 86
employs creative not imitative faculties 78
not an act of intellectual creation (Story, J.) . . . . . 78 *n.* 3
consists of discovery and construction 96
generates a new idea 78

References are to sections.

INVENTIVE ACT — *continued.*
generates a new idea of means, not end 87
discovers a new union of the force, the object, and the mode of application 95
does not generate either the force, the object, or the mode of application 92–94
discovery may relate to either or all the factors, — the force, object, or mode of application 100
order of, and the primary idea 231
function the second idea 233
means the final idea 233
seven forms of 98
both conception and perception necessary 70
not complete till inventor can communicate his idea to others 400
intention to create not necessary 70
produces a complete practical idea 80
is more than mere recognition of existing needs 80
full value of the idea need not be perceived 81
scientific principles of invention need not be perceived 82
may be instantaneous or prolonged 83
accidental or intentional 83
instigated by suggestions of others, books, etc. 84
physical part, or reduction, necessary . . . . . 77 *n.* 2, 125
continuous, — begins with conception, ends with reduction 373
shows the nature of an invention 76
when performed, tests of 110–123
how proved 600
when sole, when joint, proof of 1032
general review of the evidence of 124
date of, as to prior use . . . . . 132, 321 *n.* 1
may be shown 372
evidence of 132, 1024
averment of in bill in equity 1106

(See also ABANDONED EXPERIMENTS, CO-OPERATING INVENTORS, DILIGENCE, EXPERIMENTS, INTERFERENCES, INVENTION and titles there cited, JUDGMENT, MEANS, MODE OF APPLICATION, REDUCER, RIVAL INVENTORS, SUGGESTIONS.)

INVENTIVE SKILL, defined . . . . . 78 *n.* 2
a question of fact for the jury 109, 1022
is creative skill 68
neither industry, judgment, nor reflection are 78
and mechanical skill contrasted . . . . . 85 *n.* 1
and mechanical skill difficult to distinguish . . . . . 109 *n.* 2
and novelty distinct . . . . . 112 *n.* 1
relation of to novelty and utility 70
shown by utility 344
degree of, immaterial . . . . . 59 *n.* 1, 83 *n.* 2, 85
may exist though the advance is slight . . . . . 122 *n.* 1
involved sometimes in small discoveries . . . . . 78 *n.* 2
instances of its exercise . . . . . 78 *n.* 2
exists though invention suggested by defects in other devices . . . . . 84 *n.* 1
exercised in re-organizing old inventions based on wrong principles . . . 84 *n.* 1
evidence in proof or denial of 1022
must affirmatively appear . . . . . 70 *n.* 4
burden of proof, how satisfied 1022
court will take judicial notice of want of 1022
presumed from the patent unless contrary proved 1022
evidenced by the invention, not by the assertions of the inventor 109
shown by result . . . . . 85 *n.* 1, 113–121
by prior unsuccessful efforts of others 122

References are to sections.

INVENTIVE SKILL — *continued.*
shown when result reached by many steps . . . . . 123 *n.* 1
by prior attempts of same inventor 123
by oath of inventor if legal novelty exists 123
not by increase in simplicity, cheapness, excellence, or convenience 240 *n.* 1
(See also INVENTION and titles there cited, INVENTIVE ACT and titles there cited, INVENTOR, JUDICIAL NOTICE, MECHANICAL SKILL.)
INVENTOR, defined 57, 68
creates the means, not merely perceives the end 88
conceiver not mere reducer is . . . . . 375 *n.* 1
entitled to benefit of doubt on question of inventive skill . . . . . 109 *n.* 2
need not comprehend the scientific principles of the invention 82
must comprehend scientific principles if his invention consists of them . . 82 *n.* 1
may avail himself of the suggestions or experiments of others . . . . 84 *n.* 1
may gather ideas from books or prior patents . . . . . 84 *n.* 1
presumed to know all prior inventions identical with his . . . . . 112 *n.* 1
matters familiar in the art . . . . . 99 *n.* 1, 112
not concluded by the reasons given in the specification for the operation of his invention . . . . . 485 *n.* 3
may prove his inventive act, how 1023
rights in his undisclosed invention under natural law 24
necessity of encouraging in some mode 36
stimulated by patent privilege 37
patent privilege a proper reward for 35
entitled to reward from public 34
right to patent under later English law 14
right of is the right to exclusive practice of the invention . . . . . 61 *n.* 3
alone entitled to patent 57, 67, 362, 363
obligations of public to, under contract theory of patent privilege 43
entitled to patent as soon as invention complete 403
first and original, alone entitled to patent 58
entitled to patent though one already issued to his rival . . . . . 586 *n.* 1
first inventor, defined 58
was earliest applicant, under English law 371
is earliest conceiver, under American law 372
as against all the world before 1836 58
in the United States since 1836 58
first applicant regarded as, till contrary shown . . . . . 600 *n.* 3
cannot concede priority to others 363
original inventor, defined 58
rightful inventor is the earliest reducer if also the earlier or a contemporaneous conceiver 374, 375
may employ others to reduce to practice 131
entitled to inseparable ancillary inventions of employees 394
not entitled to separable ancillary inventions of employees 395
right to complete protection upon proper disclosure of his invention to the public 43
right to a perfect patent 653
entitled to all the benefits of his invention . . . . . 81 *n.* 2, 3
remedies liberally applied when his rights are violated 846
obligations of, under contract theory of patent privilege 42
bound to good faith and reasonable diligence in disclosing his invention . . 644
must disclose to the public the best form of his invention 514
cannot have invented what he cannot describe . . . . . 490 *n.* 3, 665
duty to put his invention into practical use . . . . . 43 *n.* 2
not entitled to injunction unless he uses his invention . . . . . 31 *n.* 1
must apply for patent, if living 449
may prosecute his own application before the Patent Office 425
not prejudiced by delays and errors in the Patent Office . . . . . 451 *n.* 4

References are to sections.

INVENTOR — *continued.*
need not claim all his inventions 508
may assume that persons who examine his patent will be skilled in the art 488 *n.* 2
may assign his right to obtain a patent . . . . . 308 *n.* 1
assignee of, may obtain a patent 308
may dispose of his right to obtain a patent by his will 403
deceased, patent grantable to representatives of 367
rights and duties of executors of 406–407
sole may have an interference with a joint patent in which he is one of the patentees . . . . . 591 *n.* 1
INVENTORS, producing same invention, three classes of 306
rival, co-operating, and joint, defined 306
respective rights of 306
simultaneous, rights of destroyed by monopoly of patentee 29
rival, effect of delay in applying for a patent on . . . . . 346 *n.* 1, 390
domestic and foreign, priority between 382
co-operating (see CO-OPERATING INVENTORS) 302–305
joint (see JOINT INVENTORS) 306–402
(See also INVENTION, INVENTIVE ACT, INVENTIVE SKILL, and titles cited under them.)
ISSUES, when the same 1177

JOINDER, of causes of Action in equity 1108
of Inventions, in same patent 468–470, 522
theoretically incorrect but permitted 468
application of doctrine difficult 479
no inflexible rule of . . . . . 469 *n.* 2
rules of courts and Patent Office differ 469
rules in the courts 470
Patent Office 471
rules refer only to complete inventions . . . . . 471 *n.* 2
what inventions are capable of . . . . . 669 *n.* 1
not when invented by different persons . . . . . 470 *n.* 1
not when of different classes unless inseparable . . . . . 469 *n.* 2
not when independent in nature and use 470
when capable of common use 470
if mutually dependent 471
generic and specific . . . . . 471 *n.* 4
combinations, sub-combinations, elements, etc. 472
aggregations cannot be joined . . . . . 472 *n.* 2
arts, apparatus, product 473
machines, processes, products 474
manufactures, processes, apparatus 475
compositions, ingredients, process, apparatus 476
designs 477
improvements 478
Patent Office to determine when allowable . . . . . 469 *n.* 2, 471 *n.* 1, 479
doubt resolved in favor of applicant . . . . . 469 *n.* 2
misjoinder curable by disclaimer . . . . . 642 *n.* 1
in re-issues 669
(See also APPLICATION FOR PATENT, CLAIM, DESCRIPTION, DISCLAIMER, INVENTION, LETTERS-PATENT, PATENT, RE-ISSUES.)
JOINT INFRINGERS, living in different districts, local jurisdiction over . . . 936
JOINT INVENTION, forms of 397–399
by community of mental effort 397, 399
by community of experiment 397, 399
date of conception of 400

References are to sections.

JOINT INVENTION — *continued*.
may be united with several invention in the same art or device 401
requires joint patent, sole patent void 402, 1032
sole patent for, not curable by re-issue 600
evidence as to 1032
JOINT INVENTORS 396–402
defined 866, 396
one cannot abandon the invention to the public . . . . . 347 *n.* 1, 402 *n.* 3
(See also JOINT INVENTION.)
JOINT OWNERS OF LETTERS-PATENT (see CO-OWNERS) 795–799
JOINT PATENTEES, are not partners . . . . . 402 *n.* 2
estopped to claim that the invention was sole 1021
may file sole application and have an interference with the joint patent 591 *n.* 1
(See also ACTION AT LAW, ASSIGNMENT, CO-OWNERS, ESTOPPEL, INFRINGEMENT, MONOPOLY, PARTNERS, PATENT, PATENTED INVENTIONS, PATENTEE, RE-ISSUES, TITLE.)
JOINTLY, meaning of . . . . . 751 *n.* 5
JUDGMENT not inventive skill 78
JUDGMENTS, when conclusive 1175
between same parties on same issues, effect of 1177, 1184
not *res adjudicata* unless it appears that parties and issues were the same 1177 *n.* 3
between same parties, effect of 1176
binding on whom . . . . . 1048 *n.* 1
conclusive on actual as well as nominal parties 1176
between parties, privies, contributors to expense of suit, subsequent owners, co-grantees, etc. . . . . 1176 *n.* 2
of priority binding only on parties and privies . . . . . 1179 *n.* 2
against principal not binding personally on agent . . . 1176 *n.* 3, 1216 *n.* 3
binding on defendant who assigns pending suit unless he withdraws from the record . . . . . 1215 *n.* 1
against senior patentee does not affect junior unless inventions identical 1177 *n.* 3
against vendor no protection to vendee . . . . . 983 *n.* 1
between different parties, effect of 1179, 1184
when interpreting the patent 1017
on questions of inventive skill, legality of patent, scope of Claims, etc., always the same whoever be the parties 1179
on questions of priority, novelty, utility, abandonment, sufficiency of Description, infringement, and good faith of inventor, when open to contradiction 1179
in assumpsit against licensee a bar to suit for infringement . . . 1250 *n.* 1
in test case may bind the parties in all the other cases 1176
on same issues only are precedents 1177
conclusive only on the issues decided 1177
judgment for and payment of nominal damages for one act no bar to suit for another . . . . . 983 *n.* 1
judgment on the original, effect of on re-issue . . . . . 1179 *n.* 1
judgment sustaining one patent or Claim may support another when 1177 *n.* 4
judgment leaves all questions open when what it does decide is uncertain 1177 *n.* 3
judgment sustaining several patents is of less weight than if but one were in issue . . . . . 1177 *n.* 4
on same evidence, alone conclusive 1178
if on same issues, are followed 1178
judgment as to infringement not conclusive in other cases . . . 1179 *n.* 2
concurrence of adds to weight in other cases 1181
conflicting, effect of 1184
in patent cases, effect of 983

JUDGMENTS — *continued.*
against the patent, effect of 1184
sustaining patents do not ratify their defects . . . . . 1174 *n.* 1
effect of as estoppel 1017
as to validity not conclusive unless direct and affirmative . . . . 1177 *n.* 1
prima facie evidence on all points decided . . . . . 1179 *n.* 1
as evidence of validity 1174–1184, 1188
when of little weight as evidence 1175
weight of affected by changes in the law . . . . . 1177 *n.* 3
interlocutory, effect of 983
in motions for injunctions, effect of on subsequent cases 1182
by consent, effect of on subsequent cases 1182
without collusion are of great weight . . . . . 1177 *n.* 2
collusive, effect of on subsequent cases 1182
pro forma, effect of on subsequent cases . . . . . 1182 *n.* 2
on hearings, effect of on subsequent cases 1182
on verdict, effect of on subsequent cases 1182
when bill of exceptions filed 1182
not binding in court of equity . . . . . 1182 *n.* 5
of Supreme Court, effect of on subsequent cases 1180
of Circuit Courts, effect of on subsequent cases 1181
not reviewed in co-ordinate courts . . . . . 1181 *n.* 3
of State courts in patent cases, effect of . . . . . 1017 *n.* 2, 1184 *n.* 2
not *res adjudicata* on questions of title . . . . . 983 *n.* 2
of Probate courts, effect of . . . . . 1184 *n.* 2
in the Patent Office, effect of on subsequent cases 1183
not conclusive . . . . . 1017 *n.* 2
not effective till put in proper official form . . . . . 572 *n.* 3
in interferences, effect of 611–613
not binding on courts . . . . . 303 *n.* 2
does not estop defeated party to deny patentability . . . . . 984 *n.* 7
at law enforceable anywhere 1097
in equity enforceable only within local jurisdiction of court 1097

(See also ACTION IN EQUITY, ACTION AT LAW, CIRCUIT COURTS, COLLUSIVE SUIT, COMMISSIONER, COURTS, DECREE, ESTOPPEL, INJUNCTION, INTERFERENCES, JURISDICTION, PATENT OFFICE, PROBATE COURT, RE-ISSUES, STATE COURTS, SUPREME COURT, VERDICT.)

JUDICIAL COMITY, how far operative on different questions 1179, 1181

JUDICIAL NOTICE, courts take when 1009
of want of inventive skill 1022
that invention not legally patentable . . . . 962 *n.* 3, 968, 1025, 1033, 1115 *n.* 2
by Patent Office, of matters of public notoriety . . . . . 558 *n.* 2

JUDICIAL SALES of letters-patent 766, 803–805
difficulty of subjecting letters-patent to 803
made by court or agent thereof invalid 804
owner must assign in some form 804
effected by compelling owner to assign or appointing a trustee for that purpose 805

(See also ASSIGNMENT, BANKRUPTCY, CREDITOR'S BILL, INSOLVENT, PATENTED INVENTION, PROBATE COURT, RECEIVER.)

JURISDICTION, rules of, not changed by Patent Law . . . . . 934 *n.* 1
over actions for infringement 62
at law or in equity, in what courts 933, 934
in common law courts by Stat. Jac. 1 931
of Federal and State courts in patent cases . . . . . 62 *n.* 2, 853–866
objection to on ground of subject matter not removed by waiver, laches, or consent 863, 866
over plaintiff, obtained how 934
none till all plaintiffs are in court . . . . . 1093 *n.* 3

References are to sections.

JURISDICTION — *continued.*
over defendants, obtained how 934
local, not conferred by existence or attachment of property . . . . . 934 *n.* 4
over domestic and foreign corporations 935, 936
where circuit embraces several districts 936
over joint infringers 936
in suits for infringement under act of 1887 . . . . . 934 *n.* 3
want of, how pleaded . . . . . 950 *n.* 1
objection to must be taken before pleadings close and the evidence is published 866 *n.* 4
(See also ACTION IN EQUITY, ACTION AT LAW, COMMISSIONERS, COURTS, EQUITY, EQUITY JURISDICTION, FEDERAL COURTS, INTERFERENCES, JUDGMENTS, MANDAMUS, PATENT OFFICE, PROBATE COURT, RE-ISSUES, REPEAL, RESCISSION, SLANDER, STATE COURTS, SUPREME COURT.)
JURY, judgment of in patent cases not as reliable as that of a judge . . . 1182 *n.* 1
trial by in equity 1124–1126
questions of fact for . . . . . 988 *n.* 1, 1075
inventive skill 1022
legal patentability 1025
prior use . . . . . 1026 *n.* 3
equivalence . . . . . 240 *n.* 1
prior patent . . . . . 1027 *n.* 3
abandonment . . . . . 347 *n.* 1, 350
identity of two patents, when . . . . . 1014 *n.* 4, 1019
what patent applies to . . . . . 732 *n.* 1
fraudulent specification 1034
excessive Claim 1036
utility in cases between assignor and assignee . . . . . 1230 *n.* 7
cannot give actual damages when only nominal are proper 1068
(See also ACTION IN EQUITY, ACTION AT LAW, CHARGE, JUDGMENTS, VERDICT.)

KNOWLEDGE, matter of public, not patentable . . . . . 112 *n.* 1
KNOWLEDGE AND USE, defined 226
KNOWLEDGE, alone does not show priority . . . . . 316 *n.* 1
or use to defeat novelty must be complete and practical 227
without use may defeat novelty 226
KNOWN OR USED, means accessible to the public 226

LACHES, a defence favored in equity 1114
of plaintiff may forfeit right of action in equity 1114, 1194
to recover for past infringements 1114
of plaintiff may furnish reason for denying injunction 1194
no absolute bar to an injunction . . . . . 1114 *n.* 3
in equity what is, and is not 1114
delay in suing is, when 1194
unavoidable delay is not 1114
delay after one suit is brought, or pending suit, is not 981, 1114 *n.* 4, 1194 *n.* 7
involuntary acts or omissions are not 1194
of assignor binds assignee 1194
(See also ABANDONMENT, ACQUIESCENCE, ACTION IN EQUITY, ACTION AT LAW, APPLICATION FOR PATENT, ATTORNEYS, CONCEIVER, DATE, DELAY, DILIGENCE, DISCLAIMER, ESTOPPEL, INJUNCTION, INVENTIVE ACT, LICENSE, RE-ISSUES, RIVAL INVENTORS, UNREASONABLE DELAY.)
LAW AND EQUITY JURISDICTION, not concurrent 1084
LAW, Commissioner's judgment on question of, is never final . . . . . 617 *n.* 3
LEGAL OWNER, cannot sue equitable owner for infringement . . . . . 937 *n.* 2

References are to sections.

LEGAL REPRESENTATIVE, is the executor or administrator . . . . . 404 n. 2
LESSOR OF INFRINGER, not enjoined 1204
LETTERS-PATENT, defined . . . . . 1 n. 1
grant of, a matter of right not favor under later English law 14
object of, twofold 420
to create and define the patent privilege 415
issue of, governed by statutes and Patent Office rules 422
grantable by special act of Congress 420
Patent Office created to secure correct and lawful 416
to whom issued 610
subject-matter of 459–470
application for (see APPLICATION FOR PATENT).
protest against issue of 618
grant of 422–632
when complete 620
take effect, as a grant, when 621
form of 60, 620
before 1836 . . . . . 60 n. 1
contents, signatures, etc. 620
illegal, if statutory prerequisites not fulfilled 423
need not recite that prerequisites fulfilled . . . . . 451 n. 5, 620 n. 1
grant of, a judgment that all prerequisites are fulfilled . . . 51 n. 3, 617
not invalidated by omission of application oath 458
must accurately disclose and define the invention 415
term of under early English law 18
date of 621
not antedated 621
relates back to date of application . . . . . 621 n. 2
patent-privilege created at date of issue of 428
delivery of 621
how and to whom delivered 585
no delivery necessary to validity . . . . . 627 n. 1
recording of 627
open to public after record 627
are public records, and knowledge of them by all is presumed 112 n. 1, 627 n. 2
copies of, as evidence 627
amendment of 633–715
avoided for slightest causes under earlier English law . . . . . 14 n. 3, 4
not amendable under early English law 16
amendment under later English law, Stat. 5 & 6 W. IV. 16
leads to abuses 16
amendable by Patent Office in the United States 417
defects in, classes of, modes of amendment 636
clerical errors in 637–639
defined 637
errors of substance not 638
how corrected 637
corrections relate to what date 639
not to affect intervening rights 639
right to correct lost by delay 639
language as construed by the courts binds the patentee however it departs from his invention 633
frequent divergence from actual invention possible 633
divergence from actual invention formerly incurable 633
now curable 634
covering more than actual invention formerly held fraudulent . . . 633
power to amend to correspond to the invention is not the power to amend the invention or change the patentee 635

References are to sections.

LETTERS-PATENT — *continued.*
cannot change scope of monopoly . . . . . 035 *n.* 1
by disclaimer 040–052
by re-issue 053–715
construction of 731–751
interpreted by courts 419
strictly construed under early English law 16
repeal of 716–730
by courts not Patent Office 418
transfer of 420, 752–834
assignment of 762–794
extension of 421, 836–845
under later English law 18
avoided on proof of prior use under early English law 17
validated in spite of prior use under later English law 17
number and increase of in United States since 1836 68
(See also Action in Equity, Action at Law, Alien, Amendment, Application for Patent, Assignment, Construction, Contract, Co-owners, Copies, Creditor's Bill, Date, Defects, Description, Disclaimer, Drawings, English Patent, Errors Clerical, Executors, Extension, Foreign Patent, Identity, Infringement, Interferences, Joinder, Judicial Sale, License, Model, Monopoly, Patent, Patent Office, Patented Inventions, Patentee, Prior Patent, Record, Re-issues, Repeal, Signatures, Slander, Term, Title, Transfer.)

LIBEL against a patented invention (see Slander) 886–889

LICENSE 800–834
what is 800–809
anything less than assignment or grant is 800
distinguished from assignment and grant . . . . 763, 791, 792, 800, 1224 *n.* 1
may operate throughout entire United States 763
transfers invention not monopoly 807
may cover the three rights to make, use, or sell 763
does not affect the monopoly except by estoppel 763, 806
merely waives the monopoly as against the licensee . . . . . 806 *n.* 2
any transfer which does not carry the monopoly is 800
character indicated in words of grant, or by reservations, or covenants, or implied from the tenor of the license 808
any transfer of less than the entire interest in the patented invention or an undivided part of it is 808
transfer not conferring exclusive right to practise the invention is 763
transfer of exclusive right to make, use, and sell, is an assignment 814
transfer of exclusive right to make *or* use *or* sell, or any two of these, is a license 763, 808
transfer of exclusive right to use is a license . . . . . 792 *n.* 2
transfer of non-exclusive right to make *and* use *and* sell is a mere license . . 763
transfer of exclusive right to make and use and sell in a particular form or for a particular purpose is a license 808
transfer of exclusive right to make and sell may carry the right to use and then is an assignment 808
transfer with covenants implying rights in the alienor is a license 808
leaving any exclusive right in transferor is a license 763
reserving to the grantor a right to make or sell is a license 808
reserving right to use is an assignment with license back to assignor 808
binding alienor to protect alienee from infringements is a license . . 808
agreement not to sue may be . . . . . 808 *n.* 2
compromise of suit may be 809
of rival patentees for self-defence is a mutual . . . . 808 *n.* 2, 809
admission by defendant that he has infringed and by plaintiff that the defendant has satisfied him for it, is not . . . . . 809 *n.* 4

References are to sections.

LICENSE — *continued.*
contract to sell or license in the future may be 708, 809
insufficient assignment or grant may be 809
contract of workman to give employer the benefit of his inventions is . 808 *n.* 2
rests on common law . . . . . 930 *n.* 4
governed by State law 806
Federal courts may decide whether a license exists . . . . . 806 *n.* 8
subject to the general incidents of contracts 806
contracts arising from protected by law 849, 851
a personal contract and usual remedy is at law 1244
equity will not interpret nor prevent results of mistakes in . . . 1244 *n.* 3
by whom granted 815
granted by sole owner, co-owner, or grantee 815
invalid, unless licensor an owner of the patent 915
if licensor had assigned all his interest . . . . . 815 *n.* 5
carries no rights exceeding those of licensor 815
by one co-owner, valid against the others 815
cannot be exclusive 815
may be granted by promisee under parol contract to assign . . . 708 *n.* 2
by parties admitted by the patentee to be licensors is a defence for acts performed before notice to the contrary is given . . . . . 981 *n.* 6
rule of *caveat emptor* applies to 815
subject to all prior conveyances 815
does not diminish licensor's power to assign 705
how affected by licensor's subsequent assignment 782
not avoided, if irrevocable, by any subsequent transfer of licensor . . . 817
exclusive, form and effect of . . . . . 814, 1246 *n.* 2
non-exclusive, form and effect of 814
exclusive, invaded by licensor how 1246
upon condition, effect of breach 915
may be express or implied 809
express, may be written or oral, and in any form 809
to sell as agent may be oral . . . . . 808 *n.* 2
written, merges all prior parol agreements and oral evidence is inadmissible to vary it 818
in possession of defendant presumed authentic 1044
in hands of licensee throws burden of proof on one who alleges it was an escrow . . . . . 809 *n.* 4
may be granted before the issue of patent . . . . . 806 *n.* 2
under expired patent not fraudulent . . . . . 806 *n.* 3
may transfer either the right to make, or to use, or to sell 810
under one patent or Claim no protection against another . . . . 916 *n.* 2
to make, effect of 811
article covered by several patents avails as to all 811
does not carry the right to use or sell unless necessary to the enjoyment of the license 811
under foreign patent does not authorize the sale in the United States . . . . . 811 *n.* 3
by optional contract to purchase does not permit the making of infringing articles . . . . . 916 *n.* 7
to use, scope of, depends on nature of invention 812
covers only the invention specified 812
unless restricted in terms, gives right to use to any extent and anywhere, during the term 812
express restrictions binding on licensee 812
examples of restrictions in . . . . . 812 *n.* 1–8
violation of express restrictions is infringement 812
on certain conditions warrants the use only under such conditions 812 *n.* 5

References are to sections.

LICENSE — *continued.*
express, to use to a certain extent, or in certain ways, or for certain purposes, forbids all other uses 812
an art, carries the right to do anything the patent prescribes . . 812
a certain number, carries the right to keep the number complete . 812
once only, makes other uses infringements . . . . . 812 *n.* 5
in a certain shop, place, or business, prohibits use elsewhere . . 812
at a certain shop, if the license be personal, does not permit use elsewhere . . . . . 812 *n.* 3
in one place, not forfeited by wrongful use in another . . 812 *n.* 3
at specified place, not extended to other places by demand of royalties for such unlicensed use by licensor's agent . 812 *n.* 3
at certain place, not transferable . . . . . 812 *n.* 3
an instrument, gives no right to make and sell unless the use necessitates it 812
carries right to repair while identity remains 812
and sell, exclusive of all others, carries right to make . . 812 *n.* 6
and make, exclusive of others, carries right to sell . . . 812 *n.* 6
though not transferable does not forbid executor of licensee to sell articles on hand at his death . . . . . 910 *n.* 7
to sell usually coupled with license to make 813
may be restricted as to time, place, or quantity 813
for certain uses only, is valid 813
and make, may be restricted as to one right and not the other . . 813
the product and use the art, effect of 813
of a machine anywhere is conferred by a license to use it . . . . . 813 *n.* 1
and make, carries the right to use . . . . . 813 *n.* 3
and use, carries the right to make if necessary to the enjoyment of the license 813
if exclusive, will be protected against third parties by injunction 1255 *n.* 3
expires with original term of patent 816
license to use, or make and use, patented articles, not specified in article or number, expires with patent 816
license to use, or make and use a specific article authorizes the use till the article is used up, though patent extended 816
may run during extension . . . . . 1251 *n.* 1
but not unless so expressed 816
license to use an art continues under extension when 816
license under original patent waived by taking new one under extension 816
license under extension admits that a former license did not cover the extension . . . . . 816 *n.* 2
license to use to certain person ceases at his death . . . . 812 *n.* 5, 816
license to certain person authorizes his executor to sell the articles among his assets . . . . . 816 *n.* 11
record not required 785, 817
not constructive notice 817
scope of, measured by that of patent 818
construction of 818
by the Claim to which it is limited . . . . . 818 *n.* 4
by itself, not by the moral conditions outside it . . . . . 818 *n.* 1
by conduct of the parties under it 818
several, constituting one contract, construed together 818
granted before patent, construed by the patent as granted 818
reciprocal rights and duties of parties under 819
licensee entitled to the licensed privileges and to protection therein from others, if he fulfils his contract 819

LICENSE — *continued.*

licensor breaks the contract by enjoining licensee . . . . . 810 *n.* 2
by licensing others gratuitously or permitting infringements 810
licensor cannot contract with other parties against the interests of his licensees . . . . . 810 *n* 2
licensee claiming a reduction of royalties to compare with later licensees must assume their burdens . . . . . 810 *n.* 2
licensor not enjoined from suing for license fees because he charges more than he agreed, the remedy being at law . . . . . 810 *n.* 2
exclusive license does not warrant against infringements . . 810 *n.* 2
licensor fulfils his agreement to prosecute infringers if he stops them in any way . . . . . 810 *n.* 2, 1240 *n.* 3
licensor not bound to protect licensee against those who claim under adverse patents . . . . . 810 *n.* 2, 1240
licensor not estopped to deny validity of the patent when sued by licensee for not prosecuting infringers or for licensing others 810 *n.* 2, 1240
licensor's covenant to sue infringers does not prevent licensee from suing in his name . . . . . 938 *n.* 4
license at option of licensee does not protect him unless he exercises his option . . . . . 915 *n.* 3
surrender by one co-licensee does not bind others 819
violation of by licensee, is infringement . . . . . 822 *n.* 4, 910
license binds licensee though he did not read it . . . . . 810 *n.* 1
licensee must fulfil his contract or he is liable for the breach and as an infringer 810
violating the license may be sued on the contract or for infringement . . . . . 810 *n.* 4
examples of violation by licensee . . . . . 810 *n.* 1
estoppel of licensee 820
licensee estopped to deny validity of patent by express covenants . 820
covenant not to deny validity enforceable . . . . . 820 *n.* 4
cannot estop himself to deny that he infringes 810 *n.* 1, 910 *n.* 1, 970 *n.* 6, 984, 1250 *n.* 3
estopped to deny validity while he enjoys the benefit 820
vendee of licensee may deny validity . . . . . 820 *n.* 1
assignor taking license from his assignee is estopped to deny validity 820 *n.* 1
licensee stamping articles with the patent mark cannot deny that the patent is valid as to them 820
licensee not estopped after licensor repudiates . . . . . 820 *n.* 2
no estoppel under expired license 820
offer to take license works no estoppel 820
royalties, the consideration for the license 821
licensee liable for till evicted 821
failure to pay is not infringement though equity may rescind the license 821
demand for to be made by licensor 821
defendant claiming license ordered to pay overdue fees . . . 821 *n.* 4
oral conditional release no defence to suit for fees . . . . . 821 *n.* 4
consideration for, failure of, effects of . . . . . 1224 *n.* 1
if patent invalid an exclusive license with agreement to assign is without consideration . . . . . 814 *n.* 1
revocable for cause if not irrevocable 819
unconditional for term of patent is irrevocable 819
if paid for by gross sum in advance is irrevocable 821
forfeiture by breach of condition 822
but not unless so stipulated 822

References are to sections.

LICENSE — *continued*.
optional with licensor when . . . . . 810 *n.* 6
for abandonment of license or direct hostility to licensor 822
abandonment of exclusive license by licensee authorizes licensor to license others . . . . . 1240 *n.* 1
not forfeited for infringement outside the license 822
not forfeited by mere non-payment of fees . . . 822, 979 *n.* 3, 1240 *n.* 3
licensee failing to pay royalties still owns the license as against subsequent alienees . . . . . 822 *n.* 5
not forfeited at will of licensor, but must be rescinded in equity . . 822
rescission at suit of licensor in equity 822, 1240
not rescinded by licensor's prohibition . . . . . 1245 *n.* 2
by mere notice to licensee . . . . . 1240 *n.* 3
by mere breach without suit 1240
notice of licensor to licensee that he claims forfeiture . . . . 822 *n.* 3
rescinded when licensee wrongfully assigns or neglects to make and sell 1240
licensor not aided when he has broken his own contract . . . 822 *n.* 5
after rescission both parties stand on their original rights . . 810 *n.* 6
licensee may defend like any other infringer 979 *n.* 3, 1044 *n.* 10, 1250 *n.* 3
repudiation by licensee, when 820
notice to licensor necessary . . . . . 820 *n.* 2
effect of repudiation 820
revokes the license *ipso facto*, not a mere ground for revocation . . 822
license repudiated, rescinded, or abandoned no longer protects licensee 915
repudiating licensee cannot set up license in his defence . . 810 *n.* 5, 822
cannot claim estoppel against licensor 822
purchaser with notice from repudiating licensee is an infringer 810 *n.* 5
rescission at suit of licensee when 1245
rescinded for fraudulent representations of licensor as to salability of the invention . . . . . 819 *n.* 2
transferable only when such intention appears 823
generally personal and not transferable . . . . . 823 *n.* 1
license to use, or make and use, is personal and not transferable 823 *n.* 1
license cannot be apportioned to others by licensee . . . . 823 *n.* 1
license on annual royalties follows same rule of transfer as a lease 823 *n.* 6
license to licensee "and his assigns" not always transferable . . . 823
license to use "in his own business" or "at his shop" not transferable 823
license to use to a certain amount on payment of gross sum is *prima facie* transferable 823
license to use in a certain way does not vest in licensee's executor except to settle his estate . . . . . 823 *n.* 1
license to use is subject to a judgment in favor of licensor . . 823 *n.* 1
unauthorized transfer how ratified by licensor 823
license to partnership not affected by change of members or by dissolution when 823
license to persons named as partners vests in them personally, not in a receiver of the firm . . . . . 823 *n.* 5
judgment in suit by former partner against the firm, as surety for its royalties, binds the firm . . . . . 823 *n.* 6
license to partnership does not vest in a corporation composed of the same persons . . . . . 823 *n.* 5
license to a corporation may vest in a receiver and interference with him be a contempt of court . . . . . 823 *n.* 5
transferees of license take it subject to all burdens 823
implied, to use or sell when 1044
not from mere ownership of the invention . . . . . 824 *n.* 1

References are to sections.

LICENSE — *continued.*
implied, in favor of vendee, *purchasing patented article at lawful sale* . 824, 917
only when sale is lawful and unconditional 824
where sale made, without restriction, by patentee, assignee, grantee, unlimited licensee, sheriff levying on assets of patentee or of another person with patentee's consent 824
when sale made under foreclosure to which patentee is a party 824 *n.* 7
not in favor of purchaser from a licensee who he knows has forfeited his license . . . . . 824 *n.* 6
not where vendor had no right to sell 828
covers only the article sold or other articles necessary to its use . . 825, 917 *n.* 4
carries the right to use under other patents of licensor if not otherwise available . . . . . 1191 *n.* 8, 1204 *n.* 4
applies where the parts or materials of the article are the patented invention 825
does not apply when the parts or materials of the patented article are sold 825
gives vendee the right to use the article at any time, anywhere, and for any purpose, unless sale was restricted 820
vendees of grantee may use anywhere 793
unless restricted by the grant, or in territory of prior grantees 820 *n.* 2
vendee of patentee in a foreign country may use anywhere . . 820 *n.* 2
license of vendee continues till article used up 824, 820
article not used up while its identity remains 824
may be repaired to any extent 820
cannot be rebuilt or replaced by new 827
sold as article of traffic 827
vendee's rights under this license rest on common law, not on Federal statutes 828
are not affected by prior agreements of vendor of which he had no notice 828
are not affected by subsequent acts of vendor 828
acts of Congress 828
in favor of vendee purchasing patented article at unlawful sale . . . 829
arises if either vendor or vendee acquire an interest in the patented invention 829
if vendor compensates owner of the patent for the sale, provided he enjoys the monopoly by licensing or by making and selling, not if he maintains an exclusive use 830, 917, 1065
if vendor actually pays, or satisfies the owner, not merely when a judgment is rendered or nominal damages given 830, 834
in favor of owner of an article who had permission from the patentee to use it before the patent issued . . . . . 831, 917, 1191 *n.* 8
owner of article who had permission to use under original may use under re-issue or extension 917
license not implied from long unlawful use . . . . . 824 *n.* 1
unlawful use under defective patent 334, 917 *n.* 3
capture of the invention by American ship 824 *n.* 1
sending persons to buy of suspected infringer 824 *n.* 1
license implied from submission of the invention to the use of the United States . . . . . 824 *n.* 1
in favor of employer to use inventions of employee when . 414 *n.* 1, 832, 917
when employer is a corporation, public or private 832
when employee receives an express license . . . . . 917 *n.* 1

Referenced are to sections.

LICENSE — *continued.*
implied, in favor of the employer, given employer the right to practise the art during the life of the patent, or use the article till it is used up . 832
not transferable by sale of article to others 832
in favor of corporation or copartnership to all the inventions of its members . . . . . 833, 917 *n.* 5
arising by estoppel 917, 981
circumstances may work an estoppel 834
patentee estopped by acquiescence in use of licensee 917
patentee not estopped by acquiescing in wrongful use 834
more judgment against infringer without satisfaction no estoppel . . 834
scope of, ascertained from the circumstances which imply it 809, 834, 915 *n.* 1, 917
as a defence, proof of 1044
as evidence 1015
a continuing contract, instance of . . . . . 1249 *n.* 2
taken to avoid suit, not under duress or fraud . . . . . 806 *n.* 3
any one may contract at risk of obtaining . . . . . 1255 *n.* 3
to common carrier to act for one customer no hindrance to a decree that he shall act for all who offer . . . . . 806 *n.* 3
defendant allowed to take when . . . . . 1065 *n.* 1
(See also ACTION AT LAW, ASSIGNMENT, CONSIDERATION, CONTRACT, CO-OWNERS, COURTS, DEFENCES, EMPLOYEE, EMPLOYER, EQUITY JURISDICTION, ESTOPPEL, GRANT, INFRINGEMENT, LICENSE-FEE, LICENSEE, LICENSOR, MONEY PAID, PLAINTIFF, PURCHASE MONEY, RE-ISSUES, RESCISSION, ROYALTIES, SALES, STATE COURTS, TRANSFER, VENDEE, WARRANTY.)
LICENSE-FEE, when the measure of damages . . . . . 1056–1059, 1157 *n.* 7
established, evidence of 1057
at date of infringement is the measure . . . . . 1059 *n.* 1
not a measure, when invention is used only in part, or in a different way, or for a different period 1058
provable by parol 1057
(See also ACTION IN EQUITY, ACTION AT LAW, DAMAGES, LICENSE and titles there cited, PROFITS.)
LICENSEE, rights against licensor 1243
remedies against licensor 1243
remedy of a specific performance when 1244
remedy when licensor refuses to supply the article for sale as agreed . . 1244
refuses to reduce royalties as agreed 1244
wrongfully licenses others 1244
revokes the license and makes it publicly known 1244
remedy of rescission of license, when 1245
remedy for escaping obligations of license by repudiating it 1245
against licensor for fraud or breach of contract 1245, 1246
when licensor refuses to sue infringers as agreed 1246
violates exclusive license 1246
remedy to recover back money paid 1247
to recover money paid by fraud or mistake 1247
for use of invention, when 1251
for royalties when patent declared invalid . . 1247
cannot recover money if he has received an equal benefit 1247
liabilities of, for royalties when he has enjoyed the license 1251
becomes liable for the fees by accepting the license . . . . . 1251 *n.* 2
cannot deny validity of the patent while enjoying the license 984
bound by a covenant not to dispute validity, while license is in force 1251 *n.* 8
bound by his own contract though patent held invalid in a suit between third parties . . . . . 1251 *n.* 8
liable for fees for use of the invention until license repudiated or rescinded 1251

References are to sections.

LICENSEE — *continued.*
licensee may show repudiation in defence to claim for fees . . . 1251 *n.* 8
licensee may defend suit for fees for use of invention by showing failure of consideration, want of title, judgment of invalidity, or eviction . . 1251
licensee to use cannot enjoin licensor from suing for the fees on ground of prior patent . . . . . 1251 *n.* 8
licensee to use cannot set up subsequent patent in defence to suit for fees 1251 *n.* 6
licensee to use taking license with knowledge of adverse titles cannot set them up in defence to suit for fees . . . . . 1251 *n.* 4
licensee, being rival patentee, and taking license to quiet disputes cannot deny licensor's title . . . . . 1251 *n.* 5
licensee cannot defend on ground that other licensees pay lower rates 1251 *n.* 3
licensee liable to pay fees for use by his vendee . . . . . 1251 *n.* 1
licensee sued for breach of contract as to mode of use may defend on ground that patent is void 1250
licensee to use under implied license cannot deny utility . . . 1251 *n.* 9
cannot set up that he has been sued as infringer . . . . . 1251 *n.* 10
licensee under implied license to use may show in defence to suit for the price that the article infringes prior patents and set off a license-fee paid under such patents 1251
royalties on sales to be paid as long as licensee receives the benefit 1252 *n.* 5
licensee liable for royalties though he has assigned the license 1252
on articles sold after license was terminated for breach of condition . . . . . 1252 *n.* 3
licensee not liable for royalties on sales till price received 1252
licensee sued for royalties on sales may show his liability to superior title 1252 *n.* 7
cannot show that other parties claim the patent . . . . . 1252 *n.* 7
that patent invalid or licensor no title, unless patent repealed or licensee evicted 1252
estopped only as to acts done while patent in force . . . 1252 *n.* 5
licensee sued for royalties on sales refusing to show his accounts is presumed to have sold as much as at last accounting . . . . . 1252 *n.* 4
licensee not enjoined from selling if license fees alone in controversy . . 1252
when an infringer 1044
infringes by using any invention not identical with the one licensed . . 797
acting within his license does not infringe by breach of other parts of the contract 915
infringement not justified by licensor's breach of contract . . . . 1250 *n.* 3
licensee of co-owner cannot use infringing inventions 797
licensee not estopped by license when treated as an infringer for acts done under it . . . . . 984 *n.* 4
licensee sued in equity for infringement may avail himself of any defence 1114 *n.* 2
licensee has remedy against licensor, who wrongfully enjoins him as an infringer 1245
assignee of licensee an infringer when 916
not a party to a surrender and re-issue 698
if exclusive may be protected by injunction in State court . . . . . 865 *n.* 2
cannot be plaintiff in action at law for infringement 938
may sue at law in name of licensor, when 938
executor of, cannot sue in name of licensor 938
when plaintiff in equity 1098, 1099
not a necessary party in equity . . . . . 1100 *n.* 2
can sue only in equity for infringement by licensor 1089
can sue in equity in his own name when 1101
must join licensor as co-plaintiff when 1098

Reference are to sections.

LICENSEE — *continued.*
bound by covenant to aid in suppressing infringements . . . . . 1250 *n.* 3
when partners, obligations to each other 1255
joint, each surety for the others for license fees 1255
rights of each as surety for the others 1255
(See also ACTION IN EQUITY, ASSIGNEE, LICENSE and titles there cited, LICENSOR.)

LICENSOR, contract relations with licensee governed by ordinary law of contracts 1224
specific performance of his contract with licensee enforced 1244
rights of against licensee 1248
remedies of against licensee 1249–1252
rescission of license decreed when 1249
licensor publicly revoking license may be enjoined . . . . 1249 *n.* 4
not aided in equity when he has broken his contract . . . 1249
remedy for breach of contract 1250
breach of contract may also be infringement 1225
licensee may be sued on the contract or for infringement 1087 *n.* 1, 1250
licensor may enjoin licensee as an infringer or sue him for royalties 1087 *n.* 1
remedy to recover license fees for use of inventor 1251
under implied contract in assumpsit 1251 *n.* 9
licensor's right to license fees for use differs from that to royalties on sales 1251
licensor cannot recover license fees for the use of an invention which infringes prior patents . . . . . 1251 *n.* 10
licensor may show state of art to prove his own priority if his patent is attacked . . . . . 1251 *n.* 9
remedy to recover royalties on sales 1252
licensor not enjoined from suing for royalties 1252
when plaintiff in equity 1098
cannot sue in equity for royalties . . . . . 1087 *n.* 1
may claim indemnity against costs where licensee sues in his name . . 938
(See also LICENSE AND LICENSEE, and titles there cited.)

LOCAL JURISDICTION in equity 1006, 1097

LOCATION, changes in not always patentable . . . . . 242 *n.* 1

LOSSES of defendants not deducted from profits of infringement 1139

LOST ART, defined 322, 346, 390
abandoned and forgotten invention is a lost art 323
not prior use 322
how shown 1026
(See also ABANDONED INVENTION, ABANDONMENT, ACTION AT LAW, INVENTION, LACHES, NOVELTY, PRIOR USE.)

LOTTERIES, State laws against cannot be violated under color of patent . . 46 *n.* 4

MACHINE, defined 173
essential attributes of 178
essence is its organism under its principle or structural law . . . . 175 *n.* 1
distinguished from other inventions by its subjection to a structural law . . 175
shape, size, materials, etc., when not essential 178
principle, the essential characteristic of . . . . . 179 *n.* 1
defined 173
structural law defined 173
modus operandi defined 173
distinction between its "operation" and its "mode of operation" 174 *n.* 1
"mode of operation" not separately patentable . . . . . 174 *n.* 1
"operation" may be a separately patentable art . . . . 529 *n.* 1, 530 *n.* 3

References are to sections.

MACHINE — *continued.*
any combination of mechanical elements is . . . . . 170 *n.* 1
distinct from its force and product 177
art 174
a unit, its unity how destroyed 170
distinct from its integral parts 177
not necessary that its parts be invented by same inventor . . . 177 *n.* 1
simple or combination 170
simple, analysis of 280
combinations in machines and manufactures, distinction between 185
co-operation of machine and product not a true combination . . . 170 *n.* 1
not patentable till reduced to practice 180
not reduced to practice by drawings, descriptions, or models, but only by an operative machine 180
actual use in public, and mechanical perfection not necessary 180
reducible in many forms; all covered by patent 181
Identity, tests of . . . . . 178 *n.* 1
of simple machines, how determined 280, 290
of combination-machines, how determined 201, 202
identical while organism remains unchanged . . . . . 170 *n.* 1
when identical in principle or mode of operation . . 178 *n.* 1
when performing same function in same way . . . 178 *n.* 1
though diverse in shape, size, arrangement, speed, materials, economy, etc. . . . . 178 *n.* 1
changes in when not essential 178
mode of using not essential . . . . . 170 *n.* 1
different if they differ in *modus operandi* . . . . . 290 *n.* 2
function . . . . . 290 *n.* 1
result . . . . . 290 *n.* 1
if one is operative, the other not . . . . . 605 *n.* 4
increased utility indicates change of structural law 178
introduction of new element in combination is an essential change . 170 *n.* 1
Improvements in, how effected . . . . . 311 *n.* 1
joinder of, with process or product when 474
machine and product separately patentable 466
Description of 498
machine can be accurately described by drawings and model 682
Claim for, requisites of 530
machine must be claimed as such, not as a "*modus operandi*" 511
drawings of for Patent Office, requisites of 543
infringement of patent for, what acts are 926
(See also APPARATUS, ART, CLAIM, COMBINATION, DESCRIPTION, DRAWINGS, FUNCTION, IDENTITY, IMPROVEMENT, INFRINGEMENT, JOINDER, MANUFACTURE, MODELS, MODUS OPERANDI, PRINCIPLE, PROCESS, REDUCTION TO PRACTICE, RE-ISSUES.)
MACHINERY, to do by, what was done by hand, not an invention . . . 164 *n.* 3
MAKER AND SELLER, when liable for damages for use by vendee 1064
MAKING, damages for are nominal 1064
MANAGING AGENT of corporation, defined . . . . . 935 *n.* 4
MANDAMUS to compel Commissioner to issue patent 583
will lie where patent is allowed but Commissioner refuses to issue it . 571 *n.* 1
conclusive only on the public as represented by the Commissioner, not on other applicants . . . . . 583 *n.* 4
bill in equity to obtain patent not a substitute for . . . . . 583 *n.* 3
(See also APPLICATION FOR PATENT, COMMISSIONER, JURISDICTION, PATENT OFFICE.)
MANSELL'S PATENT, scope of . . . . . 68 *n.* 1
MANUFACTURE, defined 182

References are to sections.

MANUFACTURE — *continued.*
when patentable . . . . . 203 *n.* 1
under Stat. Jac. I., defined . . . . . 27 *n.* 1
includes what under English law . . . . . 69 *n.* 1
meaning of under English law 69
in patent 750
a comprehensive class of inventions 183
may be wide or narrow in scope 191
essential attributes of 183
a means not an end 188
generally a more mode of application 204
distinguished from machine 182
has no *modus operandi* or structural law 182
operates in obedience to exterior intelligence 182
same article may be both manufacture and design . . . . . 183 *n.* 1
distinct from its component parts and from the means producing it 184
novelty of 184
not new unless produced by an inventive act distinct from that which created its process or machine . . . . . 184 *n.* 1
not new because produced by new means 184
in a new way or more cheaply 187
more effective 188
may be new though the machine or process is old . . . . . 184 *n.* 1
may be old though the machine or process is new . . . . . 184 *n.* 1
new when produced in a new way; cases asserting this criticised . 187 *n.* 1
may be a new form of an old article . . . . . 187 *n.* 1
to perceive new qualities in an old manufacture is not to create a new one 187 *n.* 1
reduction to practice essential to patentability 190
reducible in many forms all covered by patent 191
may be simple or a combination 185
simple, analysis of 293
combination, analysis of 298
manufactures composed of parts not always combinations . . . . 293 *n.* 1
distinction between combination and aggregation in 185
distinction between combination machines and combination manufactures 185
combinations may be composed of old manufactures 186
result a test of combination 185
a unit, its unity how destroyed 189
identity of simple manufacture how determined 293–297
combination manufacture how determined 298, 299
changes in when essential 188
size or form not essential . . . . . 188 *n.* 1
identical, however produced 187
though put to different uses 295
equivalents used 296
combination, effect of change in elements 189
joinder of with process and apparatus 475
Description of 499
Claim for 531
drawings for the Patent Office 543
infringement of patent for, what acts are 927
(See also ART, CLAIM, COMBINATION, COMPOSITION, DESCRIPTION, IDENTITY, IMPROVEMENT, INFRINGEMENT, JOINDER, MACHINE, PRODUCT, REDUCTION TO PRACTICE, RE-ISSUES, RESULT.)

MANUFACTURERS' PROFIT as an item in estimating profits . . . . 1139 *n.* 15

MARKET VALUE, not "marketabillty" or "salability" . . . . . 1142 *n.* 2

MARKETING, cost of when allowed in estimating profits 1139

References are to sections.

MARRIED WOMAN, may obtain patent 303
power of, to transfer her patent governed by local law . . . . . 303 n. 3, 765
may be assignee of letters-patent . . . . . 707 n. 1
under New York law may sue alone . . . . . 944 n. 3
MASTER, duty of in taking account 1155–1159
fees of, how allowed and paid 1163
recommittal of report on accounting 1159
(See also ACCOUNT, ACCOUNTING, ACTION IN EQUITY, BOOK, BURDEN OF PROOF, CONFUSION, DAMAGES, EXCEPTIONS, OBJECTIONS, PROFITS, TESTIMONY.)
MATERIAL, change of, a phrase of two meanings . . . . . 243 n. 1
affects identity when 243
is invention when 243
use of for new purpose may be an invention . . . . . 243 n. 1
new use of may be double use . . . . . 200 n. 1
diversities of may be matter of form or of substance 243
do not show absence of infringement 894
cost of allowed in estimating profits 1139
(See also DIVERSITIES, DOUBLE USE, IDENTITY, INFRINGEMENT, USE.)
MATTER, property of, not an invention 136–138
of common knowledge not patentable . . . . . 112 n. 1
MEANS, invention a, not an end 87–90
created by inventive act, nature and development of 108
not end the subject of the patent . . . . . 377 n. 1
many may accomplish same end 117
identity of not proved by identity of end 117
disproved by diversity of end 117
different for same end are different inventions . . . . . 90 n. 1
"means," "mechanism" and similar words when proper in a Claim . . 516 n. 4
in a Claim for a combination . . . . . 520 n. 2
(See also CLAIM, COMBINATION, CONCEIVER, CONCEPTION, DESCRIPTION, DISCOVERY, EFFECT, END, FUNCTION, IDEA, IDENTITY, IMPROVEMENT, INFRINGEMENT, INVENTION, INVENTIVE ACT, NOVELTY, PATENT, PRINCIPLE.)
MECHANICAL PROCESS, Claim for when proper . . . . . 529 n. 1, 530 n. 3
MECHANICAL SKILL, not inventive skill, how distinct 78
standard of constantly raised . . . . . 78 n. 3
to be estimated as it existed at date of alleged invention . . . . . 78 n. 3
(See also INVENTIVE ACT, INVENTIVE SKILL, and titles there cited.)
MEDICINE, patent for does not authorize patentee to administer it without the usual State license . . . . . 46 n. 4
MISJOINDER of plaintiffs or defendants (see ACTIONS IN EQUITY, ACTIONS AT LAW).
MISTAKE defined 658
MODE OF APPLICATION, defined . . . . . 94 n. 1, 101
an essential element in all inventions . . . . . 262 n. 1
is an invention . . . . . 101 n. 2
not generated by the inventive act when 94
essence of 103
distinct from apparatus employed . . . . . 94 n. 1
(See also DOUBLE USE, FORCE APPLIED, IDEA, IDENTITY, INVENTION, INVENTIVE ACT.)
MODEL FOR PATENT OFFICE 545–548
when required 540
not filed until ordered by Commissioner 545
filing, not filing application nor shows that one is filed 548
its general requisites 548
must correspond with specification and drawings . . . . . 548 n. 1

References are to sections.

MODEL FOR PATENT OFFICE — *continued.*
sufficiency determined by Commissioner . . . . . 546 *n.* 2
neither aids nor impairs specification and drawing 548
does not show reduction to practice 126
prior use 318
its final disposition 547, 550
withdrawable after filing 553
if lost may be established by parol . . . . . 681 *n.* 10
(See also ACTION AT LAW, APPLICATION FOR PATENT, CLAIM, CONSTRUCTION, DESCRIPTION, DRAWINGS, IDENTITY, MACHINE, PATENT OFFICE, REDUCTION TO PRACTICE, RE-ISSUES.)

MODUS OPERANDI, of machine defined 173
difference in shows difference in machine . . . . . 200 *n.* 2
(See also MACHINE, and titles there cited.)

MONEY PAID, for defective title when recoverable 1229
for a void patent when recoverable 1230
for an assignment recoverable when wrong patent assigned 1230
for assignment procured by deceit of assignor when recoverable 1231
by licensee when recoverable 1247
not recoverable if patent afterward held invalid . . . . . 1247 *n.* 3
under threat of suit is not obtained by fraud or intimidation . . . . 1247 *n.* 2
recoverable though patent afterwards declared invalid 1247 *n.* 3
(See also ASSIGNEE, CONSIDERATION, LICENSEE.)

MONOPOLIES, origin of 1
early English 3–5
under Elizabeth 6
resistance to under Elizabeth 6
James I. 7
statute (21 Jac. I.) against 7
since James I. 8
classes of, legal and illegal 9
when valid at common law 9
illegal defined . . . . . 9 *n.* 1
several can be created by one patent 468
(See also MONOPOLY and titles there cited, STATUTES AGAINST MONOPOLIES.)

MONOPOLY defined 1
a derogation of common right 12
each distinct and separate from all others 468
indivisible except in area 460, 755, 807
whether patent privilege is, discussed 11–44
patent privilege a true 32
in inventions justified by public policy 33
relation of to invention 753–756
but one in same invention 460
prohibitory powers under, governed by Patent Law 761
in an invention created by letters-patent 415, 753
existence and scope of unalterably fixed by law 864
defined and measured by letters-patent 415
the Claim 505
governed by the construction given by the courts to the patent 419
unchangeable in scope by amendment after grant . . . 635 *n.* 1
nature and scope of property in . . . . . 408 *n.* 3
exists only in the owner of the entire interest in the invention or an undivided part thereof 758
originally exists in the patentee 758
transferable 755, 756
passes with transfer of exclusive rights 807

References are to sections.

MONOPOLY — *continued.*
In an invention transferable in connection with the entire interest in a patented invention or an undivided part thereof . . . 758
indivisible and transferable only in all the three rights in the invention 807
not transferable with the separate rights to make, use, or sell 758
to territorial grantee 758
may be enjoyed by granting licenses or preserving a close monopoly 1055
close monopoly may consist in using the invention and selling its product or in making and selling the invention itself . . 1060
(See also ASSIGNMENT, CO-OWNERS, GRANT, INVENTION, INVENTOR, LETTERS-PATENT, LICENSE, PATENT, PATENT PRIVILEGE, PATENTED INVENTIONS, PATENTEE, REPEAL, TRANSFER.)

MORTGAGE of future invention will cover it though protected by several patents 769 *n.* 1

MULTIFARIOUSNESS (see ACTION IN EQUITY) 1108

NATURE, force of, new use of is new process . . . . . 107 *n.* 2

NEW MATTER, defined, rule of properly applicable to re-issues . . . . . 561 *n.* 3
requires a new application 561

NEW TRIALS, *grounds of* 1070, 1078
in equity 1133–1135
in the Patent Office 615

NON-JOINDER of plaintiffs and defendants (see ACTION IN EQUITY, ACTION AT LAW).

NONSUIT, not allowable, equivalent procedure 1073

NOTE, given for void patent not collectible and its collection enjoined . . 1239 *n.* 1
given for invalid patent good in hands of *bona fide* holder though procured by fraud 1242
buyer of with knowledge that it was given for a patent not chargeable with notice of the fraud 1242
given for patent right collectible if patent valid, though the invention has no pecuniary value 1239
void, if sale procured by fraud . . . . . 1240 *n.* 1
collectible, though the payee afterward obtains a patent for part of the invention . . . . . 1238 *n.* 2
State power over . . . . . 46 *n.* 4
validity of statutes regulating 1242
not complying with State statutes open to all defences 1242
stating that "it is given for a patent right" is still governed by the law merchant . . . . . 1242 *n.* 7
non-negotiable, want of consideration a good defence . . . . . 1242 *n.* 4
given for patented article need not give the notice required by State laws when given for the patent itself . . . . . 1242 *n.* 4
given for right to sell a valueless device is void . . . . . 1252 *n.* 6
license fees to use an invention which infringes a prior patent is void . . . . . 1251 *n.* 10
(See also ASSIGNEE, ASSIGNOR, CONSIDERATION, CONTRACT, COURTS, LICENSE, PATENT, PATENTED INVENTIONS, STATES OF THE UNION, STATE COURTS, WARRANTY.)

NOTICE of special matters, rule of, a rule of evidence, not of pleading 991
not a plea 987
special plea may be substituted for . . . . . 987, 989, 999 *n.* 3
given in the answer in equity 1000

References are to sections.

NOTICE — *continued*.
of prior use on information and belief not sufficient . . . . . 1116 *n.* 4
by persons *of* a place not notice of use *at* a place . . . . 1116 *n.* 4
(See also ABANDONMENT, ACTION IN EQUITY, ACTION AT LAW, PRIOR PATENT, PRIOR PUBLICATION, PRIOR USE, PUBLIC USE, STATE OF THE ART.)
NOVELTY, defined 222
must formerly have been absolute and universal 223
under English law 70
is novelty "within the realm" 224
under our law since 1836 is novelty within the United States 225
and inventive skill distinguished . . . . . 112 *n.* 1
how related . . . . . 70, 112 *n.* 1, 113
and utility as evidence of inventive skill in England . . . . . 70 *n.* 4
"intrinsic novelty" defined 113
"legal novelty" defined 113, 963
intrinsic novelty shows discovery 113
not essential to patentability 123
how evidenced 114–116
by utility 116, 344, 1026
success with the public . . . . . 116 *n.* 1
novelty in mode of operation 116
in the end accomplished 117
novelty of end evidenced by its comparative utility . 121
legal novelty, essential to patentability 70, 123, 221
does not show intrinsic novelty or an inventive act 124
defence of want of 963
involves two points, identity and priority 228
resides in the invention not in the mode of producing it . . . . . 222 *n.* 1
between identical inventions determined by priority 315
patent *prima facie* evidence of 1016
negatived by prior knowledge or use 226
only by practical and complete knowledge 227
defendant must prove want of beyond reasonable doubt . . . . . 1026 *n.* 2
extension after hearing is strong evidence of . . . . . 1026 *n.* 2
and infringement not the same question though each involves identity 892, 1041
(See also ACTION AT LAW, APPLICATION FOR PATENT, COMBINATION, CONCEPTION, DATE, DISCOVERY, DOUBLE USE, FOREIGN INVENTIONS, IDEA, IDENTITY, INVENTION, INVENTIVE ACT, LETTERS-PATENT, LOST ART, PATENT, PATENT OFFICE, PRIOR PATENT, PRIOR PUBLICATION, PRIOR USE, PRIORITY, STATE OF THE ART.)

OATH, to application for patent (see APPLICATION FOR PATENT).
is *prima facie* evidence of priority . . . . . 558 *n.* 1
if wilfully false is not curable by re-issue 660
OBJECT, not generated by the inventive act 93
direction of force on a new object is a new art . . . . . 164 *n.* 2
mode of using the new susceptibilities of, is an invention . . . . . 134 *n.* 3
OBJECTIONS to evidence in equity, when made 1128
on the accounting how made and determined . . . 1157
OFFICERS OF CORPORATIONS whether liable for its infringements 912
OLD AND NEW, distinguished by the Claim 506, 513
"ON OR ABOUT" such a date, means that exact date . . . . . 595 *n.* 3
OPERATION, defined 157
OPTION attempt to exercise where there is none does not affect general remedies for breach of contract . . . . . 1251 *n.* 11
"ORIGINAL INVENTOR," two meanings of . . . . . 58 *n.* 2
OYER of patent or other public record not demandable . . . . . 950 *n.* 3

References are to sections.

PACKING, new mode of, may or may not be an invention . . . . 78 *n.* 2, 228 *n.* 2
when not an invention . . . . . 78 *n.* 2, 166 *n.* 1
PAROL EVIDENCE, admissibility of in patent cases . . . . . 1015, 1019 *n.* 2
PARTIES, change of in equity necessitates supplemental bill when 1122
to judgments, who are (see JUDGMENTS) 1176
identity of, a question for the court in subsequent suit 1176
PARTNERS, infringement by . . . . . 920 *n.* 1
right of firm to use inventions of . . . . . 414 *n.* 1
rights of to patents how affected by contracts with firm . . . . . 414 *n.* 2
PARTNERSHIP, agreement for between inventor and capitalist how far enforceable 1228
patent may be part of capital stock and dealt with as an asset . . . . 1254 *n.* 1
PARTS, diversities of may be matter of form or of substance 245
difference in number of does not show absence of infringement 894
PARTY, making adverse a witness waives nothing 1127
PATENT, a contract between inventor and public 481
never allowed on the ground that it can do no harm . . . . . 558 *n.* 2
right to accrues when invention completed 403
no legal title to until patent issues . . . . . 428 *n.* 1
can cover several monopolies 463
grant of is an *ex parte* judgment . . . . . 1183 *n.* 2
not complete till recorded . . . . . 627 *n.* 1
when a public document 1027
a public record giving notice to all the world . . . . . 381 *n.* 1, 1197 *n.* 1
all persons bound to take notice thereof . . . . . 901 *n.* 2
delay in applying for not abandonment 346, 389, 390
diligence of earliest rival inventor in applying for 388-390
when surreptitiously obtained . . . . . 960 *n.* 1
obtained after refusal to arbitrate under act of 1793 not necessarily obtained on false suggestion . . . . . 1041 *n.* 21
to wrong inventor a cloud on title of true inventor 426
right to not affected by death of inventor 403
application for pending at death of inventor to be prosecuted by his executor 407
application to be made by executor of deceased inventor . . . . 407 *n.* 1
patent in hands of executor not personalty but a franchise held in trust 405 *n.* 1
right to apply for assignable 408
assignment of governed by Patent Law 408
right to, assignable at any stage of inventive act 409
has no owners except patentees, assignees, or grantees . . . . . 758 *n.* 1
unlawful, a public injury requiring its repeal 719
not collaterally attacked for informality 967
fraud 715, 717, 967
legal prerequisites to, effect of omission 967
patent is evidence that prerequisites fulfilled 617, 1032
silence of patent as to prerequisites does not show their omission . . . 1032
technical objections to, strictly construed . . . . . 1032 *n.* 18
effect of false oath or suggestion, of want of signatures, of departure from application, of issue without notice to caveator, etc. 967
void if necessary official signatures wanting . . . . . 967 *n.* 4, 1032
proper seal is absent . . . . . 967 *n.* 4
oath wilfully false in material point 1032
not void when oath omitted 1032
invalid if issued on an application sworn to in blank and then filled out by the attorney . . . . . 660 *n.* 1
for unpatentable matter 728
Description incurably defective 483
if essential element undescribed . . . . . 490 *n.* 2

References are to sections.

PATENT — *continued*.
invalid if Description ambiguous 403
Claim excessive 643
for simple invention is either wholly valid or wholly invalid 464
for invention consisting of parts may be valid in part only 464
valid and operative as to one invention may not be so as to others intended to be covered 660
valid if invention useful for other purposes than those described . . . 486 *n.* 3
validity cannot be denied by defendant when 1189
validity not dependent on that of foreign patent . . . . . 623 *n.* 1
judgments sustaining, as evidence of validity 1174–1184, 1188
acquiescence of public in the monopoly as evidence of validity . . . 1185–1188
invalidity as a defence to assignor's action for purchase money 1239
to licensor's action for royalties 1251, 1252
subject-matter of (see APPLICATION FOR PATENT).
two for same invention not lawful . . . . . 370, 460 *n.* 1
former patent describing but not claiming no bar 465
patent for parts of previously patented whole valid 465
whole composed of previously patented parts valid 465
combination of previously patented elements cannot claim them 462
improvement cannot cover a previously patented original . . 462
an invention already covered by a defective patent to the same inventor is invalid 464
an invention dependent on or collateral to a previously patented invention is valid 460
an invention covered by a foreign patent or a rival domestic patent 461
same invention to the same patentee, suit must be brought on the earlier patent . . . . . 937 *n.* 1
later patent construed not to cover earlier, if possible . . . . . 461 *n.* 1
cannot cover what it does not attempt to properly describe and claim . . . 663
its language does not cover 633
meaning of, is a question of law 732
covers only what the court construes it to cover 731, 1019, 1041
liberally construed and sustained, if possible 735
protects the entire idea of means in every form 514
patent for generic invention covers the species 535
covers all uses of the invention 514
forms of the invention 514
inventions inseparable from the one claimed . . . 669 *n.* 1
patent for combination makes all claimed elements essential . . 670 *n* 2, 5
use does not cover making or selling 751
application of to facts is for the jury . . . . . 732 *n.* 1
date of, how shown 1043
term of, history of the law as to (see TERM) 622
should be stated in the letters-patent . . . . . 622 *n.* 1
fixed by statute not by the words of the grant 622, 1043
all persons chargeable with notice of . . . . . 806 *n.* 3
how ascertained 1043
expires when 625
not affected by terms of defendant's domestic patents 625
measured by that of foreign patent when 622, 623
foreign patent must be to same inventor 1043
limited by what term of foreign patent 624
how affected by surrender or extension of the limiting foreign patent 624
how measured when limited by foreign patent 623, 624
when not limited by foreign patent 625
design patent 625
substituted patent . . . . . 625 *n.* 2

References are to sections.

PATENT — *continued.*
application for (see APPLICATION FOR PATENT) 426
allowance of (see APPLICATION FOR PATENT) 582
withheld by Commissioner when 583
for interference after final fee paid 612
"perfect" defined . . . . . 660 *n.* 2
Claim the life of 505
value to patentee depends on completeness of Claims 658
clerical errors in, effect of, amendment of 626
error in name of patentee, effect of 626
void and unamendable if specification misrepresents or conceals with intent to deceive 685
to one person for one invention cannot be amended to become a patent to another person or for a different invention 635
Identity of patent must be preserved through all amendments 635
new necessary if invention to be changed 635
diverse effects of, after sectional owner has disclaimed a part 647
defects in not ratified by judgments sustaining . . . . . 1174 *n.* 1
when conflicting with other patents . . . . . 589, 723 *n.* 3
conflicting patents not in jurisdiction of Patent Office 588
not affected by judgment against it in interference . . . . . 588 *n.* 5
expired, not within jurisdiction of Patent Office 588
averment of in bill in equity 1106
infringement of several patents sued for in one action 1108
rights of action not extinguished by expiration of patent 973
joint and sole for joint and sole inventions, true doctrine of . . . . . 402 *n.* 3
joint, must issue for joint invention 402
joint, for sole invention void . . . . . 402 *n.* 3
as evidence 1015
whether domestic or foreign . . . . . 1015, 1019 *n.* 2
weight of increased by re-issue or extension 1016, 1041
prima facie proof of its own validity 426, 1016
inventive skill . . . . . 1022 *n.* 3
reduction . . . . . 600 *n.* 6
but not conclusive 126
that invention was made before application filed . 1022 *n.* 3
patentee is a true inventor 1023
the prior inventor 1024
against all later applicants 590
that the invention is legally patentable 1025, 1033
new . . . . . 1026, 1041 *n.* 18
different from all prior ones . . 1027, 1198 *n.* 2
not covered by prior patent . . 1027
useful . . . . . 1029, 1041 *n.* 18
not abandoned to the public . . 1030
that all prerequisites fulfilled . . . 423 *n.* 2, 451 *n.* 5, 617
the specification is not fraudulent 1034
Description is not ambiguous 1035
Claims are not ambiguous 1037
excessive 1036
patent is still in force 1038, 1039
legal title is in the patentee 1040
is not evidence of prior use 318
as evidence of prior patent takes effect when specification published . . 1027
conclusive proof that all formal requirements complied with . . . 617, 1032
not evidence that disclaimer was filed within a reasonable time 1036
of the fact of infringement . . . . . 1016, 1018 *n.* 4, 1041

Reference are to sections.

PATENT — *continued.*
patent of defendant is prima facie evidence of its validity 1016
admissible to show his own good faith and the substantial difference of his invention 1041
(See also ACTION IN EQUITY, ACTION AT LAW, ADMINISTRATOR, ADMINISTRATION, ANNUL, APPLICATION FOR PATENT, ASSIGNMENT, BANKRUPTCY, CLAIM, COMBINATION, CONGRESS, CONSTRUCTION, CONTRACT, CO-OWNERS, CREDITOR'S BILL, DATE, DECEASED INVENTORS, DEFECTS, DESCRIPTION, DISCLAIMER, DRAWINGS, EQUITY, EQUITY JURISDICTION, ERRORS CLERICAL, ESTOPPEL, EVIDENCE, EXECUTORS, FOREIGN PATENT, HEIRS, IDEA, IDENTITY, INFRINGEMENT, INJUNCTION, INTERFERENCES, INVENTION, INVENTOR, JOINDER, JOINT PATENT, JUDGMENTS, JUDICIAL SALE, LETTERS-PATENT, LICENSE, MONOPOLY, NOTES, PATENT OFFICE, PATENT PRIVILEGE, PATENTED INVENTIONS, PRIOR PATENT, RECORD, RE-ISSUES, REPEAL, RIVAL INVENTORS, SIGNATURES, SPECIFICATION, TERM, TITLE, TRANSFER.)
PATENT ACTS, epitome of . . . . . 48 *n.* 1
PATENT ATTORNEYS AND SOLICITORS (see ATTORNEYS) . . . 425, 431–437
PATENT ENGLISH, when issued . . . . . 332 *n.* 1
under great seal proves itself . . . . . 1026 *n.* 2
PATENT LAW, common law and equity the foundation of . . . . 10 *n.* 3, 725 *n.* 1
a division of the law of contracts 41
deals with the patent privilege only as a contract, not as a reward or stimulus 41
based on fundamental principles 41
these principles stated 44
must conform to the essential nature of an invention 74
developed concurrently with the perception of the essential nature of an invention . . . . . 73 *n.* 1
developed by the development of scientific knowledge . . . . . 73 *n.* 1
PATENT OFFICE, why instituted 416
created to secure correct and lawful letters-patent 416
duty of to see that Claims are correct 538
the friend, not the antagonist, of inventors and must aid them to secure their inventions . . . . . 555 *n.* 2
authority of rests on statutes 451
organization of 51
functions of 52
practice and procedure in how regulated 427
rules of practice in 422
power of Commissioner to make 422
legal obligation of . . . . . 51 *n.* 2, 422
usually follow courts on same questions . . . . . 422 *n.* 4
rules of evidence same as in courts . . . . . 422 *n.* 4
do not apply to uncontested cases . . . . . 558 *n.* 2
proceedings in presumed to be regular . . . . . 424 *n.* 5
cannot dispense with statutory requirements . . . . . 423 *n.* 2, 451
has no jurisdiction over questions of title 450
cannot notice mere equitable interests in a possible patent . . . . . 769 *n.* 3
cannot decide claims of heirs and devisees 404
accepts judgments of local probate courts . . . . . 404 *n.* 1
has no jurisdiction over patents once abandoned or forfeited applications . . 588
power of to amend defective letters-patent 417
no power to repeal letters-patent 418
applications in, fees how payable 554
mode of examining applications 53
classification of inventions and applications . . . . . 469 *n.* 2, 555
proceedings on uncontested application 555–585
begin with filing of application 550
not stayed by bill in equity to obtain a patent . . . 604 *n.* 4
effect of change in jurisdiction of officers on pending cases 573

References are to sections.

PATENT OFFICE — *continued.*
no presumption that contestants could overcome objections in . . 689 *n.* 4
correspondence concerning applications must designate them by date and number 552
evidence of priority always admissible . . . . . 612 *n.* 1
affidavits of third persons may be received . . . . . 560 *n.* 2
Commissioner may act on his personal knowledge of public use . 560 *n.* 2
interviews of applicants with examiners 573
doctrine of estoppel applied in 614
not estopped to deny validity of its own grant . . . . . 451 *n.* 5
motions when and where made, procedure on 573
motion denied not repeated without leave . . . . . 573 *n.* 2
appeals from decisions on 573
motion decided without appeal not renewable on same facts . 573 *n.* 2
new trials, grounds and rules of 615
appeals in uncontested cases 500–572
delays and errors in do not affect inventor . . . . . 451 *n.* 4, 578
do not work abandonment 353
judgments of, their effect . . . . . 451 *n.* 5
res adjudicata applied in . . . . . 613 *n.* 1
decision that attorney has power to amend is final . . . . . 561 *n.* 9
judgments affect only applicants, not patentees 588
subsequent cases in court how 1183
not conclusive in courts . . . . . 1017 *n.* 2
Supreme Court . . . . . 1180 *n.* 1
records raise no presumption that they show all that was done . . . . 458 *n.* 2
correspondence with, as evidence . . . . . 1015, 1019 *n.* 4
files of third parties, as evidence 1015
clerks may testify what documents are on file . . . . . 1015 *n.* 10
adjudication between rival inventors 54
interference the *only* contested case in 586
publication of inventions by 55
employees of cannot obtain patents 363
(See also ABANDONMENT, ACTION AT LAW, APPLICATION FOR PATENT and titles there cited, ATTORNEYS, COMMISSIONER, COPIES, DELAY, DISCLAIMER, ERRORS CLERICAL, ESTOPPEL, EXAMINERS, EXAMINATION, EXTENSION, FEES, FILE-WRAPPER, FORFEITURE, INJUNCTION, INTERFERENCES, INVENTION, INVENTOR, JOINDER, JUDGMENTS, JURISDICTION, LACHES, LETTERS-PATENT, MODELS, MONOPOLY, NEW MATTER, NEW TRIALS, NOVELTY, PATENT, PATENT PRIVILEGE, PATENTEES, RECORD, RE-ISSUES, RIVAL INVENTORS, TESTIMONY, TITLE.)

PATENT prior (see PRIOR PATENT).

PATENT PRIVILEGE, nature of, a fundamental question 12
disputed by courts and writers 11
asserted by some to be not a monopoly . 11 *n.* 1
vacillations in American courts as to . . 23 *n.* 1
permanent and correct theory of indispensable 23
the true legal monopoly 11, 32
a monopoly restricting the public right in favor of a class 27
the natural right to a disclosed invention 26
invent the same thing 28
simultaneously invent and enjoy . 29
improve on existing inventions . 30
appropriating to the practical inventor the actual discoveries of others 27
enabling the patentee to suppress the invention 31
a true monopoly, effect of this theory on early English law 14
later English law 15
legislatures and courts 12
departure from this theory on later English law 16–19

References are to sections.

PATENT PRIVILEGE — *continued.*
a true monopoly, effect of departure from this theory on American legislation 22
courts . . 21
not a monopoly, effect of this theory on legislatures and courts 13
though a monopoly, still justified by public policy 33
differs from an illegal monopoly how 32
a true and lawful monopoly, resting in contract between the inventor and the public 15, 44
a reward, a stimulus, and a contract for the disclosure of the invention to the public 40
a proper reward for an inventor 35
encourages inventions 37
promotes early disclosure of inventions 39
as a contract, alone recognized by Patent Law 41
contract theory when introduced 16
difference in effect between contract theory and reward theory . . . 20 *n.* 3
effect of contract theory on English decisions 16
contract theory in American law 20
how construed as a contract 40
cause of errors in construction of . . . . . 40 *n.* 3
contract obligations of the inventor 42
of the public 43
is property . . . . . 61 *n.* 3, 752, 884
is violated by any unlawful act which disturbs its enjoyment 884
rights included in 61
created at date of issue of letters-patent 428
rests on positive law 66
rights and remedies concerning, rest on the Constitution and statutes 46 *n.* 2, 61 *n.* 3, 66 *n.* 1, 2, 423
rights under, governed by common law . . . . . 61 *n.* 3, 66 *n.* 1
in the United States conferred by Federal Government 45
constitutional power of Federal Government over 46
may be conferred by the individual States 45
granted by the United States is limited to its territory and vessels . . . 46 *n.* 3
granted by a State limited to its territory 45
under Federal grant not subject to State Laws 46
created by special acts or general laws 47
created by special act is independent of all others 47
may restrict common rights . . . . . 46 *n.* 2
may operate retrospectively . . . . . 46 *n.* 2
may cover inventions already in use . . . . . 46 *n.* 2
grantable only to inventors 46, 57, 67, 362, 363
for their own inventions 46
cannot be granted by agreement of parties to any one not an inventor . 363
grantable only to first and original inventor 58
the earliest of rival inventors 370
the earliest reducer unless a prior conceiver was diligent in reduction 374, 375
grantable to representatives of deceased inventors 367
grantable only when inventive act complete 364
for certain classes of inventions 59, 67, 69
granted but once for the same invention 58
without examination under English law . . . . . 49 *n.* 1
as of course in this country before 1836 . . . . . 49 *n.* 2
power of Commissioner to grant or withhold . . . . . 51 *n.* 3
value of before 1836 49
since 1836 50
how affected by recent decisions of courts . . . . . 50 *n.* 2
created and defined by the letters-patent 415

References are to sections.

PATENT PRIVILEGE — *continued.*
measured by the Claim 505
scope of determined by the construction given to the patent by the courts . . 731
assignability of . . . . . 61 *n.* 2
extension of under American law 22
affects the interests of three classes of persons 716
violated by slander or libel and by infringement 885
slander or libel against (see SLANDER) 886-889
remedies for infringement of 62
compared with copyrights . . . . . 26 *n.* 1
(See also ASSIGNMENT, CONGRESS, CONSTRUCTION, CONTRACT, CO OWNERS, EMINENT DOMAIN, EQUITY, EXTENSION, IMPORTER, INFRINGEMENT, INJUNCTION, INVENTION, INVENTOR, LETTERS-PATENT, LICENSE, MONOPOLY, PATENT, PATENT OFFICE, PATENTED INVENTIONS, PATENTEE, STATES OF THE UNION, TITLE, UNPATENTED INVENTIONS.)
PATENT-RIGHTS, States cannot regulate the sale of . . . . . 46 *n.* 4
PATENT SYSTEM of the United States, history of 48
condition before 1836 49
changes in by act of 1836 50
influence of on inventors 63, 64
PATENTABLE INVENTIONS, essential attributes of 72
classification of under English law . . . . . 69 *n.* 1
PATENTABILITY, requisites to 361
courts take judicial notice of want of . . . . . 962 *n.* 3
cannot be decided on demurrer except in clear cases . . . . . 1110 *n.* 2
PATENTED ARTICLES, object of stamping, effect of failure to stamp . . . 902
PATENTED INVENTION, is the invention claimed in the patent 505, 731
nature of determined by construction given to the patent 1025
presumed to differ from all prior inventions 896, 1041
not to infringe prior patents 896, 1041
enjoyment of by its owner unrestricted by law 761
severable from the right to use it . . . . . 824 *n.* 1
property in, protected by law 848
not like any other property . . . . . 795 *n.* 1, 796
analogous to a right of common of pasture . . . . . 796 *n.* 2
twofold, the invention and the monopoly 753
property in the invention distinct from and independent of that in the monopoly 753
property in the monopoly dependent on that in the invention . . . 753
property in the invention originates in the inventive act and consists in the right to practise the invention 753
property in the monopoly is created by the patent and consists in the right to prevent others from practising the invention 753
is transferable like other property 752
only under Federal statutes 803
except as restricted by its own nature 761
property in the invention and in the monopoly both transferable . . 753
property in the invention transferable in whole or in part, for any time or place 754
property in the monopoly transferable only within certain limits . . 755
property in the monopoly may vest in several owners 755
not divisible except in area of exercise . 755
transfer of invention does not affect monopoly except by restricting its exercise 754
property in, is personal property and could be transferred by parol but for the Statute of Frauds . . . . . 768 *n.* 2
oral contract for before patent good under the Statute of Frauds 768 *n.* 2
liable for debts of owner 803

Referencos are to sections.

PATENTED INVENTION — *continued.*
cannot be reached by local process 803
not liable to execution 766, 803
not exempt from attachment by its intrinsic nature . . . . . 803 *n.* 3
subjected to claims of creditors only by some form of assignment in equity 804
not subject to sale by probate or bankrupt courts or trustees . 766, 804
reached by creditor's bill . . . . . 805 *n.* 1
not an asset of a decedent's estate 801
injuries to remediable by law . . . . . 884 *n.* 1
(See also ABANDONMENT, ASSIGNMENT, BANKRUPTCY, CLAIM, COMBINATION, CONSTRUCTION, CO-OWNERS, CREDITOR'S BILL, DESCRIPTION, FOREIGN INVENTIONS, IDENTITY, INFRINGEMENT, INVENTION, INVENTIVE ACT, INVENTIVE SKILL, INVENTOR, JUDICIAL SALE, LETTERS-PATENT, LICENSE, MEANS, MONEY PAID, MONOPOLY, NOTES, PATENT, PATENT PRIVILEGE, PATENTEE, PRINCIPLE, SALES, SLANDER, STAMPING, STATES OF THE UNION, TITLE, TRANSFER, UNPATENTED INVENTIONS, UTILITY, VENDEE.)
PATENTEES, classes of 369
must be earliest conceiver if diligent in reduction . . . . . 370 *n.* 1
may be an alien, an infant, or a married woman 363
employee of the Patent Office may not be 363
legal title to patented invention vests in at grant of patent . . . . . 765 *n.* 1
rights of depend on legal construction of his patent 633, 731
opinions of as to his rights do not bind him . . . . . 731 *n.* 2
chargeable with notice of what his patent contains . . . . . 690 *n.* 3
bound by his actual invention not by its description in the patent . . . 484 *n.* 2
bound by his Claim of the invention 505
discards all unclaimed matter from his patent . . . . . 690 *n.* 2
estopped to claim that the same matter is covered by a prior patent 1021
if fraudulent cannot deny the validity of the patent 984
is in bad faith unless he amends a faulty Description or an excessive Claim without unreasonable delay . . . . . 688 *n.* 1
presumed to own patent till transfer proved . . . . . 939 *n.* 1
may withhold the invention entirely from use 31
not all his rights and remedies rest on the Constitution and Statutes . . 725 *n.* 1
wrongs against, are violations of his rights in the monopoly 884
entitled to have unlawful rival patent repealed 718
junior cannot sue to obtain a decision that his patent does not interfere with a prior one . . . . . 723 *n.* 3
when plaintiff in equity 1098, 1099
suppressing his invention not entitled to an injunction . . . . . 31 *n.* 1
joint, not partners . . . . . 402 *n.* 2
(See also ACQUIESCENCE, ACTION IN EQUITY, ACTION AT LAW, ADMINISTRATOR, ALIEN, APPLICANT, APPLICATION FOR PATENT, ASSIGNMENT, CLAIM, CONCEIVER, CONCEPTION, CONGRESS, CONSTRUCTION, CO-OWNERS, DECEASED INVENTORS, DISCLAIMER, ESTOPPEL, EXECUTORS, EXTENSION, FOREIGN PATENTEES, HEIRS, IMPORTER, INFANT, INFRINGEMENT, INJUNCTION, INTERFERENCES, INVENTION, INVENTIVE ACT, INVENTOR, JOINT PATENTEES, JUDGMENTS, LETTERS-PATENT, LICENSE, MARRIED WOMEN, MONOPOLY, PARTNERS, PATENT, PATENT-PRIVILEGE, PATENTED INVENTIONS, RECORD, RE-ISSUES, REPEAL, RIVAL INVENTORS, TITLE, TRANSFER.)
PAVEMENT is a manufacture . . . . . 183 *n.* 1
PEDDLERS of patented articles, State may require license of . . . . . 46 *n.* 4
PENDENCY of former suit, how pleaded 956
suit in one district in equity no bar to suit in another . . 1097 *n.* 2
at law no bar to suit in another . . . 983 *n.* 4
a ground of staying decree in another . 1131 *n.* 9
(See also ACTION AT LAW.)

References are to sections.

PENDENTE LITE, transfers, do not affect the suit 781, 943, 1103
defendant to be notified of . . . . . 790 n. 2, 943
(See also ASSIGNMENT.)
"PERFECT," meaning of . . . . . 751 n. 5
PERFECT PATENT, defined . . . . . 660 n. 2
PERJURY, false swearing to motion for injunction is . . . . . 1206 n. 5
PETITION FOR PATENT, its requisites 463
PIRATICAL USE, not public use . . . . . 357 n. 2, 3
PLAINTIFFS, in actions at law for infringement 937-943
not presumed to be able to sell all that defendant did sell 1063
make all the profit defendant did 1062
not permitted to deny existence of their corporate assignor . . . . . 787 n. 1
in equity, who are 1098, 1099
joinder of legal and equitable owners as 1099
must sue in their own names 1101
added pending suit 1100
nonjoinder, misjoinder, of 1102
may be enjoined from suing defendant's vendees pending suit . . . 1211 n. 5
(See also ACTION IN EQUITY, ACTION AT LAW, INJUNCTION.)
PLAN or theory, of action or construction not an invention 166
protected by copyright not by patent . . . . . 166 n. 1
PLEA in equity, grounds and requisites of, procedure on 1112, 1113
not to anticipate the answer 1112
PLEADINGS not evidence . . . . . 1015 n. 11
POLICE POWER of the States not curtailed by Patent Law . . . . . 46 n. 4
POSSESSION of infringing device may be evidence of infringement 1041 n. 12, 1042
POWER OF ATTORNEY, creating patent attorneys, form of 432
not revocable when parts of a contract . . . . . 433 n. 1
PRACTICE IN EQUITY, rules of 1129
Patent Office, how regulated 427
PREREQUISITES TO PATENT, defects in when fatal 967
must be fulfilled or grant of patent illegal 423
Patent Office cannot dispense with . . . . . 423 n. 2
Commissioner to judge of 423
when formal, Commissioner's decision on is final . . . . . 451 n. 5
patent evidence of fulfilment of . . . . . 51 n. 3, 423 n. 2, 617
of application must be performed 451
want of, how taken advantage of . . . . . 451 n. 5
(See also ACTION AT LAW, APPLICATION FOR PATENT, LETTERS-PATENT, PATENT, PATENT OFFICE.)
PRINCIPLE, misuse of the word 134
various instances of its misuse . . . . . 134 n. 3
not an invention 134
not patentable 125, 134
cannot be claimed . . . . . 509 n. 1, 515
uses of the word explained 143
used in two senses 134
in one sense is the force employed 135
in another sense is the idea of means 139
how these differ 139
as a force, its synonymes . . . . . 135 n. 1
essential to every invention 135
not the result of inventive skill 136
not capable of being monopolized 137
not a practical and operative means 138
as the idea of means, its synonymes 139
the essence of the invention 141

References are to sections.

PRINCIPLE — *continued*.
as the idea of means, not an operative invention 140
the subject-matter of the patent 134
protected by the patent 141
application of, meanings of the phrase 142, 143
how far protected by patent 143
unapplied, not an invention 140
of a machine, defined 173
to be fully described in the specification . . . . . 484 *n.* 1, 2
(See also APPLICATION FOR PATENT, APPLICATION OF PRINCIPLE, ART, CLAIM, CONSTRUCTION, DESCRIPTION, FORCE, IDEA, IDENTITY, IMPROVEMENT, INFRINGEMENT, INVENTION, INVENTIVE ACT, INVENTIVE SKILL, MACHINE, MEANS, MODE OF APPLICATION, PATENT.)

PRIOR PATENT, defined, defence of 963
its essential requisites 331–337
stands on same ground with prior publication . . . . . 331 *n.* 1
must be a public document 332
must be accessible to the public 333
secret patent is not 333
date of relative to the invention in question 334
date of conclusive on issue of novelty 1027
does not show a use earlier than the patent . . . . . 1026 *n.* 18
must cover the same invention 335
a complete practical invention 335
for result no bar to patent for means . . . . . 335 *n.* 1
later re-issue of older patent is not a prior patent . . . . . 335 *n.* 3
must fully communicate the invention to the public 336
must have been a sufficient disclosure when issued . . . . . 336 *n.* 1
a bar, to whomsoever issued 337
previous foreign patent to same inventor a bar when . . . . . 337 *n.* 2
evidence of 1027
(See also ACTION AT LAW, FOREIGN PATENTS, LETTERS-PATENT, PATENT, PRIOR PUBLICATION, PRIOR USE and titles thereto cited.)

PRIOR PUBLICATION, as a defence 963, 1028
its essential requisites 325–330
must have been printed for general use 326
written but unpublished description is not . . . . . 326 *n.* 1
picture without printed text is not . . . . . 326 *n.* 1
business circulars or catalogues are not . . . . . 326 *n.* 2
application for patent, or provisional specification is not . . . . . 326 *n.* 3
English provisional specification is not . . . . . 332 *n.* 2
must have been put into circulation 327
date of publication 328
how proved 1028
must describe the same invention 329
a complete practical invention 329
must fully communicate the invention to the public 330
sufficiency of, a question for the jury . . . . . 330 *n.* 2
must have been sufficient when published . . . . . 330 *n.* 1
need not describe method of producing the invention . . . . . 330 *n.* 2
requisites of, how proved 1028
when provable by parol 1028
(See also ACTION AT LAW, CATALOGUES, PRIOR PATENT, PRIOR USE and titles thereto cited.)

PRIOR USE, defined, defence of 963
defeats patent . . . . . 324 *n.* 1
its bearing on the question of novelty . . . . . 321 *n.* 1, 324 *n.* 2
inventive skill . . . . . 321 *n.* 1, 324 *n.* 1

References are to sections.

PRIOR USE — *continued.*
difference between English and American rule of 22
unless secret, rendered patent void under early English law 17
on single ship however public or long continued does not prevent validation of patent under English law . . . . . 17 *n.* 3
under our Acts of 1790, 1793, 1836 . . . . . 22 *n.* 2
its essential requisites 317–323
not shown by mere knowledge without use . . . . . 316 *n.* 1
must disclose the character of the invention . . . . . 317 *n.* 1
invention used must have been complete and practically available 318
"prophetic intimation" is not . . . . . 318 *n.* 1
sketches, drawings, models, applications for patents, patents, and experiments are not 318
accidental operations, not perceived, are not . . . . . 318 *n.* 1
not unless invention used was identical . . . . . 318 *n.* 1, 4
what would infringe, if later, anticipates if earlier . . . . . 1026 *n.* 3
use as embodying one idea not prior use as another idea . . . . . *319 n.* 2
use of all elements not prior use of the combination . . . . . 318 *n.* 1
prior invention must have been practically employed 319
mere prior invention is not . . . . . 319 *n.* 2
mere making is not . . . . . 319 *n.* 2
single instance sufficient 319
though for a different purpose . . . . . 319 *n.* 4
evidenced by sale . . . . . 319 *n.* 2, 320 *n.* 3
complete without sale . . . . . 319 *n.* 2
though not patented . . . . . 319 *n.* 4
though subsequently abandoned . . . . . 319 *n.* 3
name of inventor and date of invention may be unknown 1004
means use *in* public, not *by* the public 320
secret use not 320
foreign use not 320, 1026
was under Act of 1793 . . . . . 320 *n.* 4
knowledge of use abroad not . . . . . 320 *n.* 4
not shown by foreign patents . . . . . 320 *n.* 4, 1026 *n.* 22
must make the invention known at date of patentee's *inventive act* 321
not shown by "lost art" 321
abandoned and forgotten invention is not 323
must be prior to what date . . . . . 321 *n.* 1
relative date of to that of patentee's invention . . . . . 328 *n.* 1
test of 324
must be affirmatively proved . . . . . 316 *n.* 1
evidence under the defence of 1026
naturally contradictory 1011
(See also ABANDONED EXPERIMENTS, ABANDONED INVENTIONS, ACTION AT LAW, APPLICATION FOR PATENT, BURDEN OF PROOF, COMBINATION, DATE, DEFENCES, DOUBLE USE, EXPERIMENTS, FOREIGN USE, IDENTITY, INTERFERENCES, INVENTION, INVENTIVE ACT, INVENTOR, JUDGMENTS, LOST ART, NOTICE, NOVELTY, PRIOR PATENT, PRIOR PUBLICATION, REDUCTION TO PRACTICE, SECRET, STATE OF THE ART.)
PRIORITY determines novelty between identical inventions 315
PRIORITY determined by priority of conception followed by diligence in reduction 383
date of conception may be shown . . . . . 334 *n.* 2
as between domestic and foreign inventors 382
the sole question in interference proceedings . . . . . 587 *n.* 1
burden of proof is on later patentee . . . . . 370 *n.* 1
evidence on 600
application oath *prima facie* evidence of . . . . . 558 *n.* 1
shown by use, publication, or patent 316
shown *prima facie* by prior publication . . . . . 42 *n.* 6

References are to sections.

PRIORITY — *continued.*
concession of, its requisites 603
binds whom 614
(See also ACTION AT LAW, CONCEIVER, CONCEPTION, DATE, INTERFERENCES, INVENTION, INVENTIVE ACT, INVENTOR, REDUCER, REPEAL, RIVAL INVENTORS.)
PRIVATE WRITINGS as evidence 1015
PRIVIES TO JUDGMENTS, who are 1178
PROBATE COURTS, no power over letters-patent 804
effect of judgment of . . . . . 1184 *n.* 2
and State insolvent courts, power of to compel assignment of patent for benefit of creditors rests on local law 805
(See also ADMINISTRATION, ASSIGNMENT, BANKRUPTCY, CREDITORS' BILL, JUDICIAL SALES.)
PROCEDURE IN EQUITY, rules of 1129
Patent Office, how regulated 427
PROCESS defined, synonymes of 159
distinguished from the mere function of its apparatus . . . . . 172 *n.* 2
joinder of with machine 474
and product separately patentable 466
may be joined with apparatus or product when 473
mechanical, Claim for, when void . . . . . 518 *n.* 5
"similar substances" in, defined . . . . . 285 *n.* 1
(See also ART, and titles thereto appended.)
PROCESS CIVIL, service of in actions at law for infringement 934
on domestic and foreign corporations 935
defects in, how pleaded . . . . . 956 *n.* 1
waiver of 934
(See also ACTION AT LAW, JURISDICTION.)
PRODUCT defined, when an invention 147
and process *distinct inventions* . . . . . 167 *n.* 1
separately patentable 466
may be joined when 473, 475, 476
joined with machine when 474–476
and machine separately patentable 466
Claim for 531
when protected by Claim for process or machine 531
process or machine not embraced in same Claim with product . . 510 *n* 1
(See also MANUFACTURE, and titles thereto cited.)
PROFERT being made of recorded paper it becomes part of the pleadings and demurrable . . . . . 950 *n.* 3
of patent in bill in equity 1106
PROFITS not synonymous with damages . . . . . 1136 *n.* 1
at law described . . . . . 1062 *n.* 7
how different from profits in equity . . . . . 1062 *n.* 1, 1136
of defendant, evidence of admissible at law to show plaintiff's loss 1062
immaterial when damages measured by license fee 1059
as a measure of damages, state of the cases on . . . . . 1061 *n.* 1
not a true measure of plaintiff's loss 1062
profits on product may be a measure of damages . . . . . 1061 *n.* 3
sales may be a measure of damages . . . . . 1061 *n.* 4
show plaintiff's loss how 1063
no presumption that plaintiff would have made 1063
whether recoverable at law when they exceed plaintiff's loss 1091
of plaintiff, when a measure of damages . . . . . 1062 *n.* 15
are pecuniary gains actually received from the infringement 1146
none from a void patent . . . . . 1138 *n.* 1

References are to sections.

PROFITS — *continued.*
embrace actual not possible benefits 1062, 1063
do not include remote benefits 1146
may exist though the business as a whole be unprofitable . . . . . 1148 *n.* 3
may be derived from an improvement though the whole device is unprofitable 1140 *n.* 2
from infringing use are those in excess of what the infringer might have made by using other open inventions 1145
from infringing use are what the defendant did make irrespective of what he might have made by using others . . . . . 1062 *n.* 7
none made by vendees of infringer if his price equal to plaintiff's 1151
not unliquidated damages when 1152
how shown and computed 1062, 1063
inferential evidence of 1062
not presumed to be as much as plaintiff made . . . . . 1062 *n.* 14
not measured by royalties . . . . . 1062 *n.* 2
shown by license fees afterwards paid by defendant 1062
not to be conjectured 1143
mode of computation determined by form of infringement 1138
computed from and to what date 1152
how computed where the infringer uses or makes and uses the invention 1144
profits from use of the invention to be separated from others . 1062, 1063
how computed when arising from infringing sales 1063, 1139
data of 1143
items of cost and yield 1063, 1139
burden of proof as to 1143
how computed when the patented invention is embraced in the article sold and gives it all its market value 1142
increases the number or amount of sales 1141
adds to the profits of each sale 1140
in equity, described . . . . . 1062 *n.* 7, 1138
theory of 1137
how different from profits at law . . . . . 1062 *n.* 1, 1186
rule of, places a premium on neglect of invention by inventor . . . 43 *n.* 5
presumed from infringement . . . . . 1138 *n.* 1
are money had and received, not damages . . . . . 1152 *n.* 3
how computed 1138
items of cost and yield 1062, 1063, 1139
from commissions, repairs, use by vendees, etc. 1151
accruing pending suit recoverable only where the infringement commenced before suit . . . . . 1152 *n.* 1
interest on when allowed 1066, 1153
cannot be increased by the court 1152
averment of in bill in equity 1106
plaintiff must prove 1150
payable to sole plaintiff though others interested 1153
defendant not enjoined from paying to plaintiff after the accounting . . 1153
assignable after accounting 1103
(See also ACTION IN EQUITY and titles there cited.)

PROPERTY in a patent two-fold . . . . . 408 *n.* 3

PROPORTION, diversities of may be matter of form or of substance 241
changes in without change in mode of operation do not affect identity . 241 *n.* 1
changes of in chemical combinations, etc. . . . . 241 *n.* 1

PUBLIC has a right to repeal of unlawful patents 719
inventions under natural law 25
interest of does not warrant infringement by agents or contractors . . . 919
injunction refused when it would injure 1200
(See also INFRINGEMENT, INJUNCTION, MONOPOLY, PATENT PRIVILEGE, REPEAL.)

References are to sections.

PUBLIC USE or sale as a defence 1030
a form of abandonment 865
abandonment to public presumed from 348
presumption not rebuttable . . . . . 354 *n.* 2
abandonment by, history of the doctrine 354
after application not abandonment . . . . . 354 *n.* 1
not abandonment unless more than two years before first application . 354 *n.* 2
mere making is not 355
experimental use is not 355
must give the public a knowledge of the invention 356
may exist though the invention is concealed in another device . . . 356 *n.* 1
single instance is abandonment . . . . . 356 *n.* 1
use by inventor alone may be 356
though he uses but once . . . . . 356 *n.* 2
temporary use by others as a favor is not 356
use under control of inventor is not 356
consent of inventor, whether necessary 357
acquiescence of the inventor not presumed . . . . . 358 *n.* 3
inventor acquiesces if he knows and does not forbid 358
"with consent of inventor," history of the doctrine . . . . . 357 *n.* 1
conclusions from acts of Congress, etc. . 357 *n.* 2
departures from the doctrine . . . . . 357 *n.* 2
piratical or fraudulent use not . . . . . 357 *n.* 2, 3
use under rival inventor not . . . . . 357 *n.* 2, 3
bearing of use under rival inventor on questions of abandonment and estoppel . . . . . 357 *n.* 3, 390
must be of the same exact invention 360
use of defective whole may abandon its parts . . . . . 354 *n.* 2
not shown by issue of prior patent . . . . . 360 *n.* 3
question of how tried in Patent Office . . . . . 560 *n.* 2
(See also ABANDONMENT, and titles there cited.)
PUBLICATION of inventions by Patent Office 55
prior (see PRIOR PUBLICATION) 325–330
PURCHASE MONEY, assignor's action for, assignee's defences to . . . 1237–1242
PURCHASER of patented article, right to use 824–830
(See LICENSE.)

RACE OF DILIGENCE, none between rival inventors 384
REASONING PROCESSES, not inventive skill . . . . . 78 *n.* 2
REBUTTER OF PLAINTIFF, cannot strengthen his evidence on issue of infringement . . . . . 1127 *n.* 2
RECEIVER, patents do not vest in, cannot convey legal title to . . . 766, 804 *n.* 1
may convey the equitable title to a patent . . . . . 804 *n.* 1
not assignee of license of partners of insolvent firm . . . . . 979 *n.* 2
under Pennsylvania law cannot sue on letters-patent . . . . . 944 *n.* 3
acting under orders, protected by the court from interference . . . . . 823 *n.* 5
(See also ASSIGNMENT, CREDITORS' BILL, JUDICIAL SALE, LICENSE.)

RECOLLECTIONS OF WITNESSES, weight of as evidence 1026
RECOMMITTAL of master's report on the accounting 1159
RECORD of patent is notice to all the world . . . . . 627 *n.* 2, 784
actual notice equivalent to . . . . . 784 *n.* 3
record of unrecordable instrument not constructive notice . . . . 627 *n.* 2, 785
when actual notice 785
Patent Office governed by record title . . . . . 784 *n.* 4
copies 627
of private companies as evidence . . . . . 1015 *n.* 11

References are to sections.

RECORD — *continued.*
(See also Action at Law, Application for Patent, Letters-Patent, Patent, Patent Office, Title.)

REDUCER, earliest entitled to patent unless an earlier conceiver was diligent in reduction 374, 375
later may be earliest conceiver, and *vice versa* 373
(See also Priority, and titles there cited.)

REDUCTION TO PRACTICE, necessary 125
may follow or accompany conception 381
defined 126
not shown by an application for a patent 126
by description written or pictorial 126
by model 126
by the issue of a patent 126
not accomplished while experimental 127
must prove that the invention is successful 127
practical use in business not always necessary 128
mechanical perfection not necessary to 129
does not affect the idea of means 130
involves only mechanical skill 131
may be made by employees 131
completes the inventive act 132
date of is date of inventive act 132
how shown . . . . . 1022 *n.* 3, 4, 1026
when sufficiently shown 128
patent *prima facie* evidence of . . . . . 593 *n.* 2
shown by actual use . . . . . 1024 n. 5
best mode of to be disclosed in specification 485
diligence in 383–391
by one inventor not inferred from that of another . . . . . 593 *n.* 2
by prior inventor necessary 391
(See also Action at Law, Application for Patent, Art, Composition, Conception, Date, Delay, Design, Diversities, Embodiments, Improvements, Interferences, Invention, Inventive Act, Inventor, Machine, Manufacture, Means, Novelty, Principle, Prior Use, Priority, Rival Inventors.)

REFERENCES, what and how cited on rejection of application 559
how answered by applicant 560

REHEARING in Equity to let in new defences or new evidence 1133–1135
for new evidence requires supplemental bill 1122
Patent Office, rules and grounds of 615

RE-ISSUE, amendment of letters-patent by 653–715
origin of as a mode of amending letters-patent 653
under *English law prior to Act of 1835* . . . . . 653 *n.* 3
our law prior to Act of 1832 653
Act of 1832 654
defects amendable by 654
Act of 1836 . . . . . 655, 656
variation between Act of 1836 and Act of 1832 656
different views of 656
Act of 1870 and Revised Statutes 657
Acts of 1836 and 1870 compared . . . . . 657 *n.* 1
conditions of always the same under our statutes 658
not allowable except under the statutory conditions 660
not a matter of equity regulation . . . . . 656 *n.* 2
courts cannot prescribe what a re-issue may contain, though they make rules of evidence by which the question of identity is determined 664

References are to sections.

RE-ISSUE — *continued.*
invalid if any requisite wanting . . . . . 659 *n.* 1
motive for, if no importance 703
object and character of 56
is a new contract between public and inventor . . . . . 696 *n.* 1
is a continuation of the original and governed by the law in force when the original was granted 708
not a new patent 464
the only remedy for defective patents 464
why preferable to new patent 653
or new patent, at option of inventor, may be had for matter described and not claimed . . . . . 656 *n.* 3
its relation to a disclaimer 641
disclaimer cannot enlarge a patent as a re-issue can . . . . . 650 *n.* 2
promotes public interest . . . . . 653 *n.* 2
invaluable to inventors . . . . . 653 *n.* 2
increases weight of patent as evidence 1016, 1041
treated as an honest effort to secure a right 684
effect of *laches* upon right to . . . . . 656 *n.* 2
origin of the difficulties in the law of . . . . . 635 *n.* 1
fundamental propositions of the law of 659
sole purpose to so amend an imperfect patent that it may protect the invention *which the original patent attempted to secure* 660
patent to be amended must be an imperfect existing patent 659
improper when patent perfect 660
perfect patent defined . . . . . 660 *n.* 2
patent not perfect though valid and operative as to some inventions . 660
patent not imperfect from failure to describe or claim matter outside the invention for which it was granted 661
improper where original does not describe the invention, and a new patent then needed . . . . . 665 *n.* 1
cannot amend a patent void *ab initio* 660
cannot cure a joint patent issued to a sole inventor or *vice versa* . . . 660
improper where original was issued on an application sworn to in blank and filled out by attorneys . . . . . 660 *n.* 1
cannot cure a voluntary false oath 660
of expired patent not allowed . . . . . 660 *n.* 1
proper when the patent is invalid or inoperative because the Description or Claim is defective or insufficient or the Claim is excessive . 656, 660
"invalidity," "inoperativeness," defined 660
Description or Claim "defective," when 656
insufficient when 656
proper when original inoperative from ambiguity . . . . . 660 *n.* 5
defects causing invalidity or inoperativeness enumerated 660
proper when the patent is invalid or inoperative as to the invention intended to be secured though valid and operative as to others 660
improper when original is valid and operative for any purpose . . . 660 *n.* 2
not void though it reproduces the original . . . . . 660 *n.* 2
reproducing the original admits that it was not invalid or inoperative 693 *n.* 3
is intended to amend defects of statement, not of subject matter 662
cannot remedy mistakes of judgment as to nature of invention 662 *n.* 2, 663 *n.* 1
of choice or judgment as to what a patent shall cover 662, 663 *n.* 1, 664 *n.* 5
may amend both Description and Claim . . . . . 656 *n.* 4
may cure an imperfect Description or an excessive Claim . . . . . 656 *n.* 2
may amend a defect in the statement of the term . . . . . 662 *n.* 2
alone can cure error as to effect produced . . . . . 643 *n.* 2
proper when specification imperfect though models and drawings are perfect 660 *n.* 6

References are to sections.

RE-ISSUE — *continued.*
can amend models and drawings of machine-patents only by each other 668 *n.* 1
can embrace only what the inventor had fully invented and attempted to secure by the original 660, 661
cannot include new matter which the inventor did not at first intend to protect 635 *n.* 1, 661
new matter defined . . . . . 668 *n.* 10
new matter may be an improvement or a subsequent invention . . 668
new matter is matter not mentioned in the original . . . . . 665 *n.* 1
cannot expand the invention nor include prior devices . . . . . 693 *n.* 2
cannot cover improvements . . . . . 661, 663 *n.* 1
cannot include distinct species of the original or ideas subsequently reduced to practice 661
cannot cover what the original alludes to as a mere possibility . . . 667 *n.* 3
cannot embrace devices used with, but not part of the original invention 661 *n.* 1
cannot claim matter which the records of the Patent Office show that the patentee was not the first to disclose . . . . . 661 *n.* 1
cannot cover what the state of the art, at the date of the original, shows to be new . . . . . 661 *n.* 1
cannot introduce a different principle though it was known to the patentee when the original was granted . . . . . 661 *n.* 1
cannot cover matter whose right to protection has expired by the limitation fixed by a prior patent . . . . . 662 *n.* 2
courts will not explore history of the art to see what the inventor might have covered by the original . . . . . 667 *n.* 2
confined to subject-matter which the patentee endeavored to describe and claim in the original patent 663
cannot cover even the actual invention unless the original attempted to describe and claim it . . . . . 663 *n.* 1
statements that "re-issue may cover all the original might have claimed," and that "it cannot cover anything which the original did not claim," alike erroneous 664
can cover in some cases what original did not claim 664
cannot always cover what the original might have claimed 664
cannot cover all the original could have claimed, but only what the original attempted to claim . . . . . 663 *n.* 1
improper to embrace matters described but not attempted to be claimed in the original 465
cannot cover all that was "suggested" in the original unless the attempt were there made to claim it . . . . . 663 *n.* 1
cannot cover what is merely claimed but not described in the original 667 *n.* 3
cannot cover matter which the patent or contemporary records show could not have been claimed in original . . . . . 665 *n.* 4
cannot claim matters inconsistent with Description, drawings, and model of original even though original claimed them . . . . . 665 *n.* 1
cannot cover matters which the courts have held not described in original 667
cannot cover separate parts of an invention which the original treated as an indivisible whole . . . . . 669 *n.* 1
may cover all the inventions which the original attempted to describe and claim, if the rules of joinder permit 669
sustained when courts can see that the patentee only seeks to cover the real invention . . . . . 661 *n.* 1
may claim whatever the original patent itself shows that it attempted to protect . . . . . 665 *n.* 1
may cover matter necessarily implied from the Description and Claims of the original 667
may cover matter not within the judicial interpretation of the original Claims . . . . . 667 *n.* 5
may cover all inventions inseparably connected with the one claimed in the original . . . . . 669 *n.* 1

Reference are to sections.

RE-ISSUE — *continued.*
may cover matter which as previously described was impracticable 667, 671 *n.* 2
identity of subject-matter with that of original presumed till the contrary appears . . . . . 664 *n.* 2, 681, 684
identity depends on the things described, not on the descriptions 668 *n.* 3
identity determined by what the original did set forth, not by what it might have set forth 681
identity with original primarily a question of interpretation, not of evidence . . . . . 684 *n.* 3
identity ascertained by comparing specifications 681
identity exists if the re-issue specifications are consistent with the original . . . . . 681 *n.* 5
identity determined by taking specifications, drawings, and models all into consideration 681
identity shown by model or proof of lost model or by files of re-issue application 681
identity cannot be shown by extrinsic evidence 681
or by parol proof . . . . . 605 *n.* 4
mode of determining what matters in the original patent the inventor did endeavor to describe and claim 664
courts and Patent Office follow the same rules in ascertaining what the original attempted to describe and claim . . . . . 664 *n.* 1
history of the rules for determining what the original did attempt to describe and claim . . . . . 664 *n.* 2
various statements of the mode of determining whether a re-issue exceeds the invention attempted to be described and claimed in the original 664
attempt to describe and claim in the original appears how 665
what the original attempted to describe and claim is ascertained from the original specification itself compared with the actual invention and the re-issue specification 664, 665
re-issue can cover nothing which is not found in the original specification, drawings, or model . . . . . 665 *n.* 2
attempt of original to describe and claim may appear either in the specification, drawings, or model 666
how the specification, drawings, or model of the original may show the attempt to describe and claim 667
impossible that original Description and Claim should not give some idea of what is attempted to be described and claimed 665
description in the original taken as it is not as it might have been 665 *n.* 1
in comparing original and re-issue both are construed by the state of the art at the date of the application . . . . . 667 *n.* 2
re-issue whose only Claims are not in the original is void . . 664 *n.* 5
presumption that the original intended to claim all that could properly have been claimed under its description 669
original model may be inspected by the court . . . . . 666 *n.* 1
re-issue cannot claim a feature shown in the origin by the model alone, without any proof of an attempt to claim it . . . . 666 *n.* 2
lost model how proved 666, 668
may amend the patent to any extent necessary to secure the invention attempted to be described and claimed in the original 659, 693
variations between the Descriptions and Claims of original and re-issue, how far consistent with identity of subject-matter 668
re-issue may vary from original in language, in general description, in statements of mode of making and use, in number and scope of Claims, etc. 668, 693
may amend language to any extent necessary to set forth the invention . . . . . 635 *n.* 1
may make definite what was before matter of inference . . . 668 *n.* 1

References are to sections.

RE-ISSUE — *continued.*
numerous examples of allowable variations . . . . . 008 *n.* 1–10
may make any correction which equity would decree . . . . 008 *n.* 9
may enlarge or narrow Claims 008
cannot amend Description or narrow Claims without limit at option of patentee . . . . . 088 *n.* 1
generally objected to on ground that Claims enlarged 088
may enlarge Claims when original is inoperative from narrowness of Claims . . . . . 000 *n.* 6
to enlarge Claims stands on same ground of right as one for any other purpose . . . . . 000 *n.* 1
of little value to inventors if confined to amendment of Description or narrowing of Claims 050
may enlarge the Claim but not the invention . . . . . 050 *n.* 3
where no adverse rights are affected . 050 *n.* 3
cannot enlarge the Claim . . . . . 050 *n.* 2
re-issue expressly enlarging Claims is void . . . . . 004 *n.* 5
against public and intervening patentees . . . . . 050 *n.* 2
Claim enlarged by omitting part formerly claimed . . . 070 *n.* 2
of generic patent may cover all included species 073
cannot claim different species from the one claimed in the original 073
of specific patent cannot cover the genus when 073
of combination-patent cannot cover a combination of less than all the elements, or of different elements, or of the same elements differently combined 070
may not cover the same combination with added elements . 070, 072 *n.* 5
may claim as a combination what the original claimed as an article . . . . . 070 *n.* 6
cannot cover subcombinations after unreasonable delay . . 000 *n.* 2
may cover subcombinations when . . . . . 070 *n.* 2, 071
may omit non-essentials or substitute equivalents 070
may cover elements when 072
though the combination was impracticable 072 *n.* 2
but only as described in the original . . . 072
but not when disclaimed in the original . . 072
of patent for an art, confined to same art 074
may cover apparatus and product when . . . . . 074, 075 *n.* 3
cannot cover the product however produced . . . . . 074 *n.* 3
of patent for a machine confined to same machine 075
identity with original determined by drawing and model . . . 082
confined to matters shown in original drawing or model . . . 004
may cover modes of making or using it if the original described them . . . . . 075 *n.* 2
may cover the process and product when 075
of patent for a manufacture, confined to same manufacture . . . 070
may vary from original in its description of the machine to which the manufacture is attached . . . . . 070 *n.* 3
may cover the process and apparatus when 070
if original confined to manufacture resulting from a certain process, re-issue cannot cover it as made otherwise 070
of patent for a composition confined to same composition 077
may cover ingredients, process, or apparatus when 077
cannot cover mode of packing . . . . . 077 *n.* 2
of patent for a design confined to same design 078
may cover elements and subcombinations when 078
cannot cover the same article as a manufacture 078
of patent for an improvement confined to the exact improvement . . 079
may cover process and apparatus when 079

References are to sections.

RE-ISSUE — *continued.*
not allowed unless the defect arose through inadvertence, accident, or mistake and without fraud 658, 660, 685
courts can treat re-issues as void if absence of inadvertence, accident, or mistake is evident from the face of the patent or the facts proved . . 658
"inadvertence," "accident," "mistake" defined 658
inadvertence, etc., relates to the application, not the invention . . . 685 *n.* 4
does not include errors of choice or judgment . . 685 *n.* 4
mistake, character of immaterial . . . . . 685 *n.* 4
is not misunderstanding . . . . . 685 *n.* 4
absence of inadvertence, accident, or mistake how shown 658
re-issue is *prima facie* evidence of inadvertence, etc. . . . . 685 *n.* 4
cannot amend defects *arising* through fraud 686
intentional defects not amendable though arising without fraud 687
whether defect was intentional or not is determined either from the patent, or the records of the Patent Office, or the acts or omissions of the inventor before or after the issue of the original 687
re-issue cannot restore matter intentionally excluded nor reject matter intentionally inserted 687
cannot reject matter before claimed as essential 668
adhered to on interference . . . . . 689 *n.* 4
may exclude from a domestic patent devices covered by expired foreign patents . . . . . 602 *n.* 2
cannot embrace matter expressly or impliedly excluded from the invention in the original patent 680
cannot enlarge Claims to cover matter intentionally excluded . 688
cannot cover matter abandoned before the original issued . . 708 *n.* 4
cannot cover matter actually used before the excluding application was filed . . . . . 691 *n.* 8
cannot cover forms, uses, causes, etc., once impliedly disclaimed 680
cannot cover matter once expressly disclaimed . . . 668, 680, 689
intentional exclusion not shown by mistaken disclaimer . 689 *n.* 1
re-issue may restore matter disclaimed by mistake . . . 689 *n.* 1
cannot cover matter disclaimed, or rejected by the examiner with the acquiescence of the patentee, or withdrawn to save the application or escape an interference 689
re-issue may restore matter disclaimed through a mistake in the Patent Office, when . . . . . 689 *n.* 6
re-issue may restore matter disclaimed in the Patent Office by an attorney without authority, when . . . . . 689 *n.* 6
re-issue may cover matter which the applicant proposed to withdraw when the proposal was not accepted by the Office 689 *n.* 4
re-issue cannot avert the consequences of an improper rejection in the Patent Office, but parties must appeal or sue in equity 689
acquiescence in the rejection of a Claim is an intentional exclusion of it 689
re-issue cannot cover a product where the original was confined to the process by amendment in the Patent Office rejecting the Claim for a product . . . . . 689 *n.* 4
re-issue may restore a Claim rejected in the Patent Office with the acquiescence of the patentee if it has since been allowed to another applicant . . . . . 689 *n.* 3
disclaimers in a re-issue bind the patentee in suits on that re-issue, but do not estop him from claiming the same matter in a new re-issue unless it was excluded from the original . . . . . 689 *n.* 5
re-issue may omit disclaimers found in the original when 689 *n.* 1

References are to sections.

RE-ISSUE — *continued.*
cannot cover matter intentionally excluded from the original Claims 690
presumption of intentional exclusion from failure to Claim is *prima facie* only . . . . . 690 *n.* 2
intentional exclusion shown by failure to claim clearly described matter unless the amendment is made without unreasonable delay 690
delay in applying for re-issue, if apparent on its face, raises a question of law as to its validity . . . 1114 *n.* 3
what is notice to a patentee that his invention is not covered by his Claims 691
patentee bound to examine his patent when granted and see if his Claims are too narrow . . . . . 690 *n.* 2
patentee presumed to know what, if diligent, he could have known . . . . . 691 *n.* 1
knowledge of the defect by the patentee may appear on the face of the patent . . . . . 1030 *n.* 13
re-issues to enlarge Claims clearly defective and re-issues to enlarge Claims defective only under certain interpretations stand on different grounds . . . . . 690 *n.* 2
intentional exclusion not shown by failure to claim imperfectly described matter unless the re-issue is unreasonably delayed after the patentee knows of the defect . 691
defects in original not always apparent on face of patent 690 *n.* 1
inoperativeness of a patent as to some inventions may not be discovered till long after the patent issues . . 690 *n.* 5
often doubtful whether the Claims cover the invention or not . . . . . 690 *n.* 1, 3
intentional exclusion shown by unreasonable delay in amending 691
unreasonable delay in amending shows that there was no inadvertence, etc. . . . . 690 *n.* 2
diligence required in amending Description or narrowing Claims . . . . . 688 *n.* 1
delay in discovering the defect may be unreasonable as well as delay in acting on the discovery . . . . 691 *n.* 1
no fixed rule for unreasonable delay . . . . . 690 *n.* 5
special rules and examples of unreasonable delay 690 *n.* 1–8
less than two years' delay may be unreasonable . . 690 *n.* 6
two years' delay unreasonable unless explained . . 690 *n.* 6
unreasonable delay how ascertained 690
delay may be explained . . . . . 691 *n.* 6
unreasonable delay not excused by ignorance of law 690 *n.* 3
question of delay how affected by ignorance of language . . . . . 690 *n.* 3
mere delay in re-issue does not show intentional exclusion 692
original Claims may be reproduced without reference to delay . . . . . 688 *n.* 1
right to re-issue not affected by matters occurring after issue of original . . . . . 690 *n.* 1
facts occurring after issue of original are evidence of other facts existing at date of original . . . . 690 *n.* 1
right to re-issue not lost by lapse of time 692
re-issue allowable after extension whether in due course or by special act 692
right to re-issue how affected by unreasonable delay . 690
abandonment by unreasonable delay in re-issue . . . 352
delay in re-issue enures to benefit of public . . . . 690 *n.* 7

References are to sections.

RE-ISSUE — *continued.*
intervening rights affect right to re-issue how . . . . . 690 *n.* 1
conduct of third parties affects right to re-issue how . . . . 690 *n.* 1
conduct of patentee toward third parties affects right to re-issue how 710 *n.* 2
cases bearing on the questions of intervening rights, unreasonable delay, insertion of new matter, etc., cited and discussed . . 690 *n.* 1
construed to sustain it, if possible 684
not to extend beyond matter attempted to be described and claimed in the original . . . . . 603, 714 *n.* 8
re-issue invalid unless it can be so construed 603
by the original . . . . . 684 *n.* 3, 746
by the state of the art when the original was granted . . . . 684 *n.* 6
excessive Claims restricted by interpretation 684
valid *prima facie* . . . . . 714, 1032 *n.* 18
validity of re-issue shown by acquiescence in original 1187
re-issue granted after a severe contest has a strong presumption in its favor 684 *n.* 1
invalid, when, evidence of 1032
evidence as to divergence from original 1032
evident invalidity available on demurrer 1110
number of, not limited by law 693
several successive re-issues allowable 693
each presumed to have been necessary to cure defects . . . . . 693 *n.* 4
each stands by itself free from the defects of the others 693
re-issue cannot be changed into the original by disclaiming the new features . . . . . 693 *n.* 3
one re-issue being void a second one may reproduce the original . . 693 *n.* 3
in divisions, allowable 694
proper when inventions are separable . . . . . 694 *n.* 1
combination-patent may re-issue in divisions for each element and sub-combination . . . . . 694 *n.* 2
all divisions must issue to same patentee and for parts embraced in the original invention 695
one division may contain the original Claims and another the new ones 694 *n.* 1
each division must cover a patentable invention 695
may describe the whole invention but must claim only its own part 695
is a separate patent and unaffected by faults in others . . 695
all divisions rest on same original and suffer its incurable defects . . . 695
supersedes the original and requires its surrender to the government . . . 696
surrender, how accomplished 696
need not be in writing . . . . . 696 *n.* 2
destroys, when accepted, all existing rights of action . 696 *n.* 3, 699, 713, 973
subsequent rights of action rest on re-issue 696
no damages for infringements prior to re-issue recoverable 696
suspends at once all rights of action . . . . . 696 *n.* 3, 699, 956 *n.* 2
history of doctrine as to taking effect of 697
takes effect on grant of re-issue 697
re-issue refused, original returned to patentee 697
unless refused for want of patentability or priority . . . . 697 *n.* 3
re-issue illegal, the original is still in force . . . . . 697 *n.* 1
by whom made 698
who must apply for re-issue 701
inventor, if living, must concur 700
even if he has assigned the patent 700
re-issue to patentee bars a re-issue to an unrecorded assignee 701 *n.* 8

References are to sections.

RE-ISSUE — *continued.*

inventor may be compelled to obtain re-issue for assignee by bill in equity 701
inventor cannot obtain re-issue without consent of assignees 701
inventor cannot surrender without consent of assignees . . 701
assignee's consent shown by abstract of title . . . 701 *n.* 5
grantees and licensees not parties to re-issue 698
executor may obtain re-issue 406
re-issue to administrator presumed regular . . . . . 701 *n.* 1
surrender by person other than the owner cannot affect his rights . . . . . 698 *n.* 2
surrender made effective by ratification as well as original consent of owners 698
assignee may accept or reject . . . . . 778 *n.* 1
grantees and licensees cannot claim under re-issue without renouncing all rights under original 698, 702
parties asserting rights under re-issue adopt it and abandon the original . . . . . 698 *n.* 7, 701 *n.* 4
assignees have the same rights under re-issue as under original . . . . . 701 *n.* 4, 702
re-issue may be in force in one granted territory and original in another 698
to whom granted 702
to an assignee of any degree . . . . . 702 *n.* 1
of an executor . . . . . 702 *n.* 1
grant of to assignee is *prima facie* evidence of his title 702
to assignee cannot cover matter disclaimed by the assignor . . . 689 *n.* 1
application for, form of 704
oath 700
contents of 705
assignees of applicant bound by his oath . . . . . 705 *n.* 1
prima facie evidence of priority 708
specification, drawings, and model 706
specification must follow language of original unless a departure therefrom is necessary 706
multiplication of Claims in . . . . . 608 *n.* 5
broad Claim binds patentee though it does not secure his invention 708 *n.* 1
drawings cannot vary from original unless the variation appears in the model 706
joinder of inventions in 669
true date of, as to public use . . . . . 354 *n.* 1
is date of the original . . . . . 708 *n.* 4
fees not payable if error arose in Patent Office 638
must be based on single original patent 704
matter described in two patents but claimed in neither must be covered by re-issue of earlier 680
filing of entitles applicant to a hearing 707
hearing on re-issue has precedence over ordinary applications . . . 707
expedited when patent nearly expired . . 707 *n.* 2
examination as to patentability, identity with original, fact of inadvertence, etc. 708
Patent Office same power over as over original . . . . . 703 *n.* 1
on examination as to merits, not aided by fact that original was granted 708
dismissed if on its face original was void . . . . . 660 *n.* 1
Claims sustained by courts may be revised in the Patent Office 708 *n.* 2
patentability determined by state of art at date of original . . 703, 708
re-issue void for want of novelty, if original was . . . . . 708 *n.* 3
abandonment, how indicated 708

References are to sections.

RE-ISSUE — *continued.*
identity with original, how shown 709
how shown in the Patent Office when no drawings or model . . 683
extrinsic evidence when admissible 683
when model lost and drawings incorrect, they cannot be changed without the clearest evidence . . . . 681 *n.* 12
Patent Office to judge of inadvertence, etc. 658
inadvertence, etc., shown how 710
interferences 711
appeals 712
when withheld by Commissioner 712
withdrawal and revocation of surrender 707
date and term of 713
judgment of Commissioner on, when final 714
accepting the surrender and allowing a re-issue, is final 714
as to date of the invention is final . . . . . 713 *n.* 1
as to inadvertence, etc., how far final . . . . . 686 *n.* 1
that re-issue covers patentable subject matter, or describes and claims no new matter, or defects arose from inadvertence, etc., not final . . . 714
on good faith of applicant and absence of fraud in allowing re-issue, how far final . . . . . 686 *n.* 1
whether defects arose from fraud always an open question in courts and Patent Office 686
re-issue can be attacked in infringement suits for fraudulent specification or fraud in defects of original 715
jurisdiction of Commissioner over, history of question . . . . . 715 *n.* 1
fraud *in allowance of, question not raised collaterally* 715
ground for proceeding to repeal, how shown 715
re-issue void, if applicant attempts fraud 702
knew at date of application that he or his assignor was not the true inventor . . 702 *n.* 2
surrender no proof that original entirely void 699
rights under governed by same law as under original 713
governed by contracts made as to the original . . . . . 699 *n.* 2
re-issue does not affect judgments, payments, or any closed transactions based on the original 699
violation of rights under, not authorized by acquiescence before surrender 699 *n.* 5
not sanctioned by surrender 699
amendable by re-issue or disclaimer 703
when changes made by can be removed by disclaimer . . 642 *n.* 1; 649 *n.* 2
void Claims do not prejudice valid ones 684
extension of 838
as evidence, that the invention was made as described in the original . 1022 *n.* 3
re-issued patent is *prima facie* evidence of priority over all applicants later than its original application 590
infringed, sometimes when original would not have been . . . . . 983 *n.* 3
same defences to as to original 985
pending suit in equity, whether new or supplemental bill required 1122
suit not continued in order to obtain . . . . . 713 *n.* 5
(See also ACTION AT LAW, APPLICATION FOR PATENT, ART, ASSIGNEE, ATTORNEYS, CLAIM, COMBINATION, COMMISSIONER, COMPOSITION, CONSTRUCTION, DELAY, DESCRIPTION, DESIGN, DISCLAIMER, ESTOPPEL, EXTENSION, GENERIC INVENTION, IDENTITY, IMPROVEMENT, INTERFERENCES, JOINDER, JOINT PATENT, JUDGMENTS, LACHES, LETTERS-PATENT, MACHINE, MANUFACTURE, MODELS, NEW MATTER, PATENT, PATENT OFFICE, PATENTEE.)
REJECTION OF APPLICATION, what references cited by examiner and how . 559
RELEASE OF CAUSE OF ACTION, form and effect of 982
as a defence, evidence of 1047
REMEDIES for wrongs against the patent privilege liberally applied 843

References are to sections.

REMEDY for infringement, originally in Star Chamber, later in common law courts 931
by action at law (see ACTION AT LAW) 931–1080
by action in equity (see ACTION IN EQUITY) 1081–1167
cannot be complete . . . . . 1136 n. 1
REMITTITUR, when verdict curable by 1068, 1078
RENEWAL OF APPLICATION AFTER FORFEITURE 584
RENT PAID, allowed in estimating profits 1139
REPEAL OF LETTERS-PATENT 710–730
by courts, not Patent Office 418
jurisdiction of Federal courts over 859
three classes of persons interested in 716
not necessary in the interest of alleged infringers 717
necessary in the interest of prior inventors 718
the public 719
two modes of proceeding for 720
In the interest of prior inventors 721–724
under Acts of 1790, 1793, 1836 721
1870 722
Revised Statutes 723
who *may sue for* 723
repeal by collateral suit not allowed 717
plaintiff must be a patentee 722
procedure 723
interference judgment no bar to suit for repeal . . . . 613 n. 3
effect of delay in suing for repeal . . . . . 723 n. 5
no repeal after extension has expired . . . . . 723 n. 4
sole issue is priority 724
judgment, scope and effect of 724
dismissal of suit not a judgment that patents do not interfere 1182 n. 1
affects only parties and privies to the suit 723
the right of the defeated party 974
in the interest of the public 725–730
allowable and necessary 725
in three cases, — prior grant, grant procured by fraud, grant of ungrantable matter 726
in cases of prior grant covered by repeal in interest of prior inventor 726
grant procured by fraud special proceeding required 727
evidence in such cases 715
grant of ungrantable matter 728
procedure, is by bill in equity 729
not instituted in interest of private persons when 729
instituted in name of United States 729
practice in 730
judgment, effect of, costs 730
extinguishes all rights under the patent 974
private suits not enjoined pending suit for repeal . . 730 n. 1
suit for repeal before judgment raises no presumption against the patent . . . . . 730 n. 1
(See also ACTION AT LAW, ANNUL, COURTS, EQUITY, FRAUD, INTERFERENCES, JUDGMENTS, LETTERS-PATENT, PATENT, PATENT PRIVILEGE, PRIORITY, RIVAL INVENTORS.)
REQUESTS TO CHARGE 1074
RES ADJUDICATA in patent cases, doctrine and application 983, 1017
doctrine of applied in the Patent Office . . . . . 613 n. 1
evidence of in defence 1048
(See also ACTION AT LAW, INJUNCTIONS, JUDGMENTS, PATENT OFFICE, RE-ISSUES.)

References are to sections.

RESCISSION OF ASSIGNMENT, in equity, terms of 1229
when patent invalid, terms of 1230
procured by fraud, terms of 1231
by assignee under reservation in the contract, terms of . . . . . 1231 *n.* 10
OF LICENSE, when decreed 1245
at suit of licensor, when 1249
(See also ASSIGNEE, ASSIGNMENT, EQUITY, LICENSE.)
RESERVATION, for future patent . . . . . 500 *n.* 3
of right to patent inventions described but not claimed . 465 *n* 8
RESTRAINING ORDER, pending motion for preliminary injunction 1207
RESTRAINT OF TRADE, grant of exclusive right not . . . . . 793 *n.* 3
RESULT, defined, when an invention 147
Claim for void, how construed 510
Claim for all modes of effecting, void . . . . . 515, 519 *n.* 2
difference in shows difference of machine . . . . . 200 *n.* 1
(See also EFFECT, END, IDEA, MANUFACTURE, MEANS.)
RETROSPECTIVE LEGISLATION covering patent privilege not unconstitutional . . . . . 46 *n.* 2
REWARD THEORY of patent privilege under American law 20
RIGHT to make distinct from that to use . . . . . 811 *n.* 1
RIGHTS included in patent privilege 61
separable and separately transferable 61
of inventor and his transferees protected by law 849
RIGHT OF ACTION, for past infringements vests in executor and he may assign or sue thereon . . . . . 943 *n.* 1
assignment of, form and effect 790
is not a sale of unliquidated damages . . . . . 943 *n.* 1
assignable only with the patent 943
requires distinct words of conveyance 781
assignment of expired patent transfers rights of action 781, 790
assignee takes subject to all equities . . . . . 790 *n.* 1
(See also ACTION AT LAW, ASSIGNMENT.)
RIVAL DOMESTIC PATENT no bar 461
RIVAL INVENTORS 370–391
defined 366
relations of toward each other . . . . . 995 *n.* 1
earliest entitled to the patent 370
first reducer *prima facie* entitled to patent . . . . . 58 *n.* 3
first conceiver, if diligent in reducing, entitled to patent . . . . 58 *n.* 3, 375
no "race of diligence" between 384
the one who understands the invention best is probably the true inventor 379 *n.* 1
adjudication between in Patent Office 54
rights of how determined in Patent Office 586
(See also ABANDONMENT, CONCEIVER, CONCEPTION, INTERFERENCES, INVENTION, INVENTIVE ACT, LETTERS-PATENT, PATENTS, PRIORITY, REDUCTION TO PRACTICE.)
ROYALTIES, various examples . . . . . 821 *n.* 1
on sales how distinguished from license fees for the use of the invention . . 1251
agreement to pay *per* article is not an agreement to produce any number of articles . . . . . 821 *n.* 1; 1250 *n.* 2
on sales when due and payable 1252
on each article sold, become due though the articles are unfinished when sold 1252 *n.* 3
due from licensee if satisfaction has been made for unlawful sales . . 830 *n.* 1
licensee, in action for royalties on sales, not allowed to deny validity of patent 1252 *n.* 5

References are to sections.

ROYALTIES — *continued.*
paid, allowed in estimating profits 1130
effect of failure to pay 821
right to, insurable . . . . . 821 *n.* 1
(See also ASSIGNMENT, LICENSEE, LICENSE-FEE, and titles there cited.)

SALARIES, when allowed in estimating profits 1130
SALE, mode of presenting not invention . . . . . 78 *n.* 2; 166 *n.* 1
any transfer for value, however disguised, as a judgment, exchange, etc., is a sale 905, 1252
without restrictions as indicating abandonment 350
how proved on an action for royalties 1252
unconditional and lawful sale of patented article confers full ownership on vendee and impliedly warrants title of vendor . . . . . 824 *n.* 9
lawful sale of patented article without restrictions releases it from the monopoly 824
to patentee is evidence of sale to others . . . . . 1042 *n.* 1
of patent rights, States cannot regulate . . . . . 46 *n.* 4
of patented articles, States can regulate . . . . . 46 *n.* 4
(See also ABANDONMENT, ACTION IN EQUITY, ACTION AT LAW, ASSIGNMENT, DAMAGES, LICENSE, PROFITS, ROYALTIES, STATES OF THE UNION.)
SALESMEN, infringement by 920
may be enjoined when the profit is distinct . . . . . 1204 *n.* 9
SAVINGS, are profits in equity 1140
from defendant's inventions allowed in estimating profits 1139
(See also ACTION IN EQUITY.)
SECRECY, caveats, specifications, etc., kept in Patent Office in 442, 553
adverse specifications shown to interference contestants . . . . . 592 *n.* 1
SECRET, affidavits claiming priority against an existing patent are . . . 560 *n.* 1
INVENTION, the sole property of the inventor 24
how protected by law (see UNPATENTED INVENTIONS) 867-883
USE, not to avoid patent . . . . . 17 *n.* 2
not prior use 320
SECRETARY OF THE INTERIOR, authority of over Commissioner 424
SHAPE, diversity in may or may not show want of identity 238
does not affect identity unless it changes the function or mode of operation . . . . . 238 *n.* 1
producing change in operation is different invention . 238 *n.* 2
result is different invention . . 238 *n.* 2
increasing utility may be a different invention . . . 238 *n.* 2
may be matter of substance in machines or manufactures 238 *n.* 2
in combinations, effect of . . . . . 238 *n.* 2
compositions, effect of . . . . . 238 *n.* 2
designs is matter of substance 238
does not prove absence of infringement 894
(See also DIVERSITIES, IDENTITY, INFRINGEMENT.)
SIGNATURES, essential to patent . . . . . 967 *n.* 4
SIMPLICITY OF INVENTION a ground of merit . . . . . 85 *n.* 2
does not show want of inventive skill . . . . . 113 *n.* 2
increase of, not proof of want of identity . . . . . 240 *n.* 1
SIZE, diversity in, may be matter of form or of substance 239
is not difference in the inventions . . . . . 239 *n.* 1
enlarging, is not invention . . . . . 78 *n.* 2
does not show absence of infringement 894
(See also DIVERSITIES, IDENTITY, INFRINGEMENT.)

References are to sections.

SKETCHES, not evidence of prior use 318
SKILLED IN THE ART, who are 488
Description addressed to persons who are 488
means skilled as the art existed at date of invention . . . . . 488 *n.* 2
presumed to know only known equivalents . . . . . 488 *n.* 2
understand its technical terms 492
(See also ACTION AT LAW, DESCRIPTION.)
SLANDER AGAINST A PATENTED INVENTION 886-889
nature of the injury 886
not actionable unless special damage results 887
by denying patentability 887
title of patentee 888
circulars warning the public against an infringer, when not . . . 886 *n.* 1
assertion of rights in good faith and by proper modes is not 888
agent of patentee to ascertain fact of infringement, not guilty of . 1218 *n.* 1
remedies at law or in equity 889
to be sought in State courts 889
(See also UNPATENTED INVENTIONS.)
SLAVE, invention of, patentable neither by him nor his master . . . . 303 *n.* 3
"SMALT PATENTS," scope of . . . . . 68 *n.* 1
SOLE PATENT FOR JOINT INVENTION, void, evidence as to 1032
SOLICITORS OF PATENTS (see ATTORNEYS) 425, 431-437
SPECIFIC INVENTION, covered by patent for generic (see GENERIC INVENTION) 535
SPECIFIC PERFORMANCE, of assignment of right to patent 411
of contract to assign when decreed in equity 1228
refused 1228
enforced against assignee 1234
of license contract decreed against licensor when 1244
of implied contract decreed . . . . . 1244 *n.* 1
refused when it would compel the disclosure of an inventor's secret . . 1228 *n.* 3
of contract for personal services not decreed . . . . . 1228 *n.* 3
enforced indirectly by injunction when 1228
(See also ASSIGNEE, ASSIGNMENT, ASSIGNOR, CLOUD ON TITLE, CONTRACT, COURTS, EQUITY, ESTOPPEL, INJUNCTION, LICENSE, LICENSEE, PATENT, PATENTED INVENTIONS, RESCISSION, STATE COURTS, TITLE, TRANSFER.)
SPECIFIC TREATMENT OF SPECIFIC OBJECT, is an invention . . 101 *n.* 3
defined 101
essence of 104
recently recognized as an invention, formerly confounded with double use 104 *n.* 1
(See also ART, DOUBLE USE, FORCE, IDEA, INVENTION, INVENTIVE ACT, MEANS, PROCESS.)
SPECIFICATION 480-539
meaning of the word . . . . . 750 *n.* 6
in the Act of 1836 . . . . . 655, 656
first required in 1712, in England 42
purpose of 481
sets forth the contract between inventor and public 481
importance of as basis of all rights under the patent 480
must conform to statutes and Patent Office rules . . . . . 480 *n.* 1
parts of, — Description, Claim 482
Description and Claim not distinct under Act of 1793 654
Claim essential to 504
misrepresenting or concealing the invention with intent to deceive the public is fraudulent and avoids the patent 685
fraudulent concealment or redundancy how proved 1034

References are to sections.

SPECIFICATION — *continued.*
intentional misrepresentation or concealment without intent to deceive binds the patentee to the invention as described 685
claiming the invention as a combination does not abandon the elements 689 *n.* 1
erasures and interlineations in 539
how signed and attested, amendments to 539
not withdrawable after filing 553
copy may be obtained by inventor or his attorney 553
as evidence 1015
all construed together 489
English, when a publication . . . . . 328 *n.* 3
provisional not a publication . . . . . 332 *n.* 2
(See also ACTION AT LAW, APPLICATION FOR PATENT, CLAIM, CONSTRUCTION, DEFECTS, DESCRIPTION, DISCLAIMER, DRAWINGS, FALSE SUGGESTION, FRAUDULENT CONCEALMENT, JOINDER, LETTERS-PATENT, MODELS, PATENT, PATENT OFFICE, RE-ISSUES.)

SPECIMENS for Patent Office, when required 540, 549
necessity for decided by Commissioner . . . . . 549 *n.* 1
and models as evidence of prior use 1026
(See also APPLICATION FOR PATENT, PATENT OFFICE.)

SPECIAL ACT, granting patent independent of other acts 47
construed by general law 47
(See also ACTS OF CONGRESS, LETTERS-PATENT, PATENT.)

SPECULATION as to needs or results not invention . . . . . 80 *n.* 1

STAMPING PATENTED ARTICLES, duty and purpose of 902
when and why required 628
rule of applies in equity as well as law . . . . . 628 *n.* 3
statute regulating it to be strictly construed . . . . . 628 *n.* 1
mode of 628
effect of failure in 628
failure in no bar to an injunction . . . . . 628 *n.* 3
effect of failure, in suit for infringement at law 981
evidence of omission of, as a defence 1046
by infringers prohibited 629

STAMPING UNPATENTED ARTICLES, when forbidden 630
statute against construed strictly 631
an offence though never offered for sale 630
in expectation of a patent 630
under an expired patent 630
in joke or derision no offence 630
no offence unless with fraudulent intent 630
with intent to deceive an offence 630
intent to deceive, defined . . . . . 630 *n.* 2
who liable for . . . . . 631 *n.* 3
corporation may be guilty of . . . . . 630 *n.* 2
procedure and penalty for 631
person guilty, estopped to deny validity 631
(See also ACTION AT LAW, DAMAGES, ESTOPPEL, PATENTED ARTICLES.)

STATE OF THE ART, illustrations of its meaning . . . . . 88 *n.* 2
evidence of, admissible for what purpose 1020
to aid in construction of patent 740
admitted without notice . . . . . 1006, 1116 *n.* 4, 5
confined to 1020
how shown . . . . . 740, 1020, 1026 *n.* 3
recited in bill in equity . . . . . 1106 *n.* 2
(See also ACTION AT LAW, INVENTOR, NOTICE.)

Reference are to sections.

STATES OF THE UNION, power to grant letters-patent 45
power over patent privileges granted by the United States 46
have no power over the monopoly but may regulate use or sale of patented art or article . . . . . 46 *n.* 4, 1242
power to regulate contracts concerning inventions . . . . . 46 *n.* 4
have no power over contracts concerning the patent privilege . . . 46 *n.* 4
have no power to restrict sale of patent privilege 1242
power to authorize involuntary assignments of patents . . . . 766 *n.* 1
power to require notes for patent rights to follow certain forms . . . 46 *n.* 4
disclose their consideration . 1242
power to change the usual legal character of mercantile paper when given for patent rights 1242
have no power over the rights of executors under the Patent Law . . 404 *n.* 1
to exempt counties from suits for infringement . . . 911 *n.* 4
to discriminate against patented inventions as such . . . 46 *n.* 4
have power to regulate peddlers of a patented invention . . . . . 46 *n.* 4
sale of dangerous articles . . . . . 46 *n.* 4
establish a maximum charge for use of an invention . . 1242 *n.* 4
police power not curtailed by Congress . . . . . 46 *n.* 4
laws of, govern licenses 306
(See also NOTES, LICENSE, PATENT PRIVILEGE, PATENTED INVENTIONS.)
STATE AND FEDERAL COURTS, jurisdiction discussed 853–866
cases not removable from Federal jurisdiction by a State statute providing a tribunal to decide them . . . . . 861 *n.* 1
(See also COURTS, FEDERAL COURTS, STATE COURTS.)
STATE COURTS, jurisdiction of, over suits for libel against inventors . 1257 *n.* 6
on contracts relating to inventions 1257
no jurisdiction to determine patentability or infringement 1256
effect of judgments on subsequent cases . . . . . 1184 *n.* 2
(See also COURTS, FEDERAL COURTS, JURISDICTION.)
STATUTE OF FRAUDS, contract for sale of invention before patent not a contract for goods under . . . . . 768 *n.* 2
STATUTE AGAINST MONOPOLIES, passage of 7
quoted . . . . . 10 *n.* 1
its relation to common law 10
modern Patent Law 10
effect of on legal monopolies 10
is a negative statute excluding all inventions except those named . . . 66 *n.* 1
"within the realm," meaning and effect of . . . . . 70 *n.* 1
"which others . . . did not use," meaning of . . . . . 71 *n.* 1
"generally inconvenient," meaning of . . . . . 70 *n.* 2
(See also MONOPOLIES, PATENT LAW, PATENT PRIVILEGE.)
STATUTE 5 & 6 WILL. IV. conferring power to amend letters-patent . . 16 *n.* 4
validating patents void for prior use . . . . . 17 *n.* 3
STATUTE OF LIMITATIONS, Federal and State, effect on patent causes . . 980
not retrospective 980
must be specially pleaded 992
defence of, evidence under 1045
(See also ACTION AT LAW.)
STIPULATIONS OF COUNSEL, effect of 1129
STOCKHOLDERS OF CORPORATION, whether liable for its infringements . 912
STRUCTURAL LAW OF A MACHINE, defined 173
SUBCOMBINATIONS, essential character of 279
relation to principal combination . . . . . 670 *n.* 2
patentability of . . . . . 670 *n.* 2
of previously patented combination patentable . . . . . 465 *n.* 2
joinder of with combination and elements 472, 528
(See also COMBINATION and titles there cited.)

References are to sections.

SUBJECT-MATTER, of application for patent (see APPLICATION FOR PATENT).
SUBPŒNA DUCES TECUM, to defendant on accounting . . . . . 1157 n. 3
SUBPROCESSES, joinder of with principal process 520
SUBSTANCE AND FORM, how distinguished . . . . . 220, 235 n. 1
matter of, defined, instances of 566
"SUBSTANTIALLY as and for the purpose set forth," meaning of in Claim . . 517
as described," meaning of in Claim 517, 760
SUGGESTIONS OF OTHERS, not incompatible with exercise of inventive skill 84
do not impair merit of true inventor . . . . . 393 n. 1
as to inseparable ideas of means are not co-operative invention 394
separable and united ideas are co-operative invention 395
as to reduction belong to the inventor 131, 393
not part of inventive act 393
not co-operative invention 393
(See also INVENTIVE SKILL.)
"SUITABLE MATERIALS," meaning of 751
SUPERSEDEAS, appeal to Supreme Court when a 1161
SUPPLEMENTAL BILL, grounds and requisites of, procedure on 1122
SUPPRESS evidence in equity, motion to 1128
SUPPRESSION OF TRUTH, raises every presumption against the party 1041 n. 11, 1042
SUPREME COURT of the United States, no original jurisdiction over questions of fact in patent cases . . . . . 800 n. 2
no jurisdiction to enforce contract for patent unless amount over $2000 866 n. 2
may reverse decree when based on evidence improperly admitted . . 1116 n. 4
effect of judgments on subsequent cases 1180
construction of letters-patent by is final . . . . . 733 n. 2
(See also ACTION IN EQUITY, ACTION AT LAW, COURTS, JUDGMENTS, JURISDICTION.)
SUPREME COURT of the District of Columbia, has same power in patent cases as the Circuit courts . . . . . 866 n. 1
appeal from Commissioner to 570
decisions of how far conclusive 570
(See also APPEALS, APPLICATION FOR PATENT.)
SURRENDER AND RE-ISSUE (see RE-ISSUE) 696–699
SURREPTITIOUS use not public use or abandonment 358
"SURREPTITIOUSLY," meaning of . . . . . 960 n. 1
changes in meaning of in Acts of Congress 995
SUSPENSION, of preliminary injunction 1212
of suit pending other suits . . . . . 1155 n. 5

TECHNICAL PHRASES in Claim 517
TERM OF PATENT 622–625
under early English law 18
measure of 978
how fixed 1043
error in stating cured by re-issue . . . . . 662 n. 2
(See also APPLICATION FOR PATENT, FOREIGN PATENT, LETTERS-PATENT, PATENT, RE-ISSUE.)
TESTIMONY, may be taken abroad by order of Commissioner . . . . . 601 n. 3
failure to appear to take, after due notice, waives all technical irregularities 601 n. 2
notice to take not reasonable if party must travel day and night to reach the place . . . . . 601 n. 2
THEORY, not patentable 125
scientific theory of the invention not to be set forth in specification 484 n. 2, 485 n. 3
THEORIES and abstractions to be kept out of specification 485

References are to sections.

TITLE TO PATENT, legal created by issue of patent . . . . . 428 *n.* 1
does not exist till patent issues . . 769 *n.* 4, 940 *n.* 1
vests in patentee when patent issues . . . . . 765 *n.* 1
not complete till patent recorded . . . . . 627 *n.* 1
perfect without delivery of patent . . . . . 627 *n.* 1
shown by patent or its assignment duly recorded . 786
transferable only by written assignment . . . 768 *n.* 2
conferred by an assignment in trust . . . . . 786 *n.* 7
vests in assignee when . . . . . 769 *n.* 4
if patent issues to him . . . 769 *n.* 4
vests on issue of patent in the latest assignee of record though issued to assignor . . . . . 769 *n.* 4
failure of, remedy of assignee 1229
equity will compel assignor to cure, if possible . 1229
as defence to assignor's suit for price 1238
by estoppel 787
patent *prima facie* evidence of 1016
application evidence of applicant's title . . . . 450 *n.* 1
not overthrown on soluble doubts . . . . . 773 *n.* 4
equitable, rests on contracts or unrecorded transfers 786
may vest in different person from legal 786
arising under assignments, relation of to legal 786
and legal meeting in same person prevail over an equitable of equal equity 786
legal when held in trust for equitable . . . . . 769 *n.* 6, 786
equity will compel transfer to equitable owner . . . . . 1228 *n.* 5
of record, Patent Office bound by . . . . . 450, 784 *n.* 4
when conclusive on subsequent parties 784
outstanding rival patent a cloud on 718
averment of in bill in equity 1106
defect of, raised by demurrer 1110
cannot be tried in interference proceedings . . . . . 587 *n.* 1
(See also ACTION IN EQUITY, ACTION AT LAW, ASSIGNEE, ASSIGNMENT, CLOUD ON TITLE, CO-GRANTEES, CONTRACT, CO-OWNERS, EMPLOYEE, EMPLOYER, EQUITABLE INTERESTS, GRANT, GRANTEE, GRANTOR, LICENSE, LICENSEE, LICENSOR, PARTNERS, PATENT, PATENT PRIVILEGE, PATENTED INVENTIONS, PATENTEE, RECEIVER, RESCISSION, SPECIFIC PERFORMANCE, STATES OF THE UNION, TRANSFER.)

TOOLS, value of use of, allowed in estimating profits 1139

TRADE, restraint of, contract not to make articles during the life of a patent is not 1255 *n.* 3

TRADEMARK may be assigned with patent . . . . . 780 *n.* 1

TRANSFER of Letters-Patent 420, 752–834
allowable 752
unrestricted except by their own nature 761
governed by statute . . . . . 761 *n* 3
by any co-owner, of his share, allowed . . . . . 765 *n.* 3, 795–799
by executors of deceased patentee 765, 800–802
right to, vests in assignee of any degree . . . . . 765 *n.* 2
pendente lite, effect of 1103
rights created by, governed by the law of contracts 761
two classes of transfers 756
one class transfers both invention and monopoly 756
other class transfers invention, affecting monopoly only by estoppel . . 757
transfer of both invention and monopoly must convey entire interest in the patented invention or an undivided portion thereof for the whole United States or some specific territory therein 758
transfers covering both invention and monopoly are of two classes, one for whole United States, the other for certain territory only . . . 759

Reference are to sections.

TRANSFER — *continued.*
forms of, — assignment, grant, and license 760
transfer of right to make and sell carries the right to use and is an assignment . . . . . 763 *n.* 4
transfer by assignment or grant not prevented by outstanding licenses . 765
transfer, whether assignment or license, ascertained from subject-matter, not from terms or conditions 764
(See also ASSIGNMENT, CONTRACT, LICENSE, TITLE and titles there cited.)
TRIAL BY JURY, in equity 1124–1126
TRUSTEE IN INSOLVENCY, no right to insolvent's patents . . . 760, 803–805
de son tort, infringer not 1091
though treated as 1137
TRUSTEES must act jointly . . . . . 780 *n.* 3

UNIT, every invention a 151
UNITY OF INVENTIONS, basis of the doctrine . . . . . 92 *n.* 1
UNITED STATES, patents usually granted only by 45
patent system of, its history 48
no right to use patented invention without the inventor's consent except where taking it by eminent domain 910
must compensate the patentee like any other user 910
has a right to use inventions of its agents and officers . . . . . 1258 *n.* 1
using an invention, presumed to use under an implied contract to pay . . . 1258
contracts with inventors, express and implied . . . . . 1258 *n.* 1
may be sued in the Court of Claims for use of the patented invention . . . 1258
Court of Claims has sole jurisdiction over suits against the United States for the unauthorized use of the invention . . . . . 910 *n.* 5
cannot authorize others to use patented inventions without consent of patentee 910
cannot sue for infringement 1098
not liable in damages for the unlawful issue of a patent to a rival inventor 1258 *n.* 3
(See also COURTS, INFRINGEMENT, PATENT SYSTEM, STATES OF THE UNION.)
UNPATENTED INVENTION, property in protected by law 847
wrongs and remedies relating to 867–883
rights of inventor in, not violated by acts of rival inventors 883
wrongful appropriation of is a tort at common law, not under the Patent Law 907
property of inventor in, depends on preservation of his secret 867
inventor's secret protected though the invention is not patentable . . . 873
discovery of secret by fraud or force is a tort 868
remedies for fraudulent or forcible discovery 869
may be confidentially disclosed without forfeiture of property therein . . . 870
disclosure by confidential depositaries is a breach of trust 871
remedies for wrongful disclosure or misuse 872
abandoned to the public by voluntary unrestricted disclosure unless protected by statute 874
protected by statute during two years of disclosure next preceding the application 875
legal status of, during these two years, doubtful 876
not temporarily abandoned to the public 877
not protected by Patent Law 878
protected as still secret, by the common law and equity . . 879–882
protected by injunction after application filed . . . . . 882 *n.* 1
(See also INVENTION, MONOPOLY, PATENT, PATENTED INVENTION, SLANDER.)
UNREASONABLE DELAY, in disclaiming, defined 640
evidence of 1036
in re-issue, effect of 690
how proved 1030
unavoidable delay is not 1036
(See also DELAY, DISCLAIMER, LACHES, REDUCTION TO PRACTICE, RE-ISSUES.)

References are to sections.

UNSUCCESSFUL EXPERIMENTS, instances and proof of . . . . . 318 *n.* 3
USE, does not include making or selling 751
diversity in may be diversity of form or of substance 259
of an old invention may be a new invention . . . . . 81 *n.* 3, 259 *n.* 1, 463
distinguished from the invention used 261
in a "force applied" 263
in a "mode of application" 263
in a "specific treatment of a specific object" 263
four diversities of 264
use with new force possible *only* to a "mode of application" 265
when double use 266
with new object possible either to a "mode of application" or a "force applied" 266
is a new invention when inventive skill required to devise it . . . . . 259 *n.* 1
is double use, various applications of the rule . 266 *n.* 1
in combination is not double use 267
out of combination is not double use 268
when a new invention 269
belongs to what class 270
usually an art 270
discoverer of, has no right to thing used on that account . . . . . 259 *n.* 1
difference in, does not show absence of infringement 894
prior use 317–324
(See also DIVERSITIES, DOUBLE USE, IDENTITY, INFRINGEMENT, INVENTION, PRIOR USE.)
USELESSNESS OF INVENTION, when a defence to a note given for the patent 1230 *n.* 2, 1239
UTILITY of inventions 338–344
under English law 70
defined 339, 964
essential to patentability 70, 221, 338
absent if the invention is immoral or dangerous 340
in connection with other things sufficient 341
degree of, immaterial 341
exists if the invention can be made useful . . . . . 341 *n.* 2
exists though the invention will not serve all the purposes claimed for it . 341 *n.* 2
has been superseded by others 342
actual not comparative required 342
how ascertained 343
shown by use and sale . . . . . 343 *n.* 1
is evidence of inventive skill . . . . . 116 *n.* 1, 121 *n.* 1, 344, 1022
novelty . . . . . 116 *n.* 1, 121 *n.* 1, 344, 1026
actual and comparative as evidence of novelty, etc., distinguished . . . . . 116 *n.* 1, 344
comparative, as evidence of novelty 116
of end 121
actual, as evidence of inventive skill 113
patent valid though it overrates the utility of the invention . . . . . 486 *n.* 3
a question for the jury . . . . . 338 *n.* 1, 1075
how proved 1029
patent *prima facie* evidence of 1016, 1239
infringer estopped to deny when . . . . . 964, 984, 1029, 1189 *n.* 2
want of when a defence to action of assignor for purchase money 1239
(See also ACTION AT LAW, ASSIGNOR, INVENTION, INVENTIVE SKILL, NOVELTY.)

VALUE pecuniary, want of, no defence to a note given for a patented invention 1230, 1239

References are to sections.

VENDEE, buying with an option to pay or return must elect within a reasonable time 1251
suit against for infringement suspended till pending suit against vendor is finished . . . . . 1155 *n.* 5
VENDIBLE SUBSTANCE, not the only class of inventions 160
VENDOR, may be made party to a bill in equity against vendee . . . . 1105 *n.* 3
VERDICT, requisites of, when set aside 1076
when curable by *remittitur* 1068
for defendant when court will order, order how enforced 1073
(See also ACTION AT LAW, DAMAGES.)

WAGES, allowed in estimating profits 1139
WAIVER, not by making adverse party a witness 1127
WANT, perception of is not invention 88
satisfied by successive inventions gradually narrowing the field . . . . 88 *n.* 2
WARRANTY, express, in assignment 783
not by parol in connection with assignment . . . . . 783 *n.* 4
valueless when the thing warranted does not exist . . . . . 783 *n.* 4
implied from assignment when 774, 783
grant 794
not implied that patent is valid . . . . . 783 *n.* 4
when implied that the invention does not infringe other patents . . . . 783 *n.* 4
breach of, assignor liable for 783, 1232
assignee's remedy for 1232
(See also ASSIGNEE, ASSIGNMENT, ASSIGNOR, CONSIDERATION, GRANT.)
WASTE, loss by, allowed in estimating profits 1139
WATER TABBIES CASE . . . . . 83 *n.* 3
"WHAT WOULD INFRINGE IF LATER WOULD ANTICIPATE IF EARLIER" criticised . . . . . 318 *n.* 1
"WITHIN THE REALM" meaning of . . . . . 70 *n.* 1
includes colonies which have no separate patent system . . . . . 320 *n.* 4
WITNESSES, estoppel of . . . . . 1021 *n.* 1
competency of, who are competent 1010
credibility of 1010, 1011
recollection of as to obsolete inventions admissible 1026
courts, not Commissioner, to control . . . . . 601 *n.* 1
(See also ACTION AT LAW, ESTOPPEL, EXPERT EVIDENCE.)
WORKMEN, infringement by 920
acting voluntarily infringe . . . . . 921 *n.* 1
having no option do not infringe . . . . . 920 *n.* 4
(See also AGENCY, INFRINGEMENT, INJUNCTION.)
WRIT OF ERROR in actions at law, grounds of, effect of 1079
WRITERS ON PATENT LAW, etc., Extracts from:
American Law Reg. N. S. 7. Principle defined . . . . . 135 *n.* 1
Patentability of discoveries, laws of nature, principles and principles reduced to practice . . . . . 141 *n.* 1
11. Degree of reduction necessary . . . . . 126 *n.* 1
Bentham J. Patent a fit reward for inventor . . . . . 35 *n.* 1
Bishop on Written Law. Judicial construction of statutes . . . . . 41 *n.* 1
Coke, Inst. "Manufacture" in Stat. Jac. I. . . . . 69 *n.* 1
Improvement not patentable . . . . . 210 *n.* 2
Coryton on Patents. Nature of patent privilege . . . . . 11 *n.* 2, 3
Monopoly of patentee against other inventors . . . . . 29 *n.* 1
Patent privilege as a contract . . . . . 40 *n.* 1

References are to sections.

WRITERS ON PATENT LAW — *continued.*
Rights of inventors in undisclosed inventions . . . . . 24 *n.* 2
Duty of State to secure disclosure of inventions . . . . . 38 *n.* 1
Necessity of encouraging inventors . . . . . 36 *n.* 1
Legal status of patentee before A.D. 1800 . . . . . 14 *n.* 2, 4
Abuse of amending power . . . . . 16 *n.* 6, 7
Form of pleading at law . . . . . 986 *n.* 4
Curtis on Patents. Nature of patent privilege . . . . . 11 *n.* 1
Rights of inventors in their undisclosed inventions . . . . . 24 *n.* 1
Power of patentee to suppress all equivalent inventions . . . . . 30 *n.* 2
Policy of protecting inventors . . . . . 33 *n.* 1
Right of inventor to a reward . . . . . 34 *n.* 1
Construction of patent privilege as a contract . . . . . 40 *n.* 2, 3
Contract of patentee to disclose the invention . . . . . 42 *n.* 8
Defective disclosure . . . . . 42 *n.* 9
Novelty and utility as proof of a sufficiency of inventive skill . . . 70 *n.* 4
Utility as evidence of inventive skill . . . . . 344 *n.* 1
Foote, Elisha. Effect of encouraging inventors . . . . . 36 *n.* 2
Godson on Patents. Nature of patent privilege . . . . . 11 *n.* 3
Simultaneous Inventions . . . . . 29 *n.* 3
Patentability of an art . . . . . 100 *n.* 1
Form of pleading at law . . . . . 986 *n.* 3
Law's Digest. Original inventor as against all the world . . . . . 58 *n.* 4
Changes in Act of 1836 as to prior knowledge and use . . . . . 58 *n.* 5
Lund on Patents. Right of patentee to monopolize a discovery . . . . 28 *n.* 2
Relation of improver to original inventor . . . . . 30 *n.* 1
Effect of secret prior use . . . . . 17 *n.* 2
Abuse of amending power . . . . . 16 *n.* 7
Magna Carta. Illegal Monopolies . . . . . 9 *n.* 6
Norman on Patents. Natural rights of inventors to their inventions . . 24 *n.* 2
Early legal construction of letters-patent . . . . . 14 *n.* 3
Parsons on Contracts. Common law as applied to patents . . . . . 41 *n.* 2
Phillips on Patents. Nature of patent privilege . . . . . 11 *n.* 3
Rights restricted by patent privilege . . . . . 32 *n.* 2
Right of inventor to a reward . . . . . 34 *n.* 1
Patent privilege as a contract . . . . . 40 *n.* 1
Differences in England and America as to priority of knowledge . . 22 *n.* 2
Simonds on Patents. Grant of English patents without examination . . 49 *n.* 1
Smith, Chauncey. Necessity of encouraging inventors . . . . . 36 *n.* 1
Effect of patent privilege as encouraging inventors . . . . . 37 *n.* 1
Storrow, J. J. Policy of protecting inventors . . . . . 33 *n.* 1
Thacher, J. M. Policy of protecting inventors . . . . . 33 *n.* 1
Webster, Patent Cases. Essential distinction between means and end . . 117 *n.* 1
Relation of novelty to inventive skill . . . . . 112 *n.* 1
Utility as evidence of inventive skill . . . . . 344 *n.* 1
Necessity of utility . . . . . 338 *n.* 1
Suggestions of employees . . . . . 131 *n.* 1
Double Use . . . . . 266 *n.* 1
Prior use must be practical use . . . . . 319 *n.* 1
Prior use not secret use . . . . . 320 *n.* 1
Lost arts . . . . . 322 *n.* 2
Requisites of prior publication . . . . . 325 *n.* 1
Prior publication must describe a complete practical invention . . . 329 *n.* 3
Presumption that inventor knows all prior published descriptions of the invention . . . . . 112 *n.* 1
Prior patent . . . . . 331 *n.* 1
Abandonment to the public . . . . . 71 *n.* 3
WRONGS AND REMEDIES, general division of 852

Ex. J.C.D. 7/16/07