SYNOPSIS OF LECTURES ON THE PATENT LAWS OF THE UNITED STATES

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LECTURERS.

LECTURE I.

PATENTABILITY.

1. Primary Division of the Subject.

(*a*) The subjects of patents; (*b*) Invention; (*c*) Novelty; (*d*) Utility.

2. The Subjects of Patents.

(*a*) Arts; (*b*) Machines; (*c*) Manufactures; (*d*) Compositions of Matter; Revised Statutes, Section 4886; (*e*) Designs.

3. Patentable Arts are Processes.

(*a*) Processes which include some non-mechanical transaction.—*Tilghman* v. *Proctor* (102 U. S., 728); *Eames* v. *Andrews* (122 U. S., 40); *Fermentation Co.* v. *Maus* (122 U. S., 427); *Telephone Cases* (126 U. S., 533); (*b*) Machine processes.—*Corning* v. *Burden* (15 Howard, 267); *Busch* v. *Jones* (184 U. S., 607); *Carnegie Steel Co.* v. *Cambria Iron Co.* (185 U. S., 425); (*c*) Manipulative processes.—*Expanded Metal Co.* v. *Bradford* (214 U. S., 366, 1909).

4. Machines.

(*a*) Definition of the word "Machine." *Walker on Patents*, Section 16; (*b*) Improvements in Machines.

5. Manufactures.

(*a*) Patent law meaning of the noun "manufacture," *Johnson* v. *Johnston*, 60 F. R., 620.

6. Compositions of Matter.

(*a*) Meaning of the phrase "composition of matter." *Walker on Patents*, Sec. 18.

7. Designs.

Ornamental designs for articles.—32 *Statutes at Large* (p. 193, Chap. 783): *Weisgerber* v. *Cleaney* (131 F. R., 480). *Scofield* v. *Browne* (158 F. R., 306).

8. Invention.

(*a*) There is no affirmative criterion of invention,—*American Graphophone Co.* v. *Universal Talking Mach. Mfg. Co.* (151 F. R., 509); (*b*) Invention present where no negative rule shows it to be absent (*McClain* v. *Ortmayer* (141 U. S., 472).

9. Mere Skill is not Invention. *Atlantic Works* v. *Brady* (107 U. S., 199); *Perkins Electric Switch Co.* v. *Gibbs Electric Mfg. Co.* (87 F. R., 923); *Badische Anilin & Soda Fabrik* v. *Kalle* (94 F. R., 173).

(*a*) Circumstances distinguishing invention from skill,—*The Barbed Wire Patent* (143 U. S., 283). *Mast Foos Case* (177 U. S., 494, 1900).

10. Excellence of Workmanship is not Invention.

(*a*) Distinction between this rule and the previous one.

11. Substitution of Materials is not Invention. *Hotchkiss* v. *Greenwood* (11 Howard, 248); *Drake Castle Pressed Steel Lug Co.* v. *Brownell & Co.* (123 F. R., 87).

(*a*) Exception where substitution involves a new mode of operation,—*Wickelman* v. *A. B. Dick Co.* (88 F. R., 264); (*b*) Exception where substitution resulted in the first success in the art,—*Edison Electric Co.* v. *U. S. Electric Lighting Co.* (52 F. R., 308); (*c*) Exception where substitution changes both purpose and material,—*Potts* v. *Creager* (155 U. S., 597).

12. Change of Size or Degree or Quality is not Invention.

(*a*) In the case of a machine,—*Phillips* v. *Page* (24 Howard, 164); *Planing Machine Co.* v. *Keith* (101 U. S., 490); (*b*) In the case of a manufacture,—*Glue Co.* v. *Upton* (97 U. S., 6).

Exception where the change involves a new mode of operation,—Edison Electric Light case (52 F. R., 300).

13. Aggregation is not Invention. *Hailes* v. *Van Wormer* (20 Wallace, 353); *Overweight Co.* v. *Mach. Co.* (102 F. R., 961); *In re Mond* (16 App. D. C., 354).

(*a*) Want of simultaneousness of action does not necessarily imply aggregation, or negative combination.—*Holmes Alarm Tel. Co.* v. *Domestic Tel. Co.* (42 F. R., 226).

14. Duplication is not Invention. *Dunbar* v. *Meyers* (94 U. S., 197).

(*a*) Exception where duplication produces a new unitary result,—*Goss Printing Press Co.* v. *Scott* (108 F. R., 260)

15. Omission is not Invention. *Richards* v. *Elevator Co.* (159 U. S., 486); *Stow* v. *Chicago* (3 Banning & Arden, 92).

(*a*) Exception where omission changes and improves the mode of operation,—*Enterprise Co.* v. *Sargent* (28 F. R., 187); *Pacific Contracting Co.* v. *Bingham* (62 F. R., 283).

16. Substitution of Equivalents is not Invention. *Smith* v. *Nichols* (21 Wallace, 119); *Tiemann* v. *Kraatz* (85 F. R., 440).

17. New Combination, without New Mode of Operation, is not Invention. *Burt* v. *Ivory*, (133 U. S., 349); *Florsheim* v. *Schilling* (137 U. S., 77). *Rapp* v. *Central Fire-Proof Door & Sash Co.* (158 F. R., 448).

18. Using an Old Process or Thing for a New Purpose is not Invention. *St. Germain* v. *Brunswick* (135 U. S., 230); *Lovell Mfg. Co.* v. *Cary* (147 U. S., 637).

(*a*) Exception where new use is not nearly analogous to the old use.—*Potts* v. *Creager* (155 U. S., 597); *National Brake Beam Co.* v. *Interchangeable Brake Beam Co.* (106 F. R., 702).

19. Doubts Relevant to Presence of Invention, Solved by Presence of Superior Utility. *Smith* v. *Dental Vulcanite Co.* (93 U. S., 495); but not by superior sales. *McClain* v. *Ortmayer* (141 U. S., 427).

20. Novelty distinguished from newness.

21. Novelty not Negatived.

(*a*) By knowledge or use in a foreign country.—Revised Statutes, Sections 4886 and 4923; (*b*) By abandoned application for United States Patent, *Corn Planter Case* (23 Wallace, 211); (*c*) By unpublished drawing, or prior model,—*Elithorp* v. *Robertson* (4 Blatch., 309); *Cahoon* v. *Ring* (1 Cliff., 593); (*d*) By anything apparently similar but practically useless,—*Morey* v. *Lockwood* (8 Wallace, 230); *Ideal Stopper Co.* v. *Crown Cork & Seal Co.* (131 F. R., 244); (*e*) By antiquity of parts,—*Louden Mach. Co.* v. *Jamesville Hay Tool Co.* (141 F. R., 978); (*f*) By prior accidental, but not understood, production,—*Beckwith* v. *Malleable Iron Range Co.* (174 F. R., 1010); (*g*) By anything which was neither designed, nor apparently adapted, nor actually used, to perform the function of the thing covered by the patent,—*Topliff* v. *Topliff* (145 U. S., 161).

22. Novelty is Negatived.

(*a*) By prior knowledge and use by even a single person,—*Coffin* v. *Ogden* (18 Wallace, 120); (*b*) By prior known existence without using, of the thing patented,—*Corn Planter Case* (23 Wallace, 220); But not by prior existence without knowledge. *Acme Clasp Co.* v. *Cary Mfg. Co.* (96 F. R., 344).

23. Negation of Novelty is not Averted.

(*a*) By the fact that the inventor had no knowledge of the anticipating matter,—*Derby* v. *Thompson* (146 U. S., 481); (*b*) By the fact that the anticipating substance was derived from a different source from that which produced the patented substance,—*Cochrane* v. *Badische Anilin & Soda Fabrik* (111 U. S., 311).

24. Utility.

(*a*) Resides in instrumentality; *Burrall* v. *Jewett* (2 Paige, 143); (*b*) Resides in beauty,—*Magic Ruffle Co.* v. *Douglas* (2 Fisher, 330); (*c*) Negatived by lack of function,—*Coupe* v. *Royer* (155 U. S., 574); (*d*) Negatived where function is necessarily evil,—*Fuller* v. *Berger* (120 F. R., 275).

LECTURE II.

PATENTS.

1. Primary Division of the Subject.

(*a*) Letters patent; (*b*) Disclaimers; (*c*) Reissues.

2. The Right Secured by Letters Patent.

(*a*) Not under common law,—*Brown* v. *Duchesne* (19 Howard, 195); (*b*) Wholly under United States Constitution,—Article 1, Section 8; (*c*) Is a property right,—*Seymour* v. *Osborne* (11 Wallace, 533); *United States* v. *Am. Bell Telephone Co.* (167 U. S., 238); (*d*) Relations of, to the Sherman Law; *Bement* v. *National Harrow Co.* (186 U. S., 88); *Blount Mfg Co.* v. *Yale & Towne Mfg. Co.* (166 F. R., 555); (e) is exclusive of the government, as it is of citizens,—*Belknap* v. *Schild* (161 U. S., 16); (*f*) Taxation of Patents,—*People* v. *Assessors* (156 N. Y., 421).

3. The Territorial Scope of United States Patents.

(*a*) The forty-eight United States,—Revised Statutes, Section 4884; (*b*) The tide waters of the United States,—*Colgate* v. *Ocean Telegraph Co.* (17 Blatch., 310); (*c*) The decks of United States Ships,—*Gardiner* v. *Howe* (2 Cliff., 464).

4. The Duration of Patents.

(*a*) The regular duration,—Revised Statutes, Sections 4884 and 4931; (*b*) The duration of patents on inventions first patented abroad, in pursuance of applications filed prior to 1898,—Revised Statutes, Section 4887.

5. Patentees.

(*a*) Inventors,—Revised Statutes, Section 4886; (*b*) Assignees, Revised Statutes, Section 4895; (*c*) Legal Representatives,—Revised Statutes, Section 4896.

6. Letters Patent as Documents.

(*a*) The grant; (*b*) The description,—Revised Statutes, Section 4888; (*c*) The claim or claims,—Revised Statutes, Section 4888; (*d*) The drawings.

7. The Construction of Patents.

(*a*) In light of descriptions,—Telephone cases (126 U. S., 537); (*b*) In the light of the state of the art,—*Railway Co. v. Sayles* (97 U. S., 554); *Continental Paper Bag Co. v. Eastern Paper Bag Co.* (210 U. S., 405).

8. Only One Patent for One Invention. *Miller v. Eagle Co.* (151 U. S., 197); *National Mach. Co. v. Wheeler & Wilson Mfg. Co.* (72 F. R., 199); *Dayton Fan & Motor Co. v. Westinghouse Elec. & Mfg. Co.* (118 F. R., 563); *Dodge Coal Storage Co. v. N. Y. C. & H. R. R. Co.* (139 F. R., 981).

9. Disclaimers.

(*a*) Statutory Provisions relevant to disclaimers,—Revised Statutes, Sections 4917 and 4922.

10. Errors which Justify Disclaimers.

(*a*) Inadvertence; (*b*) accident; (*c*) mistakes of fact; (*d*) mistake of law,—*O'Reilly v. Morse* (15 Howard, 120).

11. Fraudulent or Deceptive Intention, Fatal to Right to Disclaim. Revised Statutes, Section 4917.

12. Unreasonable Delay to Disclaim Fatal to Efficacy of Disclaimer. *Seymour v. McCormick* (19 Howard, 106).

13. Construction of Letters Patent after Disclaimer. *Dunbar v. Myers* (94 U. S., 187).

14. Reissues.

(*a*) The origin of reissues.—*Grant v. Raymond* (6 Peters, 243); (*b*) The reissue statute.—Revised Statutes, Section 4916.

15. Faults which Justify Reissues.

(*a*) Invalidity arising from defective description; (*b*) Invalidity arising from insufficient description; (*c*) invalidity arising from defective claims; (*d*) Invalidity arising from claiming too much (*e*) Inoperativeness arising from insufficient claims.—Walker on Patents, Sec. 218.

16. Inadvertence, Accident, or Mistake.

(*a*) Are the sources of reissuable faults.—Walker on Patents, Sec. 220; (*b*) Question of force of decision of Commissioner of Patents on existence of.—Walker on Patents, Sec. 221.

17. Broadened Reissues. *Miller v. Brass Co.* (104 U. S., 350). *Milloy Electric Co. v. Thompson-Houston Electric Co.* (148 F. R., 846). *Thompson-Houston Electric Co. v. Western Electric Co.* (158 F. R., 817).

(*a*) Definition of broadened reissues.—Walker on Patents, Sec. 226; (*b*) Delay to apply for broadened reissue.—*Topliff v. Topliff* (145 U. S., 171).

18. The Same Invention. Revised Statutes, Section 4916.

(*a*) Definition of the phrase "the same invention."—*Parker & Whipple Co. v. Yale Clock Co.* (123 U. S., 99); *Weston Electric Co. v. Stevens* (134 F. R., 580).

19. Reissues Partly Void and Partly Valid. *Gage v. Herring* (107 U. S., 640). *Rawson & Morrison Mfg. Co. v. C. W. Hunt Co.*, 147 F. R., 240.

LECTURE III.

TITLE, LICENSES, AND INFRINGEMENT.

1. Title.

(*a*) By occupancy; (*b*) By assignment; (*c*) By grant; (*d*) By creditor's bill; (*e*) By bankruptcy; (*f*) By death.

2. Title by Occupancy.

(*a*) Inchoate,—*Hendrie* v. *Sayles* (98 U. S., 541); (*b*) Complete,—*Harrison* v. *Morton* (83 Md., 477).

3. By Assignment.

(*a*) An assignment defined,—*Gayler* v. *Wilder* (10 Howard, 477); (*b*) Subject to reasonable State regulation,—*Allen* v. *Riley* (203 U. S., 355); (*c*) Held upon special tenure,—*Littlefield* v. *Perry* (21 Wallace, 220); (*d*) Incomplete estates created by,—*Solomons* v. *United States* (21 Court of Claims, 481).

4. Warranty of Title.—*Bush Electric Co.* v. *Electric Light Co.* (52 F. R., 963).

5. No Implied Warranty of Validity. *Hiatt* v. *Twomey* (1 Devereaux & Battle's Equity Cases, N. C., 315).

6. By Grant.

(*a*) A grant defined.—*Gayler* v. *Wilder* (10 Howard, 494); (*b*) Extra-territorial rights.—*Keeler* v. *Folding Bed Co.* (157 U. S., 659); *Jackson* v. *Vaughan* (73 F. R. 837).

7. Recording in the Patent Office.—Revised Statutes, Section 4898.

8. By Creditor's Bill.—*Alger* v. *Murray* (105 U. S., 126); *Newton* v. *Buck* (77 F. R., 615).

9. By Bankruptcy, or Insolvency.

Bankruptcy Statute of July 1, 1898, Section 70.—*Ball* v. *Coker* (168 F. R., 309).

10. By Death.—Revised Statutes, Section 4896, as amended March 3, 1903, 32 Statutes at Large, p. 1225.

11. Licenses.—*Waterman* v. *Mackenzie* (138 U. S., 255). *Hartman* v. *John D. Park & Sons Co.* (145 F. R., 304); Express or implied and written or oral; Oral licenses are subject to Statutes of Frauds.—*Buhl* v. *Stephens* (84 Fed. Rep., 922).

12. Express Licenses, with Implied Incidents.

(*a*) To make, with implied leave to use; (*b*) To make with implied leave to sell; (*c*) To use, with implied leave to make; (*d*) To make, with implied leave to use and to sell.

13. Purely Implied Licenses.

(*a*) Licenses implied from conduct.—*United States* v. *Palmer* (128 U. S., 269), *Solomons* v. *United States* (137 U. S., 346);

(*b*) Licenses worked by estoppel.—*Curren* v. *Birdsall* (20 F. R., 835).

14. Subsequent Purchaser Without Notice.

A license good against everybody, without notice or record. —*Chambers* v. *Smith* (5 Fisher, 14); *Farrington* v. *Gregory* (4 Fisher, 221); *Continental Windmill Co.* v. *Empire Windmill Co.* (8 Blatch., 295).

15. Warranty of Validity.

(*a*) No implied warranty of validity.—*Birdsall* v. *Perrego* (5 Blatch., 251); *United States* v. *Harvey Steel Co.* (196 U. S., 310); (*b*) But implied warranty against eviction.— *White* v. *Lee* (14 F. R., 701).

16. Infringement.

(*a*) Of a patent for a process; (*b*) A machine or a manufacture; (*c*) A composition of matter; (*d*) A design.

17. Infringement of Process Patents.

(*a*) Illustrated by the Fat Acid Case,—*Tilghman* v. *Proctor* (102 U. S., 730).

18. Infringement of Machines and Manufactures.

(*a*) The general rule,—Walker on Patents, Sec. 339; (*b*) Comparative results,—*Westinghouse* v. *Boyden Power Brake Co.* (170 U. S., 562); (*c*) Comparative mode of operation,—*Field* v. *DeCamcau* (116 U. S., 187); (*d*) Comparative structure.

19. Comparative Structure.

(*a*) Addition,—*American Laundry Mach. Co.* v. *Adams Laundry Mach. Co.* (161 F. R., 503); (*b*) Omission,—*Prouty* v. *Ruggles* (16 Peters, 341); *Cimiotti Unhairing Co.* v. *Am. Fur. Ref. Co.* (198 U. S., 410); (*c*) Interchange of position of parts,—*Sanders* v. *Hancock* (128 F. R., 425); (*d*) Substitution of equivalents,—*Iron Clad Mfg. Co.* v. *Dairyman's Mfg. Co.* (138 F. R., 134).

20. Equivalents.

(*a*) Primary inventions and secondary inventions,—*Railroad Co.* v. *Sayles* (97 U. S., 556) *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.* (210 U. S., 405); *Marconi Wireless Tel. Co.* v. *De Forest Wireless Tel. Co.* (138 F. R., 678).

21. Infringement of Compositions of Matter.

(*a*) Addition,—*Byram* v. *Eddy* (2 Blatch., 521); (*b*) Omission,—*Otley* v. *Watkins* (36 F. R., 324); (*c*) Change of proportion,—*Atlantic Dynamite Co.* v. *Climax Powder Co.* (72 F. R., 925); (*d*) Substitution of equivalents—*Tyler* v. *Boston* (7 Wallace, 330).

22. Infringement of Design Patents.

(*a*) Decided on the basis of the opinions of ordinary observers,—*Gorham* v. *White* (14 Wallace, 528); *H. F. Earl Mfg. Co.* v. *Clark & Parsons Co.* 154 F. R., 853).

23. Ignorance of Patent.

(*a*) Does not negative infringement,—*Parker* v. *Haworth* (4 McLean, 337); *Norton* v. *Can Co.* (57 F. R., 933).

LECTURE IV.

COURTS AND PARTIES, AND ACTIONS AT LAW.

1. Courts.

(*a*) District Courts of the United States, 36 Statutes at Large, pp. 1091-2 and 1100, Chapter 231, Sections 24 and 48; (*b*) Supreme Court of the District of Columbia.—Revised Statutes relating to the District of Columbia, Sections 760 and 764; (*c*) State Courts,—*Broan* v. *Shannon* (20 Howard, 56); *Wilson* v. *Sandford* (10 Howard, 101); (*d*) The Court of Claims, 36 Statutes at Large, Chapter 423.—*United States* v. *Palmer* (128 U. S., 269); *Belknap* v. *Schild* (161 U. S., 10).

2. Plaintiffs at Law.

(*a*) Patentees; (*b*) Assignees; (*c*) Grantees; (*d*) Legal Representatives; (*e*) Owners in Common; (*f*) Licensees.

3. Defendants at Law.

(*a*) Natural persons; (*b*) Partnerships; (*c*) Private corporations; (*d*) Public corporations.

4. Complainants in Equity.

(*a*) Must generally own interest in patent at time of action, —*Waterman* v. *Mackenzie* (138 U. S., 255); (*b*) May generally recover for infringement prior to assignment,—*Dibble* v. *Augur* (7 Blatch., 86).

5. Defendants in Equity.

(*a*) Not liable for profits realized by each other,—*Elizabeth* v. *Pavement Co.* (97 U. S., 140).

6. Actions at Law.

(*a*) Trespass on the case,—Revised Statutes, Section 4919; (*b*) Civil Code action,—*May* v. *Mercer County* (30 F. R., 250); *Myers* v. *Cunningham* (44 F. R., 349).

7. Pleas in Bar.

(*a*) Their number is twenty-seven; Walker on Patents, Section 440; (*b*) The first fourteen and the eighteenth deny validity to the original patent; (*c*) The fifteenth, sixteenth, and seventeenth are only applicable to reissues; (*d*) The last nine are miscellaneous.

The twenty-seven defenses are based on a comprehensive view of many parts of the patent law, and are to be thoroughly considered by the students, in the light of the text book.

8. Special Pleading.

(*a*) According to the ancient common law; (*b*) According to the modern practice; Walker on Patents, Sec. 442.

9. The General Issue.

(*a*) Accompanied by notice of special matter,—Revised Statutes, Section 4920; (*b*) Where defense is based upon a fact within judicial notice,—*May* v. *Juneau County* (137 U. S., 408).

10. Trials of Actions at Law.

(*a*) By jury,—*International Tooth Crown Co.* v. *Hanks Dental Association* (111 F. R., 917); (*b*) By a judge, —*Revised Statutes*, Section 649; (*c*) By a referee.—*Heckers* v. *Fowler* (2 Wallace, 123).

11. Evidence to Support the Declaration.

(*a*) The letters patent; (*b*) The title; (*c*) The infringement; (*d*) The damages.

12. Evidence to Support the Defenses.

(*a*) Judicial notice.—*Specialty Mfg. Co.* v. *Fenton Mfg. Co.* (174 U. S., 497); (*b*) Prior patents,—Revised Statutes, Section 892; (*c*) Prior printed publications,—*Britton* v. *White Mfg. Co.* (61 F. R., 95); (*d*) Parol testimony,—*Barbed Wire Patent* (143 U. S., 284).

13. Instructions to Juries.

(*a*) On questions of law.—*Haines* v. *McLaughlin* (135 U. S., 598); (*b*) On questions of fact.—*Lincoln* v. *Power* (151 U. S., 442); *Coupe* v. *Royer* (155 U. S., 579).

14. Costs.

(*a*) The items recoverable,—Revised Statutes, Sections 823 and 983; *Tesla Electric Co.* v. *Scott* (101 F. R., 524); (*b*) Exceptions to recoverability of costs,—Revised Statutes, Sections 973, 4917, and 4922.

15. New Trials.

(*a*) For error of judge; (*b*) For error of jury; (*c*) For newly discovered facts,—*Washburn* v. *Gould* (3 Story, 122).

16. Writs of Error.

(*a*) Take actions at law for infringement of patents to Circuit Courts of Appeals,—36 Statutes at Large, pp. 1133-4; Chap. 231, Section 128. (*b*) Such actions go from Circuit Courts of Appeals to Supreme Court only on certificate or certiorari,—36 Statutes at Large, p. 1150, Chapter 231, Section 251.

17. Bills of Exception.

What to contain. *Philadelphia & Trenton Railroad Co.* v. *Stimpson* (14 Peters, 448); *Blanchard* v. *Putnam* (8 Wallace, 420); *Railroad Co.* v. *Smith*, (21 Wallace, 255); *Lovell* v. *Davis* (101 U. S., 542); *Jones* v. *Buckell* (104 U. S., 554).

LECTURE V.

ACTIONS IN EQUITY.

1. Courts having jurisdiction in Equity in Patent Litigation; same as in actions at law.

2. The Functions of Equity Patent Cases.

(*a*) Injunctions,—*Allington & Curtis Mfg. Co.* v. *Booth* (78 F. R., 879); (*b*) Recovery of defendant's profits,—*Root* v. *Railway Co.* (105 U. S., 189); (*c*) Recovery of Complainant's damages,—Revised Statutes, Section 4921; *Emigh* v. *Railway Co.* (6 F. R., 283); *Westinghouse* v. *N. Y. Air Brake Co.* (131 F. R., 607).

3. The Original Bill.

(*a*) The title of the Court; (*b*) The introduction; (*c*) The stating part; (*d*) The prayer for relief; (*e*) The interrogating part; (*f*) The prayer for process; (*g*) The oath.

4. Defenses to an Original Bill.

(*a*) By demurrer; (*b*) By plea; (*c*) By answer.

5. The Twenty-nine Defenses.

(*a*) The twenty-seven defenses, (*b*) Non-jurisdiction of equity,—*Root* v. *Railway Co.* (105 U. S., 189); *Clark* v. *Wooster* (119 U. S., 324); *Dowell* v. *Mitchell* (105 U. S., 430); *Waterman* v. *Mackenzie* (138 U. S., 257); *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.* (210 U. S., 405); (*c*) Laches,—*Galliher* v. *Cadwell* (145 U. S., 372); *Johnston* v. *Mining Co.* (148 U. S., 370); *Lane & Bodley Co.* v. *Locke* (150 U. S., 200); *Halstead* v. *Grinnan* (152 U. S., 416).

6. The Hearing of an Action in Equity.

(*a*) Before a judge; (*b*) Before a judge and a jury,—18 Statutes at Large, Part 3, p. 316, Chap. 77, Sec. 2; (*c*) Before a master in chancery,—*Western Union Telegraph Co.* v. *American Bell Telephone Co.* (125 F. R., 686); *Hancock* v. *Boyd & Getty* (170 F. R., 601).

7. The Hearing by a Judge.

(*a*) The preliminary hearing; (*b*) The interlocutory hearing; (*c*) The final hearing.

8. The Sources of the Rules of Decision.

(*a*) The statutes of United States; (*b*) The decisions of the United States Supreme Court; (*c*) The decisions of the United States Circuit Courts of Appeals; (*d*) The decisions of the United States District Courts, and the former United States Circuit Courts; (*e*) The ancient decisions of the chancellors of England; (*f*) The modern English decisions; (*g*) The decisions of State Courts; (*h*) The *obiter dicta* of judges; (*i*) The commentaries of text writers.

9. Questions of Facts.

(*a*) Undecided questions; (*b*) Questions previously decided by the Supreme Court of the United States; (*c*) Questions previously decided by a United States Circuit Court of Appeals; (*d*) Questions previously decided by another District Court of the United States, or a former Circuit Court.

10. Evidence.

(*a*) Generally same as in actions at law; except on questions of laches, and questions of actual or threatened infringement, and questions of money recovery, and occasionally a few other items. Walker on Patents, Sec. 636.

11. Testimony.

(*a*) Taken by depositions in writing; (*b*) Taken orally in open court.

12. Depositions.

(*a*) Taken by commission; (*b*) Taken under equity rule 67; (*c*) Taken under Sections 863, 864, and 865 of the Revised Statutes; (*d*) Taken according to State laws (27 Statutes at Large, Ch. 14, p. 7); (*e*) Taken under stipulations; (*f*) Taken in other cases. Walker on Patents, Sec. 640.

13. Documentary Evidence.

(*a*) Which requires to be proved by oral testimony; (*b*) Which proves itself.

14. Decrees.

(*a*) Interlocutory decrees; (*b*) Final decrees.

15. Petitions for Re-Hearing.

(*a*) For matter apparent on the face of the record; (*b*) For newly discovered evidence.

16. Appeals to a Circuit Court of Appeals.

(*a*) When allowed; (*b*) How heard.

17. Certificate to, or Certiorari from, the Supreme Court.

18. Injunctions.

(*a*) Preliminary; (*b*) Permanent.

19. Grounds for Preliminary Injunctions.

(*a*) Special presumption of validity.—*Dickerson* v. *Machine Co.* (35 F. R., 113); *Standard Elevator Co.* v. *Crane Elevator Co.* (56 F. R., 719); (*b*) Proof of Title.—*Mowry* v. *Railway Co.* (5 Fisher, 587); (*c*) Proof of Infringement, or danger of infringement.—*Brush Electric Co.* v. *Storage Battery Co.* (64 F. R., 776); *Tindel Morris Co.* v. *Chester Forging Co.* (163 F. R., 305).

20. Defenses to Motions for Preliminary Injunctions.

(*a*) By way of traverse; (*b*) By way of confession and avoidance.

21. Permanent Injunctions.

(*a*) When granted.—*Potter* v. *Mack* (3 Fisher, 430); *Rumford Chemical Works* v. *Hecker* (2 Banning & Arden, 388); *Consolidated Roller Mill Co.* v. *Coombs* (39 F. R., 805); (*b*) When refused.—*Bignal* v. *Harvey* (18 Blatch., 356); *Westinghouse* v. *Carpenter* (43 F. R., 894); *Draper* v. *Hudson* (1 Holmes, 208); *Mumma* v. *Potomac Co.* (8 Peters, 286).

LECTURE VI.

MONEY RECOVERIES.

1. Classes of Recoveries.

(*a*) Plaintiff's damages; (*b*) Defendant's profits

2. Plaintiff's Damages.

(*a*) Their generic measure is plaintiff's loss.—*Coupe* v. *Royer* (155 U. S., 565); (*b*) Plaintiff's established royalty; (*c*) Hurtful competition; (*d*) Nominal damages only.

3. Royalties.

(*a*) How established,—*Rude* v. *Westcott* (130 U. S., 152); *Corneley* v. *Marckwald* (131 U. S., 159); (*b*) How not established,—*Judson* v. *Bradford* (3 Banning & Arden, 549): *Westcott* v. *Rude* (19 F. R., 833): *Ewart Mfg. Co* v. *Baldwin Cycle Chain Co.* (91 F. R., 264); *Emigh* v. *Railroad Co.* (6 F. R., 284); *La Baw* v. *Hawkins* (2 Banning & Arden, 564); *Colgate* v. *Mfg. Co.* (28 F. R., 147); (*c*) How applied,—*Birdsall* v. *Coolidge* (93 U. S., 70): *Asmus* v. *Freeman* (34 F. R., 903).

4. Hurtful Competition. *McSherry Mfg. Co.* v. *Dowagiac Mfg. Co.* (160 F. R., 951).

(*a*) Lost sales,—*Corneley* v. *Marckwald* (131 U. S., 159): *Rose* v. *Hirsch* (94 F. R., 178); *Regina Music Box Co.* v. *Otto,* (114 F. R., 505): (*b*) Reduction of prices,—*Boesch* v. *Graff* (133 U. S., 705): *Holmes* v. *Truman* (67 F. R., 545).

5. Nominal Damages Only.—*City of Seattle* v. *McNamara* (81 F. R., 863): *City of Boston* v. *Allen* (91 F. R., 252): *Brown* v. *Lanyon* (148 F. R., 838).

6. Exemplary Damages.

(*a*) May be imposed by the judge, but not by the jury,—Revised Statutes, Section 4919; *Wilbur* v. *Beecher* (2 Blatch., 143); (*b*) Under what circumstances imposed,—*Russel* v. *Place* (9 Blatch., 175); *Peck* v. *Frame*, (9 Blatch., 194).

7. Increased Damages.

(*a*) May be imposed by the judge, but not by the jury,—Revised Statutes, Section 4919; (*b*) When justified,—*Brennan & Co.* v. *Dowagiac Mfg. Co.* (102 F. R., 473); (*c*) And not changed on writ of error, except in clear case,—*Toplitt* v. *Toplitt* (145 U. S., 174).

8. Defendant's Profits.

(*a*) When Recoverable,—*Root* v. *Railway Co.* (105 U. S., 214); (*b*) On what theory recoverable,—*Tilghman* v. *Proctor* (125 U. S., 148); (*c*) What are recoverable as defendant's profits,—*Rubber Co.* v. *Goodyear* (9 Wallace, 800); *Livingston* v. *Woodworth* (15 Howard, 546); *Dean* v. *Mason* (20 Howard, 204); *Elizabeth* v. *Pavement Co.* (97 U. S., 138); *Piper* v. *Brown* (1 Holmes, 198).

9. Rule for Ascertaining Defendant's Profits.

(*a*) The generic rule,—*Root* v. *Railway Co.* (105 U. S., 214); *Tilghman* v. *Proctor* (125 U. S., 148); *Bredin* v. *Solmson* (145 F. R., 945); (*b*) The rule where infringement consisted in making and selling; (*c*) The rule where infringement consisted in selling; (*d*) The rule where infringement consisted in using, or making and using.

10. Defendant's Profits from Infringement by Making and Selling.

(*a*) The items of cost,—*Rubber Co.* v. *Goodyear* (9 Wallace 803); *National Folding Box & Paper Co.* v. *Dayton Paper Novelty Co.* (95 Fed. Rep., 994); *Mfg. Co.* v. *Cowing* (105 U. S., 257); *Seabury* v. *Am. Ende* (152 U. S., 564); *Piaget Novelty Co.* v. *Headley* (123 Fed. Rep., 897); (*b*) The selling price.

11. The Items of Cost.

(*a*) The market value of materials; (*b*) Money paid for making the infringing articles; (*c*) Proper remuneration for the labor of the infringer; (*d*) Interest on borrowed money, (*e*) Expenses of selling, including advertising; (*f*) Miscellaneous expenses. Walker on Patents, Sec. 718.

12. The Selling Price.

(*a*) Where the patent covers the thing made and sold; (*b*) Where the patent covers only a part or parts of the thing made and sold,—*Garretson* v. *Clark* (111 U. S., 120); *Mason* v. *Graham* (23 Wallace, 276).

13. Defendant's Profits from Infringement by Selling Only.

(*a*) The purchase price and the cost of selling; (*b*) The selling price. Walker on Patents, Sec. 724.

14. Defendant's Profits from Infringement by Using or Making and Using.

(*a*) The generic rule,—*Fullerton Walnut Growers' Association* v. *Anderson-Barngrover Mfg. Co.* (166 F. R., 453); (*b*) In cases of affirmative gain; (*c*) In cases of saving from loss,—*Cawood Patent* (94 U. S., 709); *Mees* v. *Conover* (125 U. S., 144); (*d*) In cases of affirmative gain and saving from loss,—*Tilghman* v. *Proctor* (125 U. S., 142).

15. The Standard of Comparison.

(*a*) What is the true standard of comparison; (*b*) Must have been known at the time of the complainant's invention,—*Lawther* v. *Hamilton* (64 F. R., 224); (*c*) Needs not to have been used by the defendant,—*Locomotive Safety Truck Co.* v. *Railroad Co.* (2 F. R., 679); (*d*) nor be unpatented,—*McCreary* v. *Pennsylvania Canal Co.* (141 U. S., 464).