Argument for the appellant.

WILLIAM ATKINSON, APPELLANT,

vs.

WILLIAM BOARDMAN, APPELLEE. INTERFERENCE.

ORIGINALITY OF INVENTION—FIRST MACHINE—PRESUMPTIONS.—In the absence of all evidence to the contrary, the presumption is that the person who constructed the first machine is the real inventor; and where another person claims to be the author of such machine, the burden of proof rests on him to show, not merely that he suggested the abstract idea of the machine, but that he invented the improvements which entitle it to a patent.

SAME—DISTINCTION BETWEEN SUGGESTION AND DISCLOSURE OF INVENTION.—One person may have suggested to another the idea of some new machine, and yet that other person may be the inventor of that peculiar combination of mechanical principles which is the real invention.

EVIDENCE—DECLARATIONS OF PARTIES INADMISSIBLE.—The declarations of the parties to an interference in their own behalf and in the absence of each other, incompetent evidence for any other purpose than to show when or what they have respectively claimed to have invented.

(Before CRANCH, Ch. J., District of Columbia, October, 1847.)

Chas. M. Keller, for Atkinson.

1. The Commissioner has no authority in deciding an interference to refer to caveats, letters alleged to have been filed in the Patent Office, or generally to the files and entries in the Patent Office which have not been introduced in evidence by the parties.

2. The fact that Boardman, in carrying out the invention of Atkinson, was the first to make a machine embodying the invention, does not place the burden of proof upon Atkinson. The invention is his who first conceives of and discovers the thought or idea which is the essence of the invention; and if the inventor is not a worker with tools, he is at liberty to employ skilled mechanics to carry his invention into effect. (Bloxon *v.* Elsee, Hindmarch on Patents, 23, 25, 31, 445.) The fact that the inventor does employ, and is often compelled so to employ, mechanics in building his inventions does not, and should not in reason, create a *prima-facie* case against him.

Opinion of the court.

CRANCH, J.

This is an appeal from the decision of the Commissioner of Patents in a case of conflicting applications for certain improvements in the construction of steam-pumps.

It appears by the files in the Patent Office that on the 4th of December, 1843, William Boardman, Jr., filed his application for his invention "of a new and improved portable steam-pumping engine for relieving stranded vessels, and for other purposes;" which application was rejected by the then Commissioner of Patents on the 20th of February, 1844. It does not appear upon what grounds that application was rejected, but it is suggested that the matter as then presented was not patentable, but that certain improvements have been since invented and made by which the matter has become patentable; and the Commissioner has decided that the applicant—William Boardman, Jr.—is entitled to a patent. It is unnecessary to ascertain what those improvements were, as this is a case of conflicting applications for a patent for the same thing. The question is not, now, who invented the matter upon which the first application of Mr. Boardman was founded, but who is the inventor of the improvements which have made the matter patentable. That such improvements have been made, is admitted by both parties and by the Commissioner.

I do not find any evidence that Mr. Atkinson, after the rejection of Mr. Boardman's first application on the 20th of February, 1844, invented any patentable improvement upon the pump. It appears by all the evidence that Mr. Boardman constructed the pump and all the improvements. In the absence of all evidence to the contrary, the presumption, therefore, is that he was also the inventor; and the burden of proof is thrown upon Mr. Atkinson to show, not merely that he first suggested to Mr. Boardman the abstract idea of a steam-pump—(for steam-pumps had been in common use for many years)—but that he invented the improvements which entitled it to a patent. To rebut this inference Mr. Atkinson produces the deposition of Josiah L. Hale, who says: "Not long after the loss of the ship 'Sheffield,' in November or December, 1843, I met Mr. Atkinson and Mr. Boardman in the Merchants' Exchange; and knowing that some alienation of feel-

ing existed between them, and being anxious that they should be friends, I said to Mr. Boardman, 'Why don't you and Mr. Atkinson settle your difficulties,' or words equivalent. He (Boardman) made a reply having reference to a little paragraph which had about that time appeared in one of the papers respecting the pump in question,—meaning, no doubt, the paragraph which appeared in the *Journal of Commerce* of the 25th of November, 1843, which gave to Mr. Atkinson the whole credit of the invention of the pump. He (Boardman) spoke with some warmth, but respectfully. The deponent replied, I had always supposed Mr. Atkinson was the inventor; he (Boardman) said he was, I again say he was; he (Boardman) used these words or words equally strong. I (deponent) replied, "so I always supposed." After those strong expressions, Mr. Boardman said that it was the combination which made the steam-pump. Always supposing that Mr. Atkinson was the inventor, I feel certain I could never have conveyed any other idea to any person that he was not the inventor."

Taking the whole testimony of Mr. Josiah L. Hale together, it seems strange that Mr. Boardman, while expressing indignation at the paragraph which gave to Mr. Atkinson the whole credit for the invention of the pump, should have admitted that he was the inventor in the technical sense of the word. He might have admitted that Mr. Atkinson suggested the idea of having a steam-pump, as testified by Mr. Flanders, and yet he (Boardman) might be the inventor of the peculiar combination of mechanical principles which entitled it to a patent. Mr. Hale says that Mr. Boardman told him "that it was the combination which made the steam-pump." There is no evidence that that combination was suggested to him by Mr. Atkinson.

I do not perceive in the testimony any further evidence in support of Mr. Atkinson's claim to be the inventor of any of the patentable improvements in the portable steam-pump.

I have not considered the declarations of the parties in their own favor in the absence of each other as competent evidence in this cause for any purpose but to ascertain when and what they have respectively claimed to have invented.

There is no evidence that Mr. Boardman was in the employment and pay of Mr. Atkinson at the time of the supposed inven-

tion, or at the time of the construction of the improvements which rendered it a patentable invention, or at any previous time. On the contrary, it appears in the testimony of Mr. Carmen that before the first application for a patent in December, 1843, Mr. Boardman built four of these pumps for the Board of Underwriters, who paid him for the construction thereof, and that this was done without the interference or agency, but with the knowledge, of Mr. Boardman.

There does not appear to be any evidence that Mr. Atkinson, either before or after the rejection of Mr. Boardman's application for a patent for the pump, gave Mr. Boardman any instructions in relation to the particular combination of mechanical principles which is understood to be the ground of his present application for a patent, nor any model or drawings by which to construct the pump; nor does there appear to be any evidence that he paid Boardman or any other person for constructing it, or that the underwriters had any authority from Mr. Atkinson to use those pumps which had been built for them by Mr. Boardman.

The deposition of Mr. Josiah L. Hale was taken in New York ten days after Mr. Boardman's (Sr.) deposition had been taken in Nashville, N. H., and may have been taken with a view to rebut it. Mr. Boardman testified that between the spring of 1841 and the fall of 1842 Mr. Atkinson told him that William (his son) had invented a steam-pump at his (Atkinson's) request, and that he had requested him to give his attention to getting up a steam-pump—a portable pump to be used about wrecked vessels. That Atkinson asked him if he had seen the model of the pump invented by William. He and this witness replied that it was shown to him by Carmen. That in none of the conversations which he had with Mr. Atkinson did he ever pretend or intimate that he was the inventor of the pump or of any part of it; but, on the contrary, had always stated that William (his son) was the inventor. That in September, 1842, Mr. Hale, speaking of William Boardman, Jr., said he had recently invented a steam-pump which they thought highly of, and he should use his influence to have the insurance company adopt it and to have one built, and that he intended William should make money out of it.

Mrs. Boardman, mother of the appellee, says that in the summer of 1842 Mr. Atkinson, speaking of her son William, told her

that he had been inventing a new pump—a steam-pump—to raise ships from the ocean; that he thought William would do something great with it; that he would assist him; that in the next season Mr. Atkinson was again at their house in Nashville. He said William was getting along finely with his pump, and expressed his opinion that it would be very valuable to him; that in neither of those conversations did Mr. Atkinson intimate that he had invented any part of the said pump; that he expressed himself as grateful for favors he had received from her husband, and was glad to have some opportunities to make a return by assisting her son.

Mr. Jeremiah J. Dickson says that some time between June or September, 1842, he was present at the exhibition of a steam-pump in Pearl street at the request of Mr. Atkinson; that two or three of the board of underwriters were there, and he thinks Mr. Boardman was there also. He understood from Mr. Atkinson that Mr. Boardman was the inventor of the pump; that Mr. Atkinson was to find the funds, and that they were to be partners in the concern, and that he always thought they were partners until one or two years ago, when he learned there had been some misunderstanding between them.

Horace Prior testifies that he received from Mr. Boardman compensation for the use of the room in which the pump was exhibited.

Mr. Orlando Burnett proves the publication of the offensive paragraph which seems to have caused the misunderstanding between Boardman and Atkinson, by attributing the whole invention to Mr. Atkinson. This paragraph, a copy of which is annexed to Mr. Burnett's deposition, appeared in the *Journal of Commerce* of the 25th of November, 1843. This seems to have excited Mr. Boardman, and on the 4th of December following he filed his petition for a patent.

William Hetcher testifies that William Boardman, Jr., employed him to make the patterns for the pump, and paid him for making them. Mr. Boardman showed him a sketch which gave him the idea so that he could commence. He never had any communication with Mr. Atkinson, and did not know him till the day of taking his deposition. This witness made a casting of the pump pattern. Mr. Boardman made an alteration in the angle of the

discharge nozzle. About the 1st of June, 1842, he took to Mr. Boardman a boiler for the purpose of trying the model, which was then complete. The boiler was of iron. The pumps were cast in Browning's foundry.

Cyrus Currin, of the firm of Davis, Currin & Co., machinists at Newark, New Jersey, testifies that they made five of these steam-pumps for Mr. Boardman, and were paid for them by the New York underwriters, Mr. Boardman having testified to the accuracy of the accounts; that he directed the building of them and drafted them. The order for the first pump was given about the middle of March, and completed the middle of May, 1843. Mr. Atkinson was never in the shop during the building of these pumps to the knowledge of this witness, and gave no instructions about the building of them. He (Mr. Atkinson) has been in the shop since they were removed. He came and said he wanted an engine built with a pump attached to it. He gave no drawings, but asked this witness' opinion as to the size, &c.; thinks he asked if Mr. Boardman's patterns were there. We answered, "No, they are in New York." He then asked the witness if he could build him a pump the same as they had built for Boardman; thinks it was in the fall of 1841 that Boardman first told him he contemplated building a pump for wrecking purposes; thinks it was in the middle of the fall. He first saw the model of the steam-pump completed in the spring or summer of 1842. He saw Atkinson at the place where he saw the model. Mr. Atkinson did not at the time claim to be the inventor of the pump, or say anything to lead this witness to think that he was the inventor; nor did he say or do anything which gave this witness to understand that he did not recognize Mr. Boardman at that time as the inventor. Mr. Atkinson said nothing about it. Mr. Boardman showed him the whole, and explained it to him.

Mr. Julius Von Schmidt, a machinist in Washington, D. C., testified that he was applied to to make a model for Mr. Atkinson "a year ago last winter" (his deposition was taken in 1847). Mr. Atkinson showed him a model and drawing in Doctor Jones' office, and wished him to make him such a model, which he did with some small variations; saw the same model in the Patent Office about three months ago; the name of William Boardman, Jr., was upon it; he made a sketch of it at Doctor Jones' office;

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he has seen at the Patent Office the model he made for Mr. Atkinson. Mr. Atkinson did not give him any idea of the principle or construction of the pump before he took him to Doctor Jones' office; he called the model at Doctor Jones' office *his* model; he did not examine the drawing particularly; he only took a glance at it; Doctor Jones held it in his hands and took it away immediately, and told him he could sketch better from the model. Upon a careful consideration and comparison of the evidence on both sides, I am of opinion that the preponderance is greatly in favor of William Boardman, Jr., as the inventor of the improvement in the steam pump for which he has now applied for a patent; and I do therefore affirm the decision of the honorable Commissioner of Patents in this cause.

Keller & Greenough, for the appellant.

Z. C. Robbins, for the appellee.

IN RE EDWIN JANNEY. APPEAL FROM REFUSAL TO GRANT PATENT.

DECISION OF FORMER COMMISSIONER—REFUSAL TO REHEAR NOT APPEALABLE.—The refusal by one Commissioner to rehear a case decided by his predecessor is not a ground of appeal to the judge. The acts of 1836 and 1839 only give an appeal from the refusal of the Commissioner to issue a patent.

NO LIMITATION OF APPEAL.—*Semble*, that the applicant might still appeal from the decision of the former Commissioner, there being in the act no limitation of time as to the appeal.

(Before CRANCH, Ch. J., District of Columbia, December, 1847.)

J. J. Greenough for the appellant.

1. There is and can be but one Commissioner of Patents, and the rule of action should be the same whether an application is brought up for consideration under the same or a different incumbent of the office.

2. The Commissioner does not pretend to extend the rule stated by him to his final action in cases that have been presented since