JAMES R. NICHOLS, APPELLANT,

vs.

ELBRIDGE HARRIS, APPELLEE. INTERFERENCE.

JURISDICTION—POWER OF COMMISSIONER TO GRANT NEW TRIAL.—When the decision of the Commissioner was reversed by the judge upon the ground that the depositions of the prevailing party were improperly taken, it is competent for the Commissioner to grant a new trial to afford the parties the opportunity of having their testimony fully and impartially taken.

INVENTION—PRINCIPLE—EQUIVALENTS.—The first and original inventor is entitled to protection against all other means of carrying the principle into effect.

IDENTITY OF INVENTIONS—SAME IN PRINCIPLE AND RESULT.—When two machines are substantially the same, and operate in the same manner to produce the same result, they must be in principle the same; and it is to be understood that when the results are referred to as a test of the identity of the machines, the results must be the same in kind though they may differ in degree.

(Before MORSELL, J., District of Columbia, January, 1855.)

STATEMENT OF THE CASE.

The patent issued to Harris, No. 12,550, March 20th, 1855. (See Patent Office Report, 1855, vol. 4, p. 110.)

MORSELL, J.

This case was once before brought before me on appeal, by referring to which (*ante*, p. 302) a particular statement will appear. The objection stated and relied on in the reasons of appeal was to the admissibility of the testimony. This objection was sustained, and the decision of the Commissioner based thereon reversed, and the case remanded for further proceeding. There was no decision by me on the merits of the question, because under such circumstances it was not deemed necessary.

The Commissioner states in his certificate to me that he proceeded subsequently to order the testimony to be again taken, with full opportunity to both parties for that purpose, and the trial thereof was appointed to take place on the third Monday of July, 1854; at which time the testimony was duly laid before him and the parties heard; on which subsequent occasion he says that

he decided that so far as the parties do interfere, priority of invention rests with Harris, who seems entitled to date as far back as May 19th, 1852.

Again, the Commissioner says: "It would seem that the interference was declared on just and sufficient grounds, inasmuch as they both claimed making and using a metallic lining to glass lamps for burning camphene. If there be anything over and above this single idea appertaining to either party, such party will be entitled to a patent therefor if, upon due examination, he shall be found to be the original and first inventor of the same."

This decision and the reasons of appeal, together with all the papers and evidence, were again produced before me, and the case submitted on written argument. The first reason of appeal relates to what is supposed to be the effect of the reversal just alluded to; that is, that it was the duty of the Commissioner to have proceeded in the case by ordering a patent, according to the provisions of the patent laws, to issue to the said Nichols for the invention claimed by him; and that the subsequent rehearing was illegal, and the decision founded on such rehearing void. This is a misapprehension, as before stated. The merits of the case were not considered; it was not so intended. I know of no rule of patent law that warrants such an inference. It was supposed that, for the ends of justice, an opportunity should be afforded to the parties to have their testimony fully and impartially taken. This was thought to be a matter of common right, and which on the former occasion sufficiently appeared not to have been done. The Commissioner was, therefore, entirely correct in making his order to that effect.

The second reason is, that upon the evidence it appears that the said Nichols was the first original inventor of lining "all the inside of the reservoir of a glass lamp with metal."

The third reason is, that the testimony of John Newell, one of the appellee's witnesses, ought not to have had any weight with the Commissioner by reason of the suspicious conduct of the witness in testifying on the former trial. As it respects priority, the appellant's evidence does not satisfactorily prove his invention to have been earlier than the 15th of July, 1852. The evidence on the part of the appellee shows his to have been at least as early,

if not earlier, than the 10th of June, 1852; so that the only question is as to the interference.

Emmerson, a witness on the part of Doctor Nichols, describes the invention as a common glass lamp, which he assisted him in cutting off the top of, for the purpose of lining it with metal.

Moses H. Pearson, another witness on behalf of the same party, says: "I know of some improvements made by James P. Nichols. Some time before September, 1852, Doctor Nichols brought a glass lamp into my shop with the top broken off, and wanted me to make a lining to it. I made it at that time; it was a common glass-stand lamp. He wanted me to make a lining to it so that he could put the glass on again which he had broken off. I made the lining to it as well as I could, but could not make it so that the glass pieces would fit on again. He said it was of no consequence whether the top fitted on it, although he should like it so that the top would fit on again."

The lamp laid on the shelf in the shop for a number of weeks, and he did not come after it during that time. Witness supposes the reason he did not come after it was because he had gone to the White Mountains.

To the fifth interrogatory he says that he did not think those pieces of glass if produced would, with the other parts of the glass, have entirely covered the metal, because some of the pieces of glass were gone; but they would have covered it had all the pieces of glass been there. It was the intention to make the tin fit the glass; but witness could not make it an entire fit, as some of the pieces of glass were gone. Had the dome of the lamp have been taken off whole so that it could have been put on whole again he would have made the lining for it.

On the part of the appellee, Gardiner S. Coffin describes Harris' lamp thus: The improvement was a metallic lining inside of a glass lamp. He (Harris) drew out on a piece of paper with a pencil a description of it, and gave witness to understand what the benefit was. Harris stated that in case the lamp should be broken the fluid would not spill. He asked witness' opinion in regard to it. A drawing of the lamp was made on paper by Mr. Harris. Then there was a drawing of a metallic lining; and this metallic lining which contained the fluid was to be placed inside of the glass part of the lamp and cemented, so that in case

of the lamp being broken the fluid would not spill or ignite. Each separate part was drawn and described, and corresponded with the plan made by Leonard. He then described it so that witness could have made one, or caused one to be made, from his said description or explanation.

This witness is corroborated by Leonard and Farewell, who describe the improvement as follows: Common glass lamps were to be made in a different shape by having them larger at the top than at the bottom—not oval, as usual—(leaving off that part of the glass—the oval part), and having instead an oval metallic top fastened to an inner metallic lining, made so as to drop into the glass, to be fastened at the top of the glass by cement; the cap the same as in other fluid lamps. By these means the accidents from breaking the glass would be prevented.

It appears from the specifications that the object of both parties was the same—namely, to guard against the danger from the use of camphene in the common glass lamps, which both proposed to effect by a metallic lining; and though neither the glass nor the metallic lining (separately) might be deemed a patentable invention, yet in their combined use it would be otherwise. The evidence (setting aside the testimony of Newell) shows that the means used by each of the parties are so very much alike in other respects that the question is narrowed down to this, whether, for the purpose stated, there is in principle a difference between a metallic dome and a glass dome.

I need only to state what is the well-settled principle on the subject to show what must be the conclusion: "The first and original inventor is entitled to protection against all other means of carrying the principle into effect."

In the case of Gray *v.* James, Peters, C. C., 394–400, Washington, justice, applied the same doctrine to an improvement in the art of making nails by means of a machine which cuts and heads the nails at one operation—holding that where two machines are substantially the same, and operate in the same manner to produce the same result, they must be in principle the same; and that when the same result is referred to as the test, it must mean the same kind of result, though it may differ in extent.

Governed by this rule, I must come to the conclusion that in

this case the principle of the invention in the two lamps in the present case is the same, and that the appellee, being the first and original inventor, has the prior right, and that the decision of the Commissioner on all the points of controversy in this case ought to be affirmed.

Hubbard & Pinkerton, for the appellant.

A. B. Stoughton, for the appellee.

WALTER HUNT, APPELLANT,

vs.

ELIAS J. HOWE, JR., APPELLEE. INTERFERENCE.

JURISDICTION OF THE COMMISSIONER.—The Commissioner of Patents is now vested with the whole and only original initiatory jurisdiction that exists up to the granting and delivering of the patent.

BOARD OF EXAMINERS—ITS JURISDICTION DISTRIBUTED—POWER OF COMMISSIONER.—When the board of examiners created by the act of 1836 was abolished by the act of 1839 its original jurisdiction was vested in the Commissioner and its appellate jurisdiction in the chief justice of the District of Columbia.

POWER OF COMMISSIONER PLENARY WITHIN ITS LIMITS.—It is true that the jurisdiction of the Commissioner of Patents is a limited one, but it is equally true that it is to be understood not only from what is expressly stated, but from what ought necessarily to be inferred, and is as absolute within its proper legal limits as a tribunal of general jurisdiction would be.

PUBLIC USE AND ABANDONMENT—COMMISSIONER MAY INVESTIGATE—DUE PROCEEDINGS.—The Commissioner of Patents has jurisdiction to try and determine the questions of public use and abandonment arising in connection with an application by due proceedings suitable to the nature of the inquiry.

SM—SM—SECTIONS 6 AND 7, ACT OF 1836, CONSTRUED.—The negative prerequisites to a patent—that the invention has not been in public use or on sale, &c.—as mentioned in the sixth section of the act of 1836, are equally binding upon the Commissioner with the others therein named, and are expressly submitted to his examination by the opening provisions of section 7 of the same act.