

125. *Witness Fees.*

Every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States. *Rev. Stat. § 4907.*

126. *Penalty for failing to Attend, or refusing to Testify.*

Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself. *Rev. Stat. § 4908.*

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**X. APPEALS. BILL IN EQUITY**127. *Appeals from Primary Examiners to Examiners-in-chief.*

Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal. *Rev. Stat. § 4909.*

The fee prescribed is ten dollars. See *Rev. Stat.* § 4934 ; *Rules of Prac.* 128.

To allow such appeal there must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and all the claims must be passed upon, and all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled, before the case is appealed to the examiners-in-chief. *Rules of Prac.* No. 129.

Upon the filing of the appeal the same shall be submitted to the primary examiner, who, if he find the appeal to be regular in form, shall furnish the examiners-in-chief with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims, and with the references applicable thereto. If the primary examiner shall decide that the appeal is not regular in form, an appeal from such decision may be taken directly to the commissioner, as provided in Rule 140. *Id.* No. 130.

The appellant shall, before the day of hearing, file a brief of the authorities and arguments on which he will rely to maintain his appeal. *Id.* No. 131.

If the appellant desire to be heard orally before the examiners-in-chief, he will so indicate when he files his appeal ; a day of hearing will then be fixed, and due notice of the same given to him. *Id.* No. 132.

In contested cases the appellant shall have the right to make the opening and closing arguments unless it shall be otherwise ordered by the tribunal having jurisdiction of the case. *Id.* No. 133.

The examiners-in-chief in their decision will affirm or reverse the decision of the primary examiner only on the points on which appeal shall have been taken. (See Rule 128.) If they shall discover any apparent grounds not involved in the appeal for granting or refusing letters patent in the form claimed, or in any other form, they will annex to their decision a statement to that effect, with such recommendation as they shall deem proper. *Id.* No. 134.

From any judgment of the primary examiner, on points embraced in the recommendation annexed to the decision adverse to the appellant, appeal may be taken on questions involving the merits to the board of examiners-in-chief and on other questions to the commissioner, as in other cases. *Id.*

If an appeal shall be taken from the decision of the examiners-in-chief to the commissioner, the commissioner, whenever, in his opinion, substantial justice shall require it, may, either before or

after final judgment, remand the case to the primary examiner for consideration of any amendment or action based upon the recommendation annexed to the decision of the examiners-in-chief. *Id.*

If the commissioner, in revising the decision of the examiners-in-chief, shall discover any apparent grounds for granting or refusing letters patent not involved in the appeal, he will, before or after final judgment, whenever, in his opinion, substantial justice shall require, give reasonable notice thereof to the parties; and if any amendment or action based thereon shall be proposed, he will remand the case to the primary examiner for consideration. *Id.*

From decisions of the primary examiner, in cases remanded, as herein provided, appeal will lie to the board of examiners-in-chief, or directly to the commissioner, as in other cases.

If affidavits be received, under Rule 75 or 86, after the case has been appealed, the application will be remanded to the primary examiner for reconsideration. *Id.* No. 135.

#### 128. *From Examiners-in-chief to Commissioner.*

If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the commissioner in person. *Rev. Stat.* § 4910.

The fee prescribed is twenty dollars. See *Rev. Stat.* § 4934; *R. les of Prac.* No. 136.

Cases which have been heard and decided by the commissioner on appeal will not be reopened except by the commissioner; cases which have been decided by the examiners-in-chief will not be reheard by them, when no longer pending before them, without the written authority of the commissioner; and cases which have been decided by either the commissioner or the examiners-in-chief will not be reopened by the primary examiner without like authority, and then only for the consideration of matters not already adjudicated upon, sufficient cause being shown. *Rules of Prac.* No. 137. See also *Id.* No. 67.

Cases will be regarded as pending before a tribunal until appeal has been taken from its decision, or until the limit of appeal which must be fixed in contested cases has expired. *Id.* No. 138.

Cases which have been deliberately decided by one commissioner will not be reconsidered by his successor except in accordance with

the principles which govern the granting of new trials. *Id.* No. 139.

Upon receiving a petition which shall state concisely and clearly any proper question, which has been twice acted upon by the examiner, and which does not involve the merits of the case, or the rejection of a claim, and which shall also state the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the commissioner, and directing the examiner to report upon or answer the matters averred in such petition at least five days before such day of hearing. *Id.* 140.

In cases of interference parties have the same remedy by appeal to the examiners-in-chief and to the commissioner as in *ex parte* cases; but no appeal lies in such cases from the decision of the commissioner. *Id.* No. 141.

Appeals in interference cases must be accompanied with brief statements of the reasons therefor; and both parties will be required to file briefs of their arguments before the day of hearing. Printed briefs are in all cases preferred. *Id.* No. 142.

The commissioner may, in his discretion, order a rehearing, and upon such rehearing may revise his original decision. *Matthews v. Weede*, 1 *MacArthur Pat. Cas.* 144; *Re Rouse*, *Id.* 286; *Nichols v. Harris*, *Id.* 362.

### 129. *From the Commissioner to the Supreme Court, District of Columbia.*

If such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc. *Rev. Stat.* § 4911.

It is no longer customary in the patent-office to allow *pro forma* proceedings, in order to give opportunity for an appeal to the Supreme Court of the District. *Rules of Prac.* No. 145.

The rules and forms for these appeals are given in the Appendix to the Rules.

The refusal by the commissioner of patents to grant a patent to an assignee does not form the subject of an appeal to a judge at chambers in the Supreme Court of the District of Columbia. *Whitney v. Fisher*, 4 *Fish. Pat. Cas.* 248.

No appeal lies from a decision of the commissioners upon the

relative priority of two pending interfering applications for a patent. *Exp. Gower*, 15 *Pat. Off. Gaz.* 828.

Patentee has no right of appeal from the decision of the commissioner in an interference between the patentee and the applicant for a patent ; the latter only has the right, the patentee being left to his remedy by action. *Pomeroy v. Connison*, 1 *McArthur Pat. Cas.* 40.

An appeal did not lie from the refusal of a commissioner to reopen a hearing upon an application under the acts of 1836 and 1839. *Re Janney*, 1 *MacArthur Pat. Cas.* 86. Under the act of 1839, the reasons of appeal filed upon appealing from a decision of the commissioner limit the jurisdiction of the appellate court, and where these reasons are vague and indefinite they will not be considered by the court. *Re Winslow*, 1 *MacArthur Pat. Cas.* 123 ; *Jillson v. Winsor*, *Id.* 136 ; *Burlew v. O'Neil*, *Id.* 168.

Upon appeal the court will pass upon the merits of the case without regard to the reasons which the commissioner assigned for his decision ; those reasons may be wrong and still the decision be correct. *Re Aiken*, 1 *MacArthur Pat. Cas.* 126 ; *Re Aiken*, *Id.* 130 ; *Re Crooker*, *Id.* 134.

Upon appeal the ruling of the commissioner upon the admission of evidence cannot be reviewed, unless such ruling was specifically set forth in the reasons of appeal. *Jillson v. Winsor*, 1 *MacArthur Pat. Cas.* 136.

The right to appeal from the decision of the commissioner, given by section 11 of the act of 1839, is lost by failing to file the reasons of appeal within the time prescribed therefor, although a motion for a rehearing is pending, unless a special order enlarging the time is made. *Greenough v. Clark*, 1 *MacArthur Pat. Cas.* 173.

Refusal of the commissioner to admit competent and material evidence offered by an applicant was ground for appeal from his decision, under the acts of 1836 and 1839, and upon each appeal an order might be made directing the case to be reheard and the evidence to be admitted before the commissioner. *Re Fultz*, 1 *MacArthur Pat. Cas.* 178.

The court cannot review the commissioner's exercise of his discretionary power in extending time for taking testimony in an interference proceeding ; granting a rehearing, &c. *Mathews v. Weede*, 1 *MacArthur Pat. Cas.* 144 ; *O'Reilly v. Smith*, *Id.* 218 ; *Re Rouse*, *Id.* 287 ; *Nichols v. Harris*, *Id.* 362.

A decision of the commissioner rejecting an application for a patent for want of novelty, upon references to other inventions, should be reversed upon appeal, where the references originally relied upon are virtually abandoned and others presented for the first time on the appeal. *Re Jewett*, 1 *MacArthur Pat. Cas.* 259.

That a commission to take testimony in interference proceedings was executed before a magistrate who was of counsel for one of the parties is ground for reversal of a decision of the commissioner founded upon the depositions so taken. *Nichols v. Harris*, 1 *MacArthur Pat. Cas.* 302.

Decision of the commissioner against an applicant in an interference case upon the ground that the invention was not operative, reversed upon appeal, the testimony of witnesses that they had tested the device and found that it would not work being overcome by the production and operation in court of the machine itself. *Bell v. Hill*, 1 *MacArthur Pat. Cas.* 351.

In determining an appeal from the commissioner of patents, the supreme court of the District of Columbia will look only into the reasons of appeal, and into the records and proceedings in the case which are applicable to these reasons. *Re Conklin*, 1 *MacArthur Pat. Cas.* 375 ; 5 *Pat. Off. Gaz.* 235.

The jurisdiction of the appellate court in interference cases is not limited to cases where the commissioner has awarded priority ; but an appeal may be taken from his refusal to grant any patent. *Carter v. Carter*, 1 *MacArthur Pat. Cas.* 388.

Decision of the commissioner in an interference case, reversed, upon the evidence, the negative testimony of a single witness who was in a position to know the fact testified being deemed sufficient, under the circumstances, to outweigh the positive testimony of two witnesses, whose answers appeared to be evasive and unfair. *Cornell v. Hyatt*, 1 *MacArthur Pat. Cas.* 423.

No appeal lies from an interlocutory decision of the commissioner, such as a refusal to extend the time for taking testimony. *Wellman v. Blood*, 1 *MacArthur Pat. Cas.* 432.

A claim filed upon an application for a patent, construed, upon appeal from a rejection, by giving it the interpretation most favorable to the applicant, and held to be for a patentable combination, although in each of the features of the improvement, separately considered, there was strong resemblance to known things and known results ; the combination differing from each and all in the

specific result, and appearing by the united action to accomplish the desired result with a saving of material and of operative force. *Re Cole*, 1 *MacArthur Pat. Cas.* 539.

Under section 8 of the act of 1836, an appeal from a decision of the commissioner of patents in an interference case might be taken by a patentee where the decision was in favor of the patentee. *Babcock v. Degener*, 1 *MacArthur Pat. Cas.* 607. Overruling on this point, *Pomeroy v. Connor*, *Id.* 40, which had been followed in the following cases: *Brown v. Herrick*, *Id.* 310; *Whipple v. Renton*, *Id.* 332; *Hopkins v. Barnum*, *Id.* 334; *Drake v. Cunningham*, *Id.* 378; *King v. Gedney*, *Id.* 443.

The commissioner of patents had the power, under section 11 of the act of 1839, to enlarge the time for taking an appeal from his decision. *Justice v. Jones*, 1 *MacArthur Pat. Cas.* 635.

The owner of a label entitled to registration made application to the commissioner for its registration, and had complied with all the requirements of the law; but the examiner rejected the application on the ground that the label was not of the class entitled to registration. The applicant, instead of appealing to the commissioner, petitioned the Supreme Court of the District of Columbia for a mandamus to compel the commissioner to register his label. The commissioner, in his answer to the rule to show cause, recited the facts of the failure of the applicant to appeal to the commissioner from the examiner's decision, but at the same time approved of and indorsed the reasons of the examiner for refusing to register the label. It was *held*, that a peremptory mandamus to register the label should issue. *United States v. Marble*, 1 *Mackey*, 284; 2 *Pat. Off. Gaz.* 1366.

Under the act of 1839 the attorney general advised, that, in order to be effectual, the certificate of the proceedings and decision of a justice of the Supreme Court of the District of Columbia in an appeal from the commissioner of patents, required to be delivered and returned by him to the commissioner, must be made and certified by the justice while he is in office; but, if so made and certified, it may be transmitted by him to the commissioner after he has ceased to be a justice. 13 *Op. Att. Gen.* 265.

The requirement of section 7 of the act of 1836 that the applicant shall make oath anew when he persists in his application after having been informed by the commissioner of the errors or defects of his specification, does not make a new oath necessary to enable

him to appeal when his application is finally rejected. *Re Crooker*, 134.

130. *Notice of and Proceedings on such Appeals.*

When an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the patent-office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing. *Rev. Stat.* § 4912.

The court shall, before hearing such appeal, give notice to the commissioner of the time and place of the hearing, and on receiving such notice the commissioner shall give such notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the commissioner and the examiners may be examined under oath in explanation of the principles of the thing for which a patent is demanded. *Rev. Stat.* § 4913.

131. *Determination of such Appeal, and its Effect.*

The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decisions, which shall be entered of record in the patent-office, and shall govern the further proceedings in



the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. *Rev. Stat.* § 4914.

*The Revised Statutes of the District of Columbia*, Provide, on the subject of "Appeals from Commissioner of Patents," as follows: "The supreme court" [of the District of Columbia], "sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the commissioner of patents," in accordance with the provisions of section 4911 to section 4915, inclusive of the Revised Statutes of the United States. *Rev. Stat. Dist. Col.* § 780.

### 132. *Patents obtained by Bill in Equity.*

Whenever a patent on application is refused, either by the commissioner of patents or by the supreme court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the patent-office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. *Rev. Stat.* § 4915; and see *Id.* § 629.

Rev. Stat. § 4915 does not give the courts general appellate jurisdiction in cases of interference. And it would be improper for a court to enjoin the applicant who prevails before the commissioner from receiving his patent, upon the mere suggestion that the commissioner erred in his decision. *Whipple v. Miner*, 15 *Fed. Rep'r*, 117 ; 23 *Pat. Off. Gaz.* 2236.

The jurisdiction of the circuit courts to grant a patent, notwithstanding an adverse decision of the commissioner of patents, is an independent original jurisdiction ; it is not within the discretion of the defeated party to say when and under what circumstances the action of the office shall be suspended. *Ib.*

If an applicant is dissatisfied with limitations imposed by the commissioner, he should resort to the courts in the same manner as from a rejection of his application. *New York Belting, &c. Co. v. Sibley*, 15 *Fed. Rep'r*, 386 ; 23 *Pat. Off. Gaz.* 1444.

The circuit court has jurisdiction of a bill to obtain the issue of a patent refused by the commissioner of patents ; and the commissioner, by accepting service of process has been *held* to subject himself to such jurisdiction in a district in which he did not reside. *Vermont Farm Machine Co. v. Marble*, 20 *Fed. Rep'r*, 117.

The suit in equity authorized under Rev. Stat. § 4915, is an original and not an appellate proceeding. It is conducted according to equity rules, and a party contesting his right to a patent thereunder need not be confined to matters existing of record in the patent-office or in the supreme court of the District of Columbia. In this case a motion to appoint a special examiner, under the rules of the court, for the purpose of taking additional testimony, was accordingly granted. *Re Squire*, 12 *Pat. Off. Gaz.* 1025 ; 3 *Bann. & A. Pat. Cas.* 133.

Upon a suit under Rev. Stat. § 4915, a court of equity will not aid the inventor to obtain a patent himself in direct violation of his agreement transferring the property in his invention. *Runstetler v. Atkinson*, 23 *Pat. Off. Gaz.* 940.

Rev. Stat. § 4915, providing a remedy by bill in equity for an erroneous decision on an interference case, means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure ; not a technical appeal confined to the case as made in the record of the patent-office, but a suit prepared and heard upon all competent evidence, and the whole merits ; the

decree in which is conclusive on the department. Matthews, J., in *Butterworth v. Hoe*, 112 *U. S.* 50, 61.

Such bill is the only mode allowed, of reviewing a commissioner's decision on an interference ; there is no appeal from such decision. *Butler v. Shaw*, 21 *Fed. Rep'r*, 321.

The commissioner need not be a party to such bill ; an assignee of defendant's patent should be a defendant. *Graham v. Teter*, 25 *Fed. Rep'r*, 555 ; 33 *Pat. Off. Gaz.* 758.

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## XI. SURRENDER AND REISSUE.

### 133. *Reissue of Defective Patents.*

Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject

to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form ; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other : but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. *Rev. Stat. § 4916.*

#### 134. *General Nature, Scope and Extent of the Right of Reissue.*

A reissue is granted to the original patentee, his legal representatives, or the assignees of the entire interest, when, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his invention or discovery more than he had a right to claim as new, the original patent is inoperative or invalid, provided the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. In the cases of patents issued and assigned prior to July 8, 1870, the applications for reissue may be made by the assignees ; but in the cases of patents issued or assigned since that date the applications must be made and the specification sworn to by the inventors, if they be living. *Rules of Prac. No. 84.*

Matter which is shown and described, and might have been lawfully claimed, in an unexpired patent, but was not claimed by reason of a defect or insufficiency in the specification, arising from inadvertence, accident or mistake, and without fraud or deceptive intent, cannot be subsequently claimed by the patentee in a separate patent, but only in a reissue of the original patent. *Rules of Prac. No. 91.*

If an inventor has produced a new and useful combination, which composes an organized machine, and also made new inventions of a less number of elements of the same combination than what compose the entire machine, he may, with the proper descriptions, claim the whole combination, and also the lesser ones, or ones composed of fewer elements than what make up the whole machine. He may, if he choose, make the several claims in one patent. If by inadvertence, accident, or mistake, he has failed in his original patent to claim any of the lesser combinations not embracing the whole machine, he can surrender his patent, and obtain a reissue for any additional claims so omitted in the original. *Stevens v. Pritchard*, 4 *Cliff.* 417 ; 10 *Pat. Off. Gaz.* 505 ; 2 *Bann. & A. Pat. Cas.* 390.

Prior use under a defective patent will not authorize the use of the invention after the issue of a renewed patent. *McWilliams Manuf. Co. v. Blundell*, 11 *Fed. Rep'r*, 419 ; 22 *Pat. Off. Gaz.* 177 ; *Hussey v. Bradley*, 5 *Blutchf.* 134 ; 2 *Fish. Pat. Cas.* 362.

As to reissue of patents which have been already extended, see *Woodworth v. Edwards*, 3 *Woodb. & M.* 120 ; *Gibson v. Harris*, 1 *Blutchf.* 167 ; *Wilson v. Rousseau*, 4 *How.* 646.

That a patent may be amended and reissued as often as errors are discovered,—see *Morse v. Bain*, 9 *West. L. J.* 106.

### 135. *Surrender ; How Made, and its Effect.*

The surrender of a patent extinguishes it ; cancels it ; and no right can afterward be asserted upon it. Suits pending for an infringement of a patent fall with its surrender, because the foundation upon which they were commenced no longer exists (*Mosfitt v. Garr*, 1 *Black*, 273 ; *Peck v. Collins*, 103 *U. S.* 660) ; but a person who under an honest misapprehension surrenders a valid patent, and takes out a reissue which proves to be void, is entitled to a reissue of the first patent in the identical language originally used. *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 *Fed. Rep'r*, 509.

That when a reissue is adjudged invalid, the surrender which preceded it will also be invalidated ; and the original patent will be treated as remaining in force,—see *Woodworth v. Hall*, 1 *Woodb. & M.* 248 ; 6 *Pa. L. J.* 178 ; *Woodworth v. Hall*, 1 *Woodb. & M.* 389 ; *Woodworth v. Edwards*, 4 *Woodb. & M.* 129.

136. *Loss of the Right, by Delay.*

The right to have corrections made by reissue may be abandoned and lost by unreasonable delay. *Miller v. Brass Co.*, 104 *U. S.* 350 ; aff'g 14 *Blatchf.* 282 ; 12 *Pat. Off. Gaz.* 667 ; 3 *Bann. & A. Pat. Cas.* 20 ; *Turrell v. Bradford*, 23 *Pat. Off. Gaz.* 1623 ; 15 *Fed. Rep'r*, 808 ; *Wollensak v. Reiher*, 115 *U. S.* 96.

Where a specific device or combination is claimed, the non-claim of other devices or combinations apparent on the face of the specification is, in law, so far as the patentee is concerned, a dedication of them to the public, and will so be enforced, unless he with all due diligence surrenders his patent for reissue, and proves that his omission to claim them arose wholly from inadvertence, accident, or mistake. *Miller v. Brass Co.*, *supra*. Followed, in case of a patent reissued 14 years after the original. *Baltimore Car Wheel Co. v. North Baltimore Passenger R. Co.*, 21 *Fed. Rep'r*, 47.

The right to have a mistake in a patent corrected does not depend upon what information the patentee or his assignee actually had of the mistake, but as to what they might have had if they had availed themselves of the opportunities at their command to discover it. *Ives v. Sargent*, 17 *Fed. Rep'r*, 447.

Action of the patent-office in granting a reissue is not conclusive on the question of laches of the patentee in applying for it ; the question is ultimately one of law for the court, and if there was delay and it cannot be accounted for, it may invalidate the reissue. *Wollensak v. Reiher*, 115 *U. S.* 96. Two years' delay in applying for a reissue, was *held* not unreasonable where no adverse rights had accrued meantime. *Stutz v. Armstrong*, 20 *Fed. Rep'r*, 843. The application for a reissue is not an application for a patent, but for the amendment of one, and is not such an application as must be made before two years of public use have been had. *Shaw v. Colwell Lead Co.*, 11 *Fed. Rep'r*, 711 ; 20 *Blatchf.* 417.

The facts that a patentee was a foreigner, unfamiliar with the English language, and ignorant of the omission from his patent of a claim contained in his application but rejected, the rejection having been acquiesced in by his solicitors, was *held*, not sufficient to excuse delay of more than two years in applying for a reissue. *Boland v. Thompson*, 26 *Fed. Rep'r*, 633.

137. *Who may Surrender for Reissue : Rights of Assignees.*

In respect to the right of a patentee to surrender a defective patent and take out a new one, there is no difference between a citizen and an alien. *Shaw v. Cooper*, 7 *Pet.* 292, 315.

A patentee, to be entitled to a reissue, must have been the first to disclose the invention in the record existing in the patent-office. *Exp. Platts*, 15 *Pat. Off. Gaz.* 827.

There was nothing in the act of 1836 to restrict the right of surrendering a patent and taking a renewal thereof upon amended specifications because of special or limited grants or licenses previously made. *Smith v. Plympton*, 4 *West. L. J.* 49. Compare *Brooks v. Bicknell*, 4 *McLean*, 64 ; 3 *West. L. J.* 35 ; *Smith v. Mercer*, 5 *Pa. L. J.* 529.

Where a patent had by the death of the patentee devolved upon his executor, and had been by him assigned, the assignee may take a reissue in his own name and for his own benefit ; the statutory provisions authorizing a reissue are remedial, and are to be liberally construed. *Carew v. Boston Elastic Fabric Co.*, 1 *Holmes*, 45. And see another proceeding in same case, 3 *Cliff.* 356 ; 1 *Pat. Off. Gaz.* 91 ; 5 *Fish. Pat. Cas.* 90.

Under Rev. Stat. § 4895,—which provides for reissues of patents to assignees, the ultimate assignee may apply, though there may be intermediate ones through whom he derived the interest of the inventor ; and if the inventor parted with his interest before July 8, 1870, it is not necessary that he join in the application. *Selden v. Stockwell Self-lighting Gas-burner Co.*, 9 *Fed. Rep'r*, 390 ; 19 *Blatchf.* 544 ; 20 *Pat. Off. Gaz.* 1377. To same effect, under previous statutes, *Swift v. Whisen*, 2 *Bond*, 115 ; 3 *Fish. Pat. Cas.* 343.

Where there has been an assignment of an undivided part of the whole original patent, the assignee of such part and the patentee become joint owners of the patent, and should join in the surrender ; if they do not, it will be invalid, unless the part owner not joining shall ratify it. *Potter v. Holland*, 4 *Blatchf.* 206 ; 1 *Fish. Pat. Cas.* 327. And see *Commissioner of Patents v. Whiteley*, 4 *Wall.* 522.

A patentee cannot, by a surrender of his patent, affect the rights of third persons, to whom he had previously, by assignment, passed

his interest in the whole or a part of the patent, without the consent of such assignee. *Woodworth v. Stone*, 3 *Story*, 749. Such persons are entitled, upon the surrender of the patent and the obtaining of a reissued patent by the patentee, to the same right, under the reissued patent, that they had to the old one; but they cannot be compelled to take under the reissued one. *Potter v. Holland*, 4 *Blatchf.* 206; 1 *Fish. Pat. Cas.* 327. Where a patentee had sold all his right, title, and interest in his patent, except as to a little town; and subsequently, at the request of the assignees, applied for, and obtained, a reissue of the patent in his own name, which reissued patent he assigned as before, it was *held*, that the surrender of the original patent, at the request of the true owners, was valid; and that if the reissue to the patentee was a clerical error, he had corrected it by the subsequent assignment. *Wing v. Warren*, 5 *Fish. Pat. Cas.* 548.

Assent to the surrender of a patent by a transferee of an interest in it, who is not an assignee within the meaning of the statute, is not essential to the validity of a reissued patent. *Meyer v. Bailey*, 2 *Bann. & A. Pat. Cas.* 73; 3 *Pat. Off. Gaz.* 437. If an assignee accepts the reissue of a patent and transfers a part of the interest in it which was originally vested in him by the patentee, it is a ratification by him of the act of the patentee in securing the reissue, although he did not join in the surrender of the original patent. *Ib.*

Although an inventor has conveyed all his interest, yet if his assignment has not been recorded, the assignee cannot, after the patent has been reissued, demand issue of a patent to himself. *Whitely v. Fisher*, 4 *Fish. Pat. Cas.* 248; 5 *Id.* 528.

Amendments to a patent made on a reissue thereof will inure to the benefit of the assignees and grantees under the patent as it stood before such reissue; but such grantees may, if they prefer, rest their claims upon the specification as it stood when they purchased their right. *Smith v. Plympton*, 4 *West. L. J.* 49. See, also, *Smith v. Mercer*, 5 *Pa. L. J.* 529.

### 138. *The Application for a Reissue.*

The petition for a reissue must be accompanied with a certified copy of the abstract of title, giving the names of all assignees owning any undivided interest in the patent; and in case the appli-



cation is made by the inventor, it must be accompanied with the written assent of such assignees. *Rules of Prac.* No. 85.

Applicants for reissue, in addition to the requirements of rule 45, must also file with their petitions a statement on oath as follows :

1. That applicant verily believes the original patent to be inoperative or invalid, and the reason why.

2. Where it is claimed that such patent is so inoperative or invalid "by reason of a defective or insufficient specification," particularly specifying such defects or insufficiencies.

3. Where it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new," distinctly stating such part or parts so alleged to have been so improperly claimed as new.

4. Particularly specifying the errors which it is claimed constitute the inadvertence, accident, or mistake relied upon, and how they arose or occurred.

5. That said errors arose "without any fraudulent or deceptive intention" on the part of the applicant. *Rules of Prac.* No. 86.

A reissue claiming matters not in the original patent, and which did not infringe it, was *held* invalid, where, owing to the death of the inventor before the application for reissue, it was not supported by his oath as to inadvertence, accident or mistake. *Wooster v. Handy*, 22 *Blatchf.* 307 ; 21 *Fed. Rep'r*, 51 ; 28 *Pat. Off. Gaz.* 629.

The applicant for a reissue is not required to take any oath on the subject of the invalidity of his original patent. *Hartshorn v. Eagle Shade Roller Co.*, 18 *Fed. Rep'r*, 90 ; 25 *Pat. Off. Gaz.* 1191. He need not use the exact phraseology of the statute, if he employs language which conveys its legal meaning. *Gold, &c. Telegraph Co. v. Wiley*, 17 *Fed. Rep'r*, 234 ; 16 *Rep'r*, 129.

Where an applicant for reissue of a patent has done all in his power to make his application effectual—has filed his application with the acting commissioner and paid the requisite amount of fees—the application is to be considered as properly before the commissioner. *Commissioner of Patents v. Whiteley*, 4 *Will.* 522. A mandamus will lie to compel the commissioner of patents to receive an application for a reissue of a patent ; or to allow an appeal from his decision refusing a reissue. *Ib.*

Although a surrender of an original patent is the act of the

party making the application, still the application for a surrender and reissue may be withdrawn, under leave of a commissioner, for good cause shown, at any time before the proceedings are fully completed. *Forbes v. Barstow Stove Co.*, 2 *Cliff.* 379.

The application for a reissue must be accompanied by a surrender of the original patent, or, if that is lost, by an affidavit to that effect, and a certified copy of the patent; but if a reissue be refused, the original patent will, upon request, be returned to the applicant. *Rules of Prac.* No. 90.

### 139. *The Hearing.*

In cases of application for reissue, an original claim, if reproduced in the amended specification, is subject to re-examination, and the entire application will be revised and restricted in the same manner as original applications. *Rules of Prac.* 89.

A patentee is not entitled to have his patent reissued, unless he shows, by satisfactory evidence, that the error he seeks to have corrected was owing to "inadvertence, accident or mistake, and without any fraudulent or deceptive intention," and states particularly wherein the inadvertence, accident or mistake consisted. *Conklin's Case*, 5 *Pat. Off. Gaz.* 235; S. C., 1 *MacArthur*, 375.

In the case of the surrender for a defective or insufficient specification, under the act of 1836, the commissioner is to decide whether the invention claimed in the original patent and that claimed in the amended one is substantially the same. He is to inquire and ascertain whether the specification is defective or insufficient in point of law or fact, and whether the inventor has claimed more than he has invented, and in each case whether the error has arisen from inadvertency, accident, or mistake, or with a deceptive or fraudulent intention. *Allen v. Blunt*, 3 *Story*, 742; 8 *L. Rep'r*, 165. He is not confined to the claims, nor even to the evidence furnished by the specification, models and drawings accompanying the original application; but any legal proof to show it to be the same invention should be received. Even a statement, in an original patent, that a part is old, or a disclaimer of a part, does not necessarily prevent such part from being claimed in a reissued patent, though it would have that effect if made advisedly. *Hussey v. Bradley*, 5 *Blatchf.* 134; 2 *Fish. Pat. Cas.* 362. The commissioner has no jurisdiction to hear testimony as to what the original

invention was, and to allow the claims and specification to be amended so as to embrace what the proofs show was invented, where the reissue may thus show improvements neither described, suggested, nor indicated in the model, drawings, or specification of the original. *Cahart v. Austin*, 2 *Cliff.* 528.

#### 140. *Powers and Duties of the Commissioner.*

The power of accepting the surrender of the original patent and of granting a reissue of it is confided exclusively to the commissioner, and is to be exercised judicially by him. *Parham v. American Buttonhole, &c. Co.*, 4 *Fish. Pat. Cas.* 468; *Parham v. Machine Co.*, 1 *Leg. Gaz.* 145; *Carew v. Boston Elastic Fabric Co.*, 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; 3 *Cliff.* 356; *Thomas v. Shoe Machinery Co.*, 16 *Pat. Off. Gaz.* 541; *Dunbar v. White*, 15 *Fed. Rep'r*, 747; 4 *Woods*, 116; 23 *Pat. Off. Gaz.* 1446.

The commissioner has power to reissue a patent to cure defects in the specification; but not to cure false statements in the application; as, that the applicant is a citizen, when in fact he is an alien. *Mini v. Adams*, 3 *Wall. Jr.* 20.

It is for the commissioner to decide whether an applicant for a reissue is an assignee within the meaning of the act. *Commissioner of Patents v. Whiteley*, 4 *Wall.* 522.

The power of the commissioner to cancel a patent and issue another for the purpose of correcting an error in it not embraced by the statute authorizing reissue, considered. *Dental Vulcanite Co. v. Wetherbee*, 2 *Cliff.* 555; 3 *Fish. Pat. Cas.* 87.

Under the act of 1836, where a patent was antedated in supposed accordance with the provisions of that act, and upon the express request of the patentee, who acquiesced in and accepted the patent so granted, it was *held* that the commissioner could not subsequently alter the date of the patent, the error, if any, being not merely clerical, but an error of judgment as to his duty and authority under the law. *Re Cushman*, 1 *MacArthur Pat. Cas.* 577.

146. *What Defects in a Patent, warrant a Reissue.*

The statute, only authorizes a reissue when, from an unintentional error in the description of the invention, the patent is invalid or inoperative, or when the claim of the patentee exceeds his invention. *Giant Powder Co. v. California Vigorit Powder Co.*, 4 *Fed. Rep'r*, 720; 6 *Saywer*, 508; 18 *Pat. Off. Gaz.* 1339. Whenever a patent fails to secure all that the patentee was by his specifications entitled to claim, it is inoperative within the meaning of the statute, and he is entitled to a reissue. *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 *Fed. Rep'r*, 509. If a patentee, in the description and claim in his original patent, erroneously set forth something short of his real invention, it is a proper case for a reissue, although his real invention may be fully shown in the drawings and model. *Wilson v. Coon*, 6 *Fed. Rep'r*, 611; 18 *Blatchf.* 532; 19 *Pat. Off. Gaz.* 482. A reissue is not invalid merely because the claim of the original patent was valid, and suit could be sustained thereon. *Ib.*

A reissue is valid when made in order to correct a claim which might not fully secure the invention, and which was so ambiguous as to suggest doubt of its sufficiency; and where the mistake was not so obvious as to be instantly suggested on reading the claim. *Western Union Tel. Co. v. Baltimore, &c., Telegraph Co.*, 25 *Fed. Rep'r*, 30.

Where, on application for a patent, the examiner denied the application on the ground that he deemed certain claims anticipated by a prior device, this is not a "mistake or inadvertence" such as will entitle the assignee of the patentee to a reissue; the remedy in such cases is by appeal. *Putnam v. Hutchinson*, 12 *Fed. Rep'r*, 127; 11 *Biss.* 233; 28 *Int. Rev. Rec.* 177.

Where, upon application for a patent, one of the claims presented is rejected because covered by previous inventions, and thereupon the duly authorized attorney of the applicant orders such claim to be erased and withdrawn, and a patent for the remaining claims is issued and is accepted by the applicant, he is not entitled to a reissued patent containing the claim so erased and withdrawn. There is, under such circumstances, no error arising by inadvertence, accident or mistake, within the meaning of the patent law, which would authorize an application for a reissue. *Re Hatchman*, 3 *Mackey*, 288; 26 *Pat. Off. Gaz.* 738.

Under the act of 1836, whether the defect be in the specification or claim, the patentee may surrender his patent, and, by an amended specification or claim, cure the defect. When the specification or claim is so vague as to be inoperative and invalid, an amendment might give it validity and protect the rights of the patentee against subsequent infringements. *Battin v. Taggart*, 17 *How.* 74. A specification may be insufficient or defective so as to allow a reissue, either by a mistake of law as to what is required to be stated therein in respect to the claim of the inventor, or by a mistake of fact in omitting things which are indispensable to the completeness and exactness of the description of the invention, or of the mode of constructing, or making, or using the same. *Allen v. Blunt*, 3 *Story*, 742; 8 *L. Rep'r*, 165.

The practice of surrendering valid patents and of granting reissues thereon in cases where the original patent was neither inoperative nor invalid, and where the specification was neither defective nor insufficient, condemned. *Burr v. Duryee*, 1 *Wall.* 531; aff'g 2 *Fish. Pat. Cas.* 275.

#### 142. *What Changes may be made by a Reissue.*

No new matter shall be introduced into the reissue specification, nor in case of a machine shall the model or drawings be amended except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake. *Rules of Prac.* No. 87.

It is a legitimate and important function of a reissue of a patent to modify or change the claims of the original patent so as to cover the invention set forth therein. *Westinghouse v. Garden, &c. Air-brake Co.*, 9 *Pat. Off. Gaz.* 538; 2 *Bann. & A. Pat. Cas.* 55. Compare *Cornell v. Downer, &c. Brewing Co.*, 7 *Biss.* 346.

The commissioner may allow the original specification to be amended in the reissue, and he may permit the applicant for a reissue to re-describe his invention, including in the new description and claims not only what was well described before, but also what was suggested or indicated in the original specification, drawings or patent-office model. *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356; 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; *Tucker v. Tucker*,

Manuf. Co., 10 *Pat. Off. Gaz.* 464 ; 4 *Cliff.* 397 ; 2 *Bann. & A. Cas.* 401 ; Draper v. Potomska Mills Corp., 13 *Pat. Off. Gaz.* 276 ; 3 *Bann. & A. Pat. Cas.* 214 ; Woven Wire Mattrass Co. v. Wire Web Bed Co., 8 *Fed. Rep'r*, 87 ; Gold, &c., Tel. Co. v. Wiley, 17 *Fed. Rep'r*, 234 ; 16 *Rep'r*, 129.

In case of a reissue of a patent, the patentee may claim something when he is informed of its importance which he had before described as one mode of making his machine or article. Atwood v. Portland Co., 10 *Fed. Rep'r*, 283 ; 5 *Bann. & A. Pat. Cas.* 533.

The provision of Rev. Stat. § 4916, forbidding amending model and drawings of a machine patent except by each other, does not preclude an amendment which does not affect the claim. Pearl v. Appleton Co., 3 *Fed. Rep'r*, 153 ; 5 *Bann. & A. Pat. Cas.* 553. The specifications for the reissue of a patent may be amended by the model deposited in the patent-office as well as by the drawings. Hendy v. Golden State, &c., Iron Works, 17 *Fed. Rep'r* 515 ; 8 *Sawyer*, 468.

A patent for a combination of old elements may be reissued for a combination of a fewer elements than were contained in the combination originally claimed. Herring v. Nelson, 14 *Blatchf.* 293 ; 3 *Bann. & A. Pat. Cas.* 55 ; Christman v. Rumsey, 17 *Blatchf.* 148 ; 17 *Pat. Off. Gaz.* 903 ; 4 *Bann. & A. Pat. Cas.* 506 ; 58 *How. Pr.* 114.

In the absence of an error arising from inadvertence, accident or mistake, a patent for a machine will not sustain a reissue for a process. Eachus v. Broomall, 115 *U. S.* 489, 529.

Reissued patent in 1879 for an improvement in electric lamps, known as the "clamp patent," considered, and *held* anticipated by the invention of the same clamp in 1876, although only one clamp and one lamp were ever made by the latter inventor, and were used together two and one-half months only ; such use having been public and practical, in ordinary work and with reasonable success. Brush v. Condit, 22 *Blatchf.* 246 ; 20 *Fed. Rep'r*, 826.

The legal effect of the changes which, in various cases, may be introduced into the language of a patent, by surrender and reissue, explained. Dunbar v. White, 4 *Woods*, 116 ; 23 *Pat. Off. Gaz.* 1146 • 15 *Fed. Rep'r* 747.

143. *Dividing a Patent by Reissue.*

The commissioner may, in his discretion cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division of such reissued letters patent. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division ; and the drawing may represent only such part or parts, subject to the provisions of rule 49. Unless it shall be otherwise ordered by the commissioner, all the divisions of a reissue will issue simultaneously ; if there be controversy as to one, the others will be withheld from issue until the controversy is ended, unless he shall otherwise order. *Rules of Prac.* No. 88.

Where a patent claims a combination of several devices, it may be reissued to claim the devices separately, if new and useful, even though the aggregate combination claimed in the original patent was not, by itself, useful, or was even impracticable ; provided the reissue points out how the devices, separately claimed, may be reduced to practical use. *Wheeler v. Clipper Mower, &c., Co.*, 2 *Pat. Off. Gaz.* 442; 10 *Blatchf.* 181; 6 *Fish. Pat. Cas.* 1. But the patent cannot be broadened by reissuing it in divisions any more than if reissued together. *New v. Warren*, 22 *Pat. Off. Gaz.* 587. The thing patented may be separated on the reissue of a reissued patent as on the first reissue. *Selden v. Stockwell Self-lighting Gas-burner Co.*, 9 *Fed. Rep'r*, 390 ; 19 *Blatchf.* 544 ; 20 *Pat. Off. Gaz.* 1377.

Where a patentee has, in his original patent, patented an aggregate of several devices, he may, in obtaining a separate reissue for each device, give the same identical description in each issue, of all the devices in the original. If, in such case, the claim of each reissue is for a distinct and severable part of the invention described and shown in the original patent, the reissues are not open to the objection that there are several patents for the same invention. *Wheeler v. McCormick*, 4 *Pat. Off. Gaz.* 692; 6 *Fish. Pat. Cas.* 551; 11 *Blatchf.* 334. Where an application for reissue for two or more divisions is made whilst the original patent is in existence, the commissioner of patents has power to issue a patent for one or more of the divisions of the reissue application, and subsequently to issue a patent for the remaining divisions, if it be

deemed that otherwise the applicant is entitled thereto. Until such application is ended in all its divisions, the vitality of the original patent continues, so far as required to support that portion of the application which remains undecided. 16 *Op. Att. Gen.* 560

Where an original patent describes a new article made by a new process, the reissue may be in two parts, one for the process, and one for the article of manufacture. *Tucker v. Burditt*, 4 *Bann. & A. Pat. Cas.* 569; *Badische Anilin, &c. Fabrik v. Hamilton Manuf. Co.*, 13 *Pat. Off. Gaz.* 273; 3 *Bann. & A. Pat. Cas.* 235, *Same v. Higgins*, 15 *Blatchf.* 290; 3 *Bann. & A. Pat. Cas.* 462.

A division of the original patent, upon a reissue, into two claims, though unnecessary to effectuate the invention, will not necessarily impair the validity of the reissues. *Salt Manuf. Co. v. Thomas*, 3 *Leg. Gaz.* 316. 1 *Leg. Gaz. Rep'r*, 275.

#### 144. *The Invention must not be Enlarged.*

The general rule that reissued letters patent expanded beyond the claim of the original letters, are void, is sustained by *Miller v. Brass Co.*, 104 *U. S.* 360; *aff'g* 14 *Blatchf.* 282; 12 *Pat. Off. Gaz.* 667; 3 *Bann. & A. Pat. Cas.* 20; *James v. Campbell*, 104 *U. S.* 356; *rev'g* 17 *Blatchf.* 42; 18 *Pat. Off. Gaz.* 979; 8 *Rep'r*, 455; 4 *Bann. & A. Pat. Cas.* 456; *Nye v. Allen*, 23 *Pat. Off. Gaz.* 2328; 15 *Rep'r*, 114; *Lorillard v. McAlpin*, 14 *Fed. Rep'r*, 112; 22 *Pat. Off. Gaz.* 1208; *Dryfoos v. Wiese*, 19 *Fed. Rep'r*, 315; 22 *Blatchf.* 19; 26 *Pat. Off. Gaz.* 639; *Adjustable Window Screen Co. v. Boughton*, 10 *Phila.* 251; 1 *Bann. & A. Pat. Cas.* 327; *Edgerton v. Furst, &c. Manuf. Co.*, 9 *Fed. Rep'r*, 450; 10 *Biss.* 402; 27 *Int. Rev. Rec.* 383; 21 *Pat. Off. Gaz.* 267; *Wood Paper Patent*, 23 *Wall.* 566; *Russell v. Dodge*, 93 *U. S.* 460; *Powder Co. v. Powder Works*, 98 *U. S.* 126; *Ball v. Langles*, 102 *U. S.* 128; *Manufacturing Co. v. Ladd*, *Id.* 408; *Manufacturing Co. v. Corbin*, 103 *U. S.* 786; *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356; 5 *Fish. Pat. Cas.* 90; 1 *Pat. Off. Gaz.* 91; *Rayer, &c., Seaming Machine Co. v. American Printing Co.*, 19 *Fed. Rep'r*, 428; *Tarr v. Webb*, 10 *Blatchf.* 96; 5 *Fish. Pat. Cas.* 593; 2 *Pat. Off. Gaz.* 568; *Meyer v. Maxheimer*, 9 *Fed. Rep'r*, 99; 20 *Blatchf.* 15; 20 *Pat. Off. Gaz.* 1162; *Averill Chemical Paint Co. v. National Mixed Paint Co.*, 9 *Fed. Rep'r*, 462; 20 *Blatchf.* 42; 22 *Pat. Off. Gaz.* 585; *Dunbar v. White*, 4 *Woods*, 116; 23 *Pat. Off. Gaz.* 1146; 15 *Fed. Rev.* 747.



*Vogler v. Semple*, 7 *Biss.* 382 ; 23 *Int. Rev. Rec.* 112 ; 11 *Pat. Off. Gaz.* 923 ; 2 *Bann. & A. Pat. Cas.* 556 ; Driven Well Cases, 16 *Fed. Rep'r*, 387 ; 26 *Pat. Off. Gaz.* 1011.

The privilege of surrendering a patent and obtaining a reissue cannot be extended to afford the patentee an opportunity to expand his exclusive privilege, so as to enable him to suppress an invention made subsequent to his own, which does not conflict with the invention prescribed in the patent which he surrenders. *Gill v. Wells*, 22 *Wall.* 1.

Where a reissued patent is granted upon a surrender of the original, for its alleged defective or insufficient specification, such specification cannot be substantially changed in the reissued patent, either by the addition of new matter or the omission of important particulars, so as to enlarge the scope of the invention, as originally claimed. A defective specification can be rendered more definite and certain, so as to embrace the claim made, or the claim can be so modified as to correspond with the specification ; but, except under special circumstances, this is the extent to which the operation of the original patent can be changed by the reissue. *Russell v. Dodge*, 93 *U. S.* 460 ; *Yale Lock Manuf. Co. v. Scovill Manuf. Co.*, 3 *Fed. Rep'r*, 288 ; 18 *Blatchf.* 248 ; 5 *Bann. & A. Pat. Cas.* 519. By new matter, with reference to the reissue of a composition, is meant not merely the introduction of a new ingredient, but any change in the original specification and claim, whereby a new and substantially different composition is secured. *United States, &c., Felting Co. v. Haven*, 1 *L. & Eq. Rep'r*, 16 ; 2 *Bann. & A. Pat. Cas.* 164. It is in cases where a patent is inoperative or invalid, by reason of a defective or insufficient description, specification, or claim, and not where the device is not described or specified at all, that permission is given to reissue the patent ; devices, not described or specified, may, if they are the invention of the patentee, be the subject of a patent, subject to all other rules governing the inventor's right ; but it is not the office of the reissue to embrace them. *Sarven v. Hall*, 9 *Blatchf.* 524 ; 1 *Pat. Off. Gaz.* 437 ; 5 *Fish. Pat. Cas.* 415.

A reissued patent shown to be broader than the original cannot be sustained by proof that the patentee had invented, before making his original application, all the things added in the reissue, and might rightfully have claimed them at first. *Manufacturing Co. v. Ladd*, 102 *U. S.* 408 ; aff'g 2 *Bann. & A. Pat. Cas.* 488. And see *Atwater Manuf. Co. v. Beecher Manuf. Co.*, 8 *Fed. Rep'r*,

608 ; *Kells v. McKenzie*, 9 *Fed. Rep'r*, 284 ; 20 *Pat. Off. Gaz.* 1363 ; *Dederick v. Cassell*, 9 *Fed. Rep'r*, 306 ; 27 *Int. Rev. Rec.* 400 ; 20 *Pat. Off. Gaz.* 1263. Where it appears, as matter of law, on a comparison of the two instruments, that a reissued patent is not for the same invention as that embraced and secured in the original patent, the reissued patent is invalid. *Sickles v. Evans*, 2 *Cliff.* 203 ; 2 *Fish. Pat. Cas.* 417 ; *Tucker v. Tucker Manuf. Co.*, 10 *Pat. Off. Gaz.* 464 ; 2 *Bann. & A. Pat. Cas.* 201. If a patent, containing a single claim for a combination, is reissued, with the same description as before, but with two claims, the one a repetition of the original claim, and the other for a combination of some of the elements only, the reissue is valid as to the repetition of the original claim but invalid as to the new claim ; to uphold the latter would be to enlarge the claim, which must not be done by reissue. *Gage v. Herring*, 107 *U. S.* 640 ; 2 *Sup. Ct. Rep'r*, 819. Compare *McMurray v. Mallory*, 111 *U. S.* 97 ; *Washburn, &c., Manuf. Co. v. Fuchs*, 16 *Fed. Rep'r*, 661 ; *Terrell v. Bradford*, 15 *Fed. Rep'r*, 808 ; 23 *Pat. Off. Gaz.* 1623.

#### 145. *Illustrations.*

A patent for a machine cannot be broadened on reissue to cover a process described in the original patent ; if the process were patentable it should have been included in the original patent. *New v. Warren*, 22 *Pat. Off. Gaz.* 587. Neither can a patent limited to a product when made in a certain method be expanded to cover the product without reference to the manner in which it is produced. *Vacuum Oil Co. v. Buffalo Lubricating Oil Co.*, 22 *Blatchf.* 266 ; 28 *Pat. Off. Gaz.* 1101.

Where the original patent covers a mechanism to accomplish a specific result, and the reissued patent covers the process by which that result is attained, without regard to the mechanism used to accomplish it, the reissue is broader than the original patent, for it covers every mechanism which can be contrived to carry on the process ; it is, therefore, void. *Bedford v. Burton*, 106 *U. S.* 338 ; 1 *Sup. Ct. Rep'r*, 98 ; *Powder Co. v. Powder Works*, 98 *U. S.* 126 ; rev'g 3 *Sawyer*, 448 ; 2 *Bann. & A. Pat. Cas.* 131 ; *James v. Campbell*, 104 *U. S.* 356 ; rev'g 17 *Blatchf.* 42 ; 18 *Pat. Off. Gaz.* 979 ; 8 *Rep'r*, 455 ; 4 *Bann. & A. Pat. Cas.* 456. The patentee may not strike out the entire description of one of the ingredients of a combination, and insert in lieu thereof a descrip-

tion of other devices, unless it be alleged that such other devices are equivalents of the device stricken out. *Tucker v. Tucker Manuf. Co.*, 10 *Pat. Off. Gaz.* 464.

A patent granted for a combination, one element of which was described in the specification as being adapted by its shape to perform specified functions, was surrendered and a reissue taken which expanded some of the claims so as to cover any form of this element, whether adapted to perform these functions, or not. It was *held* that as to these expanded claims the reissue was void. *McMurray v. Mallory*, 111 *U. S.* 97.

When divisional reissues are granted for a part of the original invention, they must not contain anything substantially new or different; thus original letters for a process will not support reissued letters for a composition, unless it is the result of the process, and the invention of the one involves the invention of the other; so letters granted for certain processes of exploding nitro-glycerine will not support reissued letters for a composition of nitro-glycerine and gunpowder or other substances, even though the original application claimed the invention of the process and the compound; these are distinct inventions. *Powder Co. v. Powder Works*, 98 *U. S.* 126; *rev'g* 3 *Sawyer*, 448; 2 *Bann. & A. Pat. Cas.* 131.

Where the specification of the original patent suggested no invention, save the one contained in the entire combination, the claim in the reissue for a lesser number of elements than it embraced was declared void. Had it been intimated in the original patent that the lesser number of elements could be used in combination, this would have justified a claim to them on reissue; but without such suggestion the claim was invalid, for departure from the original invention. *Miller v. Bridgeport Brass Co.*, 14 *Blatchf.* 282; 12 *Pat. Off. Gaz.* 667; 3 *Bann. & A. Pat. Cas.* 20. See *affirmance*, 104 *U. S.* 350.

When form is of the substance of an invention it is not to be disregarded; thus where the original invention was for a particular form of wooden bushing, wooden bushings having been previously patented, a broad claim in a reissue for any form of wooden bushings was *held* invalid. *New York Bung, &c. Co. v. Hoffman*, 9 *Fed. Rep'r*, 199; 20 *Pat. Off. Gaz.* 1451; 20 *Blatchf.* 3.

Where the patent was for a process of treating bark-tanned lamb or sheep-skin, by means of a compound in which heated fat liquor was an essential ingredient, and a change was made in the

original specification, by eliminating the necessity of using the fat liquor in a heated condition, and making, in the new specification, its use in that condition a mere matter of convenience, and by inserting an independent claim for the use of fat liquor in the treatment of leather generally, the character and scope of the invention as originally claimed were held to be so enlarged as to constitute a different invention. *Russell v. Dodge*, 93 *U. S.* 460.

#### 146. *Scope and Limits of the above Rule.*

Where the amended specification and new claim only secure to the applicant what he had originally described, the reissue is valid. *Richardson v. Lockwood*, 4 *Cliff.* 128; *Wells v. Gill*, 6 *Fish. Pat. Cas.* 574; *Draper v. Wattles*, 16 *Pat. Off. Gaz.* 629; 3 *Bann. & A. Pat. Cas.* 618; *Putnam v. Yerrington*, 9 *Pat. Off. Gaz.* 689; 2 *Bann. & A. Pat. Cas.* 237.

Upon reissue of a patent, the claim may be enlarged where there was clearly mistake or inadvertence and no unreasonable delay in applying for the correction, and no rights of others have intervened. *Wooster v. Handy*, 21 *Fed. Rep'r*, 51; *Odell v. Stout*, 22 *Fed. Rep'r*, 159; 29 *Pat. Off. Gaz.* 862. The mistake must not be from mere error of judgment, but a *bona fide* mistake inadvertently committed, such as a court of chancery, in cases within its ordinary jurisdiction, would correct. *Jones v. Barker*, 11 *Fed. Rep'r*, 597; 22 *Pat. Off. Gaz.* 771.

A reissue may be had for any invention substantially described, though not claimed, in the original specification. *Pennsylvania Salt Manuf. Co. v. Thomas*, 8 *Phila.* 144; 5 *Fish.* 149. See *McArthur v. Brooklyn Railway Supply Co.*, 19 *Fed. Rep'r*, 263; *Lorillard v. McDowell*, 11 *Pat. Off. Gaz.* 640; *Combined Patents Can Co. v. Lloyd*, 11 *Fed. Rep'r*, 149; 21 *Pat. Off. Gaz.* 713. Or whatever was substantially suggested or indicated in the surrendered specifications, drawings or patent-office model. *Stevens v. Pritchard*, 4 *Cliff.* 417; 10 *Pat. Off. Gaz.* 505; 2 *Bann. & A. Pat. Cas.* 390. Compare *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673; *Stephenson v. Second Ave. R. R. Co.*, 5 *Bann. & A. Pat. Cas.* 116; *Meyer v. Goodyear's India Rubber Glove Manuf. Co.*, 22 *Pat. Off. Gaz.* 681; *Seymour v. Marsh*, 6 *Fish. Pat. Cas.* 115; 9 *Phila.* 330; *Reissner v. Anness*, 13 *Pat. Off. Gaz.* 870.

It is of no consequence that a reissue states that certain con-

binations are found in the machine which will act in a certain way and effect certain results, when the original did not contain these statements, provided the combinations in fact existed in a machine made according to the drawings and description in the original patent, or provided the modes of operation and results in fact followed in a machine so made. *Potter v. Stewart*, 7 *Fed. Rep'r*, 215; 18 *Blatchf.* 561; 19 *Pat. Off. Gaz.* 997.

The reissue of a patent in which nothing more is done than to make a correction in the description in the original patent, without any enlargement of claim or material variation in terms, and where the effect is identical, is valid. *Sewing Machine Co. v. Frame*, 24 *Fed. Rep'r*, 596; 28 *Pat. Off. Gaz.* 96.

Where the patentee, when he applied for his patent, evidently attached more importance to one form of his invention than the other, but afterward changed his opinion and reissued, laying more stress on the second form, it was *held*, that such modification of opinion on his part did not disturb the fact that both forms were described, though imperfectly, in his first specifications. *American Nicolson Pavement Co. v. Elizabeth*, 6 *Fish. Pat. Cas.* 424.

Where the claim in a reissue, while differing verbally from the claim in the original patent, is substantially and in legal effect a mere repetition of that claim, the claim in the reissue may be sustained. *National Pump Cylinder Co. v. Gunnison*, 17 *Fed. Rep'r*, 812. If new claims in the reissue are only restatements of the functions and mode of operation of the elements of one of the claims of the original, in combination with the other parts of the machine, then they are valid. *Fay v. Fraser*, 11 *Biss.* 422.

The original patent having called the absorbent material with which the nitro-glycerine was mixed, "inexplosive," it was *held*, that to omit the term upon reissue was no enlargement of the invention. The word was ambiguous, since it was clear from the original description that the patentee did not contemplate the use of materials which, though explosive, were not so in comparison and under like conditions with nitro-glycerine. *Atlantic Giant Powder Co. v. Goodyear*, 13 *Pat. Off. Gaz.* 45.

Whether a reissued patent is (as it always should be) for the same invention as the original, is a question, not of fact, but of legal construction of the two instruments. *Stevens v. Pritchard*, 4 *Cliff.* 417; 10 *Pat. Off. Gaz.* 505; 2 *Bann. & A. Pat. Cas.* 390; *Tucker v. Tucker Manuf. Co.*, 10 *Pat. Off. Gaz.* 464; 4 *Cliff.* 397; 2 *Bann. & A. Pat. Cas.* 401.

147 *Effect of the Commissioner's Decision : Presumptions.*

The action of the commissioner of patents in accepting a surrender and granting a reissue of letters-patent is judicial in its character, and presumed correct, but is not conclusive upon the court. *Flower v. Rayner*, 5 *Fed. Rep'r*, 793 ; 19 *Pat. Off. Gaz.* 425 ; 11 *Rep'r*, 555. It is final and conclusive as to all matters of fact involved in the hearing of the application (*Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171 ; 3 *Bann. & A. Pat. Cas.* 539), and as to the mere necessity of a reissue (*Smith v. Merriam*, 6 *Fed. Rep'r*, 713 ; 19 *Pat. Off. Gaz.* 601. Compare *Conklin's Case*, 1 *MacArthur*, 375 ; 5 *Pat. Off. Gaz.* 235); but it is not conclusive as to his own jurisdiction (*Cahart v. Austin*, 2 *Cliff.* 528. Compare *Whitley v. Swayne*, 4 *Fish. Pat. Cas.* 117 ; *Giant Powder Co. v. California Vigorit Powder Co.*, 4 *Fed. Rep'r*, 720 ; 6 *Sawyer*, 503 ; 18 *Pat. Off. Gaz.* 1339), nor as to the reasonableness of the delay. *Wollensak v. Recher*, 115 *U. S.* 96.

The correct performance of all those preliminaries on which the validity of a reissued patent depends is always examinable in the court in which a suit for its violation is brought. *Odell v. Stout*, 22 *Fed. Rep'r*, 159.

The general rule is that the decision of commissioner of patents is conclusive in a suit for infringement, unless it is apparent on the face of the patent that he has exceeded his authority. *Wells v. Gill*, 2 *Pat. Off. Gaz.* 590 ; 6 *Fish. Pat. Cas.* 89. *S. P., American Nicolson Pavement Co. v. Elizabeth*, *Id.* 424 ; *Spaeth v. Barney*, 22 *Fed. Rep'r*, 828 ; 30 *Pat. Off. Gaz.* 997.

The commissioner's authority being limited to a reissue for the same invention, the two patents may be compared to determine the identity of the invention. If the reissued patent, when thus compared, appears on its face to be for a different invention, it is void, the commissioner having exceeded his authority in issuing it. *Russell v. Dodge*, 93 *U. S.* 460 ; *Sickles v. Evans*, 2 *Fish. Pat. Cas.* 417 ; 2 *Cliff.* 203 ; *Cahart v. Austin*, 2 *Fish. Pat. Cas.* 543 ; *Swift v. Whisen*, 2 *Bond*, 115 ; 3 *Fish. Pat. Cas.* 343 ; *Goodyear v. Berry*, *Id.* 189 ; 3 *Fish. Pat. Cas.* 439.

The decision of the commissioner can only be impeached in the courts on the ground of, 1. Fraud or collusion between the commissioner and the applicant ; 2. An excess of authority on the part of the commissioner, apparent on the face of the patents ; or, 3. A

clear repugnance between the new and old patent. *House v. Young*, 3 *Fish. Pat. Cas.* 335; *Hussey v. Bradley*, 5 *Blatchf.* 134; 2 *Fish. Pat. Cas.* 362; *Blake v. Stafford*, 6 *Blatchf.* 195; 3 *Fish. Pat. Cas.* 294; *Swift v. Whisen*, 2 *Bond*, 115; 3 *Fish. Pat. Cas.* 343; *Crompton v. Belknap Mills*, 3 *Fish. Pat. Cas.* 536; *Jordan v. Dobson*, 2 *Abb. U. S.* 398; 7 *Phila.* 533; *Stimpson v. Westchester R. R. Co.*, 4 *How.* 380, 404; *Battin v. Taggart*, 17 *How.* 74; *Woodworth v. Stone*, 3 *Story*, 749; *Reissner v. Anaess*, 13 *Pat. Off. Gaz.* 870; *Miller, &c. Manuf. Co. v. Du Brul*, 12 *Pat. Off. Gaz.* 351; 2 *Bann. & A. Pat. Cas.* 618; *Andrews v. Wright*, 6 *Rep'r*, 193.

Some cases hold that the action of the commissioner is conclusive against a charge of fraud in obtaining the reissue, as well as all other objections, unless it appears upon the face of the papers that the new patent is not for the same invention as the original. *La Baw v. Hawkins*, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; *Milligan, &c. Glue Co. v. Upton*, 6 *Pat. Off. Gaz.* 837; *Union Paper Collar Co. v. White*, 7 *Pat. Off. Gaz.* 698, 877. To justify the rejection of a reissue, therefore, on the ground of "new matter," it must clearly appear that such matter has been introduced. Nothing plainly embraced in the specifications, model or drawings of the original, is "new matter." *Dederick v. Cassell*, 9 *Fed. Rep'r*, 306; 27 *Int. Rev. Rec.* 400; 20 *Pat. Off. Gaz.* 1233. Compare *Kells v. McKenzie*, 9 *Fed. Rep'r*, 284; 20 *Pat. Off. Gaz.* 1663.

An objection to the validity of a reissued patent that the surrendered patent was not inoperative by reason of a defective specification, on which ground the application for a reissue was made, is conclusively decided by the commissioner's granting the reissue, and will not be reviewed by the circuit court. *Selden v. Stockwell Self-lighting Gas-burner Co.*, 9 *Fed. Rep'r*, 390; 19 *Blatchf.* 544; 20 *Pat. Off. Gaz.* 1377; *Kerosene Lamp Heater Co. v. Littell*, 3 *Bann. & A. Pat. Cas.* 312; 1 *N. J. L.* 195.

When the commissioner has decided that an applicant for a reissue is not an assignee within the meaning of the act of 1836, a mandamus will not lie commanding him to refer the application to "the proper examiner, or otherwise examine or cause the same to be examined according to law;" the preliminary question was within the scope of his authority. *Commissioner of Patents v. Whiteley*, 4 *Wall.* 522.

The granting of a reissue is *prima facie* evidence of inadvert-

tence, accident or mistake, as the granting of original letters is *prima facie* evidence of invention. *Odell v. Stout*, 22 *Fed. Rep'r.*, 159.

It is the duty of the commissioner to see that a reissued patent does not cover more than the original one; and the presumption is, until the contrary appears, that it does not. *O'Reilly v. Morse*, 15 *How.* 62, 112. Compare *Tatham v. Lowber*, *Mir. Pat. Off.* 146; *Stevens v. Pritchard*, 4 *Cliff.* 417; 10 *Pat. Off. Gaz.* 505; 3 *Bann. & A. Pat. Cas.* 390; *Jordan v. Dobson*, 2 *Abb. U. S.* 398; 7 *Phila.* 533; *Guidet v. Barber*, 5 *Pat. Off. Gaz.* 149; *Morris v. Royer*, 2 *Bond*, 66; *Smith v. Whisen*, *Id.* 115; 3 *Fish. Pat. Cas.* 343; *Bantz v. Elsas*, 6 *Fish. Pat. Cas.* 117; *Chicago Fruit House Co. v. Busch*, 4 *Fish. Pat. Cas.* 395. But such inference or presumption in respect to identity may be rebutted by evidence, which should be submitted to the jury. *Allen v. Blunt*, 2 *Woodb. & M.* 121, 139.

In an action for an infringement, the duty devolves upon the court to determine whether the reissue claims more than the original specification shows the patentee to have invented. *Woodward v. Dinsmore*, 4 *Fish. Pat. Cas.* 163. Compare *Parham v. Machine Co.*, 1 *Leg. Gaz. Rep.* 145.

When as a defense to a reissue patent, it is set up that the reissue covers more than was embraced in the original, the respondent must introduce in evidence the original to support the allegation; otherwise it will be assumed that the invention described in the reissue is the same as that secured by the original. *Doherty v. Haynes*, 4 *Cliff.* 291; 6 *Pat. Off. Gaz.* 118; 1 *Bann. & A. Pat. Cas.* 289.

Reissued patent, *held* valid, notwithstanding errors apparent on its face in stating the number of the surrendered patent for which it was re-issued, and in expressing the claim. *Reed v. Street*, 34 *Pat. Off. Gaz.* 339.

#### 148. *Validity of Reissued Patents.*

A reissue can only be impeached for fraud by a bill in equity brought for the purpose by the government. *Birdsell v. McDonald*, 6 *Pat. Off. Gaz.* 682.

The fact of procuring a patent for a machine under the assumption of a reissue, which was not useful as patented in the surrendered



patent, for want of some parts used in the reissued patent, would present a question of fraud committed on the public by the patentee, by giving his reissued patent date as an original discovery, made at the time of the original patent, and thereby overreaching similar inventions made between the time of the original patent and the time of the reissued patent. *Brooks v. Fiske*, 15 *How.* 212.

A reissued patent need not contain any recitals that the prerequisites to the grant of it,—as, that it was reissued for errors arising not from inadvertency, accident, or mistake,—have been duly complied with; for the law makes the presumption that they have been. *Philadelphia & Trenton R. R. Co. v. Stimpson*, 14 *Pet.* 446, 458.

A reissued patent is not the less valid because it contains a full account of processes, which, although adverted to in the original, were not described at length, because they were well known in the art. *Goodyear Dental Vulcanite Co. v. Smith*, 5 *Pat. Off. Gaz.* 585; 1 *Holmes*, 354.

Where the reissue covers only claims which do not appear on the face of the original, it is invalid. *Singer Manuf. Co. v. Goodrich*, 15 *Fed. Rep'r*, 455.

It is no objection to the validity of a reissue, that the object of it was to extend the monopoly secured by the patent beyond the limits assigned to it by a judicial decision upon it in its original form. *Poppenhusen v. Falke*, 5 *Blatchf.* 46; 2 *Fish. Pat. Cas.* 213.

A reissue is not invalidated by immaterial difference between it and the original. *McCreary v. Pennsylvania Canal Co.*, 26 *Int. Rev. Rec.* 379; 10 *Rep'r*, 723; S. C., *sub nom.* *McCrary v. Pennsylvania Canal Co.*, 5 *Fed. Rep'r*, 367. See, also, *Smith v. Mercer*, 5 *Pa. L. J.* 529.

A reissue of a patent is not void for stating modes of operating the invention not stated in the original, the invention being the apparatus or combination of parts and not any particular instrumentality by which it is operated. *Broadnax v. Central Stock Yard, &c. Co.*, 5 *Bann. & A. Pat. Cas.* 609; 4 *Fed. Rep'r*, 214; 11 *Rep'r*, 6.

A reissued patent to John Deuchfield is not void because the original was granted to John Denchfield, the change of the letter being a clerical mistake. *Bignall v. Harvey*, 4 *Fed. Rep'r*, 334; 18 *Blatchf.* 353; 18 *Pat. Off. Gaz.* 1275; 5 *Bann. & A. Pat. Cas.* 636.

A reissued patent may be valid, notwithstanding the invalidity of one of its claims, if it appears that such claim was made in good faith by the inventor, and was not intended to broaden the original claims for the purpose of covering intermediate inventions or improvements. *Odell v. Stout*, 22 *Fed. Rep'r*, 159; 29 *Pat. Off. Gaz.* 862.

A reissue granted on an application made after unreasonable delay, and for the purpose of enlarging the specification and claims in order to bring within the exclusive privilege an invention, patented after the original patent was granted, is void as to the new claims. *Torrent Arms Lumber Co. v. Rodgers*, 112 *U. S.* 659.

#### 149. *Reissued Patents void in Part only.*

Although the reissue of a patent may be void as to new or expanded claims, it may be good as to claims not expanded or which do not show a different invention from the original patent. A patentee may recover on an infringement of the valid claim. *Havemeyer v. Randall*, 21 *Fed. Rep'r*, 404; *Havemeyer v. Bonnell*, *Id.* 406; *Gage v. Herring*, 107 *U. S.* 646; 2 *Sup. Ct. Rep'r*, 819; *Worden v. Searls*, 21 *Fed. Rep'r*, 406; *Gould v. Spicer*, 15 *Fed. Rep'r*, 344; *Cote v. Moffitt*, *Id.* 345; *Starrett v. Athol Machine Co.*, 14 *Fed. Rep'r*, 910; 23 *Pat. Off. Gaz.* 1729; *Reay v. Raynor*, 19 *Fed. Rep'r*, 308; *Dryfoos v. Wiese*, *Id.* 315; *Wood v. Packer*, 17 *Fed. Rep'r*, 650.

When a patent is reissued in several divisions, no one of them is void merely because they, every one, describe all the mechanism shown in the original, provided the claim in each is for a different device which is already described, and there is no conflict between them. *Wheeler v. McCormick*, 4 *Pat. Off. Gaz.* 692; 11 *Blatchf.* 334; 6 *Fish. Pat. Cas.* 551.

#### 150. *Grounds on which they may be adjudged Void.*

Reissued patent declared invalid because the affidavit filed to obtain it was not drawn in compliance with the statute. *Poage v. McGowan*, 15 *Fed. Rep'r*, 398.

Whenever the power of reissue has been fraudulently or corruptly abused, the renewal will be avoided. *Woodworth v. Edwards*, 3 *Woodb. & M.* 120.

An application for a patent was rejected because of want of novelty, on reference to a prior invention; but on a re-application it was granted because of a disclaimer by the patentee of certain claims made on the prior application; it was *held*, that a reissue to the assignee of the inventor, on claims including those disclaimed by the prior patentee, is invalid as to such claims. *Putnam v. Hutchinson*, 12 *Fed. Rep'r*, 127; 11 *Biss.* 233; 28 *Int. Rev. Rec.* 177.

Where, upon the application for a patent for an improvement in cotton presses, a claim of the applicability of the invention to a certain class of presses was abandoned; it was *held*, that a reissue of the patent by which the invention was made applicable to that class of presses was improper and void. *Wicks v. Stevens*, 2 *Woods*, 310; 2 *Bann. & A. Pat. Cas.* 318.

On an application by J., as assignee of a patent, for a reissue, the commissioner declared an interference between it and a patent previously issued to S., and rendered his decision in favor of S. On appeal, the decision of the commissioner was reversed and a reissue ordered to J. Before the reissue was granted, the owner of a patent issued to W., prior to the application of J., applied to the commissioner to declare an interference between it and the application of J. The interference was declared, and the commissioner decided in favor of the patent to W. On appeal by J. from this decision, the second interference was held to have been wrongfully declared, on the ground that no second interference could be declared under the statute (act of 1836, § 8), and the reissue to J. was peremptorily ordered. The reissue was granted, and the owner of the patent to W. then filed a bill against the owners of the reissued patent to J., to have that patent declared void. On an application for a preliminary injunction,—it was *held*, that the order declaring the second interference and directing the reissue to J. was a nullity, and the reissued patent void; and the injunction was granted. *Potter v. Dixon*, 5 *Blatchf.* 160.

### 151. *Construction and Effect of reissued Patents.*

A reissued patent has the same effect and operation in law as though it had been originally filed in the corrected form, only on the trial of actions brought on it for causes thereafter arising, and has no such effect in any other case, or for any other purpose. *United States Stamping Co. v. King*, 7 *Fed. Rep'r*, 830; 17

*Blatchf.* 55 ; 17 *Pat. Off. Gaz.* 1399 ; 4 *Bann. & A. Pat. Cas.* 469.

The correction of the patent by reissue relates back, and, except as to suits for infringements before the reissue, it operates from the date of the original. *Woodworth v. Hall*, 1 *Woodb. & M.* 248 ; 6 *Pa. L. J.* 178 ; *Stanley v. Whipple*, 2 *McLean*, 35 ; *Smith v. Pearce*, *Id.* 176 ; *Bloomer v. Stolley*, 5 *McLean*, 158 ; 8 *West. L. J.* 158 ; *Grant v. Raymond*, 6 *Pet.* 218. And being only a continuation of the first one, the rights of the patentee are to be ascertained by the law under which the original application was made. *Shaw v. Cooper*, 7 *Pet.* 292, 315.

Where in the case of a reissued patent, the complainants had adopted the surrender and accepted the new patent, it was held, that they were estopped from denying either the authority of the applicant, or that of the commissioner. *Dental Vulcanite Co. v. Wetherbee*, 2 *Cliff.* 555 ; 3 *Fish. Pat. Cas.* 87.

Where one paragraph in a reissue specification would seem to lead to a construction which would make void the reissue, explanation of its meaning may be sought in a succeeding one. *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356 ; 1 *Pat. Off. Gaz.* 91 ; 5 *Fish. Pat. Cas.* 90.

Where the process and purpose are plainly suggested and understood, and the language in an original specification is suggestive of new terms and names used in the reissue, such new names and terms do not show that the reissue is descriptive of an invention different from that set out in the original. *Ib.*

If a patentee uses certain words in his first specification and afterwards withdraws them in his amended specification in a reissued patent, he is not estopped by the words which have been so withdrawn and canceled. *Allen v. Blunt*, 2 *Woodb. & M.* 121, 143.

Reissuing a patent which has been adjudged void for want of novelty cannot give it validity. *Jones v. McMurray*, 2 *Hughes*, 527 ; 3 *Bann. & A. Pat. Cas.* 130. Nor will the invalidity of a claim in a reissue impair the validity of a claim in the original patent which is repeated and separately stated in the reissue. *Schillinger v. Greenway Brewing Co.*, 17 *Fed. Rep'r*, 244 ; 24 *Pat. Off. Gaz.* 495 ; *Fetter v. Newhall*, 17 *Fed. Rep'r*, 841 ; 25 *Pat. Off. Gaz.* 502 ; 16 *Rep'r*, 360.

The novelty of a patented invention is not impeached by a prior patent which did not originally describe the invention, but has since been enlarged by reissue so as to include it. *Vogler v. Semple*, 7

*Biss.* 382; 11 *Pat Off. Gaz.* 923; 23 *Int. Rev. Rec.* 112; 2 *Bann. & A. Pat. Gaz.* 556.

Where, by a prior decision of a case involving the validity of a patent, it was decided that the present reissue was not patentable by reason of an earlier patent, argument against the propriety of such decision will not be entertained. *Meyer v. Goodyear India-Rubber Manuf. Co.*, 11 *Fed. Rep'r*, 891; 20 *Blatchf.* 91.

Features of an invention which have been disclaimed by the patentee on applying for and obtaining a patent cannot be afterward secured by surrendering the patent and taking a reissue embracing them. If such reissued patent is erroneously granted by the commissioner, it will not sustain a suit for infringement of the parts of the invention originally disclaimed. *Leggett v. Avery*, 101 *U. S.* 256.

Where an inventor inserts a description of a modified or improved form in an application for reissue, and is required, by the commissioner of patents, to disclaim this description as a condition precedent to granting of the reissue, he is not estopped from enjoining the use of machines containing such modification or improvement. The admission or disclaimer is not of a fact of invention, but of the propriety of inserting a certain clause in the descriptive part of the specification. If the patentee's invention and his patent rightly included a certain form as an equivalent, it was a mere nullity to confess that it did not include it. *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 7 *Fed. Rep'r*, 344.

Where a patentee invented an apparatus for breaking coal, and combined it with an apparatus for screening coal, which he did not invent, and took a patent for the combination only, and afterward took a patent for the breaking apparatus, and then surrendered both patents and took one for the breaking apparatus alone; it was *held*, that his describing and not claiming the breaking apparatus in his first patent and the surrender and cancellation of the second did not deprive him of his right to a patent for the breaking apparatus. *Battin v. Taggart*, 17 *How.* 74. And see 2 *Wall. Jr.* 101.

**XII. DISCLAIMERS. INTERFERENCE SUITS.**152. *Disclaimers authorized.*

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented ; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the patent-office ; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. *Rev. Stat. § 4917.*

See also *Rev. Stat. § 4922* ; which is as follows :

Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest

in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was *bona fide* his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the patent-office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

*Rev. Stat. § 973* also provides :

When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the patent office before the suit was brought.

### 153. *Nature and Uses of a Disclaimer.*

The disclaimers mentioned in section 4917 must be distinguished from those which are embodied in original or reissue applications, as at first filed or subsequently amended, referring to matter shown or described, but to which the disclaimant does not choose to claim title ; and also from those made to avoid the continuance of interferences, which require no fee, but must, like all other disclaimers, be signed by the applicants in person and duly witnessed. *Rules of Prac. No. 168.*

When an applicant makes two or more applications relating to the same subject matter of invention, all showing, but only one claiming, the same thing, those not claiming it must contain disclaimers thereof, with references to the application claiming it.

The law requiring and permitting a patentee to disclaim is not penal, but remedial. It is intended for the protection of the patentee as well as the public, and should not receive a construction

that would restrict its operation within narrower limits than the words of the law fairly import. Whether a patent is illegal in part because of claiming more than the inventor has described, or more than he has invented, the patentee must in either case disclaim in order to save the portion to which he is entitled; and he is allowed to do this when the error was committed by mistake. *O'Reilly v. Morse*, 15 *How.* 61, 121.

Where, in a disclaimer, the party states that he was the patentee, and nothing is said in respect to a transfer of any interest, the fair presumption is, that he still owns the whole; and it is a sufficient compliance with the requirement of the act of 1837,—that the party making a disclaimer should state the extent of his interest in the patent,—to say “that such disclaimer is to operate to the extent of his interest therein.” *Silsby v. Foote*, 14 *How.* 218; *aff'g 1 Blatchf.* 445.

It is not competent for a patentee who has surrendered his letters-patent and made oath that he believes that by reason of an insufficient or defective specification the surrendered letters are inoperative and void, and has taken out reissued letters on a new specification and for new claims, to abandon the reissue and resume the original patent by a disclaimer. *McMurray v. Mallory*, 111 *U. S.* 97.

Where a patent for the infringement of which suit is brought, appears to cover separate and distinct inventions, without connection between them, either in purpose, design or operation, other than that all are designed for use upon the same article, each being a distinct improvement, the court may, as a condition of granting the relief sought, require the complainants to file in the patent-office a disclaimer of all the claims except that alleged to be infringed. *Sessions v. Romadka*, 21 *Fed. Rep'r*, 124.

An acquiescence in a decision requiring a disclaimer as a condition precedent to granting a patent (here, an extension) and filing a disclaimer pursuant to it, are as operative to estop the disclaimant from afterward recovering on the invention disclaimed as from claiming it on a subsequent reissue. *Cartridge Co. v. Cartridge Co.*, 112 *U. S.* 624, 644.

Justice BLATCHFORD suggests that “the word ‘claimant’ is an evident error\* for disclaimant.” *Ib.*

\* As one of the late commissioners to revise the statutes, I will say that I do not remember whether the board had special discussion over the word “claimant” in this section; but I think it is correct. The sense is, *the person claiming the inven-*



What persons, under act of 1870, c. 230, § 54 (Stat.) 205, might make a disclaimer, of what, and its effect, explained. *Ib.*

Limitations and provisos introduced by an inventor into his application, especially if it has been rejected, must be deemed equivalent to disclaimers. *Sargent v. Hall Safe and Lock Co.*, 114 *U. S.* 63.

If the patentee has assigned his patent in part, and a joint suit is brought in equity for a perpetual injunction, a disclaimer by the patentee alone without the assignee's uniting in it will not entitle the parties to the benefit of the act of 1837, §§ 7 and 9. *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54.

Where the thing claimed without right is a part of a machine, if it is not an essential part and was not introduced into the patent through the willful default of the patentee, or with intent to defraud or mislead the public, the want of a disclaimer in regard to it affords no ground for invalidating the patent. *Hall v. Miles*, 2 *Blatchf.* 194.

A disclaimer may embrace subject-matter set up for the first time without right in the reissue patent ; and it may apply not only to the invalid claim, but to statements in the body of the specification upon which the invalid claim or part of claim is founded. The reissue specification is to be thereafter read as if the disclaimer were incorporated in it. *Schillinger v. Gunther*, 17 *Blatchf.* 66 ; 16 *Pat. Off. Gaz.* 905 ; 4 *Bann. & A. Pat. Cas.* 479. Where the statements in the specification and claim of the reissue patent, which the disclaimer seeks to modify, were mistakes in fact and were founded upon experiments made after the date of the original patent, it was *held*, that the disclaimer was lawful both to remedy the misstatements and to save the reissue from impeachment as for a different invention, it appearing that the inventor had acted, throughout, in good faith. *Ib.*

*tion.* In the preceding sentences the statute is speaking of the person filing the disclaimer, and disclaimant is used, properly. In this sentence the sense changes to that of the person who in the "original specification" laid claim to the invention. Were "disclaimant" substituted for "claimant," in this sentence, what would be the force of the clause "to the interest possessed by the disclaimant?"

How can a disclaimant, strictly as such, possess an interest? In so far as he is a disclaimant he disavows interest. Take, also, the words next following: "and by those claiming under him." How can persons be said to "claim under" a disclaimant, as contrasted with a claimant? The change of term corresponds to the change of sense. B. V. A.

Where parts of the thing patented in claims which had been infringed were definitely distinguishable from parts claimed in other claims made by mistake, without any willful default, or intent to defraud or mislead the public, and the complainant had not been unreasonably negligent in not entering a disclaimer,—*held*, that he might, on entering a disclaimer, maintain the suit brought for infringement, but without costs. *Matthew v. Spangenberg*, 10 *Fed. Rep'r*, 823 ; 20 *Blatchf.* 482.

A disclaimer limiting the actual invention of the patentee, the result of an error or mistake on the part of the patent-office, may be omitted in a reissue. *American Shoe Tip Co. v. National Shoe Toe Protecting Co.*, 11 *Pat. Off. Gaz.* 740 ; 2 *Bann. & A. Pat. Cas.* 561.

Where on application for a patent, the specification, as filed, disclaims a certain principle, the generality of such disclaimer will be restricted to the purpose for which it is used, as intended to be considered upon that application ; it will not estop the applicant from subsequently claiming, in another application, the invention so disclaimed. *Hill v. Dunklee*, 1 *MacArthur Pat. Cas.* 475.

#### 154. *Effect.*

Where, upon the purchase of a patent, the purchaser in a reissue of such patent disclaims a portion of the mechanism as insufficient to produce the desired result, a third person has the right to improve such part of the machine by changing its internal form so as to effect a result which the purchaser of the patent, in his reissue, disclaims for it. *Hatch v. Moffitt*, 15 *Fed. Rep'r*, 252.

Where a patentee has defectively or insufficiently described his invention, and claimed more than he has a right to claim as new, he is entitled to a reissue of his patent upon his surrender of the original ; but it is not the office of a disclaimer to reform the description of an invention. *Hailes v. Albany Store* ; 15 *Fed. Rep'r*, 240 ; 24 *Pat. Off. Gaz.* 391 ; 16 *Rep'r*, 65.

Where there are several claims, some of which belong to another, and the part of the invention which is his own can be clearly distinguished from that which is not his own, a disclaimer before suit brought will put him right, and enable him to recover upon his patent as though it had originally been confined to the proper claims ; but he cannot convert a claim for one thing into a claim

for something else, and amend the description to effectuate such claim. *Ib.*

A disclaimer can add nothing to the patent. It can take away from what was described as the invention and claimed as such, so as to be covered by the grant of the patent, but it has no office to make the patent cover any thing, however clearly shown in the patent, not described and claimed as a part of the invention. *White v. E. P. Gleason Manuf. Co.*, 17 *Fed. Rep'r*, 159; 24 *Pat. Off. Gaz.* 205.

If inventions not new or original with the patentee are included in the specification by mistake, accident, or inadvertence, or without willful defraud or intent to defraud or mislead the public, the patent is good and valid for so much of the invention or discovery as is truly and *bona fide* the invention of the patentee. But if no disclaimer be entered in the patent-office before suit is brought, the plaintiff cannot recover costs against the defendant, although infringement of the valid claim be proved. But if, when the patentee applied for a reissue of his original patent, he well knew he was not the first inventor of the invention mentioned in any of his claims, then his patent is void, and no recovery can be had thereon. *Singer v. Walmsley*, 1 *Fish. Pat. Cas.* 558.

A disclaimer of part of an invention cannot affect a prior grantee under the patent, unless he accepts it; he may refuse to be affected by it. *Smith v. Mercer*, 5 *Pa. L. J.* 529.

A motion for a preliminary injunction in a suit for infringement may be granted, notwithstanding the filing by plaintiffs of a disclaimer after suit was brought, if the defendants' rights have not been in any degree prejudiced by the disclaimer. *Libbey v. Mt. Washington Glass Co.*, 26 *Fed. Rep'r*, 757.

### 155. *Neglect or Delay in filing.*

A disclaimer may be made after as well as before a suit for infringement; but the court has power to protect the defendant from surprise, &c., and to take into consideration the fact of delay. *Smith v. Nichols*, 21 *Wall.* 112; *aff'g* 1 *Holmes*, 172; 2 *Pat. Off. Gaz.* 649; 6 *Fish. Pat. Cas.* 61.

The disclaimer, to be effectual under the act of 1837, §§ 6, 7 (now Rev. Stat. § 4922), must be filed in the patent-office before suit is brought. If it is filed during the pendency of the suit, the

plaintiff will not be entitled to the benefit thereof in that suit. Unless it is so filed, the plaintiff will not be entitled to recover costs in such suit, even if he should establish at the trial that a part of the invention not disclaimed has been infringed by the defendant. But whether filed before or after suit brought, the plaintiff will not be entitled to the benefit of a disclaimer if he has unreasonably neglected and delayed to file it. Such neglect or delay is a good defense to the suit. *Reed v. Cutter*, 1 *Story*, 590

Section 7 of the act of 1837 (5 Stat. 193),—providing for the making of a disclaimer when a claim to a patent is too broad,—does not affect a suit pending when the disclaimer is filed, so as to prevent the plaintiff from recovering in it, unless there was unreasonable neglect or delay in filing the disclaimer. *Tuck v. Bramhill*, 6 *Blatchf.* 95 ; 3 *Fish. Pat. Cas.* 400.

Where, on the hearing of a bill to enjoin infringement of a patent, the claim appears too broad, but the complainant offers to disclaim the excess, there may be a decree for an injunction without waiting for filing an actual disclaimer in the patent-office ; but the complainant cannot have costs. *Aiken v. Dolan*, 3 *Fish. Pat. Cas.* 196.

It is not a good objection to the grant of a preliminary injunction under a valid claim, that a disclaimer was not filed as to other claims before suit was brought. Such claims having the sanction of the commissioner, and the question of their validity being one of law, to be ultimately decided by the courts, it cannot be said that the plaintiffs have unreasonably neglected or delayed to enter a disclaimer. *Duff v. Calkins*, 25 *Pat. Off. Gaz.* 601.

A disclaimer in a suit on a patent, under Rev. Stat. § 4922, need not be filed, except where costs are sought, until the court has passed upon the contested claims alleged to contain that of which the patentee was not the inventor. *Stutz v. Armstrong*, 20 *Fed. Rep'r*, 843.

What amounts to unreasonable delay or neglect in filing a disclaimer. *Silsby v. Foote*, 20 *How.* 378 ; modifying 2 *Blatchf.* 278 ; *Seymour v. McCormick*, 19 *How.* 96 ; aff'g 3 *Blatchf.* 209 ; *O'Reilly v. Morse*, 15 *How.* 62.

As to effect upon right to costs, under Rev. Stat. § 4922, of failure to file disclaimer before bringing suit for infringement,—see *Elastic Fabrics Co. v. Smith*, 100 *U. S.* 110 ; aff'g 1 *Holmes*, 340 ; 5 *Pat. Off. Gaz.* 329 ; 1 *Bann. & A. Pat. Cas.* 58 ; *Reed v.*

*Cutter*, 1 *Story*, 590; *Hall v. Wiles*, 2 *Blatchf.* 194; *Aiken v. Dolan*, 3 *Fish. Pat. Cas.* 197; *Stutz v. Armstrong*, 20 *Fed. Rep'r*, 843.

### 156. *Suits touching interfering Patents.*

Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. *Rev. Stat.* § 4918.

Where two patents have been issued, each claiming, broadly, the same invention, and the earlier patentee is held to be the first inventor, the claim in the second patent must be restricted to the particular devices specially described. *Richardson v. Noyes*, 10 *Pat. Off. Gaz.* 507; 2 *Bann. & A. Pat. Cas.* 398.

It is not material to the patentee's right that in the interval of delay, other inventors have devised and patented the same thing, if this was wholly without the knowledge or acquiescence of the first inventor. *Sprague v. Adrianee*, 14 *Pat. Off. Gaz.* 308; 3 *Bann. & A. Pat. Cas.* 124.

In an action under *Rev. Stat.* § 4918, where the plaintiff seeks to have the defendant's patent declared void on the ground that it is for the same invention as, and subsequent to, the plaintiff's patent, a plea in bar which admits the priority of the plaintiff's patent for the same invention, but sets out a fact which would render the plaintiff's patent void for want of novelty, must be over-

ruled, because the fact is immaterial in such proceeding. *Pentlarge v. Pentlarge*, 19 *Fed. Rep'r*, 817.

Where a patentee has been defeated in an interference proceeding and a patent has been granted to the other party on the ground that he was the prior inventor, the defeated party will not be allowed to plead, in an action against him for the continued use of the invention, that neither party was in fact the first inventor, if he acted in bad faith. *Greenwood v. Bracher*, 5 *Bann. & A. Pat. Cas.* 302; 1 *Fed. Rep.* 856; 17 *Pat. Off. Gaz.* 1151.

In a suit against an interfering patentee under Rev. Stat. § 4918, the defendant need not file a cross-bill to obtain affirmative relief. *Lockwood v. Cleveland*, 6 *Fed. Rep'r*, 721; 11 *Rep'r*, 557.

The sole question that can be litigated under Rev. Stat. § 4918, is the question of priority between two interfering patents. *Lockwood v. Cleveland*, 20 *Fed. Rep'r*, 164.

Under the provisions of Rev. Stat. § 4918,—in respect to interfering patents,—the circuit court has authority to adjudge either of the interfering patents void in whole or in part, and, upon proper issues and proof, to authorize a decree that both patents are void. *Foster v. Lindsay*, 3 *Dill.* 123; 2 *Bann. & A. Pat. Cas.* 172.

There is no provision of law whereby in proceedings for relief against owners of an interfering patent, under Rev. Stat. § 4918, persons who are not inhabitants of and cannot be served in the district, can be brought in as defendants; a service of a mere notice that the suit is pending is inoperative. *Liggett, &c. Tobacco Co. v. Miller*, 1 *Fed. Rep'r*, 203; 1 *McCrory*, 31; 17 *Pat. Off. Gaz.* 798; 5 *Bann. & A. Pat. Cas.* 237.

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### XIII. INFRINGEMENT.

#### 157. *Nature of the Right which must not be infringed.*

The invention itself, before the patent is issued, is "property" in the inventor, and continues to be such, without the protection of a patent, until he abandons the same to the public, unless he suffers the patented product to be in public use or on sale, with his consent and allowance, for more than two years before he files his applica-

tion for a patent. *Jones v. Sewell*, 6 *Fish. Pat. Cas.* 343 ; 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630.

But the right which an inventor has to control the exclusive use of his invention after he has suffered it to be used in public, is the creature of the statute ; the supreme court has always held that he has no right upon which he can maintain suit, unless he obtains letters patent according to the statute ; and his right is regulated and measured by the provisions of the act, and cannot go beyond them. *Brown v. Duchesne*, 19 *How.* 183 ; aff'g 2 *Curt.* 371. S. P., *Morton v. New York Eye Infirmary*, 5 *Blatchf.* 110 ; 2 *Am. L. Reg. N. S.* 672 ; 2 *Fish. Pat. Cas.* 320 ; *Waterbury Brass Co. v. Miller*, 9 *Blatchf.* 77 ; 5 *Fish. Pat. Cas.* 48 ; *Sisson v. Gilbert*, *Id.* 109 ; 9 *Blatchf.* 185 ; *Re Brosnahan*, 18 *Fed. Rep'r*, 62. The exclusive right does not rest alone upon the discovery, but also upon the legal sanctions which have been given to it, and the forms of law with which it has been clothed. *Shaw v. Cooper*, 7 *Pet.* 292, 320.

The applicant must bring himself within the terms of the law before he can derive any title to demand or hold a patent. *Pennock v. Dialogue*, 2 *Pet.* 1, 18 ; aff'g 4 *Wash.* 359.

But (in this country) it is a matter of right, on complying with the conditions prescribed by law. *Whitney v. Emmett*, *Baldw.* 303. It is not a "monopoly," but resembles a contract between the government and the inventor, securing to him, for a limited time, the exclusive enjoyment of the practice of his invention, in consideration of his disclosure of the secret to the public, and his relinquishment of his invention to the public at the end of the term (*Attorney-General v. Rumford Chemical Works*, 9 *Pat. Off. Gaz.* 1062 ; *McKeever v. United States*, 14 *Cl. of Cl.* 396 ; 23 *Pat. Off. Gaz.* 1325 ; *Ames v. Howard*, 1 *Summ.* 482 ; *Blanchard v. Sprague*, 3 *Summ.* 535 ; 2 *Story*, 161) ; though it is a contract only as between the parties to it, namely, the United States on one side and the patentee on the other. *Re Brosnahan*, 18 *Fed. Rep'r*, 62.

No right of property vests in the public, in the sense of the 5th amendment of the Constitution, because of the consent of the inventor to the public use of his invention, such as will prevent the subsequent allowance, by act of Congress, of a patent for such invention, unless there was, in a particular case, a reduction of the invention to use and practice, by its embodiment in some apparatus, prior to the issue of such patent. *Page v. Holmes Burglar Alarm Co.*, 1 *Fed. Rep'r*, 304 ; 17 *Blatchf.* 484 ; 17 *Pat. Off. Gaz.* 737 ; 5 *Bann. & A. Pat. Cas.* 165.

But a patent if valid, gives to the patentee a right of property in the thing patented, which is entitled to full protection in the courts. *Whitney v. Emmett*, *Baldw.* 303. And see *Kittle v. Merriam*, 2 *Curt.* 475 ; *Smith v. Pearce*, 2 *McLean*, 176.

Although a patentee was the first to conceive of the convenience and utility of the mechanism patented by him, his right to a patent rests upon the novelty of the means he contrives to carry his idea into practical application. Changes in old instrumentalities, made to adapt them to a use for which they were not originally intended, which involve only the exercise of ordinary mechanical skill, do not sanction the patent. *Aron v. Manhattan R. Co.*, 26 *Fed. Rep'r*, 314 ; 34 *Pat. Off. Gaz.* 1508.

As invention is an intellectual process or conception, he who first makes an invention known sufficiently, by describing it in words or drawings, will be considered to be the first discoverer, and vested with an inchoate right to its exclusive use, which he may embody, perfect and make absolute, by proceeding to mature it in the manner which the law requires. Delay in so doing, caused by poverty of the inventor and his inability to engage in the manufacture of the invention, does not prejudice his rights. *Hill v. Dunklee*, 1 *MacArthur Pat. Cas.* 475.

With respect to cases where one person conceives a new and useful idea, which others co-operate with him in developing, the general rule is that the invention and the patent belong to him who forms the conception, especially if he employs them to assist him, pays their wages, and, generally, furnishes means for carrying on the necessary experiments. *McClurg v. Kingsland*, 1 *How.* 202 ; *Worley v. Tobacco Co.*, 104 *U. S.* 340 ; *Sparkman v. Higgins*, 1 *Blatchf.* 205 ; 5 *N. Y. Leg. Obs.* 122 ; 6 *Pa. La. J.* 344 ; *Soder v. Mills*, 25 *Fed. Rep'r*, 321. Employes may make and patent independent inventions, even though improvements in the machinery used in the employer's business (*Hapgood v. Hewitt*, 11 *Biss.* 184 ; 21 *Pat. Off. Gaz.* 1786 ; 11 *Fed. Rep'r*, 422 ; *Berdan Fire Arms Manuf. Co. v. Remington*, 3 *Pat. Off. Gaz.* 688 ; *Damon v. Eastwick*, 14 *Fed. Rep'r*, 40 ; 14 *Rep'r*, 644 ; 22 *Pat. Off. Gaz.* 1709) ; but assistance rendered to an employer in development of his conceptions ; and suggestions and advice, incidental thereto, do not, in general, give a right under the patent laws. *Agawan Co. v. Jordan*, 7 *Wall.* 583 ; *Pennock v. Dialogue*, 4 *Wash.* 538 ; *aff'd*, 2 *Pet.* 2 ; *Watson v. Bladen*, 4 *Wash.* 580.



158. *Its Scope and Extent.*

Not only is a patentee's right bounded by the law, it is limited by the patent even though the patent is not as broad as the law under which it is issued, yet the right is under the patent, and not under the law. See *Evans v. Eaton*, *Pet. C. Ct.* 322, 340. See reversal, 3 *Wheat.* 454.

An inventor must be assumed to know of what his invention consists, and his patent does not secure him the exclusive right in anything more than he claims to have invented. *Rich v. Close*, 8 *Blatchf.* 41 ; 4 *Fish. Pat. Cas.* 279.

The grant of a patent gives an exclusive right to the patented invention for all uses to which it can be put, whether contemplated by the inventor or not. But the invention must in some way be covered by the patent before he can acquire an exclusive right to it for any purpose. *Tinker v. Wilber Eureka Mower, &c. Co.*, 1 *Fed. Rep'r*, 273 ; 5 *Bann. & A. Pat. Cas.* 92.

A patentee is entitled to all benefits which result from his invention, whether he has specified all the benefits in his patents or not. *California Artificial Stone Paving Co. v. Perine*, 8 *Fed. Rep'r*, 821 ; 7 *Sawyer*, 190 ; 20 *Pat. Off. Gaz.* 813.

In reducing his patent to practical application a patentee is not held to strictly and entirely follow the mere mechanical device shown in his drawings, but he may deviate so long as he does not violate the principle involved in his patent. *Weir v. North Chicago Rolling Mill Co.*, 23 *Pat. Off. Gaz.* 191 ; 14 *Fed. Rep'r*, 42 ; 9 *Biss.* 508.

A patentee is not generally limited by the literal import of his description of his invention, but may, in construction, make such modifications of it as do not involve a departure from its principle, or a material change in its mode of operation. *Grier v. Castle*, 17 *Fed. Rep'r*, 533 ; 24 *Pat. Off. Gaz.* 1176.

A naked principle is not patentable ; nor is the application of the effect of a principle ; the same effect may therefore be produced by various persons by different means without infringement. *Bain v. Morse*, 1 *MacArthur Pat. Cas.* 90 ; *Re Halsey*, *Id.* 459.

A patentee has the right to grant the right to make and sell the patented invention within specified territory, and to make that right exclusive in the grantee, and yet limit the use of the thing so made and sold, within specified limits ; or, while granting to another

a right to make or to make and sell, he may retain to himself the exclusive right to make and sell for export or use in other countries. *Dorsey, &c. Rake Co. v. Bradley Manuf. Co.*, 12 *Blatchf.* 202.

The owner of a useful invention has the right to sell it to all who will purchase, subject only to restraint from some party having a conflicting patent. He holds the right from the general law of the land, and needs no act of Congress to enable him to make or vend his article, and obtains no such right from Congress. He obtains from the patent laws only the power to restrain another from unlawfully making, using or vending his invention. *Celluloid Manuf. Co. v. Goodyear Dental Vulcanite Co.*, 13 *Blatchf.* 375; 10 *Pat. Off. Gaz.* 41; 2 *Bann. & A. Pat. Cas.* 334.

The sole object and purpose of the patent laws is to give to the inventor a monopoly of what he has discovered. What is granted to him is the exclusive right; not the abstract right, but the right in him to the exclusion of everybody else. He is not authorized by the patent laws to manufacture and sell the patented article in violation of the laws of the state. His enjoyment of the right may be modified by the exigencies of the community to which he belongs, and regulated by laws which render it subservient to the general welfare, if held subject to State control. *Re Brosnahan*, 18 *Fed. Rep'r*, 62.

One who invents a new machine never used before, and procures letters patent therefor, acquires a monopoly as against all merely formal variations thereof; but if the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete thing, each inventor is entitled only to his own specific form of device. *Railway Co. v. Sayles*, 97 *U. S.* 554.

When an invention is simply an improvement on a known machine, by a mere change of form or of combination of parts, the inventor is entitled only to the specific form of device which he has produced; and he cannot invoke the doctrine of equivalents to suppress other improvements except such as are mere colorable invasions of his own. But where an inventor precedes others, and his machine performs a function never performed by any earlier machine, the court will treat as infringers all who accomplish the same result by substantially the same or substantially equivalent means. *Morley Sewing Machine Co. v. Lancaster*, 23 *Fed. Rep'r*, 344.

An inventor who first applies an old device to a new use is not entitled to the exclusive use of such device when applied in other

mechanisms not analogous to produce a new effect. *Judd v. Babcock*, 8 *Fed. Rep'r*, 695 ; 23 *Pat. Off. Gaz.* 92.

Where a patent clearly shows and describes a machine whose use necessarily involves the production of a certain process, no other person can afterwards patent that process. The patentee is entitled to his mechanism for every use of which it is capable, and there is no invention in the use of an old machine for a new purpose. *New Process Fermentation Co. v. Koch*, 21 *Fed. Rep'r*, 586 ; 29 *Pat. Off. Gaz.* 535.

Although an invention be a primary one and the machine invented be the first practical one for accomplishing the result, and although the patent for it declares that the machine described is only one of different mechanisms contemplated by the patentee which may be effectually employed for carrying out the main feature of his invention, he is entitled only to the exclusive use of the particular contrivance to make the idea practically useful ; the patent does not give an exclusive right to the principle, or to groups of instrumentalities, independent of the mechanism desired. *Morley Sewing Machine Co. v. Lancaster*, 23 *Fed. Rep'r*, 344.

### 159. *How long it endures.*

Congress having power to secure, "for limited times," to inventors, the exclusive right to their discoveries, in consideration of the benefit which the public will derive from the invention after the expiration of the term, whatever was patented to the inventor and enjoyed by the inventor and those operating in any way under him during the term, belongs to the public and is free to all at the expiration of the term. *Wilcox, &c. Sewing Machine Co. v. The Gibbons Frame*, 17 *Fed. Rep'r*, 623 ; 21 *Blatchf.* 431 ; 24 *Pat. Off. Gaz.* 1272 ; *McCormick v. Manny*, 6 *McLean*, 539 ; 4 *Am. L. Reg.* 277. The patentee cannot claim to continue the exclusive use on the ground that the shape, name, design, etc., under which he has been accustomed to sell the invention has become a trademark. *Wilcox, &c. Sewing Machine Co. v. The Gibbons Frame*, *supra* ; *Fairbanks v. Jacobus*, 14 *Blatchf.* 337 ; *Consolidated Fruit Jar Co. v. Dorflinger*, 2 *Am. L. T. N. S.* 571 ; *Singer Manuf. Co. v. Stanage*, 6 *Fed. Rep'r*, 279 ; 2 *McCrury*, 512 ; 11 *Rep'r*, 661 ; *Same v. Riley*, 11 *Fed. Rep'r*, 706 ; *Singer Manuf. Co. v. Larsen*, 8 *Biss.* 151 ; 3 *Bann. & A. Pat. Cas.* 246 ; *Tucker Manuf. Co. v. Boying-*

ton, 9 *Pat. Off. Gaz.* 455 ; *Leclanché Battery Co. v. Western Electric Co.*, 21 *Fed. Rep'r*, 538. But see *Lorillard v. Wight*, 15 *Fed. Rep'r*, 383.

Devices made according to a patent, but which have been made and combined since the expiration of the patent, are not an infringement of the patent, or violative of an injunction order restraining infringements during the term of the patent. *American Diamond Rock-Boring Co. v. Sutherland Falls Marble Co.*, 2 *Fed. Rep'r*, 353 ; 18 *Blatchf.* 148 ; 10 *Rep'r*, 9 ; 5 *Bann. & A. Pat. Cas.* 247.

A patent, bearing date May 15, 1855, does not expire until the last hour of May 15, 1869. *Johnston v. McCullough*, 4 *Fish. Pat. Cas.* 170.

Where, under the acts of July 4, 1836, and March 3, 1839, a patent was taken out for a machine for the manufacture of a specific article, and subsequently, and within two years, patents were granted for the process of manufacturing such article, and also for the product of such process as a new article of manufacture,—it was held, that the patents for the process and product did not terminate with the expiration of the patent for the mechanism, although it might be of no value except to carry on such patent process and manufacture such patent product. *McKay v. Dibert*, 5 *Fed. Rep'r*, 587 ; 19 *Pat. Off. Gaz.* 1351 ; 11 *Rep'r*, 386.

The burden of proof is on a party seeking to limit the duration of a patent, to show the facts which limit it. *American Diamond Rock-Boring Co. v. Sheldon*, 17 *Blatchf.* 303 ; 4 *Bann. & A. Pat. Cas.* 603.

The intent of the act of 1861, declaring that all patents hereafter issued shall remain in force for seventeen years, and repealing inconsistent acts, was simply to increase the duration of all patents thereafter issued, giving to each an additional period of three years. *Siemens v. Sellers*, 23 *Pat. Off. Gaz.* 2234 ; 16 *Fed. Rep'r*, 856.

For the statute and decisions limiting patents for inventions patented abroad, see *Rev. Stat.* § 4887 ; *ante*, pp. 60–65.

### 160. *General Rules for Construction of Patents.*

A patent must be construed and passed upon according to the laws in force at the time of granting it ; the repeal of such acts cannot impair the right of property existing in a patentee. *McClurg v. Kingsland*, 1 *How.* 202 ; *Hogg v. Emerson*, 6 *How.* 437, 479 ; *aff'g* 2 *Blatchf.* 1.

Patents are to be construed in a liberal manner, so as to give them effect, and to secure the rights of the patentees. *Grant v. Raymond*, 6 *Pet.* 218; *Simpson v. Wilson*, 4 *How.* 709; *Turrill v. Michigan Southern, &c. R. R. Co.*, 1 *Wall.* 491; *Ames v. Howard*, 1 *Sumn.* 482; *Blanchard v. Sprague*, 3 *Sumn.* 535; 2 *Story*, 264; *Ryan v. Goodwin*, *Id.* 514; 3 *L. Rep'r*, 220; *Davoll v. Brown*, 1 *Woodb. & M.* 53; *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356; 5 *Fish. Pat. Cas.* 90; 1 *Pat. Off. Gaz.* 91; *Goodyear Dental Vulcanite Co. v. Gardiner*, 3 *Cliff.* 408; 5 *Pat. Off. Gaz.* 586; 4 *Fish. Pat. Cas.* 224; *Goodyear v. Railroad*, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; *Davis v. Palmer*, 2 *Brock. Marsh.* 298; *Bloomer v. Stolley*, 5 *McLean*, 158; 8 *West. L. J.* 158; *Allen v. Hunter*, 6 *McLean*, 303; *Latta v. Shawk*, 1 *Fish. Pat. Cas.* 465; 1 *Bond*, 259.

That they should be construed strictly, because in derogation of common right, see *Re Kemper*, *MacArthur Pat. Cas.* 1.

The true rule of construction is to apply plain and ordinary principles, and not to yield to subtleties and technicalities unsuited to the subject, and not in keeping with the liberal spirit of the age, and likely to prove ruinous to a class of the community so inconsiderate and unskilled in business as men of genius and inventors usually are. *Hogg v. Emerson*, 6 *How.* 437, 485. See also, *Davoll v. Brown*, 1 *Woodb. & M.* 53; *Woodworth v. Hall*, *Id.* 248; 6 *Pa. L. J.* 178; *Winans v. Denmead*, 15 *How.* 332; *Imlay v. Norwich & Worcester R. R. Co.*, 4 *Blatchf.* 227; 1 *Fish. Pat. Cas.* 340; *Henderson v. Cleveland Co-operative Stove Co.*, 2 *Bann. & A. Pat. Cas.* 604.

The rule that patents are to be construed liberally, so as, if possible, to carry out the construction claimed by the patentee, and sustain the patent, applies to a reissue as well as an original patent; thus, where the meaning of the specification and claim in the reissue is not perfectly clear, they may be read by the light of the specification and claim of the original patent, and, if consistent with the language there used, be sustained by them. *Klein v. Russell*, 19 *Wall.* 433. See, also, *Bussey v. Wager*, 9 *Pat. Off. Gaz.* 200.

In patents for combinations of mechanism, limitations and provisos imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed, against the inventor. *Sargent v. Hall Safe & Lock Co.*, 114 *U. S.* 63, 29.

In construing a patent, the court looks through the whole patent and specification, in order to ascertain what is the thing claimed and patented in it. There is no artificial or universal rule of interpretation of such an instrument beyond that which common sense furnishes, which is, to construe the instrument as a whole, and extract from the descriptive words and the claim what the invention is which is intended to be patented, and how far it is capable of exact ascertainment, and how far it is maintainable in point of law, supposing it clear from all ambiguity. *Carver v. Braintree Manuf. Co.*, 2 *Story*, 432, 446. S. P., *Pitts v. Whitman*, 2 *Story*, 609; *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356; 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; *Sullivan v. Redfield*, 1 *Paine*, 441; *Goodyear v. Railroad*, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; *National Car Brake Shoe Co. v. L. S. & M. S. Ry. Co.*, 4 *Fed. Rep'r*, 219; 9 *Biss.* 503; 18 *Pat. Off. Gaz.* 1179.

In deciding on the sufficiency of a patent, the court inspects the whole description as one paper, which they assume to be true in fact; and if found to be in conformity with the requisitions of the law, so that it appears with reasonable certainty, either from the words used or by necessary implication, in what the invention consists, though the description may be somewhat obscure, or imperfect, or defective, in form or mode of explanation, as claimed by the patentee, it will be adjudged sufficient. *Carver v. Braintree Manuf. Co.*, 2 *Story*, 432; *Whitney v. Emmett*, *Baldw.* 303.

The power to correct mistakes in letters patent does not belong to the courts, but it is confided to the commissioner. The court can only construe the specification and claim as they stand, and determine the legal effect of the claim. *Kittle v. Merriam*, 2 *Curt.* 475.

A patent, being a pioneer and foundation patent, both as to process and machine, is not to be construed as confined to specific details, if it fairly admits of the liberal construction to which such a patent is entitled. *Hammerschlag v. Seamoni*, 7 *Fed. Rep'r*, 584; 20 *Pat. Off. Gaz.* 75.

In the construction of letters patent, reference will be made to the existing state of the art at the time of the invention. *Wollensak v. Reiher*, 115 *U. S.* 87, 29. Patents are to be construed in the light of what was before known to persons skilled in the art to which they relate, in order to give effect to the true meaning of what is there described. *Webster Loom Co. v. Higgins*, 16 *Pat. Off. Gaz.* 675.

Decisions and opinions as to the validity of a patent are authorities in all similar cases, but not estoppels in any, except such as may arise between those very parties, or others claiming under them. But where there was no *prima facie* evidence to impeach the validity of a patent sustained in previous cases, it was construed with reference to prior existing devices to ascertain its scope. *Day v. Combination Rubber Co.*, 2 *Fed. Rep'r*, 570; 17 *Pat. Off. Gaz.* 1347; 5 *Bann. & A. Pat. Cas.* 385.

An inventor is supposed to describe in his patent the best mode of practicing his invention; but it is not necessarily limited to the precise constructions shown, so as to exclude a method differing from it only in a single detail, but producing the same result. *Lorillard v. McDowell*, 11 *Pat. Off. Gaz.* 640; 23 *Int. Rev. Rec.* 90; 13 *Phila.* 461; 2 *Bann. & A. Pat. Cas.* 531.

Whether two patents cover the same invention must be determined by the tenor and scope of their claims, not by the description in the patent. *McMillan v. Rees*, 1 *Fed. Rep'r*, 722; 17 *Pat. Off. Gaz.* 1272; 9 *Rep'r*, 544; 5 *Bann. & A. Pat. Cas.* 269.

The court should sustain the interpretation of a patent claimed for it by the patentee, if this can be done consistently with the language he has employed. *Bradley v. Dull*, 19 *Fed. Rep'r*, 913; 27 *Pat. Off. Gaz.* 625.

A construction of a patent which would render a disclaimer altogether nugatory should not be adopted. *Atlantic Giant Powder Co. v. Hulings*, 21 *Fed. Rep'r*, 519.

Though the construction of the patent must certainly depend on the words of the instrument, where the words are ambiguous, there may be circumstances which ought to have great influence in expounding them. The intention of the parties, if that intention can be collected from sources which the principles of law permit the courts to explore, are entitled to great consideration. Therefore, a special act may be referred to, as well as the patentee's petition, and such construction should be given to the grant as will make it, with such documents forming a part of it, not contradictory with itself. *Evans v. Eaton*, 3 *Wheat.* 454, 506; *rev'g Pet. C. Ct.* 322.

Declarations of a patentee and former owner of a patent, undertaking to restrict the invention within a narrower compass than that stated in his specification, will not be allowed to vary the construction which would otherwise be given to the patent. *Union*

Paper Bag Machine Co. v. Pultz, &c. Co., 15 *Blatchf.* 160 ; 15 *Pat. Off. Gaz.* 423 ; 3 *Bann. & A. Pat. Cas.* 403.

### 161. *Of Specifications.*

The schedule or specification annexed to the letters-patent is, under our laws and practice, to be regarded as a competent part of the letters-patent, and may be referred to explain or add to the title of the patent. *Hogg v. Emerson*, 6 *How.* 437, 478 ; aff'g 2 *Blatchf.* 1. See *Evans v. Eaton*, *Pet. C. Ct.* 322.

The patent and specification are connected together and dependent upon each other for support. The specification should maintain the title of the patent ; the latter should not indicate one thing, and the former describe another, as to the subject of the grant. *Sullivan v. Redfield*, 1 *Paine*, 441 ; *Goodyear v. Railroad*, 2 *Wall. Jr.* 356 ; 1 *Fish. Pat. Cas.* 626.

Sometimes the preamble, even, may be resorted to for ascertaining the object of the specification, sometimes the body of the specification, sometimes the summing up, and sometimes the formal clause at the end of the specification. Generally, all of them are examined together, unless the formal clause seems explicitly to exclude the rest. *Davoll v. Brown*, 1 *Woodb. & M.* 53.

If the specification of a patent, taken as a whole, leaves no reasonable doubt concerning the intention of the patentee to include in his claim a certain part of a combination, though there may be an error in describing it, it will be considered as included. *Kittle v. Merriam*, 2 *Curt.* 475.

If the specification is wholly ambiguous and uncertain, so loosely defined and so inaccurately expressed, that the court cannot, upon fair interpretation of the words, and without vague conjecture of intention, gather what it is, the patent is void for such defect. But if the court can fairly see, by a reasonable use of the means of interpretation of the language used, taking the whole into connection, what is the nature and extent of the claim, then the plaintiff is entitled to the benefits of it, however imperfectly and inartificially he may have expressed himself. *Ames v. Howard*, 1 *Sumn.* 482. S. P., *Ryan v. Goodwin*, 3 *Sumn.* 514 ; 3 *L. Rep'r*, 220 ; *Emerson v. Hogg*, 2 *Blatchf.* 1. See affirmance, 6 *How.* 437 ; *Parker v. Stiles*, 5 *McLean*, 44, 57 ; 7 *West. L. J.* 168. Such a construction as will allow an inventor to couch his speci-



eration in such ambiguous terms that its claims may be expanded or contracted to suit the emergency should not be allowed. *Detmold v. Reeves*, 5 *Pa. L. J. Rep* 99.

The words of the specification are to be taken together, and they are to be so construed as to give effect to the meaning and intention of the persons using them. Words are not to be distorted so as to effect what may be supposed to have been the intention of the one using them ; but they are to have a reasonable construction, as connected with the sentence in which used. *Allen v. Hunter*, 6 *McLean*, 303.

A general description of the nature of the invention at the beginning of a specification, is not to be taken alone, in determining what is covered by the patent, but should be construed with a description of the invention itself, also contained in the specification, which gives instructions as to how the patented device is made, and specific directions as to characteristics which it must possess. *Holt v. Kendall*, 26 *Fed. Rep'r*, 622

### 162. Claims

In general, when a patentee describes a machine and then claims it as described, he is understood to intend to claim, and by law does actually cover, not only the precise forms he has described, but all other forms which embody his invention. *Winans v. Denmead*, 15 *How.* 342. Followed, *Grier v. Castle*, 17 *Fed. Rep'r*, 523 ; 24 *Pat. Off. Gaz.* 1176.

Where the "claim" immediately follows the description, it may be construed in connection with the explanations contained in the specification ; and be restricted accordingly. *Turrill v. Michigan Southern, &c. R. R. Co.*, 1 *Wall.* 491. See, also, *Hovey v. Stevens*, 3 *Woodb. & M.* 17 ; *Winans v. Denmead*, 15 *How.* 330 ; *Matthews v. Shoneberger*, 4 *Fed. Rep'r*, 635 ; 18 *Blatchf.* 357 ; 18 *Pat. Off. Gaz.* 1464 ; *Roberts v. Dickey*, 4 *Brews.* 260 ; 3 *Pittsb.* 352 ; 1 *Pat. Off. Gaz.* 4 ; 4 *Fish. Pat. Cas.* 532 ; *McMillin v. Rees*, 5 *Bann. & A. Pat. Cas.* 269.

A claim for a combination of several devices, so combined together as to produce a particular result, is not good as a claim for "any mode of combining those devices which would produce that result," and can only be sustained as a valid claim for the peculiar combination of devices invented and described. *Case v. Brown*, 2 *Wall.* 320 ; aff'g 2 *Fish. Pat. Cas.* 268.

The courts of this country cannot always indulge the same latitude which is exercised by English judges in determining what parts of a machine are or are not material. Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, the court cannot declare that any one of these elements is immaterial. The patentee makes them all material by the restricted form of his claim. The courts can only decide whether any part omitted by an alleged infringer is applied by some other device or instrumentality which is its equivalent. *Water Meter Co. v. Desper*, 101 *U. S.* 332. And see *Lefever v. Remington*, 22 *Pat. Off. Gaz.* 1537.

The courts should be careful not to enlarge, by construction, the "claim" which the patent-office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms. *Burns v. Meyer*, 100 *U. S.* 671.

The scope of letters patent should be limited to the invention covered by the claim, and this cannot be enlarged by the language in other parts of the specification. *Western Electric Manuf. Co. v. Ansonia Brass & Copper Co.*, 114 *U. S.* 447, 29.

Where, after an application for a patent for combination is rejected, the applicant, in order to obtain a patent, upon a new application, narrows his claim by the introduction of a new element, and a patent is thereupon issued to and accepted by him, he cannot afterwards, in a suit for infringement, enlarge the patent by construction so as to cover elements not falling within its terms and which he had explicitly abandoned. *Shepard v. Carrigan*, 116 *U. S.* 593.

Where a wholly new method or art has been discovered by a patentee, the courts will construe the claims of his patent broadly, and so as to cover all such mechanical means as embody the real invention. *Standard Measuring Machine Co. v. Teague*, 15 *Fed. Rep'r*, 390. *S. P., Kimball v. Hess*, *Id.* 393 ; 15 *Rep'r*, 583.

Where two patents have been issued, each claiming, broadly, the same invention, and the earlier patentee is held to be the first inventor, the claim in the second patent must be restricted to the particular devices there specially described. *Richardson v. Noyes*, 10 *Pat. Off. Gaz.* 507 ; 2 *Bann. & A. Pat. Cas.* 398.

The technical claims in a patent are to be construed with reference to the state of the art, so as to limit the patentee to, and give him the full benefit of, the invention he has made. *Estabrook v. Dunbar*, 19 *Pat. Off. Gaz.* 909 ; 2 *Bann. & A. Pat. Cas.* 427.

Although it is true that in the construction of a claim, reference may be had to the specification, to ascertain the true interpretation of the claim, yet, where the claim is such as to leave no room for construction, where it is clear and explicit, and especially, where there is nothing in the specification which shows that the patentee did not mean just what the plain language of the claim imports, the court is not aided by, and has no need of aid from, such specification. *Rich v. Close*, 8 *Blatchf.* 41 ; 4 *Fish. Pat. Cas.* 279.

A patent covers only the devices which are claimed, although others are described by way of explaining them or illustrating the way in which they operate. *Wheeler v. McCormick*, 4 *Pat. Off. Gaz.* 692 ; 11 *Blatchf.* 334 ; 6 *Fish. Pat. Cas.* 551. S. P., *Couse v. Johnson*, 16 *Pat. Off. Gaz.* 719 ; 4 *Bann. & A. Pat. Cas.* 500.

Where a claim is not limited to a particular form of construction of device, and the specification does not assign as a peculiar merit or claim, any new result of a product of its conformation, such form cannot be considered as an essential part of the invention. *Couse v. Johnson*, *supra*.

Where a claim of the patent appears to be for a result, produced substantially "in the manner and for the purposes" described, the claim will be construed to be for the mechanism set forth in the specifications, by which the result is produced, and not for the result itself. The principle, of construing a claim for a result to be a claim for the means by which the result is produced, is applied to all cases where a result is claimed, whether there is any reference to the specifications in the claim or not. *Henderson v. Cleveland Co-operative Stove Co.*, 2 *Bann. & A. Pat. Cas.* 604.

Where a particular result is claimed by an inventor of an improvement, the patent protects only such result as a whole ; not each particular entering into it. *Huggins v. Hubby*, 3 *West. L. Month.* 347.

A patent claim must be construed in the light of the specifications ; and where the specifications describe the entire article, parts of the description cannot be separately considered, to show an infringement of one of the parts. *Evans v. Kelly*, 13 *Fed. Rep'r.* 903 ; 9 *Biss.* 251 ; 26 *Int. Rev. Rec.* 349 ; 23 *Pat. Off. Gaz.* 192 ; 5 *Bann. & A. Pat. Cas.* 71. See *Haselden v. Ogden*, 3 *Fish. Pat. Cas.* 378.

Where there is a slight change in a machine, by which a new result is brought about, and which might be the subject of a patent, courts do not feel inclined to extend the invention beyond the mere

change, although they may be inclined to sustain the patent ; but where something elementary has been discovered and constitutes fairly a part of the invention of the patentee, no other inventor or manufacturer ought to be permitted to use that elementary part without paying tribute to the first inventor or originator. *Cornell v. Downer, &c. Brewing Co.*, 7 *Biss.* 346 ; 11 *Pat. Off. Gaz.* 331 ; 2 *Bann. & A. Pat. Cas.* 514.

The claim in a patent cannot be enlarged by construction, even though it might have been made broader, in view of the invention described in the specifications and drawings. *Becker v. Hastings*, 22 *Fed. Rep'r*, 827 ; 28 *Pat. Off. Gaz.* 98. S. P., *Wyeth v. Stone*, 1 *Story*, 274.

A claim, in a patent for a new manufacture, of a coloring matter obtained "substantially in the manner set forth, or by any other method which will produce a like result," was construed as covering any method of treatment the equivalent of the process described, producing like results ; and chemical identity of an article produced by alleged infringers, *held, prima facie* sufficient proof of infringement by them. *Pickhardt v. Packard*, 22 *Fed. Rep'r*, 530 ; 29 *Pat. Off. Gaz.* 179. See *Knox v. Murtha*, 9 *Blatchf.* 205 ; 5 *Fish.* 176.

In the construction of claims in a patent, however careful the courts should be not to enlarge a claim, they may apply intelligently and fairly, for the purpose of ascertaining the actual meaning, every part of the specification to which it refers ; and may consider as embodied in the claim, whatever by fair interpretation is drawn into it from the other parts. Thus, where the form and proportions and arrangement and position of the elements of a combination are mentioned in the claim, it may be understood as referring to a combination of those elements when they are formed or proportioned or placed substantially as there described, and for the purpose there stated. *Fisk v. Hollander*, *MacArthur & M.* 355.

### 163. *Drawings, Models, &c.*

Models and drawings are a part of the letters-patent, and may be resorted to for clearer information respecting the invention described in the specification. *Hogg v. Emerson*, 6 *How.* 437, 435 ; aff'g 2 *Blatchf.* 1. Compare *Grant v. Mason*, 1 *L. Int. & Rev.* 22.

Drawings annexed and referred to in the specification constitute

a part thereof ; and they may be resorted to to aid the description, and to distinguish the thing patented from other things known before. *Earle v. Sawyer*, 4 *Mas.* 1 ; *Washburn v. Gould*, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L. Rep'r*, 276 ; *Knight v. Gavit*, *Mir. Pat. Off.* 153. S. P., *Hogg v. Emerson*, 11 *How.* 587, 606 ; 2 *Blatchf.* 1 ; *Howes v. Nute*, 4 *Fish. Pat. Cas.* 263 ; *Heinrich v. Luther*, 6 *McLean*, 345.

The question as to the sufficiency of a description must be determined, like a question of construction, from what is written, aided by the drawings, and, if need be, by the patent-office model. Particular passages in a description must not be separated from what precedes or follows them in the same connection ; but one part of the instrument must be compared with another, and the whole considered together, in order to determine whether it is incomplete and ambiguous, or sufficient to uphold the claim. If the drawings are clear, reference to them may be made in the written description, to aid in an understanding of the nature of the invention. *Howes v. Nute*, 4 *Cliff.* 173. See *Seymour v. Osborne*, 11 *Wall.* 516.

The drawing may be examined by the court in an infringement case to explain an ambiguity in the specification, but not to supply a part lacking. *Tinker v. Wilbers Eureka Mower, &c. Manuf. Co.*, 5 *Bann. & A. Pat. Cas.* 92 ; 1 *Fed. Rep'r*, 138 ; 9 *Rep'r*, 273 ; *Banker v. Bostwick*, 5 *Bann. & A. Pat. Cas.* 463.

When the invention patented consists of a combination of old elements to produce a new result, mere matters of adjustment of the individual elements are not limited or controlled by the drawings, unless, 1. They are expressly so limited by the specifications as well ; or, 2. Such limitation and control are essential to produce the result claimed. *Hamilton v. Ives*, 3 *Pat. Off. Gaz.* 30 ; 6 *Fish. Pat. Cas.* 244.

For the weight to be given to drawings filed with a patent issued prior to December 15, 1836, by virtue of the act of March, 1837, § 1 (5 Stat. 191), see *Emerson v. Hogg*, 2 *Blatchf.* 1 ; and affirmance, 6 *How.* 437 ; *Winans v. Schenectady & Troy R. R. Co.*, 2 *Blatchf.* 279, 298.

#### 164. Referring to Application, &c

The original application for letters-patent (with its accompanying drawings and model), filed by an inventor, should possess great weight in showing what his invention really was, especially where

it remains unchanged for a considerable period, and is afterward amended so as to have a broader scope. But amendments embracing any material variation from the original application cannot be sustained on the original application, and should not be allowed; if they were, great injustice might be done to others who may have invented or used the same things in the meantime. *Railway Co. v. Sayles*, 97 *U. S.* 554.

Neither the correspondence between the commissioner of patents and the applicant nor the proceedings in the patent-office, pending an application, are admissible as evidence to enlarge, diminish, or vary the language of the claim of a patent. *Goodyear Dental Vulcanite Co. v. Gardiner*, 3 *Cliff.* 408 ; 5 *Pat. Off. Gaz.* 586 ; 4 *Fish. Pat. Cas.* 224.

In an action for infringement of a patent, letters of the plaintiff to the patent-office, containing his application for a patent, and inclosing a specification substantially agreeing with his patent afterward issued, and asserting his claim as inventor to the invention described, are properly admissible in evidence to show the existence of such facts. *Pettibone v. Derringer*, 4 *Wash.* 215. Ambiguity in a patent and specification may be explained by the affidavit annexed to the specification. *Ib.*

In interpreting the language of a patent, in order to know what construction the patentee himself placed upon it, recourse may be had to the files of the application, to ascertain what changes were made in the original specification and claims, and the significance of those changes as revealed by the history of the case. *Trader v. Messmore*, 7 *Pat. Off. Gaz.* 385 ; 1 *Bann. & A. Pat. Cas.* 639.

If the field of invention be bounded by prior patents, though referring to the objects of the patent in issue only by general terms known in the art to which they belong, to include them, the description of what the inventor undertook to cover must be construed in the light of their existence. *Parsons v. Colgate*, 15 *Fed. Rep'r*, 600 ; 24 *Pat. Off. Gaz.* 203.

### 165. *Consulting Experts on Questions of Construction.*

The opinion of experts cannot be received as to the construction of a patent. Experts may be examined as to the meaning of terms of art, on the principle of *cuique in sua arte credendum* ; but not as to the construction of written instruments. *Corning v. Burden*,

15 *How.* 252, 270 ; *Winans v. New York & Erie R. R. Co.*, 21 *How.* 88, 100.

The established practice of taking testimony of experts on the diversity of the inventions embraced in two different patents, instead of requiring courts to compare the specifications and give the jury instructions on the question as one of law, does not trench upon the doctrine that the construction of written instruments is the province of the court alone: for it is not the construction of the instrument, but the character of the thing invented, which is sought in questions of identity and diversity of inventions. *Bischoff v. Wethered*, 9 *Wall.* 812.

Whether a patent is void for uncertainty or ambiguity in the description, is a matter of fact to be decided upon the evidence of experts. *Washburn v. Gould*, 3 *Story*, 122, 138 ; 7 *L. Rep'r*, 276 ; 1 *West. L. J.* 465

Two different translations of a phrase in a French patent for a firearm, equivalent to "breech-loading," were urged upon the court, supported by testimony of experts. The court adopted that which was more literal, which better accorded with the other parts of the instrument not involved in doubt, and was germane to the invention and more in harmony with the other language of the patent. *White v. Allen*, 2 *Cliff.* 224 ; 2 *Fish. Pat. Cas.* 440.

The mere opinion of an expert, that two pieces of machinery constructed to produce the same results and working out those results by means so nearly identical as to create a strong presumption of a common origin, are essentially different in mechanical structure and mode of operation, when he does not point out the particular differences or coincidences between the two, is not enough to determine the right to a preliminary injunction. *United States Annunciator, &c. Manuf. Co. v. Sanderson*, 3 *Blatchf.* 184.

#### 166. *Application of Rules of Construction in peculiar cases.*

Patent granted to Goodwin, in 1876, for improvements in harvesters, was construed, as to its claim of a pivotal rock-shaft, and held to be restricted to the specific device claimed, and therefore not infringed by a different, although perhaps substantially equivalent device. *Goodwin v. Randolph*, 21 *Fed. Rep'r*, 575.

Patent granted to Lull and Porter, in 1854, for an improvement

in shutter hinges, was construed, and *held* to include in its claim, substantially two claims; one for such of the described mechanism as is necessary to secure the described swinging and locking of the shutter, and the other for such of the described mechanism as is necessary to secure the result described as to strain on the spindle. The former claim was *held* infringed by a device which was a mere formal variation therefrom, having the same mode of operation. *Lull v. Clark*, 21 *Blatchf.* 95.

Patent granted to Adams, in 1869, for an improvement in the electro-deposition of nickel, was construed, with regard to the validity and extent of its claims, and *held* infringed by the use of a solution which, though not the same as that described by Adams, accomplished the same results by the same electro-chemical mode of operation, by the same process, with the absence of the same injurious elements. *United Nickel Co. v. Pendleton*, 21 *Blatchf.* 226.

A claim in a patent for a combination, the elements or parts of which were old, was construed, in connection with the state of the art, as limited substantially to the special character of parts and the particular organization described; and *held*, not infringed by a machine differing from that described in the specifications in construction and organization, and also in mode of operation and the result produced. *Buzzell v. Andrews*, 25 *Fed. Rep'r*, 822; 34 *Pat. Off. Gaz.* 830.

Patent granted to Clark in 1877, for an improvement in lubricators, construed, and compared with the device for which a patent was granted to Swift, in 1884. That device was *held* not an infringement of the patent to Clark; the doctrine of equivalents not being applicable to the case, and the difference in details of construction of the Swift device, from the earlier patents, appearing to be so great that it might fairly be deemed a patentable invention. *Jenks v. Swift*, 25 *Fed. Rep'r*, 722; 34 *Pat. Off. Gaz.* 609.

The claim of the original patent granted to Garner, in 1869, to a circular-shaped harrow tooth "constructed and used in the manner and for the purposes herein specified," construed, with the drawings and specifications referred to, and *held* to include within its grant the exclusive right not only to harrow teeth made literally according to the drawings and descriptions of the specifications, but also all similar harrow teeth fastened at one end to the bars or frame of the harrow, and curved so as to form an arch, above the plane of the bars or frame of the harrow, and descend between the bars, in a curve, to the ground, their points inclining forward; and



therefore to cover everything embraced in the seven claims of the reissued patent for the same invention granted in 1880. *Reed v. Chase*, 25 *Fed. Rep'r*, 94 ; 33 *Pat. Off. Gaz.* 996.

Patents issued to Black, in 1870, and to Garland in 1871, for improvements in automatic relief valves, were construed, with reference to prior inventions, and *held* to be limited to the specific mechanisms described in the patents, or their equivalents ; and that, so limited, neither patent was infringed by mechanism substantially different from that described in it. *Shaw Relief Co. v. City of New Bedford*, 26 *Fed. Rep'r*, 331.

Patent issued to Martin, in 1877, for improvement in furniture casters, was construed, with reference to the prior state of the art. It was *held* to be limited to certain details of construction, and therefore was not infringed in the particular case. It appeared that the combination patented accomplished no new result in mechanics, and differed from previous known combinations designed for the same and similar purposes, only in the construction of one or two of the parts, whereby perhaps a better but certainly not a different kind of result was accomplished than had been before effected. *Phoenix Caster Co. v. Spiegel*, 26 *Fed. Rep'r*, 272.

A patentee who accepts a narrow claim can not be allowed to extend it by construction so as to cover devices not within its terms. *Roemer v. Peddie*, 27 *Fed. Rep'r*, 702.

### 167. *What constitutes Infringement, generally.*

Inventions pertaining to machines may be divided into four classes. 1. Where the invention embraces the entire machine. 2. Where the invention embraces one or more of the elements of the machine, but not the entire machine. 3. Where the invention embraces both a new element and a combination of elements previously known. 4. Where all the elements are old, and a new combination, producing a new result, is made out of them. *Union Sugar Refinery v. Mathiessen*, 3 *Cl.* 639 ; 2 *Fish. Pat. Cas.* 600 ; *Sanford, v. Merrimac Hat Co.*, 10 *Pat. Off. Gaz.* 466.

A person is an infringer of a patent of the first class who, without license, makes any portion of the machine ; of the second when the part new and patented is made or used ; of the third, when the new element or new combination is used ; of the fourth, when the patented combination is pirated. *Union Sugar Refinery*

*v. Mathiessen, supra.* See *Haseldean v. Ogden*, 3 *Fish. Pat. Cas.* 378.

There may be an infringement by the use of the patented article for a purpose not mentioned in the patent and for which it was not intended. *Zinn v. Weiss*, 7 *Fed. Rep'r*, 914.

A change in the mode of a device, where all its benefits are secured thereby, is an infringement. *Union Paper Bag Co. v. Nixon*, 9 *Pat. Off. Gaz.* 691 ; 1 *Flippin*, 491 ; 2 *Bann. & A. Pat. Cas.* 240.

Every manufacture for sale abroad, followed by actual sale, of a machine on which an American patent has been issued, is an infringement of the American patentee's rights of property and exclusive use. *Ketchum Harvester Co. v. Johnson Harvester Co.*, 8 *Fed. Rep'r*, 586 ; 19 *Blatchf.* 367 ; 12 *Rep'r*, 553.

If a machine is so constructed as to conform to the description in the patent except as to one particular, but with the design that this effect shall be attained by the action or wearing of the parts in use, there is an infringement. *American Diamond Rock-boring Co. v. Sullivan Machine Co.*, 14 *Blatchf.* 119 ; 2 *Bann. & A. Pat. Cas.* 522.

Where a party sells an article to persons who intend to use it in the combination claimed in the patent, and it is advertised and sold for that very purpose, such sale is an infringement, although the manufacture and sale would not, *per se*, be an infringement. *Bowker v. Dows*, 15 *Pat. Off. Gaz.* 510 ; 3 *Bann. & A. Pat. Cas.* 518. Thus the making and sale by defendants of an article, which, of necessity, to their knowledge, was to be used for the purpose of infringing the complainant's patent was *held* to render them liable as infringers. *Travers v. Beyer*, 26 *Fed. Rep'r*, 450.

It is not necessary to constitute an infringement that a man should work by the specification contained in the patent. He might not even know that there was such a patent, and still infringe it. *Matthews v. Skates*, 1 *Fish. Pat. Cas.* 602 ; *Parker v. Haworth*, 14 *McLean*, 370.

Infringement of a patent can occur only by actually making, using or selling the patented device. Advertising it for sale, though not of itself a violation of an injunction restraining sales, is yet strong evidence of an intent to violate ; but to warrant convicting a defendant of selling in contempt of court, a clear case must be made out. *Allis v. Stowell*, 19 *Pat. Off. Gaz.* 727.

A machine is not infringed if the same result is produced by

the defendant by instrumentalities other than those which were claimed in the patent. *Toohey v. Harding*, 1 *Fed. Rep'r*, 174 ; 4 *Hughes*, 253 ; 5 *Bann. & A. Pat. Cas.* 195 ; *Dittmar v. Rix*, 1 *Fed. Rep'r*, 342 ; 17 *Pat. Off. Gaz.* 973 ; 5 *Bann. & A. Pat. Cas.* 240 ; *Hall v. Stern*, 15 *Fed. Rep'r*, 463 ; 25 *Pat. Off. Gaz.* 206 ; *Rich v. Lippincott*, 2 *Pittsb.* 38.

Use of old devices is not an infringement, although they are equivalents for those in the patent. *Dennis v. Cross*, 6 *Fish. Pat. Cas.* 138 ; 3 *Biss.* 389.

The fact that the infringement is not perfect because the machine is imperfect does not exonerate defendant ; it is still an infringement. *Union Paper Box Co. v. Binney*, 5 *Fish. Pat. Cas.* 106.

If changes of form or arrangement introduce a new principle, power, or mode of operation producing a new kind of result, the patent is not infringed. *Many v. Sizer*, 1 *Fish. Pat. Cas.* 17.

Dividing an invention and making two operations where only one is necessary is an infringement. *Baldwin v. Bernard*, 5 *Fish. Pat. Cas.* 75 ; 9 *Blatchf.* 509 n. ; 2 *Pat. Off. Gaz.* 320.

Where a plaintiff claims several distinct and independent improvements in the same machine, and procures a patent for them in the aggregate, he is entitled to recover against any person who shall use any one of the improvements so patented, notwithstanding there has been no violation of the other improvements. *Moody v. Fiske*, 2 *Mas.* 112.

A party may sue for an infringement of any one of the separate and distinct inventions that may be covered by his patent. *McComb v. Ernest*, 1 *Woods*, 195.

If a patent is for two distinct machines conducing to a common end, to use either one is an infringement. *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54 ; *Emerson v. Hogg*, 2 *Blatchf.* 1 ; and see *affirmance*, 6 *How.* 437, 485.

It is no infringement of a patent embracing an old invention, to imitate the old part, so long as there is no interference with the new. *Simon v. Neumann*, 20 *Fed. Rep'r*, 196.

Where the machine described and claimed in complainant's patent, and respondents' machines, each contained four elements operating together to produce the same result, although formal differences existed between certain of the elements of the two, yet, the same not being substantially different in object or operation, it was held that the respondents' machine was an infringement of

complainant's patent. *Storrs v. Howe*, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420.

Where a portion of the structure was useless ; was not sold to be used, and was not used in any infringing structure, the patent is not infringed in making and selling it ; an article is not an infringement, unless it is to be used in the manner pointed out in the patent. *Campbell v. Kavanaugh*, 11 *Ibid. Rep'r.* 83 ; 20 *Blatchf.* 256.

Where a patentee claims three distinct improvements in the same patent, he must show himself entitled to each, to sustain an action for an infringement. *Heinrich v. Luther*, 6 *McLean*, 345.

If a machine in its mechanical operation and effect is the same as the patentee's, a difference in cost, adjustability or other peculiarity in construction, will not prevent its being an infringement. *Foss v. Hubert*, 2 *Fish. Pat. Cas.* 31 ; 1 *Biss.* 21.

If the result is the same in kind it is not necessary that it be the same in degree. *Whipple v. Middlesex Co.*, 4 *Fish. Pat. Cas.* 41.

A substitute for the original invention, or an old instrument used to accomplish a new result, is no infringement, unless the defendant uses substantially the same instrument in substantially the same manner as that set forth in the patent. *Johnson v. Root*, 1 *Fish. Pat. Cas.* 351.

A patent depending on a novel use of water is infringed by a similar use of water in less quantity. *Roberts v. Roter*, 5 *Fish. Pat. Cas.* 529.

Two patents may both be valid where the second is an improvement on the first ; and, if the second includes the first, neither of the two owners can lawfully use the invention of the other without such other's consent. *Star Salt Castor Co. v. Crossman*, 4 *Cliff.* 508 ; 3 *Bann. & A. Pat. Cas.* 281.

The use of all the elements of a patented improvement, with an addition which does not take the place of the device patented, is as much an infringement as the use without such addition. *Roemer v. Simon*, 28 *Pat. Off. Gaz.* 194. And see *Williams v. B. & O. R. Co.*, 16 *Pat. Off. Gaz.* 906 ; 17 *Blatchf.* 21 ; 4 *Bann. & A. Pat. Cas.* 441.

Embodying a patentee's invention in defendant's machinery, however it may be combined with other machinery, is an appropriation, the same as if it were used alone and separate from those connections. *Sickels v. Borden*, 3 *Blatchf.* 535 ; *Pitts v. Wemple*, 6 *McLean*, 558 ; *Foster v. Moore*, 1 *Curt.* 279 ; *Johnson v. Root*, 1

*Fish. Pat. Cas.* 351 ; *Mallory v. White*, 4 *Fish.* 628 ; 8 *Blatchf.* 552 ; *Hoffheins v. Brandt*, 3 *Fish. Pat. Cas.* 218 ; *Waterbury Brass Co. v. N. Y. Brass Co.*, 3 *Fish. Pat. Cas.* 43 ; *Flint v. Roberts*, 4 *Bann. & A. Pat. Cas.* 165.

The general principle is that, where the claim of a patent is limited to a particular product when produced in a particular way, there is no infringement unless the article described is produced, by employment of substantially the same means to accomplish the result. This principle was applied, in a case of a new article of manufacture in the form of a cast copper tube or cylinder free from blow-holes and other similar defects. *Adams v. Bridgewater Iron Co.*, 26 *Fed. Rep'r*, 324 ; 34 *Pat. Off. Gaz.* 1045.

Where a modification displaces and supersedes the patented invention it is not an infringement. *Whipple v. Middlesex Co.*, 4 *Fish. Pat. Cas.* 41.

Unless the same result is produced by the same means, there is no infringement of the invention ; hence in an action for infringement on letters patent for a lock, where the defendant does not use the same combination, and employs no device as an equivalent and substitute for the omitted element, he will not be liable as an infringer. *Yale Lock Manuf. Co. v. Sargent*, 117 *U. S.* 373.

An improvement on a patent may infringe the original patent. *Tate v. Thomas*, 27 *Fed. Rep'r*, 306.

Where a patentable improvement on a device contains all the essentials of the original patent, it infringes. *Hoff v. Iron-Clad Manuf. Co.*, 27 *Fed. Rep'r*, 307.

Results the same in kind, though not the same in degree, constitute an infringement. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

Embodiments of the new idea and similarity of mechanical construction are what constitutes infringement. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

Where a party avails himself of the invention of another without such variation as constitutes a discovery, there is an infringement. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

### 168. *Motive.*

To constitute an infringement for which an action will lie, the making of a machine must be with intent to infringe the patent

right, and deprive the owner of the lawful rewards of his discovery. *Sawin v. Guild*, 1 *Gall.* 485.

The question of infringement is one irrespective of motive. The defendant may have infringed without intending, or even knowing it; but he is no less the infringer. *Parker v. Hulme*, 1 *Fish. Pat. Cas.* 44; 7 *West. L. J.* 417.

The making of a patented machine, fit for use, and with a design to use it for profit, in violation of the patent right, is an infringement. *Whittemore v. Cutter*, 1 *Gall.* 429; 1 *Robb.* 28; *Bloomer v. Gilpin*, 4 *Fish. Pat. Cas.* 50.

The making of a patented machine merely for philosophic experiments, or for the purpose of ascertaining the sufficiency of the machine to produce its described effects, is not an infringement of the right. *Whittemore v. Cutter*, 1 *Gall.* 429; *Poppenhusen v. Falke*, 2 *Fish. Pat. Cas.* 181; 5 *Blatchf.* 493.

Whoever erects or uses a patented machine does it at his peril. He takes upon himself all the chances of the patent being originally valid; or being afterward made so by a surrender and the grant of a new one, which may cure all defects. *Ames v. Howard*, 1 *Summ.* 482. And see *Evans v. Weiss*, 2 *Wash.* 342; 3 *Am. L. J.* 180; *McClurg v. Kingsland*, 1 *How.* 202; 17 *Pet.* 228; *Simpson v. Westchester R. R. Co.*, 4 *How.* 380; *Simpson v. Mad River R. R. Co.*, 6 *McLean*, 603.

The keeper of a hotel who uses a patented hotel register without right, is liable as an infringer, and not the less so because he did not intend to violate the rights of the patentee, and desisted when notified. *Hawes v. Washburne*, 5 *Pat. Off. Gaz.* 491.

One selling a machine to be used for the purpose of infringing a patented combination is liable as an infringer himself. *Holly v. Vergennes Machine Co.*, 4 *Fed. Rep'r*, 72; 18 *Blatchf.* 327; 18 *Pat. Off. Gaz.* 1177.

### 169. Identity of Devices.

To constitute identity of invention, and therefore infringement, not only must the result obtained be the same, but in case of a combination of known elements, the elements combined must be the same, and combined in the same way, so that each element shall perform the same function; provided, however, that the differences alleged are not merely colorable, according to the rule forbidding

the use of known equivalents. *Electric R. Signal Co. v. Hall R. Signal Co.*, 114 *U. S.* 87.

If two machines, having the same mode of operation, do the same work in substantially the same way and accomplish substantially the same result, they are the same, though differing in form, shape, or name. *Union Sugar Refinery v. Mathiesen*, 3 *Cliff.* 639; 2 *Fish. Pat. Cas.* 600. *S. P., Alden v. Dewey*, 1 *Story*, 336; 3 *L. Rep'r.*, 383; *Dixon v. Moyer*, 4 *Wash.* 68; *Rich v. Lippincott*, 1 *Pittsb.* 31; 2 *Fish. Pat. Cas.* 1; *Spring v. Domestic Sewing Machine Co.*, 9 *Fed. Rep'r.*, 505; 21 *Pat. Off. Gaz.* 633.

Where the end to be accomplished by two devices is the same, and the substantial means to accomplish the end are the same, the two devices are identical, though one may accomplish the end more effectually than the other. *Imlay v. Norwich & Worcester R. R. Co.*, 4 *Blatchf.* 227; 1 *Fish. Pat. Cas.* 340.

If there is infringement, a person of competent skill will be able to make a machine like defendants from the description given in plaintiff's patent. *Schneider v. Lovell*, 22 *Pat. Off. Gaz.* 499; 10 *Fed. Rep'r.*, 666; *Many v. Sizer*, 1 *Fish. Pat. Cas.* 17.

If mechanical differences exist, but the two products and the general mode of construction are the same, as would appear by a comparison of the two manufactures, the court will hold that infringement is proved. This doctrine applied in a suit for infringement of patent for improvement in billiard tables. *Collender v. Came*, 4 *Cliff.* 393; 10 *Pat. Off. Gaz.* 467; 2 *Bann. & A. Pat. Cas.* 412.

Where, in mechanics, one device does a particular thing, or accomplishes a particular result, every other known device which skilled workmen know will do the same thing or produce the same result is a known mechanical substitute (*Carter v. Baker*, 1 *Sawyer*, 512; 4 *Fish. Pat. Cas.* 404); *e. g.*, a handle used in place of a lever to produce the same result. *Brown v. Guild*, 23 *Wall.* 181. See also *Cahoon v. Ring*, 1 *Fish. Pat. Cas.* 397; 1 *Cliff.* 592; *Smith v. Downing*, 1 *Fish. Pat. Cas.* 64; *Johnson v. Root*, 1 *Fish. Pat. Cas.* 351; *Burden v. Corning*, 2 *Fish. Pat. Cas.* 477. Mechanical equivalents are not those merely which produce the same result. *Smith v. Marshall*, 10 *Pat. Off. Gaz.* 375; 2 *Bann. & Ard.* 371.

A person, to invoke the doctrine of equivalents, must be the first inventor of the principle and not only of the machine which carries it out. *Singer v. Walmsley*, 1 *Fish. Pat. Cas.* 558. As to the term equivalents in chemicals, see *Tyler v. Boston*, 7 *Wall.* 327. Known

equivalents to ingredients in a composition are covered by a patent for such composition. *Matthews v. Skates*, 1 *Fish. Pat. Cas.* 602; *Woodward v. Morrison*, 5 *Fish. Pat. Cas.* 557; 1 *Holmes*, 124; 2 *Pat. Off. Gaz.* 120.

It is an infringement of a patented machine to make and use a machine which operates, or may operate if the owner is disposed to use it so, in the manner pointed out by the patent. *Holbrook v. Small*, 10 *Pat. Off. Gaz.* 508.

Where a device effects the same results in substantially the same way, it is an infringement on plaintiff's patent, although it presents great simplicity and cheapness as compared to complainant's patent. *Eyory v. Burt*, 15 *Fed. Rep'r*, 112; 23 *Pat. Off. Gaz.* 312. That it was not known at the date of plaintiff's invention, is immaterial. *Potter v. Stewart*, 18 *Blatchf.* 561; 19 *Pat. Off. Gaz.* 997; 7 *Fed. Rep'r*, 215.

Where a greater number of persons have to be employed in the operation of a machine formerly in use than in a patented machine, this tends to prove that the machines are not alike. *Coupe v. Weatherhead*, 16 *Fed. Rep'r*, 673; 23 *Pat. Off. Gaz.* 1927.

It is not necessary, to continue an infringement, that the whole invention be taken. *Fetter v. Newhall*, 17 *Fed. Rep'r*, 841; 25 *Pat. Off. Gaz.* 502; 16 *Rep'r*, 360; 21 *Blatchf.* 415.

Where a patented machine is capable of performing several functions, as Blanchard's machine for turning irregular forms, and a person constructs a machine to perform but one of such functions, as the turning of wagon spokes, it is an infringement. *Blanchard v. Beers*, 2 *Blatchf.* 411.

In order to constitute an infringement, it is not necessary that the arrangement and combination of the party charged with the infringement should be the same to the eye as the patented invention. If they embody the ideas of the patentee, and the machinery of the defendant operates by such adoption and appropriation, then, though the arrangement may be apparently different, in reality and in judgment of law an infringement exists. *Smith v. Higgins*, 1 *Fish. Pat. Cas.* 537.

Where the defendant in an action for infringement uses substantially the same devices as plaintiff, and produces the same result and certain other results differing from those produced by plaintiff, it will still be considered that the patent of plaintiff has been infringed and that defendant appropriates the invention of



complainant. *New York Rubber Co. v. Chaskel*, 9 *Pat. Off. Gaz.* 923.

The true test of identity between two designs is their sameness of effect upon the eye of an ordinary observer, bringing to the examination of the designs that degree of observation which men of ordinary intelligence give. In what cases the court may make the comparison. *Jennings v. Kibbe*, 10 *Fed. Rep'r*, 669 ; 20 *Blatchf.* 353 ; 22 *Pat. Off. Gaz.* 331.

To constitute an infringement there must be similarity of design, and substantial identity of purpose and result. Where similarity of design exists and a similar result is attained, in substantially the same way, by the use of a device which, although intended to operate in a different way, did not so operate, such use will nevertheless be an infringement. *Henderson v. Co-operative Stove Co.*, 2 *Bann. & A. Pat. Cas.* 604.

It must always be very much a matter of judgment to the eye, in the examination of two machines, and in observing their mode of operation, whether the one, in the whole, or in any of its parts, is a mere colorable or formal alteration of the other. If a patentee has invented a combination of two or more old things, so as to produce a new and useful result, he has a right to treat as infringers all who have used his invention, in order to accomplish something more or better, when, without the aid of such invention, it could not be effected. *Sayles v. Chicago & North-western R. R. Co.*, 4 *Fish. Pat. Cas.* 584 ; but see reversal, 97 *U. S.* 554.

A patent cannot be defeated by dividing a patented device into two parts, which, when combined, produce the same result in substantially the same way. *Strobridge v. Lindsay*, 6 *Fed. Rep'r*, 510 ; 19 *Pat. Off. Gaz.* 1285 ; 11 *Rep'r*, 734.

A patent for the application of heat to a particular purpose is infringed by the use of the same process for the same purpose, and with the same result, although a higher degree of heat is used. *Cary v. Wolff*, 24 *Fed. Rep'r*, 139 ; 32 *Pat. Off. Gaz.* 257 ; *Cary v. Lovell Manuf. Co.*, 24 *Fed. Rep'r*, 141 ; 32 *Pat. Off. Gaz.* 1009 ; *Cary v. Domestic Spring Bed Co.*, 34 *Pat. Off. Gaz.* 1158.

A patent for a fabric is infringed by the use, without license, of the fabric, although less is used than the patentee uses in the manufacture of similar articles. *Celluloid Manuf. Co. v. Chrolithion Collar, &c. Co.*, 23 *Fed. Rep'r*, 397 ; 31 *Pat. Off. Gaz.* 519. Adhered to on rehearing, 25 *Id.* 482.

Where contrivances or devices are substantially identical, there

is an infringement Yale Lock Manuf. Co. v. Sargent, 117 *U. S.* 536.

170. *Identity in Principle, sufficient.*

A difference in mechanism, such that the same result is produced in a different way, is a difference in principle. Silsby v. Foote, 14 *How.* 218; 1 *Blatchf.* 445.

To constitute an infringement, the thing used by the defendant must be such as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. It is not necessary that the defendant should employ the plaintiff's invention to as good advantage as he employed it, or that the result should be precisely the same in degree; but it must be the same in kind. But, generally, where a patentee describes a machine, and then claims it as described, to copy the principle, or mode of operation described, is an infringement, however unlike the original the copy may be. Winans v. Denmead, 15 *How.* 330.

That is a substantial identity which comprehends the application of the principle of the invention. If a defendant's device merely adopts a different mode of carrying the same principle into effect, and the principle admits a variety of forms, there is an identity of principle, although not an identity of mode. Page v. Ferry, 1 *Fish. Pat. Cas.* 298.

An improvement in the principle of a machine is no invasion of the rights of the inventor and patentee of such machine. The rule is otherwise when it is only an improvement in the form. Reutgen v. Kanows, 1 *Wash.* 168; Park v. Little, 3 *Wash.* 196; Smith v. Pearce, 2 *McLean*, 176.

It is generally true that when a patentee describes a machine, and then claims it as described, he covers not only the precise forms he has described, but all other forms which embody his invention; and to copy a principle or mode of operation described, is an infringement, although such copy is totally unlike the original in form or proportions. Grier v. Castle, 17 *Fed. Rep'r*, 523; 24 *Pat. Off. Gaz.* 1176.

It is no defense to an infringement that the machine or product is not as good as the patentee's, if it operates or is produced in substantially the same way (Roberts v. Harnden, 2 *Cliff.* 500); nor that defendant's machine is superior to the patentee's, unless it is

shown that there is a substantial difference. *Alden v. Dewey*, 1 *Story*, 336 ; 3 *L. Rep'r*, 383.

If the principle on which the machinery works is the same, and the effect is similar in both, the machines are identical in law. *Brooks v. Bicknell*, 3 *McLean*, 250 ; 1 *West. L. J.* 150.

To establish an 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. If the operative principles of the two machines be the same, the substantial identity contemplated by the patent law is established. *Parker v. Stiles*, 5 *McLean*, 44 ; 7 *West. L. J.* 168.

A well known principle or truth of natural science, as well as a newly discovered one, is patentable to the first applicant of it in the useful arts ; but having once been made known and applied, any subsequent application must, to insure a patent, rest upon new machinery or combination of machinery, and not upon the principle the novelty of which has been exhausted. Even though the application of the principle, in prior patents, was not so perfectly made as it might have been or as it would be made by using the forms of machinery suggested in the specifications of an applicant for a new patent, this does not entitle the latter to a patent for the principle. *Re Henry*, 1 *MacArthur Pat. Cas.* 467.

Patent issued to Nobel, in 1865, relating to use of nitro-glycerine as a substitute for gunpowder, was *held* not to cover the use of a capsule or percussion cap, operating by its detonation, as a means of exploding nitro-glycerine ; the principle of the patent being explosion effected by heat and pressure. *Atlantic Giant Powder Co. v. Hulings*, 21 *Fed. Rep'r*, 519.

Two devices or inventions infringe if they are substantially alike. In determining the question of infringement, the court or jury are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do or what office or function they perform, and to find that one thing is substantially the same as the other, if it performs substantially the same function in substantially the same way, to obtain the same result ; and should always bear in mind that devices in a patented machine are "different" in the sense of the patent law when they perform different functions, or in a different way, or produce a substantially different result. *Cantrell v. Wallick*, 117 *U. S.* 689.

171. *What is the "Principle" of a Machine.*

In an action for an infringement, the first question for consideration is whether the machine used by the defendant is substantially, in its principles and mode of operation, like the plaintiff's. If so, it is an infringement to use it. *Odiorne v. Winkley*, 2 *Gall.* 51; *Howe v. Abbott*, 2 *Story*, 190; *Grant v. Mason*, 1 *L. Int. & Rev.* 22; *Parker v. Haworth*, 4 *McLean*, 370.

What constitutes form, and what principle, is often a nice question to decide. The safest guide to accuracy in making the distinction is to ascertain what is the result to be obtained by the discovery; and whatever is essential to that object, independent of the mere form and proportions of the thing used for the purpose, may generally, if not universally, be considered as the principle of the invention. *Treadwell v. Bladen*, 4 *Wash.* 703, 706; *Gray v. James*, *Pet. Ct. Ct.* 394; *Olcott v. Hawkins*, 2 *Am. L. J. N. S.* 319; *Inlay v. Railroad Co.*, 1 *Fish. Pat. Cas.* 340; 4 *Blatchf.* 227.

Principle, in machines, is not a new mechanical power—none such have been discovered for centuries. That is a principle which applies, modifies or combines mechanical powers to produce a certain result. *Smith v. Pearce*, 2 *McLean*, 176.

Where two machines or things are made to operate substantially in the same way, so as to produce the same result, they are considered the same in principle. Thus, where any of the mechanical powers, the lever, screw, wheel, &c., are used to accomplish certain purposes, the same powers being used, the fact that they are used in a somewhat different form, to do the same thing, will not constitute a difference in principle. Whether the mechanical instruments be larger or smaller, whether their action be horizontal or vertical, the principle is the same. *Roberts v. Ward*, 4 *McLean*, 565.

The principle of a machine is the particular means of producing a given result by a mechanical contrivance (*Parker v. Stiles*, 5 *McLean*, 44, 63; 7 *West. L. J.* 168; *Brooks v. Jenkins*, 3 *McLean*, 432; 2 *West. L. J.* 11), independent of mere form. *Olcott v. Hawkins*, 2 *Am. L. J. N. S.* 317. And see *Le Roy v. Tatham*, 22 *How.* 132; *Tatham v. LeRoy*, 2 *Blatchf.* 474; 7 *West. L. J.* 431.

The machinery or apparatus by which a principle is applied to practical uses is not of the essence of the invention, when a patent

is sought for the process ; and lack of novelty or utility in the mere arrangement of machinery described in the specification is no objection to such an application. *Re Henry*, 1 *MacArthur Pat. Cas* 467.

### 172. *Formal Changes.*

A change in or variation from the plaintiff's machine, which affects merely its form or proportions, &c., or involves merely the substitution of one mechanical equivalent for another, does not constitute such a change as will relieve the defendant from the charge of infringement. *Winans v. Denmead*, 15 *How.* 330, 342 ; *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54 ; *Gorham v. Mixer*, 1 *Am. L. J. N. S.* 543 ; 19 *Hunt Mer. Mag.* 296 ; 5 *West. L. J.* 525 ; *Sargent v. Larned*, 2 *Curt.* 310 ; *Miller's Falls Co. v. Backus*, 17 *Pat. Off. Gaz.* 852 ; 5 *Bann. & A. Pat. Cas.* 53 ; *McWilliams Manuf. Co. v. Blundell*, 11 *Fed. Rep'r*, 419 ; 22 *Pat. Off. Gaz.* 177 ; *Blanchard v. Beers*, 2 *Blatchf.* 411 ; *American Pin Co. v. Oakville Co.*, 3 *Blatchf.* 190 ; 3 *Am. L. Reg.* 136 ; *Sickels v. Borden*, 3 *Blatchf.* 535 ; *Poppenhusen v. Falke*, 5 *Wash.* 46 ; *Dixon v. Moyer*, 4 *Wash.* 68.

Where one particular geometrical form alone is capable of embodying the invention, that form must be used, to amount to an infringement. Otherwise, where that form is the best, but other forms may and do embody the invention. *Winans v. Denmead*, 15 *How.* 330.

Form, when of the essence of an invention, is necessarily material ; and, if it be inseparable from the successful operation of the machine, the attainment of the same object by a machine different in form is not an infringement. *Werner v. King*, 98 *U. S.* 219.

Patent issued to Tate, in 1871, for an improvement in quilting machines, was held to be infringed by a machine involving a change by which no new result was obtained, although an aggregation of results was accomplished. *Tate v. Thomas*, 22 *Fed. Rep'r*, 660 ; 30 *Pat. Off. Gaz.* 345.

Except where form is of the essence of the invention, it has but little weight in the decision of an issue whether two patents have been issued for the same invention. The correct rule is, that in determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences

by the name of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way, to obtain the same result ; always bearing in mind that devices in a patented machine are "different" in the sense of the patent law when they perform different functions, or in a different way, or produce a substantially different result. *Machine Co. v. Murphy*, 97 *U. S.* 120.

A formal change in an important part of a machine, requiring a modification of other parts to meet the change, is an infringement. *Union P. B. M. Co. v. P. & U. Co.*, 15 *Pat. Off. Gaz.* 423 ; 15 *Blatchf.* 160 ; 3 *Bann. & A. Pat. Cas.* 403.

Where a patent extends only to the form or parts of the machine as set out, and made of any kind of materials, or saying nothing as to materials, the right would be violated by a machine of like form, as the form would be the only matter patented. But if the patentee chooses to go further, and cover the material of which a part of his machine is made, he entirely endangers his right to prosecute when a different and inferior material is employed, and especially one rejected by himself. *Aiken v. Bemis*, 3 *Woodb. & M.* 348.

Though, as a general rule, a patent only covers the improvement precisely described, and is not violated unless the defendant make use of the precise thing described in the patent, yet if the imitation be so nearly exact as to satisfy the jury that the imitator attempted to copy the model, and to make some almost imperceptible variation for the purpose of evading the right of the patentee, this will be considered a fraud upon the law, and such slight variation will be disregarded. *Davis v. Palmer*, 2 *Brock. Marsh.* 298.

Where the differences are merely in the form and not in the substance, and defendant's machine really shows the various parts described in the complainant's patent ; or where the various parts of defendant's machine exhibit mechanical parts equivalent to those in complainant's machine, and producing the same result, an infringement is established. *Graham v. Geneva Lake Crawford Manuf. Co.*, 11 *Fed. Rep'r*, 138 ; 21 *Pat. Off. Gaz.* 1536.

The use of a patented device, with all its beneficial results, is an infringement of the patent, notwithstanding a mechanical change in the form and arrangement of the parts, by which an effect addi-

tional to the one previously produced is obtained. *Hartford Woven Wire-Mattress Co. v. Peerless Wire-Mattress Co.*, 23 *Fed. Rep'r*, 587.

A patent for a machine is infringed by another machine which does the same work, in the same manner, and by the same means, although there are structural differences in parts of the infringing machine, and the manner of using it is different. *Sewing Machine Co. v. Frame*, 24 *Fed. Rep'r*, 596; 28 *Pat. Off. Gaz.* 96.

A patent for a new manufacture was *held* to be infringed by manufacturing a similar article with a change in the method employed, which, while it might be an improvement upon the patent or upon the specific arrangements therein detailed, was merely a change in construction. *Reed v. Street*, 34 *Pat. Off. Gaz.* 339.

A patent for an improvement in apple-paring machines consisted in so attaching the knife-block to the rod which moved it as to allow the knife-block to rotate round the rod at right angles, to accommodate itself to any irregularities in the surface of the fruit. The defendants, instead of making the knife movable in the rod, made the rod movable in its socket, but the knife-block had the same motion. This was *held* only a change of form, and therefore an infringement. *Sargent v. Larned*, 2 *Curt.* 346.

A change in the size of a machine, making it larger or smaller, while its mode of operation is not improved or affected, is not a patentable change; and when there is nothing in the patent as to the size of the machines to be made under it, the patentee has a right to make a machine just as large or just as small as he chooses under the specification of his patent. *Montross v. Bullard*, 27 *Fed. Rep'r*, 64.

Simple difference in size, form and degree does not escape the charge of infringement. *Armus v. Alden*, 27 *Fed. Rep'r*, 684.

Where two devices are essentially similar in construction of a particular element thereof, with a slight and immaterial variation in the method of attachment, but perform the same functions in each, there is an infringement. *Thayer v. Spaulding*, 27 *Fed. Rep'r*, 66.

### 173. *Nature and Measure of the Protection accorded to patented Process or Product.*

A person who, after a patent issued for a process, discovers a new mode of carrying out the process, and obtains letters patent

therefor, is not entitled to use the process without the consent of the prior patentee. *Tilghman v. Proctor*, 102 *U. S.* 707.

Unauthorized making an article according to a patented process, or selling it, is an infringement. *Bridgeport Wood Finishing Co. v. Hooper*, 5 *Fed. Rep'r*, 63 ; 18 *Blatchf.* 459 ; 20 *Pat. Off. Gaz.* 156.

A patent for a new manufacture is infringed by the manufacture of the new product by any process whatever. *Badische Anilin, &c. Fabrik v. Hamilton Manuf. Co.*, 13 *Pat. Off. Gaz.* 273 ; 3 *Bann. & A. Pat. Cas.* 235.

A patent for "ornamenting bracelets and other articles of jewelry" was *held* to be infringed by using the process on buttons. *Royce v. Fifield*, 18 *Fed. Rep'r*, 262.

A patent containing two claims,—one for a certain process set forth and the other for the compound made by the process,—is not infringed by the manufacture of a similar compound not made by the patented process. *Dittmar v. Rix*, 1 *Fed. Rep'r*, 342 ; 17 *Pat. Off. Gaz.* 973 ; 5 *Bann. & A. Pat. Cas.* 240.

In a patent for a process, every successive step enumerated in the claim must be regarded as an essential part, and must be employed by defendants in order to render them liable to the charge of infringement. *Hammerschlag v. Garrett*, 10 *Fed. Rep'r*, 479 ; 28 *Int. Rev. Rec.* 40.

Where a patent process consists of a number of steps, all well known except the first and last, the use of all except the first and last steps will not infringe the patent. *Heller v. Bauer*, 19 *Fed. Rep'r*, 96.

To constitute an infringement of a patented process, the process must be substantially followed. *Royer v. Chicago Manuf. Co.*, 20 *Fed. Rep'r*, 853.

If the patent does not fully describe everything essential to the making of the thing patented, there will be no infringement by the invention of processes which the patentee has withheld from the public. An infringement will not take place unless the invention can be practiced completely by following the specifications. *Page v. Ferry*, 1 *Fish. Pat. Cas.* 298.

Difference in degree of the process by which an end or result is attained is not a new or different process. *Commercial Manuf. Co. v. Fairbank Canning Co.*, 27 *Fed. Rep'r*, 78.

It being known to an art that a certain process will accomplish a certain result, the discovery that a better result may be obtained



by pursuing the process further is not a patentable discovery. *Smith v. Murray*, 27 *Fed. Rep'r*, 69.

A process the exact equivalent of an earlier patented process is an infringement. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

#### 174. Protection accorded to an Improvement of a Device already patented.

If improvements be made upon an invention which has been patented, by any person other than the inventor or patentee, the inventor of the original thing and those claiming under him have no right to use the improvements without a license from the inventor thereof; nor can the inventor of such improvements or any other person lawfully use the principal machine without the license of the inventor thereof. *Gray v. James*, *Pet. C. Ct.* 394; *Washburn v. Gould*, 3 *Story*, 122; 1 *West. L. J.* 465; 7 *L. Rep'r*, 276. S. P., *Goodyear v. Railroad*, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; *Filley v. Littlefield*, 25 *Fed. Rep'r*, 282; *Pitts v. Wemple*, 6 *McLean*, 558; *Whipple v. Baldwin Manuf. Co.*, 4 *Fish. Pat. Cas.* 29.

The fact that defendant has made improvements upon, or additions to, the invention patented by plaintiff, gives him no right to use the plaintiff's invention. *Alden v. Dewey*, 1 *Story*, 336; 3 *J. Rep'r*, 383; *Woodworth v. Rogers*, 3 *Woodb. & M.* 135; *Gorham v. Mixer*, 1 *Am. L. J. N. S.* 543; 19 *Hunt Mer. Mag.* 296; 5 *West. L. J.* 525; *Foster v. Moore*, 1 *Curt.* 279; *Howe v. Merton*, 13 *L. Rep'r, N. S.* 70; *Howes v. Nute*, 4 *Cliff.* 173; *White v. Heath*, 10 *Fed. Rep'r*, 291; 22 *Pat. Off. Gaz.* 500; *Parkhurst v. Kinsman*, 1 *Blatchf.* 488; 8 *N. Y. Leg. Obs.* 146; *Howes v. McNeal*, 15 *Pat. Off. Gaz.* 608; 15 *Blatchf.* 103; 3 *Bann. & A. Pat. Cas.* 376; *La Baw v. Hawkins*, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; *Union Stone Co. v. Allen*, 14 *Fed. Rep'r*, 353; *Westinghouse v. Gardner, &c. Air Brake Co.*, 9 *Pat. Off. Gaz.* 538; 2 *Bann. & A. Pat. Cas.* 55; *Foye v. Nichols*, 13 *Fed. Rep'r*, 125; 8 *Sawyer*, 201; 22 *Pat. Off. Gaz.* 2243; 13 *Fed. Rep'r*, 125.

Any person may improve a patented invention, but all that he can patent is his improvement. *Colt v. Mass. Arms Co.*, 1 *Fish. Pat. Cas.* 108.

A mere change of form in arrangement of parts does not enable

him who has devised it to treat as an infringer one who improves the form or combination. Otherwise, when something elementary is newly discovered which fairly constitutes a part of the invention. *Taylor v. Garretson*, 5 *Fish. Pat. Cas.* 116; 9 *Blatchf.* 156; *Merriam v. Van Nest*, 13 *Pat. Off. Gaz.* 597; *Cornell v. D. & B. Brewing Co.*, 11 *Pat. Off. Gaz.* 331; 7 *Biss.* 346; 2 *Bann. & A. Pat. Cas.* 514.

A patent for an improvement embraces nothing more than the improvement described and claimed as new; any one who afterward discovers a method of accomplishing the same object, substantially and essentially differing from the one described, has a right to use it. *O'Reilly v. Morse*, 15 *How.* 62, 119.

If an invention is only an improvement on a known machine, the patentee cannot treat another as an infringer who has improved the original machine by using a different form or combination performing the same functions. *McCormick v. Talcott*, 20 *How.* 403.

Where a party having made application for a patent for certain improvements, afterward, with his claim still on file, makes application for another but distinct improvement, but does not in such second application claim it as original, the description in such second application, and non-claim of it there, is not a dedication of the first invention to the public. *Suffolk County v. Hayden*, 3 *Wall.* 315.

When several patents are issued for improvements upon the same general structure, each patentee is liable to all prior patentees to the extent to which he adopts their improvements. *Warth v. Browning*, 17 *Pat. Off. Gaz.* 624; 5 *Bann. & A. Pat. Cas.* 341.

Although improvements may be made in the separate devices constituting a combination, which improvements may be the proper subject of a patent, yet if the combination made by the defendant embraces and shows the elements of the plaintiff's invention, operating substantially in the same manner to produce the same results, it must be treated as an infringement. *Hartshorn v. Shorey*, 9 *Pat. Off. Gaz.* 595.

An improvement in the construction of a portion of a patented mechanism, by which it performs an additional function to that in the original invention, does not justify the use of the original invention. Nor does the fact that some of the devices of the combination are old defeat the validity of the patent. *Strobridge v. Lindsay*, 2 *Fed. Rep'r.* 692; 18 *Pat. Off. Gaz.* 62; *Bann. & A. Pat. Cas.* 411.

A patent for a mere improvement if limited in its scope to the method of arrangement of devices described and claimed in it as new, is not infringed by the use of substituted devices, different in character and dissimilar in form, although they may perform some of the functions of the patented devices, or may effect the same general result. *Dyer v. National Hod Elevating Co.*, 24 *Fed. Rep'r.* 182.

Letters patent for an improvement on a patented invention cannot be declared void because they include such patented invention. And a party who is infringing both the improvement and the original invention cannot set up the existence of the first patent as an excuse for infringing the improvement. *Cantrell v. Wallick*, 117 *U. S.* 689.

A patent for an improvement can not be so extended as to include the older process of the art of the process or science. *Globe Nail Co. v. Superior Nail Co.*, 27 *Fed. Rep'r.*, 450.

Where there are a number of devices, all acting substantially upon the same principle, and a patent is granted for a device which has, in addition to the elements common to all, a special feature possessed by it alone, the patent can be upheld so as to protect such special feature; but it cannot be so construed as to include other machines which are mere adaptations or simplifications of other older devices. *Montross v. Bullard*, 27 *Fed. Rep'r.*, 64.

### 175. *To a Combination.*

To constitute an infringement of a patent for a combination of several elements, the defendant must have used all the elements of the combination. If he has used some of them only, omitting one or more, without substituting any equivalent therefor, there is no infringement. *Prouty v. Ruggles*, 16 *Pet.* 336; *aff'g* 1 *Story*, 568; *Stimpson v. Baltimore & Susquehanna R. R. Co.*, 10 *How.* 329; *Brooks v. Fiske*, 15 *How.* 210; *McCormick v. Talcott*, 20 *How.* 402; *Eames v. Godfrey*, 1 *Wall.* 78; *Barrett v. Hall*, 1 *Mas.* 447; *Moody v. Fiske*, 2 *Mas.* 112; *Howe v. Abbott*, 2 *Story*, 190; *Aiken v. Bemis*, 3 *Woodb. & M.* 348; *Gorham v. Mixer*, 1 *Am. L. J. N. S.* 543; 19 *Hunt Mer. Mag.* 296; 5 *West. L. J.* 525; *Evans v. Eaton*, *Pet. Ct.* 322; *Gray v. James*, *Id.* 394; *Brooks v. Bicknell*, 4 *McLean*, 70; 3 *West. L. J.* 109; *Root v. Ball* 4 *McLean*, 177; *Parker v. Haworth*, *Id.* 370; *McCormick*

*v. Manny*, 6 *McLean*, 539 ; 4 *Am. L. Reg.* 277; *Pitts v. Wemple*, 6 *McLean*, 558 ; *Fay v. Allen*, 24 *Fed. Rep'r*, 804 ; 32 *Pat. Off. Gaz.* 1355 ; adhered to on rehearing, 25 *Pat. Off. Gaz.* 201. And see *Foster v. Moore*, 1 *Curt.* 279 ; *Sands v. Wardell*, 3 *Cliff.* 277 ; *Storrs v. Howe*, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 421 ; *Sanford v. Merrimac Hat Co.*, 10 *Pat. Off. Gaz.* 466 ; *Gould v. Spicers*, 20 *Fed. Rep'r*, 317 ; *Matteson v. Caine*, 17 *Fed. Rep'r*, 525 ; *Huggins v. Hubby*, 3 *West. L. Month.* 347 ; *Howe v. Neemes*, 18 *Fed. Rep'r*, 40 ; *Saladee v. Racine Wagon, &c. Co.*, 20 *Fed. Rep'r*, 686 ; 27 *Pat. Off. Gaz.* 1133 ; *Hovey v. Henry*, 3 *West. L. J.* 153 ; *Westlake v. Carter*, 4 *Pat. Off. Gaz.* 636 ; 6 *Fish. Pat. Cas.* 519.

Where, in an action for an infringement of a patent for an invention, which, as claimed in the patent, consists of several elements in combination, the defendant shows that in his article one of the elements claimed by the plaintiff is not used, the plaintiff will not be allowed to avoid that defense by setting up that such element is immaterial. *Vance v. Campbell*, 1 *Black*, 427 ; rev'g 1 *Fish. Pat. Cas.* 483.

Where a patent is made up of several constituent steps of which the patentee is not the inventor, he has no claim to the constituents singly ; his patent only secures him their use when arranged in the process. *Mowry v. Whitney*, 14 *Wall.* 620.

If the subsequent combination is new, or if the ingredient substituted for the one withdrawn is a newly discovered one, or even an old one performing some new function, and was not known at the date of the patent as a proper substitute for the ingredient withdrawn, there is no infringement; for a new combination, or a newly discovered ingredient substituted for the one omitted, or even an old one performing a new function not known at the date of the patent as a proper substitute for the one withdrawn, is not an equivalent for the ingredient omitted, within the meaning of the patent law. *Fuller v. Seutzer*, 94 *U. S.* 299 ; 1 *Bann. & A. Pat. Cas.* 520 ; *Seymour v. Osborne*, 11 *Wall.* 516.

Where the thing patented is an entirety, consisting of a separate device, or of a single combination of old elements incapable of division or separate use, a defense on the ground of want of novelty cannot be established by proving that a part of the entire invention is found in one prior patent, printed publication or machine, and another part in another, and so on indefinitely, and from the whole or any given number allowing the court to determine the issue of

novelty adversely to the complainant. Common justice forbids such a defense, as it would work a virtual repeal of so much of the patent act as gives to inventors the right to a patent consisting of old elements, where the combination itself is new and produces a new and useful result. New elements in such a patent are not required, and if such a defense were allowed, not one patent of the kind in a thousand of modern date could be held valid. Nor is such a defense consistent with the regulations enacted by Congress in respect to the procedure in litigations in respect to patent rights. *Parks v. Booth*, 102 *U. S.* 96; aff'g 1 *Ellipin*, 281; 1 *Bann. & A. Pat. Cas.* 225.

A patent for a combination is not infringed by using one part of it combined with other devices substantially different from those described in the patent, in form or mode of arrangement and combination with the other parts. *McMurray v. Mallory*, 111 *U. S.* 97.

A patent for a combination is not infringed by a use of one element in the combination unless it be used in connection with mechanical equivalents known when the patent was granted, substituted for the omitted element. *Rowell v. Lindsay*, 113 *U. S.* 97; *Voss v. Fisher*, *Id.* 213. S. P., *Schillenger v. Cranford*, 2 *Cent. Rep'r*, 680.

A subordinate device is not an "element," within the rule which requires the use of all the elements of a combination to constitute an infringement. *Smith v. Fay*, 6 *Fish. Pat. Cas.* 446.

If a substance was not known as a substitute for a certain element in a combination, at the time of the invention of the combination, the use of it in lieu of that element is not an infringement. *Colgate v. Law Tel. Co.*, 5 *Bann. & A. Pat. Cas.* 437.

If the patentee names a specific material for one element of his combination, using another material for that element is not an infringement. *Harris v. Allen*, 15 *Fed. Rep'r*, 106.

The improvement of one element of a combination does not give the right to use or appropriate the original combination. *Stainthorp v. Humiston*, 4 *Fish.* 107; *Converse v. Cannon*, 2 *Woods*, 7; 9 *Pat. Off. Gaz.* 105.

If the defendant has merely substituted an equivalent for one of the elements of the patented combination, he infringes it, although his combination includes other functions and produces other effects not attainable by the patented combination. *Sarven v. Hall*, 5 *Fish.* 415; 9 *Blatchf.* 524; 1 *Pat. Off. Gaz.* 437; *Whee-*

ler v. Clipper Co., 6 *Fish.* 1; 10 *Blatchf.* 181; 2 *Pat. Off. Gaz.* 442.

If the defendant has a patent for a combination which contains as one of its elements the principle embodied in the complainant's patent, it is an infringement. *Cleveland v. Towle*, 3 *Fish. Pat. Cas.* 525.

A combination is patentable only when the several elements of which it is composed produce by their joint action a new and useful result, or an old result in a cheaper or otherwise more advantageous way. *Stephenson v. Brooklyn Cross-Town Railroad Company*, 114 *U. S.* 149; 5 *Sup. Ct. Rep'r*, 781.

Where a defendant, in constructing his machine, omits entirely one of the ingredients of the plaintiff's combination, without substituting another, he does not infringe; nor does he infringe in case he substitutes another in place of the one omitted, which performs a different function, or which is new, or which, though old, was not known, at the date of the plaintiff's invention, as a proper substitute for the omitted ingredient. *Gould v. Rees*, 15 *Wall.* 187.

Inasmuch as a combination of old elements is only an improvement upon what was before known, and without the new combination the whole would have been the property of the public, when such a combination is patented, it is infringed by every subsequent combination of the same elements as those which compose it; and no subsequent combination is substantially different from the patented one, merely because it was in a single device different from one of its elements, provided such substituted device was at the date of the patent a well-known substitute for the omitted one. *Sands v. Wardell*, 3 *Cliff.* 277.

Where all the elements of a machine are old, and the invention consists solely in the combination, by which a new and useful result is effected, as compared with the old machine on which the improvement is made, no one can be held as an infringer who does not use all of the elements of the new combination. But if defendant uses the same elements in substantially the same way and so as to produce substantially the same result, he is liable. *Roberts v. Harden*, 2 *Cliff.* 500.

Although one person has patented a combination, which, however, turns out to be useless, if another adds to the combination another element, and thereby makes the whole practically useful, the person who adds this last element is not an infringer, but is

entitled to use, not merely his improvement,—requiring first a license to use the former combination,—but he may use the whole. *Robertson v. Hill*, 4 *Pat. Off. Gaz.* 132 ; 6 *Fish. Pat. Cas.* 465.

A patent for a mere combination of three distinct devices is not infringed by the use of only two of such devices without the other, if there is a substantial difference between the two machines. *Rich v. Close*, 8 *Blatchf.* 41 ; 4 *Fish. Pat. Cas.* 279.

If a patent is for a mere arrangement or combination of old devices to produce a somewhat better result in a known art, the substitution of a new element, not known at the date of the patent, may avoid infringement. *American Bell Telephone Co. v. Spencer*, 8 *Fed. Rep'r*, 509 ; 20 *Pat. Off. Gaz.* 299.

The use of a worthless patented combination, in connection with a new element that renders the whole useful, cannot be punished as an infringement of the patent for the worthless combination. *Bliss v. Brooklyn*, 6 *Fish. Pat. Cas.* 289.

Where a patented invention is merely a combination subordinate to pre-existing devices and has been limited to such sub-combination by the language of the claim, the patentee cannot successfully insist that he is entitled to cover by such claim the pre-existing devices ; and this is true where one of the joint inventors of the junior invention is also the inventor of the senior inventions. *The Hopkins, &c. Manuf. Co. v. Corbin*, 14 *Blatchf.* 396.

A patent for a combination of new elements with old may secure the new elements by themselves as well as the combination. *American Diamond Rock Boring Co. v. Sutherland Falls Marble Co.*, 2 *Fed. Rep'r*, 353 ; 18 *Blatchf.* 148 ; 10 *Rep'r*, 9 ; 5 *Bann. & A. Pat. Cas.* 347.

Where a patent for a combination of known parts is not infringed by the use of any number of the parts less than the whole, yet if some of the parts are new, the like use of such parts, though with different devices from the rest of the combination, is an infringement to that extent. *Sharp v. Tiffit*, 2 *Fed. Rep'r*, 697 ; 18 *Blatchf.* 132 ; 17 *Pat. Off. Gaz.* 1282 ; 5 *Bann. & A. Pat. Cas.* 39<sup>a</sup>.

Complainant filed a bill for infringement of a patent for a combination against one who had erected a machine containing all the parts of the patented combination but one. After the filing of the bill this latter part was added. It was *held* that the bill must be dismissed, as there was proof that this part was not a necessary incident to the machine, and that its use was not contemplated at

the time of the construction of the machine. *Maynard v. Pawling*, 3 *Fed. Rep'r*, 711; 18 *Pat. Off. Gaz.* 244; 5 *Bann. & A. Pat. Cas.* 551.

If a patented combination of numerous parts includes in it other new and useful combinations of less of the parts, the patentee is entitled to the exclusive use of the lesser combinations as well as the exclusive use of the whole. *Holly v. Vergennes Machine Co.*, 4 *Fed. Rep'r*, 74; 18 *Blatchf.* 327; 18 *Pat. Off. Gaz.* 1177.

Using a part of a patented combination is an infringement, if that part is separable and was new and patentable to the inventor. *Adair v. Thayer*, 4 *Fed. Rep'r*, 441; 17 *Blatchf.* 468; 9 *Rep'r*, 401; 4 *Bann. & A. Pat. Cas.* 118.

A combination for a fruit-preserving jar, all the elements of which, except a device to secure more effectual sealing are old, is a new and original invention. If all the essential elements of the combination have not been before embodied and employed together, it is to be taken as original. *McCulley v. Cunningham*, 3 *Pittsb.* 366.

The elements of a combination being old *per se*, the essence of the invention consists in the novelty of their combination and its adaptation to the use for which it is intended; and its infringement will consist in the use of a machine substantially embodying the combination in its entirety for the same purpose. *Smith v. Marshall*, 10 *Pat. Off. Gaz.* 375; 2 *Bann. & A. Pat. Cas.* 371.

A distinct claim for each of the constituents of a combination of old elements will not protect such combination where there has been no specific claim for the same. *Delaware Coal, &c. Co. v. Packer*, 1 *Fed. Rep'r*, 851; 24 *Pat. Off. Gaz.* 1273; 5 *Bann. & A. Pat. Cas.* 296.

Any new combination of old ingredients is patentable when any new, useful results follow; but the mere exercise of judgment or mechanical skill in selecting a few ingredients from a larger number already known and specified in prior patents is not an invention. *Welling v. Crane*, 14 *Fed. Rep'r*, 571; 23 *Pat. Off. Gaz.* 189.

It is not essential to a patentable combination that the several devices or elements should co-act upon each other, provided all cooperate. *Stutz v. Armstrong*, 20 *Fed. Rep'r*, 843; 28 *Pat. Off. Gaz.* 367.

The manufacture and sale by a defendant of stove-pipes, elbows, valves and the like apparatus, such as are used and which are intended to be used in a patented combination of such articles with



others not manufactured and sold by the defendant, but which may be and are used in other combinations, do not necessarily infringe the patent for the particular combination. *Millner v. Schofield*, 4 *Hughes*, 258.

A patent claiming combinations separate in their nature but capable, if desired, of separate use, was *held* not to be a unit, and use of all the parts was adjudged not necessary to constitute an infringement. *Densmore v. Schofield*, 4 *Fish. Pat. Cas.* 148.

No one infringes a patent for a combination who does not employ all the ingredients of the combination; but if he employs all the ingredients, or adopts mere formal alterations, or substitutes for one ingredient another which was well known at the date of the patent as a proper substitute for the one withdrawn, and which performs substantially the same function as the one withdrawn, he does infringe. *King v. Louisville Cement Co.*, 4 *Pat. Off. Gaz.* 181; 6 *Fish. Pat. Cas.* 336.

If the patent is for a combination, and on that a recovery is sought, the complainant may recover for the element that he has added. *Ingels v. Mast*, 1 *Flippin*, 424; 2 *Bann. & A. Pat. Cas.* 24.

Where the invention consists not only in the combination, but in the improvement of several of the parts of the combination, the violation of one of them is an infringement for which an action will lie. *Parker v. Haworth*, 4 *McLean*, 370.

If the whole of the combination be taken, though something be added, still it is an infringement. *Pitts v. Wemple*, 6 *McLean*, 558.

A patent for a combination of known parts is not infringed by the use of any number of the parts less than the whole; or by the substitution of a new element, or of one that performs a substantially different function; or by the substitution of an old element not known at the date of the patent as a proper substitute for the omitted ingredient; or by a new combination of the existing elements of the patented combination. A combination must be maintained as an entirety, and no one separate element can be regarded as the distinctive and essential feature of the invention. *Rowell v. Lindsay*, 6 *Fed. Rep'r*, 290; 10 *Biss.* 217; 17 *Pat. Off. Gaz.* 1565.

A patent for the combination of old parts is not infringed by a different combination of the same parts to produce the result. *Pattee v. Moline Plow Co.*, 9 *Fed. Rep'r*, 821; 10 *Biss.* 377; 22.

*Pat. Off. Gaz.* 173 ; Washburn, &c. Manuf. Co. v. Griesche, 16 *Fed. Rep'r*, 669 ; 5 *McCrary*, 246.

A patent for a combination of mechanical devices is not infringed by the use of a mere element of the combination previously well known. *Underwood v. Warren*, 24 *Fed. Rep'r*, 182.

Using one of the important parts of a combination may be an infringement of a patent for the combination. *Matthews v. Spangenberg*, 15 *Rep'r*, 261.

Where old devices are brought together to co-operate in producing a result which has not been produced before by the same elements, the invention is patentable although the same result may have been produced before by some of the elements of the combination acting with others, but in a substantially different way. *Hoe v. Knap*, 27 *Fed. Rep'r*, 204.

In patents for combinations of mechanisms, limitations and provisos imposed upon the inventor are to be strictly construed. The production of an old result by a more effective combination of old elements, by one patentee, will not prevent another patentee from making new combinations of such elements to produce the same result, if the latter does not use the combination of parts claimed in the first patent. *Otis Bros. Manuf. Co. v. Crane Bros. Manuf. Co.*, 27 *Fed. Rep'r*, 550.

A device is patentable although the elements are old, if the combination is new, and produces a new and useful result, and if to produce it required more than mere mechanical skill. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

A combination of old elements for a new purpose is patentable. *Donoughe v. Hubbard*, 27 *Fed. Rep'r*, 742.

A patent for an improved baggage-check holder, claiming only a combination which included flanges bent over for holding the check securely, was *held* not infringed by a device for the same purpose having such flanges but no other element of the combination. *Abbott v. Hoole Manuf., &c. Co.*, 31 *Pat. Off. Gaz.* 156.

The claim of a specific device or combination in a patent, and the omission to claim other devices or combinations apparent on its face, are in law a dedication to the public of that which is not claimed. *Hill v. Comrs. of Patents*, 1 *Cent. Rep'r*, 91.

In a patent for a new and useful improvement in the mode of forming rails for railroad carriages, for use in cities, &c., "where it is desirable that the wheels of ordinary carriages should not be subjected to injury or obstruction," the patentee claimed the em-

ployment of plates or rails having narrow grooves on each side of the track for the flanges of the car wheels to run in, by which they were adapted to the unobstructed passing over them of the various kinds of common carriages, such rails being also sunk to a level with the surface of the street. It was *held* that such patent consisted of the combination of such grooves with the rail, on both sides of a railroad track, such combination being depressed to a plane corresponding with the street; and that the use by the defendant of a double iron rail, with a groove or interval between large enough for the flange of the wheel, placed on the inner side of a curve, the ordinary flat iron rail being used on the exterior line of the same curve, and the whole constructed on the same plane with the general track of the road, without regard to the convenience of carriages to pass over it, was not an infringement of such combination, it having used but one element of the plaintiff's combination. *Stimpson v. Baltimore & Susquehanna R. R. Co.*, 10 *How.* 329, 346.

In a patent for a combination, with other elements, of heating pipes described in the specification as constructed with flexible tubes, gum tubing or suitable rock-joints, so as to permit the elevation and lowering of the pipes without interfering with the circulation of steam through them, the flexible joints are distinguishing and essential features of the construction of the pipes; and a machine without hinge joints is not an infringement of the combination. *Sheeder v. Shannon*, 25 *Fed. Rep'r*, 824.

#### 176. *To a Composition of Matter.*

In a patent for an improvement in making friction matches, the invention was not a compound of new ingredients, but was simply a new combination of materials before in use for that purpose, consisting of a composition formed of phosphorus with the earthy material and glutinous substance only, without chlorate of potash or other like objectionable ingredients. It was *held* that any person might use any one or all the materials forming the composition, provided he did not use them in the combination patented, or that any one might use them in combination with chlorate of potash, as they were formerly used. But a mere colorable difference or slight variation of such a combination will not exempt a person from the charge of infringement. *Byam v. Eddy*, 2 *Blatchf.* 521; 23 *Vt.* 666.

In an action for an infringement of a patent for a compound, if the defendants do not use the entire combination, but use another ingredient producing another result, they do not infringe. *Smith v. Murray*, 27 *Fed. Rep'r*, 69.

### 177. *The Doctrine of Equivalents, in General.*

In the administration of the patent law the substantial equivalent of a thing is deemed the same as the thing itself. Two devices which perform the same function in substantially the same way, and accomplish substantially the same result, are treated as the same, though they may differ in name or form. *Machine Co. v. Murphy*, 97 *U. S.* 120.

Where all the elements of a machine are old, the patentee cannot invoke the doctrine of equivalents to suppress all other improvements on the old machine. But he is an infringer who makes or vendes the patented improvement with no other change than the employment, as a substitute for one of its elements, of a device well known in the state of the art to be such at the date of the invention, and which any constructor acquainted with the art would then know how to employ. Such substitution of one well-known element for another is a mere colorable evasion of the patent. *Union Sugar Refinery v. Mathiessen*, 3 *Cliff.* 639; 2 *Fish. Pat. Cas.* 600.

The term "equivalent" has two meanings; the one relates to the results that are produced, and the other to the mechanism by which those results are produced. Two things may be equivalent, that is, the one equivalent to the other as producing the same result when they are not the same mechanical means. In other words there may be equivalents in the sense of producing the same result, each of which is an independent matter of invention. *Johnson v. Root*, 1 *Fish. Pat. Cas.* 351; *Burden v. Corning*, *Id.* 477.

The action of the commissioner of patents, in requiring a disclaimer of so much of the reissued patent as claimed in specific terms the use of a specified equivalent, is not conclusive upon complainants. The patentee, without describing equivalents, is entitled to use equivalents and to treat the use of equivalents by others as an infringement. *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 11 *Pat. Off. Gaz.* 1113.

One substance does not constitute the equivalent of the other

when each produces a different product under the same conditions. *Clarke v. Johnson*, 4 *Fed. Rep'r*, 437; 18 *Blatchf.* 450; 18 *Pat. Off. Gaz.* 1276.

The defendant employed the plaintiffs' patented process of treating tobacco, with the exception that he made use of an equivalent for the gum arabic used by the plaintiffs to produce the same effect as that rendered by the plaintiffs' process. This was held an infringement. *Kimball v. Hess*, 15 *Fed. Rep'r*, 393; 15 *Rep'r*, 583; 26 *Pat. Off. Gaz.* 107.

Mechanical equivalents are not those merely which produce the same result; a mechanical equivalent, as generally understood, is where one device may be adopted instead of another to perform the known function of the latter, by a person skilled in the art, from his knowledge of the art. *Smith v. Marshall*, 10 *Pat. Off. Gaz.* 375; 2 *Bann. & A. Pat. Cas.* 371; *Johnson v. Root*, 1 *Fish. Pat. Cas.* 351; *Burden v. Corning*, 2 *Id.* 477.

Though the defendant's machine may be simpler, cheaper, and possibly better than the complainant's patented machine, yet if its chief efficiency arises from the use of equivalents to the complainant's patent, it is infringement. *Odiorne v. Denney*, 3 *Bann. & A. Pat. Cas.* 287; 1 *N. J. L. J.* 183.

Where a person procures a patent for the building of a machine which produces certain novel and useful results by means of certain mechanical contrivances and appliances, any application of known mechanical powers which will produce such results, although different in form from the means employed by the original patentee, is a mechanical substitute and equivalent of the same. *Wilt v. Grier*, 5 *Fed. Rep'r*, 450; 19 *Pat. Off. Gaz.* 427.

A device is the equivalent of one that is patented, if it performs substantially the same function, in the same way, and produces the same result; though it may be of a different form and bear a different name, its use will be an infringement. *Westlake v. Cartter*, 4 *Pat. Off. Gaz.* 579; 6 *Fish. Pat. Cas.* 519.

Devices are equivalents when those skilled in the science or art know that one will produce the same result as the other. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

One patent infringes another when the second device works out the same result as the first by substantially the same means, using equivalent parts to perform the functions performed by the elements of the first mechanism. *Holliday v. Covel*, 27 *Fed. Rep'r*,

217 ; *Conover v. Roach*, 4 *Fish. Pat. Cas.* 12 ; *Merriam v. Drake*, 5 *Id.* 259 ; 9 *Blatchf.* 336.

A rod is the known equivalent of an endless chain in machinery, where it can be used for the same purpose and with like effect. According to the principles of patent law, they are not substantially different. *Spain v. Gamble*, 1 *MacArthur Pat. Cas.* 358.

A contrivance which is used for the same general purpose as a patented device, which performs the same kind of duties, or is applicable to the same object as the latter, will be regarded as its equivalent and is not patentable. *Re Nutting*, 1 *MacArthur Pat. Cas.* 455.

The doctrine of mechanical equivalents is *held* not applicable to a case of alleged infringement where the inventors of complainant's device were not the first to show the use of such a device for the particular purpose. *Tobey Furniture Co. v. Colby*, 26 *Fed. Rep'r*, 100 ; 34 *Pat. Off. Gaz.* 1276.

### 178. *Application of the Doctrine of "Equivalents" to Combinations.*

*Bona fide* inventors of a combination are as much entitled to equivalents as the inventors of other patentable improvements ; by which is meant that a patentee in such a case may substitute another ingredient for any one of the ingredients of his invention, if the ingredient substituted performs the same function as the one omitted in the patented combination. Hence, it is clear that an alteration in a patented combination which merely substitutes another (old) ingredient for one of those in the combination, is an infringement, if the substitute merely performs the same function and was well known, at the date of the patent, as a proper substitute for the omitted ingredient. *Gould v. Rees*, 15 *Wall.* 187. S. P., *Water Meter Co. v. Desper*, 101 *U. S.* 332 ; *Imhauser v. Burke*, *Id.* 647 ; *Storrs v. Howe*, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420 ; *Welling v. Rubber Coated Harness Trimming Co.*, 7 *Pat. Off. Gaz.* 606 ; 2 *Bann. & A. Pat. Cas.* 1 ; *Dederick v. Cassell*, 9 *Fed. Rep'r*, 306 ; 27 *Int. Rev. Rec.* 400 ; 20 *Pat. Off. Gaz.* 1233 ; *King v. Louisville Cement Co.*, 4 *Pat. Off. Gaz.* 181 ; 6 *Fish. Pat. Cas.* 336 ; *Whittlesey v. Ames*, 13 *Fed. Rep'r*, 893 ; 9 *Biss.* 225 ; 18 *Pat. Off. Gaz.* 357 ; 5 *Bann. & A. Pat. Cas.* 96.

It is not always sufficient evidence that two combinations of elements are equivalent, to show that each element of the combination in one may be regarded, under some circumstances, as the equivalent of the corresponding element in the other, when the elements are separately considered. If the mechanical combinations of the members of the two machines are such that the action and mode of operation differ in the two machines, then one is something more than a new mechanical equivalent for the other. *Blake v. Rawson*, 3 *Biss.* 77; 3 *Pat. Off. Gaz.* 122; 6 *Fish. Pat. Cas.* 74.

When a substitute is used for one ingredient in a patented combination which has every property and performs every function of the original in the combination, it does not cease to be an equivalent because, in addition, it does something more and better. *Atlantic Giant Powder Co. v. Goodyear*, 13 *Pat. Off. Gaz.* 45; *Adams v. Joliet Manuf. Co.*, 12 *Pat. Off. Gaz.* 93.

Where, by a claim in a patent for an improvement in grain drills, a lever or its equivalent as a mechanical instrument was made an essential element, it was *held*, that the use of the human hand instead of the lever was not a mere equivalent constituting an infringement, although in the patented machine the hand was applied to work the lever. *Brown v. Davis*, 116 *U. S.* 237.

A different arrangement of the parts of the machine from that of the complainant's, and producing a different and better result, is not an infringement. *Habeman v. Whitman*, 5 *Bann. & A. Pat. Cas.* 530.

A patent for an "improvement in floating mowing machines," arranged and adapted to cut weeds and grass under water, claimed only the combination of the old cutting device of a mowing machine with a boat to float upon the water, transmitting motion to the cutter by means of a vibrating lever. It was *held* that the substitution of a vertical crank-shaft for such vibrating lever, the shaft performing the same functions as the lever and no other, and being a known equivalent for the lever, was an infringement of the patent. *Piper v. Shedd*, 26 *Ed. Rep'r*, 151.

A patent for a machine for washing bottles, which claimed the combination of a stationary water supply-pipe, a sleeve shaft mounted upon and adapted to be revolved about said stationary pipe, and a brush or scraper, with other devices, was *held* to be infringed by a machine with a revolving supply pipe covering the brush at its forward end and joined at its rear to the stationary

supply-pipe, these devices being fairly equivalents. *Hoyt v. Slocum*, 26 *Fed. Rep'r*, 329.

Patent granted to Walworth and Buschick, in 1867, for improvements in looms was *held* not infringed by a device which did not contain an important element of the claim or any equivalent therefor. *Taft v. Steere*, 26 *Pat. Off. Gaz.* 1020.

A patent for an improvement in hammocks, claiming six elements, was *held* not infringed by a hammock in which three of them were not used. *Travers v. Palmer*, 25, *Fed. Rep'r*, 511 ; 31 *Pat. Off. Gaz.* 382.

A patent for an improvement in wardrobe bedsteads, covering a device for an arrangement of folding doors, which used, described, and specifically claimed three doors, was *held* not infringed by a device which accomplished, substantially the same result, by the use of only two folding doors. *Tobey Furniture Co. v. Colby*, 26 *Fed. Rep'r*, 100 ; 34 *Pat. Off. Gaz.* 1276.

### 179. *To Compositions of Matter.*

The substitution of a mere known equivalent in place of one element in a composition of matter is an infringement of a patent for such composition ; but where the patentee of a composition does not embrace equivalents in his claim, but confines himself to the specific ingredients or things, and expressly excludes all others, or expressly excludes some or one other, a use, in a similar combination, of the thing disclaimed is no infringement. Where a patent was for sawing matches in sheets, so as to leave them united at one end, and then wrapping them in paper in a particular manner, it was *held* that the patent was for the entire and complete mode described, and was not infringed by putting up matches attached at one end, but not wrapped in slips of paper. *Byam v. Farr*, 1 *Curt.* 260.

Patents are infringed by the substitution of chemical equivalents, as well as of mechanical equivalents ; even if in some respects they are improvements on the original process patented. To constitute an infringement of a chemical process, it is not necessary that the substituted ingredient be the equivalent in every respect, and for every purpose, of that in place of which it is used ; it must only be an equivalent in the particular process, contributing to produce the same composition of matter, by substantially the same



chemical action. Thus a paste consisting of flour, salt, alum, and corrosive sublimate, is infringed by a compound consisting of flour, chloride of zinc, alum, corrosive sublimate and oil of cloves; and where the patentee of an improved paste used the chloride of sodium mainly for increasing the solubility of the antiseptic agent employed, and assisting in its diffusion through the mass of the paste, the use of the chloride of zinc, which in the particular process produced practically the same result, was *held* to be an infringement. *Woodward v. Morrison*, 1 *Holmes*, 124; 2 *Pat. Off. Gaz.* 120; 5 *Fish. Pat. Cas.* 357.

The substitution in a patented mixture, of an ingredient which, although not precisely the same in its action, produces all the valuable and beneficial results attending that for which it was substituted, and in substantially the same manner, is an equivalent, and an infringement of the patent. *Atlantic Giant Powder Co. v. Mowbray*, 12 *Pat. Off. Gaz.* 560; 2 *Bann. & A. Pat. Cas.* 442; *Knox v. Great Western Quicksilver Mining Co.*, 14 *Pat. Off. Gaz.* 897; 6 *Sawyer*, 430; 7 *Rep'r*, 325; 4 *Bann. & A. Pat. Cas.* 25.

Where the ingredients in a compound are the same, and the change is merely in the mode of combining them, or there is a substitute of one ingredient having the same qualities and producing the same result, there is an infringement. *Allen v. Hunter*, 6 *McLean*, 303, 313.

Selling materials in dry packages with printed directions whereby an article or effect can be produced essentially similar to that covered by a patent, infringes such patent. *Alabastine Co. v. Payne*, 27 *Ibid. Rep'r*, 559.

#### 150. *Rights of Purchaser of a Specific Article from the Patentee or his Licensee.*

For Rev. Stat. § 4899, securing this right, see *ante*, 135.

By the sale of a patented machine, it becomes the property of the purchaser, and is no longer protected by the patent laws. The purchaser may use it, repair it, improve it, &c., in the same manner as any other chattel belonging to him. *Chaffee v. Boston Belting Co.*, 22 *How.* 217.

Use of an invention with knowledge and without prohibition of an inventor, before application, entitles the person so using to continue the use after the patent has been granted. *McClurg v. Kingsland*, 1 *How.* 202; 17 *Pet.* 228

Repairing partial injuries, whether they occur from accident or wear, is only refitting a machine for use. And it is no more than that, though it shall be a replacement of an essential part of a combination. But if a patented machine as a whole should happen to be broken so that its parts could not be re-adjusted, or be so much worn as to be useless, a purchaser cannot make or replace it by another, but must buy a new one. To do either would be reconstruction. *Wilson v. Stimson*, 9 *How.* 109, 124.

Thus the right to replace the cutters in Woodworth's planing machine was *held* to vest in a purchaser; as the use of the machine depends upon the replacement of such cutters, and as a machine will last several years, whereas the cutters must be replaced every sixty or ninety days. *Ib.*

A grant of a right, by a patentee, to make and use a patented machine within a term for which it has been granted, will give the purchaser of machines from such grantee the right to use the individual machine as long as the machine itself lasts; nor will this right to use a machine cease because an extension of the patent, not provided for when the patentee made his grant, has since been allowed, and the machine sold has lasted and is used by the purchaser within the term of the time covered by this extension. *Bloomer v. Millinger*, 1 *Wall.* 340. S. P., *Bloomer v. Stolley*, 5 *McLean*, 158; 8 *West. L. J.* 158.

A patented article, when rightfully bought, may be used anywhere. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

Where a patentee has assigned his right to manufacture, sell and use within a limited district an instrument, machine or other manufactured product, a purchaser of such instrument or machine, when rightfully bought, within the prescribed limits, acquires by such purchase the right to use it anywhere, without reference to other assignments of territorial rights by the same patentee. The right to the use of such machines or instruments stands on a different ground from the right to make and sell them, and inheres in the nature of a contract of purchase, which carries no implied limitation of the right of use within a given locality. The assignee, for a limited district, of a patent for an improvement in coffins, made and sold within the district, coffins containing the patented improvements; it was *held*, that the purchaser of a coffin could put it to use in an interment anywhere. He was not restricted to use within the district designated in the assignment. *Adams v. Burke*,

17 *Wall.* 453. S. P., *McKay v. Wooster*, 6 *Am. L. T. Rep.* 169 ; 3 *Pat. Off. Gaz.* 441 ; 2 *Sawyer*, 373 ; 6 *Fish. Pat. Cas.* 375.

The assignee of a particular territory may sell within that territory, although he knows the article is to be used in the territory of another assignee. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

To entitle the purchaser of a machine to the benefits of the act of 1839, § 7, he must be one who has used the invention before the application for a patent by license from the inventor himself, and not a fraudulent purchaser, or a purchaser from a wrong-doer, without the knowledge or against the will of the inventor. *Pier-son v. Eagle Screw Co.*, 3 *Story*, 402.

When a patentee has himself constructed a machine, and sold it without any conditions, or has authorized another to construct, sell and deliver it, or to construct and use and operate it without any conditions, and the consideration has been paid to him for the thing patented, the rule is well established that the patentee must be understood to have parted to that extent with all his exclusive right, and that he ceases to have any interest whatever in the patented machine so sold and delivered, or authorized to be constructed and operated. When such circumstances appear, the owner of the machine, whether he built it or purchased it, if he has also acquired the right to use and operate it during the continuance of the patent, may continue to use it until it is worn out, in spite of any and every extension subsequently obtained by the patentee or his assigns. *Wooster v. Seidenberg*, 13 *Blatchf.* 88 ; 10 *Pat. Off. Gaz.* 244. See, also, *Wooster v. Taylor*, 12 *Blatchf.* 384 ; 8 *Pat. Off. Gaz.* 644.

If one has a right to a patented machine, and to the use of it, he has a right to work it himself, or by his servants, or to lease it out to any other person. *Reutgen v. Kanowrs*, 1 *Wash.* 168.

An agreement between the patentee and his licensees, that the latter will not manufacture certain articles, cannot prevent third persons, who purchase from the licensees articles which they are authorized to make and sell, from afterward converting them into the prohibited articles. The public cannot be compelled to notice or regard agreements between the patentee and his licensees as to the limitation of the use of the article made by them. Such a contrivance to destroy competition may be valid, but the covenant binds only the parties to it. If a stranger purchase the product from one licensed to use the process, he need look no further, and may use it for his own purposes, without inquiring for or regard-

ing any private agreement of licensees not to compete with one another. *Metropolitan Washing Machine Co. v. Earle*, 2 *Fish. Pat. Cas.* 203.

Buying and using a second time articles stamped "licensed to use once only," and sold to defendants' vendor upon that express condition, *held* an infringement. *American Cotton Tie Supply Co. v. Bullard*, 17 *Blatchf.* 160; 17 *Pat. Off. Gaz.* 388; 9 *Rep'r.* 70; 4 *Bann. & A. Pat. Cas.* 520; *Same v. Simmons*, 106 *U. S.* 89.

### 181. *Rights of Purchaser from an Infringer*

The purchaser of a manufactured article made in violation of a patent of a third person, but without any connection on the part of such purchaser with the manufacturer except as a purchaser, will not make the party buying guilty of an infringement of the rights of the patentee, as having used the patented invention. Thus, in general, a contract to buy all the product of a patented machine, during a certain period, does not render the purchaser liable to an action of infringement for the use of the machine on which it is made. Otherwise, if such contract is only a colorable purchase of the products, and is in reality a hiring of the machine. *Keplinger v. De Young*, 10 *Wheat.* 358.

Purchasers of an article manufactured by infringers of a patented machine, are not liable as infringers. *Goodyear v. Railroad*, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; *Anon.*, 3 *West. L. J.* 144; *Blanchard's Gun-stock Turning Factory v. Jacobs*, 2 *Blatchf.* 69.

The sale of the products of a patented machine is not an infringement. The products cannot be reached except in the hands of some one in some manner connected with the use of the patented machine. *Boyd v. McAlpine*, 3 *McLean*, 427; *Goodyear v. Railroad*, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626.

When a patentee recovers from an infringing manufacturer full damages and profits on account of the infringement, the purchaser from the manufacturer, who is a user of the machine, will be protected in such use against a suit for infringement, as he would be if he were a licensee from the patentee. But this could only be held on a clear showing that the purchaser was using the same patented machine or instrument as that involved in the suit between the patentee and the infringing manufacturer, and that the user was a vendee of such manufacturer. Probably, it must further

appear that the patentee's claim to profits and damages against the manufacturer has been actually paid and satisfied. *Allis v. Stowell*, 16 *Fed. Rep'r*, 783.

An agreement between owners of a patent and infringers, by which the former release to the latter all claims against them by reason of the manufacture and sale of the patented article, and also all claims against all other persons who had purchased or sold the same article when manufactured by the infringers, makes purchasers from the infringers lawful owners of the articles so purchased; and a re-sale by them of such articles is not an infringement. *Alabastine Co. v. Richardson*, 26 *Fed. Rep'r*, 620.

182. *What has been held to be or not to be Infringement, in peculiar Cases.*

A patent claiming only a particular style of spring was *held* not to be infringed by employing for the same purpose a spring differing somewhat in style. *Field v. De Conneau*, 116 *U. S.* 187.

A patent for covering the upper surface and front edge of a keyboard with a single sheet of plaster composition was *held* infringed by covering the surface with a strip and the front edge with another strip of such composition. *Celluloid Manuf. Co. v. Pratt*, 22 *Blatchf.* 367; 21 *Fed. Rep'r*, 313. See 23 *Id.* 38.

Patent for covering piano keys with celluloid, in a "continuous strip or roll"—was *held* not infringed by a device using a separate strip for each key. *Celluloid Manuf. Co. v. Comstock*, 23 *Fed. Rep'r*, 38.

A patent for improving locks by making part of the mechanism more yielding than the rest, was *held* not infringed by the device of making the other parts stronger than those which in the patentee's lock were weakened. *Newbury v. Mossman*, 21 *Fed. Rep'r*, 579; 29 *Id.* 271.

A patent for causing a steamboat capstan to revolve by connecting it with the vessel's engine, *held* not infringed by accomplishing the same thing by connecting an independent engine with the capstan. *McMillin v. St. Louis & Vicksburg Anchor Line*, 22 *Fed. Rep'r*, 169.

A patent for forming a pavement by laying concrete in sections so that any single block could be raised separately, was *held* infringed by laying the concrete in a mass while yet plastic, and

immediately dividing it into blocks. *Kuhl v. Mueller*, 21 *Fed. Rep'r*, 510 ; 28 *Pat. Off. Gaz.* 541.

A plainly declared element of a combination cannot be eliminated by judicial construction, although using it is not necessary to the result. Thus a patent for straining out sand by a screen working in water in a closed vessel is not infringed by disusing the vessel and using the same strainer in the open river. *Williams v. Stoltzenback*, 23 *Fed. Rep'r*, 39 ; 30 *Pat. Off. Gaz.* 891.

A patent for an improvement in telegraphic printing instruments, the principal feature of which was the independent rotation of the two type wheels, standing contiguous, "so as to be impressed separately or jointly upon the same strip of paper," was *held* infringed by a machine the type wheels of which could not rotate together, although they could not print simultaneously. *Gold & Stock Tel. Co. v. Commercial Tel. Co.*, 23 *Fed. Rep'r*, 340 ; 31 *Pat. Off. Gaz.* 1559. See *Same v. Same*, 22 *Fed. Rep'r*, 838.

A patent for improving flanging machines by throwing the lower roll beyond the upper, is infringed by the device of throwing the upper roll back of the lower roll. *Phillips v. Carroll*, 23 *Fed. Rep'r*, 249 ; 31 *Pat. Off. Gaz.* 265.

A patent for "a horse collar, consisting of a frame combined with a number of detachable pads" was *held* not infringed by the use of detachable pads, or sweat-cloths with detachable pads, independent of a collar. *Osmer v. J. B. Sickles Saddlery Co.*, 23 *Fed. Rep'r*, 724.

A patent for a leather cutting-press, claiming "the revolving cutting-block, in combination with the cutting-press," was *held* not infringed by a machine using a revolving block and cutting-die, but not *the* cutting-press described in the specification and drawings of the patent. *Richardson v. Bresnahan*, 23 *Fed. Rep'r*, 897.

A patent for an air-cooling apparatus, using ice as the cooling agent was *held*, not infringed by an apparatus in which the refrigerating effect was produced by the compression and expansion of air, not by contact with ice. *Bate Refrigerating Co. v. Eastman*, 24 *Fed. Rep'r*, 645 ; 32 *Pat. Off. Gaz.* 517.

Patent for improvement in pocket check-books was *held* not limited to any particular manner of binding, and therefore infringed by a device in which the checks were unbound. *Norrington v. Merchants' Nat. Bank*, 25 *Fed. Rep'r*, 199.

Patent for improvements in tilting chairs was construed ; and *held*, that it included a chair whose seat and occupant were sup-

ported by a central spiral spring interposed between the seat frame and the base, but not a chair where the weight of the occupant was sustained by rockers, and the only function of the spring was to impart the tilting motion. *Bunker v. Stevens*, 26 *Fed. Rep'r*, 245.

A patent for an improvement in cultivators, consisting in runners pivoted to the wheel spindles or axle, so as to be held out of contact with the ground when the machine was used for field operations, and to be held in contact with the ground when the plows were suspended from the axle for transportation, was *held* not infringed by the use of hinged runners, which were folded up by hand for field operations, and folded down and locked for transportation. *Pattee Plow Co. v. Kingman*, 23 *Fed. Rep'r*, 801.

A patent for a combination, constituting an improvement in tables for tile machines, was *held* not infringed by similar mechanism not employing a flexible standard which appeared to be an indispensable part of the patented combination. *Leach v. Chandler*, 24 *Fed. Rep'r*, 791 ; 33 *Pat. Off. Gaz.* 237.

The use of celluloid in the fitting of artificial teeth was *held* not an infringement of a patent involving the use of hard rubber or vulcanite for the same purpose. *Goodyear Dental Vulcanite Co. v. Brightwell*, *MacArthur & M.* 74.

Patent for improvements in the construction of lumber-driers, was *held* infringed by a drier in the construction of which the main features of the patented devices were involved, and which was, in principle, the same as that intended to be described in the patents, notwithstanding some slight mechanical deviations from the specific directions given in the patents for the construction of the driers described. *Burdsall v. Curran*, 27 *Pat. Off. Gaz.* 1320

A patent covering the process of maturing and browning coffee in an uncured condition by subjecting it to the direct action of steam, is not infringed by the application of heat only to the coffee in that condition. *Arnold v. Phelps*, 29 *Pat. Off. Gaz.* 538.

#### XIV. JURISDICTION OF COURTS OVER INFRINGEMENTS.

##### 183. *Distinction between the Legal and the Equitable Remedy.*

Different rules for the assessment of damages prevail in suits of equity, from those which are recognized in actions at law, but in all other respects the rights of the parties depend upon the same considerations. *Hudson v. Draper*, 4 *Fish. Pat. Cas.* 256 ; 4 *Cliff.* 178.

In case of infringement, the patentee may elect to sue at law for damages, usually measured by his royalty, or in equity—for profits and an injunction. *Cowing v. Rumsey*, 4 *Fish. Pat. Cas.* 275 ; *Bragg v. City of Stockton*, 27 *Fed. Rep'r*, 509.

Even when a suit at law will lie for infringement of a patent, proceedings in equity may usually be maintained, as affording a more practical and efficient remedy. *Hill v. Whitcomb*, 5 *Pat. Off. Gaz.* 430 ; 1 *Holmes*, 317 ; 1 *Bann. & A. Pat. Cas.* 34.

A bill for an accounting of profits is not maintainable unless a right to an injunction or some other substantive ground of equitable relief is shown. *Spring v. Domestic Sewing Machine Co.*, 13 *Fed. Rep'r*, 446 ; 22 *Pat. Off. Gaz.* 1445 ; 29 *Int. Rev. Rec.* 22 ; 14 *Rep'r*, 711.

A bill in equity will not lie solely to recover damages for the infringement of a patent ; but if it pray for an injunction, or for a discovery and account of profits, it will be maintained. *Vaughan v. East Tennessee, Virginia, &c. R. R. Co.*, 11 *Pat. Off. Gaz.* 789 ; 1 *Flippin*, 621 ; 2 *Bann. & A. Pat. Cas.* 537.

The principle upon which courts of equity have jurisdiction in patent cases, and upon which injunctions are granted to patentees, is not that there is no remedy at law in favor of those whose property is invaded, but that the remedy at law involves a multiplicity of suits, and does not afford means of taking an account of profits. *Motte v. Bennett*, 2 *Fish. Pat. Cas.* 642.



184. *Original Jurisdiction of Circuit Courts.*

The circuit courts shall have original jurisdiction as follows :

Ninth. Of all suits at law or in equity arising under the patent or copyright laws of the United States. *Rev. Stat.* § 629.

Originally the circuit courts had not jurisdiction of a suit for infringement of patents. *Livingston v. Van Ingen*, 1 *Paine*, 45 ; 4 *Am. L. J.* 46. This jurisdiction was conferred by section 7 of the act of 1836. *Smith v. Plymouth*, 4 *West. L. J.* 49 ; *Goodyear v. Hullihen*, 3 *Fish. Pat. Cas.* 251 ; ? *Hughes*, 492. See note to *Rev. Stat.* 4921, *post*.

When a controversy turns, not upon the letters patent themselves, but only upon contracts concerning them, the circuit court has no jurisdiction except as citizenship of the parties may give it. The subject-matter of such contracts, where neither the validity of the patent nor a question of infringement of it is involved, does not give a court of the United States jurisdiction ; such court can act only where rights of the patentee under the patent laws are directly brought in question. *Burr v. Gregory*, 2 *Paine*, 426 ; *Landolph v. Robinson*, 2 *N. J. L. J.* 171 ; *Teas v. Albright*, 13 *Fed. Rep'r*, 406 ; 28 *Int. Rev. Rep'r*, 290 ; 22 *Pat. Off. Gaz.* 2069 ; 14 *Rep'r*, 712.

In a suit where all the parties to the suit were citizens of New York, the circuit court was *held* powerless to decree that defendant execute to plaintiff a transfer of letters patent. *Perry v. Littlefield*, 17 *Blatchf.* 272 ; 17 *Pat. Off. Gaz.* 51 ; 4 *Bann. & A. Pat. Cas.* 624.

Where one circuit court has sustained a patent, another circuit court should, unless plain mistake be shown, follow such decision in a suit upon the same patent in which the same evidence is relied on. *Hammerschlag v. Garrett*, 9 *Fed. Rep'r*, 43 ; 27 *Int. Rev. Rec.* 309. S. P., *McCloskey v. Hamill*, 15 *Fed. Rep'r*, 750 ; 23 *Pat. Off. Gaz.* 2122.

Where suit is brought in a circuit court upon a patent the validity of which has been sustained by judgments of other circuit

courts, the respect due to such decisions and the importance of consistency and uniformity of decisions in courts of co-ordinate jurisdiction where the same subject-matter is involved, require the court to adopt such judgments. *American Ballast Log Co. v. Cotter*, 11 *Fed. Rep'r*, 728 ; 31 *Pat. Off. Gaz.* 1030.

Where a patent has been established by a decision of a circuit court, after careful consideration, that decision is entitled to very great weight in a subsequent application, either before the same court or any other, for a preliminary injunction or for any preliminary relief. *American Middlings Purifier Co. v. Christian*, 3 *Bann. & A. Pat. Cas.* 42.

The provision of section 11 of the judiciary act of 1789 (now Rev. Stat. 739), that no civil suit shall be brought against an inhabitant of the United States, in any other district than that in which he is an inhabitant or in which he is found at the time of serving the writ, applies to suits for infringement, notwithstanding the legislation of Congress giving exclusive jurisdiction of such writs to courts of the United States. *Chaffee v. Hayward*, 20 *How.* 208; *Allen v. Blunt*, 1 *Blatchf.* 480; *Day v. Newark India Rubber Manuf. Co.*, 1 *Blatchf.* 628. The decisions have settled that, under section 11, in order to give jurisdiction to a circuit court, the defendant must be an inhabitant of the district in which the suit is brought, or be found within that district at the time of service of original process. *Day v. Newark India Rubber Manuf. Co.*, *supra*. The provision applies to a suit in equity brought under Rev. Stat. § 4915. *Butterworth v. Hill*, 114 *U. S.* 128.

For the jurisdiction of district courts over actions for penalties for false marking, see Rev. Stat. § 4901, *ante*.

### 185. *Their Jurisdiction does not embrace Suits to enforce Licenses.*

A suit, the real nature and object of which appears upon hearing to be to recover an additional license fee or royalty for the use of a patent under an agreement between a patentee and the defendant, and which does not involve the validity of the patent, is not within the jurisdiction of the circuit court as a suit under the patent laws, but can only be entertained there upon the ground of citizenship of the parties. The fact that the pleadings may aver facts sufficient to authorize taking cognizance of the suit, is not conclu-

sive ; if it appears at the trial that no question arising under the patent laws is involved in the case, the suit must be dismissed. *Blanchard v. Sprague*, 1 *Cliff.* 288.

The subject-matter of an action to enforce or annul a license to use a patent right, is not within the jurisdiction of the courts of the United States; and is not brought within their jurisdiction by the fact that the controversy ultimately turns upon the validity of the patent ; to give a circuit court jurisdiction of such a cause the plaintiff must aver himself and defendant to be citizens of different States. *Merserole v. Union Paper Collar Co.*, 6 *Blatchf.* 358; 3 *Fish. Pat. Cas.* 483. S. P., *Goodyear v. Union India Rubber Co.*, 4 *Blatchf.* 63. And see *McKay v. Jackman*, 17 *Fed. Rep'r*, 641; 24 *Pat. Off. Gaz.* 1177; 19 *Rep'r*, 163. Whether a suit be one by a licensor, to enforce the covenants contained in a license granted under a patent, or by a licensee, to destroy and annul a license and its covenants, the rule is the same ; the suit is not within the jurisdiction of a circuit court. *Ib.*

The courts of the United States have no power under the patent laws to determine upon the fulfillment of a contract of license. *Tilghman v. Hartell*, 11 *Phila.* 500 ; 2 *Bann. & A. Pat. Cas.* 260. See 99 *U. S.* 547.

Where a license provides that the patentee may terminate it by giving notice, and he does so, his suit to enjoin subsequent sales by the licensee is a suit for infringement, of which the circuit court has jurisdiction irrespective of citizenship of parties, rather than a suit to establish rights under the license. *Smith v. Standard Laundry Machinery Co.*, 19 *Fed. Rep'r*, 825; 20 *Blatchf.* 360.

A license was granted under a patent, with covenants that the licensee should pay certain tariffs, keep correct accounts, and permit his books to be examined, but there was no express provision that if the covenants were broken, the rights granted should revert to the licensor ; and a bill was filed by the licensor against the licensee, praying for a decree that the covenants should be performed, and for an injunction to prevent the use of the patent under the license, until the covenants should be performed ; but the citizenship of the parties was not such as to give jurisdiction. It was *held*, that the suit was not one to prevent the violation of any right secured by any law of the United States, but was one to prevent the violation of the rights secured by the covenants ; and therefore the court had no jurisdiction of the case from the subject matter. *Goodyear v. Union India Rubber Co.*, 4 *Blatchf.* 63.

B., a patentee, granted to S. the exclusive right to make and vend the invention during the life of the patent, for a royalty; and S. sued B. in the circuit court sitting in equity, alleging that he was infringing the patent. It was *held* that whether S. was a licensee or a grantor, he was suing B. on an infringement, and therefore the court had jurisdiction of the suit. *Stanley Rule, &c. Co. v. Bailey*, 14 *Blatchf.* 510; 3 *Bann. & A. Pat. Cas.* 297.

### 186. *Or other Contracts.*

The jurisdiction of courts of the United States in reference to patent rights, does not extend to protecting one who purchases a patented article for the purpose of using it in right of property. A purchaser of a patented article exercises no rights created by the acts of Congress, nor does he derive title by virtue of the franchise or privilege granted to the patentee. When the machine passes to the hands of the purchaser, it is no longer under the protection of Congress, but becomes private property, protected by the laws of the State where it is situated; and if the right to it is infringed, redress is to be sought in the courts of the State, according to the laws of the State, and not in the courts of the United States, nor under the laws of Congress. *Bloomer v. McQuewan*, 14 *How.* 539, 550; *Chaffee v. Boston Belting Co.*, 22 *How.* 217.

A suit between citizens of the same State can not be sustained in the circuit court as arising under the patent laws of the United States, where the defendant admits the validity and his use of the plaintiff's letters patent, and a subsisting contract is shown, governing the rights of the parties in the use of the invention. Relief in such a suit is founded on the contract, and not on those laws. *Hartell v. Tilghman*, 99 *U. S.* 547.

The circuit court cannot take jurisdiction of a suit between citizens of the same State, brought to recover for violation of a contract, merely because the subject-matter of the contract is a patent right.\* *Goodyear v. Day*, 1 *Blatchf.* 565. *S. P., Hill v. Whitcomb*, 5 *Pat. Off. Gaz.* 430; 1 *Holmes*, 317; 1 *Bann. & A. Pat. Cas.* 34; *Ingalls v. Tice*, 14 *Fed. Rep'r*, 552; 22 *Pat. Off.*

\* Upon like grounds it has been *held* that a suit brought upon an agreement for the publication of a manuscript, to determine the rights of the parties under

it, is not a suit under the copyright laws, of which the circuit court can take jurisdiction by reason of the subject matter. *Pulte v. Derby*, 5 *McLean*, 328.

*Gaz.* 2160 ; 14 *Rep'r*, 714 ; *Nesmith v. Calvert*, 1 *Woodb. & M.* 34 ; *Burr v. Gregory*, 2 *Paine*, 426 ; *Brooks v. Stolley*, 3 *McLean*, 523 ; 2 *West. L. J.* 396.

One who purchases a patented article for the purpose of using it, stands on different grounds from a purchaser of the right to make and sell it. In the former case, when the patented article rightfully passes from the patentee to the purchaser, the article is no longer within the limits of the monopoly, or under the protection of the patent act. Redress for injury in such a case must be sought in the State courts. *Aiken v. Manchester Print Works*, 2 *Cliff.* 435.

Where the controversy does not involve the validity of letters patent, but turns upon the effect and force of some contract under them, the State courts are the proper tribunals for the adjudication and the Federal courts cannot properly assert jurisdiction, unless the residence or citizenship of the parties confers it. *Consolidated Fruit Jar Co. v. Whitney*, 2 *Bann. & A. Pat. Cas.* 30.

An original patentee may, in selling rights by districts, prohibit each assignee from vending the article beyond his district. But, in such case, his remedy is on the contract, and not under the patent law. *Boyd v. Brown*, 3 *McLean*, 295:

### 187. *Jurisdiction of the Supreme Court of the District of Columbia.*

The powers and jurisdiction of the supreme court of the district in patent cases are the same (as well in equity as at law), as those of a circuit court. *Cochrane v. Deener*, 94 *U. S.* 780.

That the supreme court of the district has power to issue a mandamus, but whether the power is so broad as to embrace compelling the issue of a patent, see *Secretary v. McGarrahan*, 9 *Wall.* 298 ; *United States v. Schurz*, 102 *U. S.* 378, 393.

The supreme court of the District of Columbia, being charged with the special jurisdiction of appeals from the commissioner of patents, must decide on the merits, with the assistance of determinations upon the same subjects of the circuit and district courts of the United States ; but the decrees of those courts will not be considered as *res judicata*. *Schillinger v. Cranford*, 2 *Cent. Rep'r*, 680.

For the appeals allowed to be taken by a party dissatisfied with

a decision of the commissioner, to the supreme court of the district, see *Rev. Stat.* §§ 4911–4914 ; *Id.* § 780 ; *ante.*

For the jurisdiction of a bill in equity, filed to procure issue of a patent which the commissioner has refused, see *Rev. Stat.* § 4915, *ante.*

### 188. *Jurisdiction of the Court of Claims.*

The court of claims cannot take jurisdiction of claims against government founded on mere torts (*Milwaukee, &c. Canal Co. v. United States*, 1 *Ct. of Cl.* 187 ; *Spicer v. United States*, *Id.* 316 ; *Dennis v. United States*, 2 *Ct. of Cl.* 210 ; *Johnson v. United States*, 2 *Ct. of Cl.* 391); and, therefore, cannot entertain a suit founded on an infringement considered as a tort merely ; but may entertain a suit as founded on contract, where the circumstances under which the invention was used are such as warrant a finding of a promise, express or implied, to make compensation, or pay a license fee. See *ante*, 7.

### 189. *Appellate Jurisdiction of Supreme Court.*

The supreme court shall have appellate jurisdiction in the cases hereinafter specially provided for. *Rev. Stat.* § 690.

The right of appeal or error, without regard to value, given by *Rev. Stat.* § 699, in cases arising under the patent laws, applies to controversies between a patentee and alleged infringers, as well as to those between rival patentees (*Philip v. Nock*, 13 *Wall.* 185) ; but does not apply to controversies arising upon enforcement of contracts relative to patents. *Brown v. Shannon*, 20 *How.* 55.

### 190. *It is not Dependent on Amount in Controversy.*

A writ of error may be allowed to review any final judgment at law, and an appeal shall be allowed from any final decree in equity hereinafter mentioned, without regard to the sum or value in dispute :

First. Any final judgment at law or final decree in equity of any circuit court, or of any district court acting as a circuit court, or of the supreme court of the District of Columbia, or of any Territory, in any case touching patent rights or copyrights. *Rev. Stat.* § 699.

The supreme court has no appellate jurisdiction of a suit to enforce the specific performance of a contract in relation to a patent unless the value of the matter in controversy exceeds the jurisdictional amount; although it may exercise jurisdiction when a far less amount is in dispute, if the suit be for the infringement of a patent right. *Brown v. Shannon*, 20 *How.* 55.

#### 191. *Exclusive Jurisdiction of Courts of the United States.*

The jurisdiction vested in the courts of the United States in the cases and proceedings hereinafter mentioned, shall be exclusive of the courts of the several States :

Fifth. Of all cases arising under the patent right or copyright laws of the United States. *Rev. Stat.* § 711.

State courts, although they may adjudicate on assignments and other contracts involving patent rights, have no jurisdiction to enjoin infringement of patent, even in a case depending on extent of the right which has been vested by an assignment. The jurisdiction of the United States courts is exclusive. *Continental Store Service Co. v. Clark*, 1 *Cent. Rep'r*, 530.

**XV. RIGHT OF ACTION AT LAW FOR DAMAGES.**192. *Suits for Infringement ; Damages.*

Damages for the infringement of any patent may be recovered by an action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. *Rev. Stat.* 4919.

193. *Limitation of Time for bringing an Action.*

While there is no act of Congress limiting the time for suing under the patent laws, the statute of limitations of the State in which the court is held, governs, so far at least as actions at law are concerned. The act of Congress of July 8, 1870, c. 230, § 55 (10 *Stat.* 206), prescribed a limitation of six years. But this statute is generally considered to have been repealed by the omission of it from the Revised Statutes. See *Sayles v. Oregon Central R. R. Co.*, 6 *Sawyer*, 31 ; 3 *Rep'r*, 424 ; 4 *Bann. & A. Pat. Cas.* 429 ; *Sayles v. Richmond, Fredericksburgh, &c. R. R. Co.*, 4 *Bann. & A. Pat. Cas.* 239 ; *Sayles v. Oregon Central R. R. Co.*, 8 *Rep'r*, 424 ; *Vaughn East Tennessee, Virginia, &c. R. R. Co.*, 11 *Pat. Off. Gaz.* 789 ; 1 *Flippin*, 621 ; 2 *Bann. & A. Pat. Cas.* 537 ; *Hayden v. Oriental Mills*, 15 *Rep'r*, 742 ; 24 *Pat. Off. Gaz.* 601 ; 17 *Fed. Rep'r*, 605 ; *Rich v. Ricketts*, 7 *Blatchf.* 230. But the decisions have been somewhat conflicting. See *Hayward v. St. Louis*, 11 *Fed. Rep'r*, 427 ; 3 *McCrary*, 614 ; *Anthony v. Carroll*, 9 *Pat. Off. Gaz.* 199 ; 2 *Bann. & A. Pat. Cas.* 195 ; *Read v. Miller*, 2 *Biss.* 12 ; 3 *Fish. Pat. Cas.* 310 ; *Sayles v. Louisville City R. Co.*, 9 *Fed. Rep'r*, 512 ; *Sayles v. Dubuque & Sioux City R. Co.*, *Id.* 516, *note* ; 5 *Gill*, 561.



The above mentioned phrases of the question of the application of the statute of limitations have lost interest by lapse of time. The present question of importance is whether to consider the State statute as applying directly in the case of an action at law, and by an analogy to a suit in equity, to actions and suits now brought. The affirmative is held in *Hayden v. Oriental Mills*, 15 *Rep'r*, 742 ; 24 *Pat. Off. Gaz.* 601 ; 17 *Fed. Rep'r*, 605 ; *Parker v. Hawk*, 2 *Fish. Pat. Cas.* 58 ; *Rich v. Ricketts*, 7 *Blatchf.* 239 ; *Sayles v. Louisville City R. Co.*, 9 *Fed. Rep'r*, 512 ; *Sayles v. Dubuque & Sioux City R. Co.*, *Id.* 516, *note*. Contrary views have been expressed in *Anthony v. Carroll*, 2 *Bann. & A. Pat. Cas.* 195 ; 9 *Pat. Off. Gaz.* 199 ; *Parker v. Hallock*, 2 *Fish. Pat. Cas.* 543, *note* ; *Wetherill v. New Jersey Zinc Co.*, 1 *Bann. & A. Pat. Cas.* 489 ; *Collins v. Peebles*, 2 *Fish. Pat. Cas.* 540. See *Reed v. Miller*, 2 *Biss.* 12 ; 3 *Fish. Pat. Cas.* 310.

#### 194. *Nature of the Remedy by Action at Law.*

The sale of machines embodying the patented inventions of another, to one for use, is an invasion of the patentee's rights, and such a conversion of his property as will render the party so selling the invention liable in an action for tort ; though in such case, the plaintiff may waive the tort and sue in assumpsit for the money received from the sale. *Steam Stone Cutter Co. v. Sheldons*, 15 *Fed. Rep'r*, 608 ; 24 *Pat. Off. Gaz.* 703. In an action or proceeding for the money, the measure of damages would be the amount of money received, not the amount of damages done, and all right of recovery beyond that would be waived. This is the effect of waiving the tort. The recovery of satisfaction in either form would pass the right to that for which satisfaction was had, and there could be no damages beyond. Consequently, when the plaintiff has recovered and received satisfaction for the tort committed, the title to so much of his property as was wrongfully converted, will have passed by the sale and conversion, and no damages will accrue to him on account of further use of that property. *Ib.*

The infringement of a patent is a tort ; but the wrongful act not being committed with direct force, the form of action is that description of tort called trespass on the case. *Stein v. Goddard*, *McAll.* 82. A reiteration of infringements of a patent, like a

repetition of torts of any other kind, may be sued for in one action. *Wilder v. McCormick*, 2 *Blatchf.* 31.

The granting of a patent confers upon the patentee the right to bring suits thereon for its infringement, and a court is not authorized to grant an injunction to restrain him from so doing pending a suit to invalidate his patent, especially when such patent was granted after an interference. *Asbestos Felting Co. v. United States, &c. Felting Co.*, 10 *Pat. Off. Gaz.* 828 ; 13 *Blatchf.* 453 ; 2 *Bann. & A. Pat. Cas.* 369

### 195. *Right of Action of Patentee.*

An action for an infringement cannot be maintained by an inventor before patent obtained. *Gayler v. Wilder*, 10 *How.* 477.

By the statute (act of 1836, § 14, last cl.), requiring an action for damages for infringement of a patent to be brought in the name of the person interested, the right of action is given to the person owning the patent at the time the infringement is committed ; and a transfer of the exclusive right is no bar to an action to recover damages for an infringement committed before such transfer. *Moore v. Marsh*, 7 *Wall.* 515.

Where a patentee has a partner in the manufacture and sale of his patented article, such patentee is entitled to recover full damages for an infringement, notwithstanding such partnership. *Yale Lock Manuf. Co. v. Sargent*, 117 *U. S.* 536.

No person who is not the patentee or such an assignee or grantee as the statute points out can bring a suit for profits or infringement. And a claim to recover profits or damages for past infringement cannot be severed from the title by assignment or grant so as to give a right of action for such claim in disregard of the statute. The profits or damages for infringement cannot be sued for except on a basis of a title as patentee, or as such assignee, or grantee to the whole or a part of the patent ; nor on the basis merely of an assignment of a right to a claim for profits and damages severed from such title. *Gordon v. Anthony*, 16 *Pat. Off. Gaz.* 1135.

An action for infringement must be brought in the name of the real and beneficial party in interest. *Goldsmith v. American Paper Collar Co.*, 2 *Fed. Rep'r*, 239 ; 18 *Blatchf.* 82 ; 18 *Pat. Off. Gaz.* 192 ; 9 *Rep'r*, 640 ; 5 *Bann. & A. Pat. Cas.* 300.

A patentee is entitled to recover for a violation of his patent,

no matter what private agreement subsists between him and any other one, as to an interest in his invention, unless he has made a legal assignment and transfer of his interest in the invention. *Park v. Little*, 3 *Wash.* 196.

Two patents cannot support or supplement each other ; and in a suit for infringement, the question is whether the defendant uses the combination shown in each patent, and not whether parts in each combination can be found in each patent. *Blades v. Rand, McNally & Co.*, 27 *Fed. Rep'r*, 93.

A patentee whose rights are fully covered and protected by a suit he has brought against a manufacturer may, in a proper case, be enjoined from suing purchasers from the manufacturer. *Birdsall v. Hagerstown Agricultural Implement Manuf. Co.*, 1 *Hughes*, 64.

A patentee who has sold the exclusive right to use his invention for a term of years short of the full life of the patent can maintain an action for an infringement during such term. The petition in such action, however, is demurrable, unless it affirmatively shows that the alleged infringer is not using the invention under the authority of the licensee. *Still v. Reading*, 9 *Fed. Rep'r*, 40 ; 4 *Wood's*, 345 ; 20 *Pat. Off. Gaz.* 1025.

A patentee may reserve to himself the right to prosecute for piracies within the particular district where the right of use is conveyed. But if he afterward assigns all his right to such district, owner of the patent may sue. *Bicknell v. Todd*, 5 *McLean*, 236.

### 196. *Of Joint, or Deceased, Patentee.*

Upon the death of the patentee his interest passes to the personal representative in the State of the domicile of the patentee, and remains in him until assignment to the parties beneficially interested therein. In order that he may sue for an infringement it is not necessary that letters patent should be taken out in the State in which the suit is brought. *Hodge v. North Missouri R. R.*, 1 *Dill.* 103 ; 34 *Fish. Pat. Cas.* 161.

A suit by one of two joint inventors to establish his right and interest as such in an improvement for which his fellow inventor has fraudulently taken out a patent alone, and to restrain him from using the patent except for their joint benefit, is within the juris-

diction of the circuit court irrespective of citizenship of parties. *Duke v. Graham*, 19 *Fed. Rep'r*, 647.

Actions may be maintained by joint owners of a patent, who have not transferred their claims for damages and profits, to recover past damages for infringement within the period of time of their ownership, though when the suit was instituted neither of the joint owners had any interest in the title to the patent. *Spring v. Domestic Sewing Machine Co.*, 13 *Fed. Rep'r*, 446 ; 22 *Pat. Off. Gaz.* 1445 ; 29 *Int. Rev. Rec.* 22 ; 14 *Rep'r*, 711.

S. and W. conveyed to S. and B. all their right, title and interest in and to an invention, within the State of Massachusetts, except the right to build the patented machines. In a suit against one who had infringed by making the patented invention, it was *held*, that the suit was properly brought in the name of S. and W., without joining S. and B. *Sanford v. Messer*, 2 *Pat. Off. Gaz.* 470 ; 5 *Fish. Pat. Cas.* 411

#### 197. *Of Assignee.*

The grantee of an exclusive right under a patent, though such right may be limited to the use of a certain number of machines within a certain territory or district, has such an exclusive right as will enable him to sue for an infringement of the patent within that district, under the act of 1836, § 14. *Wilson v. Rousseau*, 4 *How.* 646, 686 ; *Nellis v. Pennoch Manuf. Co.*, 13 *Fed. Rep'r*, 451 ; 28 *Int. Rev. Rec.* 297 ; 22 *Pat. Off. Gaz.* 1131 ; 14 *Rep'r*, 260.

An assignor who retains an interest in a patent may be joined as a party complainant with an assignee of the exclusive interest in a certain territory in which such assignor has no interest, in a bill for an injunction to restrain the violation of the patent in that territory. *Woodworth v. Wilson*, 4 *How.* 712. Compare *Railroad Co. v. Trimble*, 10 *Wall.* 367 ; *Brooks v. Bicknell*, 3 *McLean*, 250 ; 1 *West. L. J.* 150 ; *Whittemore v. Cutter*, 1 *Gall.* 429.

To enable an assignee of a sectional interest in a patent to sue in his own name, he must have the exclusive right, or entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee as well as others. *Gayler v. Wilder*, 10 *How.* 477 ; *Blanchard v. Eldridge*, 1 *Wall. Jr.* 387. S. P., *Littlefield v. Perry*, 21 *Wall.* 205 ; *Washburn v. Gould*, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L. Rep'r*, 276.

In case of infringement subsequent to an assignment of an

undivided part of a patent, action must be brought in the joint names of the parties owning the entire interest. Per CLIFFORD, J. *Moore v. Marsh*, 7 *Wall.* 515.

Under the patent laws of the United States, an assignee of a patent must be regarded as acquiring his title to it with a right of action in his own name, only by force of the statute. *Suydam v. Day*, 2 *Blatchf.* 20.

An exclusive right of action exists in favor of a sole assignee of a patent only in two cases: namely, where he acquires by assignment the whole interest in the patent; or, by a grant or conveyance, the whole interest within some particular district or territory. *Suydam v. Day*, 2 *Blatchf.* 20. And see *Tyler v. Tuel*, 6 *Cranch*, 324; *Washburn v. Gould*, 3 *Story*, 122; 1 *West. L. J.* 465; 7 *L. Rep'r*, 276.

An absolute assignment of a patent, for a valuable consideration, although limited to a specified territory, if it is, as to such district, unqualified, and excludes the patentee from any interest in or control over the rights secured by the letters patent, is a grant of the exclusive right under the patent to use and to grant to others to make and use the thing patented within and throughout a specified part of the United States, and warrants a suit in the name of the grantee or assignee for an infringement within the territory named. *Perry v. Corning*, 7 *Blatchf.* 195.

A grant of a right, though exclusive, to manufacture or sell under a patent within a limited territory, does not carry an interest in the patent such as will enable the grantee to maintain a suit for infringements, though committed within that territory. *Ingalls v. Tice*, 14 *Fed. Rep'r*, 297; 22 *Pat. Off. Gaz.* 2160; 13 *Rep'r*, 676.

The assignee of an exclusive right to use, but not to make the thing patented, within specified territory, may maintain an action against an infringer in his own name. *Chambers v. Smith*, 5 *Fish. Pat. Cas.* 12; 7 *Phila.* 575.

A declaration in a patent suit which avers an assignment of the invention before the issuing of the patent, and claims title under such an assignment, is not demurrable; such assignment being sufficient in law. *Rathbone v. Orr*, 5 *McLean*, 131.

Under the provision of Rev. Stat. § 4919, that damages for infringement may be recovered in the name of the party interested, an assignee of a patent whose assignment includes, in terms, all claims for prior infringements, may sue in his own name for all infringements, including those of date prior to the assignment to

him. *Adams v. Bellaire Stamping Co.*, 25 *Fed. Rep'r*, 270 ; 33 *Pat. Off. Gaz.* 623.

The right to sue for infringements of a patent is assignable. It is not within the rule prohibiting assignments of unliquidated damages. *Jenkins v. Greenwald*, 1 *Bond*, 126 ; 2 *Fish. Pat. Cas.* 37 ; *Hamilton v. Rollins*, 4 *L. & Eq. Rep'r*, 561 ; 5 *Dill.* 495 ; 3 *Bann. & A. Pat. Cas.* 157.

The assignees of a patent, though their title accrues to them by several deeds, may all join, as the holders of the title, in an action for the recovery of damages for an infringement of the patent. *Stein v. Goddard*, *McAll.* 82.

Certain instruments,—*Held* not to amount to such an assignment by a patentee for a process patent, as to preclude him from suing third persons who infringe his patent. *Downton v. Yaeger, Milling Co.*, 3 *McCrary*, 414.

Where a patent has been assigned for a particular territory, the assignor retaining the right to use in common with assignee in part of such territory, the assignee may sue alone for an infringement outside of the reserved territory. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

The claims for profits or damages arising from infringement prior to a purchase of the patent are choses in action, and the assignee takes the title subject to all the equities existing against the assignors. Such claims do not pass by a mere assignment of the patent. The assignee of a patent seeking to recover for infringements before the assignments must allege an assignment of the claims for past infringement. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 *Fed. Rep'r*, 638 ; 25 *Pat. Off. Gaz.* 1076 ; 21 *Blatchf.* 519.

The mere assignment of a patent would give the assignee no right to damages or profits already accrued ; otherwise where the language of the assignment, or the circumstances attending it, show that the parties did not intend to transfer such already existing claims. *Merriam v. Smith*, 11 *Fed. Rep'r*, 588 ; *Dibble v. Auger*, 7 *Blatchf.* 86. See *Consolidated O. W. P. Co. v. Eaton*, 12 *Fed. Rep'r*, 865.

A suit may be maintained to recover past damages for infringement, although at the time when the suit was brought, the parties plaintiff had parted with their interest in the patent. *Spring v. Domestic Sewing Mach. Co.*, 22 *Pat. Off. Gaz.* 1445 ; 13 *Fed. Rep'r*, 446 ; 29 *Int. Rev. Rec.* 22 ; 14 *Rep'r*, 711.

198. *Licensee.*

A licensee cannot, as such, sue for an infringement, but must assert his rights in the name of the original patentee. *Paper Bag Cases*, 105 *U. S.* 766; *Grover & Baker Sewing Machine Co. v. Sloat*, 2 *Fish. Pat. Cas.* 112.

A mere license to make and use, without the right to grant to others to make and use the thing patented, though exclusive, will not authorize the licensee to bring suit in his own name for infringement, without joining the patentee. *Wilson v. Chickering*, 14 *Fed. Rep'r*, 917; 23 *Pat. Off. Gaz.* 1730; *North v. Kershaw*, 4 *Blatchf.* 70; *Bogart v. Hinds*, 25 *Fed. Rep'r*, 484; 33 *Pat. Off. Gaz.* 1268. S. P., *Cottle v. Krementz*, 25 *Fed. Rep'r*, 494.

Where an exclusive license has been granted, the licensee and the patentee are both necessary parties to a suit for infringement. *Hammond v. Hunt*, 4 *Bann. & A. Pat. Cas.* 111.

An action at law, brought in the name of the patentee for the benefit of his licensee, cannot be discontinued by the nominal plaintiff; but the real parties in interest will be permitted to show their interest, in answer to a release by the nominal plaintiff. The nominal plaintiff may, however, claim indemnity against costs, and the court, on a proper application, will provide for it. *Goodyear v. Bishop*, 4 *Blatchf.* 438; 2 *Fish. Pat. Cas.* 96.

Where a license includes a large number of patents, and provides that the licensee shall pay a stipulated royalty on all machines manufactured by him embodying in their construction or mode of operation the inventions and improvements shown and described in each, all or either of said letters patent," as long as the licensee uses either of the patents he will be liable to pay the stipulated royalty. *Pope Manf. Co. v. Owsley*, 27 *Fed. Rep'r*, 100.

Where a license to manufacture and sell under a patent is subject to revocation by written notice by the licensor, a postal card reading: "Your royalty return for February has not come to hand. Failure to forward same for five days from March 10th, subjects your license to revokement," is not notice in writing of the revocation or termination of the license. *Ib.*

A reservation of a right to sue for a royalty, held inconsistent with a license to use which accompanied a sale of the thing patented, by the patentee. *Bigelow v. Louisville*, 3 *Fish. Pat. Cas.* 602.

Money voluntarily paid under license for use of a patent cannot be recovered on subsequent determination of invalidity of patents. *Schwarzenbach v. Odorless Excavating Co.*, 2 *Cent. Rep'r*, 859.

### 199. *Who may or should be Sued.*

Where a structure consisting of several parts is patented as a combination, one who manufactures and sells some of the parts, they being useless without the residue, with the understanding and intent that such residue should be supplied by another and the whole go into use in its complete form, is liable as an infringer. *Wallace v. Holmes*, 9 *Blatchf.* 65 ; 1 *Pat. Off. Gaz.* 117. S. P., *Craig v. Fisher*, 2 *Sawyer*, 345; 5 *Pac. L. R.* 52.

One joint owner of a patent for a machine can use and sell machines made according to the patent, only in respect to his own right. If he uses or sells them without the authority of his co-owner as respects the right of the latter, he is liable to an action by such co-owner for an infringement of the patent. In such action the plaintiff may recover his actual and proper damages, proportioned to the value and extent of his undivided interest, without regard to the amount which his co-proprietor has received by means of the infringement. *Pitts v. Hall*, 3 *Blatchf.* 201.

An agent selling an article which infringes on the plaintiff's patent may be joined as a party defendant with the one who manufactures such article, as they are joint trespassers, and are liable to be sued jointly. *Buck v. Cobb*, 1 *Brunner Col. Cas.* 550.

That the assignee of gains and profits assigned after the decree awarding them can recover them in his own name, see *Campbell v. James*, 5 *Bann. & A. Pat. Cas.* 630.

The use of a patented invention by an officer of the government, in the performance of his duties for the benefit of the government, may render him liable as an infringer. *Campbell v. James*, 17 *Blatchf.* 42 ; 18 *Pat. Off. Gaz.* 979 ; 4 *Bann. & A. Pat. Cas.* 456 ; 8 *Rep'r*, 455 ; reversed on another point, 104 *U. S.* 357.

Armor for a vessel was constructed by Q., under an order given for that purpose by the secretary of the navy, and was applied to a vessel built for the United States, and was paid for to Q. by the secretary of the navy. It was *held*, that although the armor might have been the same in arrangement as that covered by a patent for the application or employment of armor on vessels, Q.



was not liable in a suit on the patent for any value which the armor may have been to the United States. The putting of the armor on a vessel owned by the United States was not a making, or using, or a vending to be used, of the armor. *Heaton v. Quintard*, 7 *Blatchf.* 73.

A mere workman employed by a person other than the patentee to make parts of a patented article is not liable to an action for damages. *Delano v. Scott*, *Gilp.* 489.

Manufacturers of an article are not liable as infringers where the infringement consists in a special use of it made by one who procured it from them. Their privity with the unlawful use will not be presumed. *Keystone Bridge Co. v. Phœnix Iron Co.*, 9 *Phila.* 374.

Action against administrator survives, if there has been an infringement; the latter being held as a trustee for the owner. *Atterbury v. Gill*, 2 *Illippin.* 239; 13 *Pat. Off. Gaz.* 276.

An action for infringement will lie against the parties making a machine which is patented, though such persons are employed by others to do the work. But if such parties have acted without a knowledge of the plaintiff's rights, only nominal damages should be found against them. *Bryce v. Dorr*, 3 *McLean*, 582.

A part owner of a patent has no right to use an infringing device. If he does, he is liable to his co-owner for the wrong done. *Herring v. Gas Consumers' Assoc.*, 9 *Fed. Rep'r.* 556; 3 *McCrary*; 206; 21 *Pat. Off. Gaz.* 203.

Suit cannot be sustained against an administrator to charge the estate for his having undertaken to sell patented articles in violation of a patent right. He cannot charge the estate for a tort. *Thompson v. Canterbury*, 2 *McCrary*, 332; 12 *Fed. Rep'r.* 485.

One who is manufacturing and selling a patented article under a license from the patentee cannot be sued as an infringer; the only remedy which the patentee can claim against him is such as may be afforded by the contract of license. *Kelly v. Porter*, 17 *Fed. Rep'r.* 519; 8 *Sawyer*, 482.

In what case, and to what extent a landlord is liable for an infringement because the manufacture is carried on in his building and he receives a rent graduated by the amount of sales, see *Starrett v. Athol Machine Co.*, 14 *Fed. Rep'r.* 910; 23 *Pat. Off. Gaz.* 1729.

One who sells a compound he knows cannot be applied without

making the user a trespasser, is accessory to the infringement. *Albertine Co. v. Payne*, 27 *Fed. Rep'r*, 559

### 200. *Cases involving Corporations.*

A town which had maintained a ferry in violation of an exclusive franchise granted to a corporation by the legislature of the State was *held*, liable for damages. *East Hartford v. Hartford Bridge Co.*, 10 *How.* 541.

The only persons who can be held for damages for the infringement of a patent are those who own or have some interest in the business of making, using or selling the thing which is an infringement; an action at law cannot be maintained against the directors, shareholders or workmen of a corporation which infringes a patented improvement. *United Nickel Co. v. Worthington*, 13 *Fed. Rep'r*, 392; 23 *Pat. Off. Gaz.* 939.

The board of directors of a railroad company authorized their chairman to make a certain contract. Pursuant to that authority he made and signed in behalf of the corporation a contract with a manufacturer for the construction of a number of cars, to be delivered to the railroad company. The cars were to be furnished with a certain patented improvement, which the manufacturer had no license to use. In a suit by the patentee against the chairman for an infringement of the patent, it was *held*, that the contract of the chairman could not be construed as authorizing or contemplating any trespass upon the rights of the patentee, and that he was not liable. The fact that the cars were run on the road after completion gave no right of action against the chairman, as his authority extended only to the making of the contract. *Lightner v. Brooks*, 2 *Cliff.* 287.

A transportation company was organized for the purpose of providing a through line for freight between certain cities in the eastern and others in the western States; and contracted with the companies owning railroads between those cities, to furnish cars for use throughout the line. The defendant was the general agent of the transportation company, with power to contract for the carriage of goods, but without power to say in what cars they should be carried, or what axle-boxes should be used on the cars. Axle-boxes which infringed the plaintiff's patent were used on the cars in which the goods were so forwarded by the transportation com-

pany. It was *held*, that defendant was not liable to an action as an infringer of the plaintiff's patent. *Lightner v. Kimball*, 1 *Low*. 211. The defense of the agent in such a case is not that he is the servant of the transit company in doing the wrong, but that he is a stranger to the wrong done; that he has neither the property, the custody, nor the control of the cars in which this contrivance is used; that he can neither command the use nor the discontinuance of it; and that his duties have relation to an entirely distinct subject-matter. *Ib.*

An action may be maintained against a corporation for the infringement of a patent, upon proof of a wrongful manufacture by agents of the corporation with its approval and for its benefit. Corporations can act only by their agents. They can act only by those who are in their employ. And when one in the employment 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 the act, and will be as much bound by it as though expressly authorized. *Poppenhusen v. New York Gutta Percha Comb Co.*, 2 *Fish. Pat. Cas.* 62; 4 *Blatchf.* 184.

If a few persons form themselves into a corporation under the Missouri statute, the business of which is a necessary infringement of a patent, they cannot escape individual liability for the acts done in the corporate name. *St. Louis Stamping Co. v. Quinby*, 18 *Pat. Off. Gaz.* 571; 5 *Bann. & A. Pat. Cas.* 275.

One who was president and sole shareholder of a corporation, was *held*, under the circumstances, personally liable for an infringement committed in the course of the company's business. *Smith v. Standard Laundry Machinery Co.*, 19 *Fed. Rep'r*, 826; 25 *Pat. Off. Gaz.* 393; 15 *Rep'r*, 74.

A corporation is responsible for the conduct of its superintendent in affixing the word "patented" to unpatented articles. *Tompkins v. Butterfield*, 25 *Fed. Rep'r*, 556.

A city is liable in its corporate capacity for the infringement of a patent. *Munson v. New York*, 5 *Fed. Rep'r*, 338; 18 *Blatchf.* 237; 10 *Rep'r*, 135; 5 *Bann. & A. Pat. Cas.* 486.

A city will be held responsible for infringements of patents by its fire department, though separately incorporated. *Brickill v. New York*, 7 *Fed. Rep'r*, 479; 18 *Blatchf.* 273; 18 *Pat. Off. Gaz.* 463.

The act of the legislature of New York, passed March 28, 1862

(Laws 1862, c. 63), has no effect to relieve the corporation of the city of Brooklyn from liability to pay the patentee of a patent for an improvement in hose-couplings used by it without his license. *Bliss v. Brooklyn*, 8 *Blatchf.* 533 ; 4 *Fish. Pat. Cas.* 596.

The city of Brooklyn is not liable to the patentee of a patented seat, for the use thereof in the public schools of the city, under the direction of the board of education, which purchased and owns the seats ; the corporation of the city not using them and having no power by law, to direct the discontinuance of their use. *Allen v. Brooklyn*, 8 *Blatchf.* 535 ; 4 *Fish. Pat. Cas.* 598.

The board of education of the city of New York purchased patented seats for use in public schools. It was *held*, that the city was liable in a suit for infringement, notwithstanding the board was an independent corporation created by the State government. *Allen v. New York*, 17 *Blatchf.* 350 ; 17 *Pat. Off. Gaz.* 1281 ; 5 *Bann. & A. Pat. Cas.* 57.

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## XVI. GROUNDS OF DEFENSE.

### 201. *Interest of the Public in Inventions and Patents.*

From the principle established by many decisions, that the application of an old process or machine to a similar or analogous subject, with no change in the manner of application and no result substantially distinct in its nature, will not sustain a patent, it follows that where the public has acquired in any way the right to use a machine or device for a particular purpose it has the right to use it for all the like purposes to which it can be applied ; and no one can take out a patent to cover the application of the device to a similar purpose. *Blake v. San Francisco*, 113 *U. S.* 679.

A patentee is bound either to use his patent himself or permit others to do so on reasonable and equitable terms. *Hoe v. Knap*, 27 *Fed. Rep'r*, 204.

The public have an equity in patents which must always be regarded. *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.*, 27 *Fed. Rep'r*, 377.

One who invents, or discovers and keeps secret, a process of manufacture, has a property therein, which the courts will protect. *Salomon v. Hertz*, 2 *Cent. Rep'r*, 182.

202. *Fraud.*

A patentee brought a suit for damages against a British corporation on the following facts: The "managing agent" of the British corporation had been sent to this country and had fraudulently pretended, in a series of negotiations, to conclude an agreement with the plaintiff, to make use of his patent. The real purpose of the agent, as alleged by the plaintiff, had been, by means of protracted consultations and drafts of agreements, to prevent him (the plaintiff) from using his invention during a certain period, and thus gain time for his principal to introduce another invention in which it was largely interested. A charge that, if the corporation never gave any authority to its managing agent to assent to the draft of agreement in its behalf and in its name, and never sanctioned it as a corporate act, suit for such a fraud as above indicated could not be maintained, was *held* erroneous, upon the ground that the suit not being upon a contract, the corporation might be responsible for the fraud, notwithstanding its authority and sanction were never given. *Butler v. Watkins*, 13 *Wall.* 456.

In a case of alleged infringement, if the parties deal at arms-length, and the defendant is given his choice between a settlement on the terms offered by the complainant, and a law-suit with time sufficient for reflection and investigation, the fact that the defendant feared the result of litigation on his business, and therefore settled, is not sufficient to support the charge of fraud. *Pope Manuf. Co. v. Owsley*, 27 *Fed. Rep'r*, 100. The mere fact that the owner of a patent alleges an infringement, and threatens suit unless a settlement is made with him, cannot be held to make such settlement void for fraud or intimidation. *Ib.*

Where a patentee claims an infringement, the fact that at the time of making a settlement of the claim for past manufacturing and sale, and granting a license, the patent had expired, though in force when negotiations were begun, does not render the transaction fraudulent. *Ib.*

A party who has owned the recorded title of a patent for more than six months, may, for a valuable consideration, convey the

same to a corporation competent to purchase and hold it ; and the title thus conveyed will not be open to attack for fraud in the assignor. *Racine Seeder Co. v. Joliet Wire-Check Row Co.*, *Fed. Rep'r*, 367.

### 203. *Estoppel.*

Declarations on the part of an inventor that he intended not to take out a patent, but to let the public have his invention, will estop such party, or any one holding under him, from asserting his right against a person acting on the faith of such declarations. *Pitts v. Hall*, 2 *Blatchf.* 229.

A mechanic, working at his employment for wages, who permits his employer to apply for and obtain a patent without objection, upon a machine which the mechanic has perfected, will be deemed to have waived any rights he may have had as a prior inventor. *Fraim v. Keen*, 25 *Fed. Rep'r*, 820 ; 34 *Pat. Off. Gaz.* 1048. S. P., *Ruggles v. Young*, 1 *MacArthur Pat. Cas.* 160 ; *Warner v. Goodyear*, 1 *MacArthur Pat. Cas.* 60 ; *McCormick v. Howard*, *Id.* 238.

A disclaimer at the close of a specification estops the patentee from setting up any privilege to the part disclaimed. *Whitney v. Emmett*, *Baldw.* 303.

A disclaimer made by an attorney in the prosecution of an application for a patent, does not necessarily estop the patentee from maintaining that his claim embraces the matter so referred to. *Mann v. Bayliss*, 10 *Pat. Off. Gaz.* 789.

A patentee is not estopped by his silence in omitting to assert his claim to an invention, unless it has misled another to his hurt. *Railroad Co. v. Dubois*, 12 *Wall.* 47.

A certified copy of the model does not conclude the defendant, but he may show that the model has been changed. *Johnson v. Beard*, 8 *Pat. Off. Gaz.* 435 ; 2 *Bann. & A. Pat. Cas.* 50.

A patentee can not repudiate one of the parts of his combination after another inventor has taught him how to dispense with it. *Hale v. Stimpson*, 2 *Fish. Pat. Cas.* 565 ; *Cooledge v. McCone*, 2 *Sawyer*, 571 ; 5 *Pat. Off. Gaz.* 458 ; 1 *Am. L. T. N. S.* 214 ; 1 *Bann. & A. Pat. Cas.* 78.

Where one has advertised a patented article as one of the most useful of inventions, and one which has superseded all other similar articles ; and has also sold such article for use ; such person is

estopped, in an action against him for an infringement, from denying the utility of the invention. *Stanely v. Whipple*, 2 *McLean*, 35, 39.

In a suit for infringement of a patent, against a purchaser from a licensee, in which the complainant treats the license as no longer in force, the defendant is not estopped from denying the validity of the patent. *Baltimore Car Wheel Co. v. North Baltimore Passenger R. Co.*, 21 *Fed. Rep'r*, 47.

Estoppel of patentee, as against assignee of patent, to allege its invalidity in suit for infringement. *Rumsey v. Buck*, 20 *Fed. Rep'r*, 697; *Underwood v. Warren*, 21 *Fed. Rep'r*, 578.

A licensee under a patent is not estopped to deny its validity, when he has not done or claimed anything under it, and the licensor has had knowledge of his position. *Brown v. Lapham*, 27 *Fed. Rep'r*, 77. He is estopped to deny its validity on any question arising out of that relation between the parties (*Ib.*), so long as the license remains in force. *Pope Manuf. Co. v. Owsley*, 27 *Fed. Rep'r*, 100.

A licensee who agrees not to contest the validity of the patent or the title of the licensor thereby admits the validity of the patent, and waives all questions of limiting or escaping the claims by the prior art; the only question being whether the machines made are within the terms of the patent. The date and duration of a patent are matters of public record which the licensee is as much bound to know as the licensor. *Ib.*

Where it is claimed that a patentee has estopped himself to deny that his American patent was for the same invention as was patented to him in prior foreign patents, by representing that it was for the same, in his application, if the patentee was laboring under a mistake as to this point, his rights ought not to be defeated, or seriously abridged by such mistake. *Commercial Manuf. Co. v. Fairbank Canning Co.*, 27 *Fed. Rep'r*, 78.

A decree dismissing a former bill for failure to show infringement, does not estop the plaintiff, or his assignees, from suing the same defendant for infringing the same patent. *Steam-Guage & Lantern Co. v. Meyrose*, 27 *Fed. Rep'r*, 213.

The equitable doctrine of estoppel is applied to a patentee who, after unreasonable delay, applies for an amendment and enlargement of his claim. *Asmus v. Alden*, 27 *Fed. Rep'r*, 684.

Where the terms of a claim in a patent are clear and distinct, the patentee, in a suit brought upon the patent, is bound by it, and

cannot show that his invention is broader than the terms of his claim ; or, if the invention is broader, he must be held to have surrendered the surplus to the public. *Blades v. Rand, McNally & Co.*, 27 *Fed. Rep'r*, 93.

Where a patentee, in the first instance, made broad claims, which were denied, it was *held* that by accepting a patent for a restricted claim, he abandoned his claim by construction, so far as what was in terms refused him was concerned ; and that his action became part of the law of the patent, and controlled the assignee as well as the original patentee. *Blades v. Rand, McNally & Co.*, 27 *Fed. Rep'r*, 93 ; *Otis Bros. v. Crane Bros. Manuf. Co.*, 27 *Fed. Rep'r*, 550 ; *Roener v. Peddie*, 27 *Fed. Rep'r*, 702.

The inventor of a certain mechanism assigned the invention to a manufacturing company of which he was superintendent, by which it was patented ; and he caused mechanism to be made by the company, representing it to be one of the modifications of the invention patented ; for the construction of which the company had special tools made, and which it introduced to the public as covered by the patent. It was *held*, after he had left the company, that he and all in privity with him, were estopped from denying that the mechanism so constructed was covered by the patent ; and that, as to him and them, an injunction against its reproduction should issue. *Time Telegraph Co. v. Himmer*, 19 *Fed. Rep'r*, 322.

Patent was issued to Armstrong and Hutchinson, in 1875, for an improvement in machines for finishing horse-shoe nails. It was *held* to be shown by a preponderance of evidence in a suit for infringement, to have been obtained by them for devices invented and put in use by them while they were in the employ of the defendant under such terms as to preclude them from making any claims against the defendant for such devices. *Bensley v. Northwestern Horse Nail Co.*, 26 *Fed. Rep'r*, 250.

A patentee of an improvement consisting in securing a loose case or jacket around a hydrant, in such manner that the hydrant might be withdrawn without disturbing the case, was *held* not estopped by procuring a patent therefor, from patenting a further improvement, consisting in so connecting the case with the hydrant that the upheaval of the case a few inches by the frost would not injure or break the hydrant. *Mathews v. Flower*, 25 *Fed. Rep'r*, 830 ; 33 *Pat. Off. Gaz.* 887.

A patent for the change of old parts of a combination to effect efficient co-operation must be limited to the express improvement



made. *Troy Laundry Machinery Co. v. Bunnell*, 27 *Fed. Rep'r*, 810.

The holder of a patent for a combination of devices for a sliding door for railroad cars, claiming as part of the combination guiding rods and staples, and expressly disclaiming the use of grooves as an equivalent, is estopped from insisting, to establish an alleged infringement, that the grooves are equivalent to the rods, or that the rods and staples are not essential to his combination. *Watson v. Cincinnati, I. & C. R. Co.*, 23 *Fed. Rep'r*, 443.

#### 204. *Former Adjudication.*

A former verdict, or dismissal of a bill filed for an injunction to restrain the use of a patented invention, is not a bar to a subsequent action at law for damages, in another State, unless a judgment was rendered on such verdict against the plaintiff, or the dismissal was on the merits. *Allen v. Blunt*, 2 *Woodb. & M.* 121, 132.

The defendant in a suit at law for infringement agreed with the plaintiff, for a valuable consideration, to discontinue the manufacture of the infringing article; and subsequently suffered interlocutory judgment to be entered against himself by default. Afterward he continued to make and sell an article differing but slightly from the former, and a clear infringement of the one patented. A bill in equity having been brought to restrain the unlicensed manufacture, and it appearing that the defenses set up in the answer were within the defendant's knowledge at the time of the action at law, it was *held*, that he was concluded by the agreement of compromise; and should not be permitted to contest the validity of the patent. *Brooks v. Moorhouse*, 13 *Pat. Off. Gaz.* 499; 3 *Bann. & A. Pat. Cas.* 229.

A verdict sustaining a patent, and judgment thereon, in an action between an owner of a territorial right under such patent and an infringer is not admissible in evidence in an action brought by another owner of another territorial right under the same patent for the purpose of establishing his right; but would be admissible on a notice for a provisional injunction, as affording strong evidence of the validity of the patent and of the title. *Buck v. Hermance*, 1 *Blatchf.* 322; 1 *L. Rep'r, N. S.* 321.

A patentee and his assignee brought a suit in equity, in the

circuit court of Louisiana, against a junior patentee, seeking to have the junior patent declared void for interference with their patent. The bill was dismissed on the merits. Subsequently the same plaintiffs brought an action at law, in another circuit for infringement of their patent, against a person who had not been a party to the record in the suit in Louisiana, but who had obtained an interest in the junior patent, after the commencement of the Louisiana suit, and before the judgment of dismissal. It was *held*, that the rights of the parties to the action at law would have been bound by a judgment in the Louisiana suit declaring either patent void; but that the judgment of dismissal did not import the invalidity of the senior patent, and could not be pleaded in bar of the action at law. To constitute such a judgment a bar to such subsequent action, it should have been direct and affirmative in its terms, and have asserted the interference of the patents, and have declared the patent void in whole or in part, or inoperative and invalid in some part of the United States. *Tyler v. Hyde*, 2 *Blatchf.* 308.

The validity of a patent having been in part sustained in one circuit, suit was brought in another circuit for infringement by a party who had contributed to the payment of the counsel who had defended the first suit. The defendant was *held* estopped by the adjudication in the other circuit, and that the proper practice to introduce new evidence as to prior use, would be to move for a rehearing in the other circuit. *Miller v. Liggett, &c. Tobacco Co.*, 7 *Fed. Rep'r*, 91; 2 *McCrary*, 375; 27 *Int. Rev. Rec.* 295; 19 *Pat. Off. Gaz.* 1138.

A judgment recovered in a prior action, was *held*, under the circumstances, not to preclude impeaching the patent in a subsequent suit. *Russell v. Place*, 94 *U. S.* 606.

An adjudication against the defendant in a suit for infringement of a patent binds his servants or agents only through their relation to their employer or principal, and they are not thereby precluded from setting up any defense to a new suit against them for an alleged new infringement by them acting in their own right. *Hayes v. Bickelhaupt*, 24 *Fed. Rep'r*, 806; 32 *Pat. Off. Gaz.* 136.

In an action at law, by patentees, for damages for the use of machines covered by their patent, an answer which sets up the recovery by the plaintiffs against a third person of a decree in equity for an accounting of profits in manufacturing and selling such machines in infringement of the patent; an accounting had

a certain sum awarded to them as such profits; and that the machines for the use of which the action at law is brought were purchased by defendant from such third person, and the profits of their manufacture and sale included in such decree, but which does not allege that such decree has been satisfied by payment or otherwise, or that the accounting included the machines in question, does not state a defense. *Fisher v. Consolidated Amador Mine, &c.*, 25 *Fed. Rep'r*, 201.

Where a licensee accepts a license agreeing not to contest the licensor's title or the validity of the patent, a subsequent decision of a court declaring the patent void will not affect the license. *Pope Manuf. Co. v. Owsley*, 27 *Fed. Rep.* 100.

The rule that parties directly interested in the subject-matter of a suit and a right to make a defense, are concluded by the judgment therein is applied in patent cases. *American Bell Telephone Co. v. National Improved Telephone Co.*, 27 *Fed. Rep'r*, 633.

205. *That the Device Patented does not Involve Invention.*

“Invention,” in the sense of the patent law, means finding out, contriving or creating, by intellectual act, something which did not previously exist. *Conover v. Roach*, 4 *Fish. Pat. Cas.* 12. The word implies exercise of genius, and production of a new idea. *New York Belting & Packing Co. v. Magowan*, 27 *Fed. Rep'r*, 362. See also, pages 36, 37, *ante*.

There may be invention in the adaptation of an old article to a new purpose, producing a useful result. *Yale Lock Manuf. Co. v. Norwich Nat. Bank*, 19 *Blatchf.* 123; 6 *Fed. Rep'r*, 377; *Washing Machine Co. v. Lincoln*, 4 *Fish. Pat. Cas.* 379. But merely bringing old devices into such juxtaposition as will allow each to work out its own effect, but without causing either to contribute any new function or mode of operation, is not invention. *Troy Laundry Machinery Co. v. Bunnell*, 27 *Fed. Rep'r*, 810.

The mere selection, for a particular purpose, from materials known to possess the proper qualities, of materials specially adapted to that purpose—as a choice of steel, or case-hardened iron, for combination with softer metal, in gun-cartridges—is not invention. *Re Maynard*, 1 *MacArthur Pat. Cas.* 536. S. P., *Putnam v. Yerrington*, 2 *Bann. & A. Pat. Cas.* 237; 9 *Pat. Off. Gaz.* 689. And

so, of the substitution of a more appropriate or economical material for one previously in use. *New York Bung, &c. Co. v. Doelger*, 23 *Fed. Rep'r*, 191; 32 *Pat. Off. Gaz.* 651; *Hotchkiss v. Greenwood*, 11 *How.* 248. But the substitution of one material for another may involve contrivance or ingenuity; may involve a new mode of construction, or result in developing new properties or uses; and where this is the case, the rule that there must be exercise of invention is satisfied, and the process or result is patentable. *Hicks v. Kelsey*, 18 *Wall.* 673; *Smith v. Goodyear Dental Vulcanite Co.*, 93 *U. S.* 486; *aff'g 1 Holmes*, 354; *Goodyear Dental Vulcanite Co. v. Root*, 1 *Bann. & A. Pat. Cas.* 384; 6 *Pat. Off. Gaz.* 154; *Goodyear Dental Vulcanite Co. v. Willis*, 1 *H'lipin*, 385; 1 *Bann. & A. Pat. Cas.* 568; 7 *Pat. Off. Gaz.* 41; *Putnam v. Weatherbec*, 1 *Holmes*, 497; 2 *Bann. & A. Pat. Cas.* 78; 8 *Pat. Off. Gaz.* 320; *Dalton v. Nelson*, 13 *Blatchf.* 357; 2 *Bann. & A. Pat. Cas.* 225; 9 *Pat. Off. Gaz.* 1112; *United States Stamping Co. v. King*, 17 *Blatchf.* 55; 4 *Bann. & A. Pat. Cas.* 469; 7 *Fed. Rep'r*, 860; 17 *Pat. Off. Gaz.* 1399.

#### 206. *But only Mechanical Skill.*

To sustain a patent, the device must involve exercise of the inventive faculties; that it is merely new, or useful, or shows mechanical skill, is not enough. *Thompson v. Boisselier*, 114 *U. S.* 1, 29; *Yale Lock Manuf. Co. v. Greenleaf*, 117 *U. S.* 554; *Brown v. Guild*, 23 *Wall.* 181; 6 *Pat. Off. Gaz.* 731; *Celluloid Manuf. Co. v. Comstock & Cheney Co.*, 27 *Fed. Rep'r*, 358; *May v. Fond du Lac County*, 27 *Fed. Rep'r*, 691. See *Hill v. Biddle*, *Id.* 560.

A change in an old device, producing a new and useful result, in which invention is involved, is patentable. *Sewing Machine Co. v. Frame*, 24 *Fed. Rep'r*, 596; 28 *Pat. Off. Gaz.* 96. *S. P.*, *Reed v. Street*, 34 *Pat. Off. Gaz.* 339.

A patent for a combination is not necessarily invalid because all the parts are old; yet merely assembling them together, or placing them in juxtaposition does not indicate invention; but some new or peculiar function, produced by such a combination, must be developed, or the new arrangement is the mere exhibition of mechanical skill (*Scott Manuf. Co. v. Sayre*, 26 *Fed. Rep'r*, 153); and a device which does not involve invention, but mechanical skill simply, is not patentable. *Butler v. Steckel*, 27 *Fed. Rep'r*,

219; *Calkins v. Oskosh Carriage Co.*, *Id.* 296. Though new and useful, an invention, to be patentable, must be the result of something more, and different from, mechanical skill. *Celluloid Manuf. Co. v. Comstock & Cheney Co.*, 27 *Fed. Rep'r*, 358.

Mere mechanical skill applied to an old idea, modifying it and making it more practical, is not patentable unless some new and useful result is obtained. *New York Belting & Packing Co. v. Magowan*, 27 *Fed. Rep'r*, 362.

207. *Novelty in the Invention, Lacking*

It is a valid defense to a suit for infringement (as well as a sound objection to the original application for a patent), to show that the device for which the patent has been granted was not new. Novelty is essential; the patent law requires a thing to be new as well as useful, in order to entitle it to protection by patent. *Stanley Works v. Sargent*, 8 *Blatchf.* 344; 4 *Fish. Pat. Cas.* 443. If there is nothing new in the process, or the machinery for applying it, the result is not patentable. *Collar Co. v. Van Deusen*, 23 *Wall.* 530; 5 *Pat. Off. Gaz.* 919; aff'g 5 *Fish. Pat. Cas.* 597; 10 *Blatchf.* 109; 2 *Pat. Off. Gaz.* 361. Novelty and utility combined determine patentability. *Celluloid Manuf. Co. v. Comstock & Cheney Co.*, 27 *Fed. Rep'r*, 358. See also *ante*, p. 55.

Novelty is variously defined; but the cases agree that the substance or article need not have been non-existent, prior to the invention patented; the inventor's right is secured if his ingenuity, method, or device has given the thing new properties, brought it into uses before impracticable, imparted to it a new value, invested it with a new mode of operation, made it substantially better or cheaper, or the like. *Glue Co. v. Upton*, 97 *U. S.* 3; aff'g 4 *Cliff.* 237; 1 *Bann. & A. Pat. Cas.* 497; 6 *Pat. Off. Gaz.* 837; *Salt Manuf. Co. v. Thomas*, 3 *Leg. Gaz.* 316; 1 *Leg. Gaz. Rep.* 275; *Furbush v. Cook*, 2 *Fish. Pat. Cas.* 668; *Strong v. Noble*, 3 *Id.* 586; 6 *Blatchf.* 477.

Novelty in the result or effect only, is not, in general, sufficient; there must be evidence that the effect is produced by some new process, device, contrivance, mode, manner, or means, or by some new machinery; for a patent cannot be granted for an effect only. Where, however, such a result is shown, slight evidence only of the existence of novelty and invention will suffice. *Yearsley v. Brookfield*, 1 *MacArthur Pat. Cas.* 193.

Where the principle of an alleged invention has been previously discovered and applied, although there may be in the new application some degree of novelty, and something may have been discovered or found out that was not known before, it is not patentable unless the new occasion on which the principle is applied, leads to some kind of new manufacture, or to some new result. *Re Blandy*, 1 *MacArthur Pat. Cas.* 552.

Although a mere analogous use is not patentable, yet where a new or improved manufacture is produced by new contrivances, combinations or arrangements, a new principle may be constituted, and the application or practice of old things will of course be new also in the result. The usual test is whether the production of the article is as good in quality at a cheaper rate, or better in quality at the same rate, or with both these consequences partly combined; and so is the like principle in mechanism. That a combination appears to be simple, and the invention not very great, is not sufficient objection if the invention be not frivolous and foolish. *Re Smith*, 1 *MacArthur Pat. Cas.* 255.

In order to constitute patentable novelty and utility, it must appear that, in a *new process* of manufacture, the result produced was an improvement in the trade, and for the public good or advantage, by the manufacture either of a new or better article, or one cheaper to the public than that produced by the old method. *Jones v. Wetherill*, 1 *MacArthur Pat. Cas.* 409.

In the case of combinations, the fact that one or more of the elements of which it is formed have been used before for other purposes, is not such want of novelty as will defeat an application for a patent; if the combination is substantially new, the invention of the combination is patentable. *Re Watson*, 1 *MacArthur Pat. Cas.* 510. See *Brown v. Whittemore*, 5 *Fish. Pat. Cas.* 524; 2 *Pat. Off. Gaz.* 248.

If the article or result patented can be produced without the aid of the description given in the patent, there is lack of novelty. *Lockwood v. Faber*, 27 *Fed. Rep'r*, 63.

### 208. *Utility Lacking.*

Although a mere change of form or proportion is not a patentable invention, if by such a change a new effect is produced, and proof of its practical utility is given, it may be patentable. *Re Fultz*, 1 *MacArthur Pat. Cas.* 178.

The question of utility pertains chiefly to the examination of the application before the commissioner ; it can seldom be raised with good effect as a defense to a suit for infringement, for the courts will not usually revise the decision of the patent-office as to utility (*Doherty v. Haynes*, 4 *Cliff.* 291 ; 6 *Pat. Off. Gaz.* 118 ; 1 *Bann. & A. Pat. Cas.* 289), but are inclined to treat the fact that defendant thought worth his while to appropriate plaintiff's invention as sufficient proof that it was a useful one. See *ante*, p. 56 ; *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

In order to sustain a patent as well as to obtain one, the machine, device, improvement, combination or other thing for which it has been granted must appear to be useful, as well as new. But a high degree of utility is not required ; nor is utility the sole test of patentability. *Stanley Works v. Sargent*, 8 *Blatchf.* 314 ; 4 *Fish. Pat. Cas.* 443. If an invention produces either a new result which is useful, or an old result more cheaply or advantageously, than was formerly practicable, it is "useful." *Niles Tool Works v. Betts Machine Co.*, 27 *Fed. Rep'r*, 301 ; *Hobbie v. Smith*, 27 *Ib.* 656.

A change in the construction and mode of operation of a mechanical device, although but slight, may be patentable, where the consequences of the change are considerable, resulting in a very great saving of expense. *Re Walsh*, 1 *MacArthur Pat. Cas.* 530. But see *Re Littlefield*, *Id.* 574.

### 209. *Typical Cases illustrating Application of the Rules requiring Invention, Novelty, Utility, &c.*

The decisions are very numerous which, without establishing any new principles of the law of patents, determine the application of the principles presented in the last three sections to particular inventions. *The following are the more instructive examples of THINGS NOT PATENTABLE which have been adjudged so for want of invention, novelty, utility, or for like objections.*

A combination of machinery used to form lead pipes in a new way ; such machinery in principle being the same as that commonly employed to make maccaroni, and clay pipes. *Le Roy v. Tatham*, 14 *How.* 156.

A wagon-reach made of iron instead of wood as formerly used. *Hicks v. Kelsy*, 18 *Wall.* 670.

A combination which consists only of the application of a piece

of rubber to one end of the piece of wood which makes a lead pencil. *Rubber Tip Pencil Co v. Howard*, 20 *Wall.* 498 ; aff'g 5 *Fish. Pat. Cas.* 377 ; 9 *Blatchf.* 490 ; *Reckendorfer v. Faber*, 92 *U. S.* 347 ; aff'g 12 *Blatchf.* 68 ; 1 *Bann. & A. Pat. Cas.* 229.

A claim of a woven elastic fabric, differing from those previously used only in being more tightly woven, and more elastic by reason of a greater proportion of elastic strands. *Smith v. Nichols*, 21 *Wall.* 112.

A product consisting merely of a metallic ring envelope in a composition of ivory or similar material,—being an improved form of rings for martingales. *Rubber-Coat Harness Trimming Co. v. Welling*, 97 *U. S.* 7.

The grinding or powdering an article of commerce,—in this instance glue,—to render it easier of handling, and more readily dissolved for use. *Glue Co. v. Upton*, 97 *U. S.* 3 ; aff'g 4 *Cliff.* 237 ; 6 *Pat. Off. Gaz.* 837 ; 1 *Bann. & A. Pat. Cas.* 497.

The use of wedge-shaped blocks in making a pavement ; that being the principle long since applied in laying cobble-stone pavements ; also the mere exercise of judgment as to the amount of force or degree of force to be used in ramming or swaging. *Stow v. Chicago*, 8 *Biss.* 47 ; 8 *Bann. & A. Pat. Cas.* 83 ; aff'd, 104 *U. S.* 547.

A contrivance consisting merely in putting an additional pane of glass in a fare-box in a street car, opposite the side next the driver, so that the passengers can see the interior of the box through it ; for this requires no more invention than the placing of an additional pane of glass in a show-case, or the putting of an additional window in a room. *Slawson v. Grand Street R. R. Co.*, 107 *U. S.* 649.

The use in succession of two distinct pairs of dies, of well-known kinds, not combined in one machine, nor co-operating to one result, but each pair doing by itself its own work. *Beecher Manuf. Co. v. Atwater Manuf. Co.*, 114 *U. S.* 523.

A combined hose-carriage and fountain-standard, consisting in the combination of “a wheeled carriage provided with a foot or brace to sustain it in an upright vertical position, a nozzle-holding device, and a reel of large diameter to allow water to flow through the hose when partially wound there ;” the proof showing that a fountain-standard and hose-reel, similarly mounted, had been previously used in combination. *Preston v. Manard*, 116 *U. S.* 661



The making of a part of an old manufacture as a separate article of trade. *Seligman v. Day*, 14 *Blatchf.* 72 ; 2 *Bann. & A. Pat. Cas.* 467.

A paper bag made with a notch cut with jagged or serrated edges with a view to facilitate the opening of the mouth, instead of with smooth edges as previously used. *Matter of Arkell*, 15 *Blatchf.* 437.

An improvement in distributors for copy for compositors, which, instead of the device previously in use, of a series of hooks lettered to correspond with letters systematically placed upon the leaves of copy, also marked upon the type, employed a galley holder with compartments for galleys permanently lettered to correspond with the lettering on the hooks. *Brainard v. Evening Post Assoc.*, 22 *Blatchf.* 61.

An improvement in the application of palm-leaf to stuffing beds, &c., which same process had been used in preparing hair for like uses, so that there was no invention of any new process. *Howe v. Abbott*, 2 *Story*, 190.

An improvement consisting only in a change in the manner of attaching several knives, instead of one, on a cylinder by screws, instead of attaching it to the cylinder by rings at the end. *Hovey v. Stevens*, 1 *Woodb. & M.* 290.

An improvement in the known mode of making car-wheels by placing a heated tire of cast steel in a mould, and then pouring in molten cast iron at the center of the mould, thus producing a weld or union between the iron and the steel ; which consisted merely in introducing the molten iron through a series of openings or "sprues" just inside the heated rim or tire. *Needham v. Washburn*, 4 *Cliff.* 254 ; 7 *Pat. Off. Gaz.* 649 ; 1 *Bann. & A. Pat. Cas.* 537.

An improvement in locks and door-fastenings, consisting in making them double-faced, so that the same lock or fastening may be used for a right or left-hand door ; locks that might be applied in the same way, though not used or made for that precise purpose, being in public use. *Livingston v. Livingston*, 1 *Fish. Pat. Cas.* 521.

Where the patentee of an improvement in chewing-gum took the crude chicle of commerce, washed it in hot water to remove the coloring matter and impurities, and claimed the product as a new invention ; but there was proof that the same process had long been used for washing and purifying India rubber and gutta-percha,

which are products of the same vegetable family as chickly. *Adams v. Loft*, 8 *Rep'r*, 612 ; 4 *Bann. & A. Pat. Cas.* 495.

The preparing and cutting up meat, and putting it in a can which is then hermetically sealed ; and the construction of the can of a particular form. *Wilson Packing Co. v. Clapp*, 8 *Rep'r*, 262 ; 8 *Biss.* 545 ; 4 *Bann. & A. Pat. Cas.* 355.

A method by which hair is put in small packages and compressed into convenient shape for sale to plasterers, so that the compressed bale may be separated into convenient smaller packages as desired. *King v. Frostel*, 8 *Rep'r*, 490 ; 8 *Biss.* 510 ; 4 *Bann. & A. Pat. Cas.* 236.

The mere change of the form of a die so as to change the form of that which was manipulated under the die. *Smith v. American Bridge Co.*, 8 *Biss.* 312 ; 3 *Bann. & A. Pat. Cas.* 565.

The mere change of the spaces of lines embossed on paper so that they might be used for writing. *Cone v. Morgan Envelope Co.*, 4 *Bann. & A. Pat. Cas.* 107.

Merely attaching prongs to a disk to serve the same purpose as the disk. *Lorillard v. Ridgway*, 4 *Bann. & A. Pat. Cas.* 564 ; 16 *Pat. Off. Gaz.* 1231.

A lady's hair-net made of coarse threads interspersed with fine threads, instead of fine threads alone, as already in use. *Dalton v. Jennings*, 5 *Pat. Off. Gaz.* 615.

A patent for apparatus in which the acid and alkaline solutions for forming carbonic acid gas were kept separate until required to extinguish a fire, when they could be readily mingled ; it appearing that similar apparatus had been employed in soda-fountains for the supply of beverages. *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 6 *Pat. Off. Gaz.* 34 ; 10 *Phila.* 227 ; 1 *Bann. & A. Pat. Cas.* 177.

The mere making of a model of an invention, was held not to constitute invention, as against a patent subsequently granted to another for the same thing. *Stilwell, &c. Manuf. Co. v. Cincinnati Gas-light, &c. Co.*, 7 *Pat. Off. Gaz.* 829.

A claim for making in iron, a frame which has before been made in wood. *Holbrook v. Small*, 10 *Pat. Off. Gaz.* 503.

Combining a curved metal receiver with an elevated, instead of a horizontal, delivery. *Mann v. Bayliss*, 10 *Pat. Off. Gaz.* 789.

The putting a second cover on a base-ball, to harden it ; there being proof that a double cover had previously been used for the

like purpose upon softer balls. *Mahn v. Harwood*, 3 *Bann. & A. Pat. Cas.* 515 ; 14 *Pat. Off. Gaz.* 859.

The fastening of one or more fire-lighters to each bundle of the common article known as bundle or kindling wood ; or the " accompanying " the bundle with a fire-lighter. *Alcott v. Young*, 16 *Pat. Off. Gaz.* 403.

The use of kerosene oil in a stove by means of prior devices ; though such prior devices were intended for illuminating purposes, and alcohol or other combustible fluids were to be used. *Couse v. Johnson*, 16 *Pat. Off. Gaz.* 719 ; 4 *Bann. & A. Pat. Cas.* 501.

A metallic roofing or covering, made of a series of corrugated shingles, to be secured to the roof by nails, as are ordinary wooden shingles, one shingle overlapping another, so as to cover the nail holes in the lowest shingle. *American Iron Co. v. Anglo-American Roofing Co.*, 16 *Fed. Rep'r*, 915 ; 24 *Pat. Off. Gaz.* 1274 ; 15 *Rep'r*, 779.

A change in form of corrugated iron to be applied to a building, or making the nail-holes in it elongated. *Belt v. Crittenden*, 2 *Fed. Rep'r*, 82 ; 1 *McCrary*, 209 ; 18 *Pat. Off. Gaz.* 191 ; 5 *Bann. & A. Pat. Cas.* 131.

A window cleaner, consisting of a holder with an elastic strap attached. *Perfection Window Cleaner Co. v. Bosley*, 2 *Fed. Rep'r*, 574 ; 9 *Biss.* 385 ; 10 *Rep'r*, 67 ; 5 *Bann. & A. Pat. Cas.* 449.

The use of the same mechanism for the purpose of applying a blast of hot air to the interior of beer casks to heat them, as had been previously used to apply a blast of hot air, of the same character, to the interior of moulds and other receptacles for the same purpose. *Gottfried v. Crescent Brewing Co.*, 9 *Fed. Rep'r*, 762 ; 22 *Pat. Off. Gaz.* 497.

The employment of sheet metal as a lining for the bottom of a vessel to obtain liquids. *New York Grape Sugar Co. v. American Grape Sugar Co.*, 10 *Fed. Rep'r*, 835 ; 20 *Blatchf.* 386 ; 13 *Rep'r*, 548.

An improvement in stoves, consisting in the substitution of a flat grate for a dished grate (*Perry v. Co-operative Foundry Co.*, 12 *Fed. Rep'r*, 149) ; or the substitution of an old grate made in two parts for another old grate made in one part. *Id.* 436.

A can adapted to hold liquids, constructed after a device previously patented for a can to hold dry substances. *Norton v. Haight*, 22 *Fed. Rep'r*, 787.

A composition for an artificial ivory, consisting of a mechanical mixture of kaolin and shellac ; where it appeared that the use of

those ingredients in combination was not new, and that the proportions stated in the patent did not produce any new or useful result. *Welling v. Crane*, 21 *Fed. Rep'r*, 707; 29 *Pat. Off. Gaz.* 451.

Alleged improvements in dissolving xyloidine, consisting in the use of camphor in conjunction with alcohol as a solvent; and in bleaching zyloidine, consisting in the application of ordinary bleaching materials, which had not before been used. *Spill v. Celluloid Manuf. Co.*, 22 *Blatchf.* 441; 21 *Fed. Rep'r*, 631.

An improvement in sectional honey-frames, consisting of making them by bending and uniting the ends of a blank consisting of a single piece. *Fornerook v. Root*, 21 *Fed. Rep'r*, 328; 29 *Pat. Off. Gaz.* 775.

Application to the turning of machine awls and needles, from metal, of mechanism old and familiar in the art of wood-turning. *Howe Machine Co. v. National Needle Co.*, 21 *Fed. Rep'r*, 630.

A claim of a process for preserving animal and vegetable substances, which process had been previously known; although the apparatus described might carry out the process better than that previously in use. *Alden Evaporating Fruit Co. v. Bowen*, 24 *Fed. Rep'r*, 787; 32 *Pat. Off. Gaz.* 1355.

An improvement in bushings for bungs, consisting in a change, in an old device, of one known material for another which had been previously used for kindred purposes. *New York Bung, &c. Co. v. Doelger*, 23 *Fed. Rep'r*, 191; 32 *Pat. Off. Gaz.* 651.

A patent for an improvement in construction of mosaic flooring, consisting of laying such flooring of hard wood upon a foundation of soft wood, tongued and grooved together. *Kappes v. Hartung*, 23 *Fed. Rep'r*, 187; 32 *Pat. Off. Gaz.* 652.

A claim of an improved tap-sole for rubber boots; the essence of the invention being in the form or shape. *Woonsocket Rubber Co. v. Candee*, 23 *Fed. Rep'r*, 797.

An improvement in type-writers, covering a combination of key levers of the third order of levers, and shields for covering the exposed ends of the levers; both of which were previously known and used in type-writers, although not in combination; the improvement involving a mere change of location of the shields to meet the different points of exposure. *Phipps v. Yost*, 26 *Fed. Rep'r*, 447.

An improvement in spittoons, consisting in loading the bottom

with sand secured by a metal plate. *Havemeyer v. Randall*, 21 *Fed. Rep'r*, 404 ; *Havemeyer v. Bonnell*, *Id.* 406.

An improvement in soldering process, involving a mere change of process from that of turning the article to be soldered in molten solder, while heated, to that of pouring melted solder into the joint from a ladle. *Adams & Westlake Manuf. Co. v. Wilson Packing Co.*, 21 *Fed. Rep'r*, 648.

An improved mode of uniting small biscuit pans together in clusters, consisting in providing the pans with horizontal flanges and riveting them. *Lalace & Grojean Manuf. Co. v. United States Stamping Co.*, 23 *Fed. Rep'r*, 800.

An improvement in a process of treating oleaginous seeds, consisting only in certain mechanical changes in carrying into effect the well-known old steps of the process. *Lowther v. Hamilton*, 21 *Fed. Rep'r*, 811 ; 29 *Pat. Off. Gaz.* 449.

An improvement in dummies for displaying clothing, consisting in the substitution of paper or papier mache for the wire previously used in making such dummies ; but that material had been used before in constructing lay figures, representing celebrated personages clothed with costumes. *Palmenburg v. Buchholz*, 21 *Blatchf.* 162.

Patent for an improvement in the manufacture of hydrogen peroxide, or oxygenated water ; the alleged improvement consisting merely in the stirring, by a well-known and simple mechanical device, of a liquid which, in the prior process, had been stirred by hand. *Marchand v. Emken*, 26 *Fed. Rep'r*, 629 ; 34 *Pat. Off. Gaz.* 1275.

An improvement in tools for reaming and squaring pipes ; being only an adaptation, perhaps to a new use, of a tool long previously well known, requiring mere mechanical change. *Barry v. Crane Bros. Manuf. Co.*, 22 *Fed. Rep'r*, 396.

An improvement in scale-pans for weighing, describing the scale-pans as "made entire of glass," with strong lugs, on each side, through holes in which were passed double suspending bows ; there having been prior knowledge and use of scale-pans made of glass and glazed porcelain, and of metallic scale-pans suspended on bows similar to those described. *Forschner v. Baumgarten*, 26 *Fed. Rep'r*, 858.

An improvement in marking plug, claiming, as a new article of manufacture, a plug of tobacco marked with indentations to serve as guides for cutting the plug into measured quantities ; the same

device having been applied to other articles, and for the same purpose. *Drummond v. Venable*, 26 *Fed. Rep'r*, 243.

A corset with an elastic gore or gusset, for wearing apparel; the difference between these and previous patents for similar articles appearing to involve only the substitution of one material for another, and to require no inventive ability, but mere mechanical skill or adaptation. *Florsheim v. Schilling*, 26 *Fed. Rep'r*, 256.

A peculiar form of packing ice, for shipment or storage, consisting in placing the blocks close together, in a manner to prevent percolation of water. *Re Kemper*, 1 *MacArthur Pat. Cas.* 1.

The discovery that attaching an advertisement permanently to a balloon is a good mode of advertising. *Gould v. Commissioner*, 1 *MacArthur*, 410 ; 5 *Pat. Off. Gaz.* 121.

The application of a known and ordinary power to an ordinary purpose,—such as the combination of an endless screw and cog-wheel for steering apparatus to vessels. *Cochrane v. Waterman*, 1 *MacArthur Pat. Cas.* 52. *S. P., Walker v. Rawson*, 4 *Bann. & A. Pat. Cas.* 128.

The application of a mere mechanical device, requiring no invention, to a machine which was conceived by another and is being actually reduced to practice. *Marshall v. Mee*, 1 *MacArthur Pat. Cas.* 229.

The mere repetition of a well known process by which a metallic paint, heretofore known, may be obtained from waste matter. *Re Maule*, 1 *MacArthur Pat. Cas.* 271.

The use, in illuminated vault covers, of polygonal glasses of an inverted pyramidal form instead of lens-shaped glasses previously used, there being no evidence of the actual results in practice. *Re Jackson*, 1 *MacArthur Pat. Cas.* 485.

An improvement which consists merely in the employment of an obvious substitute, but does not involve, to any considerable extent, the exercise of ingenuity. *Re Everson*, 1 *MacArthur Pat. Cas.* 406 ; *May v. Fond du Lac County*, 27 *Fed. Rep'r*, 691.

Otherwise, if the substitute is not obvious, and is new and useful. *Ladd v. Tucker Manuf. Co.*, 4 *Bann. & A. Pat. Cas.* 344.

A mere change in the details of mechanical construction of a device, as in the relative position and mode of attachment of its parts, but producing no new effect (*Re Bishop*, 1 *MacArthur Pat. Cas.* 518 ; *Dane v. Illinois Manuf. Co.*, 6 *Fish. Pat. Cas.* 124 ; 3 *Biss.* 374 ; *Hancock Inspirator Co. v. Lally*, 27 *Fed. Rep'r*, 88) ; though a change in arrangement of old parts of a combination

which effects efficient co-operation may involve invention. *Troy Laundry Machinery Co. v. Bunnell*, 27 *Fed. Rep'r*, 810.

An alleged invention of an improved mode of protecting objects from the effect of lightning, by surrounding that part of the lightning-rod which is imbedded in the earth with a galvanic battery. *Re Cushman*, 1 *MacArthur Pat. Cas.* 569.

211. *Cases of Patents sustained against Objections of Want of Invention, Novelty, Utility, &c.*

A process of nickel plating, doubts existing whether nickel plating was reduced by previous discoveries to a practical art. *United Nickel Co. v. California Electrical Works*, 25 *Fed. Rep.* 475.

A process of manufacturing spoons and forks from steel, and the product resulting from such process; the result being attained by a succession of processes, which, though separately old, had not previously been practically grouped in the order employed. *Wallace v. Noyes*, 21 *Blatchf.* 83.

The subjection of spiral steel wire springs to heat, not merely for the purpose of tempering the steel, but also to restore strength and elasticity of the wire, lost by the displacement of its particles from being made into springs. *Cary v. Wolff*, 24 *Fed. Rep'r*, 139; 32 *Pat. Off. Gaz.* 257; *Cary v. Lovell Manuf. Co.*, 24 *Fed. Rep'r*, 141; 32 *Pat. Off. Gaz.* 1009; *Cary v. Domestic Spring Bed Co.*, 34 *Pat. Off. Gaz.* 1158.

An improved automatic fire extinguisher, in which the seal was placed at the extreme outer end of the water pipe, and so near to the distributor, that, when the joint of the seal was melted, the seal itself was forced into the distributor and the water was left unobstructed. *Parmelee v. Burritt Hardware Co.*, 24 *Fed. Rep'r*, 735; 33 *Pat. Off. Gaz.* 237.

The creation of a new device from an old one, by altering the structure at tops of childrens' carriages, so as to abandon the principal thing which the old device was created to do, and so as to change the principle of the mechanism in order to accomplish what the old structure did not undertake to do. *Parker v. Stow*, 23 *Fed. Rep'r*, 252; 31 *Pat. Off. Gaz.* 117; *Parker v. Montpelier Carriage Co.*, 23 *Fed. Rep'r*, 886; 31 *Pat. Off. Gaz.* 1688; *Parker v. McKee*, 24 *Fed. Rep'r*, 808; 32 *Pat. Off. Gaz.* 137.

An improvement in cake-pans, where all the parts were known before, but not in the same connection and arrangement. *Bell v. United States Stamping Co.*, 22 *Blatchf.* 27.

An improvement in kerosene stoves, consisting in holding the chimneys between upper and lower plates, so that the lower plate rested directly over the burners, while the upper plate furnished facilities for holding the cooking utensils. The fastening the chimney between the two plates, in this device, caused its success. *Adams & Westlake Manuf. Co. v. Rathbone*, 26 *Fed. Rep'r*, 262.

An improvement in friction drums for pile-drivers and hoisting machines, being for new combination, making a more compact, economical and useful machine than those previously in use. *Mundy v. Lidgerwood Manuf. Co.*, 27 *Pat. Off. Gaz.* 718.

The substitution in a pendulum level of an entire graduated circle for a graduated semi-circle; the improvement involving a difference of construction which was shown to fit the new instrument for use in places where the old form could not be used; although opportunities for its use were rare. *Chandler v. Ladd*, 1 *MacArthur Pat. Cas.* 493.

An improved brick machine adapted to the manufacture of tubular or perforated brick, by providing the mold box with a core and an annular bottom or plunger for expelling the brick; held more than a mere change in the form of previous machines. *Re Wagner*, 1 *MacArthur Pat. Cas.* 510.

A pavement composed of stone blocks, of which the ends lying in the end of travel were smooth and fitted close together, while the sides lying across the street were left rough, with spaces between them in which the horses' feet might take hold. *Guidet v. Barber*, 5 *Pat. Off. Gaz.* 149.

A blank book with spaces numbered for bonds and coupons outstanding against the proprietor of the book, arranged for keeping them for reference as they should come in and be paid. *Munson v. New York*, 3 *Fed. Rep'r*, 338; 18 *Blatchf.* 237; 10 *Rep'r*, 135;

A hotel register, whose side margin was occupied with advertisements, and the middle left vacant for names of guests. *Hawes v. Washburne*, 5 *Pat. Off. Gaz.* 491. See also *Hawes v. Cook*, *Id.* 493; *Hawes v. Gaze*, *Id.* 494.

A fare register and recorder, consisting of a new arrangement of working together of old devices. *Railway Register Manuf. Co. v. Broadway & Seventh Ave. R. R. Co.*, 22 *Fed. Rep'r*, 655; 30 *Pat.*



*Off. Gaz.* 180 ; but see decision granting rehearing, 32 *Pat. Off. Gaz.* 257 ; and decision on rehearing, 34 *Pat. Off. Gaz.* 921.

An improvement in manufacturing artificial teeth by substituting a vulcanizable rubber plate in place of other material formerly used. *Smith v. Goodyear Dental, &c. Co.*, 93 *U. S.* 486.

An improvement in a bottle-stopper fastener, consisting in forming the fastener at the part that comes over the cork, of a piece of wire of a **U** form, with the ends returned and connected to the bottle in order that the pressure on the cork or stopper, may cause the fastener to hold more securely ; a prior patent having been issued for a similar fastener made of tin. *Putnam v. Yerrington*, 9 *Pat. Off. Gaz.* 689.

An improvement in a compressed steam-gauge cock, consisting in the substitution of vulcanized rubber in the opposing surfaces in place of brass or lead, leather or cork, as previously used. *Dalton v. Nelson*, 13 *Blatchf.* 357.

An improvement consisting in the substitution of an intermittent rotary seed-wheel for an oscillatory seed-wheel. *Brown v. Deere*, 6 *Fed. Rep'r*, 484.

An improvement in regulating the draft of stoves, consisting in the application of the principle of expansion or contraction of a metallic rod by means of the heat produced by the stove itself, thereby producing a self regulator. *Foote v. Silsby*, 1 *Blatchf.* 445 ; 2 *Blatchf.* 260 ; aff'd 20 *How.* 378.

A number of rollers, acting in pairs, arranged for a particular purpose. *Knight v. Gavit*, *Mir. Pat. Off.* 132. *S. P.*, *Parker v. Hulme*, 7 *West. L. J.* 417 ; 1 *Fish. Pat. Cas.* 45.

An invention of a peculiar form of a last. *Mabie v. Haskell*, 2 *Cliff.* 507.

The placing of a rivet at the corners of a pocket opening. *Strauss v. King*, 17 *Pat. Off. Gaz.* 1450 ; 18 *Blatchf.* 88 ; 5 *Bann. & A. Pat. Cas.* 338 ; 2 *Fed. Rep'r*, 236.

The discovery that the foam in beverages can be increased by the use of soapine. *Bowker v. Dows*, 15 *Pat. Off. Gaz.* 510 ; 3 *Bann. & A. Pat. Cas.* 518.

A float-valve placed at the mouth of an air eduction-pipe in a night-soil cask, so as to close such pipe and stop the operation of the air-pump when the cask is filled ; notwithstanding similar valves had been before used in steam-boilers and water-tanks to close eduction passages. *Odorless Excavating Apparatus Co. v. Clements*, 16 *Pat. Off. Gaz.* 854 ; 4 *Bann. & A. Pat. Cas.* 540.

An improvement in the art of curing fish, by removing a part of the mucous membrane not before known to be injurious to the keeping quality of the fish. 1 *Fed. Rep'r*, 140 ; 3 *Bann. & A. Pat. Cas.* 478.

A vulcanized rubber packing for boxes of pistons, sustained against the objection of lack of invention, because it disclosed a new and better method of obtaining a tight joint between the packing and the piston-rod than had been before obtained. *New York Belting, &c. Co. v. Magowan*, 34 *Pat. Off. Gaz.* 1159.

An improvement in floating mowing machines, consisting of the combination of the cutting apparatus of a mowing-machine with a boat, in such a way as to make it operate successfully for mowing under water. *Piper v. Shedd*, 26 *Fed. Rep'r*, 151.

Where an old device, with serious defects, was changed, and an improved result obtained. *Asmus v. Alden*, 27 *Fed. Rep'r*, 684.

A new combination of old and well-known mechanical appliances, the patent being limited to the combination alone. *Re Boughton*, 1 *MacArthur Pat. Cas.* 278 ; *Frink v. Petry*, 11 *Blatchf.* 422 ; 5 *Pat. Off. Gaz.* 201 ; 1 *Bann. & A. Pat. Cas.* 1 ; *Forbush v. Cook*, 2 *Fish. Pat. Cas.* 668 ; *Re Hebbard*, 1 *MacArthur Pat. Cas.* 543.

An imitation honey, which could be made more cheaply than real honey, and was not unwholesome ; although purchasers might easily mistake it for the real. *Re Corbin*, 1 *MacArthur Pat. Cas.* 521.

## 212. *Irregularities or Defects in the Patent or the Proceeding to obtain it.*

Although an inventor cannot obtain a valid patent until he has in some sense completed or perfected his invention (*Colt v. Massachusetts Arms Co.*, 1 *Fish. Pat. Cas.* 108 ; *National Oil Co. v. Arctic Oil Co.*, 4 *Id.* 514 ; 8 *Blatchf.* 416 ; and see p. 58, *ante*), yet a patent duly issued will not be adjudged void because the invention was not literally and completely reduced to practice before the patent was issued ; the phrase "reduced to practice," simply means that the thing must be so described, modeled, or otherwise exhibited in working condition, as to demonstrate that it does not rest in mere theory. *Heath v. Hildreth*, 1 *MacArthur Pat. Cas.* 12 ; *Re Seely*, *Id.* 243. It is in this sense that an invention is said not to be

patentable until "perfected." *Moore v. Thomas*, 3 *Bann. & A. Pat. Cas.* 13.

The filing of an application containing a clear and distinct description of the invention by specification and drawing, is a sufficient compliance with the requirement of a reduction to practice to entitle the applicant to a patent; and the fact that it has been used by others, although the applicant has not himself been able to use it successfully, is sufficient evidence of its capability of being used in the manner described. *Burrows v. Wetherill*, 1 *MacArthur Pat. Cas.* 315.

The descriptive language in a specification or claim, if clear, should be followed in its natural and ordinary meaning (*Mitchell v. Tilghman*, 19 *Wall.* 287; and see *ante*, pp. 68-76; 220-229), or, if ambiguous, should be favorably read, so as to give effect to the true intention of the patentee, considered as probably inexpert in the use of scientific language (*French v. Rodgers*, 1 *Fish. Pat. Cas.* 133; *Page v. Ferry*, *Id.* 298); and disregarding an error of expression which is apparent, and by which no one could be misled (*Kneass v. Schuylkill Bank*, 4 *Wash.* 9), without, however, forcing it beyond the true meaning of the language used. *Masury v. Anderson*, 6 *Fish. Pat. Cas.* 457; 11 *Blatchf.* 162; 4 *Pat. Off. Gaz.* 55.

But the description must clearly specify the various elements which the patentee claims as his invention, so fully that a competent artisan, skilled in the art, could construct the invention from the description given, without other aid (*Webster Loom Co. v. Higgins*, 16 *Pat. Off. Gaz.* 675), and so distinctly that the court can say what is the improvement or invention claimed by the patentee, and to what it is limited (*Barrett v. Hall*, 1 *Mas.* 447, 476; *Lowell v. Lewis*, 1 *Mas.* 182; *Langdon v. De Groot*, 1 *Paine*, 203; *Parker v. Stiles*, 5 *McLean*, 44; 7 *West. L. J.* 168; *Tyler v. Deval*, 1 *Code Rep'r*, 30); or can determine what parts or features of the machine, &c., are essential to the proposed result; without this (even though they may be distinguishable in the patent-office model), other persons are not forbidden to imitate them (*Barry v. Gugenheim*, 5 *Fish. Pat. Cas.* 452; 1 *Pat. Off. Gaz.* 382). Portions of the invention, which are omitted from the description, are not protected by the patent (*Burden v. Corning*, 2 *Fish. Pat. Cas.* 477); if, however, the description states lucidly what the patentee claims, it need not characterize what he does not claim as

“old” (*Brown v. Guild*, 23 *Wall.* 181), or describe it otherwise than in general terms. *Ib.*; *Many v. Jagger*, 1 *Blatchf.* 372.

An original patent is said to be entitled to a broader construction than a mere improvement. *May v. Fond du Lac County*, 27 *Fed. Rep'r*, 691.

A claim in the patent for more than plaintiff was the first and original discoverer and inventor of, will not avoid as to that which is new; and if his process in the separate preparation of either of the ingredients named in his patent was before named and used, yet if his combination of them is new, and the result produced is new and useful, his patent is valid. *Stephens v. Felt*, 11 *Hunt Mer. Mag.* 266.

When the claim expresses a combination of several elements without particularly pointing out the special construction of one embodying the actual novelty and invention, and the general combination is old, the patent is broader than the actual invention, and invalid. *Terry Clock Co. v. New Haven Clock Co.*, 17 *Pat. Off. Gaz.* 908; 3 *Bann. & A. Pat. Cas.* 332.

If it is apparent from the specifications that the patent is for an invention which is frivolous, the court may declare it inoperative. *Wilson v. Janes*, 3 *Blatchf.* 227.

A patent for a composition, where the specification clearly describes the composition and all the ingredients and proportions, in language intelligible to those skilled in the art, cannot be invalidated by evidence of a failure to deposit in the patent-office a sample of one of the ingredients. It is for the commissioner to decide, before granting the letters-patent, whether this requirement has been complied with. A patent once granted cannot be subsequently impeached by evidence tending to show a want of compliance with the law as to giving notice, or paying fees, or performing the other acts required to be done before the patent is granted, and the performance of which is to be proved to the satisfaction of the commissioner, whose decision on these questions is final where he has jurisdiction. *Tarr v. Folsom*, 1 *Holmes*, 312; 5 *Pat. Off. Gaz.* 92; 1 *Bann. & A. Pat. Cas.* 24.

A claim to a patent for a compound is not void because the specification does not prescribe exact and unvarying proportions in the ingredients of the compound. *Klein v. Russell*, 19 *Wall.* 433.

Subject to general principles such as these (more fully explained *ante*, pp. 68-76, 220-229), not only may the commissioner reject an application for its obscurity or deficiency of language, but an

alleged infringer may object that the scope of a patent cannot be extended beyond its language (see *Rapp v. Bard*, 1 *Fish. Pat. Cas.* 196 ; *Renwick v. Pond*, 10 *Blatchf.* 39 ; 5 *Fish. Pat. Cas.* 569 ; 2 *Pat. Off. Gaz.* 392 ; *Roemer v. Neumann*, 26 *Fed. Rep'r*, 102); that the grant must be limited to the invention covered by the claim, and while the claim may be illustrated, it cannot be enlarged by language used in other parts of the specification (*Yale Lock Manuf. Co. v. Greenleaf*, 117 *U. S.* 554); or where the claims and specifications are repugnant, and the claim does not cover what is covered or described in the specifications, may contend that the patent is void for uncertainty. *Smith v. Murray*, 27 *Fed. Rep'r*, 69.

Whether alterations made in an application, after it has been filed, impair the validity of a patent issued upon it, see *Gill v. Wells*, 22 *Wall.* 1 ; *Robertson v. Secombe Manuf. Co.*, 10 *Blatchf.* 481 ; 3 *Pat. Off. Gaz.* 412 ; 6 *Fish. Pat. Cas.* 268 ; *Globe Nail Co.*, 27 *Fed. Rep'r*, 450 ; also *ante*, p. 78.

With respect to official errors in preparing and issuing the patent, the cases have *held*, that the point that a patent was issued unintentionally, through the blunder of a subordinate in the patent office, cannot be raised in a suit brought on the patent. The seal of the United States and the signature of the proper officers to the grant must be respected, in the absence of fraud, so long as the United States do not themselves question the grant. *Doughty v. West*, 6 *Blatchf.* 429 ; 3 *Fish. Pat. Cas.* 580. See also, *Tarr v. Folsom*, *supra* ; *Railway Reg. Manuf. Co. v. North Hudson C. R. Co.*, 23 *Fed. Rep'r*, 593 ; 32 *Pat. Off. Gaz.* 519.

A grant (here, letters-patent) is not necessarily void by reason of an error in the Christian name of the grantee ; and where it contains any other matter descriptive of the person for whom it was intended, extrinsic proof of such matter is admissible to identify the grantee. *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 10 *Phila.* 227 ; 6 *Pat. Off. Gaz.* 34 ; 1 *Bann. & A. Pat. Cas.* 177.

The decision of the commissioner of patents in the allowance and issue of a patent creates a *prima facie* right only ; and, upon all the questions involved therein, the validity of the patent is subject to examination by the courts. *Reckendorfer v. Faber*, 92 *U. S.* 347. *S. P.*, *Agawam Co. v. Jordan*, 7 *Wall.* 583, 596 ; *Union Paper Bag Machine Co. v. Crane*, 1 *Holmes*, 429 ; 6 *Pat. Off. Gaz.* 801 ; 1 *Bann. & A. Pat. Cas.* 494 ; *Whipple v. Miner*, 15 *Fed.*

*Rep'r*, 117 ; 23 *Pat. Off. Gaz.* 2236 ; Gloucester Isinglass, &c. Co. v. Brooks, 19 *Fed. Rep'r*, 426.

The decision of the commissioner of patents is conclusive as to the law and facts arising under the application for a patent, unless it be impeached for fraud or connivance between him and the patentee, or unless his excess of authority be manifest on the face of the papers. *Allen v. Blunt*, 3 *Story*, 742 ; 8 *L. Rep'r*, 165. But compare *Allen v. Blunt*, 2 *Woodb. & M.* 121.

The questions of the regularity of the proceedings in petitioning for and obtaining a patent, and of the correctness of the judgment of the officer in awarding it, cannot be inquired into. *Wilder v. McCormick*, 2 *Blatchf.* 31.

The decision of the commissioner of patents that the drawings and model required by statute have been presented, that the attorney of the applicant was properly so constituted and had authority to amend or alter the specification, and that the specification was duly sworn to, cannot be reviewed collaterally ; but only in a proceeding to set aside the patent. *Hoe v. Cottrell*, 1 *Fed. Rep'r*, 597 ; 17 *Blatchf.* 546 ; 18 *Pat. Off. Gaz.* 59.

In a suit for infringement of a patent issued under the act of 1836, regular upon its face, and which recited that the patentee had made oath to his application therefor, it was *held*, that an objection to the validity of the patent, upon the ground that the records of the patent-office showed that the supplementary or amended application upon which the patent was granted was verified, not by the oath of the patentee, but by that of his attorney, could not be considered. *Hancock Inspirator Co. v. Jenks*, 21 *Fed. Rep'r*, 911 ; *De Florez v. Reynolds*, 14 *Blatchf.* 505.

### 213. *Disputing Plaintiff's Title to the Invention.*

As to the right of an alleged infringer to defend, on the ground that the patent was wrongfully issued to plaintiff, who is not the true inventor, or not the sole inventor, or that another person is jointly interested with him. *Pitts v. Wemple*, 1 *Biss.* 87 ; 2 *Fish. Pat. Cas.* 10 ; *Worden v. Fisher*, 11 *Fed. Rep'r*, 505 ; 21 *Pat. Off. Gaz.* 1957 ; *Barker v. Woodruff*, 1 *Pat. Off. Gaz.* 256 ; *Collar Co. v. Deussen*, 23 *Wall.* 530 ; *aff'g* 10 *Blatchf.* 109 ; *ante* 41, 280-286.

The relation between employer and employee may be such, and the suggestions of the latter in aid of developing a device or

machine, may involve so much independent invention, that the employee ought to be joined with the employer in the patent, and, consequently in an action for infringement. *Collar Co. v. Deusen, supra*; *Hoe v. Kahler*, 12 *Fed. Rep'r*, 111.

The employee in such cases is, however, at most only a joint inventor; he cannot sustain a patent in his own name alone. *Arnold v. Bishop*, 1 *MacArthur Pat. Cas.* 27; *Id.* 36. But where the inventor assigned the improvement to another person, on the agreement that the latter should take out a patent, and pay a royalty on manufactures under it, and a patent was obtained in the name of the assignee which the parties acted on as good, the invalidity of the patent as toward the public was *held* no defense to an action by the true inventor, against the assignee and patentee for agreed royalty. *Milligan v. Lalance, &c. Manuf. Co.*, 21 *Fed. Rep'r*, 570; 29 *Pat. Off. Gaz.* 367.

The right to a patent for a practical application of a known principle is in the person who first conceived that application; any subsequent patent issued for an improved application must rest upon and be limited to the improvement the second patentee has made. *Re Henry*, 1 *MacArthur Pat. Cas.* 467.

A new application for a patent, made by an attorney without authority, is invalid; and a subsequent ratification does not relate back. *Consolidated Fruit Jar Co. v. Bellair Stamping Co.*, 27 *Fed. Rep'r*, 377.

A party sued for infringement by one claiming sole interest who procures an assignment and release from infringement of claims, takes with notice and subject to equities. *Kearney v. Lehigh Valley R. Co.*, 27 *Fed. Rep'r*, 699.

214. *Defenses Allowable under General Issue and Notice, by Rev. Stat. § 4920 (Act of 1836, § 15).*

In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:

First. 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 ; or,

Second. That he 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 ; or,

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof ; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented ; or,

Fifth. That it 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.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used ; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement ; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. *Rev. Stat. § 4920.*

215. *First. Fraudulent Defect or Excess in Specification.*

A patent from the government cannot, in a collateral proceeding, be impeached for fraud in procuring it. The allegation, that



“the same was procured by fraud, misrepresentation, and in violation of law,” is simply an allegation of a conclusion of law from facts, which facts are not pleaded. *Gear v. Grosvenor*, 1 *Holmes*, 215 ; 3 *Pat. Off. Gaz.* 380 ; 6 *Fish. Pat. Cas.* 314.

The degree of evidence required to prove a fraudulent intent in a defective specification of a patent rests with the jury. Positive evidence is not necessary. The intention may be presumed from circumstances,—*e. g.*, when the parts concealed are so essential and so obviously necessary to be disclosed, that no mechanic skilled in the art could reasonably be expected to understand the subject so as, from the description given, to make the machine. But such a presumption would be weakened by the testimony of skillful persons that they could not hesitate in supplying the omissions. *Gray v. James*, *Pet. C. Ct.* 394.

#### 216. *Second. Patent Surreptitiously or Unjustly Obtained.*

A charge that the original patentee of an invention fraudulently and surreptitiously obtained a patent on what he well knew was invented by another, constitutes no defense to the charge of infringement, unless accompanied by the further allegation that the alleged first inventor was at the time using reasonable diligence in adapting and perfecting the invention. *Agawam Co. v. Jordan*, 7 *Wall.* 583. S. P., *Reed v. Cutter*, 1 *Story*, 590.

If a patent has been obtained by the plaintiff, upon the defendant's refusal to submit to an arbitration, according to the act of February 21, 1793, § 9 (1 Stat. 318), and the defendant subsequently obtains a patent for the same invention, this is not conclusive proof that the latter was obtained surreptitiously, or upon false suggestion. *Stearns v. Barrett*, 1 *Mas.* 153, 174.

In the race of diligence between two independent inventors, he who first reduces his invention to a fixed position and practical form would seem to be entitled to a priority of right to a patent therefor. But this right was qualified by the act of 1836, § 15,—which provided that in such cases the first inventor shall have the prior right, if he is using reasonable diligence in adopting and perfecting the same, although the second inventor has, in fact, first perfected the same and reduced the same to practice in a positive form. *Reed v. Cutter*, 1 *Story*, 590 ; *Reed v. Robinson*, 4 *L. Rep'r*, 342. S. P., *Washburn v. Gould*, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L.*

*Rep'r*, 276; *Bedford v. Hunt*, 1 *Mas.* 302; *Many v. Jagger*, 1 *Blatchf.* 372; *Parkhurst v. Kinsman*, *Id.* 488; 8 *N. Y. Leg. Obs.* 146; *Allen v. Hunter*, 6 *McLean*, 303.

That a person constructed and used his machine before another took out a patent for a similar machine is not a justification, if in fact the former was copied from the machine subsequently patented. *Hovey v. Stevens*, 1 *Woodb. & M.* 290.

In order to bring a case within the meaning of the clause of the act of July 4, 1836, § 15 (now Rev. Stat. § 4920, subd. 2),—which specifies, as a defense to an action for the infringement of a patent, that the “plaintiff 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,”—it is not necessary to implicate the good faith of the plaintiff or his assignees. The injustice relied on may be rather injustice in the abstract than injustice resulting from any intentional wrong. The term was used and intended to be used in its broadest sense. *Phelps v. Brown*, 4 *Blatchf.* 362; 1 *Fish. Pat. Cas.* 479; 18 *How.* 7.

Sections 12 and 15 of the act, taken together, were designed to protect the right of the first inventor, although he may not have been the first to adapt his invention to practical use, provided he has filed his caveat and has used reasonable diligence in perfecting his discovery. The purpose of the caveat is to save the discoverer from the effect of the rule of law which gives to the inventor who first adapts his invention to practical use the right to the grant of the patent. *Ib.* A. filed a caveat in the patent-office April 17, 1854. B. made application for a patent for the same invention November, 1854. No notice was given to A. of this application, but a patent was granted to B., January 9, 1855. A patent was subsequently granted to A. In a suit by the assignees of B. against the assignees of A., it was *held*, that the omission to give notice to A. might be set up as one of the defenses under section 15 of the act of July 4, 1836, as proof that B. “had surreptitiously or unjustly obtained the patent for that which was, in fact, discovered by another,” &c. A patentee should not be prejudiced for the error or oversight of the patent-office. *Ib.*

In an action for infringement of a patent, the minutes of a company of which the plaintiffs were members and at whose suggestion and expense the subject of the patent was claimed to have been invented, may be read in evidence to prove that the

plaintiffs were not the original inventors of the thing patented ; but not to show that the plaintiffs had surreptitiously obtained a patent for another's invention, unless notice of such defense and intention has been given to the plaintiffs. *Pennock v. Dialogue*, 4 *Wash.* 538.

The mere existence of a previous patent, or specification of an improvement, is not sufficient to establish the fact of fraud in obtaining a subsequent patent for a similar improvement ; actual knowledge of the former patent by the subsequent patentee must be proved. *Delano v. Scott*, *Gilp.* 489.

217. *Third. Prior Patent or Published Description.*

Prior printed publications relied upon to defeat a patent, are sufficient for the purpose, if they describe the process covered by the patent so fully and clearly, as to enable persons skilled in the art to which the invention relates, to carry on the process. *Downton v. Yeager Milling Co.*, 108 *U. S.* 466 ; aff'g 1 *Fed. Rep'r*, 199 ; 1 *McCrary*, 26 ; 17 *Pat. Off. Gaz.* 306 ; 9 *Rep'r*, 462 ; 5 *Bann. & A. Pat. Cas.* 112.

When properly pleaded and proven, the statutory defense "that the invention had been patented, or described in some printed publication, prior to the supposed invention" by the patentee, is sustained, if the conflicting patent, whether foreign or domestic, was duly issued or the complete description was published prior to the date of the patent in contest. *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673 ; 4 *Cliff.* 424. Whether the rival patent or the printed description must in all cases have appeared before the patentee's invention was made ; and whether a crude machine, made and used only as an experiment or specimen, may be introduced in proof that such invention existed, see *Ib.* ; *Elizabeth v. Pavement Co.*, *infra* ; *Gottfried v. Phillip Best Brewing Co.*, 17 *Pat. Off. Gaz.* 675 ; 5 *Bann. & A. Pat. Cas.* 4 ; *Bartholomew v. Sawyer*, 4 *Blatchf.* 347 ; 1 *Fish. Pat. Cas.* 516 ; 11 *Hunt Mer. Mag.* 575.

Upon a question of the validity of a patent, it is admissible to show that the invention had been described in publications prior to the issuing of the patent ; and such publication may be proved by the production of the book, or by parol testimony. *Allen v. Hunter*, 6 *McLean*, 303, 314.

Use or sale of an invention before it is perfected, necessarily

made as an aid to the inventor in ascertaining its usefulness and deficiencies and in perfecting it, is not such a use or sale as defeats the right to a patent. *Graham v. McCormick*, 11 *Fed. Rep'r*, 859 ; 10 *Biss.* 39 ; 21 *Pat. Off. Gaz.* 1533 ; 5 *Bann. & A. Pat. Cas.* 244.

Under the act of 1836, § 6, it was *held* that a prior construction and use of the thing patented, in one instance only, never made public, and which had been finally forgotten, or abandoned, so that, at the time of the invention by the patentee, the invention did not exist, would not render a patent invalid; for, by the phrase, "knowledge and use" referred to in the act, was meant knowledge and use existing in a manner accessible to the public. *Gayler v. Wilder*, 10 *How.* 477.

A foreign patent or publication describing an invention, unless published anterior to the making of the invention or discovery secured by letters-patent issued by the United States, is no defense to a suit upon them. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

The only exception to the rule, that in order to confer an exclusive right on the patentee, the thing patented must have been original with the inventor and not known to others, is where an individual obtains a patent believing the invention to be original, and it is made to appear that it had been known in a foreign country, but not patented there, nor described in any printed publication. *Parker v. Stiles*, 5 *McLean*, 44, 61 ; 7 *West. L. J.* 168.

The mere fact that an invention patented was known and used in a foreign country before its discovery by the patentee, is not sufficient (under the act of 1836) to avoid the patent, provided the patentee, at the time of making his application for a patent, believed himself to be the first inventor of the thing patented. *Bartholomew v. Sawyer*, 4 *Blatchf.* 347 ; 1 *Fish. Pat. Cas.* 516 ; 41 *Hunt Mer. Mag.* 575 ; *Boemer v. Simm*, 5 *Pat. Off. Gaz.* 555 ; *Doyle v. Spaulding*, 19 *Fed. Rep'r*, 744.

No description, in any printed publication, of the thing patented, can avoid the patent, unless such description was prior, in point of time, to the invention of the patentee ; that the description in the printed publication was prior to the application for the patent, is not enough. *Bartholomew v. Sawyer*, *supra*.

The fact that the use of the invention before the patentee originated it was unknown to him, will not prevent such use from avoiding the patent, if the use was in this country. *Boemer v. Simm*, *supra*.

If it is proved that the invention, or something substantially like it, has been described in a book, or has been the subject of a patent in a foreign country, this is a good defense to an action for infringement in this country. *Judson v. Cope*, 1 *Fish. Pat. Cas.* 615 ; 1 *Bond*, 327.

If the jury find that the patentee, when he made application for his patent, believed himself to be first inventor, his patent will not be invalidated by the existence of the thing abroad. *Forbush v. Cook*, 10 *L. Rep'r, N. S.* 664.

Previous use or knowledge of an invention abroad is no defense against a patent, unless such invention was described in some printed publication so clearly as to enable others to put it in practice. *Jones v. Sewall*, 3 *Cliff.* 563 ; 6 *Fish. Pat. Cas.* 343 ; 3 *Pat. Off. Gaz.* 630. *S. P., Cahill v. Brown*, 15 *Pat. Off. Gaz.* 697 ; 3 *Bann. & A. Pat. Cas.* 580 ; *Atlantic Giant Powder Co. v. Parker*, 16 *Pat. Off. Gaz.* 495 ; *Roberts v. Dickey*, 1 *Pat. Off. Gaz.* 4 ; 4 *Fish. Pat. Cas.* 532 ; 4 *Brews.* 260 ; 3 *Pittsb.* 352.

Foreign patents urged as anticipations of domestic patents, where the article is not properly proved to have been known or used in this country, or the patentee's circular to the trade was not a printed publication, or his provisional specification did not make the invention described in it patented, within the meaning of the act of 1836, §§ 7, 15, will not be considered. *Parsons v. Colgate*, 15 *Fed. Rep'r*, 600 ; 24 *Pat. Off. Gaz.* 203.

An English patent, taken out surreptitiously by any person, who, without the knowledge of the American inventor, and without authority from him, endeavored to appropriate the benefits of his invention, would not thereby deprive the real inventor of any of his rights. *Kendrick v. Emmons*, 9 *Pat. Off. Gaz.* 201 ; 2 *Bann. & A. Pat. Cas.* 208.

An invention is not patented in England within the meaning of *Rev. Stat.* § 4920, subd. 3, until the completed specification has been filed; unless it has been described in some printed publication within the meaning of *Rev. Stat.* § 4920, subd. 3. *Coburn v. Schroeder*, 11 *Fed. Rep'r*, 425 ; 20 *Blatchf.* 392 ; 22 *Pat. Off. Gaz.* 419.

In 1861, a certain description and drawings were published in England, from which the United States, in 1863, caused to be constructed and placed on a vessel, certain armor. One Heaton conceived, in 1856, the idea of armor, and experimented by firing pistols at small pieces of wood and iron. In 1861, he began to make

a model of a war vessel. In 1862, it was completed. It was *held*, that his invention was later than the publication in England. An idea, to be considered an invention, in the frequent sense of the word, must be embodied in some distinct form. *Webb v. Quintard*, 9 *Blatchf.* 352 ; 1 *Pat. Off. Gaz.* 525 ; 5 *Fish. Pat. Cas.* 276.

The patent law protects simplicity and economy of construction as against prior complex and expensive combinations ; and although the general and abstract effect may be analogous, if the two mechanisms produce their respective results by essentially different processes, the one being more simple and capable of being operated with greater economy than the other, it is not anticipated thereby. In order that a prior patent or publication should anticipate a patent, the description must appear to embody substantially the same organized mechanism, operating substantially in the same manner as that described in the patent claimed to have been anticipated. *Gottfried v. Phillip Best Brewing Co.*, 17 *Pat. Off. Gaz.* 675 ; 5 *Bann. & A. Pat. Cas.* 4.

Apparently a description is not in a "printed publication" in the sense of the statute, unless copies have been printed and disseminated to render the work somewhat generally accessible. *Coburn v. Schroeder*, 20 *Blatchf.* 392. See *Keene v. Wheatley*, 9 *Am. L. Reg.* 33 ; 5 *Pa. L. J.* 501. And so *held* of printed circulars, limited in distribution, and giving a meager description of the invention. *New Process Fermentation Co. v. Koch*, 21 *Fed. Rep'r*, 580 ; 29 *Pat. Off. Gaz.* 535.

Test proposed, for determining whether the inventions described in an American and a foreign patent are the same, see *Commercial Manuf. Co. v. Fairbanks Canning Co.*, 27 *Fed. Rep'r*, 78.

#### 218. *Fourth. Patentee not "First Inventor."*

By "the original and first inventor" is meant not necessarily he who first conceived the idea of the invention, but he who first gave to the idea a useful and practical form and matured for it a plan of material means by which it could have actual operation. *Foote v. Silsby*, 14 *How.* 218 ; aff'g 1 *Blatchf.* 445 ; *Teese v. Phelps*, *McAll.* 48 ; *Goodyear v. Day*, 2 *Wall. Jr.* 283.

In the sense of the term above indicated, "first inventor" means the person who first devises means to put the invention into practice ; he, and he only, is entitled to the patent. *Bedford v. Hunt*, 1 *Mas.* 302 ; *Union Sugar Refinery v. Matthiesen*, 3 *Cliff.* 639 ; 2

*Fish. Pat. Cas.* 600 ; Jones *v.* Sewall, 6 *Fish. Pat. Cas.* 343 ; 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; Ellithorp *v.* Robertson, 4 *Blatchf.* 307 ; 2 *Fish. Pat. Cas.* 83 ; Evans *v.* Weiss, 2 *Wash.* 342 ; 3 *Am. L. J.* 180 ; Parker *v.* Hulme, 1 *Fish. Pat. Cas.* 44 ; 7 *West. L. J.* 417 ; Reeves *v.* Keystone Bridge Co., 1 *Pat. Off. Gaz.* 466 ; 5 *Fish. Pat. Cas.* 456 ; 5 *Am. L. T. U. S. Cts.* 150 ; 9 *Phila.* 368 ; Miller *v.* Force, 9 *Fed. Rep'r*, 603 ; 21 *Pat. Off. Gaz.* 947 ; Allen *v.* Hunter, 6 *McLean*, 303, 321 ; Teese *v.* Phelps, *McAll.* 48 ; Brodie *v.* Ophir Silver Mining Co., 4 *Fish. Pat. Cas.* 137 ; 5 *Sawyer*, 608 ; Nichols *v.* Harris, 1 *MacArthur Pat. Cas.* 362.

In determining questions of priority of invention, it is not so much he who made and perfected the first machine or instrument who is to be considered the first inventor, as he who first conceived the idea and so described it by words or drawings as to have been sufficient to enable a skillful workman to bring it into useful practical operation. Such a person will be protected against the claim of any subsequent inventor who may have been first in adapting a machine or instrument to the invention, provided such first discoverer has been using due diligence in effecting the same end, so that, although he may have been unsuccessful in some of his experiments, by following them up he at length succeeds. Davidson *v.* Lewis, 1 *MacArthur Pat. Cas.* 599.

An inventor who reduces to practice his invention with reasonable diligence, has priority over one who subsequently conceives, though actually reducing to practice first, the device. Marshall *v.* Mee, 1 *MacArthur Pat. Cas.* 229 ; Heath *v.* Hildreth, *Id.* 12 ; Perry *v.* Cornell, *Id.* 60 ; McCormick *v.* Howard, *Id.* 238 ; Chandler *v.* Ladd, *Id.* 493.

He who invents first has the prior right, if he uses reasonable diligence in adapting and perfecting his invention, although a second inventor in fact perfects it and reduces it to practice in positive form before him. Electric R. R. Signal Co. *v.* Hall R. R. Signal Co., 6 *Fed. Rep'r*, 603. S. P., Reeves *v.* Keystone Bridge Co., 1 *Pat. Off. Gaz.* 466 ; 5 *Fish. Pat. Cas.* 456 ; 5 *Am. L. T. U. S. Cts.* 150 ; 9 *Phila.* 368 ; 2 *Bann. & A. Pat. Cas.* 256.

Even before a patent has been granted, the property in an invention belongs, generally, to him who is the first inventor ; 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 so invented by another, acts at his peril and with the full knowledge of the law that a subsequent

patent may put him out of the use of the machine thus created (*Evans v. Weiss*, 2 *Wash.* 342 ; *Evans v. Jordan*, 1 *Brook. Marsh.* 248 ; *aff'd*, 9 *Cranch*, 199) ; *a fortiori*, where the party constructing knew that the inventor had obtained a patent which was afterward declared invalid, but under a subsequent act of Congress a valid patent was secured. *Evans v. Weiss, supra.*

Where plaintiff's patented machine is anticipated by a machine containing parts different in form but performing the same functions as the like parts in complainant's machine, the scope of his patent will be limited to the improvements in form made in his patented machine. *Williams v. Barker*, 2 *Fed. Rep'r*, 649 ; 18 *Pat. Off. Gaz.* 243 ; 5 *Bann. & A. Pat. Cas.* 453.

The first inventor is entitled exclusively to a patent right, though a subsequent person may have also been an original inventor. The law gives the right, as among inventors, to him who is first in point of time. *Lowell v. Lewis*, 1 *Mas.* 182 ; *Reed v. Cutter*, 1 *Story*, 590 ; *Reed v. Robinson*, 4 *L. Rep'r*, 342 ; *Allen v. Blunt*, 2 *Woodb. & M.* 121.

A complete invention is not anticipated by a partial embodiment of the idea which was lacking in just those features necessary to its success (*Richardson v. Noyes*, 10 *Pat. Off. Gaz.* 507 ; 2 *Bann. & A. Pat. Cas.* 398) ; nor will crude and imperfect experiments, equivocal in their results, and therefore abandoned and given up, be permitted to prevail against an original inventor who has perfected his improvement and obtained his patent. *Union Sugar Refinery v. Mathieson*, 3 *Cliff.* 639 ; 2 *Fish. Pat. Cas.* 600 ; *Roberts v. Dickey*, 1 *Pat. Off. Gaz.* 4 ; 4 *Fish. Pat. Cas.* 532 ; 4 *Brews.* 260 ; 3 *Pittsb.* 352 ; *Roberts v. Schreiber*, 2 *Fed. Rep'r*, 855 ; 18 *Pat. Off. Gaz.* 125 ; 5 *Bann. & A. Pat. Cas.* 491 ; *Whittlesey v. Ames*, 9 *Biss.* 225 ; 18 *Pat. Off. Gaz.* 357 ; 5 *Bann. & A. Pat. Cas.* 96 ; *Fay v. Allen*, 24 *Fed. Rep'r*, 804 ; *Yale Lock Manuf. Co. v. Berkshire National Bank*, 26 *Id.* 104.

Although a person has engaged in producing some new and useful instrument or contrivance, and has embodied it in a machine and endeavored to reduce it to practice by experiment, yet if those trials fail, if he fail in success and abandon the effort, the consideration affords no impediment to another person who has taken up the same idea, or class of ideas, and who has gone on perseveringly in his studies, trials and experiments, until he has perfected the new idea and brought it into practical and useful operation. The latter is the person, the meritorious inventor, who is entitled to the



protection of the law. *Winans v. New York & Harlem R. R.*, 31 *Jour. Tr. Inst.* 3rd S. 322.

Although a party had conceived of the invention before the patentee, and made some progress toward completing a model, yet, if he suspended his labors, and before he resumed them, the patentee perfected the invention, and embodied it in a practical working machine, the patent will be sustained. *Smith v. O'Connor*, 4 *Pat. Off. Gaz.* 633 ; 6 *Fish. Pat. Cas.* 469.

Where the anticipatory device of defendant was discontinued, but not until its practicability had been demonstrated, it was held, sufficient to defeat the plaintiff's patent. *McNish v. Everson*, 5 *Bann. & A. Pat. Cas.* 484 ; 2 *Fed. Rep'r*, 899 ; 17 *Pat. Off. Gaz.* 1506.

The chance operation of a principle unrecognized at the time, without the knowledge of its method of employment, will not defeat the claim of one who first puts it into practical use, and makes it available. *Andrews v. Carman*, 13 *Blatchf.* 307 ; 9 *Pat. Off. Gaz.* 101 ; 2 *Bann. & A. Pat. Cas.* 277.

Mere speculations, not practically used, do not deprive a subsequent inventor who puts his invention into practice, of the proper reward. *Rich v. Lippincott*, 1 *Pittsb.* 31 ; 2 *Fish. Pat. Cas.* 1.

To constitute such a prior invention as will avoid a patent, there must be proof that some one, before the patentee, not only conceived the idea of doing what the patentee has done, but also reduced his idea to practice, and embodied it in some practical and useful form. The making of drawings of conceived ideas is not such an embodiment of such conceived ideas in a practical and useful form, as will defeat a patent which has been granted. *Ellithorp v. Robertson*, 4 *Blatchf.* 307 ; 2 *Fish. Pat. Cas.* 83 ; *Reeves v. Keystone Bridge Co.*, 1 *Pat. Off. Gaz.* 466 ; 5 *Fish. Pat. Cas.* 466 ; 5 *Am. L. T. U. S. Cts.* 150 ; *Detroit Lubricator Manuf. Co. v. Renchard*, 9 *Fed. Rep'r*, 293.

Although drawings by an inventor before application for a patent by him, may carry back the date of the invention, if reasonable diligence is shown, merely making drawings is not such an embodiment of an invention as will defeat a patent subsequently granted. *Odell v. Stout*, 22 *Fed. Rep'r*, 159 ; 29 *Pat. Off. Gaz.* 862.

Where the invention described and claimed is of a machine of specified construction, it is anticipated by a prior machine of substantially the same construction although a new, and perhaps

patentable use of the machine is suggested in the specification of the patent. *Boston Elastic Fabrics Co. v. East Hampton Rubber Thread Co.*, 1 *Holmes*, 372 ; 9 *Pat. Off. Gaz.* 745 ; 1 *Bann. & A. Pat. Cas.* 222.

It is no objection to a patent for a combination of machinery that any part of the structure existed before, unless the combination has existed before. *Re Halsey*, 1 *MacArthur Pat. Cas.* 459.

A patentee cannot embrace in a subsequent patent any invention embraced in a prior one granted to himself. *Hill v. Commissioner of Patents*, 1 *Cent. Rep'r*, 91.

Contract by employee of inventor of undisclosed process of manufacture, not to divulge the secret, is limited to term of employment. *Salomon v. Hertz*, 2 *Cent. Rep'r*, 132.

### 219. *Anticipation of an Invention by one earlier. Priority between Competitors.*

The first inventor is entitled to the benefits of his invention if he reduce it to practice and obtain a patent therefor, and a subsequent inventor cannot, by obtaining a patent, oust the first inventor of his right, or maintain an action against him. *Woodcock v. Parker*, 1 *Gall.* 438.

As between rival inventors he is entitled to a patent whose inceptive invention was the earliest, who was diligent in perfecting and adapting it, and in applying for a patent. *Kneeland v. Sheriff*, 5 *Bann. & A. Pat. Cas.* 482 ; 2 *Fed. Rep'r*, 901 ; 10 *Rep'r*, 234 ; 18 *Pat. Off. Gaz.* 242.

If two machines be substantially the same, and operate in the same manner, to produce the same result, though they may differ in form, proportions, and utility, they are the same in principle ; and the one last discovered has no other merit than that of being an improved imitation of the one before discovered and in use, for which no valid patent can be granted to any one ; because he cannot be considered as the original inventor of the machine. And it makes no difference as to the patentee's rights, whether the prior machine or invention has fallen into disuse or not ; if it was used before his discovery he cannot obtain a patent for it. *Evans v. Eaton*, 3 *Wash.* 443 ; aff'd, 7 *Wheat.* 356.

A patent relates back to the date of the application ; and

patents granted to other inventors during the pendency of such application, so far as they cover the same invention, are void, and no protection to an infringer. *Johnson v. Fassman*, 1 *Woods*, 138 ; 5 *Fish. Pat. Cas.* 471.

Where a dispute arises as to priority of invention, a patentee is allowed to show the real date of it, and to have his rights as fully secured as if he had taken out his patent. *Parker v. Hulme*, 1 *Fish. Pat. Cas.* 44 ; 7 *West. L. J.* 417. And see *MacDonald v. Blackmer*, 4 *Bann. & A. Pat. Cas.* 78

An article which could be made only as a mere curiosity, and not as an article for the trade, will not defeat a subsequent invention of a machine to make it. *Lamb v. Hamblen*, 11 *Fed. Rep'r*, 722.

In order to determine whether the mechanism of two machines is the same, an examination should be made not only of the mechanism itself, that is, the devices and their arrangements, but also of their mode of operation and their effects and results. *Eames v. Cook*, 2 *Fish. Pat. Cas.* 146.

Whether the one device is the same in substance or principle as another, depends on whether it is the same kind of instrument or not, and whether it acts in the same way in substance, and produces the same result in substance. *Colt v. Mass. Arms Co.*, 1 *Fish. Pat. Cas.* 108, 118 ; *Platt v. Manuf. Co.*, 5 *Fish. Pat. Cas.* 265 ; 9 *Blatchf.* 342 ; 1 *Pat. Off. Gaz.* 524 ; *Rumford Works v. Lauer*, 5 *Fish. Pat. Cas.* 615 ; 10 *Blatchf.* 122 ; 3 *Pat. Off. Gaz.* 249 ; *Singer v. Braunsdorf*, 7 *Blatchf.* 521 ; *Wilcox v. Komp*, 7 *Blatchf.* 126.

Where the real inventor obtains the later patent he may have the prior patent canceled. *Sturges v. Van Hagan*, 6 *Fish. Pat. Cas.* 572.

Making a device which will serve the same useful purpose as one afterward perfected, is not necessarily anticipating the latter. Where the mechanical means of two machines employed are different, and the mechanical result is different, one does not anticipate the other. *Buerk v. Valentine*, 5 *Fish. Pat. Cas.* 366 ; 9 *Blatchf.* 479 ; 2 *Pat. Off. Gaz.* 295.

Where two devices are similar in construction, but there is a difference in the elements of which they are necessarily composed, and in the use to which they are to be applied, there is a patentable difference. *Thayer v. Spaulding*, 27 *Fed. Rep'r*, 66.

If the inventor produced a new article he is entitled to a patent, although others approached very near to the invention without

producing it exactly. *M. & P. Manuf. Co. v. Du Bruil*, 2 *Bann. & A. Pat. Cas.* 618.

Where the claim of a patent is a combination claim, consisting of several elements that co-operate together to produce the device claimed, such device can only be anticipated by a prior device, having identically the same elements, or the mechanical equivalents, of those that are not used. It will not do to find a portion of these elements in one machine, and a portion in a second, and a third, and so on, and then say that the device is anticipated. *Worswick Manuf. Co. v. Steiger*, 17 *Fed. Rep'r*, 250.

### 220. *Examples of Anticipation and Priority.*

A patent for an improvement in tools for attaching sheet metal mouldings was *held* to be invalid, the invention having been anticipated by a machine for putting moldings on combs, although the latter was comparatively small, and was used only for combs; nothing appearing in the patented invention more than an adaptation of that machine not requiring the exercise of the inventive faculty. *Peters v. Active Manuf. Co.*, 21 *Fed. Rep'r*, 319; 28 *Pat. Off. Gaz.* 1102.

Improvements, by Bell, in telegraphy and electric telephony, covering the electric speaking-telephone, were *held* patentable to him, notwithstanding a claim that they had been anticipated by Drawbaugh; it appearing that the latter had made no effort to secure a patent for his invention for ten years after the time he claimed to have completed and demonstrated it. *American Bell Telephone Co. v. People's Telephone Co.*, 22 *Blatchf.* 531; 22 *Fed. Rep'r*, 309; 29 *Pat. Off. Gaz.* 1029.

In an action for damages for infringement of a patent for an improvement in perches for dump-cars, it was shown that dump-cars embodying the same invention were constructed some years before the patent, and that forty such cars were ordered built for a foreign railroad company, and were shipped to that company, presumably for use. Upon this showing, the court *held* the defense of want of novelty established. *Stitt v. Eastern R. Co.*, 22 *Fed. Rep'r*, 649.

In an action between patentees under different patents, in which the senior patentee alleged an infringement of his patent by the junior patentee, an adjudication that the senior patentee was not

the first inventor of the thing patented to him, was *held*, not to enlarge or affect the estate of the junior patentee ; where the thing patented to junior was not the same as that claimed by the senior ; although the junior could not make the article the subject of his invention without using the invention patented by the senior patentee ; and it was further *held* that such adjudication was not a bar to a subsequent suit by the senior patentee against a licensee of the junior, whose license was taken after the commencement of the first suit, and with notice thereof. *Brush v. Naugatuck R. Co.*, 24 *Fed. Rep'r*, 371 ; 32 *Pat. Off. Gaz.* 894.

221. *Fifth. Public Use or Sale before Application.*

The cases collected under this topic were decided, a part of them, under the act of 1836, § 15 (usually read in connection with the act of 1839, § 7, the others under the act of 1870, § 61, *Rev. Stat.* § 4920, subd. 5).

The language of the two acts is different, but the supreme court, per SAWYNE, J., in *Consolidated Fruit Jar Co. v. Wright*, 94 *U. S.* 92, 94, seems to have treated the difference as unimportant ; the cases are therefore gathered without special discrimination.

Upon the general rule, under the successive statutes, that the fact that an inventor permits public use or sale of his invention (by the existing law) "for more than two years before his application for a patent" renders any patent he may obtain, void,—see *McClurg v. Kingsland*, 1 *How.* 202 ; *Egbert v. Lippman*, 104 *U. S.* 333 ; *Consolidated Fruit Jar Co. v. Wright*, 94 *U. S.* 92 ; *Worley v. Tobacco Co.*, 104 *U. S.* 340 ; *Manning v. Cape Ann Isinglass, &c. Co.*, 108 *U. S.* 462 ; *aff'g 9 Rep'r*, 337 ; 4 *Bann. & A. Pat. Cas.* 612.

If an invention has, through the acts of the inventor, gone into public use beyond his control, his right to a patent is forfeited. *Jones v. Sewall*, 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; 6 *Fish. Pat. Cas.* 343. To same effect, *Plimpton v. Winslow*, 14 *Fed. Rep'r*, 919 ; 23 *Pat. Off. Gaz.* 1731 ; *Rich v. Lippincott*, 1 *Pittsb.* 31.

If an inventor allows his machine to be used by other persons generally, or if it is, with his consent, put on sale for such use, then it will be in public use and on public sale, within the meaning of the law. *Elizabeth v. Paving Co.*, 97 *U. S.* 126.

The public use of an invention, by its inventor, for more than two years prior to his application for a patent, deprives him of his

right and invalidates a patent obtained after such use. *Russell Manuf. Co. v. Mallory*, 10 *Blatchf.* 140; *Guidet v. Palmer*, *Id.* 217; *McMillan v. Barclay*, 5 *Fish. Pat. Cas.* 189; 4 *Breics.* 275; 3 *Pittsb.* 377.

The effect of allowing public use of an invention cannot be avoided by afterward assigning an interest in the invention to the persons who were allowed to use it. *Worley v. Tobacco Co.*, 104 *U. S.* 340.

The fact that an invention was in public use and on sale, with the consent and allowance of the inventor, more than two years before his application for a patent; renders the patent invalid, however great the hindrances to the application, and whether caused by the want of pecuniary means or other misfortune. *Sisson v. Gilbert*, 9 *Blatchf.* 185; 5 *Fish. Pat. Cas.* 109.

Mere delay in applying for a patent after invention made, works no forfeiture of right. But if other persons practice the invention in this country, whether with or without the knowledge or consent of the patentee, more than two years prior to the filing of his application, the patent is invalid. *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673; 4 *Cliff.* 424.

The effect of the act of March 3, 1839, § 7, is to require that an inventor shall not permit his invention to be used in public at a period earlier than two years prior to his application for a patent, under the penalty of having his patent rendered void by such use. Consent and allowance by the inventor are not necessary to such invalidity. But *a fortiori*, consent to a use in public, not followed by an application for a patent within two years afterward, makes the patent, when granted, invalid. *Egbert v. Tappan*, 15 *Blatchf.* 295; 14 *Pat. Off. Gaz.* 822; *aff'd*, 104 *U. S.* 333.

As to when the two years' limitation for filing the application for a patent on an invention in public use begins to run,—see *Graham v. McCormick*, 5 *Bann. & A. Pat. Cas.* 244; 11 *Fed. Rep'r.* 859; 10 *Biss.* 39; 21 *Pat. Off. Gaz.* 1533.

## 222. *What Constitutes a Public Use.*

Use of an invention made by the inventor in good faith, for the purpose of testing its operation, ascertaining defects and maturing improvements, is not a public use which debars from obtaining a patent. The fact that he does not find need to make improvements; that the use is long continued; that it is on premises

not owned by the inventor ; that it is open to public inspection, and the public incidentally derive benefit from it, makes no difference. So long as he does not voluntarily allow others to make it and use it, and so long as it is not on sale for general use, he keeps the invention under his own control, and does not lose his title to a patent. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, even though the use and knowledge of the use may be confined to one person. *Egbert v. Lippman*, 104 *U. S.* 333.

Where an inventor allows the unrestricted use of his invention by another without injunction of secrecy or other condition, for more than two years prior to his application for a patent, although such use may be secret, this will constitute a public use and render the patent subsequently issued void. *Manning v. Cape Ann Isinglass, &c. Co.*, 108 *U. S.* 462 ; aff'g 9 *Rep'r*, 337 ; 4 *Bann. & A. Pat. Cas.* 612 ; *Burton v. Greenville*, 3 *Fed. Rep'r*, 642 ; 5 *Bann. & A. Pat. Cas.* 541 ; 18 *Pat. Off. Gaz.* 411.

Public use, in the sense of the patent law, is proved by a single unrestricted use by any person not the inventor, or by the inventor in an open way, provided the use is not experimental. *Jones v. Barker*, 11 *Fed. Rep'r*, 597 ; 22 *Pat. Off. Gaz.* 771. *S. P.*, *Clark Pomace Holder Co. v. Ferguson*, 17 *Fed. Rep'r*, 79 ; 24 *Pat. Off. Gaz.* 1090.

The use of an invention in a factory where any person may see it, is a public use ; and after two years of such use the invention becomes a public right. *Manning v. Cape Ann Isinglass, &c. Co.*, 108 *U. S.* 462 ; aff'g 9 *Rep'r*, 337 ; 4 *Bann. & A. Pat. Cas.* 612 ; see *Adams v. Edwards*, 1 *Fish. Pat. Cas.* 1.

The phrase means a use in a public manner, not use by the public generally. *Hunt v. Howe*, 1 *MacArthur Pat. Cas.* 366 ; *Henry v. Providence Tool Co.*, 14 *Pat. Off. Gaz.* 855 ; 3 *Bann. & A. Pat. Cas.* 501. But compare to the contrary, *American Hide, &c. Dressing Machine Co. v. American Tool Co.*, 1 *Holmes*, 503 ; 4 *Fish. Pat. Cas.* 284 ; and *Egbert v. Lippman*, 104 *U. S.* 333, 336.

The decisions are not agreed whether consent of the inventor to the public use, or sale, is necessary to render it operative in avoidance of the patent ; though the language of the opinion of Justice Wood, in *Manning v. Cape Ann Isinglass & Glue Co.*, 108 *U. S.* 462, implies that its necessity is not recognized. To like effect, see

*Egbert v. Lippman*, 15 *Blatchf.* 295, aff'd on other points, 104 *U. S.* 333 ; *Andrews v. Hovey*, 16 *Fed. Rep'r*, 387, 403 ; *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673 ; and to the effect that unless the inventor consents to the prior use he does not lose his right, *Davis v. Fredericks*, 19 *Fed. Rep'r*, 99 ; *Emery v. Cavanagh*, 17 *Fed. Rep'r*, 242 ; *Campbell v. Mayor*, 9 *Fed. Rep'r*, 500 ; *Elizabeth v. Paving Co.*, 97 *U. S.* 126, 136.

Under the act of 1793, §§ 3, 6, and the act of 1836, §§ 6, 15, the public use or sale of an invention, in order to deprive the inventor of his right to a patent, must be a public use or sale by others with his knowledge and consent, before his application for a patent. If the use or sale is without such knowledge or consent, or if the use be merely experimental, to ascertain its value or utility, or the success of the invention by putting it into practice, that is not such a use as will deprive the inventor of his title. *Ryan v. Goodwin* 3 *Summ.* 514 ; 3 *L. Rep'r*, 220 ; *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54 ; *Pierson v. Eagle Screw Co.*, 3 *Story*, 402 ; *Jones v. Sewall*, 3 *Cliff.* 563 ; *Winans v. New York & Harlem R. R.*, 31 *Jour. Fr. Inst.* 3rd S. 32 ; *Campbell v. New York*, 9 *Fed. Rep'r*, 500 ; 20 *Blatchf.* 67 ; 20 *Pat. Off. Gaz.* 1817.

### 223. *Limits and Exceptions to the Rule Restricting Public Use.*

The use of an invention by the inventor himself, for the purposes of experiment, though continued for more than two years, will not deprive him of his right to a patent (*Jones v. Sewall*, 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 650 ; 6 *Fish. Pat. Cas.* 343 ; *Sisson v. Gilbert*, 9 *Blatchf.* 135 ; 5 *Fish. Pat. Cas.* 109 ; *Morris v. Huntington*, 1 *Paine*, 348 ; *McMillin v. Barclay*, 4 *Brews.* 275 ; 3 *Pittsb.* 377 ; 5 *Fish. Pat. Cas.* 189 ; *Birdsell v. McDonald*, 6 *Pat. Off. Gaz.* 682), especially where it has resulted in a change in the construction of the machine. *Andrews v. Carman*, 13 *Blatchf.* 307.

Public use of an invention, unless by the patentee himself, for profit, or by his consent or allowance, will not work a forfeiture of his title, as forfeiture is not favored, unless it clearly appears that the use was solely for profit, and not with a view of further improvements or of ascertaining its defects, or for any other purpose of experiment in reducing the invention to practice. *Emery v. Cavanagh*, 17 *Fed. Rep'r*, 242 ; 16 *Rep'r*, 100.

Under the laws of 1793 and 1839, § 7, it was *held*, that the



public use, to avoid a patent, must not be a private or surreptitious use in fraud of the patentee, but a public use by his consent, by a sale by himself, or by others with his acquiescence, by which he abandoned his right, or disabled himself from complying with the law; a patentee might take a reasonable time to try experiments with his invention, or might exhibit and explain it to persons whom he desired to consult; only such prior use as implied an abandonment involved a forfeiture of the right. *Sanders v. Logan*, 2 *Pittsb.* 241; *Whitney v. Emmett*, *Baldw.* 303.

Proof of use of the thing patented between the dates of the original and the reissued patents, will not defeat an action for infringement of the reissued patent. *Battin v. Taggart*, 17 *How.* 74, 84.

To constitute a prior use in public, which impairs a patent, the use must have been of the very improvement patented. Where it was of a less perfect article (not merely a colorable variation), no dedication results, although such article may embody features in common with what was patented thereafter. *Draper v. Wattles*, 16 *Pat. Off. Gaz.* 629; 3 *Bann. & A. Pat. Cas.* 618.

#### 224. *Effect of Placing Invention on Sale.*

A single conditional sale of an invention, more than two years before an application, works a forfeiture of the patent. *Henry v. Francetown Soapstone Co.*, 2 *Fed. Rep'r*, 78; 17 *Pat. Off. Gaz.* 569; 9 *Rep'r*, 706; 5 *Bann. & A. Pat. Cas.* 108.

A patent is void, if, more than two years before the application therefor was filed, the patentee sold the patented articles for the double purpose of realizing the proceeds and of seeing if they would sell, and others had them in actual use. *Consolidated Fruit Jar Co. v. Wright*, 6 *Pat. Off. Gaz.* 327; 12 *Blatchf.* 149.

If necessary, in making tests, an inventor may sell a machine on trial so as to get it fully and fairly tested in practical use, by the class of persons for whose use it is intended; and such sale or use, even for more than two years, if made for the purpose of practical test, will not be a sufficient sale or public use to invalidate the patent. *Graham v. Geneva Lake Crawford Manuf. Co.*, 11 *Fed. Rep'r*, 138; 21 *Pat. Off. Gaz.* 1536.

The claim to an invention is not invalidated by a stipulation for its sale, made before it was completed. *Sparkman v. Higgins*, 1 *Blatchf.* 205.

The law permits an inventor to place a machine he is developing in friendly hands for the purpose of testing it, and if the machine is strictly an experiment, made solely with a view to perfect the device, the exclusive right of the inventor remains unimpaired. But when he puts his incomplete device upon the market, and sells it as a manufacturer more than two years before he applies for his patent, he gives to the public the device in the stage of development in which he sells it, and the patent cannot relate back to cover the forms it then had. *Lyman v. Maypole*, 19 *Fed. Rep'r*, 735.

225. *Decisions Illustrating the Doctrine as to Public Use or Sale.*

Laying a new kind of wooden pavement in a public city street, where it was in public view and was traveled upon for several years, done after filing a caveat for the invention and for purposes of experiment and improvement, was *held* not such public use as would avoid a patent. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

A machine used for a number of years in the ordinary course of business, was *held* not an experimental machine; and, that such use was "public" although the shop where the machine was operated was kept locked, and no one but the workmen were allowed to examine it. *Perkins v. Nashua Card, &c. Co.*, 2 *Fed. Rep'r*, 451; 17 *Pat. Off. Gaz.* 1852; 10 *Rep'r*, 7; 5 *Bann. & A. Pat. Cas.* 395.

In the case of an improvement in the construction of cars for railroads, it was *held*, that as experiments to test the value of the invention could not be made except by putting the car into the service of lines of railroads, the use of cars, for such purpose, did not render the patent void. *Winans v. Schenectady & Troy R. R. Co.*, 2 *Blatchf.* 279. To the contrary, in a case of a prolonged use of an improvement upon steamboats. *McMillin v. Barclay*, 4 *Brews.* 275; 3 *Pittsb.* 377.

Nearly eight years before applying for a patent, the inventor voluntarily, and without reserve, sold a device embodying the invention, to a third party; knowing that it would be (and it was) publicly used. Such public use was *held* to have invalidated the patent. *Schneider v. Thill*, 5 *Bann. & A. Pat. Cas.* 565.

The public use of an invention was *held* not experimental, where the inventor himself manufactured and sold machines containing the invention, and allowed such machines to be used for

several years before applying for his patent. *Sisson v. Gilbert*, 9 *Blatchf.* 185 ; 5 *Fish. Pat. Cas.* 109.

A public use of an invention (an improvement in steam fire-engine pumps), which was in its nature intended for public use, was *held*, under the circumstances, experimental merely, and not to render subsequent patent invalid. *Campbell v. New York*, 9 *Fed. Rep'r.*, 500 ; 20 *Blatchf.* 67 ; 20 *Pat. Off. Gaz.* 1817.

Where a machine, for which a patent was afterwards claimed, was freely put into numerous mills which the inventors were employed to construct, throughout a period exceeding two years the facts were *held* to show a clear case of abandonment ; as such use of the invention could not be called experimental. *Sanders v. Logan*, 2 *Fish. Pat. Cas.* 167 ; 9 *Am. L. Reg.* 475 ; 2 *Pittsb.* 241.

The use of an invention for a fare register and recorder upon street railway cars, in the only manner in which it could be conveniently used, for the purpose of actual experiment to ascertain the best mode of construction, was *held* not such a public use as would invalidate a patent for the invention applied for more than two years afterwards. *Railway Register Manuf. Co. v. Broadway & Seventh Ave. R. Co.*, 22 *Fed. Rep'r.*, 655 ; 30 *Pat. Off. Gaz.* 180. But see decision granting rehearing, 32 *Pat. Off. Gaz.* 257 ; and in action on rehearing, 34 *Pat. Off. Gaz.* 921.

In an action for infringement of a patent for corset steels, it appeared that more than two years before applying for a patent the inventor made a pair of steels, and afterwards another pair for a lady to whom he was engaged, and who wore them until they were worn out ; also that he made a third pair for another lady. It was *held* that this was a use of the invention which was equivalent to an abandonment. It was not a use for experiment, or a use in private ; but a practical use of the completed article. No secrecy was maintained or enjoined. It was a disposal of the article for the general use of the recipient. *Egbert v. Lippman*, 15 *Blatchf.* 295 ; 14 *Pat. Off. Gaz.* 822 ; *aff'd*, 104 *U. S.* 333.

## 226. *The Invention had been Abandoned to the Public.*

The question of abandonment does not turn upon the intention of the inventor ; whatever may be his intention, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent ; nor will a patent, obtained under such circumstances, protect

his right. And it makes no difference by what means an invention may be communicated to the public before a patent is obtained; any acquiescence in public use, by the inventor, will be an abandonment as towards the public. *Shaw v. Cooper*, 7 *Pet.* 292, 320.

Acts of an inventor claimed to be a dedication, are to be construed liberally; that is, he is not estopped by licensing a few persons to use his invention, in order to ascertain its utility, or by any such acts of peculiar indulgence and use, as may fairly consist with the clear intention to hold the exclusive privilege. *Mellus v. Silsbee*, 4 *Mass.* 108.

The inventor alone is competent to abandon his invention, and no use by the public, except with his knowledge and consent, can be deemed an abandonment of his patent. *Pierson v. Eagle Screw Co.*, 3 *Story*, 402.

Acquiescence by the patentee in the use by the defendant of an original defective patent, does not authorize the use of the invention after the issuing of a reissued patent. *McWilliams Manuf. Co. v. Blundell*, 22 *Pat. Off. Gaz.* 177; 11 *Fed. Rep'r*, 419.

Neither a stipulation for the sale of an invention before it is completed, nor a sale of such invention during the application for the patent, is an abandonment, or such a use as gives it to the public. *Sparkman v. Higgins*, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122; 6 *Pa. L. J.* 313.

Abandonment or dedication of an invention is in the nature of a forfeiture of a right. The law does not favor it, and it should be made out beyond all reasonable doubt. *Pitts v. Hall*, 2 *Blatchf.* 229. And, see *Seymour v. McCormick*, 16 *How.* 480; rev'g 2 *Blatchf.* 240; *McMillin v. Barclay*, 4 *Brews.* 275; 3 *Pittsb.* 377; *Hovey v. Henry*, 3 *West. L. J.* 153.

An invention may be abandoned to the public within two years prior to the procurement of a patent. The mere use or sale of the invention, however, within the two years, will not alone or of itself work an abandonment. The use or sale must be accompanied by some declaration or acts going to establish an intention on the part of the inventor to give to the public the benefit of the improvement. *Pitts v. Hall*, 2 *Blatchf.* 229.

But declarations of an intention to dedicate an invention to the public will not be regarded as equivalent to an actual dedication. Besides words, there must be acts, in order to fasten on a patentee the intention, which, in judgment of law, will work an abandonment of his invention. *Ib.*

Adverse knowledge and use of the device claimed, prior to the patentees' invention thereof, on a machine which was never completed, the device itself not being patented or otherwise given or made accessible to the public until long after the issue of complainant's patent, will not invalidate the exclusive right of the patentees. *Bullock Printing Press Co. v. Jones*, 13 *Pat. Off. Gaz.* 124 ; 3 *Bann. & A. Pat. Cas.* 195.

The omission by an inventor to claim a combination or device apparent upon the face of his patent, amounts to a dedication of the neglected contrivance to the uses of the public. *Swift v. Jenks*, 19 *Fed. Rep'r*, 641. To same effect, *Hawes v. Gage*, 5 *Pat. Off. Gaz.* 494 ; *Re Conklin*, 1 *MacArthur*, 375.

Where a device has been used by a prior inventor, but discontinued, a subsequent inventor cannot take it up and appropriate it exclusively. The invention thus becomes public property. *Shoup v. Henrici*, 22 *Int. Rev. Rec.* 114 ; 11 *Phila.* 514 ; 2 *Bann. & A. Pat. Cas.* 249.

An abandonment of a mechanical structure, the operative merit of which has been demonstrated by trial, will inure to the public, and an injunction cannot be obtained by a subsequent (even though original), inventor of substantially the same machine, who has obtained a patent therefor. *Pickering v. McCullough*, 6 *Rep'r*, 101.

The abandonment of a practical device by its inventor furnishes no warrant for a subsequent patentee to claim it as inventor. *McNish v. Everson*, 2 *Fed. Rep'r*, 899 ; 17 *Pat. Off. Gaz.* 1506 ; 5 *Bann. & A. Pat. Cas.* 484.

An abandoned experiment is not such a publication as will render invalid a patent subsequently granted for an invention similar to the thing experimentally produced. *Pickering v. Miller*, 15 *Rep'r*, 645 ; 25 *Pat. Off. Gaz.* 89.

The rule on the question of abandonment of an invention after application for letters patent is, that after the issue of letters patent, the abandonment must be shown to be positive, actual and intentional, by some act or declaration of the inventor, or by such gross laches as indicates unmistakably an intention to abandon the invention to the public. *Johnsen v. Fassman*, 1 *Woods*, 138 ; 5 *Fish. Pat. Cas.* 471.

The true meaning of the word "abandonment," as used in the acts of Congress relating to patents, is an abandonment of the invention to the public ; a dedication by the inventor of his discov-

cry to the free use of his fellow-beings. His merely withholding his invention from the public can never amount to an abandonment, however it may increase the difficulty of asserting and proving priority over another inventor. *Babcock v. Degener*, 1 *MacArthur Pat. Cas.* 607.

If an inventor abandon his invention, any patent subsequently issued to him therefor is invalid. *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.*, 27 *Fed. Rep'r*, 377.

227. *By Delay in applying for Patent, or in prosecuting Application.*

Although the invention was original with the patentee and he was otherwise entitled, on seasonable application, to a patent, yet if the inventor delayed applying, and made his invention known, and suffered it to be used by the public without objection, his doing so will operate as an abandonment or dedication of it to the public. *Pennock v. Dialogue*, 2 *Pet.* 1; aff'g 4 *Wash.* 538; *Kendall v. Winsor*, 21 *How.* 322; *Whittemore v. Cutter*, 1 *Gall.* 478; *Mellus v. Silsbee*, 4 *Mass.* 108; *Thompson v. Haight*, 1 *U. S. L. J.* 575; *Winans v. Schenectady & Troy R. R. Co.*, 2 *Blatchf.* 270; *Evans v. Eaton*, *Pat. C. Ct.* 322; see reversal, 3 *Wheat.* 454; *Treadwell v. Bladen*, 4 *Wash.* 703; *Whitney v. Emmett*, *Baldw.* 303.

The mere forbearance on the part of an inventor to apply for a patent during the progress of experiments, and until he has perfected his invention, and tested its value by actual practice, affords no just grounds for any presumption that he has abandoned his invention, and surrendered or dedicated it to the public. *Agawan Co. v. Jordan*, 7 *Wall.* 573; *Jones v. Sewell*, 8 *Pat. Off. Gaz.* 630; 3 *Cliff.* 563; 6 *Fish. Pat. Cas.* 343; *Henry v. Francestown Soapstone Stove Co.*, 9 *Pat. Off. Gaz.* 408; 2 *Bann. & A. Pat. Cas.* 221; *Russell, &c. Manuf. Co. v. Mallory*, 10 *Blatchf.* 140; 2 *Pat. Off. Gaz.* 495; *Fish. Pat. Cas.* 632; *Locomotive Engine Safety Truck Co. v. Pennsylvania R. R. Co.*, 10 *Phila.* 252; 1 *Bann. & A. Pat. Cas.* 470.

If the prior invention was only an experiment, never perfected, but abandoned, the mere fact of an unsuccessful application for a patent makes no difference; it can only have a bearing on the

question of prior invention or discovery. *Brown v. Guild*, 23 *Wall.* 181 ; *Putnam v. Hutchinson*, 12 *Fed. Rep'r*, 127.

Inventors may, if they can, keep their inventions secret, and, if they do, no neglect to petition for a patent will forfeit their right to apply for one. *Bates v. Coe*, 98 *U. S.* 31.

Where an invention is voluntarily broken up and laid aside, through discouragement or dissatisfaction, yet not wholly with the intention of abandonment, and without any controlling impediment in the way of an application for a patent, and another, in the meantime, invents the same thing, without any knowledge of that which was so suspended, and having reduced the same to practice, applies for and takes out his patent, and introduces the patented invention into public use, the latter must be considered as the original inventor, rather than the one who laid his invention aside. But where some of the parts used in an inventor's experiment were preserved by him and finally embodied in his model for the patent office, and the evidence indicates that he only intended to postpone his application for the patent until certain objections to his making such application, not relating to the completeness of his invention, ceased to exist, it was *held* that the invention had not been abandoned. *White v. Allen*, 2 *Cliff.* 224 ; 2 *Fish. Pat. Cas.* 440.

Unavoidable delay while an application for a patent is pending is no ground for imputing abandonment. *Jones v. Sewall*, 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; 6 *Fish. Pat. Cas.* 343.

While an inventor has an application for a patent pending in the patent-office, and presses it from time to time as his means allow, he cannot be charged with having abandoned his improvement, although eight years elapse before he succeeds. *Goodyear Dental Vulcanite Co. v. Smith*, 1 *Holmes*, 354 ; 5 *Pat. Off. Gaz.* 585.

Where it appeared, by the admissions of the patentee, that the improvement claimed was invented in 1844, and that it was not embodied in the original patent of 1845, or noticed therein, until more than fourteen years after the invention, it was *held* that this rendered the claim void. *Sickels v. Falls Co.*, 4 *Blatchf.* 508 ; 2 *Fish. Pat. Cas.* 202.

If a party, upon the rejection of his application, withdraws all the papers except a drawing, and then permits his invention to go into notorious public use for a long time, the application will be deemed to be abandoned. *Bevin v. East Hampton Bell Co.*, 5 *Fish. Pat. Cas.* 23 ; 9 *Blatchf.* 50.

The effect of the provision of the act of 1870, § 35 (now Rev. Stat. § 4897),—that upon the hearing of the renewed application therein referred to, abandonment should be considered as a question of fact,—is that delay is not, of itself, conclusive evidence of abandonment, but the decision of each case depends upon the peculiar circumstances, treating the question as one of fact and not of law. *United States Rifle, &c. Co. v. Whitney Arms Co.*, 11 *Pat. Off. Gaz.* 373 ; 14 *Blatchf.* 94 ; 2 *Bann. & A. Pat. Cas.* 493.

Rev. Stat. § 4894, —which provides that upon failure to prosecute an application within two years after action is had thereon by the patent-office, it shall be regarded as abandoned,—refers to the application, not the invention ; and does not prevent a subsequent application for the same invention. But such subsequent application can derive no aid as to the time from the prior abandoned application. The applicant must stand as to defenses in suits on the patent, as if the new application were the first. *Lindsay v. Stein*, 10 *Fed. Rep'r*, 997 ; 20 *Blatchf.* 370 ; 21 *Pat. Off. Gaz.* 1613.

Delay caused by public officials or courts cannot affect the rights of an applicant for a patent, where gross laches cannot be imputed to him ; but one who does not prosecute his application with reasonable diligence may justly be treated as having abandoned it. *Adams v. Jones*, 2 *Pittsb.* 73.

So, if two distinct improvements in the same machine, are applied for jointly and covered by one patent, and if the inventor is mistaken as to one of the improvements claimed, but is entitled to a patent as to the other, he cannot be justly said to have abandoned either, during a litigation as to his right to both. *Ib.*

Delay in filing an application for a patent, or in prosecuting one punctually filed is no ground for charging the inventor with abandonment where the cause was, that he resided in the insurrectionary States during the rebellion. *Knox v. Loweree*, 6 *Pat. Off. Gaz.* 802 ; 1 *Bann. & A. Pat. Cas.* 589.

A patentee cannot be charged with having abandoned his invention because his solicitors, without his knowledge, neglect to file his application in the patent-office for more than two years after it has been sworn to, and was in all respects complete. *Birdsell v. McDonald*, 6 *Pat. Off. Gaz.* 682.

The provision of the act of 1870, § 35, for the renewal of rejected and withdrawn applications, is subject to the implied condition that the applicant has not lost his right to make the



application by abandonment or surrender of the same. *Marsh v. Commissioner of Patents*, 3 *Biss.* 321 ; S. C., *sub nom.* *Marsh v. Sayles*, 2 *Pat. Off. Gaz.* 340 ; 5 *Fish. Pat. Cas.* 610.

A patentee, who delays prosecuting infringers, for the reason that his patent is defective, and a reissue is necessary, but who meantime collects information which will enable him to sue the infringers, is not guilty of laches. *American Middlings Purifier Co. v. Christian*, 3 *Bann. & A. Pat. Cas.* 42.

As to abandonment of drawings, or of a model, of a machine made in the course of experiments which the inventor did not prosecute, and a patent for which he never applied. See *Lyman V. & R. Co. v. Lalor*, 12 *Blatch.* 303 ; 1 *Ban. & Ard.* 403 ; 6 *Pat. Off. Gaz.* 642 ; *Eickemeyer Machine Co. v. Pearce*, 6 *Fish.* 219 ; 3 *Pat. Off. Gaz.* 150 ; 10 *Blatch.* 403.

If an application for a patent on an invention is refused, and the inventor casts aside his invention, he thereby makes it public property, and cannot take it back and make it again his own. *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.*, 27 *Fed. Rep'r.*, 377.

### 228. *Examples of Abandonment under Peculiar Circumstances.*

One sued for an infringement has the right to show long delay of the inventor to prosecute his application for a patent when at first rejected ; it is an abandonment. W., in 1849, applied for letters patent for an improvement in planing machines. It was rejected, and he was notified he might "withdraw or appeal." He did not appeal ; and in 1852 the attorney by whom the application was made withdrew it. W. made no attempt to have it reinstated until 1870. During the intervening period he was not prevented by sickness or poverty from prosecuting the claim, had he desired ; for he took out other patents. And machines embodying the principle of his invention came into use. It was *held*, that his delay was an abandonment ; and avoided a patent which was finally granted to him on the application made in 1870. *Woodbury Planing-machine Co. v. Keith*, 4 *Bann. & A. Pat. Cas.* 100 ; *aff'd*, 101 *U. S.* 479.

When an inventor takes out a patent founded on a claim which does not include his whole invention, and rests for twelve years, and then surrenders his patent and takes a reissue with a broader

claim, under circumstances which warrant the conclusion that the act is caused by successful competition of a rival, he will be held to have dedicated to the public so much of his invention as was not included in the original claim. *Turner & Seymour Manuf. Co. v. Dover Stamping Co.*, 111 *U. S.* 319.

An inventor, at the time of making his invention, intended to apply for a patent, but was misled and induced to believe his invention had been anticipated by a patent of prior date. While laboring under this impression he decided to keep the invention secret, and practice it for his own benefit. As soon as he was undeceived, he began his preparations for an application for a patent. It was *held*, that such delay did not render him liable to forfeit his right to the patent. *Ayling v. Hull*, 2 *Cliff.* 494.

Where a machine similar to that described in the plaintiff's patent existed twenty years before, and only a single person testified to more than an experimental use of it, and it was soon after abandoned, it was *held*, that it did not invalidate the patent. *Blake v. Rawson*, 3 *Biss.* 77 ; 3 *Pat. Off. Gaz.* 122 ; 6 *Fish. Pat. Cas.* 74.

A machine was constructed in 1852, was kept in the cellar of the maker, was occasionally used there, and existed at the time of the plaintiff's invention, but its existence and use were not made public; the defendant, though the son of the maker, constructed a different machine for the same purpose, until he heard of the machine of plaintiff, in 1864, when he remembered and brought out and used the old machine. It was *held*, that this machine was an abandoned and lost invention, and its existence was no bar to a recovery by plaintiff, especially as the plaintiff had no knowledge of its existence at the time of his invention. *Hall v. Bird*, 6 *Blatchf.* 438 ; 3 *Fish. Pat. Cas.* 595.

An invention was *held* to have been abandoned when the author, after having reduced it to perfection and actual practice, took no further measures with it for nine years and suffered the molds to be lost, and meanwhile others, independently of him, reduced it to practice and introduced it extensively into market. *Consolidated Fruit Jar Co. v. Wright*, 6 *Pat. Off. Gaz.* 327 ; 12 *Blatchf.* 149.

Where an inventor perseveres in his application for a patent, although he may file several applications, some of which are withdrawn, and merely suspended operations until he could obtain means, the delay was *held* not an abandonment. *Adams v. Edwards*, 1 *Fish. Pat. Cas.* 1, 11.

Where an inventor made application for a patent for his invention, which was denied by the commissioner and affirmed on appeal to the circuit court, but afterward allowed by a new commissioner, the inventor continually insisting upon his rights, it was *held* that these involuntary delays, being mistakes of public officers or the delays of courts, and not caused by laches of the inventor, should not work an abandonment. *Adams v. Jones, Id.* 527; see also, *Sayles v. Chicago & Northwestern R. R. Co., 2 Fish. Pat. Cas.* 523.

Where an inventor has delayed eighteen years after completion of his invention before applying for a patent, and after having obtained a patent, delayed five years before applying for a reissue, and during this time made several improvements for which he obtained patents; it was *held* that the subject-matter not claimed in the original was abandoned to the public. *Re Conklin, 1 MacArthur, 375.*

As to what amounts to abandonment, see, also, *Bell v. Daniels, 1 Fish. Pat. Cas.* 372; *American Hide, &c. Dressing Machine Co. v. American Tool, &c. Co., 1 Holmes, 503*; *4 Fish. Pat. Cas.* 284; *Thompson v. Haight, 1 U. S. L. J.* 563; *McGaw v. Bryan, Id.* 582.

Where an inventor applied for a patent and his application was rejected, he making no appeal, nor any application for a re-examination, until ten years had elapsed, when he made a new application, paying a new fee; and where, in the meanwhile, his invention had gone into general use, it was *held*, that the first application had been abandoned, and that the patent upon the second was void, because of the public use, long continued, with the inventor's approval. *Bevin v. East Hampton Bell Co., 9 Blatchf.* 50; *5 Fish. Pat. Cas.* 23.

H. and T. filed their application January 27, 1855. It was rejected, and they withdrew it June 11, 1856, for the purpose of filing a new application, which was prepared and sent to their attorney in April, 1857; but the latter failed to file it until February 26, 1858, and the patent was issued thereon March 15, 1858. It was *held*, that there was a continuous application, and no evidence of abandonment. *Howes v. McNeal, 15 Pat. Off. Gaz.* 608; *15 Blatchf.* 103; *3 Bann. & A. Pat. Cas.* 376.

Where nothing was relied upon to defeat complainant's patent but the inventor's delay in prosecuting his application, it having been finally rejected by the commissioner April 11, 1857, and not appealed until August 16, 1860, during four years of which time

the patent-office was closed to him, by reason of his residence in a State that was in rebellion, it was *held*, that no direct or implied abandonment was shown. *Johnsen v. Fassman*, 5 *Fish. Pat. Cas.* 471 ; 1 *Woods*, 138.

Where an inventor whose application was rejected and withdrawn in 1851, delayed to renew it until 1869, and meanwhile, in 1859, a patent, on substantially the same improvement, was granted to another, the existence of which patent became known to the first inventor in 1865, it was *held*, that the legal inference from these facts was, that he acquiesced in the action of the patent office, and abandoned whatever claim he had to the public. *Marsh v. Commissioner of Patents*, 3 *Biss.* 321 ; S. C., *sub nom.* *Marsh v. Sayles*, 2 *Pat. Off. Gaz.* 340 ; 5 *Fish. Pat. Cas.* 610.

It is not material whether the rejection of his claim was right or wrong. Even if wrong, he was obliged, if he insisted on his claim, to take some action on the subject within a reasonable time, either by an appeal from the commissioner, or by a bill in equity, in the proper court. *Ib.*

An application for a patent made within the two years required by the statute, was rejected, the claim being defective and not covering the real invention. Another application was made within a reasonable time, but not within the two years from the date of public use, upon the same specifications and drawings, with a corrected claim covering the invention, upon which a patent issued. It was *held*, that under the circumstances, the two applications, for the purposes of the two years, would be regarded as one continuous proceeding dating from the filing of the first application. *Smith v. Prior*, 2 *Sawyer*, 461 ; 4 *Pat. Off. Gaz.* 633 ; 6 *Fish. Pat. Cas.* 469.

A claim in a reissued patent of a device not suggested in the original patent or in the drawing annexed thereto, but only by a model preserved in the patent-office, was *held*, under the circumstances of the case, invalid ; the omission of the patentee, for a period of eight years, to obtain a correction of his patent being deemed to operate as a dedication to the public of all not claimed by him in the original. *Flower v. Detroit*, 22 *Fed. Rep'r*, 292. And see *Matthews v. Flower*, 25 *Id.* 830.

Continued poverty, sickness and mental alienation are *held* sufficient excuses for delay in procuring a patent, there being no circumstances in the case showing any intention of abandonment.

Celluloid Manuf. Co. *v.* Crofut, 24 *Fed. Rep'r*, 796 ; 33 *Pat. Off. Gaz.* 235.

229. *Failure to Mark the Article "Patented."*

By Rev. Stat. § 4900, it is made a good defense to a recovery of damages for infringement, that the article was sold without being marked "patented" (with date of patent) unless the defendant continued dealing in it after notice that he was infringing. (See *ante*, p. 141.)

The defense of omission of the stamp "patented," fails if the word was affixed in any manner or on any part of the article ; or if defendant had even oral notice of the patent. New York Pharmaceutical Assoc. *v.* Tilden, 23 *Pat. Off. Gaz.* 272 ; 15 *Fed. Rep'r*, 98.

It is not defeated by proof that the nature of the article was such as to render affixing the mark specially expensive. Putnam *v.* Sudhoff, 1 *Bann. & A. Pat. Cas.* 198.

That this defense should be set up by answer, see Rubber Co. *v.* Goodyear, 9 *Wall.* 788 ; Herring *v.* Gage, 15 *Blatchf.* 124 ; 3 *Bann. & A. Pat. Cas.* 396.

230. *Matters of Defense Peculiar to Reissue Patents.*

Rights upon a reissue patent will not be defeated because the reissue appears not to be for the same invention as the original, if such result may be avoided by giving it a liberal construction. Glue Co. *v.* Upton, 4 *Cliff.* 237 ; 1 *Bann. & A. Pat. Cas.* 497 ; 6 *Pat. Off. Gaz.* 837 ; see *aff'ce* 97 *U. S.* 3.

No action can be brought for acts infringing a patent, where, after the acts complained of, the patent has been surrendered for reissue ; for surrender for reissue is equivalent to a distinct admission that the original patent has no such validity as will entitle the patentee to an action for infringement ; and the new patent, as a ground of action, can be operative only from its date. Moffitt *v.* Farr, 1 *Black*, 273 ; *aff'g* 1 *Bond*, 315.

A reissued patent for a process of compressing the coating used in the insulation of telegraph wires, was *held* void for anticipation by English patents ; and the patent for the process being void, the invalidity of the patent for the product follows as a consequence.

*Western Electric Manuf. Co. v. Ansonia Brass, &c. Co.*, 114 *U. S.* 447.

The fact that a new claim embodied in a reissue patent is adjudged void, does not impair the validity of another, which is only a restatement of one in the original patent ; but the patentee, upon disclaiming the void claim, may have a decree (without costs) for infringement of the old and valid one. *Yale Lock Manuf. Co. v. Sargent*, 117 *U. S.* 536.

A patentee cannot be charged with fraud for asserting the validity of his reissue and claiming damages for its infringement, when the reissue was valid at the time of reissue, but by reason of a subsequent change in the rule of construction in the courts, has become invalid. *Pope Manuf. Co. v. Owsley*, 27 *Fed. Rep'r*, 100.

A reissue is void if there is an unwarrantable enlargement of the original patent. *Hoe v. Knap*, 27 *Fed. Rep'r*, 204.

When a patent has been surrendered for the purpose of securing a wider monopoly, and the specifications and claims of the reissue are identical with those of the original, the patent is abandoned and the reissue is a nugatory grant, because the precedent conditions therefor did not exist. *Celluloid Manuf. Co. v. Zylonite Brush & Comb Co.*, 27 *Fed. Rep'r*, 291.

The taking of a second or subsequent reissue, in order to reinstate the specification and claims of the original, precludes the assumption that the original was inoperative or invalid. A reissue of a patent granted merely to re-instate a patentee to an invention which he had surrendered, in order to obtain a wider monopoly, is valid. Where a patentee accepts a reissue containing the same claims as the original, he thereby declares that as to the invention he now claims, the original was not inoperative and void. *Ib.*

A reissue which seeks to cover something not suggested in the original patent, is void because of unlawful expansion. *Schultz v. Ostrander*, 27 *Fed. Rep'r*, 295.

The appropriate remedy where integral portions of an invention, proper subject-matter for a patent have been omitted from it, is a reissue ; the rights omitted cannot be secured by a distinct patent for them ; nor can the legal effect of the patent first issued be removed, except by surrender. *Hill v. Commissioner of Patents*, 1 *Cent. Rep'r*, 91.

Charge of fraud in a reissue will not be considered in a suit for infringement. *Schillenger v. Crawford*, 2 *Cent. Rep'r*, 680.

231. *Various Excuses for the Infringement Charged.*

It is no excuse for infringing a part of a patented invention that such part is not necessary to the successful working of the invention as patented. *Blaisdell v. Puffer*, 4 *Bann. & A. Pat. Cas.* 500.

An agreement for the transfer of the invention for the joint benefit of the inventors and those who will advance money for the manufacture or use of the machines invented, not carried into execution, and unaccompanied by any public use of the machine, but being prospective in its character, not consummated until within two years of the application, does not affect the validity of the patent. *Elm City Co. v. Wooster*, 6 *Fish. Pat. Cas.* 452; 4 *Pat. Off. Gaz.* 83.

Defendants were authorized to use one patented machine, and only one. They constructed and used two. It was *held* that they were not relieved from liability, by proof that both were never in operation at the same time. *Bloomer v. Gilpin*, 4 *Fish. Pat. Cas.* 50.

A person who infringes a patent is liable for the infringement, although what he does may be an improvement upon the patented device. *De Florez v. Reynolds*, 14 *Blatchf.* 505; 3 *Bann. & A. Pat. Cas.* 292. S. P., *Turrell v. Spaeth*, *Id.* 458.

When a license has been revoked by a plaintiff, and a defendant is sued as a naked infringer, he is at liberty to avail himself of any defense ordinarily open to a defendant charged with infringement. *Wooster v. Singer Manuf. Co.*, 23 *Pat. Off. Gaz.* 5513; 15 *Rep'r.* 524.

It is no defense to an infringement suit that the complainant has not put his alleged invention into practical use. *Broadnax v. Central Stock Yard, &c. Co.*, 5 *Bann. & A. Pat. Cas.* 609; 4 *Fed. Rep'r.* 214; 11 *Rep'r.* 6.

A license under a patent, other than the one sued upon, can have no independent efficacy in protecting the defendants. If such patent is for the same invention as the patent sued upon and of earlier date, it renders the patent sued upon void. If not for the same invention as the patent sued upon, it can confer no right to appropriate that invention. *Stuart v. Shantz*, 2 *Pat. Off. Gaz.* 524; 6 *Fish. Pat. Cas.* 35; 9 *Phila.* 376.

The manufacture of a separate element of a patented combina-

tion without intent of aiding an infringement, and not proved to be made for use in connection with the other elements, is not an infringement. *Saxe v. Hammond*, 1 *Bann. & A. Pat. Cas.* 629  
1 *Holmes*, 456 ; 7 *Pat. Off. Gaz.* 781.

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## XVII. MEASURE OF RECOVERY OF DAMAGES, OR PROFITS, FOR INFRINGEMENT.

### 232. *Compensation for Actual Injury the General Rule.*

The plaintiff can recover only for actual damages, and he must show the damages by evidence. Where his profit is in the form of a royalty paid by licensees, and there are no peculiar circumstances, the recovery will be regulated by that standard. An instruction to the jury to award to the plaintiff "such sum as they should find to be required to remunerate him for the loss sustained by the wrongful act of the defendants, and to reimburse him for all such expenditures as have been necessarily incurred by him in order to establish his right," was *held* to be too broad and vague, and under which the jury could hardly doubt that it was their duty to allow counsel fees, and perhaps other charges and expenditures equally inadmissible. *Philip v. Noek*, 17 *Wall.* 460.

In cases where profits are the proper measure of damages, such profits as the infringer has made, or ought to have made, govern, and not those which the plaintiff can show that he might have made. This rule applies peculiarly and mainly to cases in equity, and is based upon the idea that as to such profits the infringer of the patent should be treated as a trustee for the owner thereof. In actions at law, the rate at which sales of licenses of machines were made, or the established royalty, constitutes the primary and true criterion of damages. In the absence of satisfactory evidence of that class, which is more appropriate in the forum where the case is pending, the other class may be resorted to as furnishing one of the elements on which the damages, or the compensation may be ascertained. *Burdell v. Denig*, 92 *U. S.* 716.

Although the defendant may have made no profits, and no license fee was established, yet where the sale of the infringing device has caused an enforced reduction of the price of the patented



device, this is the proper measure of damage. *Yale Lock Co. v. Sargeant*, 117 *U. S.* 536.

The rule is, 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 for any sum not exceeding three times the amount of the verdict, together with costs. *Birdsall v. Coolidge*, 93 *U. S.* 64 ; 10 *Pat. Off. Gaz.* 748.

Where the unlawful acts consist in making and selling a patented improvement, or in its extensive and protracted use, without palliation or excuse, evidence of an established royalty will, in an action at law, undoubtedly furnish the true measure of damages ; but where the use is a limited one and for a brief period, the arbitrary and unqualified application of that rule is erroneous. *Ib.*

The plaintiffs must furnish evidence by which the jury may estimate actual damages. Damages cannot be calculated without certain data on which to proceed. If the plaintiff rest his case after merely proving an infringement, he is only entitled to nominal damages. *New York v. Ransom*, 23 *How.* 487. To same effect, *Blake v. Robertson*, 94 *U. S.* 728 ; *Black v. Thorne*, 111 *U. S.* 122 ; *Whittemore v. Cutter*, 1 *Gall.* 429. And see *Knight v. Gavit*, *Mir. Pat. Off.* 135 ; *Whitney v. Emmet*, *Baldw.* 363 ; *Schillinger v. Gunther*, 15 *Blatchf.* 303 ; 14 *Pat. Off. Gaz.* 713 ; *Garretson v. Clark*, 15 *Blatchf.* 70 ; 14 *Pat. Off. Gaz.* 485 ; *Matthews v. Spangenberg*, 14 *Fed. Rep'r.* 350 ; 14 *Rep'r.* 773 ; *Burdell v. Denig*, 2 *Fish. Pat. Cas.* 588.

The owner of a patent granted his interest in it to another, in consideration of certain payments to be made by the latter to third parties, &c. None of the payments were ever made ; and by mutual consent no part of the contract was ever carried out, because of the inability of the grantee. The grantor was obliged to pay the money which the grantee had agreed to pay ; and the latter, during his life, claimed no interest in the contract, but, on the contrary, recognized the exclusive right of the grantor, and acted as his agent in the patent, under a power of attorney, paying him part of the profits for the privilege. It was *held*, after the grantee's death, that the agreement did not prevent the grantor's bringing suit for the infringement of the patent without joining the grantee. *Railroad Co. v. Trimble*, 10 *Wall.* 367.

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 damages sustained from its infringement. Nor are

such damages to be estimated solely by the profits which the defendant actually realized, for he may have conducted his business unskillfully. The true question is, what advantage might the defendant, by skill, have obtained by using the patented device instead of the old device. *Campbell v. Barclay*, 5 *Biss.* 179.

In applying the provision of the statute, § 4921, that in a suit in equity the court may award, "in addition to the profits to be accounted for by the defendant, the damages complainant has sustained," it is pertinent to inquire as to whether the plaintiff has seen fit to retain a close monopoly of his invention, in which case the damages are computed by investigating the defendant's profits; or whether he saw fit to grant licenses to every one who offered to pay the stipulated fee, in which case the amount of such fee would be the proper measure of damage, except in cases of wanton infringement. *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 2 *Bann. & A. Pat. Cas.* 252.

The rate of damages may now be said to be generally, 1. That the plaintiff may recover in equity the profits which the infringer has made from the use of the invention; or, 2. That he may recover at law the profits which were lost; and where it can properly be done, these profits will be regarded as simply the fee which would have been charged if the infringer had procured a license. But where the plaintiff has evinced an intention to exercise an exclusive user of his invention, and where the sales of licenses have been too few to establish a criterion of their actual or market value, courts have sought for other elements or evidences to determine the profits lost. *McKeever v. United States*, 14 *Ct. of Cl.* 396; 23 *Pat. Off. Gaz.* 1525; *aff'd, Id.* 1530; 18 *Ct. of Cl.* 757.

A patentee may either proceed in equity for the profits the defendant has made; or he may sue at law for the loss he has suffered. In the first case, if the defendant has realized no profit there can be no recovery; in the second, he may recover the damages he has sustained, whether the defendant has made any profit or not. *Cowing v. Rumsey*, 4 *Fish. Pat. Cas.* 275. But see *Dental Vulcanite Co. v. Van Antwerp*, 2 *Bann. & A. Pat. Cas.* 252.

There must be injury and damage; injury by a violation of the right, and damage, at least nominal, presumed by law to arise from such violation. *Byam v. Bullard*, 1 *Curt.* 100; 1 *Am. L. Reg.* 139.

But a sale of the thing patented to an agent of the patentee, employed by him to make the purchase, and on account of the

patentee, is not an act from which damage will be presumed, as it must be supposed to have been done for the patentee's benefit, or at least not to have been to his loss. Such a sale, however, accompanied by other circumstances, may warrant a jury in finding an infringement by sales to others than the patentee. *Ib.*

The general principle is, that the plaintiff is entitled to recover a fair and adequate compensation for the loss or injury he has sustained by the infringement. *Taylor v. Carpenter*, 2 *Woodb. & M.* 1; 10 *L. Rep'r*, 35; *Hall v. Wiles*, 2 *Blatchf.* 194; *Pitts v. Hall*, *Id.* 229; *McCormick v. Seymour*, 2 *Blatchf.* 240; *Buck v. Hermance*, 1 *Blatchf.* 398; *Kneass v. Schuylkill Bank*, 4 *Wash.* 9; *Parker v. Hulme*, 1 *Fish. Pat. Cas.* 44; 7 *West. L. J.* 428.

When a user of a machine in violation of a patent is proved, the value of the use of such a machine during the time of the illegal user is the measure of damage. *Whittemore v. Cutter*, 1 *Gall.* 478.

It is difficult to establish any general rule as to damages. The better course is not to lay down any particular rule of damages, but to leave the jury at large to estimate the actual damages according to the circumstances of each particular case. *Earle v. Sawyer*, 4 *Mas.* 1, 14.

The scope of a patented invention having been defined, and the court having declared that the damages could not exceed the profits arising from the use of the improvement, a failure to show any such profits makes nominal damages alone recoverable. *Gould's Manuf. Co. v. Cowing*, 14 *Blatchf.* 315; 12 *Pat. Off. Gaz.* 942; 3 *Bann. & A. Pat. Cas.* 75. And it was held no compliance with the rule that the profits arising from the use shall be proven, to show that wherever the particular patented improvement was introduced, other kindred devices could not be sold. *Id.*; *Black v. Munson*, 14 *Blatchf.* 265; but see 105 *U. S.* 253.

Where a patentee fraudulently leads a party to infringe his patent, and then brings an action against him, only nominal damages should be given. *Washburn v. Gould*, 3 *Story*, 122, 137; 7 *L. Rep'r*, 276; 1 *West. L. J.* 465.

When a patented invention, which is useless in itself, has been made useful by being combined with something else invented by another, or has been changed in its operation by an invention to which the owner of the worthless machine had no title or claim, the patentee of such worthless machine is not entitled to damages

for the use of it, although an injunction will be granted. *Whitney v. Emmett*, *Baldw.* 303, 329.

That, where a patent has been surrendered, and a reissue granted, no damages can be recovered for any acts of infringement committed prior to the reissue, see *Peck v. Collins*, 103 *U. S.* 660.

Upon a reference to ascertain the profits recoverable for infringement of a patent for improvements of devices previously in use, the burden is upon the complainant to prove the proportion of profits justly ascribable to his invention, and failing to prove this, he is entitled to only nominal damages. *Bostock v. Goodrich*, 25 *Fed. Rep'r*, 819 ; 34 *Pat. Off. Gaz.* 1047.

The profits of which the patentee is deprived by the manufacture or use of the device, only a single element of which is covered by his patent, constitute the measure of damages. *Putnam v. Lomax*, 10 *Biss.* 546 ; 9 *Fed. Rep'r*, 448.

Each claim of a patent covers a complete invention, and is, in substance, an independent patent. *Celluloid Manuf. Co. v. Zylonite Brush & Comb Co.*, 27 *Fed. Rep'r*, 291.

Where there is no evidence as to the value of the use of a patent, only nominal damages can be allowed. *Moffit v. Cavanagh*, 27 *Fed. Rep'r*, 511.

The measure of damages for infringement is the amount the plaintiff would have made, had it not been for defendant's unlawful action. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

Where the claims infringed are unimportant, only nominal damages can be allowed. *Moffit v. Cavanagh*, 27 *Fed. Rep'r*, 511.

### 233. *Exemplary or Punitive Damages not Allowable.*

The jury are not to award what are known as exemplary, vindictive, or punitive damages. *Seymour v. McCormick*, 16 *How.* 480, 489 ; *Whittemore v. Cutter*, 1 *Gall.* 478 ; *Hall v. Wiles*, 2 *Blatchf.* 194 ; *Pitts v. Hall*, *Id.* 229, 238 ; *Stimpson v. The Railroads*, 1 *Wall. Jr.* 164, 169. To the contrary, *Parker v. Corbin*, 4 *McLean*, 492.

Punitive damages for infringement are not to be visited upon a defendant who is not a willful infringer, but manufactures under a rival patent. *Buerk v. Imhaeser*, 10 *Pat. Off. Gaz.* 907 ; 14 *Blatchf.* 19 ; 2 *Bann. & A. Pat. Cas.* 452.

The question of damages is exclusively with the jury, and if

they are of the opinion that the defendant has unlawfully infringed, they ought to award plaintiff such sum, as, in their judgment, founded upon the evidence, would fully indemnify him for the actual damages he had suffered beyond the taxable costs. *Foote v. Silsbee*, 1 *Blatchf.* 445, 459 ; aff'd, 14 *How.* 218.

Where the defendants entered upon the violation of the plaintiff's patent, after having been warned of the consequences, and went on with their eyes open, disregarding the claims of the patentee, and showing a willingness to avail themselves of the profits of his discovery, and to deprive him of the fruits of his genius, time and expense ; it was *held*, that liberal damages were warrantable. *Ib.* 467.

When the defendant purchased the machine in the open market, not knowing that it was patented, and abandoned all the patented appliances on being notified of their infringement, it was *held*, that the case was not one for exemplary damages. *Emerson v. Simm*, 3 *Pat. Off. Gaz.* 293 ; 6 *Fish. Pat. Cas.* 281.

In patent cases, damages should be compensatory, not vindictive. The object is not punishment, but indemnity. The profits which the defendant has derived should be regarded, and the amount of loss which the plaintiff has sustained should be regarded also. *Knight v. Gavit*, *Mir. Pat. Off. Gaz.* 135.

#### 234. Referring to License Fees, Royalties, &c., to Fix Damages.

The general rule is that if a patentee has established a fixed price at which he is accustomed to sell rights to manufacture under his patent, the jury may take that license fee as their guide in estimating damages against an infringer. *Hogg v. Emerson*, 11 *How.* 587, 607 ; *Seymour v. McCormick*, 16 *How.* 480, 488 ; *McCormick v. Seymour*, 3 *Blatchf.* 209 ; aff'd in part, 19 *How.* 96 ; *Sickles v. Borden*, 3 *Blatchf.* 535 ; *Wooster v. Simonson*, 20 *Fed. Rep'r*, 316 ; 28 *Pat. Off. Gaz.* 918 ; *May v. Fond du Lac County*, 27 *Fed. Rep'r*, 691.

So when it is difficult to ascertain the profits with exactness, a license fee may be adopted as the standard of profits. *Emigh v. Baltimore & O. R. R. Co.*, 4 *Hughes*, 271 ; 19 *Pat. Off. Gaz.* 935 ; 6 *Fed. Rep'r*, 283.

The above rule may be applied in determining the sum to be paid to a patentee, in a case where the user had been by consent of

the patentee but without any stipulation as to compensation, as well as in cases of unqualified infringement; the reason being even stronger in such a case. *Packet Co. v. Sickles*, 19 *Wall.* 611.

The license fee or royalty must have become uniform to warrant making it a measure of recovery against an infringer who has not assented to it; and proof of a single license is not sufficient to establish a market price for licenses. *Westcott v. Rude*, 19 *Fed. Rep'r*, 830; 27 *Pat. Off. Gaz.* 719.

Thus, if the patentee has been accustomed to take small fees in many cases, in order to get his invention introduced, the jury must take that fact into account in making their award. *Sickles v. Borden*, 3 *Blatchf.* 535.

A transfer of "the sole and exclusive right and monopoly of manufacturing" under a patent, by the owners, of their entire interest in the patent, to be paid for by a certain royalty, is not the establishment of an "ordinary license fee" within the rule, and the sum cannot be invoked as a safe criterion of damages, unless evidence is offered showing that the licensees of the complainants were deprived of the sale of the number of machines which the defendants manufactured and sold. *La Baw v. Hawkins*, 2 *Bann. & A. Pat. Cas.* 561.

An agreement by a licensee to pay a certain price, whether he use the entire invention or a part only, is no criterion by which to estimate the damages for an infringement of only one or two distinct claims in the patent, each of value. *Westcott v. Rude*, 19 *Fed. Rep'r*, 830; 27 *Pat. Off. Gaz.* 719. So the amount of plaintiff's established license fee cannot be adopted as a measure of damages where a part only of the patented invention is used by defendant. *Burdsall v. Coolidge*, 93 *U. S.* 64.

A rescinded contract for payment of a royalty is not competent in determining the measure of damages for an infringement. *Bussey v. Excelsior Manuf. Co.*, 1 *Fed. Rep'r*, 640; 1 *McCrary*, 161; 5 *Bann. & A. Pat. Cas.* 135.

It has been held that the award of damages reached by comparison with the patentee's usual license fee may be mitigated, if the maker of the machine was ignorant of the existence of the patent right, and did not intend any infringement, although such ignorance will not completely exonerate from damages. *Hogg v. Emerson*, 11 *How.* 587, 607.

If there is not an established, uniform license fee, the plaintiff must produce general evidence of actual damages sustained; such

as proof of the utility and advantage of the invention over the old modes or devices that had been used for working out similar results (*Suffolk Co. v. Hayden*, 3 *Wall.* 315); and if the proofs show that the same results were produced by other methods in common use, nominal damages only are recoverable. *Black v. Thorne*, 111 *U. S.* 122.

Occasional contracts of license cannot be considered a measure of damages. *Greenleaf v. Yale Lock Manuf. Co.*, 17 *Blatchf.* 253; 17 *Pat. Off. Gaz.* 625; 4 *Bann. & A. Pat. Cas.* 583.

### 235. *Damages Awarded in Peculiar Cases.*

When the language used by the judge in instructions to the jury was "exemplary damages," and open to be construed beyond this rule, but the jury appeared not to have gone beyond the actual injury sustained, it was *held*, that the verdict should not be disturbed. *Taylor v. Carpenter*, 2 *Woodb. & M.* 1; 10 *L. Rep'r*, 35.

Where the case admitted of only general evidence on the part of the plaintiff, and the defendants offered no proof on the question of damages, it was *held*, that the jury were warranted in exercising a liberal discretion. The defendants should have shown the amount of their sales, if necessary to prevent an excessive award. *Stephens v. Felt*, 2 *Blatchf.* 37.

When the invention was one of improvements in a pump only, numerous parts of which were in general use prior to the patent, and where plaintiff fails to show that the profits or damages arose from the improvement as distinguished from the entire machine, nominal damages only can be recovered. *Gould's Manuf. Co. v. Cowing*, 12 *Blatchf.* 243; 8 *Pat. Off. Gaz.* 277; but see 105 *U. S.* 253.

The distinction in respect to the measure of damages between a patent which covers an entire machine, and one for improvement on a machine, stated. *Seymour v. McCormick*, 16 *How.* 480, 491; *Tuttle v. Gaylord*, 28 *Med. Rep'r*, 97.

The patentee of a hotel register book is entitled to recover, as damages, not only the profit he might have made upon the book if he had sold it, but what he might have obtained from those who advertised in it. *Hawes v. Washburne*, 5 *Pat. Off. Gaz.* 491.

In an action for damages for the infringement of a patent of a water-wheel, one-fourth of the proceeds being estimated as the

profits of the mill, the damages were assessed at that amount. *Parker v. Banker*, 6 *McLean*, 631.

If the defendants used other improvements with the patented device which enhanced their value, they should have a corresponding reduction. The burden rests upon the defendant to show the value of such improvements. *Mulford v. Pearce*, 14 *Blatchf.* 141.

They will also be allowed to deduct royalty paid for improvement and cost of introducing the improvement. *American Nicholson Pavement Co. v. Elizabeth*, 6 *Pat. Off. Gaz.* 764.

When the patented device is distinguishable as an improved article of manufacture from that which is open to the public, the damages are not limited to the advantages derived by defendant in using improved article over that open to the public. *Mulford v. Pearce*, 14 *Blatchf.* 141.

Where a part owner of a patent sues a co-owner for using an infringing device, the recovery, if any, will be in proportion to their respective interests. *Herring v. Gas Consumers' Assoc.*, 9 *Fed. Rep'r*, 556 ; 3 *McCrary*, 206 ; 21 *Pat. Off. Gaz.* 203.

In what cases jury may consider costs in fixing damages, see *Day v. Woodworth*, 13 *How.* 363.

Principle on which damages should be computed where the injury caused by the infringement consists in compelling patentee to reduce his price. See *Fitch v. Bragg*, 16 *Fed. Rep'r*, 243 ; 21 *Blatchf.* 302 ; *Stephens v. Felt*, 2 *Blatchf.* 37 ; *Yale Manuf. Co. v. Sargeant*, 7 *Sup. Ct. Rep'r*, 934.

The measure of damages for the infringement of patents, determined, in view of particular facts. *Buerk v. Imhaeuser*, 10 *Pat. Off. Gaz.* 907 ; 14 *Blatchf.* 19 ; 2 *Bann. & A. Pat. Cas.* 452 ; *Cowing v. Ramsey*, 8 *Blatchf.* 36 ; *McKeever v. United States*, 14 *Ct. of Cl.* 396 ; 23 *Pat. Off. Gaz.* 1525.

In a suit for infringement of a patent for a machine, the infringement was limited to eighteen months as to four machines, and to three years as to two machines ; and the damages therefor were assessed by the master at the rate per machine of a sum which he found to be the fixed royalty for the term of the patent, the patentee having made his patent available exclusively by the sale of licenses for its use at such fixed sum. It was *held*, that this rule of damages was, under the circumstances, properly applied ; the infringement by the defendants having been deliberate, and their use of the invention, considering the nature of it and the business to which it was applied, having been extensive and protracted. *Stutz v. Armstrong*, 25 *Fed. Rep'r*, 147.



236. *Trebling the Damages.*

The proper course is for the jury to find the actual damages sustained by the patentee by the infringement, and it is discretionary with the court, in view of the circumstances of the case, to render judgment for any sum not exceeding three times the amount of the verdict. *Wilbur v. Beecher*, 2 *Blatchf.* 132, 143; *Conover v. Dohrman*, 3 *Fish. Pat. Cas.* 382; *Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539; *Stephens v. Felt*, 2 *Blatchf.* 37; *Guyon v. Serrell*, 1 *Blatchf.* 244; *Hall v. Wiles*, 2 *Id.* 194; *Parker v. Hulme*, 1 *Fish. Pat. Cas.* 44, 56. To nearly same effect, *Seymour v. McCormick*, 16 *How.* 480; *Livingston v. Woodworth*, 15 *How.* 546; *Saunders v. Logan*, 2 *Fish. Pat. Cas.* 167; 9 *Am. L. Reg.* 475; 2 *Pittsb.* 241.

The actual damages are, as a general rule, all that can be reasonably claimed for an infringement, though cases may arise where the circumstances are aggravated, and such as to repel altogether the *bona fides* of the infringement, in which the power to increase the verdict should be exercised. Each case must depend upon its own circumstances. *Guyon v. Serrell*, 1 *Blatchf.* 244; *Peck v. Frame*, 9 *Blatchf.* 194; 5 *Fish. Pat. Cas.* 113. See, also, *Russell v. Place*, *Id.* 134. They may be increased notwithstanding plaintiff, by reason of delay in filing a disclaimer, cannot recover costs. *Guyon v. Serrell*, 1 *Blatchf.* 244.

Previous to the act of 1836, the courts were compelled to treble the damages. Since that act they are not compelled to do so, but may increase them or not, at their discretion, within the threefold limit. In the exercise of that discretion, the court will not increase them if, in their opinion, the jury have already exceeded their proper measure (*Stimpson v. Railroads*, 1 *Wall. Jr.* 164; see, also, *Allen v. Blunt*, 2 *Woodb. & M.* 121); or where no special reasons are shown, such as malice, insufficiency of the verdict, or the like, for trebling (*Schwarzel v. Holenshade*, 2 *Bond*, 29; 3 *Fish. Pat. Cas.* 116); or when the action was brought after the expiration of the patent, and is prosecuted merely to collect damages (*Bell v. McCullough*, 1 *Bond*, 194; 1 *Fish. Pat. Cas.* 389); or in favor of a mere assignee of the right of action. *Schwarzel v. Holenshade*, 2 *Bond*, 29; 3 *Fish. Pat. Cas.* 116.

The power has been granted chiefly for the purpose of empowering the courts to remunerate parties driven to litigation to sustain

their patents, by wanton and persistent infringement. *Brodie v. Ophir Silver Mining Co.*, 5 *Sawyer*, 608 ; 4 *Fish. Pat. Cas.* 137.

The Federal courts sitting in equity had no power, under the act of July 4, 1836, § 14, to treble the damages found by them for violating a patent right, as they might do when sitting at law, and on a verdict and judgment. *Livingston v. Jones*, 3 *Wall. Jr.* 330 ; 2 *Fish. Pat. Cas.* 207.

That the power of "trebling," as conferred by Rev. Stat. §§ 4119, 4121, does not extend to profits, but is limited to damages, see *Campbell v. James*, 5 *Bann. & A. Pat. Cas.* 630 ; rev'd on other points, 104 *U. S.* 356. But under Rev. Stat. § 4919, where it appeared, in a suit in equity for infringement of a patent, that the defendant's profits derived from the use of the plaintiff's invention, did not amount to as much as the plaintiff's damages arising from the infringement, it was *held* that the court might add to the amount of such profits, a sum sufficient to make the amount decreed equal to the plaintiff's damages. *Simpson v. Davis*, 22 *Blatchf.* 113 ; 22 *Fed. Rep'r*, 444 ; *Willimantic v. Clark Co.*, 27 *Fed. Rep'r*, 865.

### 237. *Right to recover Profits.*

Another mode of ascertaining the damages is by inquiring what profits the infringer has realized from his unlawful use of the invention. In this class of cases, the plaintiff's measure of damages is the amount of profits actually received by the defendant from the sales complained of. *Lowell v. Lewis*, 1 *Mas.* 182 ; *Wilbur v. Beecher*, 2 *Blatchf.* 132, 143. S. P., *Hall v. Wiles*, *Id.* 194 ; *Pitts v. Hall*, *Id.* 229, 239.

In an action on the case for an infringement, it is erroneous to instruct the jury that the true rule in regard to damages is the profits made by the defendant by the infringement. The true rule is, what the plaintiff has lost, and not what the defendant has gained. *Cowing v. Rumsey*, 4 *Fish. Pat. Cas.* 275.

Where a patentee claims as damages a loss of profits caused by a loss of sales, resulting from an infringement, he must establish, by satisfactory evidence, that he would have sold more of the patented articles than he did sell, if the infringing articles had not been sold, and what profit he would have made on them, and what part of such profit is to be assigned to the invention patented. Such evidence must not be conjecture and speculation. *Ingersoll*

*v. Musgrove*, 14 *Blatchf.* 541 ; 13 *Pat. Off. Gaz.* 966 ; 3 *Bann. & A. Pat. Cas.* 304.

The measure of damages for infringement of a patent is the profits that the plaintiffs would have made on the sales of the patented article had they supplied the customers to whom the defendants sold such article. In estimating the amount of such profits the cost of manufacture and sale should be deducted, and on sales of a large amount, clerk-hire, storage, freight, &c., should be considered as part of such cost. *Zane v. Peck*, 23 *Pat. Off. Gaz.* 191.

The measure of damages for an infringement, where the defendant sold articles similar to those patented, at a loss, was *held* to be the profits the plaintiff would have made on the trade he would have had, and not on the amount of sales made by the defendant ; since it was to be inferred that the plaintiff at his price would not have sold as many as the defendant did at his. *Hall v. Stern*, 20 *Fed. Rep'r*, 788.

Should a party invent a machine having no value alone, and unsalable, and then use, in connection with his machine, the invention of another, which gives to the former a market value, the measure of damages is not the entire amount of profit, but the profit derived from the connection. *Whitney v. Mowry*, 4 *Fish. Pat. Cas.* 141 ; *rev'd* on other points, 14 *Wall.* 620.

Where the patent is for an improvement, the patentee is not entitled to all the profits that accrued in the manufacture of the whole article, but merely to the profits which were realized as the consequence of the improper use of the improvement. *Littlefield v. Perry*, 21 *Wall.* 205 ; 7 *Pat. Off. Gaz.* 964 ; *Ingels v. Mast*, 1 *Illippin*, 424 ; 2 *Bann. & A. Pat. Cas.* 24 ; *Gould's Manuf. Co. v. Cowing*, 12 *Blatchf.* 243 ; 8 *Pat. Off. Gaz.* 277 ; 1 *Bann. & A. Pat. Cas.* 375 ; *Gould's Manuf. Co. v. Cowing*, 14 *Blatchf.* 315 ; 12 *Pat. Off. Gaz.* 942 ; 3 *Bann. & A. Pat. Cas.* 75 ; *Black v. Munson*, 14 *Blatchf.* 265 ; 2 *Bann. & A. Pat. Cas.* 623 ; *Vaughan v. Cent. Pac. R. R. Co.*, 4 *Saw.* 280 ; 3 *Bann. & A. Pat. Cas.* 27 ; *Star S. C. Co. v. Crossman*, 4 *Bann. & A. Pat. Cas.* 566 ; *Maier v. Brown*, 17 *Fed. Rep'r*, 736. See *Manuf. Co. v. Cowing*, 105 *U. S.* 253.

On an injunction bill to restrain the infringement of a patent, where there is no dispute as to the title, the circuit court has jurisdiction, under the act of 1836, § 17 (5 Stat. 124), to refer the case to a master to take an account of the profits of which the plaintiff has been deprived by reason of the infringement. The defendant

is regarded as having been in the use and enjoyment of the property of the patentee, and as being bound in equity to account for the profits. *Allen v. Blunt*, 1 *Blatchf.* 480 ; 8 *N. Y. Leg. Obs.* 105

An infringer of a patent is, in equity, a trustee of the patentee, of the gains derived by him from the infringement. *Wetherill v. New Jersey Zinc Co.*, 1 *Bann. & A. Pat. Cas.* 485.

A party who has earned profits by the infringement of a patent is chargeable as trustee for the use of the real owner. *Vaughan v. East Tennessee, Virginia, &c. R. R. Co.*, 11 *Pat. Off. Gaz.* 798 ; 1 *Flippin*, 621 ; 2 *Bann. & A. Pat. Cas.* 537.

There is no right of action recognized, to recover profits for infringing a patent, founded on the theory that such profits should be treated as trust funds, and the infringer considered as a trustee *de son tort*. The act of infringement is but a simple taking and using another's property, without authority, for one's own advantage ; and this, of itself, does not confer equity jurisdiction. *Sayles v. Richmond, Fredericksburgh, &c. R. R. Co.*, 3 *Hughes*, 172 ; 25 *Int. Rev. Rec.* 209 ; 16 *Pat. Off. Gaz.* 43 ; 7 *Rep'r*, 743 ; 4 *Bann. & A. Pat. Cas.* 239.

The profits recoverable in equity by the owner of a patented invention from an infringer are such only as result directly and immediately from the infringement. Remote and contingent profits are not recoverable. Where the defendants in a suit in equity, by their use of the complainant's patented process of preserving fish, were enabled to withdraw fish from the market and thus obtain a higher price for their unpreserved fish than they would otherwise have received, it was *held*, that the profits resulting from such increased price were too remote and indirect to be charged against the defendants as profits realized from their infringement. *Piper v. Brown*, 1 *Holmes*, 196 ; 6 *Fish. Pat. Cas.* 240.

Where a patentee 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. *Graham v. Mason*, 1 *Holmes*, 88 ; 5 *Fish. Pat. Cas.* 290 ; 1 *Pat. Off. Gaz.* 609. Compare *Calkins v. Bertrand*, 8 *Fed. Rep'r*, 755 ; *Putnam v. Lomax*, 9 *Fed. Rep'r*, 448 ; 10 *Biss.* 546 ; 23 *Wall.* 261.

Where the infringer has made a profit on one fraction of the

mechanisms made and sold, but has met with losses on a larger fraction, so that a correct account of the whole operation would show a loss on the total manufacture, the patentee is entitled to the profits made on a bill counting generally against the infringer, without offset or deduction for losses made in the manufacture and sale of other infringing mechanism. *Graham v. Mason, supra.*

Where the patented invention consisted of a "bridle-motion" attachment for looms,—*held*, that the complainants had no right to any portion of the profits which the defendants made upon the looms to which the infringing mechanism was attached. *Ib.*

Where some of the infringing mechanisms made and sold by the defendant in a suit in equity on a patent, were made after a pattern of his own, differing from the complainant's in form, which was claimed to increase the value, and lessen the cost of manufacture of the mechanism,—*held*, that the complainants were entitled to recover all the profits on all the articles sold, including those made according to the defendant's own pattern. *Ib.*

And where an infringer sold parts of infringing mechanisms to repair and restore such mechanisms previously sold by him,—*held*, that the complainants were entitled in equity to recover the profits made on the sales of such parts, as well as on the sales of the original mechanism. *Ib.*

In cases in which gains and profits alone are to be awarded, when the defendant has used the infringing machine so unskillfully, or in a manner so unbusiness-like, that he has made no profit, the complainant can recover none. But the defendant cannot prejudice complainant's right to recover, by applying the gains arising from the use of an infringing machine, to make up losses on other branches of his business. *Conover v. Mers*, 11 *Blatchf.* 197; 6 *Fish. Pat. Cas.* 506.

An infringer is liable for profits although he might have employed some other contrivance than the one used to quite the same profit. *Burdett v. Estey*, 3 *Fed. Rep'r*, 566; 19 *Blatchf.* 1.

No profits will be decreed on accounting for infringement where none have accrued; but in proper cases damages may be had under Rev. Stat. § 4921. *Ib.*

The rule, that the profits which a plaintiff, who has made and patented an improvement upon an existing machine or manufacture, is to recover, must be those only which can be proved to have resulted from his own particular improvement upon the existing machine or manufacture, and that the burden of proof of such

profits is upon him, stated and applied. *Star Salt Caster Co. v. Crossman*, 4 *Bann. & A. Pat. Cas.* 566. See, also, *Garretson v. Clark*, 15 *Blatchf.* 70; 14 *Pat. Off. Gaz.* 485; 4 *Bann. & A. Pat. Cas.* 536; also 16 *Pat. Off. Gaz.* 806; 4 *Bann. & A. Pat. Cas.* 536; *Kirby v. Armstrong*, 5 *Fed. Rep'r*, 801; 10 *Biss.* 135; 19 *Pat. Off. Gaz.* 661; *Calkins v. Bertrand*, 8 *Fed. Rep'r*, 755; 10 *Biss.* 445; *Willimantic Thread Co. v. Clark Thread Co.*, 27 *Fed. Rep'r*, 865.

In cases of willful infringement, respondents ought to be held to the most rigid accountability, and no intendment ought to be made in their favor founded upon the alleged inconclusiveness of the complainant's proof of loss. Such proof ought to be interpreted most liberally in favor of complainants, within the limit of an approximately accurate ascertainment of their damages. *Bigelow Carpet Co. v. Dobson*, 10 *Fed. Rep'r*, 385; 13 *Rep'r*, 265.

Where a patentee is himself the infringer of rights under the patent which he has assigned, equity looks upon him as a trustee faithless to his trust; the violator of rights which he was bound to protect. It will accordingly charge him for all profits improperly made, as well for profits on original patents, the subject of original bill, as for profits made on reissues obtained *pendente lite*, and the subject of a supplemental bill. *Littlefield v. Perry*, 21 *Wall.* 205.

No stipulations between a patentee and his assignee, as to royalty to be charged, can prevent the latter from recovering from an infringer the whole profits realized by reason of the infringement. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

Where it appears that some of the defendants have not been jointly concerned in the infringement for the whole time covered by the account, the several liability of all must be apportioned in making up the decree. *Tatham v. Lowber*, 4 *Blatchf.* 86.

In a suit against three defendants, it is proper to award against all three the profits made by them jointly, while partners, and against two of them the profits they made after their partnership with the third defendant was dissolved, and while they were using the patented invention in conjunction with a fourth person, not a defendant. *Herring v. Gage*, 15 *Blatchf.* 124; 3 *Bann. & A. Pat. Cas.* 396.

Where the thing patented was made in one district and used in another, and the bill prays for profits from both making and using and for an injunction, plaintiff may recover profits resulting from either making or using within the jurisdiction of the court,

and obtain an injunction against making, using and vending within the same. *Locomotive Engine Safety Truck Co. v. Erie Ry. Co.*, 6 *Fish. Pat. Cas.* 187; 10 *Blatchf.* 292; 3 *Pat. Off. Gaz.* 93.

Since Rev. Stat. § 4921, a court of equity has power, in a suit for infringement, to award damages for such loss as complainant has sustained, in addition to the profits he has lost. But profits continue to be proper measure of damages in equity, except where the injury is greater than the aggregate of what was made by defendant. *Willimantic Thread Co. v. Clark Thread Co.*, 27 *Fed. Rep'r*, 865.

### 238. *How Profits are Ascertained or Estimated.*

The damages recoverable upon a bill in equity for an infringement, do not extend to the entire profits realized by the infringer; whether the patent is for a machine or a process of manufacture. The question is as to the advantage derived by the infringer by his act. Such advantage is the measure of profit to be accounted for. *Mowry v. Whitney*, 14 *Wall.* 620; *Cawood Patent*, 94 *U. S.* 695. S. P., *Knox v. Great Western Quicksilver Min. Co.*, 7 *Rep'r*, 325; 14 *Pat. Off. Gaz.* 897; 4 *Bann. & A. Pat. Cas.* 25; 6 *Sawyer*, 430.

If the patentee does not sell rights to others, but uses his invention exclusively himself, and furnishes the products to the community himself out of his own manufactory, the profits of sales may become the criterion of the actual damages of the patentee. *Seymour v. McCormick*, 16 *How.* 480, 490; rev'g 2 *Blatchf.* 240; see *Seymour v. McCormick*, 19 *How.* 96; aff'g 3 *Blatchf.* 209, 225.

The measure is, the difference between cost of manufacture and price upon sale; and a controlling consideration is that the wrongdoer shall not reap an advantage from his wrong. *American S. Co. v. Emerson*, 8 *Fed. Rep'r*, 806.

Where the profits made by a defendant from the unlawful use of a patented invention amount to more than the license fees for such use would amount to, the plaintiff, although exercising his monopoly by the granting of licenses, is entitled to recover such profits on an accounting for profits, and is not limited to such license fees. *Wooster v. Taylor*, 14 *Blatchf.* 403; 3 *Bann. & A. Pat. Cas.* 241.

Where the infringement shown is of the invention as an entirety; )

as, where not merely the new parts in a combination of new and old, but the entire combination was used, the whole profits of infringer's sales are profits of infringement. *Ruggles v. Eddy*, 2 *Bann. & A. Pat. Cas.* 627 ; 12 *Pat. Off. Gaz.* 716.

Where the entire value of the whole machine as a marketable article is properly and legally attributable to the patented features, the profits may be estimated by showing the profits derived from making and selling the article containing the patented features, and the profits realized from the manufacture and sale of other forms of the same article not embodying the same features. *Garretson v. Clark*, 16 *Pat. Off. Gaz.* 806 ; 4 *Bann. & A. Pat. Cas.* 536.

Where the infringed patent is for an art, a fair measure of the infringer's actual profits is the saving in cost of production by the use of the appropriate invention, over the cost of production by cognate means, used and available. *Wetherill v. New Jersey Zinc Co.*, 1 *Bann. & A. Pat. Cas.* 435. Compare *Munson v. New York*, 16 *Fed. Rep'r*, 560 ; 16 *Rep'r*, 99.

When a patent covers but one of many features of a machine, the gains on the whole machine cannot be reckoned as damages for infringement thereof, but only the gains arising from the use of the special device or element claimed by such patent. The burden of proof is upon the complainant to separate or apportion the defendant's profits and complainant's damages between the features infringed and not infringed, and such evidence must be reliable and tangible, 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 article is properly and legally attributable to the patentable features. *Calkins v. Bertrand*, 8 *Fed. Rep'r*, 755 ; 10 *Biss.* 445.

The general principle is that a patentee is limited in his recovery of damages for infringement 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. 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 is entitled to damages arising from the manufacture