

and sale of the entire article. But if his invention be limited to some particular part of a large machine, such as the cut-off of an engine, the axle of a wagon, or the seat upon a mowing-machine, it is equally clear that his recovery must be limited to such profits as arise from the manufacture and sale of the patented feature. His damages, too, must be proved, and not left to conjecture; and the fact that it is impossible to separate the profits arising from the improvement from those incident to the manufacture of the whole machine, is an insufficient reason for awarding the plaintiff more than he is justly entitled to receive. In case he is unable to prove how much of the entire profit upon the machine is due to his patent, he can recover only nominal charges. *Maier v. Brown*, 17 *Fed. Rep'r*, 736; 10 *Biss.* 546; 16 *Rep'r*, 585; *Fitch v. Bragg*, 16 *Fed. Rep'r*, 243; 21 *Blatchf.* 302.

In estimating profits made by the infringer,—the saving to him by the use of the patented machine,—comparison must be made between the use of the patented invention, and the use of what was known and open to the public before the date of the patent, not with subsequent appliances. *Turrell v. Illinois Central Ry. Co.*, 20 *Fed. Rep'r*, 912; *Knox v. Great Western Quicksilver Mining Co.*, 14 *Pat. Off. Gaz.* 897; 7 *Rep'r*, 325; 4 *Bann. & A. Pat. Cas.* 25.

In estimating the profits realized from infringement of a patent, compensation is not allowed the infringer for his time and labor. *Piper v. Brown*, 1 *Holmes*, 198; 6 *Fish. Pat. Cas.* 240.

An allowance to the respondents of charges for extra work and materials upon condition of their assignment of the charges to the complainant will, if the arrangement is an equitable one, be confirmed by the court. *Brady v. Atlantic Works*, 15 *Pat. Off. Gaz.* 965; 3 *Bann. & A. Pat. Cas.* 577.

The profits for which an infringer is chargeable are to be computed, for a machine, by deducting from the articles made all the elements of costs in their production. *Troy Iron, &c. Factory v. Corning*, 6 *Blatchf.* 328; 3 *Fish. Pat. Cas.* 497.

In an accounting for profits, the defendant cannot be credited with a sum of money as a salary earned by, and paid to himself, while engaged in the business which earned the profits. *Williams v. Leonard*, 9 *Blatchf.* 476; 5 *Fish. Pat. Cas.* 381.

Interest on the cost of a device, and the cost of power, are to be allowed as deductions from profits, only when it is shown they

have been paid or incurred as debts. *Herring v. Gage*, 15 *Blatchf.* 124; 3 *Bann. & A. Pat. Cas.* 396.

In what cases the defendant is accountable only for what profits he actually made, not for what, by diligence and skill, he might have received, see *Livingston v. Woodworth*, 15 *How.* 546, *Dean v. Mason*, 20 *How.* 198; *Brady v. Atlantic Works*, 15 *Pat. Off. Gaz.* 965; 3 *Bann. & A. Pat. Cas.* 577.

Where the defendants are manufacturing under a patent which, although an infringement of the complainant's patent, contains valuable improvements upon it, and for which the defendants pay a royalty, the amount of the royalty paid by them is a proper item to be deducted from the aggregate amount of profits realized by them. The fact that the defendants have not actually paid the license fee to the owner of the subsequent patent does not change the rule, when it is shown that they are liable for the amount of such royalty. *La Baw v. Hawkins*, 2 *Bann. & A. Pat. Cas.* 561.

There cannot be any rule for estimating profits which will apply equally to all cases. The mode of estimating profits must depend upon the peculiar nature of the monopoly granted. *Mason v. Graham*, 5 *Fish.* 290; 1 *Holmes*, 88; 1 *Pat. Off. Gaz.* 608; reversed on other points, 7 *Pat. Off. Gaz.* 833; 23 *Wall.* 261.

239. *What Awards of Profits have been made under Special Circumstances.*

A question of infringement had been settled in favor of plaintiffs, and reference made to a master to report the amount of damages sustained by plaintiffs for the use by defendants of their invention. The master in his report based his opinion upon the productive capacity of the machines employed. It was *held*, that the calculation should have been made on the actual production of such machines of the article manufactured. *Webster v. New Brunswick Carpet Co.*, 9 *Pat. Off. Gaz.* 203; 2 *Bann. & A. Pat. Cas.* 67.

Where the suit was for infringing patents for certain improvements in coal stoves (coal stoves generally and various improvements on them having been long known), and decretal order directed account of all the profits which the defendants have received from the manufacture, use, or sale "of stoves, &c., embracing the improvements described in and covered by the said letters patent and the reissues thereof, or any of them," it was

held, that the order was too broad. The true question is, "What advantage did the defendant derive from using the complainant's invention over what he had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result?" And the fruits of that advantage are his profits, and to be accounted for. *Littlefield v. Perry*, 21 *Wall.* 205.

The defendants, vendors of organs generally, and selling, sometimes organs having a patented invention consisting of a combination of what was called a "tremolo attachment" with the organ, and sometimes organs without the attachment, were decreed guilty, in their sales of organs with the attachment, of infringing the complainant's patent. It was *held*, that in ascertainment of profits made by them from the sales of the organs with the tremolo attachment, it was proper to let them prove the general expenses of their business in effecting sales of organs generally, and deduct a ratable proportion from the profits made by the tremolo attachment. *The Tremolo Patent*, 23 *Wall.* 518; *aff'g* 9 *Blatchf.* 385, 550; 5 *Fish. Pat. Cas.* 310, 537.

An order in a suit in equity, requiring the defendant to file a monthly account, on oath, of all "iron safes hereafter manufactured and sold by him," will be sufficiently complied with, by giving their number and inside dimensions, without stating the prices at which sold, or the names of the purchasers. It is sufficient to describe the articles in the account, so that persons in the trade can determine the value or price of them in the market, with a view to the amount of profits. *Wilder v. Gayler*, 1 *Blatchf.* 511.

The proper principles on which profits are to be computed against an infringer, explained, where the patent infringed was for an improved kind of fuel, and the master proceeded on the principle of charging as profits the value of the wood which, but for the use of the patented fuel, defendant must have burned. *Black v. Thorne*, 12 *Blatchf.* 20; 7 *Pat. Off. Gaz.* 176; 1 *Bann. & A. Pat. Cas.* 155.

Proper mode of computing profits determined, in a case where the master allowed the plaintiff for each article sold by defendant, the plaintiff's selling price, less cost and commission for making sales; and this was *held* erroneous because there was no proof that all who bought from defendant would have bought from plaintiff. *Buerk v. Imhaeuser*, 14 *Blatchf.* 19; 10 *Pat. Off. Gaz.* 907; 2 *Bann. & A. Pat. Gaz.* 452.

The proper mode of ascertaining the profits made by an infringer

explained ; and *held*, that in the particular case the proper inquiry was, not what saving the defendant had made by using the patented device, over the saving which he might have made if he had used any or all of various other devices, but what saving he had made directly by using the patented device. *Herring v. Gage*, 15 *Blatchf.* 124 ; 3 *Bann. & A. Pat. Cas.* 396.

An interlocutory decree directing an account of the gains, savings and advantages due to the infringement of a patent, in addition to the *profits*, and awarding *costs*, was *held* proper. *Coburn v. Schroeder*, 8 *Fed. Rep'r*, 521 ; 19 *Blatchf.* 493 ; 20 *Pat. Off. Gaz.* 1085 ; 12 *Rep'r*, 389.

In a former action against the maker of the infringing machine, there was a stipulation "that the amount of recovery to be adjudged against the defendants in case of a decree for complainant shall be fixed and determined upon the evidence in the case submitted at final hearing, and both parties request the court, in case of a decision against the defendant, to fix, as the amount of recovery, such amount of damages as is proved by such testimony." It was *held*,

1. The court, by giving nominal damages in the absence of proof, did not thereby adjudge in that case that one dollar was the value of the invention.

2. The amount of damages to be recovered against the user of the infringing machine was the profit which the plaintiff ordinarily received on the sale of a machine of the same size, using the patent so infringed; if such profits could not be ascertained, they could not be recovered. *Blake v. Greenwood Cemetery*, 16 *Fed. Rep'r*, 676 ; 25 *Pat. Off. Gaz.* 89 ; 15 *Rep'r*, 741.

Plaintiff was the owner of a patented improvement in trunks, which consisted in covering the frame of the trunk with narrow strips of wood, laid in close proximity to each other, all around its top and sides. Defendant infringed by manufacturing and selling trunks containing the patented covering. It was *held*, that plaintiff could not recover the net profits made by defendant in the manufacture and sale of the entire trunk, but was limited to such as were properly attributable to his improvement. A proper method of estimating damages would be to take the profits made by the defendant upon one of these trunks, and deduct from them the profits upon an ordinary trunk of similar size and general description. The difference might be properly credited to plaintiff's invention. *Maier v. Brown*, 17 *Fed. Rep'r*, 736 ; 16 *Rep'r*, 585 ; 10 *Biss.* 546.

Where Congress consent to an action "for damages occasioned by the annulment" of the claimant's contract, "and also for the use of said Nock's patent in the manufacture of mail locks subsequent to such annulment," the claimant may recover the profits which he would have made under his contract as manufacturer, or a royalty under the patent; but he cannot have both. Damages for the use of his patent are included in his profits as manufacturer. *Nock v. United States*, 2 *Ct. of Cl.* 451.

Various principles governing the estimate and allowance of profits against a corporation found chargeable with infringement; and the computation of expenses of manufacture which the corporation is entitled to have deducted from the gross prices realized from sales, explained. *Steam Stone Cutter Co. v. Windsor Manuf. Co.*, 17 *Blatchf.* 24; 4 *Bann. & A. Pat. Cas.* 445.

How profits are to be ascertained, in cases when they may be allowed, are determined, with references to the circumstances of particular cases. *Wilbur v. Beecher*, 2 *Blatchf.* 132, 143; *Tatham v. Lowber*, 4 *Blatchf.* 86; *Marsh v. Warren*, 14 *Blatchf.* 265; *Bigelow Carpet Co. v. Dobson*, 10 *Fed. Rep'r.*, 385; 13 *Rep'r.*, 265; *Kendrick v. Emmons*, 15 *Pat. Off. Gaz.* 966.

240. *Effect of Recovery and Payment of Damages.*

The recovery of a verdict by the plaintiff, in an action for infringement, does not pass any legal right to the defendant to use the machine made by him. Every future use will be an infringement of the plaintiff's patent. *Whittemore v. Cutter*, 1 *Gall.* 478, 484. S. P., *Suffolk Co. v. Hayden*, 3 *Wall.* 315. But compare *Sickels v. Borden*, 3 *Blatchf.* 535.

When a patentee gets his remuneration by the sale of his patented machine for use by others, a recovery of profits and damages from the manufacturer of an infringing machine, followed by payment, is a full compensation for his injury, and places him in the same position as if he had made and sold the machine himself; and confers on defendant the right to use the machine while it lasts. The patentee has obtained all that the law gives him, and the particular article or machine becomes, in effect, licensed by the patentee. *Perrigo v. Spaulding*, 13 *Blatchf.* 389; 12 *Pat. Off. Gaz.* 352; 2 *Bann. & A. Pat. Cas.* 348. S. P., *Booth v. Seevers*, 19 *Pat. Off. Gaz.* 1140; *Spaulding v. Page*, 1 *Sawyer*, 702; 4 *Fish. Pat. Cas.* 461; 4 *Am. L. T. U. S. Cts.* 166.

When a patentee gets his remuneration in the exclusive use of his machine and the sale of its products, a recovery will not give the infringer any right to the further use of the infringing machine. *Ib.*

The damages recovered in a suit for infringement are merely a satisfaction for prior use, and do not free the parties infringing from the operation of the patent. *Matthews v. Spangenberg*, 23 *Pat. Off. Gaz.* 1624 ; 15 *Fed. Rep'r*, 813.

The recovery of nominal damages in an action for infringement of a patent, and the tender of such sum by the maker of the machine so infringing, do not operate as a license to the maker or his vendees as to existing infringing machines so made, nor as a bar to a recovery in another action against a subsequent user of the same machine. *Blake v. Greenwood Cemetery*, 16 *Fed. Rep'r*, 676 ; 25 *Pat. Off. Gaz.* 89 ; 15 *Rep'r*, 741.

A party who has elected to take judgment for profits in an action for damages for infringement of a patent, which judgment has not been reversed, cannot prosecute a second action for other damages arising out of the same acts of infringement. For a single wrong, the damages for which are capable of ascertainment, and which is not in the nature of a continuing nuisance or trespass, only one action will lie, and the damages must be assessed once for all. *Child v. Boston, &c. Iron Works*, 19 *Fed. Rep'r*, 258.

The owner of a patent who, in an action against an infringer who has made and sold for use machines covered by the patent, has recovered the profits of such sales, cannot afterwards recover from a purchaser of such machines profits derived by him from the use of them. *Steam Stone Cutter Co. v. Sheldon*, 22 *Blatchf.* 484 ; 21 *Fed. Rep'r*, 875.

241. *Statutory Recovery of Damages, in Equity.*

The object of the new provision in the act of July 8, 1870, § 59 (now Rev. Stat. § 4921),—that a complainant in equity may recover, in addition to the profits accounted for by defendant, the damages the complainant has sustained,—was to enable the plaintiff, by bringing a suit in equity, to recover in such suit, not only the profits made by the defendant by means of the infringement, but also the damages sustained by the plaintiff thereby. In the absence of this provision, this could not have been done. But under this provision a plaintiff cannot recover, as damages, any items which

he could not recover as damages in an action on the case. *Bancroft v. Acton*, 7 *Blatchf.* 505.

In a suit in equity for an infringement, brought before the passage of the act of 1870, both profits and damages could not be recovered. *Williams v. Leonard*, 9 *Blatchf.* 476 ; 5 *Fish. Pat. Cas.* 381.

Where a decree is entered for complainant, he may recover, in addition to the profits to be accounted for by the respondent, the damages he has sustained, and the court may, in its discretion, assess the same. Profits are to be accounted for in such case by the respondent whenever the descretal order to that effect is entered ; and if the injuries sustained by the complainant from the infringement are greater than the gains and profits realized by the respondent, then the complainant is entitled to recover compensation for the excess of the injuries beyond the amount estimated for profits of the respondent. *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356 ; 5 *Fish. Pat. Cas.* 90 ; 1 *Pat. Off. Gaz.* 91.

A suit in equity for infringement may be maintained for damages sustained from the infringement as well as for an account of profits ; but if the profits exceed the damages the former only will be allowed. And the damages must be confined to the direct and immediate consequences of the infringement, and not embrace those which are both remote and conjectural. *Buerk v. Imhaeuser*, 10 *Pat. Off. Gaz.* 907 ; 14 *Blatchf.* 19 ; 2 *Bunn. & A. Pat. Cas.* 452.

The terms "profits" and "damages," as used in the patent act, are not convertible. Damages are to be awarded "in addition" to profits. "Profits" refers to what the defendant has gained by the unlawful use of the patented invention, and "damages" to what the claimant has lost. In equity, under the existing laws, a complainant can recover both profits and damages. But the amount of the license fee fixed by the complainant is usually considered a proper compensation in damages, except in those cases where the evidence warrants an allowance of exemplary or punitive damages by reason of a wanton infringement. *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 9 *Pat. Off. Gaz.* 497.

The damages to be recovered by Rev. Stat. §§ 4917, 4921, are "actual damages," and may properly be awarded in a case where sale of an infringing device has enforced a reduction of price of plaintiff's device, even though defendant made no profits and the

defendant may have had no license fee. *Yale Lock Manuf. Co. v. Sargent*, 117 *U. S.* 536.

Where it appeared that the defendant had derived no gains profits or advantages by reason of his infringement, the complainant was *held* entitled to damages only, to be limited to the amount of the license fee established by him. *Locomotive Engine Safety Truck Co. v. Pennsylvania R. R. Co.*, 2 *Fed. Rep'r*, 677 ; 10 *Rep'r*, 39 ; 5 *Bann. & A. Pat. Cas.* 514 ; *Williams v. Rome, Watertown, &c. R. Co.*, 2 *Fed. Rep'r*, 702 ; 18 *Blatchf.* 181 ; 17 *Pat. Off. Gaz.* 1447 ; 5 *Bann. & A. Pat. Cas.* 423.

In an accounting before a master in an infringement suit, it appeared that the defendants had made no profits on the articles sold by them. It was *held*, that the complainant company could not recover as damages the profits it would have made on the articles sold by the defendants. *St. Louis Stamping Co. v. Quinby*, 5 *Bann. & A. Pat. Cas.* 275.

A court of equity has no jurisdiction of a suit to recover damages for the infringement of a patent, unless there is a valid demand in the bill for an injunction against further infringement. *Burdell v. Comstock*, 15 *Rep'r*, 742.

Profits are the net gains of the infringer from the use of the patented invention, while damages are the losses sustained by the owner in consequence of the infringement. Sometimes the profits of the infringer form the sole criterion of the actual damages sustained by the patentee, and then a report of the net gains covers the whole ground of profits and damages. In other instances it would be the duty of the master to add together the net gains of the infringer and the license fee which the patentee has fixed, and to make the aggregate the measure of the profits and damages which the wrongdoer ought to pay. *La Baw v. Hawkins*, 2 *Bann. & A. Pat. Cas.* 561.

Compensatory damages for the infringement of letters patent may be allowed in equity, notwithstanding the business of the infringer was so improvidently conducted as to yield no substantial profits. *Marsh v. Seymour*, 97 *U. S.* 348.

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. *Burdett v. Estey*, 3 *Fed. Rep'r*, 566 ; 19 *Blatchf.* 1.

Where the master reported that there were no damages and no profits, but that the use of the patent restored the salable character

of the article the defendant made, and thus saved the defendant from loss. It was *held*, that the money value of such advantage could be recovered as compensation. *Sargent v. Yale Lock Manuf. Co.*, 17 *Blatchf.* 249 ; aff'd, 117 *U. S.* 536 ; 17 *Pat. Off. Gaz.* 106 ; 4 *Bann. & A. Pat. Cas.* 579.

242. Interest.

Under the general rule that interest upon unliquidated damages is not recoverable, interest is not allowable upon profits awarded to be paid over by an infringer of a patent, to the patentee, until from date of final decree. *Mowry v. Whitney*, 14 *Wall.* 620. To same effect, *Silsby v. Foote*, 20 *How.* 378 ; rev'g 2 *Blatchf.* 260 ; *Parks v. Booth*, 102 *U. S.* 96 ; *Brady v. Atlantic Works*, 15 *Pat. Off. Gaz.* 965 ; 3 *Bann. & A. Pat. Cas.* 577 ; *Holbrook v. Small*, 17 *Pat. Off. Gaz.* 55.

As a general rule, interest on profits is not allowable. Special circumstances may, however, justify the addition of interest. *Littlefield v. Perry*, 21 *Wall.* 205.

Interest allowed, in particular cases, on the damages reported by a master for an infringement of patent. *Illinois Central R. R. Co. v. Turrill*, 110 *U. S.* 301 ; *Tatham v. Lowber*, 4 *Blatchf.* 86 ; *Burdett v. Estey*, 3 *Fed. Rep'r.* 566 ; 19 *Blatchf.* 1 ; *Steam Stone Cutter Co. v. Windsor Manuf. Co.*, 18 *Blatchf.* 47 ; 5 *Bann. & A. Pat. Cas.* 335.

Interest is properly allowable on a decree for profits on the infringement, from the time the report is in proper form for exceptions. *Turrill v. Illinois Central Ry. Co.*, 20 *Fed. Rep'r.* 912.

Interest on amounts received by infringer, and how affected by filing of a disclaimer under Rev. Stat. § 4922, considered. *Burdett v. Estey*, 5 *Bann. & A. Pat. Cas.* 308.

Interest may be allowed on damages for infringement. *May v. Fond du Lac County*, 27 *Fed. Rep'r.* 691.

243. Allowance for Counsel Fees, and other Expenses.

Counsel fees are not a proper element for the consideration of the jury in the estimation of damages, in an action for an infringement. *Teese v. Huntington*, 23 *How.* 2 ; *Phillip v. Nock*, 17 *Wall.* 460. And see *Whittemore v. Cutter*, 1 *Gall.* 429 ; *Pierson*

v. Eagle Screw Co., 3 *Story*, 402; *Stimpson v. Railroads*, 1 *Wall. Jr.* 164; *Parker v. Hulme*, 1 *Fish. Pat. Cas.* 44; 7 *West. L. J.* 429; *Simpson v. Leiper*, 2 *Whart. Dig.* 414; *Blanchard Gun-Stock Turning Factory v. Warner*, 1 *Blatchf.* 258; 272, *note* 1. To the contrary, *Boston Manuf. Co. v. Fiske*, 2 *Mas.* 119; *Parker v. Corbin*, 4 *McLean*, 462; *Allen v. Blunt*, 2 *Woodb. & M.* 121.

In an action for infringement, copies of an assignment of the patent, made by the plaintiff, being proved by the defendant for the purpose of showing that the plaintiff had not retained an interest which authorized him to recover, the charge of the copies is taxable. But a copy of the plaintiff's patent, procured by the defendant, is not taxable, as the plaintiff is bound by law to offer it in evidence. *Hathaway v. Roach*, 2 *Woodb. & M.* 63.

The expense of making or procuring models cannot be included among the taxable costs, nor can models properly be classed as "exemplifications," under the act of February 26. *Parker v. Bigler*, 1 *Fish. Pat. Cas.* 285; 14 *Leg. Intel.* 18.

Models of the invention described in the plaintiff's patent, procured by the defendant in good faith, may be included in the taxation of costs; but not other models. *Woodruff v. Barney*, 1 *Bond*, 528; 2 *Fish. Pat. Cas.* 244. Copies of patents, either that of the plaintiff or others, procured by the defendant, cannot be taxed as costs to the plaintiff. *Ib.*

A patentee is not entitled to reimbursement for counsel fees paid or expenses incurred by him, other than his taxable costs. *Parks v. Booth*, 102 *U. S.* 96; *aff'g* 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225.

Profits recoverable in a suit for infringement do not include expenses of suit. *Holbrook v. Small*, 17 *Pat. Off. Gaz.* 55; 2 *Bann. & A. Pat. Cas.* 596.

Counsel fees paid by complainant in a suit in equity for infringement of a patent are not recoverable as damages, under the act of 1870, § 55 (16 *Stat.* 206), any more than they were under the corresponding provisions of the act of 1836, § 14. *Bancroft v. Acton*, 7 *Blatchf.* 505.

XVIII. REMEDY BY INJUNCTION.

244. *Power of United States Courts to Grant Injunctions and Estimate Damages.*

The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable ; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby ; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case. *Rev. Stat. § 4921.*

245. *General Nature of the Jurisdiction to Enjoin.*

Section 7 of the act of 1836 has removed the objection to the jurisdiction in equity over infringement, that the patentee might have a remedy at law, and has conferred a jurisdiction of cases arising under the patent laws, which is exclusive. *Goodyear v. Hullihen*, 3 *Fish. Pat. Cas.* 251 ; *Smith v. Plymouth*, 4 *West. L. J.* 49. See *McMillin v. St. Louis & Mississippi Valley Transp. Co.*, 18 *Fed. Rep'r*, 260.

Although the machine may be constructed or used beyond the jurisdiction of the court, yet if the court have jurisdiction of the defendant, he may be restrained from using the machine and selling

the product. *Boyd v. McAlpine*, 3 *McLean*, 427 ; *Wilson v. Sherman*, 1 *Blatchf.* 536.

The jurisdiction of the circuit courts sitting in equity over controversies under the patent laws is not merely a jurisdiction ancillary to courts of law, but a substantive jurisdiction conferred by direct grant from Congress. *Blank v. Manufacturing Co.*, 3 *Wall. Jr.* 196 ; *Saunders v. Logan*, 2 *Pittsb.* 241 ; *Jenkins v. Greenwald*, 1 *Bond*, 126 ; 2 *Fish. Pat. Cas.* 37.

History of equity jurisdiction and of the statutes conferring it on the circuit courts, in patent cases, explained ; with special reference to the question whether an injunction suit begun after expiration of a patent can be maintained, even for the purpose of compelling an accounting. *Root v. Railway Co.*, 105 *U. S.* 189. See also *post*, note 249.

An accounting may be decreed, in a proper case, notwithstanding no right to a discovery or an injunction or other distinct head of equitable relief is shown ; as, where the patent expired pending the suit, leaving nothing in litigation but the right to an account. *Blank v. Manufacturing Co.*, 3 *Wall. Jr.* 196. To same effect, *Gottfried v. Moerlein*, 14 *Fed. Rep'r.*, 170 ; *Burdell v. Comstock*, 15 *Fed. Rep'r.*, 395.

A single infringement will not warrant a suit for an injunction ; there being no threat to continue infringing ; the remedy is by suit for damages. *Smith v. Sands*, 20 *Rep'r.*, 326.

Where the injury done to a patentee by infringement is not in the use of his invention, but in making use of it without compensating the patentee therefor, it being the interest of the patentee that his invention should be used and adopted by all, the proper remedy is not an injunction but an award of damages, viz : the price or value of a license to use it. *Sanders v. Logan*, 2 *Fish. Pat. Cas.* 167 ; 9 *Am. L. Reg.* 475 ; 2 *Pittsb.* 241.

On an injunction bill filed by a patentee, where there is no dispute as to title, a circuit court has power to refer the case to a master to take and state an account of the profits made by the defendant instead of sending it to a court of law to assess the damages. *Allen v. Blunt*, 1 *Blatchf.* 480.

As the circuit courts have jurisdiction of patent cases conferred upon them by statute, and are not confined to such jurisdiction as is ancillary to that of courts of law, the rule of the English cases that if an injunction is refused a decree for an account cannot be made, but that the plaintiff must sue at law, does not apply in this

country. *Sickles v. Gloucester Manuf. Co.*, 1 *Fish. Pat. Cas.* 222. S. P., *Sanders v. Logan*, 9 *Am. L. Reg.* 475 ; 2 *Fish. Pat. Cas.* 167 ; 2 *Pittsb.* 241.

A circuit court has power to enjoin infringement of a patent, independently of making award of any other relief thereon. *American Cotton Tie Supply Co. v. McCready*, 17 *Blatchf.* 291 ; 17 *Pat. Off. Gaz.* 565 ; 4 *Bann. & A. Pat. Cas.* 588.

If the validity of the patent has been established, or is admitted, a bill will lie for an injunction, upon well-grounded proof of an apprehended intention of the defendant to violate the patent right. Such bill is substantially a bill *quia timet*, which is an ordinary remedial process in equity. *Woodworth v. Stone*, 3 *Story*, 749.

The circuit court has jurisdiction of a suit demanding a discovery of the extent of an infringement of a patent and an account of the profits realized therefrom (as being a case arising under the patent laws), as well as of one where an injunction is asked. *Nevins v. Johnson*, 3 *Blatchf.* 80.

An injunction will issue to restrain the use of a machine differing from a patented machine only by slight and unimportant alterations which the description of the invention would naturally, if not necessarily, suggest, without the aid of much ingenuity or skill. *Gibson v. Harris*, 1 *Blatchf.* 167.

Under peculiar circumstances, where the defendant commenced his manufacture without notice of plaintiff's patent, and plaintiff had no knowledge of the infringement for a considerable time, so that there had been no fault on either side,—it was *held*, that the court should grant an injunction as to the future, and an accounting from the date of defendant's first notice of plaintiff's rights. *Merriam v. Smith*, 11 *Fed. Rep'r*, 588.

An injunction ought not to issue where the special circumstances render granting one inequitable between the parties ; as where the defendant was engaged in fulfilling a contract for the manufacture of articles containing the invention, which contract had been entered into on the understanding, on the part of the defendant, that the question between him and the plaintiff was one of compensation, and defendant was willing to make compensation. *Smith v. Sharp's Rifle Manuf. Co.*, 3 *Blatchf.* 545.

Where the court is itself satisfied that the defendants are infringing the plaintiff's rights, although the majority of experts called as witnesses are of the opinion that there is no infringement, it is its duty to grant an injunction to restrain such infringement.

Wilson v. Barnum, 1 *Wall. Jr.* 347 ; 6 *West. L. J.* 464 ; 2 *Fish. Pat. Cas.* 635.

Where the defendant, sued for an infringement, admitted the infringement but pleaded his lunacy at the time, ascertained by a commission, as a defense, it was *held*, that a perpetual injunction, accounting, and costs should be awarded the plaintiff, and that expenses incurred by the defendant by reason of his lunacy should not be deducted. *Avery v. Wilson*, 20 *Fed. Rep'r*, 856.

Injunction, in case of infringement, issues on the principle of a clear and certain right to the enjoyment of the subject in question, and an injurious interruption of that right, which on just and equitable grounds ought to be prevented. Property in a patent is as much under the protection of the law as property in land. *Cook v. Ernest*, 2 *Pat. Off. Gaz.* 89 ; 5 *Fish. Pat. Cas.* 396.

Where, on a final hearing of a bill to restrain an infringement, the court finds that the patent is valid, that the defendant is chargeable with infringing, and that the complainant is entitled to a permanent injunction, and refers the case to a master to ascertain damages, the injunction should be allowed at once ; and not suspended until the master's report comes in, unless some special reasons for that course are shown. *Potter v. Mack*, 3 *Fish. Pat. Cas.* 428. To same effect, *Parker v. Halfield*, 4 *McLean*, 61.

A court of equity should not sustain a suit to enjoin infringement, where the nature of the invention is such that there can be no profits, in a proper sense of the term, of which an account can be decreed ; but the limit of the injury for the use of the invention must necessarily be the value of the license fee ; for here the patentee has a full, speedy, complete and adequate remedy at law. *Vaughan v. Central Pacific R. R. Co.*, 4 *Sawyer*, 280.

246. *Various Relief obtainable in Equity.*

Where, upon trial, the plaintiff abandons one claim of his patent and the defendant does not dispute his liability upon the other, a decree should issue against defendant. *New York Coffee Polishing Co. v. Wilson*, 2 *Fed. Rep'r*, 904.

After a decree against an infringer he cannot be restrained from paying the proceeds of the decree by the suit of a third party, seeking to recover them, where the party claims title to the patent

adversely to the plaintiff in the original suit. *Secombe v. Campbell*, 5 *Fed. Rep'r*, 804 ; 10 *Rep'r*, 686 ; 5 *Bann. & A. Pat. Cas.* 632.

A bill in equity cannot be maintained in behalf of an individual patentee to procure an adjudication that his patent does not interfere with a patent previously granted to another person for an invention apparently similar. Such a bill would be in effect a suit to limit the operation of the earlier patent. A suit of this description can be brought only by the attorney-general in the name of the United States. *Celluloid Manuf. Co. v. Goodyear Dental Vulcanite Co.*, 10 *Pat. Off. Gaz.* 41 ; 13 *Blatchf.* 375 ; 2 *Bann. & A. Pat. Cas.* 334. The jurisdiction granted by the patent laws to the courts to entertain suits in equity brought in behalf of patentees can be exercised only in protecting the right of a patentee to exclude other persons from manufacturing or selling the thing covered by his patent. Presumably every patentee has the right to maintain such a suit against any infringer of his patent. *Ib.*

Where the plaintiffs in a bill for infringements have obtained a decree for an account, and have commenced suits in the courts of other districts for like infringements, the court may, on motion, stay the accounting in the original suit, as to any matters which the plaintiffs have precluded themselves from recovering in it by equitable proceedings. But the court will not, on mere motion, enjoin the plaintiffs from prosecuting suits which they have commenced before other courts, for the recovery of damages such as they are endeavoring to obtain in the suit pending before it, especially after the plaintiffs have been allowed to proceed so far in the foreign suits as to commence taking accounts. *Rumford Chemical Works v. Hecker*, 5 *Pat. Off. Gaz.* 644 ; 5 *Fish. Pat. Cas.* 629.

Where an injunction was obtained, in a suit for license fees, upon condition that the disputed fees should be deposited in court, it was *held*, upon an application by each party to have the fund paid over to him, that though the money belonged to complainant, yet the protection he had received from the court gave the defendant an equitable lien upon the same, and hence, it would be retained until the final determination of the controversy. *Florence Sewing Machine Co. v. Singer Manuf. Co.*, 4 *Fish. Pat. Cas.* 348.

Where a bill discloses an agreement by which the defendants were to report monthly the number of machines made under their license to manufacture and sell, and a covenant not to make machines, except of a certain description, and not to dispute the validity of the patents mentioned in the license ; and that the

defendants had violated all their agreements in these particulars, clear case is established for the interposition of a court of equity. The covenant to make monthly reports is, in fact, a covenant for a monthly discovery by defendants of the work done by them under the complainant's patents. Where the licenses do not give an unlimited use of any of the patents, but only a restricted right to make machines of certain sizes and descriptions, if the licensees make machines not in conformity to these licenses, they violate, not only their express covenant not to do so, but also the licensor's patents, or some of them, covering such machines. *Pope Manuf. Co. v. Owsley*, 27 *Fed. Rep'r*, 100.

Equity cannot entertain a bill for an accounting of royalties under a license, upon allegations that the patentee does not know the number of machines which defendant has sold under the license and therefore cannot collect the royalties at law. *Crandall v. Piano Manuf. Co.*, 20 *Rep'r*, 237.

To show that a decree has been recovered against a manufacturer, for infringing, does not constitute a defense in favor of one who purchased from him, although such decree included defendant's machine. Satisfaction of the decree must be shown. *Fisher v. Consolidated Amador Mine Co.*, 20 *Rep'r*, 452.

247. *Suit to Annul a Patent on the Ground of Interference.*

Jurisdiction of United States courts in equity to adjudge a patent void because of interfering with an earlier one does not rest wholly on their general equity jurisdiction, but is supported by *Rev. Stat.* § 4918. See *ante*, p. 213. Such a suit is not, however, treated as a mere statutory remedy, it is an adversary suit, to be commenced by service of process; though no specific provision of law is made whereby a person who is not an inhabitant of and cannot be served within the district in which such suit has been brought, can be brought in as defendant. *Liggett, &c. Tobacco Co. v. Miller*, 1 *Fed. Rep'r*, 203; 1 *McCrary*, 31; 17 *Pat. Off. Gaz.* 798; 5 *Bann. & A. Pat. Cas.* 237.

A preliminary injunction may be issued in an interference suit; it is authorized by the general principles of equity, though not

expressly mentioned in section 4918. *Potter v. Dixon*, 5 *Blatchf.* 160.

The suit thus authorized raises only the question of relative priority of the competing inventions (*Lockwood v. Cleaveland*, 20 *Fed. Rep'r*, 164); if the defendant concedes that plaintiff's patent is first in date, he cannot prevail by attacking that patent for want of novelty (*Pentlarge v. Pentlarge*, 19 *Fed. Rep'r*, 817); either by plea or answer (*Pentlarge v. Pentlarge*, 22 *Blatchf.* 10); still less may he deny that either party was the first inventor; see *Greenwood v. Bracher*, 5 *Bann. & A. Pat. Cas.* 302; 1 *Fed. Rep'r*, 856; 17 *Pat. Off. Gaz.* 1151.

A decree dismissing a bill seeking relief under section 4918 is not conclusive in a subsequent suit; the decree must be such as asserts the interference of the patents and declares one of them void. *Tyler v. Hyde*, 2 *Blatchf.* 310.

A cross bill is not required in these suits in order to enable defendant to have the affirmative relief of a decree annulling the complainant's patent. *Lockwood v. Cleaveland*, 6 *Fed. Rep'r*, 721.

After a decision by the commissioner of patents in an interference proceeding awarding letters patent to an inventor whose application was filed subsequently to that of another applicant, who had obtained letters patent covering the invention in controversy, priority of invention constitutes the material issue between the parties, when the defeated party files his bill in equity to have the patent of his adversary declared void. *Sawyer v. Massey*, 25 *Fed. Rep'r*, 144.

The substantial question on an interference is as to the identity of the two inventions, in principle. *Tyson v. Rankin*, 1 *MacArthur Pat. Cas.* 262.

The court has authority to adjudge either of the interfering patents void in whole or in part, or may, upon proper issues and proof, decree that both patents are void. *Foster v. Lindsay*, 3 *Dill.* 126; 2 *Bann. & A. Pat. Cas.* 172. But see 19 *Fed. Rep'r*, 817; 22 *Blatchf.* 11; 20 *Fed. Rep'r*, 164; 6 *Id.* 721; *contra*.

Where two patents have been issued, each claiming, broadly, the same invention, and the earlier patentee is adjudged 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. General evidence that the patentee in the junior patent applied for it with such

knowledge of the invention as would debar him from obtaining a patent, may be received as warranting the court in declaring the junior patent null. *Hutchinson v. Everett*, 26 *Fed. Rep'r*, 531.

248. *Necessity of Establishing Plaintiff's Title by Action at Law, before Resorting to Equity.*

A circuit court may entertain a bill to restrain infringements of a patent, without waiting until a trial at law establishing the validity of the patent, has been had. *Cochrane v. Deener*, 94 *U. S.* 780; *Goodyear v. Gloucester Manuf. Co.*, 3 *Wall. Jr.* 196; *Sickels v. Mitchell*, 3 *Blatchf.* 548; *Goodyear v. Day*, 2 *Wall. Jr.* 283; *Sanders v. Logan*, 2 *Pittsb.* 241; 2 *Fish. Pat. Cas.* 167; 9 *Am. L. Reg.* 475; *McMillin v. Barclay*, 4 *Brews.* 275; 3 *Pittsb.* 377; 5 *Fish. Pat. Cas.* 189.

The courts of the United States are authorized to take up a patent, and, upon final hearing, to pass upon it, without reference to the fact whether it has been before a jury or not. *Doughty v. West*, 2 *Fish. Pat. Cas.* 553.

The supreme court of the District of Columbia has the same power in this respect as the circuit courts. *Cochrane v. Deener*, 94 *U. S.* 780.

The former rule that the circuit courts would interfere in aid of a patentee only where his patent had been established by long acquiescence, or by a trial at law, is now relaxed. The current of decisions of the last few years has been that the grant of jurisdiction is as full in equity as it is at law. *Sanders v. Logan*, 2 *Fish. Pat. Cas.* 167; *Hoffheins v. Brandt*, 3 *Fish. Pat. Cas.* 218; *Shelly v. Brannan*, 4 *Id.* 198. See *Buchanan v. Howland*, 2 *Fish. Pat. Cas.* 341.

It appeared on the final hearing on pleadings and proofs, of a suit in equity for an injunction and an account, that the bill was filed within three months after the issuing of the patent, that the defendant denied the infringement and the novelty of the invention, and that there had been no trial at law. It did not appear that there had been any exclusive possession under the patent, or any public acquiescence in the exclusive right of the patentee. Objections were made to the sufficiency of the specification, and the evidence on the question of infringement was indefinite and unsatisfactory. The court, under the circumstances, ordered the

cause to stand over a sufficient time for the bringing of a suit at law against the defendant for an infringement. *Muscan Hair Manuf. Co. v. American Hair Manuf. Co.*, 4 *Blatchf.* 174 ; 1 *Fish. Pat. Cas.* 320.

Even after the validity of a patent has been established in a suit, it may be shown in another suit on the patent against another defendant, or on a motion for a preliminary injunction, that the right claimed by the plaintiff in the new suit was not, either as to its nature or its extent, fairly in controversy in the former suit, or that there are relevant matters not considered in the former suit. *Page v. Holmes Burglar Alarm Tel. Co.*, 2 *Fed. Rep'r*, 330 ; 18 *Blatchf.* 118 ; 9 *Rep'r*, 775 ; 5 *Bann. & A. Pat. Cas.* 439.

For some decisions recognizing the former rule requiring an adjudication of the right, at law, before equity would act on a bill for an injunction, most of which cases, however, were rendered many years ago, see *Orr v. Merrill*, 1 *Woodb. & M.* 376 ; *Day v. Hartshorn*, 3 *Fish. Pat. Cas.* 32 ; *Thomas v. Weeks*, 2 *Paine*, 92 ; *Pentlarge v. Pentlarge*, 14 *Rep'r*, 579 ; 22 *Blatchf.* 10.

219. *Or of showing long Possession and Public Acquiescence.*

For many years before the jurisdiction of the circuit courts to entertain a bill for an injunction without awaiting a trial at law was established as firmly as it now is by the cases cited in the preceding note, there was a large body of decisions holding if there had been an exclusive possession of some duration, and without serious dispute, of the rights of a patentee, under a patent, such claim and public acquiescence would warrant a court of equity in granting an injunction without requiring the holder of the patent to first establish his right at law. *Washburn v. Gould*, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L. Rep'r*, 276 ; *Orr v. Littlefield*, 1 *Woodb. & M.* 13 ; 8 *L. Rep'r*, 314 ; *Sullivan v. Redfield*, 1 *Paine*, 441 ; *Ogle v. Ege*, 4 *Wash.* 584 ; *Foster v. Moore*, 1 *Curt.* 279 ; *Sargent v. Seagrave*, 2 *Curt.* 553 ; *Miller v. Androscoggin Pulp Co.*, 5 *Fish. Pat. Cas.* 340.

Injunctions in patent right cases are granted without a previous trial at law, in cases where the owner of a patent shows a clear case of infringement and has been in the possession and enjoyment of the exclusive right for a term of years without any successful

impeachment of its validity. Such possession and enjoyment, aided by the presumptions arising from the patent itself, are sufficient to warrant an injunction to restrain infringement. There is no fixed rule as to the length of time the possession and enjoyment of the right under the patent shall have continued. It must be sufficient to justify a presumption in favor of the validity of the patent. *Potter v. Muller*, 2 *Fish. Pat. Cas.* 465.

It is not possible to fix any term of years during which the exclusive possession must have continued in order to entitle the proprietor to a provisional injunction. Each case must depend upon its own circumstances,—*e. g.*, the extent of the use or sales by the patentee, the degree of the utility of the invention, and the number of persons whose business is affected by it, and who are interested to question the exclusive right, and the completeness of the acquiescence under it. *Foster v. Moore*, 1 *Curt.* 279 ; *Sargent v. Seagrave*, 2 *Curt.* 553.

The acquiescence of the public in the use by the patentee of his invention before applying for a patent is entitled to more or less weight, according to the degree of the utility of the machine, and the number of persons whose trade or business is affected by it. An exclusive possession of about eight years, under a patent for a useful machine which affected the trade and business of large numbers of persons ; many of such machines having been constructed and put in operation in different States, was *held* sufficient. *Foster v. Moore*, *supra*.

The sale of an invention, and its use by the inventor and his vendors, is sufficient evidence of an exclusive possession by claim and color of title, to entitle him to be protected in the continued enjoyment, whatever doubts may exist as to the validity of the patent. *Cooper v. Matthews*, 8 *L. Rep'r*, 413, 419.

Long possession and use under one patent and recoveries upon it will not inure in favor of another patent, as to which an injunction is asked, even though the two patents are very useful and necessary for each other, unless there is some connection in law between them, or one is auxiliary to or part of the other. *Hovey v. Stevens*, 1 *Woodb. & M.* 290.

To entitle a patentee to the extraordinary writ of injunction, it is not sufficient for him merely to show his patent and infringement of it. His right must be further substantiated, either by a possession accompanied by an actual use and enjoyment of the right for a sufficient length of time to afford a reasonable presumption of the

acquiescence of the public in its validity, or, by a judgment in his favor in a trial at law. *Brown v. Hinkley*, 3 *Pat. Off. Gaz.* 384 ; 6 *Fish. Pat. Cas.* 370.

On an application for an injunction against the infringement of a patent, the bill should show, either that the validity of the patent has been established in an action at law, or that the right of the complainant under the patent has been recognized and acquiesced in by long unquestioned use and enjoyment, or other equivalent acts. *Gutta-percha Co. v. Goodyear Co.*, 3 *Sawyer*, 542 ; 2 *Bann. & A. Pat. Cas.* 212.

A court of equity will not grant an injunction to restrain a party using, and in possession of, an invention, where he has been so for a long time, and under color of right. *Hall v. Speer*, 1 *Pittsb.* 513.

250. *Effect of Expiration of Patent on the Jurisdiction of Equity.*

A circuit court has not jurisdiction, upon a bill filed after the expiration of a patent, to ascertain a past infringement, and decree an accounting of profits, unless the bill shows citizenship of parties in different States, or the existence of some special ground of equitable jurisdiction, or that complainant has not an adequate remedy at law. The fiction that the infringer holds the profits he has realized, as a trustee for the patentee, will not support the suit. *Root v. Railway Co.*, 105 *U. S.* 189 ;* *Lord v. Whitehead, &c. Machine Co.*, 24 *Fed. Rep'r*, 801 ; 3 *Pat. Off. Gaz.* 498 ; *Vaughan v. Cen-*

* Before the decision of the Supreme Court in *Root v. Railway Co.*, 105 *U. S.* 189, there appears to have been some conflict of opinion in the circuit courts, as to whether a suit for a discovery and account of profits could be maintained, after the expiration of the patent had terminated the right to an injunction. The preponderance of authority, however, was that the jurisdiction of equity continued. *Howes v. Nute*, 4 *Fish. Pat. Cas.* 263 ; 4 *Cliff.* 173 ; *McComb v. Beard*, 10

Blatch. 350, 361 ; *Smith v. Baker*, 5 *Pat. Off. Gaz.* 496 ; *Nevins v. Johnson*, 3 *Blatch.* 80 ; *Gordon v. Anthony*, 16 *Pat. Off. Gaz.* 1135 ; *Atwood v. Portland Co.*, 10 *Fed. Rep'r*, 283 ; 5 *Bann. & A. Pat. Cas.* 533 ; *Stevens v. Kansas Pacific Ry. Co.*, 5 *Dill.* 486. *S. P.*, *Sayles v. Dubuque & Sioux City R. R. Co.*, *Id.* 561.

But see *Draper v. Hudson*, 1 *Holmes*, 208 ; *Sayles v. Richmond & Fredericksburgh R. R. Co.*, 4 *Bann. & A. Pat. Cas.* 239 ; 7 *Rep'r*, 743.

tral Pacific R. R. Co., 4 *Swoyer*, 280; *Burdell v. Comstock*, 15 *Fed. Rep'r*, 395; *Davis v. Smith*, 19 *Fed. Rep'r*, 823.

Where the assignee of damages for an infringement has an adequate remedy at law for an infringement of the patent which expired before the assignment was made, a demurrer to a bill will be sustained; without prejudice to a suit at law for damages. *Hayward v. Andrews*, 12 *Fed. Rep'r*, 786; *aff'd*, 106 *U. S.* 672.

Equity will not refuse to entertain a bill for an injunction and account, merely because the patent is about to expire, unless the time it has to run is so short as to show that the bill was a mere device to oust the common law jurisdiction. *Dick v. Struthers*, 25 *Rep'r*, 103.

Where a bill in equity, alleging infringement of a patent and praying for an injunction and an account was filed only five days before the expiration of the patent and no effort was made to obtain an injunction, it was *held* that the court never acquired jurisdiction. *Burdell v. Comstock*, 15 *Fed. Rep'r*, 395.

The intricacy of the accounting claimed is not ground for jurisdiction of equity over infringements of a patent expired. *Lord v. Whitehead & Atherton Machine Co.*, 24 *Fed. Rep'r*, 801.

Bills were filed about a month before an extended term of a patent expired, one of them seeking to recover for infringements during the original term, the other for those during the extended term. It was *held*, that the court had no jurisdiction of the bill relating to the original term; but, that as there were grounds of equitable relief for the bill for the extended term, at the time when it was filed, and there was nothing to show that the suit was a mere desire to transfer the jurisdiction of law to equity, by commencing suit at this late day, the court did not lose jurisdiction by expiration of the patent. *Adams v. Bridgewater Iron Co.*, 26 *Fed. Rep'r*, 324; 34 *Pat. Off. Gaz.* 1045. S. P., *Gottfried v. Moerlein*, 14 *Fed. Rep'r*, 170.

An injunction against an infringing machine, made during the life of the patent, will continue in force after the expiration of the patent. But an injunction will not issue against the use of a patented device, after the expiration of the term of the patent, upon a bill which does not allege that defendant is using machines made during the term of the patent and infringing it, or that the complainant fears such use. *American Diamond Rock Boring Co. v. Rutland Marble Co.*, 2 *Fed. Rep'r*, 355; 1 *Blatchf.* 146; 5 *Bann. & A. Pat. Cas.* 346.

Although a patent has expired, and the device covered by it can be used only in connection with other devices embraced in a patent still in life, the latter cannot be used without the consent of the patentee, though in connection with the first. *Wheeler v. McCormick*, 4 *Pat. Off. Gaz.* 692 ; 11 *Blatchf.* 334 ; 6 *Fish. Pat. Cas.* 551.

There is a broad distinction between the use of an invention and the use of a patented machine. While the right to use the invention expires with the end of the term of the original patent, the right to the continued use of the machine, which embodies it, is protected. *Wetherill v. Passaic Zinc Co.*, 6 *Fish. Pat. Cas.* 50 ; 16 *Int. Rev. Rec.* 156 ; 2 *Pat. Off. Gaz.* 471 ; 9 *Phila.* 385.

Courts of equity are authorized to grant an injunction after the expiration of a patent, to prevent the sale of articles manufactured during its life. *New York Belting & Packing Co. v. Magowan*, 27 *Fed. Rep'r.*, 111 ; 34 *Pat. Off. Gaz.* 1278.

A bill in equity filed more than a year after the expiration of a patent cannot be sustained, merely because it seeks relief by way of injunction, against the use or sale by the defendants of articles embodying the patented invention, should any be found in their possession, and also against the use of the tools and paraphernalia of infringement made during the life of the patent, for the purpose of infringement. *Consolidated Safety Valve Co. v. Ashton Valve Co.*, 26 *Med. Rep'r.*, 319.

In a suit in equity for infringement of a patent, a preliminary injunction against the defendants was denied, but they were required to give bond and make a monthly statement, under oath, of their sale. Before a final decision on the merits, the patent expired. It was *held*, that under the circumstances, a decree in favor of the complainants should include an injunction against the defendants using or selling the infringing articles manufactured by them during the life of the patent. *New York Belting & Packing Co. v. Magowan*, 27 *Fed. Rep'r.*, 111 ; 34 *Pat. Off. Gaz.* 1278.

251. *Effect of Expiration in Particular Instances.*

A., to whom letters-patent had been assigned, filed, after their expiration, which took place July 6, 1873, his bill against B., charging that the latter had during their term infringed them by using the patented invention, whereby he realized gains, profits and

savings, which he should be compelled to account for and pay to the complainant. The bill was, on demurrer, dismissed. It was *held*, that the decree below was proper, the bill being merely for an account of profits and damages against an infringer, and it not appearing from the case thereby made that any ground of equitable jurisdiction existed, or that A. had not a complete remedy at law whereby damages for the wrongs complained of could be recovered. History and limits of the jurisdiction explained. *Root v. Railway Co.*, 105 *U. S.* 189.

A bill was sustained, under the circumstances of the case, notwithstanding the patent had expired, on the ground that it was not necessarily to be treated as a bill for infringement, but might be deemed founded on an agreement proved between the parties, and which amounted to an executed license ; and that, viewed in this aspect, the bill was not open to the objection that there was a complete and adequate remedy at law, because an account and a discovery were necessary to ascertain the facts from which the damages to the plaintiffs could be computed, and the bill was a bill for an account and a discovery. *Magic Ruffle Co. v. Elm City Co.*, 13 *Blatchf.* 151 ; 8 *Pat. Off. Gaz.* 773.

After a bill in equity had been filed for the infringement, the patent was surrendered, and a reissued patent was granted. The plaintiff then moved for leave to file a supplemental bill founded on the reissued patent and for an injunction. It was *held*, that the motions must be denied, on the ground that, by the surrender and reissue, the suit was at an end, and that the plaintiff must proceed by original bill founded on the reissued patent. *Fry v. Quinlan*, 13 *Blatchf.* 205. To same effect, *Jones v. Barker*, 11 *Fed. Rep'r*, 597 ; 22 *Pat. Off. Gaz.* 771.

Filley invented and patented a new stove, known as the "Charter Oak ;" but for a long time allowed Jacobus to make and sell it, and to use that name. It was *held*, that he could not, after the patent expired, have an injunction to forbid Jacobus from continuing the sale under the name "Charter Oak," so long as the latter did not represent the stoves he sold as having been made by Filley. *Filley v. Child*, 16 *Pat. Off. Gaz.* 261 ; 16 *Blatchf.* 376 ; 4 *Bann. & A. Pat. Cas.* 353.

A manufacturer of scales cannot claim protection, after expiration of his patent for scales, against another person's making scales in imitation of the form, color, &c., of those manufactured by plaintiff. Neither a patent or a trade-mark relates to the accidental

exterior appearance of such an article. The patent (while it lasted) protected only the novel, substantial mechanism; and the trademark only forbids representing defendant's article as being of the manufacture of plaintiff. *Fairbanks v. Jacobus*, 14 *Blatchf.* 337.

The use of machines made in the life-time of a patent and infringements thereof when made,—enjoined after it had expired. *Reay v. Raynor*, 19 *Fed. Rep'r*, 308; 22 *Blatchf.* 13; 26 *Pat. Off. Gaz.* 1111.

A bill in equity for infringement of a patent, asking an account of profits and damages, and an injunction, provisional and perpetual, was filed only four days before the expiration of the patent. It was *held*, that as notice of eight days of a motion for an injunction was required by the rules of the court, and no injunction could therefore be obtained, and the sole object of the bill appeared to be pecuniary compensation in the form of profits or damages, a demurrer should be sustained. *Mershon v. J. F. Pease Furnace Co.*, 24 *Fed. Rep'r*, 741; 32 *Pat. Off. Gaz.* 1011.

But where a bill, although filed only twenty-six days before the expiration of the patent, set forth that the plaintiff, having retained the exclusive right to make and sell the patented article, was exercising it, and was able to supply the market, and that defendants were making machines containing the invention, and threatened to make them in large quantities, and intended to put on the market, after the expiration of the patent, infringing machines made before it expired, and prayed an injunction restraining the sale, after as well as before the expiration of the patent, of machines unlawfully made before it expired; it was *held*, that a demurrer to the bill should be overruled. *Toledo Mower, &c. Co. v. Johnston Harvester Co.*, 24 *Fed. Rep'r*, 739; 32 *Pat. Off. Gaz.* 1010.

A bill in equity for infringement of a patent was filed May 5th, 1885, and process was served on the defendants two days afterward, but no steps were taken to secure a preliminary injunction. The patent expired June 16th, 1885. It was *held*, that a demurrer to the bill should not be sustained because of the expiration of the patent, the case being cognizable in equity at the time the bill was filed. *Dick v. Struthers*, 25 *Fed. Rep'r*, 103; 34 *Pat. Off. Gaz.* 131.

Three patents were used in one process, and therefore must be considered in connection in estimating profits. One of them had only three months to run, when the bill was filed. This was *held*

no ground for dismissing the bill. *New York Grape Sugar Co. v. Peoria Grape Sugar Co.*, 21 *Fed. Rep'r*, 878 ; 32 *Pat. Off. Gaz.* 138.

In a suit in equity for infringement of a patent, in which an injunction and accounting were sought, several changes of parties were made by amendment of the bill, by one of which the heirs at law of one of the patentees were made parties. Pending the suit, the patent expired, and not until afterwards was the administrator of the deceased patentee made a party, by a further amendment of the bill. It was *held* that the suit must be regarded as commenced when such administrator was brought in, and, the patent having then expired, a court of equity had no jurisdiction. *Hewitt v. Pennsylvania Steel Co.* 24 *Fed. Rep'r*, 367 ; 31 *Pat. Off. Gaz.* 1687.

252. *Effect of Abandonment, Acquiescence, or Delay, on the Jurisdiction.*

Equity will not interfere in behalf of patentee, either to grant an injunction, or give him any other relief in respect to an alleged violation of his patent, if, after having obtained his patent, he has dedicated it to the public, or acquiesced for a long period in the public use thereof, without objection ; in such a case his own conduct may be considered as having led to the use of the invention complained of. *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54.

A court of equity is reluctant, even when satisfied that a patent is valid, to enforce it by enjoining infringements, where the patentee is chargeable with laches in seeking relief. And this principle extends to assignees of the patent under an extension. *Goodyear v. Honsinger*, 3 *Fish. Pat. Cas.* 147 ; 2 *Biss.* 1.

Mere delay in bringing suit for infringement is not sufficient to establish an abandonment or dedication. There must be an acquiescence in the appropriation of the right, of such character as reasonably to induce the belief that the owner intended to relinquish it to the public. *Williams v. Boston & Albany R. R. Co.*, 16 *Pat. Off. Gaz.* 906 ; 17 *Blatchf.* 21 ; 4 *Bann. & A. Pat. Cas.* 441

Thus, if a patentee has neglected to file a disclaimer, in a case where he ought to do so, until after suit is brought, a court of equity will not interfere to grant a perpetual injunction, whatever

may be his right and remedy at law. *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54.

Where there were satisfactory reasons for the delay, it will be excused. Thus, where the validity of a patent was in litigation, it was *held* not laches on the part of the patentee to wait until a decision was rendered, before bringing suit against infringers. *Green v. Barney*, 19 *Fed. Rep'r*, 420. And a patentee will not be deemed to have acquiesced in the use of his invention so as to deprive him of the right to an injunction, because he first proceeded against only the more palpable and obvious violations of his patent, or because he has not brought suit against all persons infringing upon it. *Van Hook v. Pendleton*, 1 *Blatchf.* 187.

253. *Effect of Delay, &c. in Particular Instances.*

Twenty days before the expiration of a patent for a "self-raising" flour, motions for injunctions in over fifty suits, to restrain the infringement of the patent, were made. All of the suits but one were against grocers who were selling the flour. One was against a manufacturer. The patent had been sustained on final hearing in other suits, but had been much litigated, and until recently. Since then, there had been no unnecessary delay. It was *held*, that no laches could be imputed to the plaintiff. An apprehension that the grocers may fear to sell non-infringing flours, and thus cause injury to the manufacturers of such flours, was no ground for withholding injunctions against the grocers. *Rumford Chemical Works v. Vice*, 14 *Blatchf.* 179 ; 2 *Bann. & A. Pat. Cas.* 584.

Where the patentee gave prompt notice to an infringer to cease infringing, and, within two years thereafter, and before the commencement of legal proceedings, repeated the notice three times, and the business engagements of the patentee were many and pressing, and he gave no affirmative encouragement to the infringer. It was *held*, that the right to a preliminary injunction, in a case otherwise plain, would not be affected by the delay. *Collignon v. Hayes*, 8 *Fed. Rep'r*, 912 ; 20 *Pat. Off. Gaz.* 447.

Where the patentee had knowledge of the infringement for nearly two years before applying for an injunction, and had warned the defendants that they were infringers. It was *held*, that a motion for an injunction should be denied for want of diligence. *Sperry v. Ribbands*, 3 *Bann. & A. Pat. Cas.* 260 ; 1 *N. J. L. J.* 115.

The loss of a patent issued under the act of 1793, and which by that act was required to be recorded, is no excuse for delay in applying for an injunction for its infringement. A copy would be as good evidence of the right as the original, or as a new patent issued under the act of 1837. *Cooper v. Matthews*, 8 *L. Rep'r*, 413.

From a bill in equity for infringement of a patent, it appeared that the patent had been in existence for about 15 years, and that the infringement had continued 13 years; and no excuse for the delay on the part of complainant was shown. It was *held*, that a demurrer should be sustained, on the ground of laches. *McLaughlin v. People's R. Co.*, 21 *Fed. Rep'r*, 574; 29 *Pat. Off. Gaz.* 277.

Delay for more than seven years in proceeding against open infringers of complainants' patent was *held*, ground for refusing a preliminary injunction against the same parties, notwithstanding the owners of the patent had, during that time, been engaged in disputes among themselves, and in establishing their rights against other infringers. *Ladd v. Cameron*, 25 *Fed. Rep'r*, 37.

254. *Proper Persons to be Complainants in a Suit in Equity.*

Only the patentee, or an assignee of the entire and exclusive right for a specific territory can bring suit in equity for infringement. An assignee of a part only of the right, as an assignee of the right to use and sell but not to manufacture cannot sue in his own name. *Hill v. Whitecomb*, 5 *Pat. Off. Gaz.* 430; 1 *Holmes*, 317; 1 *Bann. & A. Pat. Cas.* 34.

In a suit in equity brought on letters patent for a machine, to restrain the defendant from making the patented machines and selling them to parties who buy them for exportation to and use in foreign countries, the owner of the legal title to the patent should be joined as plaintiff with the holder of the exclusive right to make and vend the patented invention for use in foreign countries. *Dorsey, &c. Rake Co. v. Bradley Manuf. Co.*, 12 *Blatchf.* 202.

In a suit for infringement, those who have a title to the patent are necessary parties; if others are joined as parties, it is not necessary to dismiss the bill, but merely strike off their names. *Edgar-ton v. Breck*, 5 *Bann. & A. Pat. Cas.* 42.

A bill to enjoin infringement, which does not join all the owners of the patent, is fatally defective; but this rule requires the joinder of only those persons to whom interests have been transferred by assignments in writing duly authenticated. *Jordan v. Dobson*, 2 *Abb. U. S.* 398; 7 *Phila.* 533.

A motion to dismiss a bill for an injunction, on the ground that complainant has parted with all his interest in the suit, will be denied if it appears that the assignment was made after the computation of profits ended. *Dean v. Mason*, 20 *How.* 198.

A patent granted to the administrator of an inventor is held by him, *prima facie*, in trust for the heirs; and they must be parties to a suit in equity on the patent, so long as they retain such an interest; if, however, the inventor sold his interest prior to his decease, the assignee must be made the party, and not the heirs. *North-western Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 6 *Pat. Off. Gaz.* 34; 10 *Phila.* 227; 1 *Bann. & A. Pat. Cas.* 177.

One of a number of joint tenants in a patent cannot enjoin the other from the use or sale of the patent; nor can the equitable owner of a patent be enjoined from using it, upon a bill filed by one holding the legal title only. *Clum v. Brewer*, 2 *Curt.* 506.

Where the legal and the equitable right to a patent are in different persons, both should join as plaintiffs in a suit in equity for an injunction and an account. *Stimpson v. Rogers*, 4 *Blatchf.* 333.

The next of kin of a patentee cannot be united with the personal representatives, as parties plaintiff in a bill to enjoin the infringement of the rights secured by the patent, and for an accounting. *Hodge v. North Missouri R. R. Co.*, 1 *Dill.* 104; 4 *Fish. Pat. Cas.* 161.

A former owner of a patent, who, in the instrument conveying it, reserved to himself the right to use and to license others to use the patented process to a certain specified extent, is not a necessary party to a suit by the person to whom he conveyed, as against third persons, to restrain infringement. *Frankfort Whisky Process Co. v. Pepper*, 26 *Fed. Rep'r*, 336.

If the owner of an equitable right or interest in a patent institute a suit in equity for his own benefit in the name of the owner of the legal title, for an injunction and an account, he will be made a co-plaintiff with the owner of the legal title upon application to the court, even after answer is filed, testimony published, and the

case is placed on the term calendar for final hearing. *Patterson v. Stapler*, 7 *Fed. Rep'r*, 210 ; 27 *Int. Rev. Rec.* 171 ; 11 *Repr.* 731.

A party alleged to have an interest in a patent sued on may disclaim all interest in favor of complainant, and thus obviate the objection that he should be joined as a party. *Graham v. Geneva Lake Crawford Manuf. Co.*, 11 *Fed. Rep'r*, 138 ; 21 *Pat. Off. Gaz.* 1536.

A bill for an infringement was founded not on the title of the original patentee, but on the derivative title of the complainant first named in the bill, to whom, as executor of the deceased inventor, the patent was reissued. It was *held* that the objection to the right of the complainants to maintain their bill, because only one of the persons named as executors in the last will and testament of the original patentee was made a party to the bill, could not be sustained ; the reissued patent, under the circumstances, was a new contract between the government and the executor, subsequent to the decease of the original patentee. *Goodyear v. Providence Rubber Co.*, 2 *Cliff.* 351 ; 2 *Fish. Pat. Cas.* 499.

A suit for an accounting of profits for infringement of a patent by a corporation cannot be sustained on behalf of parties who, as officers and managers of the corporation, were actively engaged in such infringement, but subsequently sold their stock in the corporation and purchased the patent. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 24 *Fed. Rep'r*, 604 ; 32 *Pat. Off. Gaz.* 1356.

Who is such assignee as may sue in his own name. See *Littlefield v. Perry*, 21 *Wall.* 205.

The fact that an assignee cannot sue at law in his own name does not entitle him to resort to equity. *Hayward v. Andrews*, 106 *U. S.* 672.

A patentee may maintain an action at law upon a patent, in his own name, although he is under a contract to assign it to others so long as the assignment has not been executed ; but equity regards that as already done which the patentee has agreed to do, and will require that the proposed assignees be made parties to any bill in chancery brought against infringers. If, however, the other parties to such a contract release to the patentee all their interest in the patent, he may maintain a bill in his own name for all subsequent infringements, but not for those committed previous to the release ; neither can he recover damages for any infringements committed after he has sold and assigned the patent.

Wheeler v. McCormick, 4 *Pat. Off. Gaz.* 692 ; 11 *Blatchf.* 334 ; 8 *Fish. Pat. Cas.* 551.

One who is only a licensee cannot sue in equity in his own name, but must join with him the owner of the legal title as plaintiff. *Nelson v. McMann*, 16 *Pat. Off. Gaz.* 761 ; 16 *Blatchf.* 139 ; 4 *Bann. & A. Pat. Cas.* 203.

In an equitable suit brought by a married woman in the circuit court in the district of New York for infringement, the husband need not be joined. *Lorillard v. Standard Oil Co.*, 21 *Alb. L. J.* 492.

The receiver of a corporation appointed under the law of Pennsylvania, being, by the law of that State, the mere custodian of the property of the corporation, cannot maintain in his own name a suit for infringement of a patent owned by the corporation. *Dick v. Struthers*, 25 *Fed. Rep'r*, 103 ; 20 *Rep'r*, 643

255. *Proper Persons to be Made Defendants.*

A patentee should not be joined with his licensee, as defendant in a suit for infringing an earlier patent by manufacturing and selling the licensed machine, if the patentee made defendant has no other connection with the infringement than receiving the royalty. The licensee is the party liable for his sales. *Hussey v. Bradley*, 5 *Blatchf.* 134 ; 2 *Fish. Pat. Cas.* 362.

The use of a patented machine under a license by an assignee of the license may be enjoined, where the assignee refuses to pay the tariff agreed upon as the consideration for such license ; but the assignee cannot be enjoined by reason of a default in paying the tariff happening prior to the assignment ; he is liable only for his own default. *Goodyear v. Congress Rubber Co.*, 3 *Blatchf.* 449.

In a suit for infringement the bill alleged that the defendants had "jointly and collectively, and also separately," used and sold bottle-stoppers containing the patented invention. It was *held* that although no joint sale or use was shown, yet as the bill was framed to recover for separate infringements and was not demurred to on that ground, and the case went on upon that issue, that the plaintiff could maintain the suit as a suit against each defendant separately. *Putnam v. Hollander*, 6 *Fed. Rep'r*, 882 ; 19 *Blatchf.* 48 ; 19 *Pat. Off. Gaz.* 1423.

The unauthorized use of a patent by the agent of a joint stock

association, in its business, for the benefit of its stockholders, must be considered as a use by each of them, from which each of them may be enjoined ; notwithstanding that under the laws of the State, there being more than seven shareholders, the association might have been sued as a whole by suing the president, without making all the shareholders parties. *Tyler v. Galloway*, 13 *Fed. Rep'r*, 477 ; 22 *Pat. Off. Gaz.* 1294 ; 14 *Rep'r*, 771 ; 21 *Blatchf.* 66.

256. *In what Cases Agents, Contractors, Laborers, Corporate Officers, may be Sued.*

An injunction will not be granted against a person, restraining him from using a patented machine, unless it is shown that he actually used it, or employed others to use it for him, or received profits from its use ; except that, to prevent evasions, a workman on a machine, though not interested in it, is liable to be restrained. *Woodworth v. Hall*, 1 *Woodb. & M.* 248. Later it was *held*, in the same district, that a decree for an account cannot be had against a mere workman, who has been instrumental, while in the employment of another, in the infringement ; he having had nothing to do with the profits. *Sargent v. Larned*, 2 *Curt.* 340. Where a person runs a machine which others own, and which machine is a violation of a patent, an injunction may issue against all for the violation. *Woodworth v. Edwards*, 3 *Woodb. & M.* 120.

When contractors laid, for a city, a pavement which infringed the patent of N. ; and the city paid them as much therefor as it would have had to pay him had he constructed the improvement, it was *held*, in a suit in equity, to recover profits, brought against the city and the contractors, that the latter alone were responsible. The city might have been enjoined before the completion of the work, and perhaps would have been liable in an action for damages ; but it was not chargeable for profits, because it had not realized any ; the profits had inured to the benefit of the contractors. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

The directors of a manufacturing corporation, who manage and superintend its business, and under whose direction it manufactures and sells articles which are an infringement of a patent, and its agents, who conduct its business of selling such articles, are responsible for such infringement, and may be joined as defendants in an injunction suit. *Goodyear v. Phelps*, 3 *Blatchf.* 91. So an officer

of a corporation owning a patent, who has personally executed an agreement on behalf of the corporation, a third person to furnish the infringing machines under a tariff as rent, is a proper defendant to a suit to restrain such manufacture, brought on the ground that it is an infringement of a prior patent owned by the complainant. *Nichols v. Pearce*, 7 *Blatchf.* 5. But see a case where officers were *held* not liable for royalty, where they had derived no personal benefit, and had acted in good faith (*Phillips v. Detroit*, 16 *Pat. Off. Gaz.* 627); and a case where corporate officers were *held* liable, because they refused to disclose to the patentee the names of the persons really responsible. *American Cotton Tie Supply Co. v. McCready*, 17 *Blatchf.* 291 ; 17 *Pat. Off. Gaz.* 565 ; 4 *Bann. & A. Pat. Cas.* 588.

The fact that a defendant who has sold an article which infringes on a patent, sold it on behalf of its owner, and had no interest in it or its sale, is no ground for refusing to grant an injunction against him. *Maltby v. Bobo*, 14 *Blatchf.* 53 ; 2 *Bann. & A. Pat. Cas.* 459.

A man worked for the defendant by the piece, in the defendant's manufactory, and there used, in the defendant's business, folding-guides, his own property, which infringed the plaintiff's patent. It was *held*, in a suit in equity, that the defendant had infringed the patent. *Wooster v. Marks*, 17 *Blatchf.* 368 ; 9 *Rep'r.* 201 ; 5 *Bann. & A. Pat. Cas.* 56.

An employee may be liable to account for the commissions derived by him from the sale of infringing goods, and may be enjoined from making any further sales. And a suit against the employer, brought in another district, for such sales, cannot be pleaded in bar to a suit against such employee for an account and injunction. *Steiger v. Heidleberger*, 4 *Fed. Rep'r.* 455 ; 18 *Blatchf.* 426 ; 18 *Pat. Off. Gaz.* 1463 ; 11 *Rep'r.* 212.

An assignment of the revenues of a railroad to a preferred creditor, and the use, by the assignee, of cars which have patented brakes attached to them, does not render him liable to account for infringement of the patent, if the brakes had been licensed to the company ; the assignee uses the brakes as agent of the company, not as purchaser. *Emigh v. Chamberlain*, 1 *Biss.* 367 ; 2 *Fish. Pat. Cas.* 192 ; 1 *Am. L. Reg. N. S.* 207.

In a suit for infringement of a patent, against a corporation, its president, L., and another, the subpoena was not served on L., but a solicitor appeared for the defendants, without naming them, and

their answer was sworn to by L. as one of the defendants and signed by his individual name. It was *held*, that he had become personally a party, so that a decree for relief asked in the bill against him personally might properly be made. *Lewis v. Standard Laundry Machinery Co.*, 21 *Blatchf.* 184.

A bill for a discovery may be maintained, in aid of an action at law for damages for infringement of a patent, against a corporation as defendant, without making its officers parties. That similar relief could be obtained by the complainant in his action at law under the local practice, does not deprive the court of its equitable jurisdiction to compel a discovery in such cases. *Colgate v. Compagnie Francaise du Telegraphe*, 23 *Fed. Rep'r*, 82.

A son, who is employed in the shop of his father as superintendent, having no interest in the business, is not liable for an infringement of a patent, merely because the infringing machine is used in the shop under his direction. *McDonald v. Whitney*, 24 *Fed. Rep'r*, 600 ; 32 *Pat. Off. Gaz.* 1465.

257. *The Right to a Preliminary Injunction in General.*

To entitle complainant in equity to the remedy of a preliminary injunction, his title by the patent, and the proof of infringement by defendant must be free from doubt. *Marks v. Corn*, 11 *Fed. Rep'r*, 900 ; 23 *Pat. Off. Gaz.* 94 ; *Steam Gauge, &c. Co. v. Miller*, 11 *Fed. Rep'r*, 718 ; *Steam Gauge & Lantern Co. v. Miller*, 8 *Fed. Rep'r*, 314 ; 20 *Pat. Off. Gaz.* 889 ; *Bradley, &c. Manuf. Co. v. Charles Parker Co.*, 17 *Fed. Rep'r*, 240 ; 24 *Pat. Off. Gaz.* 995 ; *Illingworth v. Spaulding*, 9 *Fed. Rep'r*, 154 ; 12 *Rep'r*, 354. See *Isaacs v. Cooper*, 4 *Wash.* 259 ; *Woodworth v. Hall*, 1 *Woodb. & M.* 248 ; *Id.* 389 ; 6 *Pa. L. J.* 178.

The mere fact that the complainant has obtained a patent is not enough, standing alone, to entitle him to an injunction, before a hearing upon the merits. *Orr v. Littlefield*, 1 *Woodb. & M.* 13 · 8 *L. Rep'r*, 314.

The grant of a patent by the patent-office is not, of itself, a bar to an interlocutory injunction in favor of a person claiming to be a prior patentee of the same thing ; particularly when such person had no notice to appear and be heard at the patent-office, and the court is satisfied that the last granted patent was an interference. *Wilson v. Barnum*, 1 *Wall. Jr.* 347 ; 6 *West. L. J.* 464 ; 2 *Fish. Pat. Cas.* 635.

Where an interference between complainant and defendants' assignor was decided in favor of complainant, to whom a patent was granted, and he subsequently moved for an injunction thereon, it was *held*, that the interference proceedings did not estop defendants from setting up as a defense that the invention patented was anticipated by another device. *Peck, &c. Co. v. Lindsay*, 5 *Bann. & A. Pat. Cas.* 390. Compare *Smith v. Halkyard*, 16 *Fed. Rep'r*, 414; 23 *Pat. Off. Gaz.* 1832.

Where the commissioner of patents has granted a reissue with an expanded claim, a preliminary injunction may be awarded to restrain infringement of the patent. *Lorillard v. McDowell*, 23 *Int. Rev. Rec.* 90.

Where the validity of a patent is fully established, the plaintiff is entitled to protection by an injunction; and the fact that great injury may thereby be caused to the infringer by interrupting his business as a common carrier, even though to the inconvenience of the public, is no ground for refusing it. *Hodge v. Hudson River R. R. Co.*, 6 *Blatchf.* 165.

Where a defendant sued for infringement of plaintiff's patent shows that he is acting under a patent which has been issued to himself, an injunction before the trial should not be allowed. *Good-year v. Dunbar*, 1 *Fish. Pat. Cas.* 472.

Where the defendant has done the acts complained of under the authority of a patent, and with the knowledge of the plaintiff, and unmolested for a length of time, and has invested money in the business sought to be stopped, plaintiff is not entitled to ask a preliminary injunction; except in a case free from all reasonable doubt. *North v. Kershaw*, 4 *Blatchf.* 70.

If defendant has used the patented invention unlawfully and without making compensation, the plaintiff is not deprived of his right to a preliminary injunction by the fact that defendant has discontinued such use and disclaims any intention of resuming it. *Sickles v. Mitchell*, 3 *Blatchf.* 548; *Rumford Chemical Works v. Vice*, 14 *Blatchf.* 179; 2 *Bann. & A. Pat. Cas.* 584; *Poppenhusen v. New York Comb Co.*, 4 *Blatchf.* 184; 2 *Fish. Pat. Cas.* 79. S. P., *Buck v. McGill*, 4 *McLean*, 174; *Potter v. Crowell*, 1 *Abb. U. S.* 89; 3 *Fish. Pat. Cas.* 112. The complainant in such a case is not obliged to rest his interests on the mere asseveration of the party that he will not repeat the act of infringement. Having once been a wrongdoer, the law supposes the possibility of his being so again, and will impose the proper restraint to prevent the repetition

of the wrongful act. *Jenkins v. Greenwald*, 1 *Bond*, 126 ; 2 *Fish. Pat. Cas.* 37.

258. *The Application; how Made, and how Heard and Determined.*

In patent causes, the United States courts may, in a proper case, grant a preliminary injunction without requiring notice to be given. *Yuengling v. Johnson*, 1 *Hughes*, 607 ; 3 *Bann. & A. Pat. Cas.* 99.

Informality in the notice of motion is cured by appearance of the defendant. *Brammer v. Jones*, 3 *Fish. Pat. Cas.* 340.

To grant a motion for a preliminary injunction on a patent, on a theory, which, although it may be true, is not supported by affidavits, is not proper. *American Diamond Rock Boring Co. v. Sullivan Machine Co.*, 14 *Blatchf.* 119 ; 2 *Bann. & A. Pat. Cas.* 522.

Upon a motion for an injunction to restrain an infringement, the plaintiff should include in or subjoin to his bill a special affidavit to the truth of the allegations therein, and that he was the original and first inventor, as he believed, of the thing patented, and that the same had not been in use or described anterior to his invention. The formal oath to originality of the invention, made when applying for the patent, does not suffice, for the motion. *Rogers v. Abbott*, 4 *Wash.* 514. S. P., *Sullivan v. Redfield*, 1 *Paine*, 441.

The applicant for a preliminary injunction should state facts sufficient to allow the court to decide whether or not there has been an infringement ; his affidavit merely that there has been one is not sufficient. *Kirby Bung Manuf. Co. v. White*, 5 *Bann. & A. Pat. Cas.* 263 ; 1 *Fed. Rep'r*, 604 ; 1 *McCrary*, 155 ; 17 *Pat. Off. Gaz.* 974.

Where the bill states an exclusive possession of the invention for which the plaintiff has obtained a patent, a preliminary injunction may be granted, although the court may feel doubts as to the validity of the patent. *Issacs v. Cooper*, 4 *Wash.* 259. To nearly same effect, *Woodworth v. Hall*, 1 *Woodb. & M.* 248 ; 6 *Pa. L. J.* 178.

Under the rules of the circuit court in the second circuit, the court, or a judge out of a court, has power, on a motion for a provisional injunction where the defendant sets up a license in defense,

to permit the plaintiff to put in proofs in rebuttal of the proofs put in by the defendant ; and the order to admit such rebutting proofs, when made by the court, is regular, although not made till such rebutting proofs are received. The defendant is not entitled to reply to such rebutting proofs by further proofs on his part. *Day v. New England Car Spring Co.*, 3 *Blatchf.* 154.

On a motion for a preliminary injunction to restrain the infringement of letters patent, the court will not look further into the case than to ascertain whether or not, upon established principles of equity, the interference of the court is required to prevent an irreparable injury pending the litigation. And unless the right is clear upon the papers and proofs presented in favor of the plaintiffs, the injunction will be refused. *Sickels v. Youngs*, 3 *Blatchf.* 293.

An application for a provisional injunction, to restrain a defendant from continuing an alleged infringement of a patent owned by the complainant, is addressed to the discretion of the court. *Wyeth v. Stone*, 1 *Story*, 273, 295 ; 4 *L. Rep'r*, 54 ; *Orr v. Badger*, 7 *L. Rep'r*, 465 ; 1 *Brunner Col. Cas.* 537 ; *Forbush v. Bradford*, 21 *L. Rep'r*, 471 ; 1 *Fish. Pat. Cas.* 317 ; *Orr v. Littlefield*, 1 *Woodb. & M.* 13 ; 8 *L. Rep'r*, 314 ; *Earth Closet Co. v. Fenner*, 5 *Fish. Pat. Cas.* 15 ; *Irwin v. Dane*, 4 *Fish. Pat. Cas.* 359.

In granting injunctions against the violation of patent rights, the court proceeds according to the course and principles of courts of equity in similar cases. *Sullivan v. Redfield*, 1 *Paine.* 441.

On an application for a preliminary injunction to restrain infringements of a patent which had been reissued, and had been frequently adjudicated upon and sustained, it was *held*, that the court would not entertain questions as to the originality of the invention, or the validity of the reissued patent. *Gibson v. Betts*, 1 *Blatchf.* 163.

Although, on a motion for an injunction to restrain an infringement of letters-patent, the proofs should show that, on the trial of an issue awarded in the cause, on the question of infringement, the jury found in favor of the plaintiff, still the court will not, as a matter of course, adopt the verdict, but will examine the whole case, including the evidence given before the jury, and will grant or withhold the injunction according to its own judgment thereon. *Sickels v. Youngs*, 3 *Blatchf.* 293.

Where the answer in an infringement suit denies that the patentee was the true inventor, or denies that the defendant uses the plaintiff's invention, an injunction will be refused. *American Car-*

pet Lining Co. v. Beale, 5 *Bann. & A. Pat. Cas.* 529 ; Isaacs v. Cooper, 4 *Wash.* 259.

If the complainant's patent has been sustained in a suit to the defense of which the defendants contributed, he is entitled to a provisional injunction against them, although they allege in their answer that they have a witness to the prior use of the invention, who was not examined on the trial. *Birdsall v. Hagerstown Agricultural Implement Manuf. Co.*, 6 *Pat. Off. Gaz.* 604 ; 1 *Bann. & A. Pat. Cas.* 426.

The person who originally took out the patent will not be allowed, when sued to enjoin him from infringing it, to dispute the novelty or utility of the invention. *Onderdonk v. Fanning*, 4 *Fed. Rep'r*, 148 ; 5 *Bann. & A. Pat. Cas.* 85.

In a suit to restrain an infringement, where issues of fact are presented, supported on one side by affidavits and contradicted by affidavits on the other side, so that they neutralize each other, a motion for the allowance of such an injunction will be denied. *Beane v. Orr*, 9 *Pat. Off. Gaz.* 255.

If, on a motion for an injunction, there appears, from the affidavits of the parties or witnesses, such a repugnancy in point of fact, as makes it necessary to decide on the relative truth of their conflicting statements, or the credibility of the affirmants, the injunction will not be granted. *Cooper v. Matthews*, 8 *L. Rep'r*, 413. But where a motion for an injunction against infringement rests upon affidavits of dealers in the article, stating their opinion as to its composition, and is opposed by counter-affidavits of the manufacturer of the article, who states the composition from his personal knowledge, the repugnancy is not irreconcilable ; but the statements founded on personal knowledge are deemed more reliable, and the injunction will be denied. *Gutta percha Co. v. Good-year Co.*, 3 *Sawyer*, 542 ; 2 *Bann. & A. Pat. Cas.* 212.

A preliminary injunction ought never to be issued, unless the right of a patentee is an established or admitted one, and unless the alleged invasion of the right is proved beyond reasonable doubt. *Parker v. Sears*, 4 *Pa. L. T. Rep.* 443 ; 1 *Fish. Pat. Cas.* 93 ; *Batten v. Sillman*, 3 *Wall. Jr.* 124 ; *American Nicholson Pavement Co. v. Elizabeth*, 4 *Fish. Pat. Cas.* 189 ; 3 *Pat. Off. Gaz.* 522 ; *Bailey Wringing Machine Co. v. Adams*, 5 *Cent. L. J.* 425 ; 3 *Bann. & A. Pat. Cas.* 96 ; *Irwin v. Dane*, 4 *Fish. Pat. Cas.* 359 ; *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.

Application for preliminary injunction may be granted as to articles embraced in the suit which are clearly infringements and denied as to others which are doubtful. *Allis v. Stowell*, 23 *Pat. Off. Gaz.* 1033 ; 15 *Fed. Rep'r*, 242.

A district judge cannot sign a writ of injunction by himself in vacation when the circuit court is sitting and can be applied to. *Goodyear Dental Vulcanite Co. v. Folsom*, 5 *Bann. & A. Pat. Cas.* 590 ; 3 *Fed. Rep'r*, 509 ; 26 *Int. Rev. Rec.* 251.

The patent having been sustained upon final hearing against a corporation intimately connected with the defendant, the latter, in adducing new matter, must show a strong probability, that if it had been put in evidence in former suit, a different result would have been reached. *Colgate v. Gold & Stock Telegraph Co.*, 16 *Pat. Off. Gaz.* 583.

Although the court should examine anew the case, the defendant not having been a party to any former suits, yet if the points presented are the same, former decisions must be given great weight. *Potter v. Whitney*, 3 *Fish. Pat. Cas.* 77.

Where a plaintiff moves for an injunction, and it is denied on defects pointed out, it is too late, after defendant has closed his proofs for final hearing, to renew his motion upon papers designed to cure such defects. *Wooster v. Howe Sewing Machine Co.*, 16 *Pat. Off. Gaz.* 314.

259. *Necessity of First Establishing Plaintiff's Title at Law.*

A patent is *prima facie* evidence of a right ; but to grant an injunction upon the mere exhibition of a patent, and an allegation that it has been infringed, is not matter of course ; the court should be reasonably satisfied as to the validity of the patent, either by result of some judicial investigation or by proof of long public acquiescence. *Sullivan v. Redfield*, 1 *Paine*, 441 ; *Grover, &c. Sewing Machine Co. v. Williams*, 2 *Fish. Pat. Cas.* 133 ; *Tappan v. National Bank Note Co.* *Id.* 195.

So long as there is room for doubt whether the patent under which the complainant claims is valid, the court will not grant a provisional injunction, but will require him first to establish its validity, in an action at law. *Washburn v. Gould*, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L. Rep'r*, 276 ; *Concord v. Norton*, 16 *Fed.*

Rep'r, 477 ; *Sullivan v. Redfield*, 1 *Paine*, 441 ; *Thomas v. Weeks*, 2 *Paine*, 92 ; *Isaac v. Cooper*, 4 *Wash.* 259 ; *Ogle v. Ege*, *Id.* 584 ; *Miller v. McElroy*, 1 *Pa. L. J. Rep.* 304 ; *Brooks v. Bicknell*, 4 *McLean*, 70 ; 3 *West. L. J.* 109.

In general, a preliminary injunction is granted only, 1, where the right of the complainant has been established at law ; or, 2, where he has enjoyed the patent, avowedly and as against the public, for a considerable period unquestioned ; or, 3, where his right is clear and unquestionable. *North v. Kershaw*, 4 *Blatchf.* 70 ; *Toppan v. National Bank Note Co.*, *Id.* 509 ; 2 *Fish. Pat. Cas.* 202 ; *Irwin v. McRoberts*, 16 *Pat. Off. Gaz.* 853. To nearly same effect, *Doughty v. West*, 2 *Fish. Pat. Cas.* 553.

Although a decision has been made against the validity of the original patent on account of defects in the specifications, yet a preliminary injunction may be granted on a reissue. *Schneider v. Bassett*, 13 *Fed. Rep'r*, 351 ; 22 *Pat. Off. Gaz.* 1447.

Whether the judgment at law relied upon to support an application for a preliminary injunction must have been rendered in the same circuit or district as that wherein the suit in equity is filed, or whether a judgment in another circuit or district is sufficient, see *Wells v. Gill*, 2 *Pat. Off. Gaz.* 590 ; 6 *Fish. Pat. Cas.* 89 ; *Pennsylvania Salt Co. v. Myers*, 1 *Week. N. of Cas.* 377 ; *Spring v. Domestic Sewing Machine Co.*, 2 *N. J. L. J.* 274 ; *De Ver Warner v. Bassett*, 7 *Fed. Rep'r*, 468 ; 12 *Rep'r*, 35.

Prior adjudications on the same issues in other circuits will be sufficient for the purpose of granting a temporary injunction. *American Bell Telephone Co. v. National Improved Telephone Co.*, 27 *Fed. Rep'r*, 663.

Whether a judgment rendered upon consent of the parties is such an adjudication as will sustain the plaintiff in making application for a provisional injunction against a third person, see *Orr v. Littlefield*, 1 *Woodb. & M.* 13 ; 8 *L. Rep'r*, 314 ; *De Ver Warner v. Bassett*, 7 *Fed. Rep'r*, 468 ; 12 *Rep'r*, 35.

For decisions of the courts in former years which determine questions of detail in the application of the rule that a patent must have been sustained at law before equity will grant a preliminary injunction, see the following : Verdict without judgment sufficient. *Orr v. Badger*, 7 *L. Rep'r*, 465 ; 1 *Brunner Col. Cas.* 537. Recoveries against other persons sufficient against an infringer. *Hovey v. Stevens*, 1 *Woodb. & M.* 290 ; *Woodworth v. Hall*, *Id.* 248 ; 6 *Pa. L. J.* 178. Efforts to obtain adjudications, causing great delay

and loss, but frustrated by disagreements of juries, sufficient. *Buck v. Cobb*, 9 *L. Rep'r*, 545 ; 1 *Brunner Col. Cas.* 550. Where there had been an adjudication sustaining the claim of the patent which defendant was infringing, although the patent contained another claim which was in dispute. *Colt v. Young*, 2 *Blatchf.* 471. Where there had been an adjudication sustaining the patent, but it was under review in the supreme court. *Wells v. Gill*, 2 *Pat. Off. Gaz.* 590 ; 6 *Fish. Pat. Cas.* 89. Decree against buyers and users, sufficient against manufacturer. *United States, &c. Salamander Felting Co. v. Asbestos Felting Co.*, 10 *Pat. Off. Gaz.* 828.

For decisions holding simply that adjudications or public acquiescence in a patent, or both combined, will warrant a preliminary injunction, see *Van Hook v. Pendleton*, 1 *Blatchf.* 187 ; *Robertson v. Hill*, 4 *Pat. Off. Gaz.* 132 ; 6 *Fish. Pat. Cas.* 465 ; *Odorless Excavating Co. v. Lauman*, 12 *Fed. Rep'r*, 788 ; 4 *Woods*, 129 ; *Kirby Bung Manuf. Co. v. White*, 5 *Bann. & A. Pat. Cas.* 263 ; 1 *Fed. Rep'r*, 604 ; 1 *McCrary*, 155 ; 17 *Pat. Off. Gaz.* 974.

Previous adjudications in favor of a patent entitle complainants to the relief of a preliminary injunction against what seems to be a clear infringement. *Thayer v. Wales*, 9 *Blatchf.* 170 ; 5 *Fish. Pat. Cas.* 130. S. P., *Blaisdell v. Dows*, 4 *Bann. & A. Pat. Cas.* 499.

Long public acquiescence in the complainant's patent, together with the adjudications in favor of its validity, are *prima facie* sufficient reasons for the grant of a preliminary injunction when the infringement is palpable. *American Shoe Tip Co. v. National Shoe Toe Protector Co.*, 11 *Pat. Off. Gaz.* 740 ; 2 *Bann. & A. Pat. Cas.* 551.

A decision upon an interference, although not conclusive in an action between the parties for an infringement of the patent granted in pursuance of such decision, is an adjudication upon the patentability of the invention and the right of the successful party to the patent, to lay a foundation for a preliminary injunction. Alleged anticipation of the invention by others, or prior invention by defendants themselves, unless made clearly to appear, will not avail them to prevent an injunction. *Celluloid Manuf. Co. v. Chrolithian Collar, &c. Co.*, 24 *Fed. Rep'r*, 275 ; 32 *Pat. Off. Gaz.* 383.

Acquiescence for a considerable time, by a complainant in the infringement of his patent, is ground for refusing him a preliminary injunction in his suit for such infringement. *Mundy v. Kendall*, 23 *Fed. Rep'r*, 591 ; 32 *Pat. Off. Gaz.* 1237.

The fact that a patent is recent, and has not been judicially declared to be valid, is not, alone, ground for refusing a preliminary injunction in a suit for infringement. 1885, *Foster v. Crossin*, 23 *Fed. Rep'r*, 400.

Where the patent was not disputed, it was *held*, that the fact that the defendant had accepted and operated under a license was proof enough of validity of the patent, to sustain a temporary injunction. *Brown v. Lapham*, 27 *Fed. Rep'r*, 77.

Where in previous litigation a patent has been sustained against all the defenses ordinarily set up in patent cases, the question of its validity is hardly an open one on an application for a preliminary injunction. *Cary v. Domestic Spring Bed Co.*, 27 *Fed. Rep'r*, 299.

260. *Or by Long Public Acquiescence.*

Where acquiescence alone is relied upon as a basis for the motion for a preliminary injunction, the infringement must be palpable; if the defendants are using a machine openly made, sold and used under patents, and manufactured in good faith in open competition, there is reason why the court should hesitate to interfere before final decree. *Burleigh Rock-Drill Co. v. Lobdell*, 1 *Holmes*, 450; 7 *Pat. Off. Gaz.* 836; 1 *Bann. & A. Pat. Cas.* 625.

An inventor may make and sell his invention for two years before his patent, and the public may acquiesce in his claim during such period; and such acquiescence may be entitled to weight, in considering his right to a temporary injunction; and where sufficient possession is thus established, a doubt concerning the validity of the patent will not necessarily prevent an injunction. *Sargent v. Seagrave*, 2 *Curt.* 553.

To show lapse of time without objection raised, does not prove public acquiescence; there must be circumstances indicating that no doubt existed of the patent. *Guidet v. Palmer*, 10 *Blatchf.* 217; 6 *Fish. Pat. Cas.* 82.

Where complainant has for a number of years been in the extensive and undisputed use of patents, and during all that period there has been a public acquiescence in the monopoly, a provisional injunction to restrain infringement will be granted, unless some special facts appear to take it out of the general rule. *McKay v. Dibert*, 5 *Fed. Rep'r*, 587; 19 *Pat. Off. Gaz.* 1351; 11 *Rep'r*, 380.

So held, as to acquiescence in the claim to the invention during the two years preceding the application. *Sargent v. Seagrave*, 2 *Curt.* 553.

Where an invention is new and useful, want of public acquiescence cannot avail parties infringing the patent therefor, to defeat a preliminary injunction. *Hussey Manuf. Co. v. Deering*, 20 *Fed. Rep'r*, 795.

A reissue patent, containing claims not in the original, is to be treated as a new patent so far as its standing as to acquiescence and acceptance by the public is concerned. *Irwin v. McRoberts*, 16 *Pat. Off. Gaz.* 854.

261. *Equitable Reasons for Granting a Preliminary Injunction on the Merits.*

A preliminary injunction is grantable where, upon appearance of defendant to notice, he contests plaintiff's title without successfully rebutting the allegation of infringement. *Blackwell v. Armistead*, 5 *Am. L. T. U. S. Cts.* 85.

Under an agreement to manufacture and sell a patented article, equity will enjoin the breach of negative covenants and decree a specific performance of the agreement between the parties. *Hapgood v. Rosenstock*, 23 *Fed. Rep'r*, 86.

Under a contract giving the exclusive right of sale of a patented article, an injunction against sales by the grantor will be allowed, until the contract is set aside, although he claims that the contract was obtained by fraud. *Goddard v. Wilde*, 17 *Fed. Rep'r*, 845 ; 16 *Rep'r*, 617.

Although equity might have decreed a surrender and cancellation of the contract giving plaintiff the exclusive right in the patent, yet until this has been done he must be deemed to continue in the enjoyment of the right, and to be entitled to an injunction against infringement. *Gibson v. Barnard*, 1 *Blatchf.* 388.

A person who has a license to use a patented machine, upon certain conditions, may be enjoined from using it except upon those conditions, but a failure to perform such conditions is not necessarily a forfeiture of his license, such as entitles the plaintiff to an absolute injunction against all use of the machine. *Brooks v. Stolley*, 3 *McLean*, 523 ; 2 *West. L. J.* 396 ; *Wilson v. Sherman*, 1 *Blatchf.* 536.

But where it appeared that the licensee had violated the restriction under a misapprehension of his rights, and had discontinued the violation, the injunction was refused. *Wilson v. Sherman*, 1 *Blatchf.* 536.

One who, for a good consideration, has covenanted not to further infringe a patent, may be enjoined from further infringing, unless he shows some equitable reason why the agreement should not be enforced. *Sargent v. Larned*, 2 *Curt.* 340.

A party to a mutual and reciprocal covenant respecting a patent, who has broken it, cannot obtain the aid of a court of equity to restrain the other covenantor from its violation. Otherwise, where the covenants are independent, or only collaterally connected; or where the breach is of such a nature that it may be fully repaired. *Clum v. Brewer*, 21 *L. Rep'r*, 390.

262. *Preliminary Injunctions Granted Under Special Circumstances.*

A corporation, owner of certain patents, granted an exclusive license to the complainant to sell machines, and agreed to furnish the machines at a certain price; but, afterward, refused to deliver them; assigning the patent to one having knowledge of the contract, in trust for another association; and took measures for its own dissolution. At the suit of the licensee, a preliminary injunction was granted restraining the corporation from dissolving its organization, and the assignee in trust of the patents from transferring them. *Singer Sewing Machine Co. v. Union Button-hole, &c. Co.*, 1 *Holmes*, 253; 4 *Pat. Off. Gaz.* 553.

After the lapse of much time, the affidavit of a single witness that the patentee was not the first inventor was held not enough to outweigh the oath of the patentee and the general presumption arising from the grant of the letters-patent; and that an injunction should be granted. *Woodworth v. Sherman*, 3 *Story*, 171; 7 *L. Rep'r*, 279.

The complainant having been long in the enjoyment of his patent, a preliminary injunction was ordered, restraining the defendants from infringing, notwithstanding affidavits were filed, showing that articles embodying the alleged invention had been in use before the complainant made it, there being evidence to the contrary, and none of the alleged anticipating articles being produced.

Chase v. Wesson, 4 *Pat. Off. Gaz.* 476 ; 1 *Holmes*, 274 ; 6 *Fish. Pat. Cas.* 517.

Where a party held a license under a patent, in which the patentee reserved the power, upon default of payment of the agreed price for the privilege, to claim and take back the right ; and an action was brought to recover the arrears, the patentee was *held* entitled to an injunction to restrain the licensee from further use of privilege ; the action for the arrears, and judgment therein, being adjudged no waiver of the forfeiture. *Armstrong v. Hanlenbeck*, 3 *N. Y. Leg. Obs.* 431.

The right to a patent having been established in a suit at law, a preliminary injunction against a like apparatus was granted, although the defendant claimed that the apparatus used by him was patented and had been adopted by him in good faith. *Sickles v. Tileston*, 4 *Blatchf.* 109.

Preliminary injunction in a suit for infringement of a patent was granted, where it appeared that a refusal would work great and perhaps irreparable injury to complainant's business, and defendant, being a merchant and not a manufacturer, would not be materially injured by being required to discontinue his sales until the questions at issue should be finally determined. *Covert v. Curtis*, 25 *Fed. Rep'r*, 43.

In the case of a license to use a patented machine in consideration of the licensee's promissory notes, with a stipulation in writing that if any one of the notes should become due and be unpaid, the license should be void, and should revert, a provisional injunction against further use was granted, unless the licensee should in sixty days pay the amount of the due and unpaid note. *Woodworth v. Weed*, 1 *Blatchf.* 165.

Notwithstanding the use of the infringed combination was stopped upon suit brought, an injunction and account were decreed, where the defendants had made no disclaimer of the right to use, and it did not appear that the previous use, though disadvantageous to themselves, was without damage to complainants ; and where other evidence as to profits might be given on an accounting *Bullock Printing Press Co. v. Jones*, 13 *Pat. Off. Gaz.* 124 ; 3 *Bann. & A. Pat. Cas.* 195.

The fact that defendant has, by government grants, the exclusive right to operate a submarine telegraph, so that patentee of an invention which defendant is using could not make use of his invention over the line, does not exempt defendant from injunction

to restrain his use of the invention. *Colgate v. International Ocean Tel. Co.*, 17 *Blatchf.* 308 ; 9 *Rep'r*, 166 ; 4 *Bann. & A. Pat. Cas.* 609.

A decree for an injunction and account granted upon the circumstances in the particular case, against several defendants who owned, rented or occupied premises in which were placed driven wells which were used by them, and against a defendant who purchased and rented out, but never personally occupied premises containing a driven well. *Green v. Gardner*, 22 *Pat. Off. Gaz.* 683 ; 5 *N. J. L. J.* 174.

The main and principal feature of the art of canning foods of various kinds, being old and well known, a patent for any particular article of canned goods "as a new article of commerce," must be clearly sustained, by proof in order to sustain an injunction against other manufacturers of similar goods. *Wilson Packing Co. v. Clapp*, 8 *Biss.* 154 ; 3 *Bann. & A. Pat. Cas.* 243.

263. *Equitable Reasons for Refusing a Preliminary Injunction, on the Merits.*

A circuit court will not enjoin a patentee from manufacturing under his patent, upon allegations that he surreptitiously procured a patent right for an improvement, for which complainant made application for a patent. Until the complainant succeeds in obtaining a patent, he is not in a position to contest the validity of the defendant's patent, by a suit against him for an infringement. *Hoeltge v. Hoeller*, 2 *Bond*, 386.

An injunction ought not to issue to restrain infringement when it does not appear from the record that the defendant has ever made or sold any of the goods in the district. *Wilson Packing Co. v. Clapp*, 8 *Biss.* 154 ; 3 *Bann. & A. Pat. Cas.* 243. Compare *Goodyear v. Chaffee*, 3 *Blatchf.* 268.

A probability that irreparable injury may be done by granting a preliminary injunction may be reason for refusing it. *North v. Kershaw*, 4 *Blatchf.* 70. But see *Sickles v. Tileston*, 4 *Blatchf.* 109.

Where the defendant is manufacturing under letters-patent, the presumption is that he is not infringing, and unless the court can see, from an inspection alone of the patent, that his article is an infringement, the court will not issue an injunction until after a

full hearing. *Sargent Manuf. Co. v. Woodruff*, 5 *Diss.* 444; 1 *Fish. Pat. Cas.* 277.

A preliminary injunction will not be granted where defendants have manufactured under the sanction of a patent of prior date, which patent of prior date has expired, and no proceedings have, at any time, been instituted by complainants to secure or protect their rights under their patents. *Whitney v. Rollstone Machine Works*, 8 *Pat. Off. Gaz.* 908. See also *Sargent v. Carter*, 21 *L. Rep'r*, 651.

A preliminary injunction will be refused where grave doubt exists, on the evidence, whether there has been any infringement, and there is some doubt as to the validity of the patent. *Cross v. Livermore*, 9 *Fed. Rep'r*, 607.

The existence of a substantial doubt whether a reissued patent is for the same invention as the original, and as to the true construction to be given to the reissued patent, is a proper ground for denying a motion for a provisional injunction to restrain the infringement of the reissued patent. *Poppenhusen v. Falke*, 4 *Blatchf.* 493; 2 *Fish. Pat. Cas.* 181.

Where a reissue is in terms broader than the original, preliminary injunction denied, there being a doubt as to whether the patentee had applied for a reissue within a proper time. *Brewster & Co. v. Parry*, 14 *Fed. Rep'r*, 694.

Where there was no danger of loss to the plaintiff, the defendant being shown to be fully responsible for profits and damages, and great loss will result to the defendant, and where the latter does not make or vend the patented article, it was *held*, that a preliminary injunction should be denied, the title of plaintiff not being fully established. *Morris v. Lowell Manuf. Co.*, 3 *Fish. Pat. Cas.* 67; 3 *Wall. Jr.* 310; *Potter v. Whitney*, *Id.* 77.

A preliminary injunction will not be granted where the plaintiff has acquiesced in the infringement, and unreasonably delayed suit against infringers. *Green v. French*, 16 *Pat. Off. Gaz.* 215; *Morris v. Lowell Manuf. Co.*, 3 *Fish. Pat. Cas.* 67; 3 *Wall. Jr.* 310.

'Two years' use by defendant of complainant's patent with the latter's knowledge, who took no steps to stop it, was *held* sufficient to defeat a motion for a preliminary injunction. *Spring v. Domestic Sewing Machine Co.*, 16 *Pat. Off. Gaz.* 721.

264. *Refusal of Preliminary Injunctions, under Special Circumstances.*

The patent having been reissued just after the bringing of the suit ; and no exclusive possession of the invention for any considerable time, accompanied by acquiescence by the public, or any verdict, judgment, decree, or judicial order, recognizing the validity of the claim, being shown, nor irreparable injury to the complainant averred, a provisional injunction was refused. *Earth Closet Co. v. Fenner*, 5 *Fish. Pat. Cas.* 15.

Where, on a motion for a provisional injunction, the novelty of the invention was denied, and it was admitted that the plaintiff had sold, before his application for a patent, large quantities of the article in packages marked as "imported from Paris," the injunction was denied until the plaintiff should establish his right by a suit at law. *Booth v. Garely*, 1 *Blatchf.* 247 ; 6 *N. Y. Leg. Obs.* 99.

The infringing articles were made and sold in Rhode Island, and the defendant resided there and carried on there the business of making and selling them. It was *held*, that a motion in New York must be denied on the grounds that defendant was beyond the process of injunction, and issuing it would be inoperative and useless ; and that the proper place to apply was in Rhode Island. *Goodyear v. Chaffee*, 3 *Blatchf.* 268.

The plaintiff moved for an injunction to restrain the infringement of a patent. It was shown by the defendant that he had used the patented apparatus for nearly three years before any claim was made by the plaintiff. The court refused an injunction until the alleged acquiescence should be explained. *Sykes v. Manhattan Elevator, &c. Co.*, 6 *Blatchf.* 496.

Where the alleged infringement consisted in using a stone crusher in repairing roads in a public cemetery, the court denied a preliminary injunction ; because the use was for public convenience ; and also, defendants had tendered a compensation to abide event of the suit. *Blake v. Greenwood Cemetery*, 14 *Blatchf.* 342 ; 13 *Pat. Off. Gaz.* 1046 ; 3 *Bann. & A. Pat. Cas.* 112.

A decree, in a suit founded on a patent, rendered in favor of plaintiff because the defendants abandoned the defense and allowed the decree to be entered without objection and without a hearing, is not sufficient ground upon which to grant a preliminary injunc-

tion in a subsequent suit in another district and against other parties, founded on the same patent. *Hayes v. Leton*, 5 *Fed. Rep'r*, 521.

The patent was for an improvement on the horizontal wheel for gaining power to propel boats, but the specifications did not state the nature of the original invention upon which it was an improvement, nor whether it had been patented, nor give any information respecting it. An injunction was refused, on the ground that the nature of the improvement was unintelligible. *Isaacs v. Cooper*, 4 *Wash.* 259.

Special injunction to stop one hundred mills on an alleged infringement of the patent for the Parker water-wheel, was refused; where defendants had had many years' unchallenged possession of the machines, which they purchased from patentees with *prima facie* evidence of title. An injunction is not employed to create, but to prevent mischief. *Parker v. Sears*, 4 *Pa. Law J. Rep.* 443; 1 *Fish. Pat. Cas.* 93.

The plaintiff's patent was for the combination of a flat, horizontal iron plate, in connection with a chamber or recess below the plate. The defendant put horizontal plates into fire-places already provided with recesses which he had no agency in constructing. It was *held*, that the question of infringement was so far doubtful as to forbid the granting of an injunction. *Dodge v. Card*, 1 *Bond*, 393; 2 *Fish. Pat. Cas.* 116.

Plaintiff's patent had been upheld in another court, and the first claim declared to have been infringed; but there was no evidence in the present suit to show that defendant's contrivance was the same as the infringing articles in the former suit. Defendant denied infringement, and set up another patent. The moving papers contained no evidence of infringement. Preliminary injunction was denied, but defendant ordered to keep an account. *Blake v. Boisselier*, 5 *Bann. & A. Pat. Cas.* 352.

In a suit brought by a patentee, alleging an infringement and claiming only a royalty or license for the use of the patented device, a motion for a provisional injunction *simpliciter* will not be granted of course, even where the patent alleged to have been infringed has been held valid in other cases; the defendant will be held only to give bond to the plaintiff, to secure him to the full extent of his demand, with costs, &c. *McMillan v. Conrad*, 16 *Fed. Rep'r*, 123; 5 *McCrory*, 140.

A license to use a machine, the patent for which was assigned

by the licensee who invented it, to the licensor, was *held*, independent of a license previously granted by the same licensor to the same licensee, to use a process in which the machine subsequently patented was employed, so that failure to pay royalties under the earlier license did not entitle the licensor to an injunction restraining the use of such machine by the licensee. *Washburn, &c. Manuf. Co. v. Wilson*, 19 *Fed. Rep'r*, 233.

Motion for a preliminary injunction was denied in a case where complainants had known of the manufacture by the defendants of the alleged infringing machines for several years, and had neither warned nor proceeded against them, and some doubt existed as to the infringement. *Ballou Shoe Machine Co. v. Dizer*, 5 *Bann. & A. Pat. Cas.* 540.

Preliminary injunction denied, where the infringing machine was not identical with the one declared in a prior suit to be an infringement; defendant having been granted a patent since then on the present machine; and the patent of complainant never having been upheld on final hearing. *Onderdonk v. Fanning*, 5 *Bann. & A. Pat. Cas.* 562; 2 *Fed. Rep'r*, 568; 9 *Rep'r*, 737.

Preliminary injunction denied, because stopping the use of the invention would greatly embarrass defendant's entire business (the publication of newspapers) and was not necessary to secure justice for plaintiff. *Hoe v. Boston Daily Advertiser Corp.*, 14 *Fed. Rep'r*, 914; 23 *Pat. Off. Gaz.* 1124. *S. P., Swift v. Jenks*, 19 *Fed. Rep'r*, 641.

Preliminary injunction refused, on account of delay in suing, coupled with other circumstances indicating that patentee had no important right. *Tillinghast v. Hicks*, 23 *Pat. Off. Gaz.* 739; 13 *Fed. Rep'r*, 388; 14 *Rep'r*, 578.

Equities in favor of an infringer of a patent which may prevent an injunction, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 *Fed. Rep'r*, 638; 25 *Pat. Off. Gaz.* 1076.

Preliminary injunction against alleged infringement denied, where plaintiff had failed to press a pending suit at law for the same infringement against the same defendant, and the latter was pecuniarily responsible. *United Nickel Co. v. New Home Sewing Machine Co.*, 17 *Fed. Rep'r*, 528.

Effect of words "to be held to the full end of the term for which said letters patent are or may be granted," when used in the habendum of a deed, reconsidered. Where the assignor from whom complainant derived title had never done anything with the patent

in the State where the suit is pending during its extended term, and defendants bought their machines in ignorance of his rights, and the existence of the machines now set up as prior to the patent was the subject of different issues from those in the former suit on the patent, in which its validity was sustained, it was *held*, that the court would not, upon preliminary motion, enjoin the defendants from using the machines; but that the court would have acted differently if it had appeared that the defendants were not responsible; also, that if the court were sitting in any other state, it would grant an injunction against uses of the machine there, as the assignor's neglect would not affect complainant's rights in a state where complainant's title was not derived through him. *Gear v. Holmes*, 6 *Fish. Pat. Cas.* 595.

A preliminary injunction in a suit by licensor against licensee under a patent, was refused on the ground of fraud by complainant in concealing an arrangement with another licensee for the manufacture of the patented article at royalties less than the rates agreed upon between the parties; it appearing also that complainant had lost control of the market, and left it to be supplied by infringers who paid no royalties. *Washburn & Moen Manuf. Co. v. Cincinnati Barbed Wire Fence Co.*, 22 *Fed. Rep'r*, 712. And see *Washburn & Moen Manuf. Co. v. H. B. Scutt & Co.*, *Id.* 710.

A preliminary injunction in a suit for infringement of a patent was refused, there being some doubt as to the novelty of the invention; upon defendants giving security for profits and damages for infringement, if the patent should be sustained. *New York Belting, &c. Co. v. Magowan*, 23 *Fed. Rep.* 597.

Preliminary injunction in suit for infringement of a reissued patent was refused, the validity of the reissued patent, in respect of the alleged infringement, being doubtful, and the defect appearing to be, under the circumstances, incurable. *Arnheim v. Finster*, 24 *Fed. Rep'r*, 276; 32 *Pat. Off. Gaz.* 256.

Where the claims of a reissued patent appear to have been made so comprehensive and elastic as to embrace all subsequent inventions which might be made within the same field of improvement, which is more than belongs to the patentee a preliminary injunction will not be granted in suit for infringement, even of a claim held valid against a defendant who has acted on the assumption that such reissued patent could not be sustained. *Western Union Tel. Co. v. Baltimore, &c. Tel. Co.*, 25 *Fed. Rep'r*, 30.

Preliminary injunction in suit for infringement of various pat-

ents for dies for forging ox-shoes, and for the process of forging by the use of the dies, was refused until final hearing of doubtful questions of validity of reissues, and of novelty and patentability of devices described. *Gunn v. Savage*, 25 *Fed. Rep'r*, 101.

In a suit for infringement of a patent for the use of chloride of lime as a sizing ingredient in the manufacture of pulp-size paper, it appeared that chloride of lime had long previous to the patent been used in the manufacture for bleaching, and was usually washed out, at least in part, before the sizing materials were applied; but that the defendant had, long before the date of the patent, in manufacturing such paper, allowed the chloride of lime, introduced for bleaching, to remain, which was the method of manufacturing complained of as an infringement. It was *held*, that equity would not interfere to restrain a continuance of the defendant's business or manufacture as pursued anterior to the patent. *Dorlan v. Guie*, 25 *Fed. Rep'r*, 816; 34 *Pat. Off. Gaz.* 702.

Preliminary injunction was refused in a suit for infringement, notwithstanding a decision of the supreme court of the United States sustaining the complainant's patent as valid, where there was doubt as to whether the device alleged to infringe was covered by the patent. *Consolidated Safety Valve Co. v. Ashton Valve Co.*, 26 *Fed. Rep'r*, 319.

Preliminary injunction in a suit for infringement of a patent was refused, the averments in the affidavits in support of the motion being insufficient, and the opposing affidavits making the case a doubtful one. *International Tooth Crown Co. v. Mills*, 30 *Pat. Off. Gaz.* 662.

Preliminary injunction in suit for infringement of a patent was refused, where there was doubt as to the title of the complainant, who claimed as an assignee of the patent. *Continental Store Service Co. v. New York Store Service Co.*, 31 *Pat. Off. Gaz.* 1561.

265. *Granting or Refusing Injunction, upon Terms as to Security, &c.*

An application for a provisional injunction may be granted or refused unconditionally, or terms may be imposed on either of the parties, as conditions for making or refusing the order. The state of the litigation (where the plaintiff's title is denied), the nature of the improvement, the character and extent of the infringement

complained of, and the comparative inconvenience which will be occasioned to the respective parties, by allowing or disallowing the motion, must all be considered in determining whether the injunction should be allowed or refused; and if allowed, whether absolutely or upon some and what conditions. *Forbush v. Bradford*, 21 *L. Rep'r*, 471; 1 *Fish. Pat. Cas.* 317.

Where the defendants were using but not making, certain looms having a patented improvement, and an injunction would stop their whole business, it was *held*, that they might be allowed to give security to keep and render an account. *Ib.*

If an injunction will lead to serious injury in suspending the works of the defendant, the court may require security of the complainant, to indemnify the defendant for such loss, if the patent is held void. Or it can make an order to expedite a final hearing and decision. *Orr v. Littlefield*, 1 *Woodb. & M.* 13; 8 *L. Rep'r*, 314.

An injunction should not be granted where the plaintiff is made secure of receiving all the profits which may arise from the use of the machine until the final hearing. *Foster v. Moore*, 1 *Curt.* 279.

When the infringement is clear and the patent valid, an injunction will not be refused because the defendant offers to give bond with surety to pay any damages awarded against him. *McWilliams Manuf. Co. v. Blundell*, 11 *Fed. Rep'r*, 419; 22 *Pat. Off. Gaz.* 177. S. P., *Gibson v. Van Dresar*, 1 *Blatchf.* 532; *Tracy v. Torrey*, 2 *Blatchf.* 275.

Where an injunction had been granted against a person for an infringement of a patent, and while such proceedings were being taken, a third party, with full knowledge of all the circumstances connected with such injunction, became the assignee of all the rights and interests of the persons first enjoined, it was *held*, that such assignee stood in the light of the other's substitute, and that he could not be allowed, by giving security and giving an account, to continue the business till final hearing, but an injunction should issue against him. *Parkhurst v. Kinsman*, 2 *Blatchf.* 78.

Injunction to restrain infringement was refused, against a *bona fide* purchaser, upon the defendant's giving bond to account, although the plaintiff's patent had been established in two trials at law in suits between other parties. *United States Annunciator, &c. Manuf. Co. v. Sanderson*, 3 *Blatchf.* 184.

Although the defendant's machine may infringe, yet if it contain other valuable improvements not covered by plaintiff's patent,

an order for account and security may be substituted for an injunction. *Stainthorp v. Humiston*, 2 *Fish. Pat. Cas.* 311.

Upon an application for an injunction, the defendants offered to pay the plaintiff a reasonable sum for the use of the invention. It was *held*, that the defendant ought not to be enjoined, unless he preferred to be enjoined rather than pay the plaintiff a reasonable sum for the use of the invention; such sum not to exceed the license fee usually charged in like cases, and to be ascertained by reference to a master. *Hodge v. Hudson River R. R. Co.*, 6 *Blatchf.* 162.

Injunction withheld upon the giving of a bond by defendant, when the prior adjudication upon which the right to a preliminary injunction was based is pending on appeal to the supreme. *Wells v. Gill*, 6 *Fish. Pat. Cas.* 89.

On a motion for a preliminary injunction to restrain the infringement of a patent for a dredging machine, the validity of the patent was denied, on the ground of a prior public use. The patent had never been adjudicated upon, and the general allegation of public acquiescence in the bill, and which was the only proof thereof, was denied. The defendant was constructing, for his own use, a single machine. It was *held*, that the injunction ought not to be granted, provided the defendant should give security sufficient to protect the plaintiff against all loss and damages by reason of the construction and use of the machine, and to pay any sum which might be awarded to the plaintiff in the suit. *Morris v. Shelbourne*, 8 *Blatchf.* 266; 4 *Fish. Pat. Cas.* 377.

The plaintiffs in a suit in the circuit court against T. for manufacturing and selling gas machines, obtained a decree requiring T. to account for his gains and profits from such manufacture and sale, and for all damages sustained by the plaintiffs from such infringement by T. No final decree had been entered. The plaintiffs then brought this suit against B. for infringing the patent by the use of a machine purchased by him from T. and applied for a provisional injunction to restrain the further use of the machine. It was *held*, that B. ought to be allowed to give security for the payment of any decree that might be rendered against him, and that, if he would do so, the injunction ought not to be granted. *Gilbert, &c. Manuf. Co. v. Bussing*, 12 *Blatchf.* 426; 1 *Bann. & A. Pat. Cas.* 621; 8 *Pat. Off. Gaz.* 144.

Where a preliminary injunction against the use of a device claimed to be patented would work great injury to one party with-

out corresponding benefit to the other, it should not issue ; but that a bond to keep and file a verified account and to pay the amount of any decree for damages should be given. *Swift v. Jenks*, 19 *Fed. Rep'r*, 641. S. P., *Hoe v. Boston Daily Advertiser Corp.*, 14 *Fed. Rep'r*, 914 ; 23 *Pat. Off. Gaz.* 1134.

Where a party has only some vague and indistinct right, and an order may work an injury to defendant's business, a preliminary injunction will not be granted *simpliciter*, without a bond or security. *Blake v. Boisselier*, 16 *Pat. Off. Gaz.* 854.

Where the judges differed as to the question of infringement, and the jury had failed to agree, the court directed that an injunction already granted should be dissolved, upon the defendant giving proper security to keep an account ; or, if he should fail so to do, then, that it should remain, upon the plaintiff giving proper security. *Wilson v. Barnum*, 1 *Wall. Jr.* 347 ; 2 *Fish. Pat. Cas.* 635 ; 6 *West. L. J.* 464.

If the owner of a patent has never made, used, or sold to others to be used, the invention covered by his patent, an injunction will be denied, in the interlocutory decree, against its use by an infringer, on his giving bond to secure any damages which may be awarded on final hearing. *Hoe v. Knap*, 27 *Fed. Rep'r*, 204.

The fact that defendants are well able to pay ultimate damages is not a sufficient ground for the refusal of a preliminary injunction. *American Middlings Purifier Co. v. Christian*, 3 *Bann. & A. Pat. Cas.* 42.

The validity of the patents having been passed upon in one case, and restraining orders granted upon an *ex parte* application against other defendants, it was *held*, upon application for a preliminary injunction based upon the same proof as to infringement, that a preliminary injunction should be denied, there being a doubt as to infringement, upon condition that a bond be given for any damages that might be awarded, and an account of sales kept. *Steam Gauge Co. v. St. Louis Ry. Supply Co.*, 25 *Fed. Rep'r*, 494 ; 33 *Pat. Off. Gaz.* 889.

266. *Dissolution or Suspension of Preliminary Injunctions.*

An injunction is not necessarily to be dissolved because the right of the patentee is made to appear doubtful. *Orr v. Badger*, 7 *L. Rep'r*, 465 ; 1 *Brummer Col. Cas.* 537.

An injunction issued on an injunction bill which alleges long possession and sales under the patent, and that the validity of the patent has been supported by several trials, will not be dissolved on an answer of mere general denials of the originality of the patent, and the defendant's use of the invention, unless the denial is justified by the facts, or the claim of defendant is strengthened by some evidence. *Orr v. Merrill*, 1 *Woodb. & M.* 376.

An injunction once granted should not be dissolved for mere doubts ; particularly when they relate to form, and the time for a trial on the merits is near. *Woodworth v. Hall*, 1 *Woodb. & M.* 389.

The suspension of an interlocutory decree perpetually enjoining the infringement, until the final decision, upon defendants giving a bond, rests in the sound discretion of the court. *Brown v. Deere*, 6 *Fed. Rep'r*, 487 ; 19 *Pat. Off. Gaz.* 1217.

If the defendants contest the validity of the plaintiff's invention, the injunction will be granted to continue only until the validity of the patent can be determined by a trial at law ; and will be dissolved if such suit is not brought before the next term of the court. *Woodworth v. Edwards*, 3 *Woodb. & M.* 120.

A motion to dissolve an injunction will not be heard on the same evidence on which it was granted, nor upon new evidence which defendant, without good excuse neglected to offer before ; though upon new and material evidence it may be. *Woodworth v. Rogers*, 3 *Woodb. & M.* 135. *S. P., Union Paper Bag Co. v. Newell*, 11 *Blatch.* 549 ; 5 *Pat. Off. Gaz.* 459 ; 1 *Bann. & A. Pat. Cas.* 113.

Where an answer is filed to a bill, denying the validity of the patent, and evidence supporting the answer, *prima facie*, is offered, the injunction will be dissolved, unless the other side file counter-evidence sustaining the validity of the patent. *Ib.* A common injunction is usually dissolved, as a matter of course, on the coming in of an answer denying merits, or a legal title in the plaintiffs, and without any inquiry into the truth of the allegations ; otherwise, of a special injunction. *Ib.*

Unless the proof offered on motion to dissolve an injunction granted on a bill, overcomes the equity of the bill and the evidence supporting it, the motion will be denied. *Sparkman v. Higgins*, 1 *Blatch.* 205 ; 5 *N. Y. Leg. Obs.* 122 ; 6 *Pa. L. J.* 344.

Affidavits filed in support of a motion to dissolve an injunction against infringement, showed that the infringing articles made by

defendant were made under license from the patentee ; it was *held*, that the injunction must be dissolved. *Goodyear v. Bourn*, 3 *Blatchf.* 266.

Defendant will not be allowed to present, on a motion to dissolve an injunction, facts which he might have presented, but did not, in opposing a motion for a preliminary injunction, and in opposing afterward a motion to punish him for a contempt in violating such injunction. *National School Furniture Co. v. Paton*, 16 *Blatchf.* 563 ; 4 *Bann. & A. Pat. Cas.* 432.

The mere failure to join a proper party will not be sufficient ground for dissolving an injunction, where the defendant is using the infringing machine for purposes in respect to which the plaintiff has an exclusive right under his patent. *Bassett v. Malone*, 11 *Fed. Rep'r*, 801.

The fact that the complainant, after obtaining an injunction, parted with all his interest in the patent, was *held* not sufficient ground for dissolving the injunction. *Thompson v. Barry*, 2 *Week. N. of Cas.* 100.

After a final decree establishing an exclusive right to the use of a patent and awarding an injunction to protect it, the injunction will not be suspended while the decree stands unreversed, unless some extraordinary cause outside of the interests of the parties is shown. Public necessity may be a cause for such suspension. *Munson v. New York*, 19 *Fed. Rep'r*, 313 ; 22 *Blatchf.* 45.

Where the bill or affidavits of the complainant did not state with certainty the infringement of the defendant, and the complainant did not swear at the time of the filing of the bill that he believed he was the original and true inventor of the thing patented to him, and the defendant denied on oath the originality, novelty and utility of the invention, the preliminary injunction was dissolved. *Wilson v. Curtius*, 2 *West. L. J.* 511. But in such case the injunction may be revived on further affidavits setting forth the particulars of the infringement complained of, and alleging priority of invention in the patentee. *Ib.*

The suspension of an interlocutory decree, perpetually enjoining the infringement of a patent, until an accounting can be had and a decree entered from which an appeal can be taken, rests in the discretion of the court which granted the decree. *Brown v. Deere*, 6 *Fed. Rep'r*, 487 ; 2 *McCrary*, 425 ; 19 *Pat. Off. Gaz.* 1217.

In a suit for infringement of a patent for a machine the complainant obtained a decree for the profits of the manufacture and

sale by the defendant of machines embodying the patented invention, upon which some money was recovered, and real estate was set off, on execution, in satisfaction of the balance. It was *held*, that this was, *prima facie*, a satisfaction of the decree; and that in a subsequent suit by the same complainant for infringement of his patent by the use of machines purchased from the defendant in the former suit, and for the manufacture and sale, for use of which the complainant had recovered therein, a preliminary injunction should not be continued. *Steam Stone Cutter Co. v. Sheldon*, 21 *Blatchf.* 260.

Injunction restraining employes of inventor of undisclosed process of manufacture from divulging the secret, continued until final hearing. *Salomon v. Hertz*, 2 *Cent. Rep'r*, 18^o

267. *Operation and Effect of Injunctions in Patent Cases.*

Purchasers from an infringer who has been enjoined by a circuit court, cannot be permitted to use the machine purchased in another circuit while the injunction remains in full force. *Woodworth v. Edwards*, 3 *Woodb. & M.* 120.

An injunction in a patent case does not extend beyond the right of the plaintiff, as set up in his bill. *Byam v. Eddy*, 2 *Blatchf.* 521; 24 *Vt.* 666; *Wire Railing Co. v. Walker*, 2 *Fish. Pat. Cas.* 179.

To sell parts of a patented device necessary to its operation but not covered by the patent, does not constitute a new infringement, when they have already been charged in the accountings for the sale of the patented portion. *Buerk v. Imhauser*, 11 *Pat. Off. Gaz.* 112.

The words "perpetual injunction," in a decree, mean only for the life-time of the patent; and that must be determined by the statute and the facts of the case, and not merely by the terms of the patent. *De Florez v. Reynolds*, 8 *Fed. Rep'r*, 434; 17 *Blatchf.* 436; 17 *Pat. Off. Gaz.* 503; 5 *Bann. & A. Pat. Cas.* 140.

The sending of circulars by complainants to parties engaged in the trade, notifying them of a preliminary injunction, is improper. *Wilson Packing Co. v. Clapp*, 8 *Biss.* 154; 13 *Pat. Off. Gaz.* 368.

A decree for a perpetual injunction is not final where it also

directs a reference to ascertain the damages by reason of the infringement. *Barnard v. Gibson*, 7 *How.* 650.

268. *Violation of Injunctions, in Patent Cases.*

Where a person had been enjoined not to use a machine substantially like the one mentioned in the complainant's bill, it was held, that he was chargeable with a contempt, by the purchase and use of a machine which had been enjoined in another circuit as being substantially like the plaintiff's. *Woodworth v. Rogers*, 3 *Woodb. & M.* 135.

To supply an infringing device after service of an injunction is a violation, although done pursuant to a contract made before. *Colgate v. Gold, &c. Tel. Co.*, 17 *Pat. Off. Gaz.* 193 ; 4 *Bann. & A. Pat. Cas.* 559 ; *Colgate v. Western Union Tel. Co.*, 17 *Pat. Off. Gaz.* 195 ; 4 *Bann. & A. Pat. Cas.* 562.

An injunction founded upon consent, enjoining the use of a patented invention, is not necessarily deprived of vitality by the granting of a conditional license. But an attachment will not be issued for the violation of such injunction while the license itself is in litigation. *Pentlarge v. Beeston*, 1 *Fed. Rep'r*, 862 ; 18 *Blatchf.* 38 ; 9 *Rep'r*, 774 ; 5 *Bann. & A. Pat. Cas.* 326.

One who has been enjoined from infringing a patent and who continues to sell, is equally guilty of a contempt and liable to attachment, whether he sells in his own right or as agent for another. *Potter v. Muller*, 1 *Bond*, 601 ; 2 *Fish. Pat. Cas.* 631.

It is no excuse for the violation of a preliminary injunction that the patent is invalid. *Phillips v. Detroit*, 16 *Pat. Off. Gaz.* 627.

Where an injunction has been issued restraining a defendant from using patented parts of a machine, he is not at liberty to use his own judgment as to which parts are infringements, and continue the use of the remainder of the machine. *Hamilton v. Simons*, 5 *Biss.* 77.

The fact that several persons are acting in concert in the use of an infringed article as the stockholders, managers and servants of a corporation does not exempt them from the restraints of an injunction. *Poppenhusen v. Falke*, 4 *Blatchf.* 493 ; 2 *Fish. Pat. Cas.* 181. So of the fact that the person committing the acts of infringement is minor son of defendant. *Dunks v. Grey*, 3 *Fed. Rep'r*, 862 ; 10 *Rep'r*, 721 ; 5 *Bann. & A. Pat. Cas.* 634.

A sale of a patent after suit brought, but before injunction issued, is not a contempt. *United States v. Day*, 6 *Am. L. Reg.* 632.

Injunction may be violated by selling outside the territorial jurisdiction, although the goods were not sent to purchasers within the jurisdiction. *Macaulay v. White Sewing Machine Co.*, 9 *Fed. Rep'r*, 698 ; 21 *Pat. Off. Gaz.* 496.

Partial use of a thing may be adjudged a contempt of an injunction forbidding use of it. *Matthews v. Spangenberg*, 23 *Pat. Off. Gaz.* 1624 ; 15 *Rep'r*, 813.

The sale and use by defendant of a machine containing a feature not claimed in plaintiff's combination, if not a mere colorable evasion, will not render the defendant liable for violation of an injunction forbidding sale, &c. of that combination ; and the fact that a patent was issued to defendant, subsequent to granting the injunction, affords ground for him to insist that the alteration was not plainly colorable. *Onderdonk v. Fanning*, 2 *Fed. Rep'r*, 568 ; 9 *Rep'r*, 737.

The continued infringement of a patent after an interlocutory decree in a suit between the same parties for infringement, constitutes a new cause of action, notwithstanding such continued infringement is also a violation of an injunction awarded by the decree in the former suit. *Roemer v. Neumann*, 23 *Fed. Rep'r*, 447.

269. *Proceedings to Punish a Violation.*

A motion to punish violation of an injunction for an infringement as a contempt, requires clear proof that the infringement is continued. *Smith v. Halkyard*, 19 *Fed. Rep'r*, 602.

Upon a motion to punish a violation of an injunction against infringement as a contempt, such questions as whether the patentee was original inventor, whether the article as sold was an infringement, whether the patent was correctly construed in issuing the injunction, whether the patent was valid ; do not arise. They are foreclosed by the order of injunction, which must be obeyed if the court had jurisdiction to make it. *Whipple v. Hutchinson*, 4 *Blatchf.* 190 ; *Liddle v. Cory*, 7 *Id.* 1 ; *Burnett v. Estey*, 16 *Id.* 105 ; 4 *Bann. & A. Pat. Cas.* 141 ; *Roemer v. Newman*, 19 *Fed. Rep'r*, 98.

The motion to commit for contempt properly involves the ques-

tion whether what defendant has done since the injunction was issued constitutes a contempt; and the plaintiff is entitled to have this question decided on the proofs; the motion should not be denied merely because the court entertains doubt upon it. *Wetherill v. New Jersey Zinc Co.*, 1 *Bann. & A. Pat. Cas.* 105. Whether to determine the question of infringement by inspection or by testimony of experts, is a question of discretion for the court. *Burdett v. Estey*, 16 *Blatchf.* 105; 4 *Bann. & A. Pat. Cas.* 141. The question whether the machine as made by the defendant since the injunction is the same as that enjoined, is one of fact to be determined on the evidence; models first, and testimony of experts next, being the evidence. *Birdsell v. Hagerstown Agric. Imp. Manuf. Co.*, 1 *Hughes*, 59.

Should the proofs show that defendant did not intend disobedience to the order of the court, but acted in good faith, upon the advice of counsel, &c. in the exercise of what he supposed were rights reserved to him under the injunction, the court will not inflict punishment, but will limit its order to payment of plaintiff's actual damages or loss of profits, and costs. *Ready Roofing Co. v. Taylor*, 15 *Blatchf.* 94; 3 *Bann. & A. Pat. Cas.* 368; *Matthews v. Spangenberg*, 15 *Fed. Rep'r*, 813; 23 *Pat. Off. Gaz.* 1624; *Carstaedt v. United States Corset Co.*, 13 *Blatchf.* 371; 10 *Pat. Off. Gaz.* 3; 3 *Bann. & A. Pat. Cas.* 331.

Circumstances arising since or independent of the injunction, rendering it inequitable for the complainant to enforce it,—such as conduct or negotiations on his part which should operate as a release or an estoppel,—may be shown in answer to a motion to attach for contempt, and will induce the court to deny such motion. *Smith v. Patton*, 3 *Pa. L. J. Rep.* 508; 6 *Pa. L. J.* 189.

Attachment for contempt in violating an injunction restraining infringements of a patent, was refused; no sufficient service of notice of motion for the attachment upon any person responsible for the acts complained of being shown. *Bate Refrigerating Co. v. Gillett*, 24 *Fed. Rep'r*, 696; 32 *Pat. Off. Gaz.* 1466.

270. *Enjoining Prosecution of Suits for Infringement.*

Resort to injunction in patent matters is not confined to infringements; there are instances of suits brought by alleged infringers seeking to restrain the prosecution of suits against them.

These cases have not, however, according to the reports, been very frequent, or often successful, especially as respects grants of preliminary injunctions.

Patentees of an improvement in fire-engines having brought a suit against the city of Dover for using infringing engines, the city filed a bill seeking to enjoin the prosecution of that suit; alleging as grounds thereof that the invention covered by the patent had been anticipated, that the city had bought its engines in good faith from the prior inventor, and that the patentees were debarred by laches and estopped from prosecuting their suit. The patentees having filed an answer denying both the anticipation and the laches, &c., it was *held* that the prosecution of the suit could not be enjoined. *City of Concord v. Norton*, 16 *Fed. Rep'r*, 477.

The United States cannot be heard to ask an injunction restraining the commencement or prosecution of suits for infringement of a patent for the repeal of which they have begun an action. *United States v. Colgate*, 22 *Blatchf.* 412; 21 *Fed. Rep'r*, 318.

The circuit court for the southern district of New York, in an infringement suit pending in that district, refused to make an order enjoining or restraining the defendant in that suit from prosecuting suits he had begun in other districts against the plaintiff. *Rumford Chemical Works v. Hecker*, 11 *Blatchf.* 552; 5 *Pat. Off. Gaz.* 664; 5 *Fish. Pat. Cas.* 629.

An injunction should not be granted upon application of a senior patentee to restrain the order of a junior patent alleged to conflict with it, from bringing suits for infringement of his patent; at least until the junior patent has been adjudged invalid. *Asbestos Felting Co. v. United States, &c. Salamander Felting Co.*, 13 *Blatchf.* 453; 10 *Pat. Off. Gaz.* 828; 2 *Bann. & A. Pat. Cas.* 369.

Where a suit is pending against a defendant who is manufacturing and vending an article claimed to be an infringement, and the defendant is responsible for damages and profits, the court in its discretion may enjoin the complainant from bringing other suits against vendees of the defendant, and this although complainant enjoined may not be within the district at the time of the injunction. *Birdsell v. Manuf. Co.*, 1 *Hughes*, 64.

The court, upon a proper showing and in a proper case, in order to avoid a multiplicity of suits, may require the prosecution of suits against mere users and purchasers from the principal infringer to be suspended, and await the determination of the suit pending

between the patentee and the principal infringer ; but the proof should be conclusive that the patented article involved in the suit against the users was purchased of the defendant in the principal suit, and that it is identical in character with that involved in the suit against the principal infringer. *Allis v. Stowell*, 11 *Fed. Rep'r*, 783.

XIX. PLEADINGS ; AT LAW OR IN EQUITY.

271. *Declaration at Law, for Infringement.*

A declaration in an action for damages for infringement is not necessarily bad because it begins in trespass on the case and ends in debt ; nor because it claims for successive, distinct infringements of the same patent ; nor because it avers the patent to be in language of the *import* (instead of *tenor*), following, setting it out in words and figures. *Wilder v. McCormick*, 2 *Blatchf.* 31.

If the declaration professes to set forth the specification as a part of the grant, "according to its tenor" the slightest variation, —*e. g.*, using the word "wheel" for "whirl,"—is fatal. *Tyron v. White*, *Pet. Ct. Ct.* 96.

If the declaration designates the patent by the terms used in the patent, the specification need not be set out in the declaration ; it is matter of evidence on the trial. The defendant can have it put on the record by asking oyer of it. *Gray v. James*, *Pet. Ct. Ct.* 476. See *Pitts v. Whitman*, 2 *Story*, 609 ; *Cutting v. Myers*, 4 *Wash.* 220.

A statement of the plaintiff's patent and a general allegation that the defendant has infringed are sufficient to put the defendant upon answer ; and proof of an infringement of one of several claims in the patent, without proving an infringement of all, will sustain the suit. *Thatcher Heating Co. v. Carbon Stove Co.*, 15 *Pat. Off. Gaz.* 1051 ; 7 *Rep'r*, 199 ; 4 *Bann. & A. Pat. Cus.* 68 ; 2 *N. J. L. J.* 25.

A declaration in a patent suit which shows that the plaintiff has partial interest, only, in the patent is demurrable. *Suydam v. Day*, 2 *Blatchf.* 20. But where the declaration did not aver that the

plaintiff *had* a patent, but that he *claimed* a patent, and that the defendant enjoyed the right, it was *held*, that, although the objection would have been fatal on general demurrer, yet, after verdict, the court would presume that the facts showing the right were proved at the trial; and it therefore would not arrest judgment. *Stanley v. Whipple*, 2 *McLean*, 35.

The declaration for an infringement of a patent need not aver the specific date of the invention; this is immaterial; it must tender an issue upon the novelty and utility of the discovery patented; but it need not aver the regularity of the preliminary proceedings in the issue of the patent. *Wilder v. McCormick*, 2 *Blatchf.* 31.

Where titles to the original patent and an improvement on it are united in the same person, they constitute an entire right, and must be asserted as such in the declaration in an action for infringement; damages cannot be claimed separately for infringements of them. *Case v. Redfield*, 4 *McLean*, 526.

The declaration for infringement of an improvement must set out in what the improvement consists. *Peterson v. Wooden*, 3 *McLean*, 248.

The declaration need not set out in what or by what means the defendant has infringed; averring that the defendant had made, constructed, used and sold the thing patented is enough. *Case v. Redfield*, 4 *McLean*, 526. So is averring that the defendant has made the thing "in imitation of the plaintiff's patent." *Parker v. Haworth*, 4 *McLean*, 370.

The declaration need not state that the stages preliminary to the issuance of the patent were observed, but it must set up the attestation of the President of the United States, and that the patent was delivered. *Cutting v. Fulton*, 4 *Wash.* 220.

Averment that defendant's acts were done "contrary to the statute," is not necessary in an action for infringement, but only in an action brought on a penal statute. *Parker v. Haworth*, 4 *McLean*, 370. S. P., *Tryon v. White*, *Pet. Ct.* 96.

The state of the art and steps which have been taken by the patentee or others are a necessary part of the testimony, and proper averments in a bill, and it is also proper to recite the prior litigation over the same patent. *Steam Gauge & Lantern Co. v. McRoberts*, 36 *Pat. Off. Gaz.* 822.

272. *Plea, or Answer, at Law.*

When an abandonment is relied on, it should be not only stated in the plea, but the facts on which the pleader relies as showing an abandonment should be stated. *Root v. Ball*, 4 *McLean*, 177.

A plea of prior use or sale should aver that it took place more than two years before the application for the patent ; such at least was the rule under the act of 1839, § 7. *Root v. Ball*, 4 *McLean*, 177.

Where, in an action for infringement, no plea or answer is put in, the charge in the declaration is considered as admitted. *Parker v. Banker*, 6 *McLean*, 631.

A special plea that the selling alleged in the declaration, if any such was done, was made by defendant solely as agent and not for his own profit, was *held* bad on special demurrer, because hypothetical, and because it did not state the name of the person for whom the defendant claimed to have acted as agent. *Morse v. Davis*, 5 *Blatchf.* 40.

In order to rely upon a defect of title as a defense under the New York Code, it must be pleaded. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

By taking issue upon a plea its sufficiency is admitted in point of form and substance, and the truth of the facts therein having been established, defendants are entitled to judgment. *Birdseye v. Heilner*, 26 *Fed. Rep'r*, 147.

The proper mode of pleading special matter in defense to an action for infringement of a patent, is considered with reference to the practice under the Oregon Code, in *Cottier v. Stimson*, 9 *Sawyer*, 435 ; 10 *Sawyer*, 212 ; 18 *Fed. Rep'r*, 689 ; 20 *Fed. Rep'r*, 906

273. *Necessity and Uses of Notice Additional to the General Issue.*

The defenses authorized by section 15 of the act of 1836 to be proved under a notice accompanying a plea of the general issue are not required to be set up in that manner. The defendant may, if he prefers, plead specially, setting up the matters of which he

could give notice. The right to plead the general issue and give notice is an enlargement of the defendant's mode of defense; it does not take away the privilege of a special plea. *Wilder v. Gayler*, 1 *Blatchf.* 597; *Day v. New England Car Spring Co.*, 3 *Blatchf.* 179; *Read v. Miller*, 3 *Fish. Pat. Cas.* 310; 2 *Biss.* 12; *Phillips v. Comstock*, 4 *McLean*, 525; *Root v. Davis*, *Id.* 370; *Cottier v. Stimson*, 18 *Fed. Rep'r*, 689.

To entitle a defendant to contest on the trial the novelty of plaintiff's invention under the general issue, he must serve a notice in compliance with the statute. If he fails to do so he cannot introduce evidence to controvert the presumption of novelty deducible from the production of a patent on the part of a plaintiff. *Blanchard v. Putnam*, 8 *Wall.* 420; *rev'g* 2 *Bond*, 84; 3 *Fish. Pat. Cas.* 186. See *Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539; *La Baw v. Hawkins*, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; *Root v. Ball*, 4 *McLean*, 177; *Westlake v. Carter*, 4 *Pat. Off. Gaz.* 636; 6 *Fish. Pat. Cas.* 519; *Pickering v. Phillips*, 10 *Pat. Off. Gaz.* 420; 4 *Cliff.* 383; 2 *Bann. & A. Pat. Cas.* 417; *Bragg v. City of Stockton*, 27 *Fed. Rep'r*, 509.

Evidence of what is old and was in general use at the time of an alleged invention is admissible in actions at law under the general issue, and in equity cases, without any particular averment in the answer. *Brown v. Piper*, 91 *U. S.* 37.

Persons sued for infringement may, on complying with the statutory condition as to notice, give the special defenses mentioned in the patent act in evidence under the general issue; or in a suit in equity, such notice may be given in the answer; and if any one of those defenses is proved, the judgment or decree must be in favor of the defending party, with costs. But in a case where the invention consists in a combination of old elements incapable of division or separate use, such defenses must be addressed to the entire invention and not merely to separate parts of the thing patented. *Bates v. Coe*, 98 *U. S.* 31. S. P., somewhat more fully. *Parks v. Booth*, 102 *U. S.* 96; *aff'g* 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225.

Evidence on the part of the defendant as to whether the machine used by him is like the model of plaintiff's machine, produced in court, is proper under the general issue; no notice is necessary. *Evans v. Hettich*, 7 *Wheat.* 453, 469; *aff'g* 3 *Wash.* 408.

Notice is not necessary to warrant the introduction of evidence of the state of the art to which the plaintiff's invention belongs, at the alleged date of his invention. *Vance v. Campbell*, 1 *Black*, 427; rev'g 1 *Fish. Pat. Cas.* 483. S. P., *La Baw v. Hawkins*, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; *Westlake v. Carter*, 4 *Pat. Off. Gaz.* 636; 6 *Fish. Pat. Cas.* 519.

Where no question is made by the pleadings as to the novelty and originality of the invention, and the prior use relied on in defense is a use by the inventor or under his license, notice of the persons using the invention, or of the places where it was used, is not required. *American Hide, &c. Dressing Machine Co. v. American Tool, &c. Co.*, 1 *Holmes*, 503; 4 *Fish. Pat. Cas.* 284.

The statute does not enumerate all the defenses of which the defendant may avail himself. Others are allowable; such as a denial of infringement; an averment of a license. *Whittemore v. Cutter*, 1 *Gall.* 429, 435.

Evidence, taken under objection that no notice was given of it in the answer, will not be received because the answer is afterward amended so as to include such a notice. *Roberts v. Blake*, 3 *Pat. Off. Gaz.* 268.

The rule is that if the thing patented is an entirety, the statutory defenses must be addressed to the invention itself, not merely to some one or more of its features. This does not prevent each patent in suit, or each invention contained in it, as set forth in the distinct claims, from being made the subject of separate pleas in defense. *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673; 4 *Cliff.* 424. S. P., *Parks v. Booth*, 102 *U. S.* 96; aff'g 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225.

All the defenses which the statute authorizes may be made as well in respect to patents granted upon renewed applications under Rev. Stat. § 4897, as in respect to those issued upon original applications. *United States Rifle, &c. Co. v. Whitney Arms Co.*, 11 *Pat. Off. Gaz.* 373; 14 *Blatchf.* 94; 2 *Bann. & A. Pat. Cas.* 493.

Where the defense to an action for infringement is, that the plaintiff is not the original inventor, defendant is not forbidden to prove former use by certain persons because he specified other persons in his notice. *Evans v. Kremer*, *Pet. Ct.* 215; *Treadwell v. Bladen*, 4 *Wash.* 703.

274. *Requisites and Sufficiency of such Notice.*

No order of court is necessary to entitle a defendant to serve and file the notice of special matter; it may be given after the depositions relied on have been filed in court; and if at first defective, or not sufficiently comprehensive, the defendant may give another. All that is required is a notice in writing, served thirty days before trial. *Teese v. Huntingdon*, 23 *How.* 2.

A mere general reference, in a notice of special matter accompanying the general issue, to an entire and large volume, such as "Ure's Dictionary of Arts, Manufactures, and Mines,"—in which an invention has been described, is not sufficient notice. There must be a more particular reference to the parts relied on, either by pages, titles, or otherwise. Nor can such book, under such a notice, be introduced as "evidence of prior knowledge and use, by said Ure," because the notice does not state at what places the thing was used. *Silsby v. Foote*, 14 *How.* 218; *aff'g* 1 *Blatchf.* 445

A notice under the act of 1836, § 15, in a suit for infringing a patent for mill-stones, which states the names and residences of the witnesses, is sufficiently particular; the particular mill in which the stones were used need not be designated. *Wise v. Allis*, 9 *Wall.* 737.

The true construction of the act, is that the names of those only who invented or used the anticipating machine or improvement, not the names of those who are to testify as to its invention or use, must be pleaded; this is enough to protect a patentee against surprise. *Wilton v. Railroads*, 1 *Wall. Jr.* 192; *Planing Machine Co. v. Keith*, 101 *U. S.* 479; *Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539; *Many v. Jagger*, 1 *Blatchf.* 372. Compare *Judson v. Cope*, 1 *Fish. Pat. Cas.* 616; 1 *Bond*, 327.

Notice specifying certain mining establishments where defendant will show the invention to have been in use is sufficient compliance with the requirement as to specifying places and persons. *Smith v. Frazer*, 2 *Pat. Off. Gaz.* 174; 5 *Fish. Pat. Cas.* 543; 3 *Pittsb.* 397.

Where an answer relies on a previous use of the invention, and witnesses are examined to sustain the defense without objection by the complainant, he cannot afterward have their testimony struck out for want of the notice of their residences required by Rev. Stat. § 4920. *Lock v. Pennsylvania R. R. Co.*, 1 *N. J. L. J.* 227.

275. *Reception of Evidence under It.*

Under a notice of evidence that the machine had been in use in various places in the United States, evidence cannot be given of a prior use in England. *Dixon v. Moyer*, 4 *Wash.* 68.

The act of 1836 did not make the "public work" mentioned in the notice evidence of any other fact than that such description of the improvement was published; statements in such book, that the machine described was operated successfully in specified years will not authorize the jury to infer that it was in operation during the intermediate time. *Seymour v. McCormick*, 19 *How.* 96; aff'g 3 *Blatchf.* 209.

Where a defendant gives notice of a prior use of the invention in suit by a specified person, he is not obliged to call that person, but may prove the fact by another. *Planing Machine Co. v. Keith*, 101 *U. S.* 479, 492; *Many v. Jagger*, 1 *Blatchf.* 376.

Objection that witnesses produced to show a prior use of the invention were not named in the notice must be made when the testimony is taken, otherwise it will be disregarded. *Roemer v. Simm*, 5 *Pat. Off. Gaz.* 555.

Where no notice of prior use has been given, and it has not been set up in the answer, testimony taken, under objection, before a commissioner, will be rejected by the court. *Bragg v. City of Stockton*, 27 *Fed. Rep'r*, 509.

276. *Bill in Equity for Infringement.*

In a suit for infringement of a patent, an allegation in the complaint, of the residence of the parties, is not necessary to impart jurisdiction. *Teese v. Phelps*, *McAll.* 17.

Where the bill shows that defendant resides in another district, the marshal's return of service must show affirmatively that the subpoena was served within the district in which the suit is brought, to give the court jurisdiction; unless there is a voluntary appearance, which is a submission to the jurisdiction, and will cure the defect. *Thayer v. Wales*, 5 *Fish. Pat. Cas.* 448.

The bill itself, or an affidavit accompanying it on the motion for a preliminary injunction, must contain an averment that the complainant (if the patentee), was the inventor; the usual oath in

making application for the patent, to the originality of the invention will not supply the place. *Sullivan v. Redfield*, 1 *Paine*, 441. To same effect, *Rogers v. Abbott*, 4 *Wash.* 514.

The bill should set forth that, after the issuing of the patent, the complainant had put his invention into use, or had sold the same for a valuable consideration, and is, at the time of the filing of the bill, in the exclusive possession of such patent. *Isaacs v. Cooper*, 4 *Wash.* 259.

Where a patent is void on its face for want of novelty, a bill in a suit for infringement may be dismissed without regard to the answer. *Quirolo v. Ardito*, 1 *Fed. Rep'r*, 610 ; 17 *Blatchf.* 400 ; 5 *Bann. & A. Pat. Cas.* 80.

Allegations, in a bill of equity for infringement of a patent, describing prior patents to the same inventor involving the same principle, upon exceptions to them as immaterial and impertinent, were *held* proper as showing the the history of the invention. *Steam-guage & Lantern Co. v. McRoberts*, 26 *Fed. Rep'r*, 765.

It is not necessary to allege, in a bill for the infringement of a patent for a machine, what articles were made by the use of the machine, in addition to the fact that it was used. *Fischer v. Hayes*, 6 *Fed. Rep'r*, 76 ; 19 *Blatchf.* 26.

The bill need not specify the particulars of the infringement ; a general charge of infringement is all that is necessary to require the defendant to answer the bill. *Turrell v. Cammerer*, 3 *Fish. Pat. Cas.* 462 ; *Haven v. Brown*, 6 *Ill.* 413.

Infringement must be shown to have occurred prior to filing the bill therefor. *Slessinger v. Buckingham*, 17 *Fed. Rep'r*, 454 ; 8 *Sawyer*, 469.

The bill need not contain an express prayer for damages ; they are recoverable under the prayer for general relief. *Emerson v. Simm*, 3 *Pat. Off. Gaz.* 293 ; 6 *Fish. Pat. Cas.* 281.

A bill in equity for infringement of a reissued patent need not aver, specifically, the ground on which the original patent was surrendered and the reissue obtained ; nor need it allege facts to show that the commissioner of patents had jurisdiction to entertain the application. *Spaeth v. Barney*, 22 *Fed. Rep'r*, 828 ; 30 *Pat. Off. Gaz.* 997.

An assignee of a patent need not aver in his bill the recording of the instrument, but may treat the defendant as a wrongdoer, and put him to set up in his answer that he is a *bona fide* purchaser for value without notice. *Perry v. Corning*, 7 *Blatchf.* 195.

A bill for infringement filed by the assignee of a patent, set forth the infringement as having occurred while the patent was owned by the assignor, the assignment of "all the right, interest and claim for and to the past use of said invention," and prayed for an injunction and an accounting, and for "such other and further relief as shall be agreeable to equity." This was *held* sufficient to entitle complainant to recover for infringement before as well as after the assignment to him. *Campbell v. James*, 2 *Fed. Rep'r*, 338; 18 *Blatchf.* 92; 18 *Pat. Off. Gaz.* 1111; 10 *Rep'r*, 103; 5 *Bann. & A. Pat. Cas.* 354. See also, 5 *Fed. Rep'r*, 806; 10 *Rep'r*, 686.

It is unnecessary to set up in a bill, the various facts from which complainant's title may be deduced; a simple averment that the title was vested in the plaintiff is sufficient. *Nourse v. Allen*, 4 *Blatchf.* 376; 3 *Fish. Pat. Cas.* 63.

277. Multifariousness in such Bills.

A bill is not necessarily obnoxious to the charge of multifariousness because the suit is brought upon more than one patent. Courts encourage this to avoid multiplicity of suits, but in such cases the bill must allege and the proof show that the inventions embraced in several patents are capable of conjoint use and are so used by defendants. *Lilliendahl v. Detwiller*, 18 *Fed. Rep'r*, 176; 16 *Rep'r*, 775.

When a bill in equity alleges infringements of several patents for different inventions, to escape the objection of multifariousness it must aver that the inventions are capable of conjoint use, and that they are in fact so used by the defendant. *Barney v. Peck*, 16 *Fed. Rep'r*, 413; 15 *Rep'r*, 548; 24 *Pat. Off. Gaz.* 101. *S. P.*, *Gamewell Fire Alarm Tel. Co. v. Chillicothe*, 7 *Fed. Rep'r*, 351; *Gillespie v. Cummings*, 3 *Sawyer*, 259; 1 *Bann. & A. Pat. Cas.* 587; *Nourse v. Allen*, 4 *Blatchf.* 376; 3 *Fish. Pat. Cas.* 63; *Shickle v. South St. Louis Foundry Co.*, 22 *Fed. Rep'r*, 105; *Pope Manuf. Co. v. Marqua*, 15 *Fed. Rep'r*, 400.

A bill can not be brought for the infringement of distinct patents which are not capable of being used together in making a single structure. *Hayes v. Dayton*, 8 *Fed. Rep'r*, 702; 18 *Blatchf.* 420; 18 *Pat. Off. Gaz.* 1406; 10 *Rep'r*, 802; *Hayes v. Bickelhaupt*, 19 *Pat. Off. Gaz.* 177; *Barney v. Peck*, 24 *Pat. Off. Gaz.* 101; *S. C.*, 16 *Fed. Rep'r*, 413.

Upon the alleged infringement of five distinct patents by the use of one machine, each invention being capable of separate use, it was *held* that the trial of the validity and infringement of each must be upon separate issues, and that a bill uniting the cause was multifarious. *Consolidated Electric Light Co. v. Brush-Swan Electric Light Co.*, 20 *Fed. Rep'r*, 502 ; 22 *Blatchf.* 206 ; 28 *Pat. Off. Gaz.* 544.

A bill brought by a patentee to recover profits and damages for an alleged infringement of thirty-eight claims in six different patents, is demurrable on the ground of multifariousness, where there is nothing in the bill to show that any two or more of the patents are in fact, or are capable of being, used in making a single structure, and where the defendant would be prejudiced by being compelled to defend himself in one suit against so many alleged causes of action. *Hayes v. Dayton*, 8 *Fed. Rep'r*, 702 ; 18 *Blatchf.* 420 ; 18 *Pat. Off. Gaz.* 1406 ; 10 *Rep'r*, 802.

Where suit is brought for the infringement of several patents for different improvements not necessarily embodied in the construction and operation of any one machine, the bill must contain an explicit averment that the infringing machines contain all the improvements embraced in the several patents, or it will be bad for multifariousness. *Nellis v. McLanahan*, 6 *Wish. Pat. Cas.* 286.

A bill which, under Rev. Stat. § 4918, prays an adjudication concerning conflicting patents, and also alleges an infringement of the plaintiff's patent by the defendant, and prays an accounting and damages, is not demurrable for misjoinder of causes of action. *Leach v. Chandler*, 18 *Fed. Rep'r*, 262.

Where the right to both patents alleged to be infringed, for the State of California, has been assigned to complainant, the bill is not bad for multifariousness because the assignment of one of the patents also embraces other territory than the State of California. *Gillespie v. Cummings*, 3 *Sawyer*, 259 ; 1 *Bunn. & A. Pat. Cas.* 587.

A bill in equity against a corporation and its assignee under a State insolvent law, alleged the making of such assignment infringement of complainant's patent by the corporation, and by the assignee after the assignment to him, and that he was threatening to distribute to the creditors of the corporation the moneys realized by him from its property and assets ; and prayed an injunction, an accounting of profits, damages, &c. It was *held* that the bill was not multifarious ; and that the jurisdiction of the circuit court to

entertain the suit was not affected by the insolvent law of the State. *Gordon v. St. Paul Harvester Works*, 23 *Fed. Rep'r*, 147.

273. *What Faults in such Bills may be Reached by Demurrer.*

As to all merely formal defects in the bill, the objection must be taken by way of demurrer. *Pelham v. Edelmyer*, 25 *Pat. Off. Gaz.* 292 ; 15 *Fed. Rep'r*, 262 ; 21 *Blatchf.* 188.

In a suit for infringement of a patent, a demurrer to the complaint on the ground that it did not state where the complainant, a corporation, was located or did business, was overruled. *National Hay-rake Co. v. Herbert*, 2 *Week. N. of Cas.* 100.

If one who has no interest in the subject-matter of the suit, or in the relief prayed, be joined as a party complainant, the defect may be reached by a general demurrer for want of equity. *Hodge v. Northern Missouri & Iron Mt. R. R. Co.*, 1 *Dill.* 104 ; 4 *Fish. Pat. Cas.* 161.

A bill in equity, based on two patents, which alleged that the defendant was using machines containing, in one and the same apparatus, the inventions secured by each of the two patents, was sustained on demurrer. *Horman Patent Manuf. Co. v. Brooklyn City R. R. Co.*, 15 *Blatchf.* 444 ; 4 *Bann. & A. Pat. Cas.* 86 ; 7 *Rep'r*, 295.

A bill in equity for the infringement of a patent alleged that the complainant "was the true, original and first inventor of a certain new and useful improved application of steam power to the capstans of vessels, not known or used before," and made profert of his letters-patent and the specifications thereto annexed ; and further alleged "that the defendant is now constructing, using and selling steam power capstans for vessels, in some parts thereof substantially the same in construction and operation as in the said letters-patent mentioned." It was *held*, upon demurrer to the bill, that it sufficiently described the patent and alleged infringement of it. *McMillin v. St. Louis & Mississippi Valley Transp. Co.*, 5 *McCrory*, 561 ; 18 *Fed. Rep'r*, 260.

A bill in equity for injunction and an accounting, alleged that one of the defendants made a machine infringing complainant's patent, and sold it to the other defendant, who had ever since used it and still continued to use it ; but it appeared that the machine

was made more than three years before the complaint was filed, and there was no claim of any threat to repeat the wrongful act; and it also appeared that the extent of the injury to complainants from the use of the machine was a suitable license fee. It was *held*, on demurrer, that there was an adequate remedy at law, and no ground of equity jurisdiction. *Smith v. Sands*, 24 *Fed. Rep'r*, 470; 32 *Pat. Off. Gaz.* 1467.

Upon a bill in the usual form for infringement, a demurrer on the sole ground that the complainant is not entitled to equitable relief, should not be sustained, where there is nothing in the bill to indicate laches on the part of the complainant, or that he has granted or intends to grant licenses, or that a money judgment for damages alone will indemnify him, or that ultimately an injunction should not issue for his protection. *Brick v. Staten Island R. Co.*, 25 *Fed. Rep'r*, 553.

A bill in equity alleged the invention of a new and original design for a curtain and loop, and that letters patent therefor, of a specified number and date were granted and delivered to the inventor, and contained the usual averments in regard to the execution of the letters patent; but no other description of the invention was given, and no reference was made to the patent for a further description. It was *held*, upon demurrer, that the bill did not sufficiently describe the invention as patented. *Post v. T. C. Richards Hardware Co.*, 25 *Fed. Rep'r*, 905.

Where it appears from a bill founded on a reissue patent that the sole object of the reissue was to enlarge and expand the claims of the original patent; and that a delay of more than two or more years took place in applying for the reissue, which is not explained by special circumstances showing it to be reasonable, a general demurrer lies to the bill for want of equity. The decision of the patent-office as to the reasonableness of the delay is not conclusive. And the delay being *prima facie* unlawful, the party seeking to establish the jurisdiction of the patent-office to grant the reissue has the burden of proving the facts on which it rests. *Wollensak v. Reiher*, 22 *Fed. Rep'r*, 651; *aff'd*, 115 *U. S.* 96.

A bill which, under section 9818 Revised Statutes, upon proper averments prays an adjudication concerning conflicting patents and also alleges infringement by reason of the manufacture and sale by defendant of articles constructed under his patent, and prays an accounting and damages, is not demurrable for misjoinder of causes of action. *Leach v. Chandler*, 18 *Fed. Rep'r*, 262.

In an action for infringement of patent, an assignment of the patent, profert of which is formally made in the complaint, is for all purposes presented to the court as part of the pleading, and a demurrer for a cause arising therefrom may be sustained as if it appeared upon the face of the complaint. *Bogart v. Hinds*, 25 *Fed. Rep'r*, 484.

279. *Plea, or Answer, in Equity.*

A plea filed in answer to a bill against a single defendant for infringement, which alleged that the sales were not made by defendant alone, but were made by him and another person named in the plea, was held bad, because it failed to allege that such other person was yet living within the jurisdiction of the court. *Good-year v. Toby*, 6 *Blatchf.* 130.

Where, in answer to a bill of complaint for infringement, the defendants filed a plea involving three distinct grounds of defense, such plea was held bad for duplicity. The several matters, although relating in a general way to but a single defense,—viz. : the invalidity of the complainant's patent,—were essentially independent of one another, and by their retention destroyed the very office of the plea, which is to secure singleness in the issue. *Reissner v. Anness*, 12 *Pat. Off. Gaz.* 842 ; 3 *Bann. & A. Pat. Cas.* 148. The general rule is that a plea must not contain more than one defense. It is not limited to one fact ; it may embrace various facts ; but they must all conduce to a single point on which the defendant rests his defense. If there is more than one distinct ground of defense to be urged, the defendant should set the matter forth by way of answer and not of plea. *Ib.*

To a bill for infringement, which by sworn allegations fully vested the court with jurisdiction, the defendant filed a sworn plea which admitted the validity and infringement of the patents, but denied the jurisdiction, as it alleged a right to use the patented processes under a contract emanating from the only complainant in interest, and as such complainant was a citizen of the same State with himself, in the absence of further proof,—the plea was held insufficient. *Lilienthal v. Washburn*, 8 *Fed. Rep'r*, 707.

Ex parte affidavits introduced without notice to complainant, or without tender of affiant for cross-examination, and writings under private signature unauthenticated, are inadmissible upon the hearing of such plea. *Ib.*

Where parties in their answer, as originally filed, to a bill for infringing a patent, admit that they did manufacture and sell the articles alleged to have been patented, the fact thus admitted in the answer must be accepted as established; but the court will, when justice will be promoted, assume that the smallest number of articles consistent with the circumstances, were made. *Jones v. Morehead*, 1 *Wall.* 155.

Where, in a suit for the infringing of letters patent for a combination of old elements or devices, the parts of which are not susceptible of division or separate use, the answer sets up that the complainant is not the first and original inventor, the defense must apply to the combination as an entirety, and not to a part of it, or to one or more of the claims of the letters, if they do not cover the entire invention. *Parks v. Booth*, 102 *U. S.* 96.

An answer to a bill which avers that the defendant will in future, as he has heretofore done, violate the rights secured by the patent as established on the trial at law, unless restrained by injunction, is not sufficient if defendant merely alleges that what he has done since the trial has not been in violation of the plaintiff's rights; but should state distinctly that the defendant does not intend in future to do the specific things which the court has determined he has no right to do. *Poppenhusen v. New York Gutta Percha Comb Co.*, 4 *Blatchf.* 184; 2 *Fish. Pat. Cas.* 74.

The defense that the specification is insufficient is not available unless properly pleaded. *Goodyear v. Providence Rubber Co.*, 2 *Cliff.* 351; 2 *Fish. Pat. Cas.* 499.

Persons charged as infringers may set up the defense that the patentee was not the original and first inventor of the alleged improvement; but, if the suit is in equity, they must allege in the answer the names and places of residence of those whom they intend to prove have possessed the prior knowledge of the thing, and where the same has been used. Such notice is required for the benefit of the complainant to prevent surprise; but an answer does not meet that requirement if it furnishes to the complainant no means of knowing the respondent's theory of the construction of the patent. *Graham v. Mason*, 4 *Cliff.* 88; 5 *Fish. Pat. Cas.* 1. *S. P.*, *Orr v. Merrill*, 1 *Woodb. & M.* 376; *Teese v. Huntington*, 23 *How.* 2, 10.

Unless the answer contains notice of prior patents, or persons by whom, and places where, the patented improvement was known or used before the alleged invention of the patentee, copies of the

drawings of prior patents, and testimony respecting them, are not admissible in evidence, against the complainant's objection, to show that the patentee was not the original and first inventor of the patented improvement. *Earl v. Dexter*, 1 *Holmes*, 412 ; 6 *Pat. Off. Gaz.* 729 ; 1 *Bann. & A. Pat. Cas.* 400.

In suits for infringement the pleadings should be single, clear, and free from evasion, and the issue tendered clear and unconditional. More than one defense may be presented in an answer, but each should be separately and clearly alleged without condition or qualification. *Graham v. Mason*, 4 *Cliff.* 88 ; 5 *Fish. Pat. Cas.* 1. To same effect, *Jordan v. Wallace*, 5 *Fish. Pat. Cas.* 185 ; 8 *Phila.* 165 ; 1 *Leg. Gaz.* 355.

Defenses not set up in the answer will not be considered by the court in rendering its decision. *Howes v. Nute*, 4 *Cliff.* 173 ; *Wonson v. Peterson*, 13 *Pat. Off. Gaz.* 548.

Evidence of what is old and in general use at the time of an alleged invention, is admissible in equity cases without any averment in the answer. *Brown v. Piper*, 9 *U. S.* 37. See also, *Slawson v. Grand St. R'y Co.*, 107 *U. S.* 649.

An averment, in the answer, that a patent "was obtained upon false and fraudulent representations by the plaintiffs, or some of them, made to the commissioner of patents, and is wholly void in law," is too general to raise any traversable issue. *Clark v. Scott*, 5 *Fish. Pat. Cas.* 245 ; 9 *Blatchf.* 301 ; 2 *Pat. Off. Gaz.* 4.

The defense that the patentee had allowed the invention to be in public use or on sale for more than two years before he applied for a patent is distinct from the defense that he had abandoned it to the public, and should not be blended with it in the same pleading. *Jones v. Sewall*, 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; 6 *Fish. Pat. Cas.* 343.

If defendant wishes to claim that the supposed invention is not new, that defense should be set up in the plea or answer ; otherwise the evidence in support of the defense is not admissible ; but the pleadings need not specify that the subject of the invention is not patentable in its character ; this may be shown under the general issue. *Guidet v. Barber*, 5 *Pat. Off. Gaz.* 149.

The defenses of a prior patent or previous description in a printed publication, specified in Rev. Stat. § 4920, subd. 3, must, in a suit in equity, be set up in an answer and not in a technical plea. *Carrick v. McKesson*, 8 *Fed. Rep'r*, 807 ; 19 *Blatchf.* 369.

In a suit for infringement, a plea which sets up in general terms

the single defense of non-infringement, without answering, will be stricken out on motion. *Sharp v. Reissner*, 9 *Fed. Rep'r*, 445 ; 20 *Blatchf.* 10 ; 20 *Pat. Off. Gaz.* 1161 ; 12 *Rep'r*, 611.

A licensee under a patent cannot, by a plea in bar, raise such issues as are usually made in answer to a suit for infringement. *White v. Lee*, 4 *Fed. Rep'r*, 916.

In an equity suit against a licensee for an account of profits and damages, and for an injunction for infringement of a patent, it is not inconsistent to allege in an answer that respondent was acting under a license, or that the patent was invalid, where the recital or covenants of the instrument do not forbid the setting up of such a defense. *National Manuf. Co. v. Myers*, 7 *Fed. Rep'r*, 355.

Though an answer denying information as to the infringement of a patent, and denying damages, is insufficient, the orator by replying admits its sufficiency, and assumes the burden of proving the infringement. *Wooster v. Muser*, 20 *Fed. Rep'r*, 162 ; 28 *Pat. Off. Gaz.* 286.

An answer which only denies that the defendants used the patented invention "with a full knowledge of the premises mentioned in said bill of complaint, and in violation of the complainant's exclusive right secured by the patent of 1864," is an implied admission of its actual use, and complainant is not required to make any further proof of infringement. *Jordan v. Wallace*, 5 *Fish. Pat. Cas.* 185 ; 8 *Phila.* 165 ; 1 *Leg. Gaz.* 355.

280. *Amended, Supplemental, or Cross Bill.*

The bill having been brought, answered and tried upon the theory that a recovery upon the assigned claims was sought, the assignee of a patent, in a suit against an alleged infringer, was allowed to amend his bill, before the signing of an interlocutory decree, so as to include assigned claims for damages and profits due to mesne assignors. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 20 *Fed. Rep'r*, 505.

In order to continue an injunction granted on an original patent as to the amended patent, issued upon the surrender of the original patent, a supplemental bill must be filed. *Woodworth v. Stone*, 3 *Story*, 749.

Where a bill in equity was filed in a case of infringement of reissued letters patent, to which answer was made by respondents,

and complainant closed his *prima facie* case by taking proofs, it was held that such complainant would be allowed to file a subsequent bill for infringement of the letters-patent after the filing of the first bill of complaint, and that in such proceedings the testimony taken in the first proceeding, so far as relevant, could be used and considered in the subsequent proceedings. *Turroll v. Spaeth*, 9 *Pat. Off. Gaz.* 1163.

Where the question of priority of invention was put in issue in the original suit, evidence of other alleged anticipations than those set up in that suit is merely cumulative, and is not a ground for granting leave to file a supplemental bill. *Blandy v. Griffith*, 6 *Fish. Pat. Cas.* 434.

Leave to file a supplemental bill, in the nature of a bill of review, after dismissal of the original bill in a suit for infringement, for the purpose of introducing new evidence, was refused, where it was not sufficiently shown that the petitioner could not with reasonable diligence, have obtained the new evidence before the hearing on the original bill, and the new matter was itself not material. *Spill v. Celluloid Manuf. Co.*, 29 *Pat. Off. Gaz.* 773.

A cross-bill is properly filed to establish an equitable title to letters-patent, the legal title to which is in the plaintiff in the original bill filed for an infringement of such patent. *Brandon Manuf. Co. v. Prime*, 14 *Blatchf.* 371 ; 3 *Bann. & A. Pat. Cas.* 191. Where a cross-bill brought for relief as well as defense shows that persons not parties to the original bill are necessary parties to the cross-bill, they may properly be made such. *Ib.*

In a suit against an interfering patentee, under section 4918 of the Revised Statutes, the defendant is not required to file a cross-bill in order to obtain affirmative relief. *Lockwood v. Cleaveland*, 6 *Fed. Rep'r*, 721.

281. *Amended or Supplemental Answer.*

Where, after setting up the defense of prior knowledge and use, and giving the names and residences of witnesses intended to be called to prove the defense, the answer to a bill for infringement alleges that the names and residences of certain other witnesses are unknown to the defendant, and prays leave to insert and set forth in the answer such names and residences when they shall be discovered, such amendment may be allowed, on subsequent discovery

of the facts ; and leave to make it may be granted *nunc pro tunc*. *Roemer v. Simon*, 95 *U. S.* 214.

In view of certain circumstances the court permitted an amendment, at the hearing, of the answer with relation to the notice, *nunc pro tunc* as of the time the answer was filed. *Roberts v. Ryer*, 11 *Blatchf.* 11, 34.

The objection to the omission, in an answer, to set forth the defense of want of novelty with sufficient distinctness ought to be taken by exceptions ; as the answer may be amended under special order. *Graham v. Mason*, 4 *Cliff.* 88 ; 5 *Fish. Pat. Cas.* 1.

Upon a motion to open a decree and amend the answer by setting up the prior issue of a French patent for the same invention, it was *held* that such patent could be admitted only as affecting the question of the duration of the United States patent, and not upon the question of novelty. *De Florez v. Raynolds*, 8 *Fed. Rep'r*, 434 ; 17 *Blatchf.* 436 ; 17 *Pat. Off. Gaz.* 503.

A motion will be denied which was made after reference to a master to amend an answer by setting up a new defense denying the manufacture of the articles alleged to be an infringement of plaintiffs' patent, where the omission was not due to inadvertence or mistake. *Evory v. Candee*, 5 *Bann. & A. Pat. Cas.* 67.

A motion will not be granted for an amendment to answer and commission to take testimony in a foreign country to prove who is the original inventor of a patent, when the affidavits filed by plaintiff show that the answer, if amended as proposed, cannot be sustained by proof. *Hicks v. Otto*, 17 *Fed. Rep'r*, 539.

After answering a bill for infringement, setting up that defendants held an assignment from plaintiffs, the defendants discovered reason to believe that the patent was invalid. It was *held* that they might file a supplemental answer denying the validity of the patent. *Morehead v. Jones*, 3 *Wall. Jr.* 306.

XX. EVIDENCE.

282. *Judicial Notice.*

The courts of the United States, in determining a question whether the production of a particular patented article has involved an exercise of the inventive faculties, may take judicial knowledge of matters of common knowledge, and of things in common use. *Brown v. Piper*, 91 *U. S.* 37; *Terhune v. Phillips*, 99 *U. S.* 592; *King v. Gallun*, 109 *U. S.* 99; *Dunbar v. Myers*, 94 *U. S.* 187; *Slawson v. Railroad Co.*, 107 *U. S.* 649.

283. *Presumptions.*

As a patent is allowed by law to be issued only upon preliminary proofs to be laid before the commissioner, upon the sufficiency of which he is to decide, the fact that a patent has been granted raises a presumption that sufficient proof of the required facts was duly made, and found satisfactory, and that all proceedings upon which he was required to pass were regularly taken. *Philadelphia & Trenton R. R. Co. v. Stimpson*, 14 *Pet.* 448, 458; *Potter v. Holland*, 1 *Fish. Pat. Cas.* 382; 4 *Blatchf.* 238; *Cahoon v. Ring*, 1 *Fish. Pat. Cas.* 397; *Hays v. Sulsor*, *Id.* 532; 1 *Bond*, 279; *Judson v. Moore*, 1 *Bond*, 285; 1 *Fish. Pat. Cas.* 544; *Matthews v. Skates*, *Id.* 602; *Wayne v. Holmes*, 2 *Fish. Pat. Cas.* 20; 1 *Bond*, 27; *Poppenhusen v. N. Y. Gutta Percha Comb Co.*, 2 *Fish. Pat. Cas.* 62; *Hussey v. Whiteley*, *Id.* 120; 1 *Bond*, 407; *Cox v. Griggs* 2 *Fish. Pat. Cas.* 174; 1 *Biss.* 362; *Poppenhusen v. Falke*, 2 *Fish. Pat. Cas.* 181; 5 *Blatchf.* 493; *Clarke Patent Steam, &c. Co. v. Copeland*, 2 *Fish. Pat. Cas.* 221; *Union Sugar Refinery Co. v. Matthiessen*, *Id.* 600; 3 *Cliff.* 639; *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 *Fed. Rep'r*, 509.

This is so even though no recital to such effect appears in the patent. *Gear v. Grosvenor*, 3 *Pat. Off. Gaz.* 380; 1 *Holmes*, 215; 6 *Fish. Pat. Cas.* 314.

And the rule applies to the granting of reissues; the presumption of law being, that the commissioner of patents has done his duty in granting a reissue, thoroughly, faithfully and properly, and the question of its propriety is not open for re-examination,

except on the ground of fraud. *Miller, &c. Manuf. Co. v. Du Brul*, 2 *Bann. & A. Pat. Cas.* 618; 12 *Pat. Off. Gaz.* 351. The reissue is presumed right, and the burden of proving the reverse is on the party alleging the invalidity. *American Middlings Purifier Co. v. Atlantic Milling Co.*, 3 *Bann. & A. Pat. Cas.* 168; *Allen v. Blunt*, 2 *Woodb. & M.* 121, 138; *Stimpson v. Westchester R. R. Co.*, 4 *How.* 380. And where the infringement consists in the defendant's using a machine for which a patent has been issued to him, he should have the benefit of a like presumption in his favor, arising from the official investigation of the originality of his invention, as the plaintiff has by reason of his patent. *Corning v. Burden*, 15 *How.* 252, 271.

But the action of the commissioner in issuing a patent does not preclude one charged with infringing, from impeaching the patent by proof that before it was issued, the patentee had abandoned his invention to the public. *Planing Machine Co. v. Keith*, 101 *U. S.* 479.

Issuing the patent is presumptive evidence of the novelty and utility of the invention, and throws the burden of disproving them upon the defendant. *Alden v. Dewey*, 1 *Story*, 336; 3 *L. Rep'r*, 383. *S. P., Needham v. Washburn*, 4 *Cliff.* 254; 7 *Pat. Off. Gaz.* 649; 1 *Bann. & A. Pat. Cas.* 537; *Storrs v. Howe*, 10 *Pat. Off. Gaz.* 421; 4 *Cliff.* 388; 2 *Bann. & A. Pat. Cas.* 420; *Parker v. Stiles*, 5 *McLean*, 44, 62; 7 *West. L. J.* 168; *Teese v. Phelps*, *McAll.* 48; *Corvallis Fruit Co. v. Curran*, 8 *Fed. Rep'r*, 150; 7 *Sawyer*, 270; 27 *Int. Rev. Rec.* 272. A renewal of the patent strengthens the presumption, though it still may be overthrown. *Ransom v. New York*, 1 *Fish. Pat. Cas.* 252; *Smith v. Plympton*, 4 *West. L. J.* 49.

When the question is as to issuing a preliminary injunction, presumptions of the novelty of a patented invention may arise: 1. From the oath of the patentee that he was the first and original inventor. 2. From the action of the patent-office in granting the patent after full examination. 3. Undisturbed enjoyment of all the benefits of the exclusive rights granted by the patent. 4. Direct adjudications, either at law or in equity, establishing the validity of the patent. 5. Injunctions granted to restrain infringement of the patent. When such grounds exist, courts will not refuse an injunction, or, if granted, will not dissolve it, unless the patent is impeached by the most conclusive evidence. *Hussey v. Whitely*, 1 *Bond*, 407; 2 *Fish. Pat. Cas.* 120.

The issuing of a patent raises a presumption that the patentee, at the time of making his application for a patent, believed himself to be the original inventor or discoverer of the thing patented (*Union Sugar Refinery Co. v. Mathiessen*, 3 *Cliff.* 639 ; 2 *Fish. Pat. Cas.* 600); and this presumption, arising from the oath of the applicant that he believes himself to be the first inventor or discoverer of the thing for which he seeks letters patent, remains until the contrary is proved. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

The presumption of patentability arising from the grant of a patent, was *held* not repelled, where the device in question, though common, was shown never to have been used for the purpose patented. *Patterson v. Duff*, 20 *Fed. Rep'r*, 641.

The issue, reissue and extension of a patent, and the fact that it has been sustained in previous suits, create a strong presumption against a defense of want of novelty in the invention. *Jordan v. Dobson*, 2 *Abb. U. S.* 398 ; 7 *Phila.* 533. And see *Tyler v. Crane*, 7 *Fed. Rep'r*, 775 ; 19 *Pat. Off. Gaz.* 128

Inasmuch as letters-patent for an invention are issued upon adjudication of public officer, the presumption is that he adjudicated the facts correctly ; if in due form, they raise a presumption that the person named as inventor is the original and first inventor of what is therein described as the improvement ; and the burden of proof to sustain an opposite conclusion is on the party attacking the patent. *Sands v. Wardwell*, 3 *Cliff.* 277 ; *Union Sugar Refinery Co. v. Mathiessen*, 2 *Fish. Pat. Cas.* 600 ; *Hudson v. Draper*, 4 *Fish. Pat. Cas.* 256 ; 4 *Cliff.* 178 ; *Goodyear Dental Vulcanite Co. v. Gardner*, 3 *Cliff.* 408 ; 5 *Pat. Off. Gaz.* 586 ; 4 *Fish. Pat. Cas.* 224 ; *Storrs v. Howe*, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420 ; *Haskell v. Shoe Machinery Manuf. Co.*, 3 *Bann. & A. Pat. Cas.* 553.

A patentee has a right to rest upon his patent for his invention, till its validity is overthrown ; thus, if there is reasonable doubt as to defendant's claim to priority of invention, the patentee is entitled to the benefit of that doubt. *Crouch v. Spear*, 6 *Pat. Off. Gaz.* 187 ; 1 *Bann. & A. Pat. Cas.* 145 ; *Washburn v. Gould*, 3 *Story*, 122, 142 ; 7 *L. Rep'r*, 276 ; 1 *West. L. J.* 465.

Priority in the *construction* of a mechanical appliance is ground for a presumption of priority of *invention*. *Atkinson v. Boardman*, 1 *MacArthur Pat. Cas.* 80 ; *Warner v. Goodyear*, *Id.* 60.

The presumption arising from the letters patent, that the paten-

tee was the original and first inventor, in the absence of the application for the patent, extends back only to the date of the letters patent, and in no case does it extend further back than to the time of the filing of the original application ; when a patentee needs to show that his invention was made prior to the date of his application, he must prove the fact by other sufficient evidence. *Wing v. Richardson*, 2 *Fish. Pat. Cas.* 535 ; 2 *Cliff.* 449. S. P., *Jones v. Sewall*, 6 *Fish. Pat. Cas.* 343 ; 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; *Union Sugar Refinery Co. v. Mathiessen*, 2 *Fish. Pat. Cas.* 600 ; 3 *Cliff.* 639.

In order to overcome the presumption raised by a patent that the patentee is the first inventor of the article monopolized, it must be shown that there was a prior knowledge of the invention under such circumstances as to give the public a right to continue the use of it. This presumption prevails over a reasonable doubt existing as to the truth of the evidence adduced to impeach the novelty of invention. *Crouch v. Speer*, 6 *Pat. Off. Gaz.* 187 ; 1 *Bann. & A. Pat. Cas.* 145. To same effect, *Patterson v. Duff*, 20 *Fed. Rep'r*, 641 ; *Comstock v. Sandusky Seat Co.*, 3 *Cin. L. Bul.* 73.

The issuance of a patent raises a presumption that the patentee was first inventor ; in other words, the courts presume the decision of the commissioner in favor of the originality of the patentee to be correct. *Donoghe v. Hubbard*, 27 *Fed. Rep'r*, 742 ; *Pitts v. Hall*, 2 *Blatchf.* 229 ; *Rogers v. Beecher*, 3 *Fed. Rep'r*, 639 ; 5 *Bann. & A. Pat. Cas.* 619 ; 18 *Pat. Off. Gaz.* 793 ; *Konold v. Klein*, 5 *Rep'r*, 427 ; *McMillin v. Barclay*, 4 *Brews.* 275 ; 3 *Pittsb.* 377 ; 5 *Fish. Pat. Cas.* 189 ; *Brodie v. Ophir Silver Mining Co.*, 5 *Sawyer*, 608 ; 4 *Fish. Pat. Cas.* 137.

This presumption of originality of invention is not overcome by evidence introduced to impeach novelty, which does not clearly establish that the alleged anticipating device embodied the same construction and mode of operation. *Brady v. Atlantic Works*, 10 *Pat. Off. Gaz.* 702 ; 4 *Cliff.* 408 ; 2 *Bann. & A. Pat. Cas.* 436.

The claim that the patentee was the first inventor of the improvement patented is not defeated by showing the construction of the improvement before the patent issued ; there must be proof that the construction preceded the invention of the patentee ; that is, before the conception of the improvement was applied in practice. *Brodie v. Ophir Silver Mining Co.*, 5 *Sawyer*, 608 ; 4 *Fish. Pat. Cas.* 137.

Clear and satisfactory proof is required to rebut the presump-

tion of priority of invention arising from the issuing of a patent. *Rogers v. Beecher*, 5 *Bann. & A. Pat. Cas.* 619 ; 3 *Fed. Rep'r*, 639 ; 18 *Pat. Off. Gaz.* 793 ; *Konold v. Klein*, 5 *Rep'r*, 427.

When the invention consists of an improvement on an old machine, it may be taken for granted that a practical mechanic is acquainted with the construction of the machine on which the improvement is made. *Ives v. Hamilton*, 92 *U. S.* 426 ; 6 *Fish. Pat. Cas.* 244 ; 1 *Pat. Off. Gaz.* 336.

There is a presumption that any person who takes out a patent will ascertain, so far as possible, from the public records what patents of the same nature have previously been taken out. *Odiorne v. Winkley*, 2 *Gall.* 51.

The presumption of right in a patentee, because of the acquiescence of the public in his claim, is not changed in consequence of the original patent being surrendered on account of its informality. *Orr v. Badger*, 7 *L. Rep'r*, 465 ; 1 *Brunner Col. Cas.* 537.

A presumption of abandonment cannot arise from the sale or use of an invention with the knowledge and consent of the patentee, intermediate the application for a patent, and the grant. *Howe v. Newton*, 2 *Fish. Pat. Cas.* 531.

The patentee must have had such an exclusive possession, as, with his claim and the acquiescence of the public, lays a reasonable foundation for the presumption of the validity of his patent. An unsuccessful attempt to interrupt a possession strengthens the presumption which arises from it. *Sargent v. Seagrave*, 2 *Curt.* 553.

The plaintiff had a patent for a pavement, and had been employed to lay some fourteen miles of it by the authorities of the cities of New York and Brooklyn, during the past four years. This, standing alone, was *held* not sufficient proof of acquiescence to raise a presumption in favor of the validity of the patent. *Guidet v. Palmer*, 10 *Blatchf.* 217 ; 6 *Fish. Pat. Cas.* 82.

The action of the commissioner of patents usually makes a *prima facie* case for or against an application for an interlocutory injunction. *Yuengling v. Johnson*, 1 *Hughes*, 607 ; 3 *Bann. & A. Pat. Cas.* 99.

It is a presumption of law that all mechanics interested in upholding or defeating a patent were fully acquainted with the state of their art when they took out their patent, or when they built their machine. *Crompton v. Knowles*, 7 *Fed. Rep'r*, 199.

When a party claiming an exclusive right to an invention has used it publicly and notoriously, for any considerable length of

time, the public are presumed to have acquiesced in that claim. *American Middlings Purifier Co. v. Christian*, 3 *Bann. & A. Pat. Cas.* 42.

Knowledge by the public of an invention is presumed where the means of such knowledge have existed. *Perkins v. Nashua Card, &c. Co.*, 2 *Fed. Rep'r*, 451 ; 17 *Pat. Off. Gaz.* 1285 ; 10 *Rep'r*, 7 ; 5 *Bann. & A. Pat. Cas.* 395.

There is no obligatory presumption that third persons would have purchased of the patentee what they are shown to have bought of the infringer, in case the latter had not made and sold the thing patented. *Seymour v. McCormick*, 16 *How.* 480 ; rev'g 2 *Blatchf.* 240.

A jury are not authorized in presuming that a machine was in continuous operation for twenty-four years, from the mere facts that it was described in a book in 1829, and was in use in 1853. *Seymour v. McCormick*, 19 *How.* 96.

Patented articles are presumed to be patentably different from those covered by other patents. *Buerk v. Imhauser*, 11 *Pat. Off. Gaz.* 112.

Where a joint application is filed for a patent, the presumption is that the invention is joint, and clear and unequivocal evidence will be required to rebut this presumption. *Gottfried v. Phillip Best Brewing Co.*, 5 *Bann. & A. Pat. Cas.* 4 ; 17 *Pat. Off. Gaz.* 675.

The mere deposit in the patent-office of a model does not raise the inference that the application for a patent was completed at that date. *Draper v. Wattles*, 16 *Pat. Off. Gaz.* 629 ; 3 *Bann. & A. Pat. Cas.* 618.

In a suit for infringement, the patentee will be presumed to be still the owner, where no assignment has been alleged or proved. *Fischer v. Neil*, 6 *Fed. Rep'r*, 89 ; 19 *Pat. Off. Gaz.* 603.

The fact of the granting of a patent has no tendency to show that the invention described in it does not infringe a prior patent ; and the decision of the patent-office, on a question of interference between the two, is evidence of such fact on a motion for injunction. *Holliday v. Pickhardt*, 12 *Fed. Rep'r*, 147 ; 22 *Pat. Off. Gaz.* 420.

Where a patentee is in the employ of another, and uses the latter's tools and materials in perfecting his inventions, and such other person uses such inventions for a number of years without payment of royalty, a special license will be presumed. *Jencks v. Langdon Mills*, 27 *Fed. Rep'r*, 622.

284. *Burden of Proof.*

The burden is on the defendant to show that the proper notice has been given under the statute to enable him to examine witnesses to prove that the invention of the plaintiff had been known or used before his invention. *Philadelphia & Trenton R. R. Co. v. Stimpson*, 14 *Pet.* 448 ; *Id.*, Banks' ed. *note*.

In order to avoid liability for profits, made by an infringer who uses an article patented as an entirety or product, the burden is upon him to show that a portion of these profits is the result of some other thing used by him. *Elizabeth v. Pavement Co.*, 57 *U. S.* 126. But compare *Fitch v. Bragg*, 16 *Fed. Rep'r*, 243 ; 21 *Blatchf.* 302.

In a suit for infringement of a patent for an improvement and not for an entirely new machine or contrivance, the burden rests upon the patentee to show in what particulars his improvement has added to the usefulness of the machine or contrivance, and he must separate its results distinctly from those of the other parts, so that the benefits derived may be distinctly seen and appreciated. *Garretson v. Clark*, 111 *U. S.* 120 ; *aff'g* 15 *Blatchf.* 70 ; 14 *Pat. Off. Gaz.* 485.

Upon the question whether what has been done by the defendant amounts to infringement, the complainant universally has the burden of proof ; he must show satisfactorily that his right has been violated. *Washburn v. Gould*, 3 *Story*, 122 ; 7 *L. Rep'r*, 276 ; 1 *West. L. J.* 465 ; *Graham v. Mason*, 4 *Cliff.* 88 ; 5 *Fish. Pat. Cas.* 1 ; *Hudson v. Draper*, 4 *Cliff.* 178 ; 4 *Fish. Pat. Cas.* 256 ; *Storrs v. Howe*, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420 ; *American Middlings Purifier Co. v. Atlantic Milling Co.*, 3 *Bann. & A. Pat. Cas.* 168 ; *Brooks v. Jenkins*, 3 *McLean*, 432, 453 ; *S. C.*, *sub nom.* *Brooks v. Bicknell*, 2 *West. L. J.* 11 ; *Parker v. Stiles*, 5 *McLean*, 44.

Section 7 of the act of 1839,—allowing the use and sale of an invention for two years before the application for a patent,—is in the nature of a statute of limitations ; and the defendant setting up a sale more than two years before must establish the fact of such a sale, in a manner that will justify a jury in taking away the property of the plaintiff. *Hovey v. Henry*, 3 *West. L. J.* 153.

In an action for infringement, if the defendant contests the originality of the invention, the burden of proof is upon him to

show that it was known before the invention of plaintiff. *Hovey v. Henry*, 3 *West. L. J.* 153; *Winans v. New York & Harlem R. R. Co.*, 31 *Jour. Fr. Inst.* (3rd S.) 320; *Brooks v. Jenkins*, 3 *McLean*, 432; S. C., *sub nom.* *Brooks v. Bicknell*, 2 *West L. J.* 11; *Parker v. Stiles*, 5 *McLean*, 44; 7 *West L. J.* 417. To same effect, *Doherty v. Haynes*, 4 *Cliff.* 291; 6 *Pat. Off. Gaz.* 118; 1 *Bann. & A. Pat. Cas.* 289; *Hoe v. Cottrell*, 1 *Fed. Rep'r*, 597; 17 *Blatchf.* 546; 18 *Pat. Off. Gaz.* 59; 5 *Bann. & A. Pat. Cas.* 256; *Worswick Manuf. Co. v. Buffalo*, 20 *Fed. Rep'r*, 126. And see *Parker v. Remhoff*, 17 *Blatchf.* 206; 3 *Bann. & A. Pat. Cas.* 550.

The date of the patent is to be taken, in the absence of other evidence, as the date of invention; and the burden of proof is upon the defendant to show, beyond any fair doubt, prior knowledge and use. *Webster Loom Co. v. Higgins*, 16 *Pat. Off. Gaz.* 675. To same effect, *Eagleton Manuf. Co. v. West, &c. Manuf. Co.*, 2 *Fed. Rep'r*, 774; 18 *Blatchf.* 218; 17 *Pat. Off. Gaz.* 1504; 10 *Rep'r*, 297.

Where an equitable title to an interest in a patent is set up against a *bona fide* purchaser and holder of the legal title, the burden of proof lies upon him who impeaches the legal title. *Gibson v. Cook*, 2 *Blatchf.* 144, 151. Compare *Calais Steamboat Co. v. Scudder*, 2 *Black*, 372.

The burden of proof is on the defendant who alleges a prior sale or use. *Allen v. Blunt*, 2 *Woodb. & M.* 121, 145; *Hide & Leather Co. v. American Tool Co.*, 1 *Holmes*, 503; 4 *Fish. Pat. Cas.* 284; *Roemer v. Sinn*, 5 *Pat. Off. Gaz.* 555.

Power to grant reissued as well as original patents is vested in the commissioner; and, when lawfully exercised, a patent has been duly granted, whether reissued or original, it is, of itself, if introduced in evidence where a party claims redress for alleged infringement, *prima facie* evidence that the patentee is the original and first inventor. Its effect may, however, be overcome by proof that the improvement was previously made by another in this country, or had previously been described in some printed publication, prior to the supposed invention by the patentee. *Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539.

Under the act of 1861, § 13,—requiring the word “patented,” with the date when granted, to be affixed to patented articles offered for sale,—the burden of proof is upon the defendant to show that the plaintiff has failed to mark patented, as required, articles made

or sold under a patent, and then the burden is shifted upon the plaintiff to show that defendant had notice that he was infringing. *Goodyear v. Allyn*, 6 *Blatchf.* 33 ; 3 *Fish. Pat. Cas.* 374.

In a case where the application fails to take the date of invention back of the date of the patent, and the defendant shows, beyond a reasonable doubt, knowledge and use before the date of the patent, the burden of proof is shifted on to the plaintiff, to show the date of invention to be prior to the knowledge and use shown by defendant. *Eagleton Manuf. Co. v. West, &c. Manuf. Co.*, 2 *Fed. Rep'r*, 774 ; 18 *Blatchf.* 218 ; 17 *Pat. Off. Gaz.* 1504 ; 10 *Rep'r*, 297 ; *Thayer v. Hart*, 20 *Fed. Rep'r*, 693.

Where the bill alleges that defendant's infringement was without the consent of the plaintiff, which was not specifically denied by the answer or any consent or license alleged, the burden of proof does not rest upon the plaintiff to show want of consent, but upon the defendant to prove consent. *Fischer v. Hayes*, 6 *Fed. Rep'r*, 76 ; 4 *Bann. & A. Pat. Cas.* 317.

The burden is on the plaintiff, in an infringement suit, to prove that defendant's article is like plaintiff's. *Francis v. Mellor*, 4 *Am. L. T. U. S. Cts.* 237 ; 1 *Leg. Gaz. Rep.* 291 ; 8 *Phila.* 157.

The burden is upon the defendant to establish the defense that the invention is not so described as to enable a skillful mechanic to construct a machine. *Brooks v. Jenkins*, 3 *McLean*, 432, 445 ; S. C., *sub nom.* *Brooks v. Bicknell*, 2 *West. L. J.* 11.

In a suit for infringement, the allegation of a license is an affirmative defense, and must be made out by the proof. *Watson v. Smith*, 7 *Fed. Rep'r*, 350 ; 20 *Pat. Off. Gaz.* 300.

Where complainant seeks to recover damages on the basis of an established royalty for the use of several claims, only a part of which have been infringed, the burden of proof is upon him to show the relative value of the claims which have been infringed. *Willimantic Thread Co. v. Clark Thread Co.*, 27 *Fed. Rep'r*, 865.

In an action for infringement of letters patent, where the defendant sets up want of novelty, the burden is on him to establish this defense, and prove the facts set up by him beyond a reasonable doubt. *Cantrell v. Wallick*, 117 *U. S.* 689.

In a suit for infringement of a patent, the burden is upon the defendants to establish a defense of prior knowledge and use beyond a reasonable doubt. *Dreyfus v. Schneider*, 25 *Fed. Rep'r*, 481.

A party asserting, as a defense to a suit for infringement, that

the device covered by the patent has been in public use, or on sale, for more than two years prior to the application for the patent, assumes the burden of proof, and is bound to sustain this defense by clear and convincing testimony. Proof resting wholly in the recollection of persons who claim to have seen or used such prior devices twenty years before they testified, where none of such devices is produced, and it does not appear that more than one of each kind was ever made, is too unreliable to form a safe basis for judicial action. *Adams & Westlake Manuf. Co. v. Rathbone*, 26 *Fed. Rep'r*, 262.

The decision of the patent-office is not conclusive upon the court where priority of invention between interfering patents is in question, but is of sufficient weight to cast the burden of proof upon the party against whom it was rendered. *Wire Book Sewing Machine Co. v. Stevenson*, 11 *Fed. Rep'r*, 155 ; 13 *Rep'r*, 422.

285. *General Rules of Evidence as to the Construction and Validity of the Patent, and Extent of the Right it Confers.*

Evidence is admissible to show the meaning of terms used in letters patent, as well as the state of the art. *Loom Co. v. Higgins*, 105 *U. S.* 580 ; rev'g 15 *Blutchf.* 446 ; 16 *Pat. Off. Gaz.* 675 ; 4 *Bann. & A. Pat. Cas.* 88.

In determining the question as to whether the patentee believed himself to be the first inventor, it is competent for the defendant to show that the patentee knew of the existence of the invention abroad. But in considering whether the patentee did believe himself to be the first inventor, it is material to determine whether he was the first inventor. *Forbush v. Cook*, 10 *L. Rep'r, N. S.* 664 ; 2 *Fish. Pat. Cas.* 668.

The question of novelty is to be settled by a comparison of prior machines with the machine patented, rather than the form of the machine in use. *Blake v. Rawson*, 3 *Biss.* 77 ; 3 *Pat. Off. Gaz.* 122 ; 6 *Fish. Pat. Cas.* 74.

In an action at law, where the issue of novelty is raised, it is not competent to compare prior machines with the one used by defendant ; the only comparison admissible is with that used by the patentee. *Judson v. Cope*, 1 *Bond*, 327 ; 1 *Fish. Pat. Cas.* 615.

Where a patent is assailed for lack of novelty, sketches and drawings may be consulted to fix the date of inceptive invention, and if there has been no unreasonable delay subsequently in adapting the invention and applying for patent, the protection of the patent will be carried back to the date thus established. *Draper v. Potomska Mills Corp.*, 13 *Pat. Off. Gaz.* 276 ; 3 *Bann. & A. Pat. Cas.* 214 ; *Kneeland v. Sheriff*, 2 *Fed. Rep'r*, 901 ; 10 *Rep'r*, 234 ; 18 *Pat. Off. Gaz.* 242 ; 5 *Bann. & A. Pat. Cas.* 482.

The patent itself is *prima facie* evidence that the alleged inventor had made the invention at the date the specification was filed. *Jones v. Sewall*, 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; 6 *Fish. Pat. Cas.* 343. S. P., *Dane v. Chicago Manuf. Co.*, 3 *Biss.* 380.

Defendants in a suit on a reissue patent, may read the original patent in evidence at the trial, although it may not have been put in evidence before the examiner, in order to show that the reissue is, in fact, for a different invention from the original. *Knapp v. Shaw*, 23 *Pat. Off. Gaz.* 2236 ; 15 *Fed. Rep'r*, 115. S. P., *National Cylinder Co. v. Simmons Hardware Co.*, 18 *Fed. Rep'r*, 324.

Against an allegation that a patentee had abandoned his discovery, the lapse of time from the grant of the patent to the commencement of the action being urged as proof of that fact, he may give evidence of his filing of drawings, or of any other act done by him in assertion of his right. *Emerson v. Hogg*, 2 *Blatchf.* 1.

The fact that a patent has been issued for an invention does not, of itself, prove the introduction of the invention into public and common use. *Weston v. White*, 13 *Blatchf.* 364 ; 9 *Pat. Off. Gaz.* 1196 ; 2 *Bann. & A. Pat. Cas.* 321.

In an action for infringement, where there was proof that a machine constructed before the plaintiff's invention, and identical with it, for a person who lived some distance from the place of construction, was taken away by him to be put up ; but it was never afterward seen by the witness who assisted in its construction, it was *held*, that the evidence was sufficient to establish the fact of want of novelty in the plaintiff's invention, though there was no proof to show that the prior machine was ever used. *Parker v. Ferguson*, 1 *Blatchf.* 407.

When an alleged invention proves superior to what has been known before, this superiority is evidence in favor of its novelty. *Birdsell v. McDonald*, 6 *Pat. Off. Gaz.* 682 ; *Judson v. Cope*, 1 *Bond*, 327 ; 1 *Fish. Pat. Cas.* 615. S. P., *Carter v. Baker*, 4 *Fish. Pat. Cas.* 404 ; *Smith v. Woodruff*, 1 *MacArthur*, 459 ; 6 *Fish.*

Pat. Cas. 476. But except to show a difference between the two inventions, evidence that the defendant's is superior to plaintiff's is not admissible. *Alden v. Dewey*, 1 *Story*, 336 ; 3 *L. Rep'r*, 383.

The facts that many persons tried to accomplish the result, and that the patentee alone succeeded, are legitimate evidence that his invention was new and useful. *Western Electric Manuf. Co. v. Chicago Electric Manuf. Co.*, 14 *Fed. Rep'r*, 691 ; *Ward v. Grand Detour Plow Co.*, 14 *Fed. Rep'r*, 696 ; 11 *Biss.* 427.

Rejected applications for patents are not alone evidence of the existence of perfected inventions at their dates of filing ; there should be proof that, at such dates, machines embodying the inventions were in existence and operation. *Howes v. McNeal*, 15 *Pat. Off. Gaz.* 608 ; 15 *Blatchf.* 103 ; 3 *Bann. & A. Pat. Cas.* 376 ; *Lyman Ventilating Co. v. Chamberlain*, 10 *Pat. Off. Gaz.* 588 ; 2 *Bann. & A. Pat. Cas.* 433.

In connection with evidence of the construction of an operative machine embodying the invention, a rejected application for a patent for it may be received. *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 6 *Pat. Off. Gaz.* 34 ; 10 *Phila.* 227 ; 1 *Bann. & A. Pat. Cas.* 177.

File wrappers are not competent as evidence, in a suit on a patent, to show the reduction to practice and use of inventions claimed to be prior, so as to invalidate such patent. *Howes v. McNeal*, 4 *Fed. Rep'r*, 151 ; 17 *Blatchf.* 396 ; 17 *Pat. Off. Gaz.* 799 ; 11 *Rep'r*, 362 ; 5 *Bann. & A. Pat. Cas.* 77.

If the signature of a letter acknowledging the receipt of an application for a patent is proved, the letter is competent as an official act and document of a public officer in relation to such a subject, and a part of the transaction ; for, being made at the time, and in relation to the subject-matter, it is competent as a part of the *res gestæ*, and explanatory of what took place. *Pike v. Potter*, 3 *Fish. Pat. Cas.* 55.

A different result is evidence of some new cause or means, although the mechanism may apparently be substantially the same. Hence a greater degree of utility achieved by one machine is evidence of novelty. *Eames v. Cook*, 2 *Fish.* 146.

It is decisive evidence that a new mode of operation has been introduced if the practical effect of the invention is either a new effect or a materially better effect, or as good an effect more economically attained. *Furbush v. Cook*, 2 *Fish. Pat. Cas.* 668.

Public demand for an article when its existence is made known,

is not conclusive evidence of novelty and invention. *Hill v. Biddle*, 27 *Fed. Rep'r*, 560.

The extensive use of a device, however simple, is evidence of its utility, and consequently of its patentable merit. *Lorillard v. McDowell*, 23 *Int. Rev. Rec.* 90 ; 11 *Pat. Off. Gaz.* 640 ; 2 *Bann. & A. Pat. Cas.* 531 ; 13 *Phila.* 461.

The fact that defendant chose to use the invention patented by complainant, has been *held* sufficient evidence of utility in the invention to sustain it as patentable for the purposes of that suit. *Smith v. Glendale Elastic Fabric Co.*, 1 *Holmes*, 340 ; 5 *Pat. Off. Gaz.* 429 ; 1 *Bann. & A. Pat. Cas.* 58 ; *Lee v. Blandy*, 1 *Bond*, 361 ; 2 *Fish. Pat. Cas.* 89. Otherwise, of evidence that strangers to the suit offered to take licenses from the plaintiff. *Evans v. Hettick*, 3 *Wash.* 408 ; *aff'd* on other points, 7 *Wheat.* 453.

The fact that a mill for grinding bark would grind double the quantity that could be ground by the old mills, is evidence enough of utility to sustain a patent. *Wilbur v. Beecher*, 2 *Blatchf.* 132.

Where the evidence establishes the facts that the patentee was the first to conceive the idea of constructing the device described in his patent, whereby improved results were accomplished, and that the public has attested its superior utility and value by adopting the same, instead of the constructions previously used, there is sufficient proof of patentable merit. *Miller v. Pickering*, 16 *Fed. Rep'r*, 540.

On a motion for a preliminary injunction, the defense of prior public use will be entertained, although unsuccessfully made in former cases, where such defense is much more strongly fortified than before by corroborative evidence, and it is reasonable to believe that a different result would have been reached if the new evidence had been presented. *Lockwood v. Faber*, 27 *Fed. Rep'r*, 63.

Clear proof is required of mistake in drawings on file, after destruction of model. *Royer v. Russell*, 9 *Fed. Rep'r*, 696 ; 20 *Pat. Off. Gaz.* 1819.

The defense of a prior knowledge and use is established when the evidence shows that the invention was complete and capable of working, and had been put in public use, and was known to any considerable number of persons. *Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171 ; 3 *Bann. & A. Pat. Cas.* 539.

Where there has been a public acquiescence in the validity of a

patent, the court will scrutinize evidence of its invalidity with the greatest care. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

A claim to prior use needs to be proved beyond a reasonable doubt. *Coffin v. Ogden*, 18 *Wall.* 120 ; *Troy Iron, &c. Factory v. Corning*, 1 *Blatchf.* 467 ; *Campbell v. James*, 17 *Blatchf.* 42 ; 4 *Bann. & A. Pat. Cas.* 456 ; 18 *Pat. Off. Gaz.* 979 ; 8 *Rep'r*, 455 ; see reversal, 104 *U. S.* 357 ; *Campbell v. New York*, 9 *Fed. Rep'r*, 500 ; *Troy Iron, &c. Co. v. Odiorne*, 17 *How.* 72 ; 20 *Blatchf.* 67 ; 20 *Pat. Off. Gaz.* 1817 ; *Doubleday v. Beatty*, 11 *Fed. Rep'r*, 729 ; 22 *Pat. Off. Gaz.* 859 ; *Hawes v. Antisdell*, 8 *Pat. Off. Gaz.* 685 ; *Washburn, &c. Manuf. Co. v. Haish*, 4 *Fed. Rep'r*, 900 ; 10 *Biss.* 55 ; 19 *Pat. Off. Gaz.* 173 ; *Everest v. Buffalo Lubricating Oil Co.*, 20 *Fed. Rep'r*, 848 ; *Wetherell v. Veith*, 27 *Fed. Rep'r*, 364 ; *Hobbie v. Smith*, *Id.* 656. See also *infra*, p. .

The fact that a manufacturer for a long period does not make use of a means of production important in the business, shows that he did not have the idea. *Roots v. Hyndman*, 4 *Pat. Off. Gaz.* 29 ; 6 *Fish. Pat. Cas.* 439.

Making and exhibiting a new article is presumptive proof of invention ; but if the exhibitor makes no claim at the time to having invented it, this tends to rebut the presumption. *Pennock v. Dialogue*, 4 *Wash.* 538.

Evidence that in operating a prior machine a greater number of persons necessarily have to be employed than are required in the operation of a patented machine, tends to prove that the machines are not alike. *Coupe v. Weatherhead*, 23 *Pat. Off. Gaz.* 1927.

If two devices produce different results, this is some evidence that the devices themselves are different. *Waterbury Brass Co. v. New York Brass Co.*, 3 *Fish. Pat. Cas.* 43.

286. *Rules of Evidence as to Matters Connected with Reissues.*

The question of the identity of an invention described in the original and the reissued letters patent is one of law for the court, whenever it can be determined solely from their face by mere comparison of specifications, without the aid of extrinsic evidence. *Heald v. Rice*, 104 *U. S.* 737.

A defective patent was surrendered and a new one taken out. In an action for a violation thereof, in which the infringement was

laid subsequent to the date of the reissue, evidence of a use of a machine prior to the date of the second patent, but subsequent to that of the first, is not admissible in defense. *Stimpson v. West Chester R. R. Co.*, 4 *How.* 380.

Where the defendant sets up as a defense in a suit for infringement of reissued letters patent, that they are broader than the original, and therefore invalid, and the plaintiff fails to introduce the original in evidence, the defendant may introduce them, and the question of the validity of the reissued patent may be passed upon by a comparison. *National Pump Cylinder Co. v. Simmons Hardware Co.*, 18 *Fed. Repr.*, 324. S. P., *Knapp v. Shaw*, 23 *Pat. Off. Gaz.* 2236 ; 15 *Fed. Rep'r.*, 115.

287. *Evidence as to Plaintiff's Title to the Patent or to the Damages.*

In a court of equity, an equitable title is sufficient, as against the patentee, and those claiming under him if with notice of the complainant's title, and that notice appears by the records of the complainant's title. *Ruggles v. Eddy*, 10 *Blatchf.* 52 ; 5 *Fish. Pat. Cas.* 581.

A decree obtained for infringement cannot be introduced on the trial of an action against one not a party nor privy to the former suit, for the purpose of proving his acquiescence in the rights of plaintiff under the patent. Such decrees, although admissible upon motions for a provisional injunction, are proceedings *inter alios*, and are not competent evidence on a trial upon the merits. *Matthews v. Iron Clad Manuf. Co.*, 19 *Fed. Rep'r.*, 321.

A license granted by the patentee of an invention, permitting the invention to be manufactured and used upon certain terms and conditions, cannot be deemed evidence of an acquiescence in infringements of his right ; it is, rather, an assertion of an exclusive right in the invention. *Jordan v. Dobson*, 2 *Abb. U. S.* 398 ; 7 *Phila.* 533.

A patentee who has given another person a writing showing that he has an interest in the patent, may show by parol that the writing does not contain the contract nor express the intention of the parties. *Kearney v. Lehigh Valley R. Co.*, 27 *Fed. Rep'r.*, 699.

288. *As to the Charge of Infringement.*

Evidence that third persons who, as defendant has shown, have used a machine like plaintiff's, prior to his invention, and paid plaintiff for licenses, is competent, though not important. *Evans v. Eaton*, 3 *Wheat.* 454, 505.

When, upon appeal in an action for an infringement, it appears that the parties have admitted that the defendants have used machinery constructed in conformity with the plaintiff's patent, the admission is sufficient to make a *prima facie* case of infringement. *Chaffee v. Boston Belting Co.*, 22 *How.* 217.

The fact that the device defendant manufactures works better than another which is patented, and has driven it out of market, is *prima facie* evidence that the use of it does not violate the patentee's monopoly. *Smith v. Woodruff*, 1 *MacArthur*, 459 ; 6 *Fish. Pat. Cas.* 476.

Where the answer, under oath, is responsive to a bill seeking an injunction against infringement, and denies the infringement, something more than the evidence of a single witness must be produced to overcome it and justify an injunction. *Woodworth v. Hall*, 1 *Woodb. & M.* 248 ; 6 *Pa. L. J.* 178.

Exclusive right in the person under whom the defendants claim a right to use the machine in controversy, cannot be shown by evidence that the defendants have for several years used the machine, with the plaintiff's knowledge, and without any objection on his part. *Baldwin v. Sibley*, 1 *Cliff.* 150.

A failure on the part of a defendant charged with infringement to bring into court the article in question, when it is within his power so to do, will be taken as an admission of infringement. *Ely v. Monson, &c. Manuf. Co.*, 4 *Fish. Pat. Cas.* 64.

Parol evidence of a written contract for the use of a patent article, was *held* admissible in a suit for infringement. *Andrews v. Creegan*, 7 *Fed. Rep'r.* 477 ; 19 *Blatchf.* 113 ; 19 *Pat. Off. Gaz.* 1140 ; 11 *Rep'r.* 527.

In defense of a suit for infringement of a prior patent, a licensee may put in evidence the patent of his licensor. *Blanchard v. Puttman*, 3 *Fish. Pat. Cas.* 186 ; 2 *Bond.* 84.

Proof of the charge of infringement must be clear. *Racine Seeder Co. v. Joliet Wire Check Sower Co.*, 27 *Fed. Rep'r.* 367.

In a suit for infringement of a patent for improvement in ovens,

evidence that defendant put up the oven constituting the infringement; and controlled and managed it, was *held* sufficient to establish the infringement alleged. *Peterson v. Simpkins*, 25 *Fed. Rep'r*, 488 ; 33 *Pat. Off. Gaz.* 1392.

Where the answer under oath denies infringement, the testimony of one witness is insufficient, unless corroborated by circumstances. *Slessinger v. Buckingham*, 17 *Fed. Rep'r*, 454. See *Spring v. Domestic Sewing Mach. Co.*, 21 *Pat. Off. Gaz.* 633 ; *Bennett v. Fowler*, 8 *Wall.* 445.

When the proof showed that defendant's machine did not correspond with the description of the patent, and the functions of plaintiff's devices would not work in defendant's machine, it was held no infringement. *Kirby v. Dodge & Stevenson Manuf. Co.*, 10 *Blatchf.* 307.

When the answer does not explicitly deny infringement, the court may infer from the testimony of a witness who saw infringing machines in the possession of the defendants, some of which were in use, that all the machines had been used by all the defendants. *Gear v. Fitch*, 16 *Pat. Off. Gaz.* 1231.

When, from the evidence, it appears that the defendant is simply pursuing the same process of manufacturing, which he followed before the patent in question was issued, the court will not interfere to restrain defendant from continuing its use. *Dorlan v. Guie*, 34 *Pat. Off. Gaz.* 702.

289. *As to Matters of Affirmative Defense.*

Evidence that for a long time after making an invention, and without special cause, the inventor neglected to make and prosecute an application for letters patent, under attendant circumstances evincing an intent to abandon, may suffice to prove abandonment. *Planing Machine Co. v. Keith*, 101 *U. S.* 479. *S. P., Re Rowley*, 2 *Am. L. T. U. S. Cts.* 106.

It is strong evidence for a jury, of an intent to abandon, that a claimant of an invention withdrew it from use, and neglected or discarded it, and did not attempt to resume it until a rival device had been brought forward. *Johnson v. Root*, 2 *Cliff.* 108 ; 2 *Fish. Pat. Cas.* 291 ; *Parkhurst v. Kinsman*, 1 *Blatchf.* 488 ; 8 *N. Y. Leg. Obs.* 146 ; aff'd on other points, 18 *How.* 289.

Evidence of abandonment of a part only, and that not the most

important part of the claim of a patent, does not warrant a general finding of abandonment. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 *Fed. Rep'r*, 638 ; 25 *Pat. Off. Gaz.* 1076.

Evidence that a person abandoned the use of a particular machine, is not evidence that the machine itself was a new abandoned experiment. *Pickering v. McCulloch*, 13 *Pat. Off. Gaz.* 818.

Clear proof is necessary to establish the defense of anticipation (*Donoghe v. Hubbard*, 27 *Fed. Rep'r*, 742 ; *Gottfried v. Phillip Best Brewing Co.*, 17 *Pat. Off. Gaz.* 675 ; 5 *Bann. & A. Pat. Cas.* 4) ; especially where the allegation is that an invention was long ago anticipated by one which never became generally known. *Lane v. Peck*, 9 *Fed. Rep'r*, 101.

Where the alleged prior inventor was shown to be very near the realization of the invention, but could not, at a period long subsequent, make a practical machine embodying the invention, it was held that his operations were not sufficient to defeat a patent, although witnesses testified that they were successful. *American Bell Telephone Co. v. People's Telephone Co.*, 34 *Pat. Off. Gaz.* 561.

290. *As to Amount of Damages and Profits.*

Evidence of amounts received by patentee in settlements for other infringements cannot be received in aid of determining the amount which ought to be paid by defendant for his infringement of the same patent. *Westcott v. Rude*, 19 *Fed. Rep'r*, 830.

A license for future use of a patented invention, given wholly or partly in consideration of a settlement for past infringements, is not admissible, as against a stranger, to establish the amount of a royalty. *Gottfried v. Crescent Brewing Co.*, 22 *Fed. Rep'r*, 433 ; 30 *Pat. Off. Gaz.* 892.

Proof of sales of patented machines, and an agreement between patentees for their manufacture and sale was *held* admissible, although not conclusive, in a suit for infringement, as tending to show the value of the invention ; although the sales had not been numerous or uniform enough to establish a license fee. *Gottfried v. Crescent Brewing Co.*, *Ib.*

Admissibility, in a suit for infringement of one of several claims in a patent, of evidence of profits derived from the use of the patented invention, as an entirety, considered. *Fischer v. Hayes*, 22 *Fed. Rep'r*, 529.

Evidence for plaintiff in suits for infringement, was *held* inconclusive, and not sufficient, under the circumstances, to sustain the bills. *Deplanque v. Ripka*, 24 *Fed. Rep'r*, 278.

Where complainant's device was but of little value, and the defendant added improvements which rendered the device marketable, it was *held*, that the complainant must show what proportion of profits was due to the original invention ; and failing in that, the complainant is entitled to nominal damages, only. *Bostock v. Goodrich*, 34 *Pat. Off. Gaz.* 1047.

291. *Declarations of Inventor, &c.*

The conversations and declarations of an inventor stating that he had made an invention, and describing its details, and explaining its operations, are properly deemed an assertion of his right, at that time, to the extent of the facts and the circumstances which he then makes known, although not of their existence at any anterior time, and is competent evidence to fix the date of invention as of that time. *Philadelphia & Trenton R. R. Co. v. Stimpson*, 14 *Peters*, 448.

The statements of a person claiming to be an inventor, made *prior* to the proceedings for interference, in which he graphically describes the invention, are admissible as part of the *res gestæ*. *Yearsley v. Brookfield*, 1 *MacArthur Pat. Cas.* 193.

The declarations of an inventor in describing the details of a device and its mode of operation, are admissible in his favor as part of the *res gestæ*, when the priority of invention is in question. *Richardson v. Hicks*, 1 *MacArthur Pat. Cas.* 335 ; *Stephens v. Salisbury*, *Id.* 379.

292. *Testimony of Ordinary Witnesses.*

Since the rules of evidence prescribed by the State are rules of decision for the United States courts, it was *held*, that a plaintiff in an action for infringement was competent as a witness ; it appearing that under the laws of the State where the trial was had, parties to a suit were declared competent witnesses. *Vance v. Campbell*, 1 *Black*, 427 ; *rev'g* 1 *Fish. Pat. Cas.* 483 ; *Haussknecht v. Claypool*, 1 *Black*, 431.

In considering the question of originality, the oath of the inventor, made prior to the issue of the letters-patent, that he was the first inventor of the thing patented, may be opposed to the oath of a witness offered to show that the invention was not original. *Alden v. Dewey*, 1 *Story*, 336 ; 3 *L. Rep'r*, 383.

The testimony of a witness who had no knowledge as to how the articles resembling complainant's invention were made, is insufficient to invalidate plaintiff's patent on the ground that he was not the original inventor, or that the same was in use before his invention. *Treadwell v. Bladen*, 4 *Wash.* 703.

The priority of knowledge and use of an invention is a question of fact, which a jury may decide from one witness ; the question is on the credibility and not on the number of witnesses. *Whitney v. Emmett*, *Baldw.* 303, 310.

The fact that the maker of the alleged prior machine is not examined, where priority is attempted to be proved, though present, is a circumstance to be considered in weighing other testimony as to the existence and character of the machine. *Wood v. Cleveland Rolling Mill Co.*, 4 *Fish. Pat. Cas.* 550.

293. *Experts.*

Where a patent is attempted to be invalidated by a prior patent, it is proper to take the testimony of experts as to the diversity in the inventions, and submit the evidence to the jury with proper instructions, leaving them to determine the question of identity. The court cannot be required to compare the two specifications, and to instruct a jury, as matter of law, whether the inventions are or are not identical. *Bischoff v. Wethered*, 9 *Wall.* 812.

Experts may be examined to explain, if necessary, models and drawings. *Winans v. New York & Erie R. R. Co.*, 21 *How.* 88, 100.

The opinions of skillful persons, whether the principles of two machines are the same, are competent evidence to be introduced in a patent cause. *Barrett v. Hall*, 1 *Mas.* 447, 470 ; *Blanchard v. Beers*, 2 *Blatchf.* 411 ; *Parker v. Stiles*, 5 *McLean*, 44, 64 ; 7 *West. L. J.* 168.

The patent law contemplates two classes of persons as appropriate witnesses in patent cases.

1. Artisans, engaged in the trade, employment, or business of

the particular branch of mechanics to which the patent right applies, as to whether the specification sufficiently described the invention so that it could be constructed and used.

2. Persons who, although not practical artisans, are thoroughly conversant with the subject of mechanics as a science, as to the questions of novelty of invention, or identity or diversity of mechanical apparatus, and contrivances, and equivalents. *Allen v. Blunt*, 3 *Story*, 742, 747 ; 8 *L. Rep'r*, 165. S. P., *Olcott v. Hawkins*, 2 *Am. L. J. N. S.* 321.

The testimony of a chemist, who has analyzed the ingredients of a composition of matter, as to the nature of such composition, is not matter of opinion, but evidence of a fact demonstrated. *Allen v. Hunter*, 6 *McLean*, 303.

Where the opinions of experts are expressed in *ex parte* affidavits, and there is no opportunity for the court to ascertain in what sense important words are used, nor what facts they take in view, nor what standards of comparison they assume, their opinions are of very little value. *Sargent v. Carter*, 1 *Fish. Pat. Cas.* 277 ; 11 *L. Rep'r, N. S.* 651.

In a suit for infringement the testimony of a mechanical expert is to be tried by the tests applied to the evidence of other witnesses. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

Expert testimony is not essential to prove an alleged infringement of a patent. *Hayes v. Bickelhaupt*, 23 *Fed. Rep'r*, 183 ; 32 *Pat. Off. Gaz.* 133.

Experts assume the duty of the court when they undertake to tell what the patent is for, or what is or is not a violation of the patent. *Waterbury Brass Co. v. New York & Brooklyn Brass Co.*, 3 *Fish. Pat. Cas.* 43.

294. *Evidence, with Reference to Particular Pleadings.*

Where, in an action to recover the consideration for an assignment of a patent, the declaration alleged that a certain improvement containing one principal and three minor improvements, all of which were included in a patent, which patent was reissued in four reissues, and that the original described all, and no more than the improvements specified in the four reissues, it was *held* that the reissues related back and were included within the assignment, and that the declaration was sufficient. *Read v. Bowman*, 2 *Wall.* 591.

In a suit for an infringement, letters patent granted earlier than those under which complainant claims, describing the same invention, may be read in evidence to disprove priority of his invention, notwithstanding such letters are not set up in the answer. *Atlantic Works v. Brady*, 107 *U. S.* 92 ; 2 *Sup. Ct. Rep'r*, 225.

Where a bill was filed for an injunction to restrain the running of a machine in violation of the plaintiff's rights, and the defendants justified under a license, which the complainant alleged had been abandoned, and no issue of abandonment was raised by the pleadings, it was *held*, that no evidence of abandonment could be received, and therefore, an injunction could not issue. *Wilson v. Stolley*, 4 *McLean*, 275 ; 4 *West. L. J.* 412.

The plaintiff is confined to giving evidence of infringements during the period which he specifies in his declaration. *Eastman v. Bodfish*, 1 *Story*, 528 ; 2 *Robb*, 72.

In a suit in equity to restrain an infringement, a prior patent not alleged in the answer is admissible as evidence of the state of the art at the date of the complainant's invention, only ; and not to show want of novelty in that invention. *American Saddle Co. v. Hogg*, 1 *Holmes*, 133 ; 6 *Fish. Pat. Cas.* 67.

In a suit for an infringement for a design, testimony as to the prior knowledge and use of the patented design by persons not named in the answer is incompetent. *Collender v. Griffith*, 11 *Blatchf.* 212 ; 3 *Pat. Off. Gaz.* 689.

Testimony offered by the defendants respecting a prior rejected application of a third person, the use of his invention, and his prior knowledge of the thing patented, is not admissible to show that the patentee was not the original inventor, unless these facts are set up in the answer. *Union Paper Bag Machine Co. v. Pultz, & Co.*, 15 *Blatchf.* 160 ; 15 *Pat. Off. Gaz.* 423 ; 3 *Bann. & A. Pat. Cas.* 403.

Evidence of the manufacture and use of an article similar to that covered by the patent at the time of its issuance, was *held* proper, as tending to show what was in existence at the time, though knowledge had not been pleaded. *Zane v. Loffe*, 2 *Fed. Rep'r*, 229 ; 5 *Bann. & A. Pat. Cas.* 284.

XXI. MATTERS OF PRACTICE INCIDENTAL TO PATENT SUITS.

295. *Abatement of Suit.*

A suit in equity seeking relief against an infringement does not abate by the death of the plaintiff, but may be prosecuted to final judgment by his legal representative. *Illinois Central R. R. Co. v. Turrill*, 110 *U. S.* 301.

A bill in equity for an injunction and account of profits for an infringement does not abate by the death of the defendant, the infringer, but may be revived against his representatives. In the equity suit for an infringement, the complainant is allowed, instead of bringing action at law to recover damages, to sue the infringer as a trustee of the profits realized by him, and to enforce his accountability for them in that character; and this being the basis of the suit, the equitable liability of an infringer is clearly not determined by his death. The fact that the suit cannot be prosecuted against the representatives for the injunction, does not negative the right to revive the suit for the accounting; as the jurisdiction of the circuit courts to enforce an accounting in patent causes is not altogether dependent on the jurisdiction to enjoin. *Smith v. Baker*, 5 *Pat. Off. Gaz.* 496; 19 *Int. Rev. Rec.* 149; 10 *Phila.* 221; 1 *Bann. & A. Pat. Cas.* 117.

296. *Compulsory Disclosure*

It has been ruled that a defendant who both attacks the validity of the patent, and also denies that he is infringing it, cannot be compelled to disclose the name of customers to whom he has sold the articles said to infringe. *Roberts v. Walley*, 14 *Fed. Rep'r*, 167; 29 *Int. Rev. Rec.* 47; 26 *Pat. Off. Gaz.* 107; 15 *Rep'r*, 39.

On hearing of an application for an injunction against an infringement, the court may adjudge the patented article unpatentable and the patent void, from inspection, and without taking evidence. *Everett v. Thatcher*, 16 *Pat. Off. Gaz.* 1046. But it has been held, that exhibition of models of the machines of the

respective parties will not suffice to determine such applications; there must be an examination into the detail of the construction, combination and operation of all their parts, by competent mechanics. *Cooper v. Matthews*, 8 *L. Rep'r*, 413.

On a bill for an infringement, if the defendants refuse to allow the plaintiffs to examine the machines used by them, the court may order an inspection; or may order that the defendants run their machines in the presence of some expert, and that the expert may bring into court specimens of the work produced. *Sloat v. Patten*, 24 *Jour. Fr. Inst.* 3rd S. 23.

297. *Motions.*

Motion to allow a patent cause to be carried up to the supreme court, notwithstanding the amount of damages in controversy is less than the jurisdictional limit, ought not to be granted except in exercise of a sound discretion, and in cases where questions important and doubtful, and arising on the construction of the patent law itself, are involved. *Allen v. Blunt*, 2 *Woodb. & M.* 121, 155.

Decrees sustaining the validity of the patents involved were entered in certain suits, by consent of parties; but the fact that they were upon consent did not appear in the decrees. A stranger to the suits made a motion for leave to intervene, for the purpose of having these decrees vacated or modified; alleging, as a reason for requesting such relief, that the decrees were being used to support applications for injunctions pending against himself or his agents, in other circuits. It was *held*, that such motion must be denied. *Matter of Iowa Barb Steel Wire Co.*, 5 *Bann. & A. Pat. Cas.* 279.

Application, in a suit for infringement, for leave to amend the answer, and for a rehearing, for the purpose of setting up a new defense of prior use, was denied; because there was nothing to show but that the facts constituting the new defense could have been discovered by the exercise of reasonable diligence before the hearing. *Hicks v. Otto*, 22 *Blatchf.* 122. To nearly the same effect, where the new defense was want of novelty, *Lockwood v. Cleveland*, 20 *Fed. Rep'r*, 164.

A motion to consolidate several bills in equity founded on different patents and pending against different persons, may be granted when all the mechanical devices alleged to be infringed are used

in one machine. *Deering v. Winona Harvester Works*, 24 *Fed. Rep'r*, 90; 32 *Pat. Off. Gaz.* 654.

A motion to stay proceedings upon an order for an accounting, will not be granted merely because the patent has, since the order was made, been declared void, by another court, if an appeal has been taken, and the facts in the two cases are not alike. *Celluloid Manuf. Co. v. Comstock & Cheney Co.*, 27 *Fed. Rep'r*, 358.

298. *Trial.*

Whether an application for a patent claimed to be new, was really a continuance of a former one; whether a machine embodied in a patent required or admitted of invention, whether a patent described and claimed a novel device, and whether important parts of defendant's machine are merely equivalents for corresponding parts of the patented one; are questions of fact for the jury. *Bevin v. East Hampton Co.*, 5 *Fish. Pat. Cas.* 23; 9 *Blatchf.* 50; *Poppenhusen v. Falk*, 5 *Blatchf.* 49; *Bischoff v. Withired*, 9 *Wall.* 812; *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

Upon trial of an infringement suit before a jury, if, after the plaintiff's evidence is all in, the court is of opinion that it is insufficient in law to establish the infringement and warrant a judgment on the verdict if one should be rendered for the plaintiff, the court may direct a verdict for the defendant and discharge the jury. (*Millner v. Schofield*, 4 *Hughes*, 258); but the defect of evidence must be undoubted. *Klein v. Russell*, 19 *Wall.* 433.

On a motion for a new trial after verdict for plaintiff, in an action for infringement, he may in a proper case have leave to retain his verdict on consenting to a remission of damages. *Russell v. Place*, 9 *Blatchf.* 173; *Conway v. Rumsey*, 4 *Fish. Pat. Cas.* 275.

299. *Hearing, and Rehearing.*

If complainant's patent is seen to be void because the device or contrivance described is not patentable, the court at the hearing should dismiss the cause on that ground, whether defendant raises the objection or not. *Slawson v. Grand St. R. Co.*, 107 *U. S.* 649.

A decree for an injunction against the infringement of a patent and for an accounting is interlocutory, and a rehearing may be

ordered before the report of the master and final decree thereon. *Reeves v. Keystone Bridge Co.*, 2 *Week. N. of Cas.* 523.

Applications for rehearing have been denied, in cases where the reasons assigned were: Newly-discovered evidence to establish anticipation, *Kerosene Lamp Co. v. Littell*, 2 *N. J. L. J.* 150; Newly-discovered evidence to establish prior use, *Hicks v. Ferdinand*, 20 *Fed. Rep'r*, 111; Because defendant did not have proper expert testimony on the original hearing, *Hitchcock v. Tremaine*, 9 *Blatchf.* 550; 4 *Fish. Pat. Cas.* 538.

A petition by the defendant for a rehearing because of newly-discovered evidence in a suit for infringement, should ask leave to file a supplemental bill to bring in the new evidence, and that when the proofs are made thereunder, the cause may be reheard. *Hitchcock v. Tremaine*, *supra*.

Rehearing, in a suit for infringement of patent, was granted to allow further proofs that claims in the patent had been rejected upon a previous application by the same inventor for a patent, and such rejection acquiesced in and right of appeal waived by him. *Railway Register Manuf. Co. v. Broadway & Seventh Ave. R. R. Co.*, 32 *Pat. Off. Gaz.* 257.

A motion for a rehearing was granted on the condition, that in case there should be the same decree rendered, the testimony already taken upon an accounting by the master should stand for use in the case as if taken by the parties respectively upon such new accounting. *American Diamond Rock Boring Co. v. Sheldons*, 24 *Fed. Rep'r*, 374; 32 *Pat. Off. Gaz.* 1240. And see S. C., 25 *Fed. Rep'r*, 768; 33 *Pat. Off. Gaz.* 1598.

Application by the defendant for a re-argument of a suit for infringement of a patent, was denied, upon the same evidence,—the only ground stated being that one of the defenses was not fully presented at the argument. *Railway Register Manuf. Co. v. North Hudson County R. Co.*, 26 *Fed. Rep'r*, 411.

300. *Jury Trial in Equity.*

Allowance of a jury to settle the question of infringement arising in a suit in equity, is not matter of right, but rests in discretion; it is granted when the equity judge entertains reasonable doubts and wishes the aid of a jury. *Brooks v. Norcross*, 2 *Fish. Pat. Cas.* 361.

The differences of witnesses as to the fact of infringement, should be submitted to a jury, either by action at law, or by an issue directed by the court. *Brooks v. Bicknell*, 3 *McLean*, 250 ; 1 *West. L. J.* 150.

On the trial of a feigned issue the patent is not admissible, if it has no tendency to support the issue. Where the feigned issues presented no issue of fraud or mistake, and the bill of complaint was founded exclusively upon the reissued letters patent, it was *held*, that the original letters patent, if objected to, were not admissible on the trial. *Caboon v. Ring*, 1 *Cliff.* 592.

A court of equity is not bound to try by a jury, the issue, as to whether a reissue is for the same invention as the original, although the fact that there is considerable doubt may be a reason for so doing. *Poppenhusen v. Falke*, 4 *Blatchf.* 493 ; 2 *Fish. Pat. Cas.* 181.

The act of February 16, 1875, provides :

That said courts, [circuit courts] when sitting in equity for the trial of patent causes, may impanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises as may, from time to time, be made by the Supreme Court, and submit to them such questions of fact arising in such cause as such circuit court shall deem expedient.

And the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with such findings. Act of Feb. 16, 1875, c. 77, § 2 ; 1 *Supp. to Rev. Stat.* 136.

The above enactment does not affect the established rules of equity practice governing the effect of the verdict on a feigned issue and the mode of seeking a review. *Watt v. Starke*, 101 *U. S.* 247.

301. *Reference to Ascertain Damages or Profits.*

Where infringement to any extent is admitted, and the patent held to be valid, the proper practice is, to enter an interlocutory decree for complainant and send the cause to a master to ascertain the amount the complainant is entitled to recover. *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356; 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; *Jackson v. Breck*, 11 *Pat. Off. Gaz.* 112.

The defendants, adjudged infringers, must go forward in the accounting ordered, and pay the master's fees. *Urner v. Kayton*, 17 *Fed. Rep'r*, 539; 24 *Pat. Off. Gaz.* 1178; 16 *Rep'r*, 225. To the contrary, as to payment of fees, *MacDonald v. Shepard*, 10 *Fed. Rep'r*, 919.

The amount of profits or damages to be allowed in a suit for infringement is matter of fact calling for proof, and if affirmative proof is not made, a master's report of a substantial sum, founded on conjecture, must be disallowed on proper exceptions filed; and a decree entered for nominal damages only. *Ingersoll v. Musgrove*, 13 *Pat. Off. Gaz.* 966; 14 *Blatchf.* 541; 3 *Bann. & A. Pat. Cas.* 304.

The master should simply examine and decide as to the extent of the infringement as to the particular machine used by the defendants; and should not enter into the general question of infringement, nor consider the general scope and extent of the patent. *Turrill v. Illinois Central R. R. Co.*, 5 *Biss.* 344.

The master may take the account down to the time of the hearing before him, if the infringement continues to that period. *Tatham v. Lowber*, 4 *Blatchf.* 86. *S. P.*, *Knox v. Great Western Quicksilver Min. Co.*, 14 *Pat. Off. Gaz.* 897; 7 *Rep'r*, 325; 4 *Bann. & A. Pat. Cas.* 25; 6 *Sawyer*, 430.

The defendants, having been adjudged infringers of a patent for a process, claimed on the accounting, to have so altered their apparatus that its use thereafter no longer infringed the patent; and exhibited to the master such portions of it as were not in use, but, though requested, refused to exhibit the portions that were in use. It was *held*, that the master was justified in finding that the defendants still infringed the patent. *Piper v. Brown*, 1 *Holmes*, 196; 6 *Fish. Pat. Cas.* 240.

Masters charged with the duty of computing and reporting the profits of respondents in infringement suits may examine the res-

pondents, and, if necessary, inspect their books; but it is incumbent upon the complainant to furnish whatever additional proof may be necessary to enable the master to make the proper computation. *Brady v. Atlantic Works*, 15 *Pat. Off. Gaz.* 965; 3 *Bann. & A. Pat. Cas.* 577. Compare *Fisher v. Shaughnessy*, 15 *Rep'r*, 613.

A subpoena *duces tecum* may be issued. Its proper form. *Turrell v. Speath*, 8 *Pat. Off. Gaz.* 986; 2 *Bann. & A. Pat. Cas.* 185; Right of defendant to demand production of plaintiff's books, in connection with cross-examining him. *Wisner v. Dodd*, 14 *Fed. Rep'r*, 655.

The evidence adduced upon an accounting for profits made by the use of a patented bond and coupon register was *held* insufficient to sustain the master's report on an arbitrary estimate based on comparison with a different system, and not tending to show the profits actually derived by the defendants from their use of the patented system as they used it. *Munson v. New York*, 21 *Blatchf.* 342.

302. Costs.

A verdict for nominal damages only, for infringement, under the act of 1836, carried costs. *Merchant v. Lewis*, 1 *Bond*, 172. Under the Revised Statutes, assessment of costs in such cases depends on the circumstances. *Calkins v. Bernard*, 8 *Fed. Rep'r*, 755; 10 *Biss.* 445.

On the taking of an account of profits, the plaintiff exaggerated his claim, introduced irrelevant evidence, and recovered only a small sum. It was *held*, that neither party should recover, against the other, any costs or expenses that accrued before the master, embracing the fees of witnesses, the taking and printing of the evidence, and all disbursements before him, but each party should bear his own. *Troy Iron, &c. Factory v. Corning*, 6 *Fish. Pat. Cas.* 85; 10 *Blatchf.* 223.

Where the complainants united in their bill two causes of action on different patents, and by the allegation that the defendants infringed both, compelled them to litigate both, and as to one of these causes of action the defendants prevailed, it was *held*, that neither party should recover costs as against the other. *Adams v. Howard*, 19 *Fed. Rep'r*, 317; 22 *Blatchf.* 47; 26 *Pat. Off. Gaz.* 825.

Costs of taking testimony, to be used in two suits between the same parties for infringement, should be equally divided between the suits. *Thayer v. Hart*, 30 *Pat. Off. Gaz.* 776.

In an action for infringement, the expense of obtaining a model of the infringing machine, is not taxable as a disbursement by the plaintiff. *Cornely v. Markwald*, 24 *Fed. Rep'r*, 187.

Where the defendants have in good faith obtained models of the devices shown in plaintiff's patent, they may be taxed as costs. *Woodruff v. Barney*, 1 *Bond*, 528. So also such models as are copies of models deposited in the patent-office, and procured for use as a part of the evidence, may be taxed. *Hussey v. Bradley*, 5 *Blatchf.* 210. But see *Parker v. Bigler*, 1 *Fish. Pat. Cas.* 285. Where the plaintiff obtains a decree for nominal damages only, but the defendant persistently contests the validity of the patent, and the question of infringement, as well as the amount of damages, the court will award all costs against the defendant. *Calkins v. Bertrand*, 10 *Bissell*, 445.

303. *Costs, as Affected by Disclaimer.*

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. *Rev. Stat.* § 973.

Rev. Stat. §§ 4917, 4922, see *ante*, 206, 207, permit the filing of disclaimers; and section 4922, see *infra*, contains the following proviso :

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.

For the nature and uses of disclaimers, their effect, and the effect of neglect or delay in filing, see *ante*, pp. 207-211.

Under act of 1837, section 9, the fact that after verdict the plaintiff had disclaimed one of several claims in the patent, did not

necessarily deprive him of costs. *Peck v. Frame*, 5 *Fish. Pat. Cas.* 211. But under Rev. Stat. 4922, where a patent containing two claims was, as to one claim, held invalid, and as to the other sustained; the court *held* that complainant was not entitled to costs *Stewart v. Mahoney*, 5 *Fed. Rep'r*, 360; 4 *Bann. & A. Pat. Cas.* 84.

But this provision does not mean that claims not in issue should be contested for the mere purpose of settling the costs. *American Bell Telephone Co. v. Spencer*, 8 *Fed. Rep'r*, 509; 20 *Pat. Off. Gaz.* 299.

And it applies only to patentees claiming without original right, not to those whose claims have been abandoned by laches in applying for a reissue. *Mundy v. Lidgerwood Manuf. Co.*, 20 *Fed. Rep'r*, 191.

Costs should not be allowed to a complainant in a suit for infringement, who prevails only on account of a disclaimer filed after suit brought, and fails as to a large part of his case. *Hayes v. Bickelhaupt*, 23 *Fed. Rep'r*, 183; 32 *Pat. Off. Gaz.* 133.

304. *Decrees.*

In a suit for infringement of two patents, after the testimony as to one of them was closed, and the cause set down for hearing, an application for leave to discontinue so much of the bill as related to that patent, was made by the plaintiffs. It was *held* that the decree upon granting such leave should contain the condition that the evidence taken by the defendants in relation to the patent might be stipulated into any future suit upon the same patent by the plaintiffs against the defendants. *Brush v. Condit*, 22 *Blatchf.* 246; 20 *Fed. Rep'r*, 826; 28 *Pat. Off. Gaz.* 451.

In an interlocutory decree in a suit for infringement of a patent, awarding profits and damages, and directing a reference to a deputy clerk of the court to take an account of profits, and to assess the damages, no special reason for the appointment of such clerk as referee was assigned, as is required by the act of March 3, 1879 (20 Stat. 415.) It was *held* not a ground for setting aside his report, where the appointment was made upon the assent in open court of solicitors for both parties, and they had proceeded before him for several months with knowledge that he was such deputy clerk; and the decree amended to recite such facts as special reason

for the appointment. *Fischer v. Hayes*, 22 *Blatchf.* 505 ; 22 *Fed. Rep'r*, 92.

The fact, that, upon a decree dismissing, with costs, a bill for infringement of patents, execution for the costs has been issued and returned unsatisfied, is not ground for the appointment of a receiver of the patents as equitable assets, to be disposed of for the satisfying of the decree. *Thayer v. Hart*, 24 *Fed. Rep'r*, 558.

When the decree is interlocutory and not final, the court has power to open the same and allow a new defense, on motion, and without the formality of a bill of review ; but when the application is in fact and substance for a rehearing on newly discovered evidence, it must be supported by the same sort of proof as is required in order to give a party relief upon a bill of review, or a supplemental bill, after a final decree. Application denied as it did not show that the newly discovered evidence could not, with reasonable diligence, have been discovered. *Willimantic Linen Co. v. Clark Thread Co.*, 24 *Fed. Rep'r*, 799 ; 32 *Pat. Off. Gaz.* 1356.

An interlocutory decree in a suit for infringement of a patent, entered *pro confesso*, which finds the patent valid, but leaves open the questions of profits, damages and costs, and orders a reference to take an account, is not conclusive upon the defendant as to the validity of the patent in a suit between the same parties for subsequent infringements ; even where an agreement was entered into between them, whereby the complainant waived damages, profits and costs, so that he might have had the interlocutory decree made final. *Roemer v. Neumann*, 26 *Fed. Rep'r*, 332.

XXII. CASES OF SPECIFICATION TOO BROAD ; OR PRIOR FOREIGN INVENTION.

305. *Suit for Infringement Where Specification is too Broad.*

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. § 4922*

For the nature and uses of disclaimers, their effect, and the consequences of neglect or delay in filing, see *ante*, pp. 207-211. As to costs as affected by disclaimer, see *ante*, p. 478.

306. *Patent not Void on Account of Previous Use in Foreign Country.*

Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. *Rev. Stat. § 4923.*

The use of copies of certified copies of foreign letters-patent is provided for by *Rev. Stat.* § 893, *ante*, p. 27. The subjection of United States patents to foreign patents for the same invention is governed by *Rev. Stat.* § 4887, *ante*; p. 63. In addition to the cases on that subject there cited, the following should be mentioned: Time when a United States patent would expire, as governed by the date of an English patent, in a particular case, determined, see *Weston v. White*, 13 *Blatchf.* 364; 9 *Pat. Off. Gaz.* 1196; 2 *Bann. & A. Pat. Cas.* 321. The life of a foreign patent limits that of an American patent for the same invention, *Globe Nail Co. v. Superior Nail Co.*, 27 *Fed. Rep'r.*, 450; provided the foreign patent is valid, *Bate Refrigerator Co. v. Gillett*, 20 *Id.* 192.

It is only a patent for an invention which has been *previously* actually patented in a foreign country that is limited by the foreign patent. *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 22 *Fed. Rep'r.*, 341; 32 *Pat. Off. Gaz.* 384.

As to the question of identity between the invention described in the foreign patent and the U. S. patent, it was *held*, that the inventor was not estopped from showing a lack of identity, by reason of having represented their identity to be a fact in his application for a U. S. patent, when he labored under a mistake as to this point. *Commercial Manuf. Co. v. Fairbanks Canning Co.*, 27 *Fed. Rep'r.*, 78.

A fair test of identity is to inquire whether the invention described in the U. S. patent will infringe the invention described in the foreign patent. *Ib.*

An error in designating the date from which the patent for an invention which has been patented in a foreign country is to begin to run, may be corrected by a reissue. *Buerk v. Valentine*, 5 *Fish. Pat. Cas.* 366; 9 *Blatchf.* 479; 2 *Pat. Off. Gaz.* 295.

A capacity of being prolonged so as to have a duration of fifteen years is not equivalent to having a term of fifteen years, when the patent is granted for one year, and then prolonged so as to expire at the end of ten years. *Gramme Electrical Co. v. Hochhausen Electric Co.*, 17 *Fed. Rep'r.*, 838; 25 *Pat. Off. Gaz.* 193. But see *Holmes Electrical Protective Co. v. Metropolitan Burglar Alarm Co.*, 28 *Pat. Off. Gaz.* 1189.

Section 4887, is not to be construed as requiring the limitation to be expressed upon the face of the patent, but merely as controlling the effect or duration of the grant. *Canan v. Pound Manuf. Co.*, 31 *Pat. Off. Gaz.* 119.

XXIII. EXTENSIONS.**307. *The former Law Granting and Regulating Extensions of Patents.***

The five sections of the Revised Statutes relating to extensions, viz. §§ 4924 to 4928 inclusive, and numerous decisions to which they gave rise, are omitted, for the reason that the authority for granting extensions by the commissioner, has long been abrogated. The commissioner cannot by the existing law entertain an application to extend a patent, and all extensions heretofore granted have expired. See *ante*, p. 4. Congress can, however, grant an extension of a particular patent (see *ante*, p. 2), and may condition such a grant upon the results of an inquiry to be made before the commissioner. The rules of the patent-office prescribe the manner of conducting such an inquiry. See *Rules of Prac.* Nos. 172–186.

XXIV. PATENTS FOR DESIGNS.**308. *Patents for Designs authorized.***

Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woollen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon

payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor. *Rev. Stat.* § 4929.

309. *Practice in the Patent Office, as to design patents.*

A patent for a design may be granted to any person, whether citizen or alien, in the cases specified in Rule 24, upon payment of the duty required by law, and other proceedings had, as in other cases of inventions or discoveries. *Rules of Prac.* No. 78.

Patents for designs are granted for the term of three and one-half years, or for seven years, or for fourteen years, as the applicant may, in his application, elect. *Id.* 79.

The proceedings in the applications for patents for designs are substantially the same as in applications for other patents. The specification must distinctly point out the characteristic features of the design, and carefully distinguish between what is old and what is believed to be new. The claims also, when the design admits of it, should be as distinct and specific as in the case of other patents. The following order of arrangement should be observed, when convenient, in framing the specification.

1. Preamble showing name and residence of the applicant, title of the design, and the name of the article for which the design has been invented.

2. Detailed description of the design as it appears in the drawing or photograph, letters or figures of reference being used.

3. Claim or claims.

4. Signature of inventor.

5. Signatures of two witnesses.

When the design can be sufficiently represented by drawings or photographs, a model will not be required. *Id.* No. 81.

Whenever a photograph or an engraving is employed to illustrate the design, it must be mounted upon Bristol board, 10 by 15 inches in size, and properly signed and witnessed. The applicant will be required to furnish ten extra copies of such photograph or engraving (not mounted), of a size not exceeding $7\frac{1}{2}$ inches by 11. Negatives are not required. *Id.* No. 82.

Whenever the design is represented by a drawing made to conform to the rules laid down for drawings of mechanical inventions, but one copy need be furnished. Additional copies will be sup-

plied by the photolithographic process at the expense of the patent-office. *Id.* No. 38.

(Forms to be used in applications for design patents, are given in appendix to the Rules, Forms 9 and 15.)

310. *What Designs are Patentable.*

The patent allowed by the law authorizing design patents (formerly act of March 2, 1861, § 11, now *Rev. Stat.* § 4929), is simply for the design itself, not for the means of producing the design. *Clark v. Bousfield*, 10 *Wall.* 133.

The law authorizing patents for designs contemplates its appearance rather than utility ; and that, not an abstract impression, or picture, but an aspect given to one of the objects mentioned in the acts. The thing for which a patent is granted is that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form ; not the mode in which those appearances are produced, but the appearance itself. It is the appearance, no matter how caused, that is the patentable element. *Gorham Co. v. White*, 14 *Wall.* 511.

If a new idea is embodied in the method of arrangement, a design patent is not defeated merely because scrolls and ornamentation similar in effect to the scrolls and ornamentation described in the patent have before been employed. The statute permits a patent for any new, useful, and original shape or configuration of any manufacture ; and where these conditions are complied with, the invention is patentable. *Simpson v. Davis*, 12 *Fed. Rep'r*, 144 ; 20 *Blatchf.* 413.

Design patents stand on as high a plane as utility patents, and require as high a degree of exercise of the inventive or originaive faculty ; a person cannot be permitted to select an existing form, and to claim a patent merely for putting it to a new use, any more than he can be permitted to patent a double use of a machine ; but the selection and adaptation of an existing form may amount to patentable design, just as the adaptation of an existing mechanical device may amount to patentable invention. *Western Electric Manuf. Co. v. Odell*, 18 *Fed. Rep'r*, 321.

Although a drawing or casting or pattern of a letter of the alphabet is not, alone, patentable as a new design, the requisite novelty and usefulness may exist in a combination for some pur-

pose, with something else ; as the shape or configuration of the Roman letter G., for a sewing machine, to which configuration the working machinery of the sewing machine is to be applied. *Gibbs v. Ellithorp*, 1 *MacArthur Pat. Cas.* 702.

To show that a design lacked novelty when patented, it is proper to introduce specimens of it as made before complainant's invention. *Theberath v. Rubber & Celluloid Harness Trimming Co.*, 15 *Fed. Rep'r*, 246 ; 6 *N. J. L. J.* 77 ; 23 *Pat. Off. Gaz.* 1121.

Mechanical and design patents, distinguished. See *Cone v. Morgan Envelope Co.*, 4 *Bann. & A. Pat. Cas.* 107.

A beautiful appearance or color which is the mere result of the common efforts of persons ordinarily skilled in a particular art, such as workers in enamel, is not such a design as may be patented ; the law requires that it should be new and original, and the result of invention and genius. *Matter of Niedringhaus*, 2 *MacArthur*, 149.

The law does not require utility in a design in order to sustain a patent, but it does require that the shape or design shall be the result of industry, effort, genius, or expenditure ; the shape or configuration sought to be secured must be new and original, as applied to articles of manufacture. When a well known form was given to a new device, and no advantage whatever was derived from the adoption of such form, except the incidental one of a trade-mark, and the selection was but an arbitrary, chance selection of one of many well known shapes, all equally adapted to the purpose, it was *held*, that the patent could not be sustained. *Wooster v. Crane*, 5 *Blatchf.* 282 ; 2 *Fish. Pat. Cas.* 583.

A design for a card holding buttons arranged in rows, upon spaces marked on the cards, is not "new and useful" in such sense as to be patentable under the law authorizing design patents ; such cards have long been in use. *Pratt v. Rosenfeld*, 3 *Fed. Rep'r*, 335 ; 18 *Blatchf.* 231 ; 10 *Rep'r*, 328 ; 21 *Pat. Off. Gaz.* 866.

An improvement in spelling-blocks, consisting in the placing of two or more letters on each block, is not patentable, although the inventor was the first one to place the letters systematically, with a view to enlarge the usefulness of the blocks. *Hill v. Houghton*, 6 *Pat. Off. Gaz.* 3 ; 1 *Bann. & A. Pat. Cas.* 291.

Modifying the form of sieves by "flaring," so that a number may be "nested," is not new, and therefore is not patentable, even if the idea were a patentable design. *Adams & Westlake Manuf. Co. v. St. Louis Wire Goods Co.*, 3 *Bann. & A. Pat. Cas.* 77.

The mere substitution of one material for another, in the construction or for the purposes of an ornament, the ornament to be "of any approved form," cannot properly be patentable. Thus a design described as "a curtain and loop, consisting of an ornamental metallic chain, in connection with a curtain adapted to be gathered to the side of the window, and be held by said chain;" the claim covering merely the substitution for the old loop, composed of silk or woolen, of one made of metal, no new form or shape being given to the curtain or to the loop, is not patentable as a design, even if such a change can properly be called a design. *Post v. Richards Hardware Co.*, 26 *Fed. Rep'r*, 618. See *Post v. Richards Hardware Co.*, 25 *Fed. Rep'r*, 905; *Theberath v. Rubber & Celluloid Harness Trimming Co.*, 3 *Fed. Rep'r*, 151; 5 *Bann. & A. Pat. Cas.* 584.

311. *Validity of Design Patents.*

The patent is *prima facie* evidence of both the novelty and utility of the design. *Lehnbetter v. Holthaus*, 105 *U. S.* 94; 21 *Pat. Off. Gaz.* 1755.

Where a bill founded on a design patent with a claim for a pattern, and separate claims for each of its parts, is taken as confessed, it alleging infringement of the "invention," the patent will be held valid for the purposes of the suit. *Dobson v. Hartford Carpet Co.*, 114 *U. S.* 439.

A claim of "the design for a carpet, substantially as shown," refers to the description and the drawing, and is valid. *Ib.*

A claim to "the configuration of the design," is a claim to the design, figure, or pattern. *Dobson v. Dorman*, 35 *Pat. Off. Gaz.* 750; 6 *Sup. Ct. Rep'r*, 946.

To constitute a valid patent it is not necessary that the "inventor" (of a design) should personally have the manual skill and dexterity to make the drafts; if the ideas are furnished by him, he may avail himself of the mechanical skill of others to carry them out. *Sparkman v. Higgins*, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122.

A preliminary injunction may be granted in a proper case, although there has not been a decision at law sustaining the validity of the patent, nor any long continued public acquiescence. *So held*, in a case of a design patent, but on grounds applicable to cases of mechanical patents. *Foster v. Crossin*, 23 *Fed. Rep'r*, 400.

The claim in a patent for a design for figured silk buttons, was

for the radially formed ornaments on the face of the mould of the button, combined with the mode of winding the covering of the same. The specification described the configuration of the mould and the winding it with various colored threads, but did not describe the process of winding the silk. It was *held*, that the claim did not cover that process, but was for the arrangement of the different colored threads in such manner as to produce the ornaments as described. *Booth v. Garelly*, 1 *Blatchf.* 247; 6 *N. Y. Leg. Obs.* 99.

An inventor of a design for buttons manufactured such buttons, and put them upon the market two or three months before he applied for a patent for the design. It was *held*, that the question whether his doing so was an abandonment of his design, was a question of intention, to be determined as a question of fact, on a trial at law; and that a preliminary injunction might well be withheld until such trial should be had. *Ib.*

Billiard tables with beveled ends are old; hence a design for a billiard table, having a greater bevel than has heretofore been used, is void, as not involving any sufficient invention or discovery. *Collender v. Griffith*, 11 *Blatchf.* 212; 3 *Pat. Off. Gaz.* 630. See *Collender v. Griffith*, 18 *Blatchf.* 110.

A combination or aggregation of old designs producing no new appearance, is not patentable; thus a design patent for a rectangular provision-safe, was held invalid, the only originality consisting in the use of two vertical panels in each wall, and a familiar moulding around the top and bottom. *Northrup v. Adams*, 12 *Pat. Off. Gaz.* 430; 2 *Bann. & A. Pat. Cas.* 567.

A design patent is valid when the specification and claim refer for the entire description of the design to a photographic illustration accompanying the specification. *Dobson v. Dorman*, 35 *Pat. Off. Gaz.* 750; 6 *Sup. Ct. Rep'r*, 946.

But where the prominent claim in a design patent is necessarily for figures in relief, a photograph of the design, since it does not show the relief, fails to sufficiently describe the design, in the absence of a minute description in the specification. *Untermeyer v. Jeannot*, 20 *Fed. Rep'r*, 503.

Regulations and provisions applicable to the obtaining or prohibition of patents for inventions or discoveries, not inconsistent with the existing patent act, apply to patents for designs without modification or variation. *Miller v. Smith*, 5 *Fed. Rep'r*, 359; 18 *Pat. Off. Gaz.* 1047.

Design patents, as well as mechanical patents, are avoided by

having been in public use or on sale for more than two years prior to the application. *Theberath v. Rubber & Celluloid Harness, &c. Co.*, 6 *N. J. L. J.* 77 ; 15 *Fed. Rep'r*, 246.

312. *Infringement of Design Patents.*

It is not essential to constitute infringement, that the appearance of the imitation should be the same as that of the genuine, to the eye of an expert. The test of a patent for a design is the eye of an ordinary observer. If, to an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such that the imitation would deceive such an observer, inducing him to purchase one supposing it to be the other, the one first patented is infringed by the other. *Gorham Manuf. Co. v. White*, 14 *Wall.* 511 ; reversing 7 *Blatchf.* 513 ; *Miller v. Smith*, 5 *Fed. Rep'r*, 359 ; 18 *Pat. Off. Gaz.* 1047 ; *Dryfoos v. Friedman*, 18 *Fed. Rep'r*, 824 ; 21 *Blatchf.* 563 ; *Jennings v. Kibbe*, 10 *Fed. Rep'r*, 669 ; 22 *Pat. Off. Gaz.* 331 ; 20 *Blatchf.* 353 ; *Wood v. Dolby*, 7 *Fed. Rep'r*, 475 ; *Dreyfus v. Schneider*, 25 *Fed. Rep'r*, 481. In a proper case the court may determine this question of identity by an inspection of the two designs. *Jennings v. Kibbe, supra.*

A patent for a design which covers the ornamentation shown in it, is not infringed by the use of the principal figure without the ornamentation. *Collender v. Griffith*, 11 *Blatchf.* 212 ; 3 *Pat. Off. Gaz.* 689.

It is an infringement where the difference between the two designs is not appreciable by observing their artistic effect, such differences being merely in detail. *Wood v. Dolby*, 7 *Fed. Rep'r*, 475.

It is an infringement to adopt the design so as to produce substantially the same appearance ; adoption of the design in every particular is not necessary. *Root v. Ball*, 4 *McLean*, 177.

Infringement of a design patent may exist notwithstanding the fact that the alleged infringing article is made to carry a distinguishing name or distinguishing marks of other character. *Perry v. Starrett*, 14 *Pat. Off. Gaz.* 599 ; 3 *Bann. & A. Pat. Cas.* 485.

There may be an infringement of a design without taking the whole of it ; but in such cases the part taken must be a part covered by the patent. *Dryfoos v. Friedman*, 18 *Fed. Rep'r*, 824 ; 21 *Blatchf.* 563.

To constitute an infringement of a patent for a design, there is no necessity that the patented design should be copied in every particular. If the infringing design has the same general appearance, if to the eye of an ordinary person the two are substantially similar there is actionable infringement. *Tomkinson v. Willets Manuf. Co.*, 23 *Fed. Rep'r*, 895; 31 *Pat. Off. Gaz.* 918.

A patent for a design for a fringed lace fabric, the novelty of which appertains to the fringe alone, is not infringed by articles similar to the body of the fabric, but differing as to the fringe. *Jennings v. Kibbe*, 24 *Fed. Rep'r*, 697; 32 *Pat. Off. Gaz.* 653.

313. *Damages or Profits for Such Infringement.*

To warrant an award of more than nominal damages for an infringement of a design, plaintiff must introduce some evidence either of what sum he lost or defendant realized, by the infringement, or of what value was added to the manufactured article by the design; the award of damages or profits in patent cases is a subject of proof, not of mere inference or conjecture. *Dobson v. Hartford Carpet Co.*, 114 *U. S.* 439.

In a suit for infringement of a patent for a design, the remainder of the price realized by defendant from the sale of articles of the patented design, after deducting the cost of making them, and a fair profit for their manufacture, may be presumed to represent the profit realized by the defendant from his adoption of the design; and this presumption is not dispelled by proving that defendant realized the same profit from adopting, in the manufacture of similar articles, a different and unpatented design. *Simpson v. Davis*, 22 *Blatchf.* 113; 22 *Fed. Rep'r*, 444.

Damages for infringement of design patents are to be computed on the same principle as in the case of machine patents; they cannot include the entire profits of the manufacture, but must be confined to the profits which arise from the use of the particular design. *Dobson v. Dorman*, 35 *Pat. Off. Gaz.* 750; 6 *Sup. Ct. Rep'r*, 946; following *Dobson v. Hartford Carpet Co.*, *supra*.

In a suit for infringement of a design for carpets, the evidence showed the quantity of complainant's carpet sold during the season of its introduction, its cost, the profit upon it, the quantity of respondent's carpet sold during the next season, and that there was then a decline in complainant's sales. The measure of damages was *held* to be the profits which would have accrued to complain-

ants on the quantity of carpet sold by defendant. *Bigelow Carpet Co. v. Dobson*, 10 *Fed. Rep'r*, 385 ; 13 *Rep'r*, 265.

314. *Additional Provisions as to Design Patents. Models of Designs.*

The commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. *Rev. Stat.* § 4930

315. *Duration of Patents for Designs.*

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. *Rev. Stat.* § 4931.

316. *Extension of Patents for Designs*

Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty one. *Rev. Stat.* § 4932.

This section has become obsolete. See notes to *Rev. Stat.* 4924, *ante*, 483.

317. *Patents for Designs Subject to General Rules of Patent Law.*

All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this title, shall apply to patents for designs. *Rev. Stat.* § 4933.

318. *Copyright of Designs.*

Act of June 18, 1874, c. 301, § 1, contains the following provision, relative to copyright of a class of designs.

No person shall maintain an action for the infringement of his copyright, unless he shall give notice thereof by inserting in the several copies of every edition published . . . if a . . . model or design intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words, viz: "Entered according to act of Congress, in the year ———, by A. B., in the office of the Librarian of Congress, at Washington;" or, at his option, the word "Copyright," together with the year the copyright was entered, and the name of the party by whom it was taken out; thus— "Copyright, 18—, by A. B." 18 *Stat.* p. 78, § 1. 1 *Supp. Rev. Stat.* 40, § 1.

Where a design patent for a billiard table was declared void, and the defendant had a right to make them as he did, it was *held*, that there was no infringement of a copyright, which was a mere copy of the design, in defendant's publishing an engraving of his tables. *Collender v. Griffith*, 11 *Blatchf.* 212; 3 *Pat. Off. Gaz.* 689.

A copyrighted design for playing cards is infringed by cards which, though differing in some respects, exhibit a striking similarity in those distinctive features of the main design, wherein the cards registered differ from other playing cards previously used. *Richardson v. Miller*, 12 *Pat. Off. Gaz.* 3.

319. *Registration of Prints or Labels.* •

Act of June 18, 1874, c. 301, § 3, contains the following provision relative to registration, in the patent-office, of prints or labels :

No prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent-office. And the commissioner of patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the commissioner of patents, to the party entering the same. 18 *Stat.* p. 79, § 3; 1 *Supp. Rev. Stat.* 41, § 3.

The doctrine that the several acts of Congress relating to the registration of prints designed to be used as labels, allow registration of a label which might also be registered as a trade-mark; and that the question whether the commissioner of patents shall regard an application submitted to him for registration as being a trade-mark or a label, depends wholly upon the will of the proprietor (*United States v. Marble*, 1 *Mackey*, 284; 22 *Pat. Off. Gaz.* 1366); has since been overruled in *United States v. Butterworth*, 30 *Pat. Off. Gaz.* 97.

XXV. FEES AND CHARGES.

320. *Fees in obtaining Patents.*

The following shall be the rates for patent fees.

On filing each original application for a patent, except in design cases, fifteen dollars.

On issuing each original patent, except in design cases, twenty dollars.

In design cases: For three years and six months, ten

dollars ; for seven years, fifteen dollars ; for fourteen years, thirty dollars.

On filing each caveat, ten dollars.

On every application for the reissue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from the primary examiners to the examiners in chief, ten dollars.

On every appeal from the examiners in chief to the commissioner, twenty dollars.

For certified copies of patents and other papers, including certified printed copies, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar ; of over three hundred and under one thousand words, two dollars ; of over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making them. *Rev. Stat.* § 4934.

The above are the fees prescribed by the *Revised Statutes*. The table given in Rule 209 Rules of Practice in the patent-office, is somewhat more minute ; and covers a number of services as to which the statutes have not made any express provision.

The rules of the patent-office prescribe that :

An order for a copy of an assignment must give the liber and page of the record, as well as the name of the inventor ; otherwise an extra charge will be made for the time consumed in making any search for such assignment (*Rules of Prac. No. 210*) ; and that :

No person will be allowed to make copies or tracings from the files or records of the office. Such copies will be furnished, when ordered, at the rates already specified. *Id.* 211.

The list of prices of publications may be found in the Rules of Practice, Nos. 217, 218.

321. *The Exemption of Government Officers from Payment of Fees.*

The act of March 3, 1883, c. 143, contains the following provision :

The secretary of the interior and the commissioner of patents are authorized to grant any officer of the Government, except officers and employees of the patent-office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes, when such invention is used or to be used in the public service, without the payment of any fee ; *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be used by the Government, or by any of its officers or employees, in the prosecution of work for the Government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent. Act of March 3, 1883, 22 Stat. c. 143, p. 625.

322. *Mode of Payment.*

Patent fees may be paid to the commissioner of patents, or to the treasurer, or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the secretary of the treasury for that purpose ; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the patent-office, for any purpose, or from any source whatever, shall be paid into the treasury as receiver, without any deduction whatever, *Rev. Stat.* § 4935.

The Rules of Practice numbers 208, 212, 213 and 214, also relate to the mode of payment.

323. *Refunding.*

The treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the treasury, or to any receiver or depository, to the credit of the treasury, as for fees accruing at the patent-office, upon a certificate thereof being made to the treasurer by the commissioner of patents. *Rev. Stat.* § 4936.

See also Rules of Practice No. 215.

FORMS.

[From the Pamphlet: *Rules of Practice in the United States Patent-Office*; ed. 1885.]

PETITIONS.**1. BY A SOLE INVENTOR.**

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at S., in the county of M., and State of N. [*or*, subject, &c.], prays that letters patent be granted to him for the improvement in sewing-machines set forth in the annexed specification.

A. B.

2. BY JOINT INVENTORS.

To the Commissioner of Patents:

Your petitioners, A. B. and C. D., citizens of the United States residing respectively at L., in the county of M., and State of N., and at G., in the county of H., and State of I. [*or*, subject, &c.], pray that letters patent may be granted to them, as joint inventors, for the improvement in washing-machines set forth in the annexed specification.

A. B.

C. D.

3. BY AN INVENTOR FOR HIMSELF AND AN ASSIGNEE.

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at L., in the county

of M., and State of N. [*or*, subject, &c.], prays that letters patent may be granted to himself and C. D., a citizen of the United States residing at L., in the county of M., and State of N., as his assignee, for the improvement in printing presses set forth in the annexed specification.

A. B.

4. PETITION WITH POWER OF ATTORNEY.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], prays that letters patent may be granted to him for the improvement in lamps set forth in the annexed specification ; and he hereby appoints C. D.,* of the city of R., State of S., his attorney, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the patent-office connected therewith.

A. B.

5. BY AN ADMINISTRATOR.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], administrator of the estate of C. D., late a citizen of S., deceased (as by reference to the duly certified copy of letters of administration, hereto annexed, will more fully appear), prays that letters patent may be granted to him for the invention of the said C. D. (improvement in fire-hose) set forth in the annexed specification.

A. B., *Administrator, &c.*

6. BY AN EXECUTOR.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], executor of the last will and testament of C. D., late a citizen of S., deceased (as by reference to the duly certified copy of letters testamentary, hereto annexed, will more fully appear), prays that letters patent may be granted to him for the invention of the said C. D. (improvement in churns), set forth in the annexed specification.

A. B., *Executor, &c.*

7. FOR A REISSUE (BY THE INVENTOR).

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], prays that he may be allowed to surrender the letters patent for an improvement in coal-scuttles, granted to him May 16, 1867, whereof he is now sole owner [*or*, whereof C. D., on whose behalf and with whose assent this application is made, is now sole owner, by assignment], and that letters patent may be reissued to him [*or*, the said C. D.] for the same invention, upon the annexed amended specification. With this petition is filed an abstract of title, duly certified, as required in such cases.

A. B.

* If the power of attorney is to a firm, the name of each member of the firm must be given in full.

ASSENT OF ASSIGNEE TO REISSUE.

The undersigned, assignee of the entire [*or, of an undivided*] interest in the above-mentioned letters patent, hereby assents to the accompanying application.

C. D.

8. FOR A REISSUE (BY ASSIGNEE).

(To be used only when the inventor is dead or the original patent was issued and assigned prior to July 8, 1870.)

To the Commissioner of Patents :

Your petitioners, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c.*], and C. D., a citizen of the United States residing at H., in the county of I., and State of K. [*or, subject, &c.*], pray that they may be allowed to surrender the letters patent for an improvement in coal-scuttles, granted May 16, 1867, to E. F., now deceased, whereof they are now owners, by assignment, of the entire interest, and that the letters patent may be reissued to them for the same invention, upon the annexed amended specification. With this petition is filed an abstract of title [*or, an order for making and filing the same, &c.*].

A. B.

9. FOR LETTERS PATENT FOR A DESIGN.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c.*], prays that letters patent may be granted to him for the term of three and one-half years [*or, seven years, or, fourteen years*]* for the new and original design for carpets set forth in the annexed specification.

A. B.

10. CAVEAT

The petition of A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c., see Rule 191*], represents :

That he has made certain improvements in cotton-gins, and that he is now engaged in making experiments for the purpose of perfecting the same, preparatory to applying for letters patent therefor. He therefore prays that the subjoined description of his invention may be filed as a caveat in the confidential archives of the patent office.

A. B.

11. FOR THE RENEWAL OF A FORFEITED APPLICATION.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c.*], represents that on May 8, 1868, he filed an application for letters patent for an improvement in fences, serial number 885, which application was allowed July 7, 1868, but that he failed to make payment of the final fee within the time allowed by law. He now makes renewed application for letters patent for said invention, and prays that the original specification, oath, drawings, and model may be used as a part of this application.

A. B.

* Section 4931 of the R. S. requires the election to be made in the original application.

SPECIFICATIONS.

12. FOR AN ART OR PROCESS.

To all whom it may concern :

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c.*], have invented certain new and useful improvements in purifying and increasing the illuminating power of gas without appreciable loss of bulk (for which I have received letters patent in England, No. 750, dated July 6, 1878*); and I do hereby declare that the following is a full, clear, and exact description of the invention, which will enable others skilled in the art to which it appertains to make and use the same.

Heretofore gas has been purified by passing it through animal charcoal; but when this is used alone, after a short time it loses its power of absorbing impurities, and must then be washed with steam or water, or have atmospheric air blown through it, or be revived by heat. Used alone, animal charcoal also reduces the candle-power of the gas passed through it and diminishes its bulk.

The object of my invention is thoroughly to purify illuminating gas, to make the operation continuous, and to purify the gas without detracting from its illuminating power, and without causing any appreciable diminution in bulk; and to this end my invention consists in increasing the power of animal charcoal to eliminate from illuminating gas those substances which are considered impurities, in charging the charcoal with a substance which will prevent it from depriving the gas of illuminants, and in passing the gas to be purified with atmospheric air through the animal charcoal.

To carry my invention into effect, I moisten the charcoal (which may be either new or spent) with coal-tar, or with coal-tar and water, or in some cases with water only, and then charge this mass into one or more vessels, which then constitute the purifiers. I may put the mass into the vessels while still wet, or, unless water alone is used, after it has dried. Through these vessels the gas is to pass; but before it is admitted I introduce into it at the retorts, or at the stand-pipe or mains beyond, in order to insure a thorough admixture, a small quantity of atmospheric air—say, from eight-tenths to two and a half per cent. of the bulk of the gas to be purified. The quantity of air will depend directly upon the impurities of the gas. Any suitable mixing device for thoroughly mixing the admitted air with the gas may be located at any point in the mains between the retorts and the bone-black purifiers, or even at the point of admission to the purifier. For water-gas, the charcoal wet with water alone will suffice, air being introduced into the gas.

The oxygen of the air partly unites with the sulphur to form soluble salts, and the rest combines totally with the hydrogen of the sulphureted and other hydrogen sulphur compounds to form water, and part of the sulphur of the sulphureted hydrogen and other sulphur compounds is precipitated in a free state in the charcoal, while its nitrogen partly goes to form, with part of the remaining hydrogen, ammonia bases. No free oxygen passes off with the purified gas, while if any nitrogen goes over, the quantity is so small that it is not detrimental.

* If no foreign patent has been obtained, the words in parenthesis should be omitted.

By the application of air in this manner the process is rendered continuous as the charcoal is kept constantly active for a great length of time.

When the absorbing power of the charcoal finally becomes exhausted, it may either be sold for the valuable ammoniacal salts it contains, or it may be revived, or be washed and freed from sulphur by a suitable sulphur solvent for re-use.

By charging the bone-black with coal-tar, I prevent it from taking out of the gas any olefiant gas or other heavy hydrocarbons serving as illuminants.

I may treat the black, either before or after putting it into the vessels, as may be most convenient or suitable, with any substance correlative to the illuminants of the gas—that is, with any substance which will impregnate the black in such a manner that it will not take up such illuminants. I have particularly described coal-tar because that is most readily at hand ; but its hydrocarbon distillates or the benzole series will answer.

In the case of coal-gas, not only is the sulphureted hydrogen with which it is contaminated taken up, as just described, but the illuminating power of the gas, which is somewhat reduced if passed through dry animal charcoal or bone-black, is not decreased when air is used and the animal charcoal or bone-black is wet with tar, but is actually improved, inasmuch as it gives a whiter flame, of the same candle power as the gas not passed through animal charcoal or bone-black at all.

By the old method, when purification was effected by the use of lime, the sulphureted hydrogen and carbonic acid were absorbed by the lime, and the result was, of course, a loss of the original bulk of the gas. Now, by my process the sulphur and hydrogen are separated, the sulphur remaining in the charcoal and the hydrogen passing through with the gas while the carbonic acid passes through entire ; and although it passes through unchanged, it is sufficiently carbureted not to detract from the illuminating power of the gas. I thus have practically the same bulk of gas after purification as before this operation, and loss is prevented without detriment to the consumer.

A striking advantage of my process is, that it unites the scrubbing and purifying operations, for the gas may be passed directly from the condenser into my purifiers.

To eliminate sulphureted hydrogen, I may also mix with the charcoal a substance which will of itself decompose sulphureted hydrogen contained in gas, such as oxide of iron, tin, manganese ore, &c.

When the gas issues from my purifiers it is entirely free from ammoniacal and sulphur compounds, and is nearly inodorous.

When the charcoal is removed from the purifiers it is also inodorous, and is in no sense offensive and disgusting like gas-lime.

Having fully described my invention, what I desire to claim, and secure by letters patent, is—

1. In the purification of illuminating-gas by means of animal charcoal, the process of preventing absorption of illuminants of the gas by the charcoal, which consists in supplying the charcoal with a suitable correlative to such illuminants, as described.

2. The process of purifying illuminating-gas, which consists in mixing the same with air and then passing it through animal charcoal impregnated with coal-tar, all substantially as described.

A. B.

Witnesses :

P. G.
J. D.

13. FOR A MACHINE.

To all whom it may concern :

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c.*], have invented a new and useful Meat chopping Machine (for which I have obtained a patent in Great Britain, No. 870, bearing date June 24, 1878), of which the following is a specification :

My invention relates to improvements in meat-chopping machines in which vertically reciprocating knives operate in conjunction with a rotating chopping-block ; and the objects of my improvements are, first, to provide a continuously lubricated bearing for the block ; second, to afford facilities for the proper adjustment of the knives independently of each other in respect to the face of the block ; and third, to reduce the friction of the reciprocating rod which carries the knives.

I attain these objects by the mechanism illustrated in the accompanying drawing, in which*

A. B.

Witnesses :

C. D.

E. F.

14. FOR A COMPOSITION OF MATTER.

To all whom it may concern :

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c.*], have invented a new and useful composition of matter to be used for the removal of hair and grease from hides preparatory to tanning, of which the following is a specification :

My composition consists of the following ingredients, combined in the proportions stated, viz :

Pure water	500 gallons.
Unslacked lime	32 gallons.
Soda-ash	100 pounds.
Saltpetre	20 pounds.
Flowers of Sulphur	10 pounds.

These ingredients are to be thoroughly mingled by agitation.

In using the above-named composition the hides should first be freed from all salt and impurities, by soaking green hides one day and dry hides eight days, and then placing the hides so cleaned in the said solution, and allowing them to remain in it 48 hours. The hides are then to be removed from the solution and unhaired in the usual way.

By the use of the above composition the hair is speedily and thoroughly loosened and the hides, while retaining all of that portion of the substance which can be converted into leather, are at the same time entirely cleaned from grease and other substances which would prevent them from being tanned quickly.

I am aware that a composition consisting of soda-ash, water, lime, and sulphur has been used for the same purpose, and that a patent therefor was granted to C. D.,

* For the drawing referred to, and the description of the machine see the Rules and directions, p. 58.

July 10, 1875, No. 95,726. I am also aware that saltpetre has been used in depilatory processes; but I am not aware that all of the ingredients of my composition, in the proportion stated, have been used together.

What I claim, and desire to secure by letters patent of the United States, is—

The herein-described composition of matter to be used for depilating hides and preparing them for being tanned, consisting of water, unslacked lime, soda-ash, saltpetre, and flowers of sulphur, in the proportions specified.

A. B.

Witnesses:

C. D.

E. F.

15. FOR A DESIGN.

To all whom it may concern:

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c.*], have invented, and produced a new and original design for watch-cases or lockets, of which the following is a specification, reference being had to the accompanying drawings, forming part thereof.

Figure 1 is a sectional view of my newly-designed case, Fig. 2 a side elevation of same, and Fig. 3 an edge view, these three views being deemed necessary to fully illustrate my design.

Heretofore watch-cases and lockets have been made which presented, when viewed in elevation, as in Fig. 2, a scalloped outline or periphery, some being made to imitate shells. In these the scallops extend entirely across from lid to lid, and in a watch-case the center which holds the movements is also scalloped to correspond.

The leading feature of my design consists in a raised or "struck up" scalloped surface, the outlines of which, when viewed in elevation, as in Fig. 2, will fall entirely within the circular outline or circumference of the center.

A is the center of the case, which is circular in its general contour, and B B are the lids. These are also circular in their outer contour where they join the center, but have scallops C C C formed in some way upon them, substantially as represented in the several figures. The indented outline of the scalloped surface falls within the outer contour line of the case, thus presenting to the eye the combined effect of a smooth circular outline or center and an indented or scalloped outline within it.

I claim—

1. The design for a watch-case or locket herein shown and described, the same consisting of the raised scallops C C C on the lid, forming an indented outline wholly within the circular outline of the edge of the lid and the center A.

2. The design for a watch-case or locket herein shown and described, the same consisting of a circular lid, B, having a connected series of raised scallops, C C C, the contour of the same being entirely within the contour of the lid.

A. B.

Witnesses:

C. D.

E. F.

16. FOR A CAVEAT.

To the Commissioner of Patents:

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c. See Rule 191.*], having invented an

improvement in velocipedes, and desiring further to mature the same, file this my caveat therefor, and pray protection of my right until I shall have matured my invention.

The following is a description of my newly-invented velocipede, which is as full, clear, and exact as I am able at this time to give, reference being had to the drawing hereto annexed.

This invention relates to that class of velocipedes in which there are two wheels connected by a beam forming a saddle for the rider, the feet being applied to cranks that revolve the front wheel.

The object of my invention is to render it unnecessary to turn the front wheel so much as heretofore, and at the same time to facilitate the turning of sharp curves. This I accomplish by fitting the front and the hind wheels on vertical pivots, and connecting them by means of a diagonal bar, as shown in the drawing, so that the turning of the front wheel also turns the back wheel with a position at an angle with the beams, thereby enabling it easily to turn a curve.

In the drawing, A is the front wheel, B the hind wheel, and C the standards extending from the axle of the front wheel to the vertical pivot E, in the beam F, and D is the cross-bar upon the end of E, by which the steering is done. The hind wheel B is also fitted with jaws G and a vertical pivot H.

A. B.

Witnesses :

C. D

E. F

OATHS.

17. BY AN INVENTOR.

(To follow specification.)

STATE OF _____, County of _____, ss :

_____, the above-named petitioner, citizen of _____, and resident of _____ in the county of _____ and State of _____, being duly sworn (or affirmed), depose and say that² _____ verily believe³ _____ to be the original, first, and⁴ _____ inventor of the improvement in⁵ _____ described and claimed in the foregoing specification ; that the same has not been patented to⁶ _____, or to others with⁷ _____ knowledge or consent, except in the following countries :⁸ _____ ; that the same has not to⁹ _____ knowledge been in public use or on sale in the United States, for more than two years prior to this application, and¹⁰ _____ do not know and do not believe that the same was ever known or used prior to¹¹ _____ invention thereof.

(Inventor's full name):

¹ If the applicant be an alien, he will state of what foreign or sovereign state he is a citizen or subject.

² "He" or "they."

³ "Himself" or "themselves."

⁴ "Sole" or "joint."

⁵ Insert title of invention.

⁶ "Himself" or "themselves."

⁷ "His" or "their."

⁸ Here insert, if previously patented, the country or countries in which it has been so patented, giving the date and number of each patent. If not previously patented, erase the words "except in the following countries" and insert the words "in any country."

⁹ "His" or "their."

¹⁰ "He" or "they."

¹¹ "His" or "their."

Sworn to and subscribed before me this day of , 188

[I. S.] (Signature of justice or notary) :

(Official character) :

[For officers before whom the oath may be made, see Rule 46. If the applicant be an alien, the oath will show of what foreign state or sovereign he is a citizen or subject.

If the applicants claim to be joint inventors, the oath will show "that they verily believe themselves to be the original, first and joint inventors," &c.

If the inventor be dead, the oath will be made by the administrator or executor, who will declare his belief that the party named as inventor was the original and first inventor.]

19. BY AN APPLICANT FOR A REISSUE (INVENTOR).

STATE OF I., County of K., ss :

A. B., the above-named petitioner, being duly sworn [or, affirmed], deposes and says that he verily believes that his aforesaid letters patent are inoperative [or, invalid, or, both] by reason of a defective [or, insufficient] specification [or both, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new], and that the error arose by inadvertence [or accident or, mistake], without any fraudulent or deceptive intent; that he is the sole owner of said letters patent; [or, that E. F. is the sole owner of said letters patent, and that this application is made on the behalf and with the consent of said E. F.;] and that he verily believes himself to be the first and original inventor of the improvement set forth and claimed in this amended specification, and does not believe that the same was ever before known or used.

A. B.

Sworn to and subscribed before me this 26th day of July, 1869.

C. D.,

[Title of office.]

20. BY AN APPLICANT FOR A REISSUE (ASSIGNEE).

(To be used only when the inventor is dead or in cases of patents issued and assigned prior to July 8, 1870.)

STATE OF I., County of K., ss :

A. B. and C. D., the above-named petitioners, being duly sworn [or affirmed], depose and say that they verily believe that the aforesaid letters patent granted to E. F. are [here follows form 19, mutatis mutandis]; that the entire title to said letters patent is vested in them; and that they verily believe the said E. F. to be the first and original inventor of the invention set forth and claimed in the foregoing amended specification; and that the said E. F. is now deceased.

A. B.

C. D.

Sworn to and subscribed before me this 14th day of November, 1869.

A. B.,

[Title of Office.]

21. SUPPLEMENTAL OATHS TO ACCOMPANY A NEW OR AN ENLARGED CLAIM.

STATE OF I., County of K. ss :

A. B., whose application for letters patent for an improvement in seed-drills (Serial Number 4526, was filed in the United States patent office on or about the 15th day

of March, 1869, being duly sworn [or, affirmed], deposes and says that he verily believes himself to be the original and first inventor of the improvement as described and claimed in the foregoing amendment, in addition to that which was embraced in the claims originally made, and that he does not know and does not believe that the same was ever before known or used, and that the matter sought to be inserted formed a part of his original invention at the date of filing said application.

A. B.

Sworn to and subscribed before me this 11th day of July, 1870.

C. D.,

[Official title.]

22. OATH AS TO THE LOSS OF LETTERS PATENT.

STATE OF I., County of K., ss :

A. B., of said county, being duly sworn [or, affirmed], doth depose and say that the letters patent No. 12,213, granted to him, and bearing date on the 9th day of January, A. D. 1855, have been either lost or destroyed; that he has made diligent search for the said letters patent in all places where the same would probably be found, if existing, and that he has not been able to find them.

A. B.

Subscribed and sworn to before me this 5th day of October, 1868.

C. D.,

[Official title.]

23. OATH OF ADMINISTRATOR AS TO THE LOSS OF LETTERS PATENT.

STATE OF I., County of K., ss :

A. B., of said county, being duly sworn, doth depose and say that he is administrator of the estate of E. F., deceased, late of L., in said county; that the letters patent No. 12,219, granted to said E. F., and bearing date of the 9th day of January, A. D. 1855, have been lost or destroyed, as he verily believes; that he has made diligent search for the said letters patent in all places where the same would probably be found, if existing, and especially among the papers of the decedent, and that he has not been able to find said letters patent.

A. B.,

Administrator, &c.

Subscribed and sworn to before me this 5th day of October, 1868.

C. D.,

[Official title.]

24. POWER OF ATTORNEY AFTER APPLICATION FILED.

If the power of attorney be given at any time other than that of making application for letters patent, it will be in substantially the following form :

To the Commissioner of Patents :

The undersigned having, on or about the 20th day of July, 1859, made application for letters patent for an improvement in horse-powers (Serial Number 982), hereby appoints C. D., of L., in the county of M., and State of N., his attorney, with full power of substitution and revocation, to prosecute said application, to make alterations and amendments therein, to receive the patent, and to transact all business in the patent-office connected therewith.

Signed at L., in the county of M., State of N., this 6th day of June, 1870.

A. B.

25. REVOCATION OF POWER OF ATTORNEY.

To the Commissioner of Patents :

The undersigned having, on or about the 26th day of December, 1867, appointed C. D., of L., in the county of M., and State of N., his attorney to prosecute an application for letters patent, which application was filed on or about the 1st day of June, 1868, for an improvement in the running gear of wagons (Serial Number 870), hereby revokes the power of attorney then given.

Signed at L., in the county of M., and State of N., this 21st day of July, 1869.

A. B.

26. AMENDMENT.*

To the Commissioner of Patents. :

In the matter of my application for letters patent for an improvement in sewing machines, filed May 1, 1879 (Serial Number 540), I hereby amend my specification as follows :

By striking out all between the 5th and 20th lines, inclusive, of page 3 ;

By inserting the words *connected with* after the word " and " in the 1st line of the 2d claim ; and

By striking out the 3d claim, and substituting therefor the following :

" 3. The combination, with the driving shaft, the needle-bar, and mechanism for reciprocating the same, of the shuttle-carrier, the shuttle-lever, and a cam carried by the driving-shaft, whereby the proper reciprocating movement is imparted to the shuttle-carrier, and the needle-bar is caused to operate in unison therewith, substantially as described."

Signed at L., in the county of M., and State of N.

A. B.,

By S. Z.,

His Attorney in Fact.

DISCLAIMERS.

27. DISCLAIMER AFTER PATENT.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States, residing at L., in the county of M., and State of N. [*or, subject, &c.*], represents that in the matter of a certain improvement in printing-presses, for which letters patent of the United States No. 76,000 were granted to C. D., on the 12th day of June, 1879, here is [here state the exact interest of the disclaimant; if assignee, set out liber and page where assignment is recorded], and that he has reason to believe that, through inadvertence [accident or mistake], the specification and claims of said letters patent are too broad, including that of which said patentee was not the first inventor. Your petitioner therefore, hereby enters his disclaimer to that part of the claim in said specification which is in the following words, to wit :

" I also claim the sleeves A B, having each a friction-cam, C, and connected,

* In the preparation of all amendments a separate paragraph should be devoted to each distinct erasure or inser-

tion, in order to aid the office in making the entry of the amendment into the case to which it pertains.

respectively, by means of chains or chords K L and M N, with an oscillatory lever, to operate substantially as herein shown and described."

A. B.

Witness:
C. D.

28. DISCLAIMER DURING INTERFERENCE.

Interference.

A. B. }
v. } Before the examiner of interferences.
C. D. }

Subject-matter: Sewing machines.

To the Commissioner of Patents:

SIR: In the matter of the interference above noted, under the provisions of and for the purpose set forth in Rule 104, I disclaim [set forth the matter as given in declaration of interference], as I am not the first inventor thereof, and I herewith transmit an amendment to my application (Serial Number 1556), for the purpose of having the above disclaimer embodied as part of my specification.

Signed at L., in the county of N, and State of N., this 15th day of June, 1879.

A. B.

Witnesses:
E. F.
G. H.

APPEALS.

29. FROM A PRINCIPAL EXAMINER TO THE EXAMINERS-IN-CHIEF.

To the Commissioner of Patents:

SIR: I hereby appeal to the examiners-in-chief from the decision of the principal examiner in the matter of my application for letters patent for an improvement in wagon-brakes, filed January 10, 1869, which on the 20th day of July, 1869, was rejected the second time. The following are the points of the decision on which the appeal is taken: [*Here follows a statement of the points on which the appeal is taken, as provided in Rule 128.*]

[*Place and date of signing.*]

A. B.

30. FROM A PRINCIPAL EXAMINER TO THE COMMISSIONER.

To the Commissioner of Patents:

SIR: I hereby appeal to you in person from the decision of the principal examiner, made April 7, 1879, in the case of my application for letters patent for an improvement in harvesters, filed January 10, 1879, wherein he refused to consider the case upon its merits until certain alleged inaccuracies of expression in the specification should be corrected. The following are the points of the decision on which the appeal is taken: [*Here follow points on which appeal is taken.*]

[*Place and date of signing.*]

A. B.

31. FROM THE EXAMINERS-IN-CHIEF TO THE COMMISSIONER.

To the Commissioner of Patents:

SIR: I hereby appeal to you in person from the decisions of the examiner-in-chief made April 7, 1879, in the interference between my application for letters patent for

improvement in sewing-machines and the letters patent of A. B., in which priority of invention was awarded to said A. B. The following are assigned for reasons of appeal: [*Here should follow an explicit statement of the alleged errors in the decision of the examiners-in-chief.*]

C. D.

32. FROM THE EXAMINER IN CHARGE OF INTERFERENCES TO THE EXAMINERS-IN-CHIEF.

To the Commissioner of Patents:

SIR: I hereby appeal to the examiners-in-chief from the decision of the examiner of inferences in the matter of the interference between my application for letters patent for improvement in sewing machines and the letters patent of A. B., in which priority of invention was awarded to said A. B. The following are assigned for reasons of appeal: [*Here should follow an explicit statement of the alleged errors in the decision of the examiner of interferences.*]

C. D.

33. FROM THE EXAMINERS-IN-CHIEF TO THE COMMISSIONER.

To the Commissioner of Patents:

SIR: We hereby appeal to the commissioner in person from the decision of the examiners-in-chief in the matter of our application for the reissue of letters patent for an improvement in cotton-presses, granted to A. B., May 18, 1865. The following are assigned for reasons of appeal: [*Here follow the reasons as in Form 31.*]

C. D.

E. F.

34. FROM THE COMMISSIONER TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

WASHINGTON, D. C., July 20, 1871.

To the Supreme Court of the District of Columbia, in banc:

The petition of A. B., of L., in the county of M., and State of N., respectfully sheweth: That he has heretofore invented a new and useful improvement in velocipedes; that on or about the 1st day of May, 1870, he applied to the patent-office of the United States for a patent for the same [*or, for the reissue of a patent granted therefor under date of June 10, 1862*], and complied with the requirements of the several acts of congress, and with the rules of the patent-office prescribed in such cases; that his said application was rejected by the commissioner of patents, on appeal to him, on or about June 20, 1871; that he has filed in said office due notice to the commissioner of patents of this his appeal, accompanied with the reasons of appeal; and that the commissioner has furnished him with complete copies of all the original papers and evidence in the case, all of which, together with a copy of the reasons of appeal, accompany this petition, and are to be taken as a part hereof.

And the said A. B. prays that his said appeal may be heard and determined by your honorable court at such early time as may be appointed for that purpose; and that the commissioner of patents may be duly notified of the same, and directed in what manner to give notice thereof to the parties interested.

A. B.

To the Commissioner of Patents:

A. B., of L., in the county of M., and State of N., hereby gives notice that he has appealed from your decision, rendered on or about the 20th day of June, 1871, rejecting his application for a patent [*or, for a reissue of a patent granted to him June 10,*

1862], for an improvement in velocipedes ; and of this you are respectfully requested to take notice.

And the said A. B. assigns the following reason for appealing from the said decision of the commissioner of patents, viz:

[Here follow reasons, which should be full and explicit, and constitute a brief of the appellant's argument.]

A. B.

35. PRELIMINARY STATEMENT.

A. B. } Interference in the U. S. patent-office.
 vs. } Preliminary statement of A. B.
 C. D. }

A. B., of L., in the county of M., and State of N., being duly sworn, doth depose and say that he is a party to the interference declared by the commissioner of patents June 3, 1879, between A. B.'s application for letters patent, filed May 6, 1879, and the patent of C. D., granted April 20, 1879, for a twine-machine; that he conceived the invention set forth in the declaration of interference, on or about the 1st of June, 1877; that during the said month he made drawings of the invention and explained it to others; that he made a model showing the invention on or about July 20, 1877; that he embodied it in a full-sized machine, which was completed on or about August 15, 1877; that on the 21st day of the last-named month he successfully operated the said machine at his shop in the town of L., county of M., and State of N., and that he has since continued to use the same machine, and has also manufactured others for use and sale.

A. B.

Subscribed and sworn to before me this 10th day of April, 1879.

E. F.,

[Official title.]

36. RULES OF THE SUPREME COURT IN APPEALS FROM THE COMMISSIONER OF PATENTS, ADOPTED NOVEMBER 30, 1870.

1. The appellant's petition shall be addressed to the court, and shall be substantially as follows :

" To the Supreme Court of the District of Columbia, in banc, ———— 187—.

" The petition of _____, a citizen of _____, in the [State, Territory district] of _____, respectfully shows as follows :

" (1.) About the _____ day of _____, 18____, I invented [describe the subject of the desired patent in the identical words of the application to the patent-office.]

" (2.) On the _____ day of _____, 18—, in the manner prescribed by law, I presented my application to the patent-office, praying that a patent be issued to me for said invention.

" (3.) Such proceedings were had in said office, upon said application, that on the _____ day of _____, 18____, it was rejected by the commissioner of patents.

" (4.) I thereupon appealed to this court, and gave notice thereof to the commissioner, and filed in his office the following reasons for said appeal :

" (5.) The commissioner of patents has furnished me a complete copy of all the proceedings in his office upon my said application, which copy has been filed herewith, and is to be taken as part hereof.

“(6.) And thereupon I pray that the court do revise and reverse said decision, to the end that justice may be done in the premises.

“_____.”

2. This petition shall be filed in the clerk's office of this court ; and as soon as the petitioner has made the deposit required by law at the commencement of suits in this court, or said deposit has been dispensed with, the clerk shall enter the case in a docket to be provided by him for the purpose, and in which a brief of said filing and of all subsequent proceedings in the case shall be entered as and when they successively occur, down to and including the final decision.

3. The clerk shall provide a minute-book of his office, in which he shall record every order, rule, judgment, or decree of the court in each case, in the order of time in which said proceedings occur ; and of this book there shall be two alphabetical indexes, one showing the name of the party applying for the patent, and the other designating the invention by its subject-matter or name.

4. The cases in the docket of causes shall be successively numbered from No. 1 onward, and each case shall also be designated by the number assigned to it on the records of the patent-office.

5. This docket shall be called for the trial of the cases thereon on the first day of each session of this court in general term, provided the petition has been filed ten days before the commencement of the term.

6. The opinions of the court, when written, shall be kept by the clerk, in the order of their delivery and in a temporary book-file, indexed ; and when so many have been delivered as will make a volume of convenient size, he shall cause them to be bound.

7. The clerk shall furnish to any applicant a copy of any paper in any of said appeals on payment of the lawful fees.

8. Hearings of said appeals shall be subject to the rules of the court provided for other causes therein.

9. When the testimony of the commissioner, or of any examiner, touching the principles of invention in question, shall be deemed necessary, it shall be taken orally in open court, unless otherwise ordered by the court. And, in such case, the court may order it to be reduced to writing, and filed or entered on its minutes, if it think proper.

10. The final judgment or order of the court shall not recite any of the facts made to appear in the case, but shall be to the following effect :

“ This appeal having been heard upon the record from the patent office [*and* and upon the testimony of the commissioner of patents [*or*, of one of the examiners] [touching the principles of the invention], and having been argued by [counsel for] the petitioner and [for] the commissioner :

“ It is thereupon ordered and adjudged that the [petition be dismissed] [*or*, commissioner do issue to the petitioner a patent] [as prayed], [granting the petitioner (*so and so*)]. -

“ And that the clerk of this court transmit to the commissioner of patents a copy of this decree duly authenticated.”

ASSIGNMENTS.

37. OF AN ENTIRE INTEREST IN AN INVENTION BEFORE THE ISSUE OF LETTERS PATENT.

Whereas I, A. B., of L., county of M., State of N., have invented a certain new and useful improvement in harvesters [giving title of the same], for which I am about to make application for letters patent of the United States; and whereas G. D., of R., county of S., State of N., is desirous of acquiring an interest in said invention, and in the letters patent to be obtained therefor:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five thousand dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said A. B., have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said G. D., the full and exclusive right to the said invention, as fully set forth and described in the specification prepared and executed by me on the — day of —, 188—, preparatory to obtaining letters patent of the United States therefor; and I do hereby authorize and request the Commissioner of Patents to issue the said letters patent to the said G. D., as the assignee of my entire right, title, and interest in and to the same, for the sole use and behoof of the said G. D. and his legal representatives.

In testimony whereof I have hereunto set my hand and affixed my seal this 4th day of May, A. D. 1879.

A. B. [SEAL.]

In presence of—

O. P.

S. T.

38. OF THE ENTIRE INTEREST IN LETTERS PATENT.

Whereas I, A. B., of L., county of M., State of N., did obtain letters patent of the United States for an improvement in car-wheels, which letters patent are numbered 95,000, and bear date the 5th day of June, in the year one thousand eight hundred and sixty-nine, and whereas I am now the sole owner of said patent and of all rights under the same; and whereas E. F., of R., county of S., State of N., is desirous of acquiring the entire interest in the same:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five thousand dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said C. D., have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said E. F., the whole right, title, and interest in and to the said improvement in car-wheels, and in and to the letters patent therefor aforesaid; the same to be held and enjoyed by the said E. F., for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted [thus including extension], as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof I have hereunto set my hand and affixed my seal at L., in the county of M., and State of N., this 25th day of July, A. D. 1878.

A. B. [SEAL.]

In presence of—

N. P.

O. T.

39. OF AN UNDIVIDED INTEREST IN LETTERS PATENT.

Whereas I, A. B., of L., county of M., State of N., did obtain letters patent of the United States for an improvement in hay-rakes, which letters patent are numbered 89,920, and bear date the 3rd day of August, in the year one thousand eight hundred and sixty; and whereas C. D., of R., county of S., State of N., is desirous of acquiring an interest in the same:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five hundred dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said A. B., have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said D. E., the undivided one-half part of the whole right, title, and interest in and to the said invention, and in and to the letters patent therefor aforesaid; the said undivided one-half part to be held and enjoyed by the said C. D., for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted [thus including extension], as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof I have hereunto set my hand and affixed my seal at L., in the county of M., and State of N., this 7th day of June, A. D. 1862.

A. B. [SEAL.]

In the presence of—

N. P.

O. T.

40. TERRITORIAL INTEREST AFTER GRANT OF PATENT.

Whereas I, A. B., of L., county of M., State of N., did obtain letters patent of the United States for improvement in grain-binders, which letters patent are numbered 87,564 and bear date the 8th day of June, in the year one thousand eight hundred and sixty; and whereas I am now the sole owner of the said patent and of all rights under the same in the below-recited territory; and whereas C. D., of R., county of S., State of N., is desirous of acquiring an interest in the same:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five thousand dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said A. B., have sold, assigned and transferred, and by these presents do sell, assign, and transfer, unto the said C. D., all the right, title, and interest in and to the said invention, as secured to me by said letters patent, for, to, and in the State of N., and for, to, or in no other place or places; the same to be held and enjoyed by the said C. D. within and throughout the above-specified territory, but not elsewhere, for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted (thus including extension), as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof I have hereunto set my hand and affixed my seal at L., in the county of M., and State of N., this 3rd day of May, A. D. 1861.

A. B. [SEAL.]

In the presence of—

S. T.

R. D.

41. LICENSE—SHOP-RIGHT.

In consideration of the sum of fifty dollars, to be paid by the firm of S. J. & Co., of L., in the county of M., State of N., I do hereby license and empower the said S. J. & Co. to manufacture in said L. [or other place agreed upon] the improvement in cotton-seed planters, for which letters patent of the United States No. 71,846 were granted to me, November 13, 1868, and to sell the machines so manufactured throughout the United States, to the full end of the term for which said letters-patent are granted.

Signed at L., in the county of M., and State of N., this 22d day of April, 1869.

A. B.

42. LICENSE—NOT EXCLUSIVE—WITH ROYALTY.

This agreement, made this 12th day of September, 1868, between A. B., of L., in the county of M., and State of N., party of the first part, and C. D. & Co., of O., in the county of R., and State of S., party of the second part, witnesseth, that whereas letters patent of the United States No. 67,540, for an improvement in horse-rakes were granted to the party of the first part, dated October 4, 1867; and whereas the party of the second part is desirous of manufacturing horse-rakes, containing said patented improvement: Now, therefore the have agreed as follows:

I. The party of the first part hereby licenses and empowers the party of the second part to manufacture, subject to the conditions hereinafter named, at their factory in O., and in no other place or places, to the end of the term for which said letters patent were granted, horse-rakes containing the the patented improvements, and to sell the same within the United States.

II. The party of the second part agrees to make full and true returns to the party of the first part, under oath, upon the first days of July and January in each year, of all horse-rakes containing the patented improvements manufactured by them.

III. The party of the second part agrees to pay to the party of the first part five dollars as a license-fee upon every horse-rack manufactured by said party of the second part containing the patented improvements; provided, that if the said fee be paid upon the days provided herein for semi-annual returns, or within ten days thereafter, a discount of fifty per cent. shall be made from said fee for prompt payment.

IV. Upon a failure of the party of the second part to make returns or to make payment of license-fees, as herein provided, for thirty days after the days herein named, the party of the first part may terminate this license by serving a written notice upon the party of the second part; but the party of the second part shall not thereby be discharged from any liability to the party of the first part for any license-fees due at the time of the service of said notice.

In witness whereof the parties above named have hereunto set their hands the day and year first above written, at L., in the county of M., and State of N.

A. B.

C. D. & CO.

EXTENSIONS.

Forms numbered 43 to 48 inclusive are omitted because they relate to proceedings to obtain extensions, only.

DEPOSITIONS.

49. NOTICE OF TAKING TESTIMONY.

BOSTON, MASS., *March 29, 1869.*

In the matter of the interference between the application of A. B. for a paper-collar machine, and the patent No. 25,038, granted December 15, 1868, to C. D., now pending before the commissioner of patents.

Sir: You are hereby notified that on Wednesday, March 31, 1869, at the office of E. F., esq., No. 30 Court street, Boston, Mass., at nine o'clock in the forenoon, I shall proceed to take the testimony of G. H., J. K., and L. M., all of B., as witnesses in my behalf.

The examination will continue from day to day until completed. You are invited to attend and cross-examine.

A. B.,
By R. S., *his Attorney.*

[Place and date of signing.]

Proof of service.

STATE OF M., *County of N., ss:*

Personally appeared before me, a justice of the peace [or other officer], the above-named A. B., who, being duly sworn, deposes and says that he served the above notice upon O. P., the attorney of the said C. D., at one o'clock p. m. of the 30th day of March, 1869, by leaving a copy at his office in R., in the county of S., and State of N., in charge of his partner, R. S.

A. B.

Sworn to and subscribed before me at L., in the county of M. and State of N., this 31st day of March, 1869.

E. F.,
[*Official title.*]

[*Service may be acknowledged by the party upon whom it is made, as follows:*

Service of the above notice acknowledged this 30th day of March, 1869.

C. D.,
By E. F., *his Attorney.*]

50. FORM OF DEPOSITION.

Before the commissioner of patents, in the matter of the interference between the application of A. B. for a paper-collar machine and letters patent No. 25,038, granted December 15, 1868, to C. D.

Depositions of witnesses examined on behalf of A. B., pursuant to the annexed notice, at the office of E. F., No. 30 Court street, Boston, Mass., on Wednesday, March 31, 1869. Present, S. T., esq., on behalf of A. B., and V. W., esq., on behalf of C. D.

G. H., being duly sworn [*or, affirmed*], doth depose and say, in answer to interrogatories proposed to him by S. T., esq., counsel for A. B., as follows, to wit:

Question 1. What is your name, age, residence, and occupation?

Answer 1. My name is G. H.; I am forty-three years of age; I am a manufacturer of paper collars, and reside at C., in the State of M.

Question 2, &c.

And in answer to cross-interrogatories proposed to him by V. W., esq., counsel for C. D., he saith:

Cross-question 1. How long have you known A. B.?

Answer 1.

G. H.

51. CERTIFICATE OF OFFICER.

(To follow deposition.)

STATE OF M., County of N., ss :

I, A. B., a notary public within and for the county of M., and State of N. [or other officer, as the case may be], do hereby certify that the foregoing deposition of C. D. was [or, depositions of C. D., E. F., &c., were] taken on behalf of G. H., in pursuance of the notice hereto annexed, before me at—, in the city [or, town, &c.] of K., in said county, on the—day [or days] of August, 1879; that said witness [or, each of said witnesses] was by me duly sworn before the commencement of his testimony; that the testimony of said witness [or, of each of said witnesses] was written out by myself [or, by O. P. in my presence]; that the opposing party, X. Y., was present [or, absent] during the taking said testimony; that said testimony was taken at—, and was commenced at 9 o'clock a. m. on the 21st of August, 1879, was continued pursuant to adjournment on the 22d, 23d [&c.], and was concluded on the 28th of said month; that I am not connected by blood or marriage with either of said parties, nor interested directly or indirectly in the matter in controversy.

In testimony whereof I have hereunto set my hand and affixed my seal of office, at —, in said county, this 1st day of September, 1879.

S. T.,

[Official title.]

The magistrate will then append to the deposition the notice under which it was taken, and will seal up the testimony, and direct it to the commissioner of patents, placing upon the envelope a certificate, in substance as follows:

I hereby certify that the within deposition of G. H. [if the package contains more than one deposition give all the names], relating to the matter of interference between A. B. and C. D., was taken, sealed up, and addressed to the commissioner of patents by me this 26th day of April, A. D. 1869.

E. F.,

[Official title.]

URUGUAY.

*Law of Industrial Patents, November 13, 1885.**

CHAPTER I.

GENERAL PROVISIONS.

ARTICLE 1. Authorizes the Executive Power to issue patents with exclusive rights for inventions, or improvements upon inventions.

ART. 2. It has the same power with respect to the persons who, having taken out a patent in a foreign country, solicit a privilege to carry on the industry in the country, provided the application be made within the first year of the original patent and the applicant be either the inventor himself, his attorney, or lessee of the patent.

ART. 3. New discoveries or inventions of any description entitle the authors thereof to the exclusive right of working the same for the period and under the conditions expressed in this Law.

ART. 4. The following are considered discoveries or new inventions: New products of industry, new methods or means and new application of known methods or means for the attainment of a result or industrial product.

ART. 5. Patent rights will not be granted for financial schemes discoveries or inventions well known in the country or abroad, in written works, or printed periodicals, which are purely theoretic and which do not show practically their proper application, chemical compositions, and such as be contrary to the laws of morality and the republic.

ART. 6. The Government does not guarantee either the merit or the priority of discoveries or inventions.

ART. 7. Patents will be granted for 3, 6 or 9 years according to the request of the applicant.

ART. 8. Upon each patent an annuity of \$25 shall be paid whilst the privilege lasts.

ART. 9. The payment of the annuities referred to shall be effected in the Credito Publico office within the first ten days of

* There is a later decree which regulates only the granting of patents, the conduct of the patent-office, &c.

each year, under penalty of loss or cancelment of the privilege, and the letters patent will not be issued until the first of these annuities be paid by the applicant or applicants for the patents.

ART. 10. The term of ten days mentioned in the preceding article having expired without the payment being effected, the Executive Power will entertain, and in such case give preference to applications for privileges of the same nature which may be presented by other interested parties.

ART. 11. In all cases where a privilege is granted the Executive Power, previously informed by the council of public health upon privileges for unhealthy industries, shall designate a reasonable term within which to commence working the industry to which the patent refers.

ART. 12. Upon the commencement of working the industry within the term stipulated by the Executive Power, the patentee in a petition to the patent-office shall give notice of the said working stating the place where the work is carried on, which petition shall be annexed to the despatch and forwarded to the head office of public works and the board of health for their report as to the full observance of the terms of the privilege.

ART. 13. In the case of *force majeure* or difficulties occurring which can possibly justify delay in the establishment of the industry within the term designated by the Executive Power under article 11, the patentee shall be able to petition the Legislative Power for a prolongation of the term to commence working.

This petition for prolongation should be made at least three months before the termination of such term.

CHAPTER II.

PATENT-OFFICE.

ART. 14. The letters patent referred to in the preceding articles shall be inscribed upon the stamped paper designated by the law and by the department of trade and commercial marks, which from the promulgation of this law shall be styled "Office of Patents of Inventions, Trade and Commercial Marks."

The letters patent shall be sealed and signed by the *ministro de gobierno*, whose signature shall be countersigned by the chief of the aboved-named office.

ART. 15. The staff of the office shall be composed of a chief and a secretary with the salaries allowed by the budget.

ART. 16. No employe of this office may have, directly or indirectly, any interest in the privileges he may have to deal with, under penalty of immediate dismissal after the fact be proved.

ART. 17. The chief of the office is responsible to the government for all papers and objects deposited which he shall preserve with the greatest care and order.

ART. 18. This office will be under the direction of the *ministro de gobierno*.

CHAPTER III.

FORMALITIES FOR THE CONCESSION OF PATENTS.

ART. 19. Any person wishing to obtain a patent shall present a petition on paper, bearing a stamp of one dollar on each sheet, addressed to the *ministro de go'erno*, and hand it to the chief of the "patent and marks of factories and commerce office" who will despatch it immediately upon its receipt so that it may be duly dealt with.

On the said petition the last named office must note the day and hour at which it was presented.

ART. 20. A specification in duplicate must be attached to the petition giving a clear and sufficient description of the invention, together with samples, drawings, or models, according to the nature of the case, and also an oath declaring the invention to be the property of the applicant and asking for a patent securing his rights.

The samples, models, etc., presented with and accompanying the petition, must be substantial and well made.

ART. 21. The petition shall simply ask for the privilege (patent) stating the term for which it is desired, and must not contain restrictions, conditions, or reserves; it must indicate the title under which the inventor may designate it and describe the invention precisely, and must be written in Spanish with all corrections or erasures which may appear in the text being duly testified. The drawings accompanying it must be made in ink and according to the metric scale established in the republic.

ART. 22. The patent will be granted in the name of the nation and will be guaranteed by the decree granting it, which will be accompanied by the specifications and drawings.

ART. 23. The grant of the patent will not affect the dispositions of article 35.

ART. 24. Every three months the chief of the patent-office will send to the Government a concise and detailed report upon patents issued, for publication.

ART. 25. He will also send an annual report to the general directory of statistics of the patents granted, the term of their duration and the amount paid by the patentees.

ART. 26. Every two years the patent-office shall publish, in one volume, all the despatches of patents granted with descriptions of same and their respective drawings and models.

CHAPTER IV.

CERTIFICATES OF ADDITION OF IMPROVEMENTS UPON INVENTIONS.

ART. 27. Any one who may improve upon a patented discovery or invention shall have the right to solicit an extra certificate which will in no case be granted for a longer period than the remainder of the term of the original patent.

The extra certificate shall be issued on the stamped paper designated by the law, and be signed and sealed by the *ministro de gobierno* and indorsed by the chief of the patent-office. The stamp on this certificate is \$100.

ART. 28. To obtain an extra certificate the same formalities shall be observed as for a patent, excepting the tax, of which only a third part of that corresponding to the patent shall be paid when the applicant be the original patentee and two thirds when he be a third party.

ART. 29. When the extra certificate is obtained by a third party, he shall not enjoy the entire exploration of the invention without paying a share to the original inventor, the amount of which shall be determined by two experts appointed by the interested parties, and a third in case of disagreement, taking into consideration the importance of the improvement and that part still held by the original invention.

ART. 30. The original inventor shall be able to retain the right to the share (or royalty) decided upon in the previous article, or the adoption of the improvement in competition with the inventor of such improvement.

If he decide upon the latter course, an equal extra certificate with the same rights and privileges will be granted to him with the inventor of the improvement.

ART. 31. The inventor of the improvement can in no case acquire the right to carry out the original invention.

Neither can the original inventor make use of the improvement except in the second case provided for in the preceding article.

ART. 32. If two or more persons solicit a patent at the same time for the same industry, or extra certificate for the same improvement, none of the documents will be despatched unless the applicants make an agreement together beforehand.

CHAPTER V.

TRANSFER OF PATENTS.

ART. 33. Any one having obtained a patent, or an extra certificate, shall be able to transfer his rights under the conditions he may think proper, but the transference must be made public and the patent-office be advised previously, without which observance the transference to a third party will be of no value.

ART. 34. Comprised with the patent shall be included all rights conceded to the patentee, and they shall be transferred with it excepting when the deed of transfer contains a special clause to the contrary.

CHAPTER VI.

NULLITY AND LAPSE OF PATENTS.

ART. 35. Patents or certificates acquired in defiance of the prescriptions in article 5 shall be null. Those shall also be null that are obtained by false witness or information, when the drawings or specifications be imperfect and incomplete, and when, being a foreign invention, its origin has been represented as of the country (Uruguay), in which case the defaulter shall be fined \$500, or be sentenced to 6 months imprisonment.

ART. 36. Valid patents shall lapse when the working of the patented industry be not commenced within the term fixed and under the conditions expressed in the letters patent ; when the time for which it was granted is lapsed ; if working be stopped for the space of a year, excepting cases of accident or *force majeure*, which events must be proved by the interested party with sufficient proofs within the term of one month, when, if such be not produced, the chief of the patent-office shall publish in the newspapers the forfeiture of the patent.

ART. 37. If the conditions prescribed by article 12 be not ful-

filled by the patentee, the office of that branch of the service shall call upon him to appear, by means of advertisements during one month, at the end of which time if he does not present himself, the patent granted shall be declared lapsed, and the fact made public as prescribed in the latter part of the preceding article.

ART. 38. A suit for annulment can only be brought by the interested party before the civil court.

ART. 39. For the patented discovery or invention to become public property, a judicial declaration is not indispensable; it is sufficient that it has become null or forfeited, that all be at liberty to explore the patented industry.

ART. 40. In the event of the proprietor of a patent, which has been forfeited or become void, disputing the free exploration of the invention or industry to which it refers by law, suit or other means, any person can request the civil judge for a declaration proving its forfeiture or invalidity.

ART. 41. The judgment shall be summary, allowing the proofs of right, the patentee not being able to show proofs against the documents issued by the patent-office, in support of his privilege. The term for proof shall not exceed twenty days, and ten days after the term for proof the judge shall pass judgment with costs against the loser of the suit.

From this judgment there shall be an appeal to the Supreme Tribunal of Appeals, which may be sitting, which with previous report from the patent-office, shall definitely decide the question without further proceedings.

ART. 42. A patent, once declared null or forfeited, the judge who passed the sentence shall announce the fact to the chief of the patent-office, who will immediately make it public.

CHAPTER VII.

INFRINGEMENTS, THEIR SUPPRESSION AND FINES.

ART. 43. The infringement of the patent right shall be deemed crime of counterfeiture, and punished with a fine of from \$100 to \$500, or by imprisonment for from one to six months, the loss of the objects counterfeited and indemnification of damages and losses.

ART. 44. Those who, knowing of the counterfeiture, aid it by any means, shall suffer the same penalties as those laid down in the preceding article.

ART. 45. The penalties imposed previously shall be doubled for him who renews counterfeiture within five years after being first condemned.

ART. 46. Having been a workman or employe of the patentee, or having obtained knowledge of the invention by stealth or bribery, shall be considered aggravating circumstances.

ART. 47. The suit for the application of penalties above-mentioned is private, and shall be heard before the criminal judge in office, and be accompanied by the letters patent, without which judgment will not be passed.

ART. 48. The only opposition to the suit are the proofs of nullity, forfeiture, participation in the patent, or the exclusive possession thereof.

ART. 49. The plaintiff can exact caution money from the defendant so as not to interrupt him in the working of the patent if the latter wishes to continue working.

In default of the caution money, the plaintiff can ask for suspension of the working of the patent and embargo the effects constituting it, and, if required, sufficient caution money.

ART. 50. He shall be considered an infringer and be subject to the penalties established for such, who, not being the patentee, and not enjoying the privileges of same, may raise a suit as if he were being deprived of same.

CHAPTER VIII.

FINAL DISPOSITIONS.

ART. 51. The copies of the despatches of the patent, models, etc., shall be asked for in writing from the patent-office by their owners, or those who represent them, in person or by right, during the term of the privilege, after which any person may apply for them who may require them.

ART. 52. The *ministro de gobierno* will give order that they be delivered on 2nd-class stamped paper, at the cost of the applicant, who must pay in addition, as copy duty, two dollars per folio, and cost of plans, drawings, models, etc., as public works tax at the request of the *ministro de gobierno*.

ART. 53. The amount of the duties and fines imposed by this law shall be applied to general expenses of the nation.

ART. 54. The chief of the patent-office shall present the indis-

pensable and necessary books, all duly signed on each page, to the chief official of the *ministry de gobierno*.

These books shall show respectively : 1. The patents granted, their class, the date and term of the patent, and all other observations which may be judged useful for this branch of the service. 2. The date of entry, name of the applicant, and nature of the privilege asked for in each case.

These notes must be signed in the book by the applicants for the patent.

ART. 55. The law of June 20, 1853, and all other dispositions opposed to the present law, are repealed.

ART. 56. The Executive Power will administer the present law.

Furnished for this work from the collection of Patent Laws, of Mr. W. E. Richards.

VENEZUELA.

Act of May 25, 1882.

The Congress of the United States of Venezuela ordains :

ARTICLE 1. Any one who has invented or discovered any new and useful manufacture, a machine, a process, or a combination of materials, or also any new and useful improvement on the same, can obtain a patent therefor upon payment of the sum fixed by this law, and subject to the other provisions of the said law : Provided : That the invention, discovery, or improvement be not already known to or used by others dwelling in this country, that it has not been either patented or described in a public print published either in the republic or abroad, or that it has neither been in public use nor offered for sale for more than two years preceding the application, or that the discontinuance of same has not been proved.

ART. 2. The patent documents are to be issued by the Executive in the name of the United States of Venezuela, and only countersigned by the minister.

ART. 3. The government guarantees neither the correctness nor the utility nor the priority of the patented invention or discovery.

ART. 4. Any person desirous of obtaining a patent must accompany the application with a description of the invention or discovery, machine, manufactures, composition, or improvement, wherein the nature and object of same are clearly set forth, together with the corresponding drawings or samples.

ART. 5. The applicant must in his application make a declaration under oath that he is the true inventor or discoverer of the art, machine, process, composition, or improvement for which he desires to obtain a patent, and any opposition calling the correctness of this declaration in question must be decided in ordinary course of law by the interested parties before the state courts.

ART. 6. Patents are granted for five, ten, or fifteen years, and become void six months, one year, and two years, respectively, after the grant, unless the invention or discovery to which they relate has been carried into operation within the specified time. The patent will state the duration and time of expiration. Its duration dates from the day of grant.

ART. 7. Applications for patents are to be addressed to the State Executive through the minister of commerce.

ART. 8. If the conditions stipulated by this law have been fulfilled, a patent will be granted to the applicant, which empowers him to make use of his invention, discovery, or improvement in the whole territory of the United States of Venezuela and its territories. The patent will be granted by the State Executive through the minister of commerce in the form prescribed below. It must contain a title or a short description exactly setting forth the nature and object of the invention or discovery, as also the exclusive permission to the patentee, his heirs and assigns to produce, use, or sell the invention or discovery.

“The President of the Republic with the assent of the Federal Council :

Whereas——has appeared before the Federal Executive and has applied for a patent for the purpose of, [here give the nature of the application,] and having complied with the conditions prescribed in the law of May 25, 1882, in accordance with article 8 of the above-cited law, and in the name of the United States of Venezuela, I grant unto him the present patent for the period of——years for the sole use of the above-mentioned industry for his own profit, or the profit of his heirs or assigns, but in such manner that the Executive does not guarantee either the utility, the correctness, or the priority of the patented discovery or invention.

“After——from the present date this patent shall cease and determine, unless the invention has been put into operation in the interim.

“Signed, sealed, and countersigned, in the palace of the federation at Caracas, the——, &c.”

ART. 9. Patents are subject to the payment of a tax of 80 francs (Bolivars) annually in the case of an invention or discovery, and of 60 francs (or Bolivars) annually when the subject is an improvement of a known process.

ART. 10. The tax prescribed in the previous article is payable into the national treasury of the public service. Every applicant for a patent who applies to the Executive according to article 7 must accompany the application with a certificate that he has paid the half of the duty corresponding to the period of protection required. If, conformably to the provisions of this law, the patent cannot be granted, the applicant shall lose the sum deposited, which shall be applied for popular education. If the patent be granted,

the amount paid shall be deducted from that which the applicant has to pay for the period of the patent. The Executive shall have power to relieve such patentees of industrial discoveries or products of the taxes due under article 9 of this law as are in their opinion worthy of this favor.

ART. 11. Every person who has obtained a patent may publish the fact in advertisements and in his trade-mark without this publication constituting a guarantee of the government for the quality of the product, or of the priority of the invention or discovery, or becoming of any undue value whatever to the prejudice of the prior rights of a third party.

ART. 12. Every person who has had a patent granted to him for an invention or discovery in a foreign country can also obtain a patent in this : Provided : That it has not already been granted to any one. In such case the patent shall only be granted for a period equal to the unexpired term of the patent in the foreign country.

ART. 13. On the expiration of a patent the description of the discovery or invention shall be published in the Official Gazette, and from this time forward the use of the discovery or invention, together with the manufacture or sale of the industrial product hitherto protected by the patent, shall be open to any one.

ART. 14. The patent shall also be published if the same, according to article 6 of this law, lapse before the invention or discovery has been carried into operation, conformably to article 6 of this law, or when before its expiration or lapse it is declared null and void, except in the case provided for under article 18.

ART. 15. All specifications, drawings, and samples necessary for obtaining a patent are to be deposited with the minister of public affairs.

ART. 16. After an application for a patent has been accepted by the Executive, the same shall be notified in the Official Gazette ; but the patent (in the event of its being granted) shall not be issued until the expiration of thirty days after this notification has appeared.

ART. 17. Inventions, improvements, or new manufactures prejudicial to health, public order, morals, or prior rights shall not be patentable. Pharmaceutical preparations and medicines in any shape or form cannot be patented, but remain subject to the special legislation and regulations therefor provided.

ART. 18. Besides the cases provided for under article 6, patents are null and void if the Executive Government decide that the

patent granted is detrimental to the rights of a third person, as well as if the actual working of the patented industry has been discontinued for a whole year, excepting unforeseen circumstances or force *majeure*.

ART. 19. Infringements of the rights secured by patent will be adjudicated upon by the federal courts in conformity with the laws.

ART. 20. The patent law made on May 20, 1878, is hereby annulled.

Given in the palace of the Executive Government, at Caracas, May 25, 1882, &c.

From 35 *Pat. Off. Gaz.* 388.

VICTORIA.

An Act to consolidate the Law concerning Letters Patent for Inventions, being Act No. CCXL., of May 9, 1865.

(NOTE*—The words “registrar-general” in italics are alterations made by the Act, No. 432, 17th Dec., 1872.)

Be it enacted by the Queen’s most excellent Majesty, by and with the advice and consent of the Legislative Council and the Legislative Assembly of Victoria, in this present Parliament assembled, and by the authority of the same, as follows:

1. *Title.* This Act shall come into operation on the first day of June, in the year of our Lord one thousand eight hundred and sixty-five, and shall be called and may be cited as “The Patents Statute, 1865.” Its sections are divided into parts as follow:

Part I.—Mode of obtaining Letters Patent, §§ 4–19.

Part II.—Disclaimers and Alterations, §§ 20–23.

Part III.—Extension of Term and Confirmation of Invalid Patents, §§ 24–28.

Part IV.—Miscellaneous Provisions, §§ 29–39.

2. *Repeal of Acts.* The Acts mentioned in the first schedule hereto, to the extent to which the same are in and by the said schedule expressed to be repealed, shall be and the same are hereby repealed. Nothing herein contained shall affect any proceedings or things lawfully taken, done, or commenced, or any letters patent granted, or any protection or right conferred, or any rules and regulations, or any register or appointment made, or any notice or particulars given or published, or any warrant issued or caveat entered under the said repealed Acts, or either of them, before the coming into operation of this Act; and all such proceedings and things shall be as valid and may be continued, and all such letters patent, protections, rights, rules, and regulations, registers, appointments, notices, particulars, warrants, and caveats shall have the same force and efficacy as if this Act had not been passed. Letters patent may be granted in respect of applications made before the coming into operation of this Act in like manner as if this Act had

* Notes printed in this form are from Carpmael’s edition.

not been passed ; and where letters patent have been granted before the commencement of this Act, or shall in respect of any application made before the commencement of this Act be hereafter granted for any invention, such letters patent may be confirmed, or the term thereof extended or new letters patent granted for such invention in like manner as if the original or first letters patent had been granted under this Act.

3. *Interpretation.* In the interpretation of this Act the word "invention" shall mean and include any manner of new manufacture the subject of letters patent and grant of privilege within the meaning of the enactment next hereinafter contained.

PART I.—MODE OF OBTAINING LETTERS PATENT.

4. *Power to grant patents.* It shall be lawful to make and issue, in the manner hereinafter mentioned, letters patent and grants of privilege for any term not exceeding fourteen years from the date thereof of the sole working or making of any manner of new manufactures within Victoria and its dependencies to the true and first inventor of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law nor mischievous to the State by raising prices of commodities, or hurt of trade, or generally inconvenient. And all other monopolies, commissions, grants, licenses charters, and letters patent hereafter to be made or granted to any person of or for the sole buying, selling, making, working, or using of anything within Victoria or its dependencies, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, and all matters and things whatsoever in anywise tending to the instituting, erecting, or countenancing of the same, or any of them, shall be utterly void and of none effect, and in nowise to be put in execution.

5. *Governor in Council to make rules for executing this Act.* It shall be lawful for the Governor in Council, from time to time to make such rules and regulations (not inconsistent with the provisions hereof), as may appear to be necessary and expedient for the purposes of this Act ; and all such rules and regulations shall be laid before both Houses of Parliament within fourteen days after the making thereof if Parliament be sitting, and if Parliament be not sitting, then within fourteen days after the next meeting of Parliament.

6. *Inventor to deposit specifications ; same may be amended before patent issues.* All applications under this Act for the grant of letters patent for an invention shall be made as follows : (that is to say,) the applicant shall deposit at the office of the *registrar-general* an instrument in writing under his hand and seal, particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, and also a copy of such instrument, and of the drawings accompanying the same (if any) ; and the day of the deposit of every such specification, shall be recorded at the said office and indorsed on such specification, and a certificate thereof given to such applicant or his agent ; and thereupon, subject and without prejudice to the provisions hereinafter contained, the said invention shall be protected under this Act for the term of six months next after the said deposit, and the applicant shall have during such term the like powers, rights, and privileges as might have been conferred upon him by letters patent for such invention issued under this Act, and duly sealed as of the day of such deposit ; and during the continuance of such powers, rights, and privileges under this provision, such invention may be used and published without prejudice to any letters patent to be granted for the same ; and where letters patent are granted in respect of such invention, such letters patent shall be conditioned to become void if such specification does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed : Provided always, that in case the title of the invention or the said specification be too large or insufficient, it shall be lawful for the law officer during the said term of six months, and before the grant of the letters patent, to allow or require such specification to be amended, or another and sufficient specification to be deposited in lieu thereof ; and every such amended or new specification shall have the same force, effect, and operation as if it had been originally deposited in its amended or new state.

7. *Form and size of specification and copy.* Every such specification as aforesaid shall be in the form contained in the second schedule to this Act, or to the like effect, and shall be written upon both sides of one or more skin or skins of parchment, and every page thereof shall be of the exact size of twenty inches in length by fifteen inches in breadth, leaving a margin of at least one inch and a half on each side of every such page in order and to the intent that the same may be bound into books for safe custody ; but the drawings accompanying such specification (if any) may be made

upon larger sheets of parchment, leaving a margin of the size and for the purpose aforesaid; and every copy of any such specification as aforesaid, and of the drawings accompanying the same (if any), shall in like manner be written upon one or more sheet or sheets of paper of the size and with the margins aforesaid.

8. *Patent of true inventor not to be affected by specification of pretended inventor.* In case of the deposit of any such specification as aforesaid in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such deposit, or of any use or publication of the invention subsequent to such deposit and before the expiration of the said term of protection.

9. *Mode of proceeding after deposit of specification.* The applicant, so soon as he shall think fit after the deposit of such specification as aforesaid, and of the drawings and models accompanying the same (if any), may give notice in writing at the chambers of the law officer of his intention to proceed with his application for letters patent for the said invention, stating in such notice the title of the said invention; and the day on which the specification thereof was deposited at the office of the *registrar-general*, and at the time of giving such notice shall produce the said certificate of deposit; and thereupon the said law officer shall deliver to the applicant or his agent an appointment in the form contained in the third schedule to this Act, or to the like effect; and such applicant or agent, not less than twenty-one clear days prior to the day appointed by the law officer, shall cause the said appointment to be published once in the Government Gazette, once in some newspaper published in the city of Melbourne, and twice in some newspaper published in the town or place at or near to which the applicant uses or exercises the said invention, or (in case he does not use or exercise the same) in or near to which he resides, or if there shall be no newspaper published in such town or place then twice in some newspaper circulating in the neighborhood where he uses or exercises the said invention or (in case he does not use or exercise the same) where he resides; and any person having an interest in opposing the grant of letters patent for the said invention shall be at liberty, not less than three clear days prior to the day so appointed, to leave particulars in writing of his objections to the said application at the chambers of the law officer.

10. *Law officer to hear applications and objections and award costs.* At the place and time named in the said appointment the

applicant shall produce the newspapers containing the same ; and the law officer shall thereupon hear and consider the said application and all objections to the same mentioned in the said particulars (if any), and for that purpose shall obtain from the office of the *registrar-general* the said copy of the said specification, and of the drawings and models accompanying the same (if any), and may call to his aid such scientific or other person as he may think fit, and may, by writing under his hand, order to be paid to such persons some remuneration for his attendance ; and may also in like manner order that the costs of any hearing upon any objection, or otherwise in relation to the grant of such letters patent, or the protection acquired by the applicant under this Act, shall be paid, and in and by such writing shall fix the amount of such remuneration or costs, and by or to whom the same respectively shall be paid ; and every such order shall be in the form contained in the fourth schedule to his Act, or to the like effect, and may be made a rule of the Supreme Court : Provided always, that the applicant, the objectors, and respective witnesses and evidence shall be respectively heard, examined, and considered separately and apart from and in the absence of the other and his witnesses and evidence.

11. *Law officer may issue warrant for letters patent.* The law officer, after such hearing and consideration, may issue a warrant under his hand and seal for the granting of letters patent for the said invention, and by such warrant shall direct the insertion in such letters patent of all such restrictions, conditions, and provisos as he may deem usual and expedient in such grants, or necessary in pursuance of this Act : and the said warrant shall be the warrant for the making and sealing of letters patent under this Act according to the tenor of the said warrant ; and every such warrant shall be in the form contained in the fifth schedule to this Act, or to the like effect.

12. *Letters patent may be repealed or withheld, and specification canceled.* The writ of *scire facias* shall lie for the repeal of any letters patent granted under this Act and may be issued into the circuit district in which the grantee resided when the said letters patent were granted ; and in case such grantee does not reside in Victoria, it shall be sufficient to file such writ in the proper office of the Supreme Court, and serve notice thereof in writing at the last known place of residence or business of such grantee ; and nothing herein contained shall extend to abridge or affect the prerogative of the Crown in relation to the granting or withholding

the grant of any letters patent; and it shall be lawful for the Governor in Council to order such law officer to withhold such warrant as aforesaid, or that any letters patent for the granting whereof he may have issued a warrant as aforesaid, shall not issue, or to order the insertion in any such letters patent of any restrictions, conditions or provisos, in addition to or in substitution for any restrictions, conditions, or provisos which would otherwise be inserted therein under this Act; and it shall also be lawful for the Governor in Council to order any specification in respect of the invention described in which no letters patent may have been granted to be canceled, and thereupon the protection obtained by the deposit of such specification shall cease.

13. *Letters patent to be void on non performance of conditions.* All letter patent for inventions granted under this Act shall be in the form contained in the sixth schedule to this Act, or to the like effect, and be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine, at the expiration of three years and seven years respectively from the date thereof, unless there be paid within the said three and seven years respectively the sum or sums of money in that behalf hereby required to be paid; and the *registrar-general* shall issue under his hand a certificate of such payment and shall indorse a receipt for the same on the letters patent.

14. *Letters patent to be issued within three months after warrant, and during the protection.* The *registrar-general*, so soon after the receipt by him of the said warrant as required by the applicant, shall cause to be prepared letters patent for the invention according to the tenor of the said warrant; and it shall be lawful for the Governor in Council to cause such letters patent to be sealed with the seal of the colony; and such letters patent shall be made applicable to the said colony and its dependencies, and shall be valid and effectual as to the whole of the same respectively; but except as hereinafter-mentioned, no letters patent shall issue on any warrant granted as aforesaid unless application be made to seal such letters patent within three months after the date of the said warrant; nor unless such letters patent be granted during the continuance of the protection conferred under this Act by reason of such deposit.

15. *Letters patent may issue after that time in certain cases.* Where the application to seal such letters patent has been made during the continuance of such protection as aforesaid, and the seal-

ing of such letters patent has been delayed from accident and not from the neglect or willful default of the applicant, then such letters patent may be sealed at such time not being more than one month after the expiration of such protection as the Governor in Council shall direct ; and where the applicant for such letters patent dies during the continuance of such protection aforesaid, such letters patent may be granted to the executors or administrators of such applicant during the continuance of such protection or at any time within three months after the death of such applicant, notwithstanding the expiration of the term of such protection ; and the letters patent so granted shall be of the like force and effect as if they had been granted to such applicant during the continuance of such protection ; and in case any letters patent shall be destroyed or lost other letters patents of the like tenor and effect, and sealed and dated as of the same day, may (subject to such regulations as the Governor in Council may direct) be issued under the authority of the warrant in pursuance of which the original letters patent were issued.

16. *Letters patent to bear date of the deposit of specification and to be conclusive as to preliminary steps and proceedings.* Notwithstanding any enactment to the contrary, all letters patent to be issued in pursuance of this Act shall be sealed and bear date as of the day of the deposit of such specification as aforesaid, and shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date ; and after any letters patent shall have been granted or issued under this Act it shall not be necessary or material to inquire or ascertain whether such appointment as aforesaid has or has not been delivered and published in the manner hereinbefore mentioned and directed.

17. *Letters patent for foreign inventions not to continue after expiration of foreign patent.* Where upon any application made under this Act letters patent are granted for or in respect of any invention first invented in parts out of Victoria and its dependencies, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any parts out of Victoria and its dependencies is obtained before the grant of such letters patent in Victoria, all rights and privileges under such letters patent shall (notwithstanding any term in any such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such part out of Victoria and its dependencies shall continue in

force, or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges: Provided always, that no letters patent for or in respect of any invention (for which any such patent or like privilege as aforesaid shall have been obtained abroad) granted in Victoria after the expiration or determination of the term for which such patent or privilege was granted or was in force shall be of any validity.

18. *Letters patent not to prevent the use of inventions in foreign ships resorting to ports in Victoria.* No letters patent for any invention granted after the coming into operation of this Act shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel, which may be in any port of Victoria or its dependencies or in any of the waters within the jurisdiction of any of Her Majesty's courts of Victoria, where such invention is not so used for the manufacture of any goods or commodities to be vended within or exported from the same: Provided always, that this enactment shall not extend to the ships or vessels of any foreign State, the laws of which authorize subjects of such foreign State having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British ships or vessels, or in or about the navigation of British ships or vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign State.

19. *Specification to be filed after issue of patent or expiring of protection.* Every specification deposited at the office of the registrar general as aforesaid, and the drawings and models accompanying the same (if any), shall, forthwith after the grant of the letters patent, or if no letters patent be granted then immediately on the expiration of six months from the time of such deposit, be transferred to and kept in such office as the Governor in Council shall from time to time appoint for that purpose.

PART II.—DISCLAIMERS AND ALTERATIONS.

20. *Notice of application to disclaim or make alterations.* Any person who shall obtain letters patent under this Act, or in case

such person shall part with his whole or any part of his interest by assignment, such person together with the assignee (if part only has been assigned), or the assignee alone (if the whole has been assigned), may apply to the law officer for leave to enter a disclaimer of any part of either the title of the invention or of the specification, or a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent; and thereupon the law officer shall deliver to such patentee and assignee, or either of them, or to their or either of their agents, an appointment in the form contained in the seventh schedule to this Act, or to the like effect; and such patentee or assignee shall thereupon cause such disclaimer (stating the reason for the same), or such memorandum of alteration, to be written at the foot of the said appointment, and shall cause the same respectively to be published in the manner hereinbefore required with respect to the said first mentioned appointment; and any person having an interest in opposing the said application shall be at liberty to leave particulars in writing of his objections to the same at the chambers of the law officer within such time not being less than three clear days prior to the day so appointed: Provided always, that where such application as aforesaid shall be for leave to enter a disclaimer of any part of the title of the said invention, or a memorandum of any alteration in such title, the law officer may dispense with such appointment and publication, and in that case shall certify in the fiat hereinafter mentioned that he has dispensed with the same.

21. *Application for disclaimer to be heard.* At the time and place named in such appointment the said patentee and assignee, or one of them, shall produce the newspapers containing the same and the said disclaimer or memorandum of alteration at the foot thereof; and the law officer shall thereupon hear and consider the said application, and all objections to the same mentioned in the said particulars (if any), and all such power and authority shall and may be exercised upon that occasion by the law officer as by virtue of the provisions hereinbefore contained can and may be exercised in relation to the hearing and considering an application for letters patent and objections to the same, and shall and may be enforced in like manner.

22. *How disclaimer may be entered and alterations made.* After such hearing and consideration, or without such hearing and consideration where the said appointment and publication shall have

been dispensed with as aforesaid, such patentee and assignee, or either of them, may by leave of the law officer (to be certified by a fiat under his hand to be written at the foot of the same parchment with the said disclaimer or memorandum) enter such disclaimer (stating the reason for the same) or such memorandum of alteration, and at the time of entering such disclaimer or memorandum of alteration shall deposit a copy thereof in the office next hereinafter mentioned; and such disclaimer or memorandum of alteration, being filed in such office as the Governor in Council shall from time to time appoint for that purpose, shall be deemed and taken to be part of such letters patent or such specification, and subject to the several incidents thereof, in all courts whatever, and shall be valid and effectual in favor of any person in whom the rights under the said letters patent may then be or thereafter become legally vested; and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer or memorandum of alteration, on the ground that the person entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf: Provided always, that no action shall be brought upon any letters patent in which or on the specification of which any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration (unless the law officer shall certify in his said fiat that any such action may be brought), notwithstanding the entry or filing of such disclaimer or memorandum of alteration; and no such disclaimer or alteration shall be receivable as evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was filed as aforesaid; but in every such last mentioned action or suit the original title and specification alone shall be given in evidence, and be deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: Provided also, that when any such fiat shall have been granted or issued under this Act, it shall not be necessary or material to inquire or ascertain whether such appointment as last aforesaid has or has not been delivered and published or dispensed with in accordance with this Act, and such filing of any disclaimer or memorandum of alteration in pursuance of the leave of the law officer certified as aforesaid shall (except in cases of fraud) be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under this Act.

23. *Copies of specifications, disclaimers, &c., to be open to inspection.* The copies of all specifications and the drawings and models accompanying the same (if any) and of all disclaimers and memoranda of alterations respectively deposited under or in pursuance of this Act shall be open to the inspection of the public at all reasonable times after the grant of letters patent, or if no letters patent be granted then immediately on the expiration of six months from the time of such deposit; but subject to such regulations as the Governor in Council may make in that behalf.

PART III.—EXTENSION OF TERM AND CONFIRMATION OF INVALID PATENTS.

24. *Mode of obtaining extension of the term.* If any person who has obtained letters patent under this Act or any other Act relating to letters patent heretofore in force in Victoria, or (in case such person shall have parted with his whole or any part of his interest by assignment) if such person, together with the assignee where part only has been assigned, or of the assignee alone where the whole has been assigned, shall, six months before the expiration or other determination of such letters patent, present to the Governor in Council a petition for the extension of the term in such letters patent mentioned, and shall set forth in such petition that he or they has or have been unable to obtain a due remuneration for his or their expense and labor in perfecting such invention, and that an exclusive right of using and vending the same for some further period to be named in such petition, in addition to the said term, is necessary for his or their reimbursement and remuneration, it shall be lawful for the Governor in Council to refer the consideration of the said petition to commissioners to be appointed for that purpose in the manner hereinafter mentioned.

25. *Mode of obtaining confirmation of invalid patent.* If in any suit or action it shall be proved or specially found by the verdict of a jury that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, such patentee or his assigns may

petition the Governor to confirm the said letters patent or to grant new letters patent; and it shall be lawful for the Governor in Council to refer the consideration of the said petition to commissioners to be appointed for that purpose in the manner hereinafter mentioned.

26. *Appointment of commissioners.* For the purpose of considering any such petition as aforesaid, it shall be lawful for the Governor in Council (if he shall think fit) to issue and direct in the name of Her Majesty, her heirs or successors, to five or more persons (of whom some of the judges of the Supreme Court shall be two) a commission reciting such petition, and requiring and authorizing such persons, or any three of them, of whom one of the said judges shall be one, to meet at some time (not being less than two months from the publication of the said commission in the Government Gazette) and at some place to be respectively fixed in the said commission, and then and there to consider the said petition, and to report to Her Majesty, her heirs and successors (in case such petitioner shall have prayed for an extension of the term in the letters patent mentioned), whether any and, if any, what further extension of the said term should be granted according to the prayer of the said petition, and upon what, if any, conditions, or (in case such petitioner shall have prayed for a confirmation of the letters patent or for a grant of new letters patent) whether such confirmation or grant should be made.

27. *Notice of commission to be published and caveats entered.* Two months at least before the time named in the said commission for the consideration of any such petition as aforesaid, the petitioner shall cause to be published in the same manner as is hereinbefore required with respect to the said first mentioned appointment an advertisement of the contents of the said commission in the form contained in the eighth schedule to this Act, or to the like effect; and any person having an interest in opposing the said petition shall be at liberty to enter a caveat against the same at the office of the *registrar-general* at any time not being less than one week before the time named in the said commission for the execution thereof.

28. *Commissioners to hear all parties and report.* At the time and place fixed in the said commission for that purpose the commissioners shall meet and proceed to consider such petition; and the petitioner shall be heard by his counsel and witnesses to prove his case as stated in such petition, and the publication of the said

last mentioned advertisement as required by this Act; and the persons entering caveats shall likewise be heard by their counsel and witnesses; and all such witnesses shall be examined upon oath or affirmation (which oath or affirmation such commissioners as aforesaid are hereby authorized and required to administer); and thereupon and upon hearing and inquiry of the whole matter (in case such petitioner shall have prayed for an extension as aforesaid) the said commissioner may report whether any and, if any, what further extension of the said term should be granted; and the Governor in Council is hereby authorized and empowered, if he shall think fit, to grant to the petitioner new letters patent for the said invention for a term not exceeding fourteen years after the expiration of the first term, anything hereinbefore contained to the contrary thereof in anywise notwithstanding; and such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the first letters patent. Or (in case such petitioner shall have prayed for a confirmation or grant as aforesaid, such commissioners, upon examining the said matter and being satisfied that such patentee as aforesaid believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to Her Majesty, her heirs and successors, their opinion that the prayer of such petition ought to be complied with, whereupon the Governor in Council may, if he shall think fit, grant such prayer; and the said letters patent shall be available at law and in equity to give to such petitioner the sole right of using, making, and vending such invention as against all persons whomsoever, anything hereinbefore contained to the contrary thereof notwithstanding: Provided that any person, party to any former suit or action touching such first letters patent as last aforesaid, shall be entitled to have notice in writing of the time and place fixed as aforesaid for the first meeting of the said commissioners to consider the said petition; and after any such report shall have been made it shall not be material or necessary to inquire or ascertain whether any such advertisement as last aforesaid has or has not been published, or whether any such notice as last aforesaid has or has not been given in the manner hereinbefore directed in that behalf.

PART IV.—MISCELLANEOUS PROVISIONS.

29. *Index to specifications, disclaimers, &c.* The Governor in Council may cause indices to all specifications, disclaimers, and memoranda of alterations heretofore or to be hereafter enrolled or deposited as aforesaid to be prepared in such form as may be thought fit; and such indices shall be open to the inspection of the public, at such places as the Governor in Council shall appoint, and subject to the regulations to be made as hereinbefore provided.

30. *Register of patents to be kept.* There shall be kept at the office to be appointed as aforesaid a book or books, to be called The Register of Patents, wherein shall be entered and recorded in chronological order all letters patent granted under this Act and any other Act relating to letters patent heretofore in force in Victoria, the deposit and filing of specifications, disclaimers, and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, determination, vacating, or canceling such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent as the Governor in Council may direct; and such register, or a copy thereof, shall be open at all convenient times to the inspection of the public, subject to such regulations as the Governor in Council may make in that behalf.

31. *Register of Proprietors to be kept.* There shall be kept at the same office a book or books, entitled The Register of Proprietors, wherein shall be entered, in such manner as the Governor in Council shall direct, the assignment of any letters patent, or of any share or interest therein, any license under letters patent, and the district to which such license relates, with the name or names of any person having any share or interest in such letters patent or license, the date of his or their acquiring such letters patent, share, and interest, and any other matter or thing relating to or affecting the proprietorship in such letters patent or license; and a copy of any entry in such book, certified as hereinafter mentioned, shall be given to any person requiring the same, and shall be *prima facie* proof of the assignment of such letters patent, or share or interest therein, or of the license or proprietorship, as therein expressed: Provided always, that until such entry shall have been made, the grantee or grantees of the letters patent shall be deemed and taken to be the

sole and exclusive proprietor or proprietors of such letters patent, and of all the licenses and privileges thereby given and granted; and such register or a copy shall be open to public inspection, subject to such regulations as the Governor in Council may make.

32. *Certified copies to be evidence.* The Governor in Council may cause a seal to be made for the purposes hereinafter mentioned; and all courts, judges, and other persons whomsoever shall take notice of such seal, and receive impressions thereof in evidence in like manner as impressions of the seal of the colony are received in evidence; and copies or extracts, certified and sealed with such seal, of letters patent, specifications, disclaimers, memoranda of observations, and all other documents or books recorded, filed, and kept in pursuance of this Act, shall be received in evidence in all proceedings relating to letters patent for inventions in all courts, and by all judges and other persons whomsoever.

33. *Falsification or forgery of entries.* If any person shall willfully make or cause to be made any false entry in any such register, or shall willfully make or forge or cause to be made or forged any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender or cause or suffer to be produced or tendered in evidence any such writing, knowing the same to be false or forged, he shall be guilty of a misdemeanor, and shall be liable to be imprisoned for any term not exceeding five years.

34. *Entries may be expunged.* If any person shall deem himself aggrieved by any entry made under color of this Act in any such register, it shall be lawful for such person to apply by motion to the Supreme Court in term time, or by summons to a judge of such court in vacation, for an order that such entry may be expunged vacated, or varied; and upon any such application such court or judge may make such order for expunging, vacating, or varying such entry, and as to the costs of such application, as to such court or judge may seem fit; and the officer having the care and custody of such register, on the production to him of any such order, shall expunge, vacate, or vary the said entry according to such order.

35. *Penalty for unauthorized user of the word "patent."* If any person shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark upon anything made, used, or sold by him, for the sole making or selling of which he has not or shall not have obtained letters patent, the name or any imitation of the name of any other person who has or shall have obtained letters patent for the sole making and vending of such thing, without leave in writ-

ing of such patentee or his assigns, or if any person shall upon such thing, not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the Queen's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, he shall for every such offense forfeit and pay the sum of one hundred pounds, one-half to Her Majesty, her heirs and successors, and the other half with full costs of suit to any person who shall sue for the said penalty by action of debt: Provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "patent" upon anything for the sole making or vending of which letters patent before obtained shall have expired or otherwise determined.

36. *In Actions for infringement, particulars of breaches and objections to be delivered.* In any action for the infringement of letters patent the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action, and the defendant on pleading thereto shall deliver with his pleas, and the prosecutor in any proceeding by scire facias to repeal letters patent shall deliver with his declaration, particulars of any objections on which he means to rely at the trial in support of the pleas in the said action, or of the suggestions of the said declaration in scire facias respectively; and at the trial of such action or proceeding by scire facias no evidence shall be allowed to be given in support of any alleged infringement or of any objection impeaching the validity of such letters patent which shall not be contained in the particulars delivered as aforesaid: Provided always, that the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars: Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff or defendant or prosecutor respectively to amend the particulars delivered as aforesaid, upon such terms as to such judge shall seem fit. Provided also, that at the trial of any proceeding by scire facias to repeal letters patent the defendant shall be entitled to begin and to give evidence in support of such letters patent; and in case evidence shall be adduced on the part of the

prosecutor impeaching the validity of such letters patent, the defendant shall be entitled to the reply.

37. Particulars to be regarded in taxing costs. In taxing the costs in any action for infringing letters patent regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause; and it shall be lawful for the judge before whom any such action shall be tried to certify on the record that the validity of letters patent in the declaration mentioned came in question; and the record with such certificate being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding by *scire facias* to repeal the letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in such proceeding by *scire facias*, on obtaining a decree, decretal order, or final judgment, to his full costs, charges, and expenses to be taxed as between attorney and client, unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs.

38. Fees on obtaining patents. There shall be paid in respect of letters patent applied for or issued as herein mentioned, the depositing of specifications, disclaimers, and memoranda of alterations, warrants, certificates, entries, and searches, and other matters and things respectively mentioned in the ninth schedule of this Act, such fees as are enumerated in that schedule; and such of the said fees as are thereby made payable to the law officer shall and may be received and retained by such law officer for his own proper use; and the residue thereof shall form part of the the consolidated revenue of Victoria, and be paid, applied, and disposed of accordingly.

39. English patents to be subject to this Act. All letters patent which shall have been or which shall be granted in the United Kingdom of Great Britain and Ireland after the thirty-first day of December in the year of our Lord one thousand eight hundred and fifty-seven, for any invention, shall, so far as the same relate to Victoria and its dependencies, be and be deemed to have been utterly void and of none effect, and in nowise be put in execution; but all such letters patent granted in the said United Kingdom on or before that day, and which would be or would have been valid

in Victoria if this Act or any other Act relating to letters patent heretofore in force in Victoria had not been passed, shall be deemed and taken to have been granted under this Act, and may be dealt with accordingly.

SCHEDULES.

SCHEDULE I.

Section 2.

Date of Act.	Title of Act.	Extent of Repeal.
18 Vict. No. 1 ..	“An Act to protect the rights of inventors “ of articles at the Exhibition in Victoria “ of one thousand eight hundred and “ fifty-four.”	The whole.
20 Vict. No. 3 ..	“An Act concerning Letters Patent for In- “ ventions.”	The whole.

SCHEDULE II.

Section 7.

To all to whom these presents shall come, I [John Doe, of Taradale, in the county of Talbot, engineer,] send greeting:

Whereas I am desirous of obtaining Royal letters patent for securing unto me Her Majesty's special license that I, my executors, administrators, and assigns, and such others as I or they should at any time agree with, and no others, should and lawfully might from time to time, and at all times during the term of fourteen years (to be computed from the day on which this instrument shall be left at the office of the *registrar-general*), make, use, exercise, and vend within the colony of Victoria and its dependencies an invention for [*insert the title of the invention*]; and in order to obtain the said letters patent I must by an instrument in writing under my hand and seal particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and must also enter into the covenant hereinafter contained: Now know ye, that the nature of the said invention, and the manner in which the same is to be performed, is particularly described and ascertained in and by the following statement; (that is to say,) [*describe the invention*]. And I do hereby, for myself, my heirs, executors, and administrators, covenant with Her Majesty, her heirs, and successors, that I believe the said invention to be a new invention as to the public use and exercise thereof, and that I do not know or believe that any other person than myself is the true and first inventor of the said invention, and that I will not deposit these presents at the office of the *registrar-general* with any such knowledge or belief as last aforesaid.

In witness, &c.

SCHEDULE III.

Section 9.

Patent for [*insert the title of the specification*]. This is to notify that *A. B.* of &c., did on the day of instant [*or last*] deposit at the office of the *registrar-general* in Melbourne a specification or instrument in writing under his hand and seal particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, and that by reason of such deposit the said invention is protected and secured to him exclusively for the term of six calendar months thence next ensuing; and I do further notify that the said *A. B.* has given notice in writing at my chambers of his intention to proceed with his application for letters patent for the said invention, and that I have appointed [*Thursday*] the day of next, at o'clock in the noon, at my chambers to hear and consider the said application and all objections thereto; and I do hereby require all persons having an interest in opposing the grant of such letters patent to leave on or before the day of at my chambers in Melbourne particulars in writing of their objections to the said application, otherwise they will be precluded from urging the same.

Given under my hand this day of 18 .
T. H. F.,
General.

SCHEDULE IV.

Section 10.

Upon hearing the objection of *A. B.* to grant to *C. D.* of letters patent for [*insert the title as in the specification*], I do by this writing under my hand order that the said *A. B.* shall pay to the said *C. D.* the sum of for the costs of such hearing [*or to E. F.* the sum of as a remuneration for his attendance at such hearing].

Given under my hand this day of 18 .
G. H.,
General.

SCHEDULE V.

Section 11.

I have heard and considered the application of *A. B.* for letters patent for [*insert the title as in the specification*], and also all objections to the same, and having perused the specification and the usual and necessary advertisements, am of opinion that as it is entirely at the hazard of the said applicant whether the said invention is new and will have the desired success, Her Majesty's Royal letters patent may be issued in the form contained in the sixth schedule to the "Patents Statute, 1865," [with the following additional clauses (that is to say,) *here set them out if any*].

Given under my hand and seal this day of
(L. S.) W. F. S.,
General.

SCHEDULE VI.

Section 13.

Victoria, by the Grace of God, of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith, to all to whom these presents shall come, greeting :

Whereas *A. B.* of _____ in the county of _____, engineer, hath represented that he is desirous of obtaining our Royal letters patent for securing unto him our special license that he, his executors, administrators, and assigns, and such others as he or they should agree with, and no others, should and lawfully might make, use, exercise, and vend within our Colony of Victoria and its dependencies an invention for [*insert the title of the invention*]; and by an instrument in writing under his hand and seal, deposited in the office of the *registrar-general*, the said *A. B.* hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed; and we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to confer upon the said *A. B.* the privileges hereinafter mentioned: Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents, for us, our heirs, and successors, do give and grant unto the said *A. B.*, his executors, administrators, and assigns, our special license, full power, sole privilege, and authority that he the said *A. B.*, his executors, administrators, and assigns, and every of them, by himself and themselves, or his and their deputy or deputies, servants or agents, or such others as he or they shall at any time agree with, and no others during the term herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our said colony and its dependencies, in such manner as to him, his executors, administrators, and assigns, or any of them shall seem meet, and that he, his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage, from time to time coming, growing, accruing, and arising by reason of the said invention during the said term; to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages unto and by the said *A. B.*, his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years now next-ensuing; and to the end that he, his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention according to our gracious intention, we do by these presents, for us, our heirs and successors require and strictly command all and every person and persons, bodies politic and corporate and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within our said colony and its dependencies, that neither they nor any of them at any time during the said term, either directly or indirectly, do make, use, or put in practice the said invention or any part of the same so attained unto by the said *A. B.* as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto or subtraction from the same whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the consent, license, or agreement of the said *A. B.*, his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our

royal command, and further to be answerable to the said *A. B.*, his executors, administrators, and assigns, according to law for his and their damages thereby occasioned: Provided always, and these letters patents are and shall be upon this condition, that is at any time during the said term hereby granted it shall appear that this our grant if contrary to law or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said *A. B.* is not the true and first inventor thereof within this colony or its dependencies, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof, in anywise notwithstanding: Provided also, that these our letters patent, or anything herein contained, shall not extend or be construed to extend to give privilege unto the said *A. B.*, his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever and publicly used or exercised unto whom or like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof, within our said colony or its dependencies, it being our will and pleasure that the said *A. B.*, his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out according to the true intent and meaning of the same respective letters patent and of these presents: Provided likewise nevertheless, and these our letters patent are upon this express condition, that if the said instrument in writing does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and also, if the said *A. B.*, his executors, administrators, or assigns, shall not pay at the office of the *registrar-general* of our said colony the sum of fifteen pounds within three years next after the date of these presents, and the sum of twenty pounds within seven years next after such date, and also if the said *A. B.*, his executors, administrators, or assigns, shall not supply or cause to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the persons administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said persons requiring the same, that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted. And lastly, we do by these presents, for us, our heirs and successors, grant unto the said *A. B.*, his executors, administrators, and assigns, that these our letters patent shall be in and by all things, good, firm, valid, and sufficient and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense, for the best advantage of the said *A. B.*, his executors, administrators, and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever, of us, our heirs and successors, in our said colony and its dependencies, and amongst all and every the subjects of us, our heirs and successors whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials

thereunto conducing and belonging. In witness whereof we have caused these our letters to be made patent, and to be sealed and bear date as of the day of

SCHEDULE VII.

Section 20.

Patent for [*insert the title*]. This is to notify to all whom it may concern, that C. D., of &c., has applied to me for leave to enter a disclaimer of part [*or memorandum of alteration, as the case may be*] of the said invention, the particulars whereof are stated below; I do therefore appoint [*Thursday*], the day of next, at o'clock in the noon, to hear and consider the said application and all objections to the same; and I do hereby require all persons having an interest in opposing the said application to leave on or before the day of at my chambers in Melbourne particulars in writing of their objections to the same, otherwise they will be precluded from urging such objections.

Given under my hand, this day of .
W. F. S.,
 General.

The following is the disclaimer [*or as the case may be*] which I desire to make in, &c. [*The applicant must here set forth what he wishes to enter, and sign it*].

SCHEDULE VIII.

Section 27.

Patent for [*insert the title*]. Notice is hereby given, that I have presented a petition to his Excellency the Governor, praying for the confirmation of [*or extension of the term in*] the said patent, and that a royal commission has issued authorizing and requiring certain commissioners therein named to consider and report upon the subject to Her Majesty, which said commissioners will meet for that purpose on the day of next, at o'clock in the noon, at . All persons objecting to the said confirmation [*or extension*] must enter a caveat against the same, at the office of the registrar-general in Melbourne, otherwise they will be precluded from objecting to it.

Dated this day of .
A. B.

SCHEDULE IX.

Section 38.

	£	s.	d.
On depositing specification.....	2	10	0
To the law officer for any "appointment".....	2	4	6
On obtaining letters patent.....	2	10	0
At or before the expiration of the third year.....	15	0	0
At or before the expiration of the seventh year.....	20	0	0
To the law officer with particulars of objections.....	2	4	6
On presenting petition for extension or confirmation.....	2	10	0
Every search and inspection.....	0	1	0

Entry of assignment or license.....	0	10	0
Certificate of assignment or license.....	0	10	0
Filing of memorandum of alteration or disclaimer.....	2	10	0
Entering any caveat.....	2	10	0
Copy or extract of any writing per common law folio.....	0	1	0

From *Carpin. Pat. L. of World*, 615.

An act to amend the laws concerning Letters Patent for Inventions. No. DCCCVIII. December 12, 1884.

Be it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Legislative Council and the Legislative Assembly of Victoria in this present Parliament assembled, and by the authority of the same, as follows—that is to say :

1. This Act may for all purposes be cited as “The Patents Act, 1884” and shall be read and construed as one with “The Patent Statute 1865,” (hereinafter referred to as the “Principal Act”) as amended by the Act No. CCCXXXII, except so far as such construction would be inconsistent with or repugnant to the provisions of this act.

2. In this Act and the principal Act the word “patentee” shall mean the person for the time being entitled to the benefit of any letters patent in Victoria, and the words “the true and first inventor” shall mean the person who is the actual inventor or his nominee or assignee, and shall not include the unauthorized importer of an invention from elsewhere.

3. The acts specified in the first schedule hereto shall be and the same are hereby repealed to the extent specified in the third column of the said schedule : Nothing herein contained shall affect any proceedings or things lawfully taken, done, or commenced, or any letters patent granted, or any protection or right conferred, or any register or appointment made, or any notice of particulars given or published, or any warrant issued, or caveat entered under any of the repealed portions of the said Acts, before the passing of this Act ; and all such proceedings and things shall be as valid and may be continued, and all such letters patent, protections, rights, registers, appointments, notices, particulars, warrants, and caveats shall have the same force and efficacy as if this Act had not been passed. When letters patent have been granted to any person before the passing of this Act, or shall in respect of any application

made before the passing of this Act be hereafter granted to any person for any invention, such person shall with respect to all matters and things which might lawfully have been done, and with respect to all fees which might lawfully have been paid after the passing of this Act, be entitled to avail himself of the provisions of this Act as if this Act had been passed before the grant of such letters patent.

MODE OF OBTAINING LETTERS PATENT.

4. In section 6 of the principal Act the words "twelve months shall be substituted for the words "six months," wherever the same occur in the said section.

5. For the purposes of the hearing and consideration of any application in accordance with the provisions of section 10 of the principal Act, the law officer may by summons under his hand require the attendance of all such persons as he thinks fit to call before him for examination, and may under his hand order to be paid by the applicant or objector to such persons such remuneration for their attendance as to him may seem reasonable. In opposed cases where applicants and objectors consent the law officer may hear all the parties in the presence of one another.

6. If any person whose attendance has been so required and on whom any such summons has been served by the delivery thereof to him or by the leaving thereof at his usual place of abode, neglect or fail to appear or refuse to make answer to such questions as are put to him touching such application as aforesaid, such person shall forfeit and pay a penalty not exceeding twenty pounds, to be recovered by any person authorized so to do by the law officer in a summary way before a justice of the peace.

7. If any applicant for a grant of letters patent be dissatisfied with the refusal of the law officer to issue his warrant for the granting of letters patent, such applicant may appeal to the Supreme Court, and the mode of such appeal and all matters relating to pleading, practice, and procedure therein shall be in accordance with rules of court for the time being in force. For the purpose of regulating such appeals the Supreme Court may at any time, with a concurrence of a majority of the judges thereof present at any meeting for that purpose held, make rules of court, and may from time to time annul any such rules and make further or additional rules; and the Supreme Court may direct a warrant for the granting of letters patent, and such warrant shall be to all intents and

puposes as valid and effectual as though it were a warrant for the granting of letters patent for an invention under the hand and seal of the law officer.

8. Notwithstanding anything in any Act of Parliament contained, where any patent or like privilege for the monopoly or exclusive use or exercise in any parts out of Victoria and its dependencies has been obtained for or in respect of any invention first invented in parts out of Victoria and its dependencies, letters patent may be granted for or in respect of such invention at any time within one year from the date of the granting of the first of any such patents or privileges for such monopoly, exclusive use, or exercise as aforesaid, notwithstanding that such invention has been used or published in Victoria within such period of one year, and such letters patent, when granted, shall have the same force and effect as if such prior publication or use had not taken place : Provided, however, That if such use or publication have been made in Victoria with the consent of the inventor, such inventor shall not be entitled to a grant of letters patent under the authority of this section.

9. (1.) If the Governor in Council is pleased to make any arrangement with the government or governments of any Australian colony, or with the government of the colony of New Zealand, or of the colony of Fiji for the mutual protection of inventions, then any person who has applied for the protection of any invention in any such colony shall be entitled to a patent for his invention under this Act in priority to other applicants, and such patent shall have the same date as the date of the protection obtained in such colony : Provided, That his application is made within six months from his applying for protection in the colony with which the arrangement is in force : Provided, That nothing in this section contained shall entitle such person to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification in Victoria.

(2.) The publication in Victoria during the period aforesaid of any description of such invention, or the use therein during such period of invention (whether with or without the consent of such person as aforesaid), shall not invalidate the patent which may be granted for the invention.

(3.) The application for a grant of a patent under this section must be made in the same manner as an ordinary application under this Act.

(4.) The provisions of this section shall apply only to such of the colonies aforesaid with respect to which the Governor shall from time to time by order in Council declare them to be applicable, and so long only in the case of each colony as the order in Council shall continue in force with respect to that State.

10. Where Her Majesty has by order in Council applied the provisions of section 103 of an Act of the Imperial Parliament, called "The Patents, Designs, and Trade-Marks Act, 1883," or any portion thereof, to Victoria, the provisions of the last preceding section may, by order of the Governor in Council, be applied for the protection of inventions patented in the United Kingdom or Isle of Man: Provided, That such order in Council may be at any time revoked.

EXTENSION OF TERM AND CONFIRMATION OF INVALID PATENTS.

11. Where any commissioners have been appointed by the Governor in Council, under Part III. of the principal Act, to consider the petition of any person for the confirmation of letters patent, or for the grant of new letters patent, or for an extension of the term in any letters patent mentioned, such commissioners may, if in their report to Her Majesty, her heirs and successors, they recommend that such confirmation, grant, or extension should not be made, also recommend that all the costs and expenses of or relating to the consideration of such petition by the commissioners, and of and relating to the appearance of the law officers of the Crown and the crown solicitor to oppose the prayer of such petition, shall be borne by such petitioner; and the Governor in Council may thereupon make an order that such costs and expenses, or any part thereof as he thinks fit, shall be borne by such petitioner.

MISCELLANEOUS PROVISIONS.

12. Any person who writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks upon anything made, used or sold by him, and for the sole making or selling of which he has not obtained letters patent, the name or any imitation of the name of any other person who has, as patentee, obtained letters patent for the sole making and selling of such thing, without leave in writing of such patentee or his assigns, or who, upon such thing not having been purchased from the patentee or some person who purchased it

from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks the word "patent" or "patented," or the words "letters patent," "royal letters patent," or "Queen's patent," or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee, or who puts to sale as patented any article not patented in Victoria, for the purpose of deceiving the public, shall be guilty of a misdemeanor, and on conviction thereof be liable to a fine not exceeding one hundred pounds or imprisonment for a period not exceeding three months.

13. Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, any person who has, as patentee, obtained letters patent for the sole making and selling of anything, has (in his specification) claimed to be the true and first inventor or discoverer of any material or substantial part of the thing patented of which he was not the true and first inventor as aforesaid, every such patentee, his executors, administrators, and assigns, whether of the whole or any interest in such letters patent, may maintain a suit at law or in equity for the infringement of any part thereof which was *bona fide* his own, provided it be a material and substantial part of the invention in respect of which the letters patent were rightfully granted, and that it be definitely distinguishable from the parts so claimed without right as aforesaid, notwithstanding the specifications may embrace more than that of which such patentee was the true or first inventor or discoverer; but in every such case in which judgment is given or a decree is made for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the chambers of the law officer before the commencement of the action or suit, nor shall he be entitled to the benefit of this section if he have unreasonably neglected or delayed to enter said disclaimer.

14. A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs, and successors, as it has as against a subject, but the minister at the head of any department of the public service may use for the public service any patented article or any patented manufacturing process on such terms as may be agreed on with the patentee of such article or process, or in default of such agreement on such terms as may be settled by arbitration

conducted under regulations to be made by the Governor in Council.

REVOCATION.

15. (1.) The proceeding by scire facias to repeal a patent is hereby abolished.

(2.) Revocation of a patent may be obtained on petition to the Supreme Court.

(3.) Every ground on which a patent might, at the commencement of this act, be repealed by scire facias shall be a ground of revocation.

(4.) A petition for revocation of a patent may be presented by—

(a.) The law officer ;

(b.) Any person authorized by the law officer ;

(c.) Any person alleging that the patent was obtained in fraud of his rights, or of any person under or through whom he claims ;

(d.) Any person alleging that he, or that any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee ;

(e.) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5.) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of a judge of the court, be admitted in proof of any objection of which particulars are not so delivered.

(6.) Particulars delivered may be from time to time amended by leave of the court in which such action is pending or a judge thereof.

(7.) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud the law officer may, on the application of the true and first inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the patent so revoked ; but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

LEGAL PROCEEDINGS.

16. (1.) In an action for infringement of a patent, the judge who is trying the action may, if he thinks fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified and try and hear the case wholly or partially with his assistance. The action shall be tried without a jury, unless the court shall otherwise direct.

(2.) A judge of any court having jurisdiction to deal with matters and things relating to letters patent may, if he sees fit, in any proceeding before him call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the judge or judges who have called such assessor to his or their aid, and be costs in the cause.

17. (1.) In an action for infringement of a patent the plaintiff shall deliver with his statement of claim, or by order of a judge of the court in which such action is brought at any subsequent time, particulars of the breaches complained of.

(2.) The defendant on pleading thereto shall deliver with his statement of defense, or by order of the Supreme Court or a judge thereof at any subsequent time, particulars of any objections on which he relies in support thereof.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.

(4.) At the hearing no evidence shall, except by leave of the judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

(5.) Particulars delivered may be from time to time amended by leave of the court in which the action is then pending or a judge thereof.

(6.) On taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant, and they, respectively, shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the court in which the action was tried, or a judge thereof, to have been proven, or to have been reasonable and proper, without regard to the general costs of the case.

18. In an action for infringement of a patent, the court in which such action is pending, or a judge thereof, may on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the said court or such judge may see fit.

19. In an action for infringement of a patent, the court in which the action was tried, or a judge thereof, may certify that the validity of the patent came in question, and if such court or judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favor, shall have his full costs, charges, and expenses, as between solicitor and client, unless such court or judge before whom the action was tried certifies that he ought not to have the same.

20. Every patent may be in the form in the second schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

21. If a person possessed of an invention dies without making application for a patent for the invention, application may be made by and a patent for the invention granted to his legal representative. Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

22. The exhibition of an invention at an industrial or international exhibition, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application: Provided, That both the following conditions are complied with, namely;

(a.) The exhibitor must, before exhibiting the invention, give the law officer one month's notice of his intention to do so; and,

(b.) The application for a patent must be made before or within twelve months from the date of the opening of the exhibition.

23. The Governor in Council may, subject to the provisions of this act, from time to time, make, alter and repeal rules and regulations to regulate the issue of licenses to persons to practice as agents for the procuring and taking out of letters patent for inventions, and fixing the amount or fee to be charged for each such license per annum.

24. The second and third schedules to this Act shall be respectively substituted for the sixth and third schedules to the principal Act.

25. The fees set out in the fourth schedule to this Act shall be payable for and in respect of the matters and things therein mentioned in lieu of the fees prescribed by the ninth schedule to the principal Act, and the said fourth schedule hereto shall be substituted for the said ninth schedule to the principal Act.

Notwithstanding anything in the principal Act contained, a fee due in respect of letters patent for any invention at the expiration of the third or seventh year from the date therefrom, may be paid at any time within six months of such due date on payment of an additional fee by way of penalty of two pounds and ten shillings, and may be paid at any time within twelve months of such due date on payment of an additional fee by way of penalty of ten pounds; and on payment of such fee and penalty the powers and privileges granted by such letters patent shall be as good and effectual to all intents and purposes as though such fee had been paid on such due date as aforesaid.

From 32 *Pat. Off. Gaz.* 774.

VIRGIN ISLANDS.

See LEEWARD ISLANDS.

WALES.

See GREAT BRITAIN AND IRELAND.

WESTERN AUSTRALIA.

An Act to Regulate Grants of Patents for Inventions in the Colony of Western Australia. No. 1, Aug. 15, 1872.

Whereas it is expedient to make provision for granting patents for inventions in the Colony of Western Australia : Be it therefore enacted by His Excellency the Governor of Western Australia and its dependencies, by and with the advice and consent of the Legislative Council thereof, as follows :—

1. *Holder of letters patent under this Act entitled to same privileges as patentees in England.* From and after the passing of this Act, any person to whom, as the originator or discoverer of any new invention or improvement in the arts or manufactures, His Excellency the Governor shall, according to the provisions hereinafter contained, grant letters patent, or an instrument in the nature of letters patent, shall have within the said Colony of Western Australia, for a term of fourteen years next after the granting of such letters patent or instrument, the exclusive enjoyment and advantage in the said colony of such invention or improvement, and such and the same protection, and such and the same remedies at law and in equity against any person in the colony infringing the said letters patent or instrument, and generally such and the same rights, powers, and privileges throughout the said colony, with respect to the invention for which such letters patent or instrument shall be granted, as any person to whom letters patent for a new invention have been granted under the Great Seal of England has by the law of England in and throughout the realm of England (save so far as such protection, remedies, rights, powers, and privileges may be inconsistent with the provisions of this Act) : Provided that so much of the provisions contained in an Act of the United Parliament of Great-Britain and Ireland passed in the session of the fifth and sixth years of the reign of His late Majesty King William the Fourth, entitled “An Act to amend the law touching letters letters patent for inventions,” as relates to the confirming of letters patent or granting new letters patent to a patentee acting under an erroneous belief that he was the first and original inventor, and for the prolongation of letters patent, and the several provisions contained in an Act of the United Parliament of

Great Britain and Ireland passed in the session of the fifteenth and sixteenth years of the reign of Her present Majesty, entitled "An Act for amending the law for granting patents for inventions," shall not be deemed applicable to the Colony of Western Australia : Provided further, that any of the penalties recoverable by any person holding letters patent under the Great Seal of England in any court of Great Britain, under the said first-mentioned Act, for any unauthorized person using or imitating the name of any such patentee, or using the word "patent," or the like words, or counterfeiting the mark of any such patentee, may be recoverable and recovered in similar courts in the said colony by any person to whom letters patent, or an instrument in the nature of letters patent, shall be granted under the provisions hereof, or by his assignee, for similar injuries to such last mentioned patentee or his assignee in the said colony.

2. *Mode of application for letters patent.* Any person being the originator or discoverer of any new invention or improvement as aforesaid, for which no patent or instrument in the nature of letters patent has been issued in Western Australia or any other country, and being desirous of obtaining letters patent or an instrument as aforesaid under this act, shall deposit with the colonial treasurer the sum of twenty-five pounds, and leave in the office, or in the custody of such person as the Governor may appoint, a petition addressed to His Excellency, stating clearly and succinctly the object to be attained by his invention or discovery, setting forth that he has deposited the sum of twenty-five pounds as aforesaid, and praying that letters patent, or an instrument as aforesaid, may be granted to him for the exclusive use thereof in the said colony ; and every such person shall also send with his said petition a written specification, signed by him, of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or scheme to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same ; and in case of any machine, a statement of the principle and of the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions ; and shall in the said specification particularly specify and point out the part, improvement, or combination which he claims as his own invention and discovery : he shall also send a drawing and written

references, where the nature of the case admits, of drawings or specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, when the invention or discovery is a composition of matter ; and he shall moreover, if required by such person so appointed as aforesaid, furnish with the said petition a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts ; and he shall also send a solemn affirmation or declaration, made before some justice of the peace of the said colony (and which affirmation or declaration such justice is hereby authorized to take), that the petitioner is, as he believes, the first and true originator or discoverer of such new invention or improvement, and shall affirm or declare the object intended to be attained thereby.

3. *Notice of application to be published in Gazette.* The Governor in his discretion may thereupon cause notice of the said application to be inserted in the Government Gazette, and thereby require any person who may conceive that he would be prejudiced by the granting of such letters patent or instrument, to send within two months of the said publication to the office or address of such person so appointed as aforesaid, a statement in writing setting forth the grounds of such objection, subscribed with his proper name and address.

4. *Governor may refer objection to appointees who shall report to him.* It shall be lawful for the Governor, upon receipt within the time aforesaid of such objection, to refer the consideration thereof to one or more competent person or persons to be appointed by the said Governor, and also to direct the applicant for such letters patent or instrument, and the opponent of the grant or issue thereof, to attend before such person or persons so appointed, who shall investigate the said matter, and shall be at liberty to call to his or their aid such scientific or other witnesses as he or they may think fit, and to cause to be paid to such witnesses by the applicant such remuneration as he or they may direct ; and such person or persons so appointed shall report to the Governor whether in his or their opinion such letters patent should be issued, and if any such objection shall be sustained, the said specification, drawings, and models shall be returned to the said applicant, and the said sum of twenty-five pounds shall be paid to Her Majesty as hereinafter mentioned.

5. *Costs of inquiry to be given.* It shall be lawful for such

person or persons so appointed, to whom the consideration of any such objection as aforesaid is referred, if he or they see fit, by certificate under his or their hand, to determine the amount of the costs of any hearing or inquiry upon such objection, and to order by and to whom such costs shall be paid ; and if any such costs so ordered to be paid be not paid within seven days after the date of such order, every such order may be made a rule of the Supreme Court of such colony.

6. *If no objection, letters patent may be issued.* In case no objection shall be made to the issuing of the said letters patent or instrument within the time aforesaid, or in case such person or persons so appointed shall report that such letters patent or instrument should be issued, the Governor may direct, by writing under his hand, that such letters patent or instrument shall be issued by the colonial secretary or other proper officer, and shall thereupon cause such specifications, drawings, and models so sent as aforesaid, to be deposited with the colonial secretary of the said colony.

7. *Amount to be paid for letters patent.* The person applying for such letters patent or instrument shall, within one month after the issuing of such direction, pay into the office of the colonial treasury of the said colony and obtain a receipt for the sum of twenty-five pounds sterling, which sum and the said sum of twenty-five pounds, and all other moneys received by the colonial treasurer under this Act, shall be paid to Her Majesty, her heirs and successors, for the use of the said colony and in support of the government thereof.

8. *Colonial secretary to issue letters patent.* The colonial secretary or other proper officer, upon such directions as aforesaid, and production to him of the receipts of the colonial treasurer, shall forthwith cause letters patent to be prepared in the form in the schedule hereunto annexed marked A, and the Governor shall sign his name and cause the seal of the said colony to be annexed to such letters patent, and deliver the same to the person to whom the same shall be granted, or to his agent or legal representative.

9. *Letters patent to be delivered to colonial secretary.* The person to whom such letters patent shall be issued shall thereupon deliver or cause to be delivered the said letters patent at the office of the said colonial secretary, and the said letters patent shall be operative from the time of such delivery.

10. *More than ten persons may be interested in letters patent.* It shall be lawful for a larger number than ten persons to have a

legal or beneficial interest in any such letters patent or instrument in the nature of letters patent, issued under the provisions of this Act.

11. *Assignment of a patent and record thereof.* Every patent or instrument in the nature of letters patent granted under this Act shall be assignable in law either as to the whole interest or any undivided part thereof by any instrument in writing, which assignment, and also every grant and conveyance of the exclusive right under any patent to make and use and to grant to others to make and use the thing patented within the said colony, shall be recorded in the office of the colonial secretary within three months from the execution thereof upon payment by the assignee or grantee to the colonial treasurer of the sum of ten pounds.

12. *Injunction may be granted.* In any action in the Supreme Court of the said colony for the infringement of any letters patent, or instrument in the nature of letters patent, issued under the provisions of this Act, it shall be lawful for the court, as well in its common law as equity jurisdiction, or if the court be not sitting, then for a judge of such court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection, or account, and to give such direction respecting such action, injunction, inspection, and account, and the proceedings therein respectively, as to such court or judge shall seem fit.

13. *Letters patent may be repealed by scire facias.* Any letters patent or instrument in the nature of letters patent granted by virtue of this Act shall be liable to be repealed by writ of scire facias for the same causes and in the same manner as any grants of the crown are liable to be repealed.

14. *Letters patent and specifications, &c., to be enrolled.* The said colonial secretary shall cause both the said letters patent and description to be kept in his office, and shall also cause a book to be kept in his office containing an index to all such letters patent, or instruments which may be issued or assigned; the object to be attained by the invention to be protected thereby, the date thereof, the name of the person to whom the same is issued or assigned, and such description of the enrollment thereof as may be necessary to facilitate reference; and all persons whosoever may have access to the said books, and may inspect the same, and may have copies thereof, or of such parts thereof as they may require, certified by the colonial secretary, upon payment of reasonable expenses actually incurred in taking the same, and copies of, or extracts from the

said letters patent, instrument, and specification certified by the said colonial secretary to be true copies or extracts shall be received as evidence of the contents of the said letters patent, instrument, and specification respectively in all proceedings whatsoever.

15. *Specification may be corrected.* Whenever any patent or instrument in the nature of letters patent granted under the authority of this Act shall be inoperative or invalid by reason of defective or insufficient description or specification, or by reason of the patentee claiming, as his own invention, more than he had or shall have a right to claim as new, if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for His Excellency the Governor, upon the surrender of such patent or instrument, and the payment to the colonial treasurer of the sum of ten pounds, to cause a new patent or instrument as aforesaid to be issued to the said inventor for the same invention for the residue of the period then unexpired for which the original patent was granted in accordance with the patentee's corrected description and specification, and in case of his death or any assignment by him made of the original patent a similar right shall vest in his executors, administrators, or assigns; and the patent so reissued, together with the corrected description and specification, shall have the same effect and operation in law on the trial of all actions hereinafter commenced for causes subsequently accruing as though the same had been originally filed in such corrected form before the issuing out of the original patent: And whenever the original patentee or his assignee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery which shall have been originated or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the further payment of twenty pounds in manner hereinbefore provided, have the same annexed to the original description and specification, and the colonial secretary shall certify on the margin of such annexed description and specification the time of its being annexed and recorded, and the same shall thereafter have the same effect in law to all intents and purposes as though it had been embraced in the original description and specification.

16. *Disclaimer may be entered.* Any person who shall obtain such letters patent or instrument, or his assignee, may, if he think fit, enter with the said colonial secretary (having first obtained the

permission in writing of the Governor) a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such permission as aforesaid, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent or instrument, and such disclaimer or memorandum of alteration being deposited with the said colonial secretary shall be deemed and taken as part of such letters patent or instrument, or such specification, and subject to the several incidents thereof, in all courts of justice in the said colony : Provided that no such disclaimer or alteration shall be receivable as evidence in any action or suit (save and except in any proceeding by scire facias) pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted.

17. *Punishment for false entries or false affirmations.* If any person shall willfully make or cause to be made any false entry or alteration in any register or assignment of patents or instruments as aforesaid, or in any specification, or shall willfully make or forge, or cause to be made or forged, any false writing purporting to be a copy of an entry in the said book, or of any such patents, instruments, or specifications, or shall produce or tender or cause to be produced or tendered in evidence any such writing, knowing the same to be false or forged, or shall willfully make any false affirmation before any justice of the peace respecting any of the matters concerning which an affirmation is hereby required to be made as aforesaid, he shall be guilty of a misdemeanor, and on conviction thereof shall be punished by fine and imprisonment at the discretion of the court.

18. *Foreign patentees or their assignees may obtain letters of registration.* No person shall receive a patent or an instrument in the nature of letters patent under this Act for an invention or discovery which has been previously patented in Great Britain, or any other country, but it shall be lawful for the Governor, in his discretion, on the application of any person being the holder or assignee of any patent granted or issued in Great Britain, or any other country, for any new discovery or invention, and upon such proof as the Governor may deem sufficient that such person is the *bonâ fide* holder or assignee of the said patent, and that the same

is in full force, and upon payment to the colonial treasurer of the sum of twenty-five pounds, to grant letters of registration under the seal of Western Australia to the holder of such patent as aforesaid, or his assignee, and such letters of registration shall be deposited in the office of the colonial secretary in the manner herein provided, and shall be deemed to be letters patent issued under this Act for such invention or improvement, and shall have the same force and effect as letters patent issued thereunder, and shall, unless repealed by writ of scire facias or otherwise, inure to the benefit of the holder during the continuance of the original patent in the country in which it was issued or granted, and no longer; and all the provisions of this Act shall apply to such letters of registration in the same way *mutatis mutandis* and as fully as to letters patent or an instrument in the nature of letters patent issued under this Act.

19. *Interpretation clause.* In the construction of this Act, the word "person" shall include bodies corporate and companies as well as individuals, unless the context be repugnant thereto.

20. *Royal Prerogative saved.* Nothing in this Act contained shall be deemed to interfere with Her Majesty's Royal Prerogative in granting or issuing or withholding the grant or issue of any letters patent.

From Carpm. Pat. L. of World, 641.

See also AUSTRALASIA.

WURTEMBERG.

A report by Mr. George Petre, of the British Legation, published December 2, 1883, in 4 *Int. Off. Gaz.* 579, with an appendix, *Id.* 607, gives an extended account of the law and practice relative to patents which prevailed throughout Wurtemberg at the time of his writing; and which, presumably, continued in force until the adoption of the general law of July 1, 1877, for the German Empire, for which, see GERMAN EMPIRE.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.*

Signed at Paris, March 20, 1883. Ratifications exchanged at Paris, June 6, 1884.

ARTICLE I. The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland, constitute themselves into a Union for the protection of industrial property.

[NOTE.†—*The following Governments have since adhered to the Convention in accordance with article XVI.:* Great Britain, (Order in Council, under § 103 of the Patents Act, dated June 26, 1884), Ecuador and Tunis.]

ART. II. The subjects or citizens of each of the contracting States shall, in all the other States of the Union, in matters concerning patents, industrial designs or models, trade and commercial

* A conference to establish an International Union, like the Postal Union, for the protection of patents, designs, models, trade-marks and trade-names, met in Paris, March 6, 1883, and adjourned after adopting a draft of a convention at a second sitting on March 13th. The main points were settled at the first conference held at Paris two years before. The convention then proposed was communicated by the French Government to the other participating States. Some of the particulars were objected to by several of the States, and it was to harmonize their views on these minor points that the second conference was held. A much larger number of governments was represented. Representatives were present from the United States, France, England, Italy, Spain, Portugal, Russia, Sweden and Norway, Holland, Belgium, Switzerland, Roumania, Servia, Luxemburg, Brazil, the Argentine Republic, Uruguay,

Guatemala, and San Salvador. The plan is to have a union sitting at Berne, which will represent the States whose patent laws are sufficiently in harmony, and endeavor to secure greater assimilation, and the enjoyments of the rights possessed by citizens of each, by the citizens of all the others. One of the main points is, that a patentee or proprietor of a trade-mark or design, will have a prior right of registration throughout the Union. This will protect him against being forestalled by dishonest agents. Regulations for the protection of patentable devices, designs and trade-marks, during international exhibitions are recommended. The convention proposes, also, to protect trade-names without registration whether they form part of a trade mark or not. 8 Am. Annual Cyclopædia, 1883, tit. Patents.

† From Carpmaels' edition. Add St. Domingo; Sweden, Norway, Turkey.

marks and trade-names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to natives.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, subject to the fulfillment of the formalities and conditions imposed on natives by the internal legislation of each State.

ART. III. Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the contracting States.

ART. IV. Any person who has duly lodged an application for a patent, an industrial design or model, or trade or commercial mark in one of the contracting States, shall enjoy, for lodging the application in the other States, and reserving the rights of third parties, a right of priority during the terms hereinafter stated.

Consequently, a subsequent application in any of the other States of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another application, by publication of the invention, or by the working of it by a third party; by the sale of copies of the design or model, or by the use of the mark.

The above mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and for trade and commercial marks. The terms will be increased by a month for countries beyond the sea.

ART. V. The introduction by the patentee into the country where the patent has been issued of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain subject to the obligation to work his patent in conformity with the laws of the country into which he introduces the patented objects.

ART. VI. Every trade or commercial mark duly deposited in the country of its origin shall be admitted for registration, and protected in like manner in all the other countries of the Union.

The country where the applicant has his chief establishment shall be deemed the country of origin.

If this chief establishment is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

The deposit may be refused if the object for which it is solicited is considered contrary to morality or public order.