

struction, in point of law, of the specification is, in my judgment, that he does claim acids and alkalis beyond those that he mentions. You will have to say whether, in your judgment, that which the defendant has done, has been within the scope of the plaintiff's invention, or whether it is in imitation of it."

Munz's patent for improved metal plates for sheathing the bottoms of ships was called in question chiefly on the ground of want of novelty and want of sufficient directions in the specification as to the proportions and qualities of the ingredients. However, in the trial at law before the Court of Common Pleas, the subject of infringement came up for discussion among the other issues. Tindal, C. J., in his charge to the jury,¹ remarked upon that plea: "Further, the plaintiff says (and that evidence is before you) that, in the month of April, when the mode of making it and the materials were somewhat altered, i. e. when, according to the testimony of defendant's witnesses, they used nothing but cake copper, and not the purest copper obtained from the regule of the copper as the witnesses have stated, yet still it would be for you to say whether, if the very same effect and result is produced, it could have been produced in any other way than by some mode of altering the properties of the common cake copper; because there has been evidence brought before you that the cake copper would not produce the result and be attended with those properties which the plaintiff has taken out his patent for; and therefore, upon that second branch, you will have to ask yourselves whether, seeing that which has been used, and the analysis of it, and the result of such analysis, and the mode in which the witness on the part of the defendants explained that it was carried on, stating certainly that nothing was used but the cake copper for that purpose, whether, in the mode of using that cake copper, which before did not produce the result of the plaintiff's discovery, something or other must not have been managed or contrived, on the part of the defendants, to give it that purity, which, if you are satisfied upon the evidence it did not possess, it must have had through their instrumentality. If it were so, that would be a contrivance and an evasion of the direct letter and description in the patent. Although the patent describes the copper must be of the purest quality (and that seems to me to be the sense of the specification), yet, if persons could take an inferior kind of copper,

¹ 2 Webs. Pat. Cas. 101.

and by dressing it up, and by some particular way of melting and refining it, give it exactly the same effect as the best kind of copper would have done, it must be for you to say whether, in that case, they intended to imitate (as one branch of the declaration states), and to evade the patent which the other party had granted to him.”

But the most interesting case, or rather series of cases, — both as regards the magnitude of the pecuniary interests at stake, and the elaborate discussions and decisions which it called forth, — is that arising under the celebrated Heath patent for making cast-steel.

In 1839, a patent was granted to Heath “for certain improvements in the manufacture of iron and steel.” That part of the specification which immediately concerns us is contained in the following words: “Lastly, I propose to make an improved quality of cast-steel, by introducing into a crucible bars of common blistered steel broken as usual into fragments, or mixtures of cast and malleable iron, or malleable iron and carbonaceous matters, *along with from one to three per cent of their weight of carburet of manganese*, and exposing the crucible to the proper heat for melting the materials, which are when fluid to be poured into an ingot mould in the usual manner; but I do not claim the use of any such mixture of cast and malleable iron, or malleable iron and carbonaceous matter, as any part of my invention, but *only the use of carburet of manganese in any process for the conversion of iron into cast-steel.*”¹

In 1843, the suit of Heath *v.* Unwin was brought in the Exchequer before Lord Abinger, C. B.² Heath, after enrolling his patent, discovered that the same effect might be produced by using coal-tar and black oxide of manganese, the ingredients of the carburet of manganese, as by the use of the carburet itself. This he communicated to the defendant Unwin, who was at that time in his employ as agent, and furnished him with parcels of these materials to sell instead of the compound, at the same time reducing the royalty. Unwin shortly afterwards ceased to be patentee’s agent, and commenced the manufacture of cast-steel by the use of coal-tar and manganese, without paying any license fee. For this infringement the action was brought. Lord Abinger nonsuited

¹ 2 Webs. Pat. Cas. 216.

² Heath *v.* Unwin, 2 Webs. Pat. Cas. 216.

the plaintiff, ruling that the use of the materials, being out of all porportion cheaper than that of the carburet, was a new discovery, and that there was no evidence of the formation of carburet of manganese during defendant's process, and therefore no evidence of an infringement of plaintiff's patent. The Court of Exchequer refused to set aside the nonsuit.

In 1844, another action was brought in the Exchequer before Baron Parke.¹ The learned Baron, in his charge to the jury, said: "The next point for your consideration is, has the infringement taken place? Which depends on the fact, whether the use of the elements by the defendant is, in fact, a use of the compound, — whether the elements really form a carburet before the union with the steel takes place in the crucible. . . . If you are not satisfied of this, you will find for the defendant; if you find that there is carburet formed, I shall reserve the point. You will also say whether the defendant ever uses one per cent of this substance in his manufacture." The jury found that the defendant had infringed; and that though he might not have used *one per cent* of carburet, the words in the specification *from one to three per cent*, give a latitude as to the quantity to be used. Leave was then given the defendant to move to enter a verdict on the plea of non-guilty. A motion before the Court of Exchequer for a rule to show cause why such verdict should not be entered for defendant² was granted and subsequently argued. The rule was made absolute, Baron Parke rendering the judgment as follows: "In order to decide this (the infringement), we must first determine for what invention the patent, as explained by the specification, is taken out. It is not for the use of oxide of manganese in the melting of cast-steel, for carburet of manganese is expressly mentioned and distinguished from oxide of manganese; nor could the patent for the use of the oxide have been supported, as that substance had been used long before in steel-making; nor is it for the use of oxide of manganese in any mode of combination with carbon generally. If it had it would have been liable to a similar objection, as oxide of manganese had been used in crucibles containing in their construction a quantity of carbonaceous matter, with a portion of which it would necessarily combine during the process; nor is it for the use of the oxide with such a quantity of carbon as would

¹ Heath v. Unwin, 2 Webs. Pat. Cas. 218.

² 2 Webs. Pat. Cas. 221; argued, p. 223.

deoxidize it and leave the manganese alone to operate upon the steel, so that neither the quantity of the steel be altered nor the crucible destroyed by the oxide of manganese abstracting, as it otherwise would do, some quantity of carbon from them. The patent is obtained for the use of one particular combination of carbon and manganese, the metallic substance called carburet of manganese, and for the use of it in that state. The specification is expressly for the employment of carburet of manganese, and the mode of using it is by putting a certain quantity by weight of that substance in an unmelted state into the crucible. This being, in our opinion, the true construction of the specification, it is clear that the defendant has not directly infringed the plaintiff's patent, for he has never used that substance in the mode described in the specification. Then comes the question whether he has indirectly infringed the patent by imitating and using the same patent substantially, but making a colorable variation. Now there is no doubt, we think, that if a defendant substitutes for a part of a plaintiff's invention some well-known equivalent, whether chemical or mechanical, he would probably be considered as only making a colorable variation. But here he has not done so. It is quite clear, upon the evidence, that the defendant never meant to use the carburet of manganese at all; he certainly never knew, and there is no reason to suppose that, prior to this investigation, any one else knew, that the substance would be formed in a state of fusion; and it is mere matter of speculative opinion (though after the verdict we must assume it to be a correct opinion among men of science) that it would, but it was clearly not ascertained, and still less was it a known fact. There was, therefore, no intention to imitate the patented invention, and we do not think the defendant can be considered guilty of any direct imitation if he did not intend to imitate at all."

Mr. Webster; in his note (p. 227) to this passage, says, "The doctrine of intention as here expressed has been dissented from by the learned judges who concurred in the judgment, as well as by all other judges whose attention has been called to it. Evidence of intention to imitate may be material for the consideration of the jury; but if the invention be in point of fact adopted or imitated, whether in ignorance or intention, the infringement is just the same."¹

On the strength of the verdict given by the jury in the case

¹ See also *Stead v. Anderson*, 2 Webs. Pat. Cas. 156.

tried before Baron Parke alone (p. 220, Webster), the patentee commenced proceedings in chancery for an injunction and account, but in consequence of the overruling of the verdict, as above stated, these proceedings were suspended. After an interval of two years the case of *Stevens v. Keating* occurred. The Vice-Chancellor and Lord Chancellor both dissenting here from the doctrine of intention as expressed by the Court of Exchequer, Mr. Heath was advised to renew his application to the Court of Chancery. Thereupon the Vice Chancellor ordered an action to be brought in the Common Pleas, to try the questions of infringement and validity of the patent. Cresswell, J., in giving the ruling, said: "I feel fettered by the decision of the Court of Exchequer. My ruling is simply this, that the use of the ingredients, oxide of manganese and carbonaceous matter, is not an infringement of the patent, although these ingredients form a carburet of manganese before it enters into combination with the steel."

On appeal to the Exchequer Chamber by writ of error, this ruling was reversed and a new trial granted,¹ each of the judges giving an elaborate opinion. Crompton, Platt, Erle, and Wightman, *pro*, Coleridge and Alderson *contra*. In 1853 the patent was extended for seven years by the Privy Council, on application of Charlotte Heath, testatrix of the patentee.

The matter was then brought up before the House of Lords by writ of error upon this judgment of the Exchequer Chamber. (1854.)² The following question was proposed to the judges: "Whether, looking at the record as set forth in the joint appendix to the printed cases, there was evidence for the jury that the plaintiff in error (the former defendant Unwin) was guilty of an infringement of the patent stated in the declaration, by using oxide of manganese and carbonaceous matter in the manufacture of cast-steel, in the manner in which, according to his admission at the trial, he did use them." In reply, Crowder, J., Crompton, J., Williams, J., Platt, B., Erle, J., Cresswell, J., and Wightman, J., gave their opinion, that there *was* evidence of infringement; Maule, J., Parke, B., Alderson, B., and Pollock, C. B., that there *was not*.

The Lord Chancellor (Lord Cranworth) and Lord Brougham thereupon gave long and elaborate judgments in behalf of the

¹ 2 Webs. Pat. Cas. 236.

² *Unwin v. Heath*, 32 E. L. & Eq. 45.

plaintiff in error to establish that there was no evidence of infringement, and the House voted judgment accordingly, thereby sustaining the ruling of Cresswell, J., at the jury trial, and overruling the reversal of the Exchequer Chamber.

It would be impossible to give, within the limits of the present treatise, even a selection from the mass of adjudication which this celebrated case has elicited. For, as will appear from the foregoing synopsis of the course of litigation, nearly every leading judge in England was called upon to pronounce on the merits of the patent. The reader, however, is referred to the 32 E. L. & Eq. as containing a careful summary of the leading principles at issue.

The doctrines of *Heath v. Unwin* and *Unwin v. Heath* have been subsequently reaffirmed and applied in a very recent case.¹ Here, the plaintiff was the patentee of an invention for the purification of gas by means of precipitated oxides of iron, and also of a process by which the materials used could be revived and again adapted for the same purifying process. It was held by the Lord Chancellor (Westbury) that the right of the patentee was restricted to the use of artificial precipitated oxides of iron, and that the user by defendants of a natural product known as bog ochre in its natural state, which answered the same purpose as the plaintiff's invention, was no infringement of the patent; but that so far as the revivification of the natural product was concerned, it was an infringement.

¹ *Hills v. Liverpool Gas Co.* 7 Law Times, N. S. 537.

CHAPTER IX.

OF THE REMEDY FOR AN INFRINGEMENT BY ACTION AT LAW.

§ 344. THE act of Congress of July 4, 1836, ch. 357, § 14, provides that damages may be recovered for an infringement by "an action on the case," — a remedy which exists equally at common law, for the violation of the right secured by letters-patent.¹

§ 345. I. *Parties*. The statute also provides that the action shall be brought in the name or names of the person or persons interested, whether as patentee, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States."²

§ 346. Formerly, the grantee for a particular district could not bring an action on the patent in his own name.³ But the statute has made him a party interested in the patent, and consequently, in his own district, he may sue in his own name.⁴

But in order that the assignee of a sectional interest may sue in his own name, the assignment must clearly convey to him the entire and unqualified monopoly which the patentee held in the specified territory, excluding the patentee himself as well as others; for any assignment short of this is a mere license.⁵

It has been recently held that the grant of a right to construct and use fifty machines within certain localities, reserving to the grantor the right to construct and to license others to construct, but not to use them therein, was the grant of an exclusive right under

¹ Bull. N. P. 76.

² Act of July 4, 1836, ch. 357, § 14. It seems that no previous notice or claim of a right to the exclusive use of an invention is necessary to enable a patentee to maintain an action for an alleged violation of his patent right. *Ames v. Howard*, 1 Sumner, 482.

³ *Tyler v. Tuel*, 6 Cranch, 324.

⁴ Such a suit may be maintained although the plaintiff is the grantee of a right to use only a limited number of the patented machines in the particular district, provided it is an exclusive right, and it may be maintained against the patentee himself. *Wilson v. Rousseau*, 4 How. 646.

⁵ *Gayler v. Wilder*, 10 How. 477, per Taney, C. J.

the patent of 1836, and that consequently the suit was rightly brought in the name of the assignees, although agreed to be at the expense of the grantor.¹

An action may properly be brought by the patentee in behalf of one to whom he has granted an exclusive license and who has been damaged by the infringement.²

It has also been held that one joint owner of a patent can bring an action of infringement against his co-owner for making and selling machines in a manner which does not respect his rights.³

§ 347. Where the patentee has assigned his whole interest, either before or after the patent was taken out, the action can only be brought in the name of the assignee;⁴ but where the assign-

¹ Washburn v. Gould, 3 Story, 122.

² Goodyear v. McBurney, 3 Blatchf. 32.

³ Pitts v. Hall, 3 Blatchf. 201.

⁴ Herbert v. Adams, 4 Mass. 15. Affirmed by ruling in Gayler v. Wilder, 10 How. 477. "The inventor of a new and useful improvement certainly has no exclusive right to it until he obtains a patent. This right is created by the patent, and no suit can be maintained by the inventor against any one for using it before the patent is issued. But the discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner in which the law requires. Fitzgerald possessed the inchoate right at the time of the assignment. The discovery had been made, and the specification prepared to obtain a patent. And it appears by the language of the assignment that it was intended to operate upon the perfect legal title which Fitzgerald then had a lawful right to obtain, as well as upon the imperfect and inchoate interest which he actually possessed. The assignment requests that the patent may issue to the assignee, and there would seem to be no sound reason for defeating the intention of the parties by restraining the assignment to the latter interest, and compelling them to execute another transfer, unless the act of Congress makes it necessary. The court thinks it does not. The act of 1836 declares that every patent shall be assignable in law, and that the assignment must be in writing, and recorded within the time specified. But the thing to be assigned is not the mere parchment on which the grant is written. It is the monopoly which the grant confers; the right of property which it creates. And when the party has acquired an inchoate right to it, and the power to make that right perfect and absolute at his pleasure, the assignment of his whole interest, whether executed before or after the patent issued, is equally within the province of the act of Congress.

"And we are the less disposed to give it a different construction, because no purpose of justice would be answered by it; and the one we now give was the received construction of the act of 1793, in several of the circuits. As long ago as

ment is of an undivided part of the interest, the action should be brought in the joint names of the patentee and the assignee, as representing the whole interest.¹

In a recent English case,² it was held that the assignee of a separate and distinct portion of a patent may sue for an infringement of that patent, without joining one who has an interest in another part, the damages to be recovered accruing to the former alone. The patentee, having obtained a patent for "improvements in lace *and other weavings*," assigned to the plaintiffs "all share and interest in it so far as it related to or concerned the making, using, exercising, and vending of the said invention of improvements in the manufacture of *close weavings* in lace, and of *twisted purple edges* of lace and other weavings in *twist lace machines*, as described in the *sixth* part of the specification," &c. The plaintiffs brought an action in their own name for alleged infringement of this part of the patent, to which the defendants pleaded want of right to sue. This was demurred to by plaintiffs, and the demurrer sustained by the court. Erle, C. J. said (Crowder and Byles, J. J. concurring): "I am of opinion that the plaintiffs are entitled to judgment on these demurrers. The main question which has been argued before us arises apparently for the first time; therefore we must decide it according to general principles of law, no authority having been cited which bears any very close analogy. That question is, whether an assignment of part of a patent is valid. I incline to think that it is. It is every day's practice, for the sake of economy, to include in one patent several things which are in their nature perfectly distinct and severable. It is also every day's

1825, it was held by Mr. Justice Story that, in a case of this kind, an action could not be maintained in the name of the patentee, but must be brought by the assignee. 4 Mason, 15 (*Herbert v. Adams*). We understand the same rule has prevailed in other circuits, and if it were now changed, it might produce much injustice to assignees who have relied on such assignments, and defeat pending suits brought upon the faith of long-established judicial practice and judicial decision. Fitzgerald sets up no claim against the assignment, and to require another to complete the transfer would be mere form. We do not think the act of Congress requires it; but that when the patent issued to him, the legal right to the monopoly and property it created was, by operation of the assignment then on record, vested in Enos Wilder." Per Taney, C. J.

¹ *Whittemore v. Cutter*, 1 Gallis. 429, 430. An assignee of the exclusive right to use a certain number of machines in a certain district, may join his assignor with him in a bill for an injunction. *Woodworth v. Wilson*, 4 How. 712.

² *Dunnicliff v. Mallett*, 7 Com. Ben. n. s. 209.

practice to get rid by disclaimer of part of a patent which turns out to be old. Being therefore inclined to think that a patent, severable in its nature, may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part, which is the subject of infringement, may not bring an action. Then, are the assignees, bringing an action for an injury done solely to them by an infringement of that part of the patent which is thus vested in them alone, liable to be defeated because they have not joined the assignees of other parts of the patent, who have no manner of interest in the damages sought to be recovered in such action? I see no reason why the action should be defeated on such ground. I see no reason why the plaintiffs should be put to the trouble and expense of applying for leave to use the names of the other parties, or of compelling them by means of a judge's order to permit their names to be used upon an indemnity, where no practical advantage whatever is to be gained by it, — the injury being to the assignees of part only, and the damages to be recovered being theirs only. It is said that the defendants may possibly be prejudiced by the non-joinder of the other parties, inasmuch as they might thereby be deprived of the advantage of any admissions which might have been made by them. I cannot think that it is a tenable ground of objection, because, if those parties were joined, any admissions by them would not be binding on the now plaintiffs, unless made in and for the purpose of the suit. Then, as to the alleged inconvenience of the matter being brought in question several times, I must confess I do not feel the force of the argument. In the ordinary case of a patentee trying the validity of the patent against several infringers, the power given to the judge to certify under 5 and 6 W. 4, ch. 83, s. 3, is only a provision in favor of the patentee, to entitle him to treble costs where the validity of the patent has already been established. I am not aware of any authority or of any principle which precludes the assignee of part of a patent from suing for an infringement of that part; nor do I think it would lead to any multiplying of actions to permit it. I am therefore of opinion that our judgment should be for the plaintiff on both these demurrers."

This opinion is not to be reconciled with that of Taney, C. J., in the case of *Gaylor v. Wilder*, *supra*; still less with that of Grier, J., in *Blanchard v. Eldridge*.¹ Here the plaintiff, having obtained a

¹ 1 Wall. C. C. 337.

patent for turning every kind of irregular forms, assigned to one Carter "the full and exclusive license, right, and permission to have, hold, use, and enjoy Blanchard's patent for turning irregular forms, &c., so far as said improvement is or may be used for turning shoe lasts, boot and shoe trees, and hat blocks, and also for turning spokes for wheels of all kinds of carriage-wheels, and all articles that form any part in the construction of carriages," &c. He (the patentee, Blanchard) then brought the present suit for an alleged infringement of these rights, granted exclusively to Carter. The defendant moved for a new trial on the ground that the plaintiff was not entitled to sue, but the motion was refused. Grier, J.: "The point here raised by the defendant's counsel is not without its difficulty, and the force of his argument cannot be evaded, if his assumption be true, that this deed transfers to Carter the legal title of that portion of the patent which it purports to vest in him. But if it does not so operate, it cannot be noticed in a court of law, and cannot affect the case. As the grants of the crown were at common law construed with the greatest strictness, the privileges granted by a patent for a monopoly would probably not have been treated as capable of assignment unless made so by the letter of the grant. Since the statute 21 James I., patents for useful inventions (notwithstanding the statute itself mentions the 'inventor' only) have always granted the privilege or monopoly to the inventor, his executor, administrator, and assigns. These monopolies, therefore, are assignable as other personal chattels, by force of the grant which creates them. As a chattel, also, it might be held by two or more joint owners; hence any undivided portion or interest in the whole as a unity might be assigned, and if the original grantee died, such assignees might join in action for infringement of their right.¹ But the patent right itself was insusceptible of local subdivision.² As a privilege or monopoly it was an entire thing, indivisible and incapable of apportionment.³

"But the act of Congress of 1836 has regulated the assignment of patents. Sec. 11 provides that a patent shall be assignable, — (1.) As to the whole interest; (2.) As to any undivided part thereof; (3.) An exclusive right may be granted throughout any specified

¹ Boulton v. Bull, 2 H. Blackst. 463.

² Whittemore v. Cutter, 1 Gall. 429.

³ Brooks v. Byam, 2 Story, 525.

part or portion of the United States. Sec. 14 requires the action for infringement to be brought 'in the name or names of the person or persons interested, whether as patentee, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States.' The word 'assignees' in this section must be construed by reference to the eleventh section, already referred to, which defines in what way a patent may be assigned, to wit, either the whole or any undivided portion of the whole. The statute also renders the monopoly capable of subdivision in the category of its locality, but in no other way. The patentee is not allowed to carve out his monopoly, which is a unity, into a hundred or more, all acting in the same place and liable to come into conflict. The grant to Carter, by the deed under consideration, is not of the whole monopoly, nor of any undivided portion of the whole, and though for an "exclusive right," it is not exclusive of all others within a certain district or *specified part* of the United States; on the contrary, it is an exclusive right to use the machine for a *specified purpose*. A machine for turning irregular figures may be used for numberless purposes. If the patentee or his assignee can assign to A an exclusive right to use the machine for making shoe-lasts, to B for turning spokes, to C for axe handles, and so on to the end of the alphabet, then may he, out of his one monopoly, carve out a thousand others, each subdivision, like a polypus, being itself a several monopoly, and having a separate existence in the same place. What endless perplexity and confusion must necessarily arise from the establishment of such a doctrine. Suppose the monopoly granted by this patent parcelled out to some twenty sub-monopolies, with an exclusive right to each to use his machine for certain purposes in any given place; what remedy could A have against B for an infringement of his special privilege. The patentee or grantor might restrain his grantee of a machine for a special use, by a covenant; but, as between the several grantees, no action could lie, although they alone might suffer from a breach of the covenant.

"But it is sufficient for purposes of the present inquiry, that the act of Congress has not given a legal sanction to such transfers or assignments, nor subjected even a pirate of the machine to fifty different suits by fifty several assignees, whose several interests might be affected if a patent could be thus split up into numerous exclusive rights or sub-monopolies. Whether the deed confers on

Carter and his assigns more than a special license, or what remedy a court of equity might be disposed to extend to him where his rights are infringed, it is not necessary now to inquire. As it does not confer a legal title to the whole or an undivided portion of the patent, nor grant 'an exclusive right within a specified part of the United States,' it cannot be received to affect this case. It was wholly irrelevant and ought not to be received in evidence. It adds to my confidence in the correctness of this view, that, as I have been informed, my brother Nelson has ruled the question in the same way in the second circuit."

In a subsequent English case,¹ it was held that the plaintiff, who had acquired, first, an undivided moiety from the patentees directly, and afterwards, the remaining share indirectly, through a mesne assignment, was thereby vested with the entire right of the patentees, and could even bring an action against them for infringement. If the assignment has not been made, but has been merely agreed to be made, the action should be in the name of the patentee, the assignee not having the interest until the assignment has been made and recorded.² But it may be recorded at any time after the suit is brought and before trial.³ An action for an infringement may be maintained against a corporation.⁴

§ 348. The Supreme Court of the United States have held that a covenant by a patentee, made prior to the law authorizing extensions, that the covenantee should have the benefit of any improvement in the machinery, or alteration or renewal of the patent, did not include the extension by an administrator under the act of 1836; that it must be construed to include only renewals obtained upon the surrender of a patent on account of a defective specification, and, therefore, that a plaintiff who claimed under an assignment from the administrator could maintain a suit against a person who claimed under the covenant.⁵

§ 349. II. *The Declaration.* The declaration, in an action for the infringement of a patent, should show a title in the plaintiff,

¹ *Walter v. Lavater*, 8 Com. Ben. N. 3. 162.

² *Park v. Little*, 3 Wash. 196.

³ *Pitts v. Whitman*, 2 Story's R. 609, 614.

⁴ *Kneass v. The Schuylkill Bank*, 4 Wash. 9.

⁵ *Wilson v. Rousseau*, 4 How. 646

with convenient certainty; and should set forth all the matters which are of the essence. Without these allegations, the plaintiff fails to show a right in point of law to ask the court for judgment in his favor. The several parts of the declaration may here be considered in the order in which they occur in pleading.

§ 350. The declaration should commence with a recital that the plaintiff was "the original and first inventor" of the subject-matter, the making, using, or vending of which is complained of. This averment is necessary, notwithstanding the letters-patent, afterwards referred to, recite that the plaintiff has alleged that he was the original and first inventor; because it must appear affirmatively, in point of fact, at the trial, that he was so, and the letters-patent can only be resorted to as *prima facie* evidence of the fact. There must, therefore, be a distinct allegation of the fact, as one of the things essential to the plaintiff's title.¹ For the same reason, the declaration goes on to aver that the subject-matter was "new and useful," "not known or used before the plaintiff's invention or discovery," and "not at the time of his application for a patent in public use or on sale with his consent or allowance."

But while a declaration on letters-patent must tender issue on the novelty and utility of the invention patented, it need not aver at what specific time such invention was made, but only that it was before the application for the patent.²

§ 351. Whether it is necessary to aver the citizenship of the patentee has never been determined. In practice it is generally done, and it is safer to do so than to omit an averment which might on demurrer be held to be essential.³ But it is absolutely

¹ The plaintiff must affirm the performance of all acts on which his title depends. *Gray v. James, Peters*, C. C. R. 476.

² *Wilder v. McCormick*, 2 Blatchf. 31.

³ Mr. Phillips suggests that the necessity for this averment will depend on the construction to be given to the fifteenth section of the act of 1836, by which, if the patentee be an alien, the defendant is permitted to show that the patentee has "failed and neglected for the space of eighteen months from the date of the patent to put and continue on sale to the public, on reasonable terms, the invention or discovery." *Phillips on Patents*, p. 520, *note*. This clause in the statute can scarcely be considered as imposing a burden of proof of citizenship on the plaintiff. It authorizes the defendant to avail himself of the fact that the plaintiff is an

necessary to aver that the plaintiff, being the original and first inventor, obtained letters-patent for his invention, in due form of law, under the seal of the Patent Office, signed by the Secretary of the Interior, and countersigned by the Commissioner of Patents.¹

The declaration need not, however, show the regularity of the proceedings in the Patent Office preliminary to the grant, but may simply aver that the grant was duly obtained.²

alien, by showing that the plaintiff has omitted to do certain acts ; but is anything more to be inferred from the clause than this, that if the defendant means to show the omission, he must first show that the plaintiff is an alien ? I agree, however, with the learned author, that to aver the citizenship is the safest course.

¹ Formerly, patents bore the attestation of the President of the United States ; and it was held to be necessary to aver that the letters had been so tested, and that the patent had actually issued, or been delivered ; otherwise, the declaration would be bad on demurrer. *Cutting and others, Executors v. Myers*, 4 Wash. 220. For the same reason, the averment is now necessary that the letters were duly tested by the public officers whose duty it is to sign and countersign them ; and the mode of averring the delivery, now usually practised, is to declare that the plaintiff, on such a day, "did obtain" them. But it is not necessary to aver that the preliminary steps to obtain a patent were taken, because if the declaration aver that the patent was granted in the form prescribed by law, the court, upon demurrer, will presume that everything was rightly done to obtain it. *Fulton's Executors v. Myers*. *Vid.* act of 1849, ch. 108, § 2 ; modifying act of 1836, ch. 357, § 5.

² *Wilder v. McCormick*, 2 Blatchf. 31. "The third and fourth causes cannot be sustained. The third is, that it does not appear that the application for the patent was in writing, nor to whom it was made. The fourth is that it does not appear that the Commissioner of Patents had any rightful authority to grant the patent. These causes are founded upon supposed requisites of the statute, not averred in the declaration to have been complied with, and are also supposed to be supported by general principles governing proceedings in tribunals of inferior jurisdiction. If the matters which it is alleged should be set forth in the declaration would call for the application of those principles in case they were pleaded by way of justification and in defence of acts done, or as a protection to the party pleading them, which would at least be a doubtful proposition (*Martin v. Mott*, 12 Wheat. 19), it would not necessarily follow that the same method of pleading must be pursued in declaring upon a private title or a grant emanating from functionaries acting under statutory authority. (*Day v. Chism*, 10 Wheat. 449 ; *Bank of the United States v. Smith*, 11 Wheat. 171 ; *Carroll v. Peake*, 1 Peters, 18, 23.) The third cause of demurrer rests upon the assumption that the plaintiff must, in his pleading, specify all the acts done by him to obtain a patent, in order that it may appear upon the face of the declaration that the mode of proceeding pointed out by the statute has been pursued. But the case of *The Phil. & Trenton R. R. v. Stimpson*, 14 Peters, 448, disposes of this and all the other objections that fall within the same class. The grant of the patent is itself sufficient evidence that all

§ 352. The substance of the grant should then be set forth, that is to say, that the letters-patent secured to the plaintiff, his heirs, administrators, &c., for the term of fourteen years, the full and exclusive right of practising the invention ; which should be described briefly, as it is set forth in the letters-patent, of which profert should be made.¹ Where the declaration describes the plaintiff's invention in the words of the patent, it is not necessary that the description, as stated in the specification, should be set forth. If the defendant require the specification in his defence, he may have it placed in the record by praying oyer of it.²

§ 353. The declaration is concluded by an averment of the the preliminary steps required by law were properly taken. And, as the plaintiff may make his patent the direct and efficient proof, in the first instance, of his right to the grant, so *a fortiori* it would seem unnecessary for him to plead any of the particulars which conduced to the grant. It is sufficient to set forth the grant in substance (*Tryon v. White, Peters, C. C. 96*). The fourth cause of demurrer is founded upon a misapplication of a doctrine appertaining to the acts of legal tribunals, where a court of inferior jurisdiction takes cognizance of a case and renders judgment, and he who sets up such judgment in support of his own interests must aver and prove that the tribunal had jurisdiction in the matter. The authority of the Commissioner of Patents, or of the Commissioner of the Land Office, or of the President to issue grants, is not of the nature of *jurisdiction* in its common-law and technical acceptation. As in regard to patents for land, so in regard to patents for inventions, the proper officer issues the grant when he has evidence satisfactory to his own mind that the claimant is entitled to receive it. But that adjudges nothing as to the real right. That question is unaffected, and remains to be examined and decided between parties contesting it, without prejudice or advantage from the letters-patent. We are not aware of any mode of pleading by which the courts can be called upon to settle the regularity of the preliminary proceedings in the Patent Office. Nor does there seem to be any utility in putting in issue the authority of the commissioner, upon the facts before him, to grant a patent, because, if the decision should negative his authority, it could not revoke or supersede the patent. The declaration must tender an issue upon the novelty and utility of the discovery patented, these being essential to the enforcement of any exclusive privilege under the patent. But the question of the regularity of the proceedings in petitioning for and obtaining the patent, and that of the correctness of the judgment of the officer in awarding it, are not material, and cannot be inquired into."

¹ Chit. Pl. vol. 2. Profert of the letters-patent, in the declaration, makes them and the specification, when produced, a part of the declaration, and so gives all the certainty, as to the invention and improvement patented, required by law. *Pitts. v. Whitman, 2 Story's R. 609, 614.*

² *Gray v. James, Peters, C. C. R. 476.*

value of the patent right and of the breach by the defendant, and the damages sustained by the plaintiff.¹

In this action for a breach of the patent, it is indispensable to establish a breach before suit brought. But in equity the doctrine is otherwise, as a bill for an injunction will lie upon sufficient proof of an intent to violate.² The declaration need not set forth the act complained of as contrary to the statute,³ but may simply allege that the defendant "made, constructed, used, and vended to sundry persons," &c., the said invention.⁴ Repeated infringements may be sued for in one action.⁵ A declaration commencing in the form of action of trespass on the case, and concluding in the form of action of debt, is not demurrable.⁶

§ 354. If the plaintiff sues in the character of assignee of the patent, he must set forth both the patentee's title and his own, and should aver that the assignments were duly recorded in the Patent Office. If the declaration omit to state that the assignments were recorded, the omission will be cured by verdict, if the general terms of the declaration are otherwise sufficient to have authorized the admission of proof of the recording at the trial; upon the

¹ See the Precedents in the Appendix.

² *Woodworth v. Stone*, 3 Story, 749.

³ *Parker v. Haworth*, 4 McLean, 370. "A motion was made in arrest of judgment, on the ground that the declaration does not set forth the act complained of as contrary to the statute. This is necessary when an action is brought on a penal statute, but not in the case like the present, where damages are sought for an injury done. Where the plaintiff sues for a penalty, as the statute is the only foundation for the action, the declaration must aver that the act is *contra formam statuti*. In *Tyron v. White* (Peters, C. C. R. 96) it is said, 'if the declaration in an action for the invasion of a patent right fails to lay the act complained *contra formam statuti*, the defect will be purged after the verdict.'"

⁴ *Case v. Redfield*, 4 McLean, 526.

⁵ *Wilder v. McCormick*, 2 Blatchf. 31. "A reiteration of infringements of a patent, like a repetition of torts of any other kind which are of the same nature, may be sued for and recompensed in one action. There is no known doctrine of the law that requires a plaintiff to split up into separate actions grievances of that character."

⁶ *Ibid.* "We do not perceive that there is any material incongruity between the commencement and the close of the declaration. The gravamen of the suit is the tortious infringement of the plaintiff's patent, and the conclusion of the declaration is a demand of damages in gross. They are averred to be 'actual damages,' but that allegation does not change the nature of the averment. It is still merely a demand of damages in compensation of the wrong."

general principle, that, after verdict, all the facts necessary to have been proved to enable the jury to find a verdict for the plaintiff, will be presumed to have been proved, if the general terms of the declaration would have let them in.¹

§ 355. At the trial, proof may be given of the recording of an assignment, either before or after the action was brought.²

§ 356. III. *Pleadings and Defences.* The fifteenth section of the act of 1836 provides that the defendant, in any action for the infringement of a patent, shall be permitted to plead the general issue, and to give the statute and any special matter in evidence, of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, tending to prove that the description and specification of the patent does not contain the whole

¹ *Dobson v. Campbell*, 1 Sumner, 319, 326, Story, J. "We are of opinion that the motion in arrest of judgment ought to be overruled. We accede to the doctrine stated at the bar, that a defective title cannot, after verdict, support a judgment; and, therefore, it constitutes a good ground for arresting the judgment. But the present is not such a case; but is merely the case of a good title defectively set forth. The defect complained of is the omission to state, that the assignments, on which the plaintiff's title is founded, were duly recorded in the office of the department of state, which is made essential to pass the title of the original patentee, by the fourth section of the Patent Act of the 21st of February, 1793, ch. 55. The general principle of law is, that, where a matter is so essentially necessary to be proved, to establish the plaintiff's right to recovery, that the jury could not be presumed to have found a verdict for him, unless it had been proved at the trial, there the omission to state that matter in express terms, in the declaration, is cured by the verdict, if the general terms of the declaration are otherwise sufficient to comprehend it. This was the doctrine of Lord Ellenborough, in *Jackson v. Pesked* (1 M. & Selw. R. 234); and it is very elaborately expounded by Mr. Sergeant Williams, in his learned note to 1 Saunders R. 228 a. The other authorities, cited on behalf of the plaintiff, are to the same effect. Now, it seems to us, that taking the whole declaration together (however inartificially drawn), the plaintiff sets up a title to the patent right by assignment, and an enjoyment and use of the right under that title, and that he has been injured in that right, under that title, by the piracy of the defendant. This cannot be true, nor could a verdict for the plaintiff have been found by the jury, if the deeds of assignment had not been duly recorded; for, unless that was done, nothing could pass by the deeds. The cases of *Hitchins v. Stevens* (2 Shower R. 233), and *McMurdo v. Smith* (7 T. R. 518), cited at the bar, seem to us very strongly in point. So is *France v. Fringer*, Cro. Jac. 44."

² *Pitts v. Whitman*, 2 Story, 609. Of course, therefore, it is not necessary to aver that the assignment was recorded within three months. *Ibid.*

truth relative to the invention or discovery, or that it contains more than is necessary to produce the described effect; which concealment or addition shall fully appear to have been made for the purpose of deceiving the public; or that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new, or that it has been described in some public work anterior to the supposed discovery by the patentee, or had been in public use, or on sale, with his consent or allowance, before his application for a patent, or that he had surreptitiously or unjustly obtained a patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same; or that the patentee, if an alien at the time the patent was granted, had failed and neglected, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued; in either of which cases, judgment is to be rendered for the defendant, with costs.

§ 357. The object of this provision was to enable the defendant to give certain special matters in evidence under the plea of the general issue. It seems to have been generally supposed, at a very early period in the history of our legislation, that under a plea of the general issue, the defendant could not be allowed to attack the validity of the patent, and that that plea only put in issue the question of infringement.¹ Accordingly, the act of 1793, § 6, enumerated certain special defences, which it declared the defendant "shall be permitted" to give in evidence under the general issue, by first giving notice thereof to the plaintiff. The Supreme Court of the United States construed the provision as intended to relieve the defendant from what were supposed to be the difficulties of pleading, by allowing him to give in evidence, under the plea of not guilty, certain matters affecting the patent, providing, at the same time, for the security of the plaintiff against surprise, by requiring notice to be given of the special matter to be

¹ But it was not so in England. Until the act 5 and 6 Wm. IV., ch. 83, § 5, the usual plea was *not guilty*, which, putting in issue the whole of the declaration, forced the plaintiff to support the grant in all its parts, and gave to the defendant the greatest latitude for evidence; but now the defendant must plead all the defences, and must also deliver in a list of the objections on which he intends to rely at the trial. Godson on Patents, 238, 2d ed.

relied on. This notice was substituted for a special plea.¹ The court also declared that the defendant was not obliged to pursue this course. He might plead specially, in which case the plea would be the only notice the plaintiff could claim; or he might plead the general issue, in which case he must give notice of the special matter on which he relied.² However, where the defendant pleads specially and not under the general issue, the plea must still be filed thirty days before the term, or the plaintiff will be entitled to a continuance. The plaintiff has a right to the thirty days, whether the matter be set up by plea or by notice.³

§ 358. The fifteenth section of the act of 1836 is taken, with

¹ *Evans v. Eaton*, 3 Wheat. 454; *Evans v. Kremer*, Peters, C. C. R. 215. See also the elaborate note on the patent law in the Appendix to 3 Wheat. note II. (written by Mr. Justice Story.)

² *Evans v. Eaton*, 3 Wheat. 454, 503. In this case Mr. Chief Justice Marshall said: "The sixth section of the act appears to be drawn on the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue. It therefore intends to relieve the defendant from the difficulties of pleading, when it allows him to give in evidence matter which does affect the patent. But the notice is directed for the security of the plaintiff, and to protect him against that surprise to which he might be exposed from an unfair use of this privilege. Reasoning merely on the words directing this notice, it might be difficult to define, with absolute precision, what it ought to include, and what it might omit. There are, however, circumstances in the act, which may have some influence on this point. It has been already observed, that the notice is substituted for a special plea; it is further to be observed, that it is a substitute to which the defendant is not obliged to resort. The notice is to be given only when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the only notice which the plaintiff can claim. If, then, the defendant may give in evidence, on a special plea, the prior use of the machine, at places not specified in his plea, it would seem to follow that he may give in evidence its use at places not specified in his notice. It is not believed that a plea would be defective, which did not state the mills in which the machinery alleged to be previously used was placed.

"But there is still another view of the subject which deserves to be considered. The section which directs this notice, also directs that if the special matter stated in the section be proved, 'judgment shall be rendered for the defendant, with costs, and the patent shall be declared void.' The notice might be intended not only for the information of the plaintiff, but for the purpose of spreading on the record the cause for which the patent was avoided. This object is accomplished by a notice which specifies the particular matter to be proved. The ordinary powers of the court are sufficient to prevent, and will undoubtedly be so exercised, as to prevent the patentee from being injured by the surprise."

³ *Phillips v. Comstock*, 4 McLean, 525.

some additional defences, from the sixth section of the act of 1793, and has the same object in view. It differs from the former act, by omitting the provision that the patent "shall be declared void," if judgment is rendered for the defendant, and by providing that "when the defendant relies in his defence on the fact of a previous invention, knowledge, or use of the thing patented, he shall state in his notice of special matter the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same thing had been used." This provision was added in consequence of the construction given to the former act, to the effect that notice of the places was not necessary to be given.¹ In other respects, the construction given to the act of 1793, § 6, is applicable to the present law. The defendant is at liberty to plead specially, in which form of pleading he need give no other notice of his defence than the plea itself gives, or he may plead the general issue, and give notice of the special matter on which he relies. The statute does not undertake to enumerate all the defences which may be made to an action on a patent. It provides that when certain facts, which it enumerates, are to be relied on, and the general issue is pleaded, the defendant shall give notice of the facts which he means to put in evidence.² The notice must be strictly construed; if the defendant gives notice that he will prove the prior use of the invention in the United States, he cannot be allowed to offer evidence of its prior use in England.³

§ 359. But it will be useful to make a particular enumeration of the defences that may be made under the general issue, without notice, before we turn our attention to those mentioned in the statute, of which notice must be given, when the general issue is pleaded.

§ 360. The defendant may show, under the general issue, without notice, that he never did the act complained of, that is, that he has not infringed the patent, or that he was acting under a license or purchase from the plaintiff.⁴ He may show that the

¹ *Evans v. Eaton*, ante, note, *Evans v. Kremer*, Peters, C. C. R. 215.

² *Whittemore v. Cutter*, 1 Gallis, 429, 435; *Grant v. Raymond*, 6 Peters, 218.

³ *Dixon v. Moyer*, 4 Wash. 68.

⁴ *Whittemore v. Cutter*, 1 Gallis. 429, 435; 3 Wheaton's R. Appendix, Note II. p. 27.

plaintiff is an alien, not entitled to a patent; or that the plaintiff has not a good title as assignee; or that his patent was not duly issued according to law, in respect of the signatures of the public officers, or of the public seal, &c.¹

§ 361. He may also show that the invention is not a patentable subject; that is to say, admitting its novelty, he may show that it is not an "art, machine, manufacture, or composition of matter," in the sense of the statute.² But the defence that the subject is not patentable on the ground of want of novelty, falls under the statute, and must be specified.

§ 362. In like manner, the defendant may show, under the general issue, without notice, that the invention, though new, fails in point of utility, and is worthless and frivolous.³

§ 363. So, too, he may show that there is no specification, or that the specification is so ambiguous and unintelligible that the court cannot determine from it what the invention is that is intended to be patented. This is a different issue from that pointed out in the statute. If the specification do not describe the invention in clear and exact terms, so as to distinguish it from other inventions, but be so ambiguous and obscure that it cannot be ascertained with reasonable certainty for what the patent is taken, or what it includes, the patent is void for ambiguity; and this is put in issue by the plea of not guilty, because a clear and distinct specification of the invention is essential to the validity of the patent.⁴ But if the invention is definitely described in the patent

¹ *Whittemore v. Cutter*, 1 Gallis. 429, 435; 3 Wheaton's R. Appendix, Note II. p. 27; *Kneass v. The Schuylkill Bank*, 4 Wash. 9, 11.

² That the invention is not a patentable subject, admitting its novelty, is a different issue from any that is named in the fifteenth section of the statute, and it is one that is necessarily raised by the plea of "*not guilty*," since the declaration necessarily imports that the patentee had invented a patentable subject.

³ Want of novelty is one of the defences enumerated in the fifteenth section, but want of utility is not; but it is a clear bar to the action, upon the terms of the act, as well as upon the general principles of law.

⁴ 3 Wheat. R. Appendix, Note II. p. 27; Phillips on Patents, p. 308; *Kneass v. The Schuylkill Bank*, 4 Wash. 9, 13. In this last case, Mr. Justice Washington intimates that the defendant may show under the general issue, and without notice, that the patent is broader than the discovery. But this must now be otherwise; since the fifteenth section of the act of 1836 describes one of the issues

and specification, so as to distinguish it from other inventions before known, there may still exist the defect described in the fifteenth section of the statute, of some concealment or addition made for the purpose of deceiving the public; and when it is intended to show this, under the general issue, notice must be given.

§ 364. We now come to the special defences enumerated in the fifteenth section of the statute. The statute provides that the defendant may, under the general issue, give the statute itself in evidence,¹ and certain special matters, of which he shall have given notice in writing to the plaintiff or his attorney thirty days before trial.²

§ 365. The first of these special defences is, "that the description and specification filed by the plaintiff, does not contain the whole truth relative to his invention or discovery, or that it contains more than is necessary to produce the described effect; which concealment or addition shall fully appear to have been made for the purpose of deceiving the public." We have already seen what was the general purpose of Congress in providing that notice should be given, when certain facts were to be offered in evidence; but it is not very easy to define the scope of the issue intended by the above provision, or to distinguish the exact meaning of the statute in this particular. It is clear, however, that this issue, as we have already suggested, is distinguishable from the issue, which presents the naked question whether there is an intelligible description of the invention, which will enable the public to know what it is. It may help as to understand the present

which require notice to be, that the patentee was not the original and first inventor of the thing patented, *or of a substantial and material part thereof*. This is the issue, that the patent is broader than the invention.

¹ The meaning of the permission to give the statute in evidence is, that the defendant shall be allowed to rely on any matter of law enacted in the statute, without pleading it specially, which must be done when the statute is a private one. The Patent Act is undoubtedly a public act; but from abundant caution, to prevent the question of the nature of the act from being raised, this provision was inserted. *Kneass v. The Schuylkill Bank*, 4 Wash. 9, 11.

² No witness can be examined, to prove a prior use of the invention, unless notice of his name and residence has been given. *The Philadelphia and Trenton Railroad Co. v. Thompson*, 14 Peters, 448, 459.

provision, if we review the corresponding provision in the former act, and the decisions made upon it.

§ 366. The corresponding provision in the act of 1793, § 6, was in the same terms, but that act also provided that, when judgment on this issue had been rendered for the defendant, “the patent shall be declared void” ; which is omitted in the act of 1836, § 15. In one of the earliest reported cases in which this clause of the statute of 1793 came under consideration, Mr. Justice Story held that if the invention is definitely described in the patent and specification, so as to distinguish it from other inventions before known, the patent is good, although it does not describe the invention in such full, clear, and exact terms, that a person skilled in the art or science, of which it is a branch, would construct or make the thing, *unless such defective description or concealment was with intent to deceive the public.* The reasoning of the learned judge in this case tends to show that he considered the defect or concealment, with intent to deceive the public, to refer to the practicability of practising the invention from the specification ; and in a subsequent case he seems to consider that the statute intended to alter the common law, and to declare the patent void, only when the concealment or defect was with such an intent. But it is not quite clear, whether he considered that the issue raised by an allegation that the specification would not enable a workman to make the thing described, is, as a defence to the action, not one of the special defences of the statute, and consequently that it is raised by the plea of not guilty, without notice.¹

¹ *Whittemore v. Cutter*, 1 Gallis. 429, 433 ; *Lowell v. Lewis*, 1 Mas. 182, 187. The reasoning of the learned judge in both these cases was as follows : “ Another objection is to the direction, that the oath taken by the inventor, not being conformable to the statute, formed no objection to the recovery in this action. The statute requires that the patentee should swear ‘ that he is the true inventor or discoverer of the art, machine, or improvement.’ The oath taken by Whittemore was, that he was the true *inventor* or *improver* of the machine.” The taking of the oath was but a prerequisite to the granting of the patent, and in no degree essential to its validity. It might as well have been contended, that the patent was void, unless the thirty dollars, required by the eleventh section of the act, had been previously paid. We approve of the direction of the court on this point, and overrule this objection.

“ Another objection is to the direction respecting the specification. It was as follows : ‘ That if the jury should be satisfied that the specification and drawings, filed by the patentee in the office of the Secretary of State, were not made in

§ 367. In a subsequent case, the Supreme Court of the United States decided that, in order to justify a judgment declaring a patent such full, clear, and exact terms and manner as to distinguish the same from all other things before known, and to enable any person skilled in the art or science, of which it is a branch, or with which it is most nearly connected, to make and use the same, this would not be sufficient to defeat the rights of the plaintiffs to recover in this action, unless the jury were also satisfied, that the specification and drawings were thus materially defective and obscure *by design*, and the concealment made for the purpose of deceiving the public. In this respect our law differed from the law of England, that, if the specification and drawings were thus materially defective, it afforded a presumption of a designed concealment, which the jury were to judge of. That in deciding as to the materiality of the deficiencies in the specification and drawings, it was not sufficient evidence to disprove the materiality, that, by studiously examining such specification and drawings, a man of extraordinary genius might be able to construct the machine, by inventing parts, and by trying experiments. The object of the law was, to prevent the expenditure of time and money in trying experiments, and to obtain such exact directions, that, if properly followed, a man of reasonable skill in the particular branch of the art or science might construct the machine, and if, from the deficiencies, it was impracticable for such a man to construct it, the deficiencies were material.' In order fully to understand the objection to this direction, it is necessary to advert to the third section of the act of 1793, which specifies the requisites to be complied with in procuring a patent, and the sixth section of the same act, which states certain defences, of which the defendant may avail himself to defeat the action, and to avoid the patent. The third section, among other things, requires the party, applying for a patent, to deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most intimately connected, to make, compound, and use the same; and in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle, or character, by which it may be distinguished from other inventions. The sixth section provides, among other things, that the defendant may give in his defence, that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, *which concealment or addition shall fully appear to have been made for the purpose of deceiving the public.*

“ It is very clear that the sixth section does not enumerate all the defences of which the defendant may legally avail himself: for he may clearly give in evidence, that he never did the act attributed to him, that the patentee is an alien not entitled under the act, or that he has a license or authority from the patentee. It is, therefore, argued, that if the specification be materially defective, or obscurely or so loosely worded, that a skilful workman in that particular art could not construct the machine, it is a good defence against the action, although no intentional deception has been practised. And this is beyond all question the doctrine of the common law; and it is founded in good reason; for the monopoly is

ent void, the defect or concealment must appear to have been made for the purpose of deceiving the public; but if the defendant granted upon the express condition, that the party shall make a full and explicit disclosure, so as to enable the public, at the expiration of his patent, to make and use the invention or improvement in as ample and beneficial a manner as the patentee himself. If, therefore, it be so obscure, loose, and imperfect, that this cannot be done, it is defrauding the public of all the consideration upon which the monopoly is granted. (Buller, N. P. 77; *Turner v. Winter*, 1 T. R. 602.) And the motion of the party, whether innocent or otherwise, becomes immaterial, because the public mischief remains the same.

“It is said, that the law is the same in the United States, notwithstanding the wording of the sixth section, for there is a great distinction between a concealment of material parts, and a defective and ambiguous description of all the parts; and that, in the latter case, although there may be no intentional concealment, yet the patent may be avoided for uncertainty as to the subject-matter of it. There is considerable force in the distinction at first view; and yet, upon more close examination, it will be difficult to support it. What is a defective description, but a concealment of some parts, necessary to be known in order to present a complete view of the mechanism? In the present case the material defects were stated, among other things, to consist in a want of a specific description of the dimensions of the component parts, and of the shapes and position of the various knobs. Were these a concealment of material parts, or a defective and ambiguous disclosure of them? Could the legislature have intended to pronounce, that the concealment of a material spring should not, unless made with design to deceive the public, avoid the patent, and yet that an obscure description of the same spring should at all events avoid it? It would be somewhat hazardous to attempt to sustain such a proposition.

“It was probably with a view to guard the public against the injury arising from defective specifications, that the statute requires the letters-patent to be examined by the attorney-general, and certified to be in conformity to the law, before the great seal is affixed to them. In point of practice this must unavoidably be a very insufficient security, and the policy of the provision, that has changed the common law, may be very doubtful. This, however, is a consideration proper before another tribunal. We must administer the law as we find it. And, without going at large into this point, we think that the manifest intention of the legislature was, not to allow any defect or concealment in a specification to avoid the patent, unless it arose from an intention to deceive the public. There is no ground, therefore, on which we can support this objection.” 1 Gallis. 433.

“An objection of a more general cast (and which might more properly have been considered at the outset of the cause, as it is levelled at the sufficiency of the patent itself), is, that the specification is expressed in such obscure and inaccurate terms, that it does not either definitely state in what the invention consists, or describe the mode of constructing the machine so as to enable skilful persons to make one. I accede at once to the doctrine of the authority, which has been cited (*McFarlane v. Price*, 1 Starkie's R. 192), that the patentee is bound to describe, in full and exact terms, in what his invention consists; and, if it be an improvement only upon an existing machine, he should distinguish what is new and what

merely seeks to defend himself, he may do so by showing that the patentee has failed in any of the prerequisites on which the aid is old in his specification, so that it may clearly appear for what the patent is granted. The reason of this principle of law will be manifest on the slightest examination. A patent is grantable only for a new and useful invention; and unless it be distinctly stated in what that invention specifically consists, it is impossible to say whether it ought to be patented or not; and it is equally difficult to know whether the public infringe upon or violate the exclusive right secured by the patent. The patentee is clearly not entitled to include in his patent the exclusive use of any machinery already known; and if he does, his patent will be broader than his invention, and consequently void. If, therefore, the description in the patent mixes up the old and the new, and does not distinctly ascertain for which, in particular, the patent is claimed, it must be void; since, if it covers the whole, it covers too much, and if not intended to cover the whole, it is impossible for the court to say what, in particular, is covered as the new invention. The language of the Patent Act itself is decisive on this point. It requires (§ 3) that the inventor shall deliver a written description of his invention, 'in such full, clear, and exact terms, as to distinguish the same from all other things before known; and in the case of any machine, he shall fully explain the principle, and the several modes, in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions.'

"It is, however, sufficient, if what is claimed as new appear with reasonable certainty on the face of the patent, either expressly or by necessary implication. But it ought to appear with reasonable certainty, for it is not to be left to minute references and conjectures from what was previously known or unknown; since the question is not, what was before known, but what the patentee claims *as new*; and he may, in fact, claim as new and patentable what has been long used by the public. Whether the invention itself be thus specifically described with reasonable certainty, is a question of law upon the construction of the terms of the patent, of which the specification is a part; and on examining this patent I at present incline to the opinion, that it is sufficiently described in what the patented invention consists.

"A question nearly allied to the foregoing, is, whether (supposing the invention itself be truly and definitely described in the patent) the specification is in such full, clear, and exact terms, as not only to distinguish the same from all things before known, but 'to enable any person skilled in the art or science, of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same.' This is another requisite of the statute (§ 3), and it is founded upon the best reasons. The law confers an exclusive patent right on the inventor of anything new and useful, as an encouragement and reward for his ingenuity, and for the expense and labor attending the invention. But this monopoly is granted for a limited term only, at the expiration of which the invention becomes the property of the public. Unless, therefore, such a specification was made as would, at all events, enable other persons of competent skill to construct similar machines, the advantage to the public, which the act contemplates, would be entirely lost, and its principal object would be defeated. It is not necessary, however, that the specification should contain an explanation level with the capacities of

thority to issue a patent depends. This decision made the evidence of fraudulent intent requisite only in the particular case and for the particular purpose of having the patent declared void.¹

every person (which would, perhaps, be impossible); but, in the language of the act, it should be expressed in such full, clear, and exact terms, that a person skilled in the art or science of which it is a branch, would be enabled to construct the patented invention. By the common law, if anything material to the construction of the thing invented be omitted or concealed in the specification, or more be inserted or added than is necessary to produce the required effect, the patent is void. This doctrine of the common law our Patent Act has (whether wisely, admits of very serious doubts) materially altered; for it does not avoid the patent in such case, unless the 'concealment or addition shall fully appear to have been made for the purpose of deceiving the public.' (§ 6.) Yet, certainly, the public may be as seriously injured by a materially defective specification resulting from mere accident, as if it resulted from a fraudulent design. Our law, however, is as I have stated; and the question here is, and it is a question of fact, whether the specification be so clear and full, that a pump-maker of ordinary skill could, from the terms of the specification, be able to construct one upon the plan of Mr. Perkins." 1 Mass. 187.

¹ Grant v. Raymond, 6 Peters, 218, 246. Mr. C. J. Marshall, delivering the judgment of the court in this case, said: "Courts did not, at first, perhaps, distinguish clearly between a defence which would authorize a verdict and judgment in favor of the defendant in the particular action, leaving the plaintiff free to use his patent, and to bring other suits for its infringement; and one which, if successful, would require the court to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. This distinction is now well settled.

"If the party is content with defending himself, he may either plead specially, or plead the general issue, and give the notice required by the sixth section of any special matter he means to use at the trial. If he shows that the patentee has failed in any of those prerequisites on which the authority to use the patent is made to depend, his defence is complete. He is entitled to the verdict of the jury and the judgment of the court. But if, not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity to the sixth section. If he depends on evidence 'tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect,' it may avail him so far as respects himself, but will not justify a judgment declaring the patent void, unless such 'concealment or addition shall fully appear to have been made for the purpose of deceiving the public'; which purpose must be found by the jury to justify a judgment of *vacatur* by the court. The defendant is permitted to proceed according to the sixth section, but is not prohibited from proceeding in the usual manner, so far as respects his defence; except that special matter may not be given in evidence on the general issue unaccompanied by the notice which the sixth section requires. The sixth section is not understood to control the third. The evidence of fraudulent intent is required only in the particular case, and for the particular purpose stated in the sixth section.

§ 368. Now the statute of 1836 omits the provision that the patent shall be declared void, when judgment is rendered for the

“ This instruction was material if the verdict ought to have been for the defendants, provided the allegations of the plea were sustained, and if such verdict would have supported a judgment in their favor, although the defect in the specification might not have arisen from design, and for the purpose of deceiving the public. That such is the law we are entirely satisfied. The third section requires, as preliminary to a patent, a correct specification and description of the thing discovered. This is necessary in order to give the public, after the privilege shall expire, the advantage for which the privilege is allowed, and is the foundation of the power to issue the patent. The necessary consequence of the ministerial character in which the secretary acts, is that the performance of the prerequisites to a patent must be examinable in any suit brought upon it. If the case was of the first impression we should come to this conclusion ; but it is understood to be settled.

“ The act of parliament concerning monopolies contains an exception on which the grants of patents for inventions have issued in that country. The construction of so much of that exception as connects the specification with the patent, and makes the validity of the latter dependent on the correctness of the former, is applicable, we think, to proceedings under the third section of the American act. The English books are full of cases in which it has been held that a defective specification is a good bar when pleaded to, or a sufficient defence when given in evidence on the general issue, on an action brought for the infringement of a patent right. They are very well summed up in Godson's Law of Patents, title Specification ; and also in the chapter respecting the infringement of patents, also in Holroyd on Patents, where he treats of the specification, its form and requisites. It is deemed unnecessary to go through the cases, because there is no contrariety in them, and because the question is supposed to be substantially settled in this country. *Pennock & Sellers v. Dialogue*, 1 Peters, 1, was not, it is true, a case of defect in the specification or description required by the third section, but one in which the applicant did not bring himself within the provision of the first section, which requires that before a patent shall issue, the petitioner shall allege that he has invented a new and useful art, machine, &c., ‘ *not known or used before the application.*’ This prerequisite of the first section, so far as a failure in it may affect the validity of the patent, is not distinguishable from a failure of the prerequisites of the third section.

“ On the trial, evidence was given to show that the patentee had permitted his invention to be used before he took out his patent. The court declared its opinion to the jury, that, if an inventor makes his discovery public, he abandons the inchoate right to the exclusive use of the invention. ‘ It is possible,’ added the court, ‘ that the inventor may not have intended to give the benefit of his discovery to the public.’ But it is not a question of intention, but of legal inference, resulting from the conduct of the inventor, and affecting the interests of the public. It is for the jury to say whether the evidence brings this case within the principle which has been stated. If it does, the court is of opinion that the plaintiff is not entitled to a verdict.’

“ The jury found a verdict for the defendants, an exception was taken to the

defendant, and it leaves the ground of a concealment or addition in the specification, with intent to deceive the public, simply a defence to the action, of a special nature. There can be no doubt, therefore, that when the defendant proposes to show that the specification contains more or less than a true description of the invention, and that the concealment or addition was made for the purpose of deceiving the public, his plea must either be special, setting forth the defects and charging the intent, or it must be the general issue, accompanied by notice of the defects in the specification intended to be relied on. But I do not conceive that the statute means to say that no concealment or defect in a specification shall be available as a defence to the action, under the general issue, unless it was made with intent to deceive the public. The statute may be construed as if it read thus: "Whenever the defendant seeks to show that the specification does not contain the whole truth relative to the invention or discovery, or that it contains more than is necessary to produce the described effect, and that such concealment or addition was made for the purpose of deceiving the public, he may plead the general issue, and give such special matter in evidence, provided he shall have given notice," &c. On the other hand, if the defendant relies on a failure in the specification in respect of any of the prerequisites for issuing a patent, he may show such failure under a plea of the general issue, without any notice.

§ 369. The next special defence mentioned in the statute is, in substance, that the subject-matter is not new; that is, "that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof, claimed as new; or that it had been described in some public work, anterior to the supposed discovery thereof by the patentee."¹

opinion, and the judgment was affirmed by this court. This case affirms the principle that a failure on the part of the patentee, in those prerequisites of the act which authorize a patent, is a bar to a recovery in an action for its infringement; and that the validity of this defence does not depend on the intention of the inventor, but is a legal inference upon his conduct."

¹ When this defence is relied upon, it will be incumbent on the defendant to show that the invention had been known, used, or described in a public work, *anterior to the supposed discovery of the patentee*. The plaintiff's right in his invention, therefore, relates back to the original discovery, which may be proved

§ 370. We have seen, in a former chapter of this work, when a party is or is not the original and first inventor of a patented subject; and also that a failure, in point of novelty, of any substantial and material part of the alleged invention, renders the patent *pro tanto*. In order to ensure the plaintiff against surprise, whenever this defence is to be resorted to, the same section of the statute requires that the defendant "shall state in his notice of special matter, the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same had been used." This provision must be strictly complied with.¹ The statute does not, however, require notice of the *time* when such persons possessed the alleged knowledge and use of the invention.²

§ 371. It is also fairly to be inferred, from the requisition, that notice shall be given of "any special matter" intended to be offered in evidence "tending to prove" the particular defence relied upon, that the notice must describe whether the whole, or a part, and what part of the invention is to be charged with want of novelty, and in what public work or works the whole, or a part, or what part had been described before the supposed discovery by the patentee. There is no limitation of time within which this defence must be set up.³

§ 372. The stringent effect of this defence has been materially modified, however, by two other provisions. The first is contained

by parol, and is not necessarily presumed to have been made on the day when the patent issued; although the infringement must have taken place after the date of the patent. *Dixon v. Moyer*, 4 Wash. 68, 72. The conversations and declarations of a patentee, merely affirming that at some former period he had invented a machine, may well be objected to. But his conversations and declarations, 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, as an inventor, to the extent of the facts and details which he then makes known, although not of their existence at an anterior time. Such declarations, coupled with a description of the nature and objects of the invention, are to be deemed part of the *res gestæ*, and they are legitimate evidence that the invention was then known and claimed by him; and thus its origin may be fixed, at least, as early as that period. *The Philadelphia and Trenton Railroad Co. v. Stimpson*, 14 Peters, 448.

¹ *Ibid.*

² *Phillips v. Page*, 24 How. 164.

³ *Evans v. Eaton*, Peters, C. C. R. 322, 348.

in the two provisions which are found at the end of the same fifteenth section of the act of 1836: “provided that, whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the 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 before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication; *and, provided also*, that whenever the plaintiff shall fail to sustain his action, on the ground that in his specification of claim is embraced more than that of which he was the first inventor, if it shall appear that the defendant had used or violated any part of the invention justly and truly specified, and claimed as new, it shall be in the power of the court to adjudge and award, as to costs, as may appear to be just and equitable.”

In a recent case, *Forbush v. Cook*,¹ the defendants were allowed to introduce evidence tending to show that the plaintiff had had direct knowledge of two foreign machines, one of which had been patented and described in a printed publication, but the other not, previous to his obtaining his own patent. *Per contra*, in *Beard v. Egerton*,² a plea that the invention was communicated to the patentee by a foreigner was held bad on demurrer, inasmuch as such an allegation was no denial of the plaintiff's right as true and first inventor *within the realm*, under the statute 21 Jac. 1, ch. 3. Also the plea that the real inventor had assigned his whole interest to the King of France, who had dedicated the same to the French public. The English patentee in this case was really nothing more than the agent and trustee of the inventor.³

§ 373. The other provision is contained in the act of March 3, 1837, § 7, 9, in relation to a disclaimer. The seventh section enacts as follows: “That, whenever any patentee shall have, through inadvertence, accident, or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material and substantial part of

¹ 20 Mon. Law Rep. 664.

² 3 Mann. Gr. & Scott, 97.

³ For a discussion of the specification itself, see s. c., 8 Mann. Gr. & Scott, 165; and 2 Carr. & Kirwan, 667.

the thing patented being truly and justly his own, any such patentee, his administrators, executors, and assigns, whether of the whole or of a sectional interest therein, may make disclaimer of such parts of the thing patented as the disclaimer shall not claim to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; which disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, on payment, by the person disclaiming in manner as other patent duties are required by law to be paid, of the sum of ten dollars. And such disclaimer shall thereafter be taken and considered as part of the original specification, to the extent of the interest which shall be possessed in the patent or right secured thereby, by the disclaimant, and by those claiming by or under him subsequent to the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing the same."

§ 374. The ninth section is as follows: "Be it further enacted, anything in the fifteenth section of the act to which this is additional to the contrary, notwithstanding, that, whenever by mistake, accident, or inadvertence, and without any wilful default, or intent to defraud or mislead the public, any patentee shall have 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 first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be deemed good and valid for so much of the invention and discovery as shall be truly and *bonâ fide* his own: *Provided*, it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid. And every such patentee, his executors, administrators, and assigns, whether of the whole or a sectional interest therein, shall be entitled to maintain a suit at law or in equity on such patent for any infringement of such part of the invention or discovery as shall be *bonâ fide* his own, as aforesaid, notwithstanding the specification may embrace more than he shall have any legal right to claim. But, in every such case in which a judgment or verdict shall be rendered for the plaintiff, he shall not be entitled to recover costs against the defendant, unless

he shall have entered at the Patent Office, prior to the commencement of the suit, a disclaimer of all that part of the thing patented which was so claimed without right ; *Provided, however,* that no person bringing any such suit shall be entitled to the benefit of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer as aforesaid.”¹

§ 375. The result of these various enactments is, that for so much of the invention as has been described in some public work anterior to the supposed discovery by the patentee, whether the description was known to him in point of fact or not, — if it be a substantial and material part of the thing invented, and be claimed as new, — and for so much as had been previously patented, the patent is inoperative. But the mere previous knowledge or use of the thing in a foreign country will not defeat a patent here, issued to an original inventor, provided it had not been previously patented or described in a printed publication.

§ 376. It will be observed that the same statute uses different phraseology in describing the kind of publication which is to have this effect. In the body of the fifteenth section of the act of 1836, it is declared to be a description in “some public work” ; and in the proviso of the same section it is declared to be “any printed publication.” This renders it somewhat doubtful, as to what kind of publication is intended. The phrase “some public work” would seem to point to a class of regular, established publications, or to some book, publicly printed and circulated, so as to be open to the public ; while the phrase “any printed publication,” is broad enough to include any description printed in any form and pub-

¹ In *Reed v. Cutter*, 1 Story, 590, 600, Mr. Justice Story said : “ In respect to another point, stated at the argument, I am of opinion that a disclaimer, to be effectual for all intents and purposes, under the act of 1837, ch. 45 (§ 7 and 9), must be filed in the Patent Office before the suit is brought. If filed during the pendency of the suit, the plaintiff will not be entitled to the benefit thereof in that suit. But if filed before the suit is brought, the plaintiff will be entitled to recover costs in such suit, if he should establish at the trial that a part of the invention, not disclaimed, has been infringed by the defendant. Where a disclaimer has been filed, either before or after the suit is brought, the plaintiff will not be entitled to the benefit thereof if he has unreasonably neglected or delayed to enter the same at the Patent Office. But such an unreasonable neglect or delay will constitute a good defence and objection to the suit.”

lished or circulated to any extent and in any manner. Taking the whole section together, however, and looking to the apparent policy of the statute, it is probable that the intention of Congress was to make it a conclusive presumption that the patentee had seen any printed description of the thing, which had been so printed and published as to be accessible to the public; but not to adopt that presumption in cases of printed descriptions published and circulated in such a manner as not to be accessible either to the public or to him. If the presumption were adopted in cases of the latter class of publications, an original and meritorious inventor might be defeated of his patent, by showing that the thing had, in a foreign country been privately described in a printed paper published to a single individual; which certainly would not be a description in a "public work," although it would be a description in a "printed publication." When it is considered that the statute excepts cases even where the thing had been known or used abroad, provided it had not been patented or described in any printed publication, it seems reasonable to suppose that the publication intended is one to which the public could have access; and this construction is fortified by the consideration that the defence enacted in this section, to which the proviso establishes the exception is, that the thing had been described in "some public work."¹

If this be so, it would seem to be a question for the jury, under all the circumstances under which the publication has taken place, to determine whether the description was so printed and published as to be accessible to the public, where the publication took place. If it was so accessible, the presumption is against the patentee, and his patent will be defeated, notwithstanding he may not have seen it; because the description was already in the possession of the public.

¹ The statute of 1799, § 6, used only the phrase "described in some public work," and did not contain the proviso introduced into the act of 1836. Marshall, C. J., in *Evans v. Eaton*, 3 Wheat. 454, 514, commenting on the former statute, said: "It may be that the patentee had no knowledge of this previous use or previous description; still his patent is void; *the law supposes he may have known it.*" It is, therefore, by adopting a presumption of knowledge, that the law declares the patent void. But there could be no reason or justice in adopting such a presumption, in cases where the printed description had not come into the possession of the public; and it is manifest that the former statute did not mean to adopt it in such cases, since it uses only the phrase "public work."

Upon this question of description by publication, the very recent case of *Lang v. Gisborne*¹ has elicited an elaborate ruling of the Master of the Rolls. It appeared from the evidence that, in a book published at Paris in 1857, a plan for an electric target was described as having been then invented by a M. De Brettes, which plan was identical with that of the plaintiff's in the suit. It also appeared that a M. Ballière, bookseller in London, had sold one copy of the book to Dr. Wheatstone, another to the Cambridge University Library, a third to Dr. Richardson, and a fourth to some unknown party. The ruling, though made in an injunction suit, seems equally applicable to an action at law. The M. R. said: "Before I finally dispose of this case, I propose to read through the affidavits; but I will now state my view of the law, and also the general view which I take of the evidence. In the first place, I will state the law of the case as I take it to be, and as I should have instructed a jury, had I the jury before me. I will assume, for the present, that De Brettes's plan, described by the Vicomte du Moncel, is, in fact, identical with that of the plaintiff's. That plan appears to have been published in a book in Paris towards the end of December, 1857. That book was sent over to this country, and four copies of it were sold here: one on 31st December, 1857, to Professor Wheatstone; one on 6th May following to the library of the University of Cambridge; one on 21st August, 1858, to Dr. Richardson at Newcastle; and a fourth on 30th March, 1859, to some one whose name is not known. All these sales were made previous to the provisional and complete specification of the plaintiff's patent. Now, in my opinion, there are two modes by which an invention can be made public: the one is by a publication in fact or by user, such as that by the user alone the invention becomes a part of the general stock of public information; the other is by what is termed a publication in law. Upon these two modes of publication the authorities seem to establish this, that the requisition that an invention shall be made a part of the general stock of public information, applies to cases where some one has used the invention either for the purpose of experiments or as a complete and perfect invention. In such cases it is no doubt very difficult to draw the line between the user of the invention as a mere experiment, and user of the invention in a complete state; that is, in such a state as that the inventor thinks

¹ 6 Law Times, n. s. 771.

he can then make no further addition to it. It is, however, to that class of cases that, in my opinion, the authorities refer. Now I think that there is a publication in law of an invention in this country, when the inventor of it makes, either by himself or his agent, a written description of it, puts that into a book, and sends that to a bookseller here, to be published by him. It is not necessary to prove, further, that any one volume of the book has been sold ; for, according to the view which I have stated, the moment that the book is exposed in the publisher's shop for the purpose of sale, then there is in law a complete publication of the invention. I wish to state this view as broadly as I can, because, if this case should go further, it is very desirable that there should be no mistake as to my opinion of what the law is. Well, then, that is how the matter would stand, assuming the inventor to be an Englishman. But, assuming him to be a Frenchman, or any other foreigner, would the case be different ? I think not. I think that if a foreigner writes a book in his own language, describing an invention of his, and hands it over to an English bookseller for the purpose of its being sold here, so soon as the book arrives here and is offered for sale in the public shop of the bookseller, then (assuming, of course, that the description of the invention is accurate) there is in law a publication of the invention. To come to any other conclusion would, in my opinion, lead to the most inextricable confusion. For instance, it would obviously be most difficult, if not impossible, to explain who or how many persons had actually bought the book ; and then again, the buying might be nothing if they had not read it. Who could say to how many persons the purchaser might have lent it, and of those persons who could say how many had read it ? In the present case it is proved by the evidence that one of our large public libraries (that of the University of Cambridge) actually bought a copy of the Vicomte de Moncel's work. It may, therefore, well be that a thousand persons may have read it and considered De Brettes's invention before that of the plaintiff's was made ; but how can that be proved ? The courts would be involved in the most inextricable difficulties, if the onus of proof in such cases was thrown on the person who had made public an invention so far as he could do so, to show that the public had appreciated it by purchasing the book or making it common to others who had not actually purchased it. I am of opinion, therefore, that there was,

in this case, a complete publication in law in this country of De Brettes's plan, as contained in the Vicomte de Moncel's book, in December, 1857, when it was offered for sale here."

A similar doctrine has been put forth by the Common Pleas, in the case of *Stead v. Williams*.¹ At the jury trial, Creswell, J. had given the following instructions: "But then the defendants do not bring home to the plaintiff the fact of his having seen any of these publications, and it is for you to judge, upon the whole of the matter, whether you think that he had seen those publications and had derived his information from the stock of knowledge previously given to the public of this country, or whether he derived it from some person residing abroad, and therefore having a source of information which is considered as equivalent to his own invention." The defendants then moved for a new trial on the ground of improper instruction. Tindal, C. J., in granting the motion, said: "We think, if the invention has already been made public in England, by a description contained in a work, whether written or printed, which has been publicly circulated, in such case the patentee is not the first and true inventor, within the meaning of the statute, whether he has himself borrowed his invention from such publication or not; because we think the public cannot be precluded from the right of using such information as they were already possessed of at the time the patent was granted. It is obvious that the application of this principle must depend upon the particular circumstances which are brought to bear on each particular case. The existence of a single copy of a work, though printed, brought from a depository where it has long been kept in a state of obscurity, would afford a very different inference from the production of an Encyclopædia or other work in general circulation. The question will be, whether, upon the whole evidence, there has been such a publication as to make the description a part of the public stock of information."

§ 377. The book must not only be specified, but the place in the book in which the alleged description is to be found. Thus, where the defendant specified in his notice that the invention claimed by the plaintiff was described in Ure's Dictionary of Arts, &c., and had been used by Andrew Ure of London, it was held

¹ 2 Webs. Pat. Cas. 137, 142.

not to be competent to the defendant to give the dictionary in evidence, no specification having been given of the place in the book where the description might be found ; and also, that as the notice did not state the place where Andrew Ure had used the invention, the book was not competent evidence that Andrew Ure of London had a prior knowledge of the thing patented.¹

¹ *Silsby v. Foote*, 14 How. 218: "The notice given in the case was as follows: 'The patentee was not the original and first inventor or discoverer of a substantial and material part thereof, claimed as new. That it had been described in a public work called "Ure's Dictionary of Arts, Manufactures, and Mines," anterior to the supposed invention thereof by the patentee ; and also had been in public use and known before that time and used by Andrew Ure of London, the late M. Bonnemair of Paris, and George H. McCleary of Seneca Falls, New York.'

"Ure's Dictionary contains upwards of thirteen hundred pages, and the articles which the defendants offered to read were entitled Thermostat and Heat Regulator. The first question is, whether this was a sufficient notice of the special matter, tending to prove that the thing patented or some substantial part thereof, claimed as new, had been described in a patented publication. We are of opinion it was not. The act does not attempt to prescribe the particulars which such a notice shall contain. It simply requires notice. But the least effect which can be allowed to this requirement is, that the notice should be so full and particular as reasonably to answer the end in view. This end was, not merely to put the patentee on inquiry, but to relieve him from the necessity of making useless inquiries and researches, and enable him to fix with precision upon what is relied on by the defendants and to prepare himself to meet it at the trial. This highly salutary object should be kept in view, and a corresponding disclosure enacted from the defendant of all those particulars which he must be presumed to know, and which he may be safely required to state, without exposing him to any risk of losing his rights. Less than this would not be reasonable notice, and therefore would not be such a notice as the act must be presumed to have intended.

"Now, we do not perceive that the defendants would be exposed to the risk of losing any right, by requiring them to indicate in their notice what particular things, described in the printed publication, they intended to aver were substantially the same as the thing patented. This they might have done either by reference to pages or titles, and perhaps in other ways, for the particular manner in which the things referred to are to be identified must depend much upon the contents of the volume and their arrangement. It has been urged that a defendant may not have access to the book in season for the notice. But it must be remembered that, some considerable time before it is necessary to give such notice, the defendant has begun to use the thing patented, which *primâ facie* he has no right to use, and it would seem to be no injustice or hardship to expect him, before he begins to infringe, to ascertain that the patentee's title is not valid, and, if its invalidity depends upon what is in a public work, that he should inform himself what that work contains, and, consequently, how to refer to it. We do not think it necessary so to construe this act, designed for the benefit of patentees, as to enable the defendant to do, — what we fear is too often done, — infringe first, and look for defence afterwards.

§ 378. What, then, constitutes a "description"? No judicial construction has yet been given to this term. It can scarcely be supposed, however, that a mere suggestion of the possibility of constructing the machine, or other thing, which may have been subsequently patented, is what the statute intends. The reason why the statute adopts the presumption of knowledge, on the part of the subsequent patentee, is, that a knowledge of the thing was already in the possession of the public. It makes knowledge and the means of knowledge on the part of the public the same thing; and, acting upon this principle, it holds that the public have acquired nothing from the specification of the patentee which they did not possess before, and that the patentee has invented nothing which he, as one of the public, could not have derived from the means of knowledge which the public before possessed.¹ Hence it is, that the production of a prior description, which was in the possession of the public, negatives the title of the patentee as the first inventor. But it follows necessarily, from this view of the principle on which the law proceeds; that the description must be such as to give the public the means of knowledge, or, in other words, must of itself enable the public to practise the invention. It is not necessary that the invention should have been reduced to practice; but unless the description would enable the public, with-

"Nor does a notice that, somewhere in a volume of thirteen hundred pages, there is something which tends to prove that the thing patented, or some substantial and material part thereof, claimed as new, had been described therein, relieve the patentee from the necessity of making fruitless researches, to enable him to fix with reasonable certainty on what he must encounter at the trial. Upon this ground, therefore, the exception cannot be supported.

"But it is further urged, that the book ought to have been admitted as evidence that Andrew Ure of London had prior knowledge of the thing patented. This view cannot be sustained. For, although the name of Andrew Ure of London is contained in the notice of persons who are alleged to have had this prior knowledge, yet the defendants have not brought themselves within the act of Congress, because the notice did not state 'where the same was used' by Andrew Ure. Besides, inasmuch as the same section of the statute provides that a prior invention in a foreign country shall not avoid a patent, otherwise valid, unless the foreign invention had been described in a printed publication, the defendants are thrown back upon that clause of the act which provides for that defence arising from a printed publication which has already been considered." Per Curtis, J.

Compare *Jones v. Berger*, 5 Mann. & Grang. 208, for a construction of the somewhat similar statutory rule contained in 5 & 6 W. IV. ch. 83, § 5.

¹ A man cannot be said to be the inventor of that which has been exposed to public view, and which he might have had access to if he had thought fit. Lord Abinger, C. B., in *Carpenter v. Smith*, Webs. Pat. Cas. 535.

out further invention, to put the thing in practice, it cannot be said that a knowledge of that thing is in the possession of the public. Accordingly, it has been laid down by two eminent writers on the patent law, that the description which is to have the effect of defeating a subsequent patent, ought to approach the character, and in some degree to answer the purposes, of a specification, by serving as a direction for making, doing, or practising the thing which is the subject of the patent.¹ But mere speculations or suggestions of an experimental kind, not stated in such a way as to serve for a practical direction, are entirely analogous in their character to abortive and unsuccessful experiments in practice. The Marquis of Worcester's Century of Inventions contained many hints and speculations, on which subsequent inventors have acted; but, as they were the mere speculations of an ingenious man, not reduced by him to practice, and not so stated that the statement would answer for a rule of working, without the exercise of invention on the part of the public, they have not been held to have defeated the patents to which they gave rise.²

§ 378 *a*. Where the defence relied upon to defeat the novelty of the plaintiff's invention is the specification of a patent granted to some third party prior to the plaintiff's obtaining his own patent, the question arises, whether such specification must be so full and clear as to sustain the patent granted therefor, or whether, although incomplete itself, it will still be sufficient to show a want of novelty in any subsequent patent, if it contain a mere hint of the invention for which that subsequent patent was granted. This question has

¹ Phillips on Patents, p. 175. Mr. Webster (Pat. Cas. 719, note) says: "But whatever may be the peculiar circumstances under which the publication takes place, the account so published, to be of any effect in law as a publication, must, on the authority of the principal case, be an account of a complete and perfect invention, and published as such. If the invention be not described and published as a complete, perfected, and successful invention, but be published as account of some experiment, or by way of suggestion and speculation, as something which, peradventure, might succeed, it is not such an account as will vitiate subsequent letters-patent. It would appear to be a test not wholly inapplicable to cases of this nature, to inquire whether what is so published would be the subject of letters-patent, because, inasmuch as that which rests only in experiment, suggestion, and speculation, cannot be the subject of letters-patent, it would be unreasonable that what could not be the subject of letters-patent, supposing letters-patent granted in respect thereof, should vitiate letters-patent properly granted."

² See the observations of Lord Abinger, C. B., in *Carpenter v. Smith*, Webs. Pat. Cas. 534.

been ably and exhaustively treated in several leading English cases, and the House of Lords has decided that it is *not* sufficient that such prior specification contain a mere hint of the process contained in the subsequent one.¹

Lord Chancellor Westbury, in moving the vote of the House, said: "My lords, I pass on to the next conclusion which is involved in the answer of the learned judges to your lordships' question, and that conclusion is, I think, also of great importance to the law of patents, because it results from an opinion that an antecedent specification ought not to be held to be an anticipation of a subsequent discovery, unless you have ascertained that the antecedent specification discloses a practicable mode of producing the result which is the effect of the subsequent discovery. My lords, here we attain at length to a certain, undoubted, and useful rule; for the law laid down with regard to the interpretation of an antecedent specification is equally applicable to the construction to be put upon publications or treatises previously given to the world, and which are frequently brought forward for the purpose of showing that the invention has been anticipated. The effect of this opinion I take to be this, — if your lordships shall affirm it, — that a barren, general description, probably containing some suggestive information, or involving some speculative theory, cannot be considered as anticipating, and therefore avoiding for want of novelty, a subsequent specification or invention, which involves a practical truth productive of beneficial effects, unless you ascertain that the antecedent publication involves the same amount of practical and useful information. Now, my lords, it will be evident, upon a comparison of the two specifications, that the one was a mere general suggestion, while the other is a specific, definite, practical invention. It is possible that a suggestion, such as that contained in the one, may lead to the discovery contained in the other. But it is the latter alone which does really add to the amount of useful knowledge; it is the latter alone which, by its practical operation, confers a benefit upon mankind, within the meaning of the patent law. In the present case there was not only no evidence that what was contained in Dobb's specification was capable of practical operation, but in reality that conclusion was negatived by the verdict of the jury. Therefore, my lords, concurring, as I entirely do, in the conclusions which have been

¹ *Betts v. Menzies*, 7 Law Times, N. S. 110; 4 Best v. Smith, Q. B. 996.

arrived at by the judges in answer to the second question, it results, as a necessary consequence, that the decision of the Court of Queen's Bench and of the Court of Exchequer Chamber ought to be reversed, and that the rule nisi, made absolute by the Court of Queen's Bench, ought to be discharged." The House of Lords voted, as here moved, reversing thereby the judgment appealed from,¹ and modifying the decision rendered in *Bush v. Fox*,² and sustaining *Hill v. Evans*,³ where the Lord Chancellor had ruled as follows: "If appeal be made to an antecedently published book or specification, the question is, what is the nature and extent of the information thus acquired which is necessary to disprove the novelty of the subsequent patent? There is not, I think, any other general answer that can be given to the question than this, that the information as to the alleged invention, given by the prior publication, must, for the purpose of practical utility, be equal to that given by the subsequent patent. The invention must be shown to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication. Apparent generality, or a proposition not true to its full extent, will not prejudice a subsequent statement which is limited, accurate, and a specific rule of practical application. The reason is manifest, because much further invention, and therefore much further discovery, are required before the real truth can be extricated and embodied in a form to serve the uses of mankind. It is the difference between the ore, and the refined and pure metal which is extracted from it. Again, it is not in my opinion true in these cases to say that knowledge and the means of obtaining knowledge are the same. There is a great difference between them. To carry me to the place at which I wish to arrive is very different from merely putting me on the road that leads to it. There may be a latent truth in the words of a former writer not known even to the writer himself, and it would be unreasonable to say that there is no merit in discovering and unfolding it to the world. Upon principle, therefore, I conclude that the prior knowledge of an invention, to avoid a patent, must be knowledge

¹ 8 Ell. & Blackb. 923.

² 38 E. L. & Eq. 1.

³ 6 Law Times, n. s. 90.

equal to that required to be given by a patent, namely, such knowledge as will enable the public to perceive the very discovery and to carry the invention into practical use.”

The result of these recent cases would accordingly seem to be that prior specifications are, in this respect, to be construed by the same principles as other publications.

§ 379. The defendant, therefore, — to return to the consideration of this defence, — who gives notice of the statute defence of want of novelty, will not be defeated in it, if he proves a material part of the invention to have been known or used before the discovery by the patentee, provided he shows that the specification was made broader than the real discovery of the plaintiff, with “wilful default or intent to defraud or mislead the public.” But if it was made broader than the real discovery, through accident or inadvertence, the patent will still be good, and an action may be maintained for so much of the invention or discovery as is *bonâ fide* the invention or discovery of the patentee, provided it is a material and substantial part of the thing patented, and is definitely distinguishable from the other part which the patentee had no right to claim; unless there has been an unreasonable neglect or delay to file the disclaimer.¹ The question whether there has been unreasonable negligence or delay in entering a disclaimer is one which goes to the right of action, so that the *jury* may, on finding great negligence, say that the patent is void. This applies, however, only to the case where the part wrongly claimed by the patentee is a material and substantial part of the thing patented.²

¹ It seems that the ninth section was intended to cover inadvertences and mistakes of law, as well as of fact; and, therefore, a claim of an abstract principle would be within its provisions. *Wyeth v. Stone*, 1 Story’s R. 273, 295. See further as to Disclaimer, *ante*.

² *Hall v. Wiles*, 2 Blatchf. 194, pr Nelson, J. Yet in another case, *Seymour v. McCormick*, 19 How. 96, the same judge, in giving the judgment of the Supreme Court, says: “In regard to the question of unreasonable delay in making the disclaimer, as going to the whole cause of action, the court are of opinion that the granting of the patent for this improvement, together with the opinion of the court below, maintaining its validity, repel any inference of unreasonable delay in correcting the claim; and that, *under the circumstances, the question is one of law*. This was decided in the case of *O’Reilly v. Morse*, 15 How. 121. The Chief Justice, in delivering the opinion of the court, observed that ‘the delay in entering it (the disclaimer) is not unreasonable, for the objectionable claim was sanctioned by the head of the office; it has been held valid by a Circuit Court, and

No costs, however, can be recovered in such an action, unless the plaintiff, before bringing his action, has filed in the Patent Office a disclaimer of all that part of the thing patented which his original specification should not have claimed. If the disclaimer is filed before the action is brought, but the entry of it at the Patent Office has been unreasonably neglected or delayed, the defence of a want of novelty in any material respect, from whatever cause the defect in the original specification arose, will be admitted as a bar to the action; and the question of unreasonable neglect or delay will be a question of law for the court.¹

§ 380. Care is to be taken, therefore, in framing this defence, to ascertain, in the first place, whether the whole or only a part of the substance of the thing patented is open to the objection of prior use or knowledge; and, in the second place, whether a disclaimer has been filed. If a disclaimer has been filed in reasonable time, the defence of a want of novelty, that goes only to a part of the thing patented, and still leaves a material and substantial part unaffected by the objection, will not be an answer to the action, but will simply prevent the recovery of costs. But a defence which goes to the originality of the whole patent, and leaves nothing new that is material and substantial, and capable of distinction as the subject-matter of the plaintiff's invention, will be an answer to the action, notwithstanding any disclaimer. It is obviously necessary, therefore, to specify in the notice of defence the particular parts of the thing patented which it is intended to attack.²

differences of opinion in relation to it are found to exist among the justices of this court. Under such circumstances the patentee had a right to insist upon it and not disclaim it until the highest court to which it could be carried had pronounced its judgment.'” But in the trial in the Circuit Court (3 Blatchf. 209), from which the above-cited appeal was taken, Judge Nelson used the following language: “If the *jury* are satisfied that there has been unreasonable negligence and delay on the part of the patentee in making a disclaimer as respects the invalid part of his patent, then the whole patent is inoperative, and the verdict must be for the defendant.”

¹ McCormick v. Seymour, 3 Blatchf. 209; Seymour v. McCormick, 19 How. 96; Silsby v. Foote, 20 How. 378.

² See, further, an elaborate construction of the seventh and ninth sections, as to a disclaimer, in the opinion of Mr. Justice Story, in the case of Wyeth v. Stone, 1 Story's R. 273.

§ 380 *a*. It may be well to add, by way of concluding the discussion of this statutory defence, that, although the statute requires notice to be given of any matter relied upon to defeat the patentee's claim on the ground of want of novelty, it does not prescribe any notice, previous to the admission of evidence, merely going to show the general state of the art at the time when the plaintiff made his invention. The distinction is, accordingly, to be drawn between evidence introduced for the purpose of defeating the patentee's claim and such as is offered by way of explanation. Thus in the case of *Vance v. Campbell*,¹ which turned chiefly upon the question of infringement, Nelson, J., rendering the opinion of the Supreme Court, says: "Several exceptions were taken to the admissibility of evidence offered by the defendants; but without referring to them specially, it will be a sufficient answer to say, that it was competent and relative, as showing the state of the art in respect to improvements in the manufacture of cooking-stoves at the date of plaintiff's invention. No notice was necessary in order to justify the admission of evidence for this purpose."

§ 381. Another of the statute defences is, that the patentee had allowed his invention to become public, before his application for a patent, or, as it is expressed in the statute, that it "had been in public use, or on sale, with the consent or allowance of the patentee, before his application for a patent." This provision is intended to embody the defence of an abandonment or dedication to the public of his invention by the patentee, prior to his application for a patent. The question whether a patentee, by any and what degree of use of his invention before his application for a patent, could use his inchoate right in the thing invented, and not be able afterwards to resume it at his pleasure, arose before the statute of 1836 was passed, and the Supreme Court of the United States declared that an inventor might undoubtedly abandon his invention, and surrender or dedicate it to the public; and that the question which generally arises is, whether the acts or acquiescence of the party, furnish, in the given case, satisfactory proof of such an abandonment or dedication to the public. The court held that the true construction of the then existing law was, that the first inventor cannot acquire a good title to a patent, if he suffers the

¹ 1 Black, 427.

thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent; that such a voluntary act, or acquiescence in the public sale or use, is an abandonment of his right; or rather creates a disability to comply with the terms and conditions of the law, on which alone the public officer is authorized to grant a patent.¹ In a more recent case, the same court reaffirmed this construction of the patent laws, and held that the right of an alien patentee was vacated in the same manner by a foreign use or knowledge of his invention, under the then existing statutes.²

§ 382. It was the object of the clause now under consideration to make this defence of a prior abandonment or dedication to the public available under the general issue, upon notice of the facts intended to be proved. By "public use" is meant use in public; that is to say, if the inventor himself makes and sells the thing to be used by others, or it is made by one other person only, with his knowledge and without objection, before his application for a patent, *a fortiori*, if he suffers it to get into general use, it will have been in "public use."³ But where the patentee alone makes the thing for the purposes of experiment and completion, without selling it to be used by others, the term "public use" is not applicable.⁴

§ 383. An important question next arises, as to what will constitute proof of the "consent and allowance" of the patentee to the "public use or sale" of his invention before his application. In the first place, a knowledge of such public use or sale by others, without objection on his part, will go far towards raising the presumption of an acquiescence, and in some cases will be a sufficient proof of it. The question in such cases is as to his consent; and if knowledge of the use of his invention by others is brought home to him, and no exclusive right has been asserted by him against that use, his silence will furnish very strong evidence that he has waived his right.⁵ If the evidence shows a long acquiescence, or a very general use, it will be conclusive.⁶

¹ Pennock v. Dialogue, 2 Peters, 1.

² Shaw v. Cooper, 7 Peters, 292.

³ Pennock v. Dialogue; Shaw v. Cooper; Mellus v. Silsbee, 4 Mas. 108.

⁴ Shaw v. Cooper.

⁵ Mellus v. Silsbee.

⁶ Ibid.; Shaw v. Cooper.

§ 384. In the second place, although acquiescence cannot be presumed without knowledge, such knowledge may be presumed from the circumstances, and is not always required to be proved by direct evidence.¹

§ 385. In the third place, no particular lapse of time is necessary to be shown, after knowledge and acquiescence are established, in order to prove an abandonment or dedication to the public. In one of the cases the invention was made in the year 1804, and suffered to go into general use without any claim of an exclusive right, or any objection, and without receiving any compensation, until the year 1822.² In another case, the invention was completed in 1811, and the letters-patent were obtained in 1818; in the interval, a single individual had made and publicly sold large quantities of the thing patented, under an agreement with the inventor as to price.³ In a third case, the inventor, who was a foreigner, came to this country in 1817, and might lawfully have applied for a patent in 1819, but did not do so until three years afterwards. It appeared that he invented the instrument in 1813 or 1814, and made it known to certain persons in England, by or through whom, contrary to his intention, it was publicly used and sold there.⁴ In a fourth case, in England, the patentee had sold the article in the public market four months before the date of the patent.⁵ In all these cases the patentee was held to have abandoned or dedicated to the public his right in the invention.

§ 386. But, on the other hand, it is a still further question, what constitutes a public use, with the consent or allowance of the patentee. What acts, in other terms, within a longer or shorter period of time, or what permission to use, granted or allowed to several persons, or restricted to a single instance, or what use by the patentee himself, will amount to an abandonment or dedication to the public? Is the intention with which the acts are done, or the use permitted, an element in the question, or is the intention wholly immaterial, provided certain acts are done, or a certain use

¹ *Shaw v. Cooper*, 7 Peters, 292, 321.

² *Mellus v. Silsbee*, 4 Mas. 108.

³ *Pennock v. Dialogue*, 2 Peters, 1.

⁴ *Shaw v. Cooper*.

⁵ *Wood v. Zimmer*, 1 Holt, N. P. C. 60.

is permitted? In determining these questions, it is necessary to discriminate between the cases of a use permitted to others, or of a knowledge imparted to others, and the exercise or practice of the invention by the patentee himself.

§ 387. In the case of *Shaw v. Cooper*, already referred to, the Supreme Court of the United States said that the intention of the inventor is not the true ground in these cases; that “whatever may be his intention, if he suffers the invention to get into public use, through any means whatsoever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent obtained under such circumstances protect his right.”¹ The meaning of this obviously is, that no matter what the intention of the patentee was, in imparting to another a knowledge of his invention, if the person or persons, to whom he had so imparted it, afterwards, though fraudulently, use the invention in public, and the patentee looks on without objection, or assertion of his right, the public will have become possessed of the invention, and the patentee cannot resume his right in it by obtaining a patent. This meaning is apparent from other parts of the opinion in the same case; for the court say, that if the invention has become known to the public through fraudulent means, the patentee should assert his right immediately, and take the necessary steps to legalize it.² So, too, it is apparent from the opinion of the same court, in

¹ 7 Peters, 292, 323.

² “Vigilance is necessary to entitle an individual to the privileges secured under the patent law. It is not enough that he should show his right by invention, but he must secure it in the mode required by law. And if the invention, through fraudulent means, shall be made known to the public, he should assert his right immediately, and take the necessary steps to legalize it.

“The patent law was designed for the public benefit, as well as for the benefit of inventors. For a valuable invention the public, on the inventor’s complying with certain conditions, give him, for a limited time, the profits arising from the sale of the thing invented. This holds out an inducement for the exercise of genius and skill in making discoveries which may be useful to society and profitable to the discoverer. But it was not the intention of this law to take from the public that of which they were fairly in possession.

“In the progress of society the range of discoveries in the mechanic arts, in science, and in all things which promote the public convenience, as a matter of course, will be enlarged. This results from the aggregation of mind, and the diversities of talents and pursuits, which exist in every intelligent community. And it would be extremely impolitic to retard or embarrass this advance by withdrawing from the public any useful invention or art, and making it a subject of private

Pennock v. Dialogue, that it is the voluntary acquiescence of the inventor in the *public use*, and not his voluntarily imparting the monopoly. Against this consequence the legislature have carefully guarded, in the laws they have passed on the subject. It is undoubtedly just that every discoverer should realize the benefits resulting from his discovery, for the period contemplated by law. But these can only be secured by a substantial compliance with every legal requisite. His exclusive right does not rest alone upon his discovery, but also upon the legal sanctions which have been given to it, and the forms of law with which it has been clothed.

“ No matter by what means an invention may be communicated to the public before the patent is obtained ; any acquiescence in the public use, by the inventor, will be an abandonment of his right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time could give it validity. But the public stand in an entirely different relation to the inventor. The invention passes into the possession of innocent persons, who have no knowledge of the fraud, and, at a considerable expense, perhaps, they appropriate it to their own use. The inventor or his agent has full knowledge of these facts, but fails to assert his right ; shall he afterwards be permitted to assert it with effect ? Is not this such evidence of acquiescence in the public use, on his part, as justly forfeits his right ?

“ If an individual witness a sale and transfer of real estate, under certain circumstances, in which he has an equitable lien or interest, and does not make known this interest, he shall not afterwards be permitted to assert it. On this principle it is, that a discoverer abandons his right, if, before the obtainment of his patent, his discovery goes into public use. His right would be secured by giving public notice that he was the inventor of the thing used, and that he should apply for a patent. Does this impose anything more than reasonable diligence on the inventor ? And would anything short of this be just to the public ? The acquiescence of an inventor in the public use of an invention can in no case be presumed, when he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. This will, in general, be a fact for the jury. And if the inventor do not, immediately after this notice, assert his right, it is such evidence of acquiescence in the public use, as forever afterwards to prevent him from asserting it. After his right shall be perfected by a patent, no presumption arises against it from a subsequent use by the public.

“ When an inventor applies to the department of state for a patent, he should state the facts truly ; and indeed he is required to do so, under the solemn obligations of an oath. If his invention has been carried into public use by fraud, but for a series of months or years he has taken no steps to assert his right, would not this afford such evidence of acquiescence as to defeat his application, as effectually as if he failed to state that he was the original inventor. And the same evidence which should defeat his application for a patent would, at any subsequent period, be fatal to his right. The evidence he exhibits to the department of state is not only *ex parte*, but interested ; and the questions of fact are left open, to be controverted by any one who shall think proper to contest the right under the patent.

“ A strict construction of the act, as it regards the public use of an invention

knowledge to the person who fraudulently or otherwise uses it in public, that fastens upon him the presumption of a dedication.¹ It is also clear, that when the act or acts of user were by way of experiment, in order to perfect the invention, the inventor does not lose his right.

§ 388. Hence it appears, that the intention with which the inventor did the acts which are relied on as proof of "public use" is material, unless the evidence goes to the extent of showing that the invention had got beyond the control of the inventor, and he had not taken any steps to prevent its being thus situated. In other words, it may be a material element, in determining whether the presumption of acquiescence in public use arises, to ascertain whether the inventor used the invention himself, or imparted a knowledge of it to others, with or without an intention to limit such use or knowledge, in respect to time, extent, or object.

§ 389. Where a party practises his invention himself, for the purposes of experiment or completion, before he takes out a patent, the inference that he intends to surrender his invention to the public does not arise; and, consequently, a dedication cannot be proved by evidence that shows only experimental practice by the inventor, whether in public or in private.² Indeed, it may be

before it is patented, is not only required by its letter and spirit, but also by sound policy. A term of fourteen years was deemed sufficient for the enjoyment of an exclusive right of an invention by the inventor. But if he may delay an application for his patent, at pleasure, although his invention be carried into public use, he may extend the period beyond what the law intended to give him. A pretence of fraud would afford no adequate security to the public in this respect, as artifice might be used to cover the transaction. The doctrine of presumed acquiescence, where the public use is known, or might be known to the inventor, is the only safe rule which can be adopted on this subject." 7 Peters, 319, 320, 321, 322.

¹ 2 Peters, 1, 23.

² *Wyeth v. Stone*, 1 Story's R. 273. In this case, Mr. Justice Story said: "In the next place, as to the supposed public use of Wyeth's machine before his application for a patent. To defeat his right to a patent, under such circumstances, it is essential that there should have been a public use of his machine, substantially as it was patented, with his consent. If it was merely used occasionally by himself in trying experiments, or if he allowed only a temporary use thereof by a few persons, as an act of personal accommodation or neighborly kindness, for a short and limited period, that would not take away his right to a patent. To

stated, as a general test, in cases of a supposed dedication through the using, exercising, or practising the invention by the patentee himself, previous to his application for a patent, that whenever the evidence stops short of proving such a use, exercise, or practice for the purpose of gain, a "public use" will not be proved.

The Court of Common Pleas, in England, has, in a recent case, gone still further, and ruled that an experiment performed in the presence of others, which not only turns out to be successful, but actually beneficial in the particular instance, is not *necessarily* a publication, so as to constitute a gift of the invention to the world. The facts are briefly as follows. Newall, claiming to be the inventor of an improved apparatus for laying submarine telegraph wires, brought a bill for injunction against Elliot and Glass, for alleged infringement of his patent. The defendants set up the plea of public use for gain, prior to obtaining letters-patent. This chancery suit was abandoned, in consequence of an agreement entered into by all parties, to have the case decided by an arbitrator, who should, if required, state a special case, to enable the parties to take the opinion of one of the superior courts of law on any point of law. The arbitrator found for the claimant, and the

produce such an effect, the public use must be either generally allowed or acquiesced in, or at least be unlimited in time, or extent, or object. On the other hand, if the user were without Wyeth's consent, and adverse to his patent, it was a clear violation of his rights, and could not deprive him of his patent."

See also *Ryan v. Goodwin*, 3 Sumner, 518; *Bentley v. Fleming*, 1 Car. & Kirw. 587. This last case shows a strong tendency to limit the effect of use in public, by the intention of the patentee. The patent in question had been obtained for making a card-machine; and there was evidence, that, about five or six weeks before the letters-patent were obtained, the inventor, one Thornton, had lent the machine to one N., in order that he might try whether it would set the teeth of the cards. There was also evidence that N.'s room was in a mill, and that men were constantly going backwards and forwards to and from the said room. It appeared, moreover, that for some weeks before the time at which the machine was lent to N., it had been in complete working condition. On this evidence it was submitted, on the part of the defendant, that the plaintiff was out of court,—first, on the ground that the machine had been publicly used in N.'s room, which was a public room, before the granting of the letters-patent; and on this point the case of *Wood v. Zimmer* was referred to. Cresswell, J., said: "Have you any case that goes that length? The case referred to was the case of an absolute sale; but here there is no evidence that the machine was given to N. *for the purpose of giving it publicity*. The evidence merely is, that Thornton lent the machine to N. in order that he might discover whether it really was worth while to take out a patent for it or not. I cannot stop the case on that point."

Common Pleas sustained his findings of law.¹ Byles, J., in giving the judgment of the court, said: "It must be, and is, conceded, on the part of the plaintiff, that an inventor's public use, for profit, of an invention already ascertained, by previous experiment, to be useful, is a gift of the invention to the public, and avoids a subsequent patent. And it is conceded by the defendant, that a use before the patent, merely experimental and tentative, does not avoid it. Now, the use here made of the invention, in actually laying down the cable, was a use which partook of both characters. On the one hand, it was experimental and tentative; but on the other, the experiment turned out not only successful, but beneficial to the inventor at the moment. The true question, therefore, looking at the decision of the arbitrator, seems to be this: is an experiment performed in the presence of others, which not only turns out to be successful, but actually beneficial in the present instance, necessarily a gift of the invention to the world? We think it is not. In the case under consideration, experiments on dry land are found to be indecisive. The decisive experiment still remains to be made on a large scale and in deep water. An opportunity presents itself, in the course of a government contract, not a contract for the use of this particular apparatus, but a contract for laying down the cable by any means the contractor may select. The experimenter is obliged either to experiment in a way that may turn out to be useful in the particular instance, or else not to make any efficient and decisive experiment at all. The coincidence of an experiment with actual immediate profit or advantage from it, if successful, is unavoidable. Suppose, even, that this coincidence had been accidental; suppose that in the course of the voyage the inventor had tried some further and new experiment, with an alteration of the apparatus, which alteration had at once answered some useful purpose. Surely that further invention would have been his property. Otherwise a man cannot have the property in an invention, which starts from his brain so fully matured and armed that it not only succeeds at the first trial, but accomplishes on that very trial some profitable or useful purpose. If, indeed, the plaintiff in the present case had on other and subsequent voyages used his apparatus, and unnecessarily delayed his application for a patent, he would have given his invention to the public. But here the arbitrator

¹ *In re Newall and Elliot*, 4 Com. Ben. N. S. 269.

must be taken to have found — as he well might on the evidence before him — that the inventor lost no time, but applied for his patent with reasonable expedition.”

In this country, under the provisions of the act of 1839, this doctrine, if applicable at all, could or need only be applied to such profitable experiments as take place more than two years before the application for letters-patent.¹

§ 390. It has been held in England, where the “public use” must be a public use in England, that the making in England of a single pair of wheels, the subject of the patent, under the direction of the patentee, but under an injunction of secrecy, to be sent abroad for a person who intended to take a share in the patent, was not a public use within the realm.² But as our law stood before

¹ Compare also *In re Adamson's Patent*, 35 E. L. & Eq. Rep. 327, where the Lord Chancellor refused to seal letters-patent for certain machinery, which has been used and open to public inspection several months before any application for a patent.

² *Morgan v. Seaward*, Webs. Pat. Cas. 189, 193. In this case, Parke, B. said: “The evidence was, that before the date of the patent (which was the 22d of July, 1829), Curtis, an engineer, made for Morgan two pairs of wheels upon the principle mentioned in the patent, at his own factory. Galloway, the patentee, gave the instructions to Curtis under an injunction of secrecy, because he was about to take out a patent. The wheels were completed and put together at Curtis's factory, but not shown or exposed to the view of those who might happen to come there. After remaining a short time, the wheels were taken to pieces, packed up in cases, and shipped in the month of April on board a vessel in the Thames, and sent for the use of the Venice and Trieste Company, of which Morgan was managing director, and which carried on its transactions abroad, but had shareholders in England. Curtis deposed, that ‘they were sold to the company,’ without saying by whom, which may mean that they were sold by Curtis to Morgan for the company; and Morgan paid Curtis for them. Morgan and Galloway employed an attorney, who entered a caveat against any patent on the 2d of March, and afterwards solicited the patent in question, which was granted to Galloway and assigned to Morgan. Upon these facts, the question for us to decide is, whether the jury must have necessarily found for the defendants, or whether they might have found that this invention, at the date of the letters-patent, was new in the legal sense of that word. The words of the statute are, that grants are to be good ‘of the sole working or making of any manner of new manufactures within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters-patent and grants did not use’; and the proviso in the patent in question, founded on the statute, is, that if the invention be not a new invention as to the public use and exercise thereof in England, the patent should be void. The word ‘manufacture’ in the statute must be con-

the year 1839, if the inventor sold to any one who might choose to buy, although it was only a single specimen of his invention, construed in one of two ways; it may mean the machine when completed, or the mode of constructing the machine. If it mean the former, undoubtedly there has been no use of the machine, as a machine, in England, either by the patentee himself or any other person; nor indeed any use of the machine in a foreign country before the date of the patent. If the term 'manufacture' be construed to be 'the mode of constructing the machine,' there has been no use or exercise of it in England, in any sense which can be called 'public.' The wheels were constructed under the direction of the inventor, by an engineer and his servants, with an injunction of secrecy, on the express ground that the inventor was about to take out a patent, and that injunction was observed; and this makes the case, so far, the same as if they had been constructed by the inventor's own hands, in his own private workshop, and no third person had seen them whilst in progress. The operation was disclosed, indeed, to the plaintiff, Morgan, but there is sufficient evidence that Morgan, at that time, was connected with the inventor, and designing to take a share of the patent. A disclosure of the nature of the invention to such a person, under such circumstances, must surely be deemed private and confidential. The only remaining circumstance is, that Morgan paid for the machines, with the privity of Galloway, on behalf of the Venice and Trieste Steam Company, of which he was the managing director; but there was no proof that he had paid more than the price of the machines, as for ordinary work of that description; and the jury would also be well warranted in finding that he did so with the intention that the machine should be used abroad only, by this company, which, as it carried on its transactions in a foreign country, may be considered as a foreign company; and the question is, whether this solitary transaction, without any gain being proved to be derived thereby to the patentee or to the plaintiff, be a use or exercise in England, of the mode of construction, in any sense which can be deemed a use by others, or a public use, within the meaning of the statute and the patent. We think not. It must be admitted, that if the patentee himself had before his patent constructed machines for sale as an article of commerce, for gain to himself, and been in the practice of selling them publicly, that is, to any one of the public who would buy, the invention would not be new at the date of the patent. This was laid down in the case of *Wood v. Zimmer* (Holt, N. P. C. 58, and Webs. Pat. Cas. 44, n.), and appears to be founded on reason; for if the inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another take out a patent, he might have, practically, a monopoly for a much longer period than fourteen years. Nor are we prepared to say, that if such a sale was of articles that were only fit for a foreign market, or to be used abroad, it would make any difference; nor that a single instance of such a sale as an article of commerce, to any one who chose to buy, might not be deemed the commencement of such a practice, and the public use of the invention, so as to defeat the patent. But we do not think that the patent is vacated on the ground of the want of novelty, and the previous public use or exercise of it, by a single instance of a transaction such as this between the parties, connected as Galloway and the plaintiff are, which is not like the case of a sale to any individual of the public who might wish to buy; in which it does not appear

and sold for profit on it as an invention, such a sale would be a "public use," and the unlimited nature of the object with which a knowledge of the invention was imparted would prevent him from resuming his exclusive right by a subsequent patent.¹ It will presently be stated how far the law has been modified in this respect.

§ 391. Another limitation to the doctrine of presumptive dedication, or public use, with the consent, &c., is found in the case of a piratical user of the invention, by a party to whom the inventor has imparted a knowledge of it in confidence, before he has applied for a patent. Many inventions can be perfected and carried into practice only through the aid of workmen, servants, and other *employées*. We have seen that an inventor may intrust another person, confidentially, with a knowledge of his invention, for certain limited purposes; and if such a person afterwards fraudulently makes public the knowledge so acquired, the authorities seem to be agreed that the inventor may, if he takes immediate steps to give notice of his exclusive right, obtain a valid patent.² The words of the statute, describing the defence now under consideration, make it clear, that, if the invention has come into public use through a breach of confidence, it cannot be said to be in public use "with the consent or allowance" of the patentee; it is only when he has been silent after it has so become public, that the presumption of consent and allowance arises.³ The act of 1839, as will appear hereafter, has made this point still more clear.

that the patentee has sold the article, or is to derive any profit from the construction of his machine, nor that Morgan himself is; and in which the pecuniary payment may be referred merely to an ordinary compensation for the labor and skill of the engineer actually employed in constructing the machine; and the transaction might, upon the evidence, be no more in effect, than that Galloway's own servants had made the wheels; that Morgan had paid them for the labor, and afterwards sent the wheels to be used by his own copartners abroad. To hold this to be what is usually called a publication of the invention in England, would be to defeat a patent by much slighter circumstances than have yet been permitted to have that effect."

¹ *Ibid.*; *Wood v. Zimmer*, 1 Holt, N. P. C. 60.

² *Pennock v. Dialogue*, 2 Peters, 1; *Shaw v. Cooper*, 7 Peters, 292; *Mellus v. Silsbee*, 4 Mas. 108; *Grant v. Raymond*, 6 Peters, 248, 249; *McClurg v. Kingsland*, 1 How. 202, 207.

³ *Ryan v. Goodwin*, 3 Sumner, 518; *Pierson v. The Eagle Screw Company*, 3 Story's R. 406, 407, 408.

Another instance of a use, which will not expose the patentee to the consequences of this defence, is that suggested on more than one occasion by Mr. Justice Story, where the use has been permitted to others, for other limited purposes than those of experiment or completion, as from motives of neighborly kindness and the like.¹ The test that is afforded by the case of *Morgan v. Seaward*, above cited, is applicable here also; namely, that the evidence excludes the supposition that the patentee had put the thing into public use, for the purpose of profit on it, as an invention.² If a patentee could show clearly that he had allowed to others a limited use of his invention, not for his own profit, but for their accommodation, in a manner consistent with a clear intention to hold the exclusive privilege, and the invention had not got beyond his control, with his apparent acquiescence, he would not be within the mischief of this part of the statute. Of course, mere delay to take out a patent, unaccompanied by public use or sale of the thing, with the consent or allowance of the patentee, before his application, however long may be the interval between the completion of the thing and the application, will have no effect upon the patent.³ Mere delay has no other importance, than as it tends to show acquiescence in such public use as may have occurred, in the mean time; or to show that the acts of the inventor went beyond a use or permission to use, for the purpose of experiment, or other limited object.

§ 391 *a*. The very recent case of *Kendall v. Winsor*,⁴ is instructive, as affording a complete *résumé* of the rulings upon the various questions of abandonment, neglect to apply for letters-patent, piratical user, &c. The facts of the case are given in the opinion of Judge Daniel:—

¹ *Mellus v. Silsbee*, 4 Mas. 111; *Wyeth v. Stone*, 1 Story's R. 280, 281; *Ryan v. Goodwin*, 3 Sumner, 518.

² *Webs. Pat. Cas.* 189, 193.

³ *Ryan v. Goodwin*, 3 Sumner, 519. In the case of *Bentley v. Fleming*, 1 Car. & Kirw. 587, 588, it was contended that, inasmuch as the machine in question was a complete workable machine for a long period before the letters-patent were taken out, it did not form the subject of a patent at all. Cresswell, J.: "A man cannot enjoy his monopoly by procuring a patent, after having had the benefit of the sale of his invention. But you cannot contend, that if a man were to keep his invention shut up in his room for twenty years, that circumstance merely would deprive him of his right to obtain a patent for it."

⁴ 21 How. 322.

“ Upon the trial in the Circuit Court, in support of the defence, evidence was introduced tending to show that the plaintiff constructed a machine in substantial conformity with his specification as early as 1846, and that in 1849 he had several such machines in operation, on which he made harness to supply all such orders as he could obtain ; that he continued to run these machines until he obtained these letters-patent ; that he repeatedly declared to different persons that the machine was so complicated that he preferred not to take a patent, but to rely on the difficulty of imitating the machine and the secrecy in which he kept it. And the defendants also gave evidence tending to prove that the first of their machines was completed in the autumn of 1853, and the residue in the autumn of 1854, and that in the course of that fall the plaintiff had knowledge that the defendants had built or were building one or more machines like his invention, and did not interpose to prevent them. The plaintiff gave evidence tending to prove that the first machine built by him was never completed so as to operate ; that his second machine was only partially successful, and improvements were made on it ; that in 1849 he began four others, and completed them in that year, and made harness on them, which he sold when he could get orders ; that they were subject to some practical difficulties, particularly as it respected the method of marking the harness and the liability of the bobbin to get out of the clutch ; that he was employed in devising means to remedy these defects and did remedy them ; that he also endeavored to simplify the machine by using only one ram-shaft ; that he constantly intended to take letters-patent when he should have perfected the machine ; that he applied to Mr. Keller for this purpose in February, 1853, but the model and specifications were not sent to Washington till November, 1854 ; that he kept the machines from the view of the public, allowed none of the hands employed in the mill to introduce persons to view them, and that the hands pledged themselves not to divulge the invention ; that among the hands employed by the plaintiff was one Kendall Aldridge, who left plaintiff’s employment in the autumn of 1852, and entered into an arrangement with the defendants to copy plaintiff’s machine for them ; and that it was by Aldridge, and under his superintendence, and by means of the knowledge which he had gained while in the plaintiff’s employment, under a pledge of

secrecy, that the defendants' machines were built and put in operation ; and that one of the defendants had procured drawings of the plaintiff's machine, and has taken out letters-patent for it in England. Each party controverted the facts thus sought to be proved by the other. . . . The court set aside all those (defendants') prayers for instruction, and did instruct the jury as follows : —

'1. That if Aldridge, under a pledge of secrecy, obtained knowledge of the plaintiff's machine, — and he had not abandoned it to the public, — and thereupon, at the instigation of the defendants, and with the knowledge, on their part, of the surreptitiousness of his acts, constructed machines for the defendants, they would not have the right to continue to use the same after the date of the plaintiff's letters-patent. *But if the defendants had these machines constructed before the plaintiff's application for his letters-patent, under the belief authorized by him that he consented and allowed them so to do, then they might lawfully continue to use the same after the date of the plaintiff's letters-patent, and the plaintiff could not recover in this action. And that if the jury should find that the plaintiff's declaration and conduct were such as to justify the defendants in believing that he did not intend to take out letters-patent, but to rely on the difficulty of imitating his machine and the means he took to keep it secret, this would be a defence to the action. And they were further instructed, that to constitute such an abandonment to the public as would destroy the plaintiff's right to take a patent, in a case where it did not appear that any sale of the thing patented had been made, and there was no open public exhibition of the machine, the jury must find that he intended to give up and relinquish his right to take letters-patent. But if the plaintiff did intend not to take a patent, and manifested that intent by his declarations or conduct, and thereupon it was copied by the defendant, and so went into use, the plaintiff could not afterwards take a valid patent.'*

“. . . . Recurring now to the instruction from the judge at circuit in this case, we consider that instruction to be in strict conformity with the principles hereinbefore propounded, and with the doctrines of this court, as declared in the case of *Pennock v. Dialogue* and *Shaw v. Cooper*. That instruction diminishes or excludes no proper ground upon which the conduct and intent of the plaintiff below, as evinced either by declarations or acts, or by omissions to

speak or act, and on which also the justice and integrity of the conduct of the defendants were to be examined and determined. It submitted the conduct and intentions of both plaintiff and defendants to the jury, as questions of fact to be decided by them, guided simply by such rules of law as had been settled with reference to issues like the one before them; and upon those questions of fact the jury have responded in favor of the plaintiff below, the defendant in error. . . . The decision of the Circuit Court is therefore affirmed, with costs.”

§ 392. It now remains to be stated, how far this defence of a “prior public use or sale with the consent or allowance” of the patentee has been restricted or modified by subsequent legislation. Under this clause of the act of 1836, a use of the invention by a single person, or a sale of the thing invented to a single person, might, as we have seen, amount to a public use or sale, with the consent or allowance of the patentee. To remedy the inconvenience arising from this operation of the law, the act of 1839, § 7, provided “that every person or corporation, who has or shall have purchased or constructed any newly invented machine, manufacture, or composition of matter, prior to the application, by the inventor or discoverer, for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter, so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid, by reason of such purchase, sale, or use, prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.”

§ 393. This enactment enables a patentee to permit the use of his invention, by individuals, before his application, with more safety than he formerly could. Such use is not to invalidate the patent, except on proof of abandonment of the invention to the public, or that it had been continued for more than two years prior to the application for a patent. The question arises upon this provision, then, whether the particular purchase, sale, or prior use may of itself, under some circumstances, furnish proof of

abandonment to the public, or whether such an abandonment must be proved by other cases, and by other evidence *dehors* the particular purchase, sale, or prior use, that happens to be in question. The obvious construction of the act is, that a purchase, sale, or prior use, before the application for a patent, shall not invalidate it, *unless* it amounts to an abandonment to the public; a purchase, sale, or prior use shall not have this effect, *per se*, but, if connected with facts which show an abandonment to the public, or if it has been for more than two years prior to the application, it will have this effect.¹ Thus, in the case of *McClurg v. Kingsland*, where the defendants used the invention for four months before the application of the inventor for a patent, such use being in public, with the consent and allowance of the patentee, he being in their employ, and making a part of the apparatus by which the invention was to be applied, but receiving no compensation for the use of his invention, and not giving any notice to the defendants not to use his invention, until, on a misunderstanding upon another subject, he left their employment; the Supreme Court of the United States said that it would be no strained construction, under such circumstances, to hold that the patent, subsequently obtained, was void; although the decision merely went to the point that the acts of the patentee justified the presumption of a license to the defendants.²

§ 394. The words of the statute which thus authorizes a public use or sale by or to individuals, prior to the application for a patent, make the subject of such use or sale, "any newly invented machine, manufacture, or composition of matter"; and the purchaser is authorized to use, and vend to others to be used, "the specific machine, manufacture, or composition of matter," without liability to the inventor, &c.; and then the statute declares, that the patent shall still be valid, notwithstanding such prior use or sale, except on proof of the abandonment of "such invention" to the public, &c. It might admit of some doubt, upon this language, whether the invention of a method of manufacture, a process, or an art, or anything but a machine, a manufacture, or a composition of matter, is within the scope of the provision, and whether

¹ See the comment of Mr. Justice Story on this statute, in *Pierson v. The Eagle Screw Company*, 3 Story's R. 402, 405, 407, cited *ante*.

² 1 How. 202, 208.

the purchaser could do anything more than use, or vend to others to be used, the specific thing which he had purchased. But the Supreme Court of the United States have construed the terms “newly invented machine, manufacture, or composition of matter” to mean “the invention patented,” whatever it may be; and the words “the specific machine,” to refer to the thing as originally invented, of which the right is afterwards secured by a patent; so that, according to the precedent afforded by the case in which this construction was adopted, this statute embraces whatever may be the subject-matter of a valid patent, although it may be a process, or method of manufacture, and not a machine, &c.¹

§ 395. The result, therefore, of the different statute provisions

¹ *McClurg v. Kingsland*, 1 How. 202, 209. The court said: “At the trial below and here, the plaintiff’s counsel have contended, that this act cannot apply to the present case, inasmuch as the protection it affords to the person who had the prior use, is confined to the specific machine, &c., and does not extend to such use of the invention, or thing patented, if it does not consist of a machine, &c., as contradistinguished from the new mode or manner in which an old machine or its parts operates, so as to produce the desired effect; but we think that the law does not admit of such construction, whether we look at its words or its manifest objects, when taken in connection with former laws, and the decisions of this court in analogous cases.

“The words ‘such invention’ must be referred back to the preceding part of the sentence, in order to ascertain the subject-matter to which it relates, which is none other than the newly invented machine, manufacture, or composition of matter constituting the thing patented, otherwise these words become senseless when the invention is not strictly of a machine, &c. Now, in the present case, we find the invention consists solely in the angular direction given to the tube through which the metal is conducted into the cylinder in which the roller is cast. Every part of the machinery is old, the roller itself is no part of the invention, and cannot be the machine, manufacture, or composition of matter contemplated by Congress, nor can the word ‘specific’ have any practical effect, unless it is applied to the thing patented, whatever it may be, without making a distinction between a machine, &c., and the mode of producing a useful result, by the mere direction given to one of the parts of an old machine. Such a construction is not justified by the language of the law, and would defeat both of its objects. If it does not embrace the case before us, the consequence would be that the use of the invention, under the circumstances in evidence, would, according to the decision in 2 Peters, 14, 15, invalidate the patent; for if the act operates to save the avoidance of the patent, it must, of consequence, protect the person who uses the invention before the application for a patent. Both objects must be effected, or both must fail, as both parts of the act refer to the same thing, and the same state of things, as affecting the person using the newly invented machine, or the thing

and the authorities, is, that this defence of a prior public use or sale, with the consent or allowance of the patentee, can now be made good so as to invalidate a patent, only by showing an abandonment to the public, or that the use or sale dates from a period more than two years before the application for a patent; that such an abandonment will not be proved by the particular act of use or sale alone, but that the act of use or sale may be attended with such circumstances as to amount to an abandonment; and that the abandonment may also be proved by other acts or omissions disconnected with the particular use or sale, which the patentee may have allowed to individuals, and which he can show did not alone amount to an abandonment.

As the statute has been expounded in a recent case, "*it virtually extends the patentee's privilege to sixteen years instead of fourteen*"; that is, he may use his improvement by making and using his machines, and by vending and taking pay for them, for two years previous to his application, without forfeiting the benefits

patented, as well as the inventor. Had the words 'invention,' or 'thing patented,' been used instead of machine, &c., there could have been no room for doubt of the application of the act to the present case; and, by referring to the phraseology of the different acts of Congress, denoting the invention, it is apparent that, though there is a difference in the words used, there is none as to their meaning or reference to the same thing. Thus, we find in the fourteenth section of the act of 1836, relating to suits for using 'the thing whereof the exclusive right is secured by any patent'; in the fifteenth, 'his invention, his discovery, the thing patented,' 'that which was in fact invented or discovered,' 'the invention or discovery for which the patent issued,' 'that of which he was the first inventor.' In the first section of the act of 1839, 'any patent for any invention, discovery, or improvement,' 'inventions and discoveries'; in the second section, 'the invention'; in the third, 'invention or discovery'; in the fourth, 'patented inventions and improvements'; in the fifth, 'the thing as originally invented.' 2 Story, 2510, 2511, 2546.

"We therefore feel bound to take the words 'newly invented machine, manufacture, or composition of matter,' and 'such invention,' in the act of 1839, to mean 'the invention patented,' and the words 'specific machine' to refer to 'the thing as originally invented,' whereof the right is secured by patent; but not to any newly invented improvement on a thing once patented. The use of the invention before an application for a patent must be the specific improvement then invented and used by the person who had purchased, constructed, or used the machine to which the invention is applied; so construed, the objects of the act of 1839 are accomplished; a different construction would make it necessary to carry into all former laws the same literal exposition of the various terms used to express the same thing, and thereby changing the law according to every change of mere phraseology, make it a labyrinth of inextricable confusion."

conferred upon him by his patent. But if he either sells a machine, or uses one, or puts one into public use, at any time more than two years before his application, it works a forfeiture of his right.”¹

§ 395 a. With regard to the question of abandonment or dedication *after* letters-patent have been obtained, it has been held, in the case of *Wyeth v. Stone*, that, at least in equity, the defence that the patentee had for some time acquiesced in open infringements of his right would be a sufficient ground for refusing an application for injunction, whatever the action of a court of law might be.²

Another question has arisen and received final adjudication in the Supreme Court, to wit, whether an inventor may, under certain circumstances, be presumed to make a formal dedication to the public *at the time* of filing his specification. The case arose under Battin's patent for a coal-breaking apparatus. The patentee, in his first specification, filed 1843, claimed as his invention merely the arrangement and combination of parts therein described, although he was, in fact, also the inventor of one or more of the parts themselves. In 1849 he surrendered his patent and took out a new one, in which he specified and claimed as new one of these parts. The Circuit Court, per Kane, J., held the prior specification had the effect of dedicating such parts to the public, who, being thus put in the enjoyment of the invention by the inventor himself, could not be dispossessed by any subsequent measures on his part, such as surrender or disclaimer.³ On appeal to the Supreme Court⁴ this opinion was reversed. McLean, J., in delivering the opinion of the Supreme Court, says: “The above instructions were, we think, erroneous. (They were these: 1. That a description by the applicant for a patent of a machine or a part of a machine, in his specification, unaccompanied by notice that he has rights in it or that he desires to secure title to it as a patent, is a dedication of it to the public. 2. That such a dedication cannot be revoked after the machine has passed into public

¹ *McCormick v. Seymour*, 2 Blatchf. 240; affirmed in *Seymour v. McCormick*, 16 How. 480. Compare also *Pitts v. Hall*, 2 Blatchf. 229.

² 1 Story's R. 273. *Vid.* chapter on Remedy in Equity.

³ *Battin v. Taggart*, 2 Wall. C. C. 101.

⁴ *Battin v. Taggart*, 17 How. 74.

use, either by surrender and reissue, or otherwise.) Whether the defect be in the specification or in the claim, under the thirteenth section, above cited, the patentee may surrender his patent, and by an amended specification or claim cure the defect. The reissued patent must be for the same invention substantially, though it be described in terms more accurate and precise than in the first patent. Under such circumstances, a new and different invention cannot be claimed. But where the specification or claim is made so vaguely as to be inoperative or invalid, yet an amendment may give to it validity, and protect the rights of the patentee against all subsequent infringements. So strongly was this remedy of the patentee recommended by a sense of justice and policy, that this court, in the case of *Grant v. Raymond*,¹ sustained a reissued and corrected patent, before any legislative provision was made on the subject. . . . How much stronger is a case under the statute which secures the rights of the patentee by surrender, and declares the effect of the reissued and corrected patent! By the defects provided for in the statute nothing passes to the public from the specification or claims, within the scope of the patentee's invention. And this may be ascertained by the language he uses. In the case of *Stimpson v. West Chester R. R.*,² it was held, that "where a defective patent had been surrendered and a new one taken out, and a patentee brought an action for a violation of his patent right, laying the infringement at a date subsequent to that of the reissued patent, proof of the use of the thing patented during the interval between the original and renewed patents will not defeat the same. In the same case it was also held, that the proceeding before the commissioner, in the surrender and reissue of a patent, is not open for investigation except on the ground of fraud. The patent of 1843 was not surrendered on the obtainment of the patent of 1844. That was intended to be a new invention of arranging and combining the toothed rollers, which, the patentee says, was not made the subject of a claim in the patent of 1843. The patent of 1844 was cancelled but not reissued, when the patent of 1849 was issued. At that time the patent of 1843 and the improvement thereon, dated January 20, 1844, were surrendered and cancelled, and new letters-patent were issued on an amended specification. The cause of the surrender of the patent of 1843, as stated

¹ 6 Pet. 218.

² 4 How. 380.

in the charge to the jury, was the ruling of the court in the case of *Battin v. Clayton*, and that the patent was consequently obtained. (That ruling was that the patent, being merely for the combination of machinery, could neither be supported by proof of the novelty, nor assailed by proof of the want of novelty, of the parts.) That ruling is not now before us, nor is it necessary to inquire whether the patent of 1843, on the specifications and claim, was sustainable. The plaintiff, by a surrender of that patent and the procurement of the patent of 1849 with amended specifications, abandoned his first patent and relied wholly on the one reissued. The claim and specifications in this patent, as amendatory of the first, were within § 13 of the act of 1836. It is said, with entire accuracy, in the charge, in regard to the amended specification of 1849, that it “described essentially the same machine as the former one did, but claimed as the thing invented, the breaking apparatus only! And this the patentee had a right to do. He had a right to restrict or enlarge his claim, so as to give it validity and to effectuate his invention.”

A somewhat similar point was involved in the very recent case of *The Suffolk Co. v. Hayden*.¹ We give the facts as they are presented by the reporter: “In December, 1854, Hayden, being the inventor of improvements in cotton-cleaners, made application for a patent therefor. The improvements consisted in certain described changes made by Hayden in the interior arrangements of an elongated trunk previously used. While this application was still pending, Hayden made another distinct improvement in the form of the trunk. . . . He desired, apparently, to claim this new improvement in the form of the trunk, both separately and in combination with his other improvements in the interior arrangements. Accordingly, in November 1855, he filed his application for a patent, and on March 17, 1857, letters were issued to him, in the specification whereof he claims the improvement in the form of the trunk, both separately and in combination with his improvements in the interior arrangements of the trunk; but he made no claim in this specification to his improvements in the interior arrangements of the trunk. It did not appear that Hayden was guilty of any laches in reference to the delay of the commissioner to act on his first application for a patent for the improvements in the interior arrangement, made in December, 1854. For some cause, however,

¹ 3 Wall. 315.

the patent office did not act on that application till June 1857. . . . Hayden having sued the Suffolk Manufacturing Co. for breach of this last-mentioned patent, the defendant's counsel at the trial requested the judge to rule that the patent was void (June, 1857), because the improvements in the interior arrangement, which were described and claimed in it, being also described but not claimed in the patent of March 17, 1857, were by the legal operation of that patent surrendered to the public use. The judge refused so to rule, and on error this refusal raised the first question." The refusal was sustained by the Supreme Court.

§ 396. The next special defence stated in the act of 1836 is, "that the patentee had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same." This provision was intended to embrace the case of a patent being obtained fraudulently, when the party obtaining it was not the inventor, and also the case of two independent inventors, where the one makes his application before the other, who was the first inventor, and so obtains a patent for that which was previously invented by another.

§ 397. With regard to the first case, of a patent obtained by a person not the inventor, by a fraud on the rights of the real inventor, it is sufficient to observe that such a defence, if made out, would be a complete bar to the action, upon general principles, as well as upon other provisions of the statute. One of the modes in which a patent may be thus surreptitiously obtained, is by obtaining a knowledge of the invention from the public records where the inventor has deposited a description of it. When the real inventor has filed such a description at the Patent Office, or has obtained a patent, he has given notice to every subsequent applicant for a patent for the same thing, of the fact that he invented it; and although others may not afterwards be able to offer direct evidence that a subsequent patentee had seen and pirated the machine or other thing invented by the former applicant or patentee, yet the jury may infer a piracy from the existence of the former record, of which every subsequent patentee is presumed to have knowledge.¹

¹ *Odiorne v. Winkley*, 2 Gallis. 51, 55. In this case, Mr. Justice Story said: "As to the question, whether the patent was surreptitiously obtained, there is no

As to the case of two independent inventors, one of whom makes an earlier application than another for a patent and succeeds in obtaining it, it will be a good defence to an action upon such a patent, if it can be shown that the same thing was first invented by another, although not actually perfected, provided the first inventor was at the time using reasonable diligence in adapting and perfecting the thing invented.¹

direct or positive proof that Reed had ever seen Perkins's machine before he obtained a patent, but there is evidence, from which the jury may legally infer the fact, if they believe that evidence. It is a presumption of law, that, when a patent has been obtained, and the specifications and drawings recorded in the Patent Office, every man who subsequently takes out a patent for a similar machine has a knowledge of the preceding patent. As in chancery it is a maxim, that every man is presumed to have notice of any fact, upon which he is put upon inquiry by documents within his possession, if such fact could, by ordinary diligence, be discovered upon such inquiry. It is also a presumption of fact, that every man, having within his power the exact means of information, and desirous of securing to himself the benefit of a patent, will ascertain for his own interest whether any one on the public records has acquired a prior right."

¹ Reed v. Cutter, 1 Story's R. 590, 599. In this case, Mr. Justice Story said: "The passage cited from Mr. Phillips's work on Patents (p. 395), in the sense in which I understand it, is perfectly accurate. He there expressly states, that the party claiming a patent must be the original and first inventor; and that his right to a patent will not be defeated by proof that another person had anticipated him in making the invention, unless such person 'was using reasonable diligence in adapting and perfecting the same.' These latter words are copied from the fifteenth section of the act of 1836, ch. 357, and constitute a qualification of the preceding language of that section; so that an inventor, who has first actually perfected his invention, will not be deemed to have surreptitiously or unjustly obtained a patent for that, which was in fact first invented by another, unless the latter was at the time using reasonable diligence in adapting and perfecting the same. And this I take to be clearly law; for he is the first inventor, in the sense of the act, and entitled to a patent for his invention, who has first perfected and adapted the same to use; and until the invention is so perfected and adapted to use, it is not patentable. An imperfect and incomplete invention, resting in mere theory, or in intellectual notion, or in uncertain experiments, and not actually reduced to practice, and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, is not, and indeed cannot be, patentable under our patent acts; since it is utterly impossible, under such circumstances, to comply with the fundamental requisites of those acts. In a race of diligence between two independent inventors, he who first reduces his invention to a fixed, positive, and practical form, would seem to be entitled to a priority of right to a patent therefor. Woodcock v. Parker, 1 Gallis. R. 438. The clause of the fifteenth section, now under consideration, seems to qualify that right, by providing that, in such cases, he who invents first shall have the prior right, if he is using reasonable

§ 398. The last defence mentioned in the statute, is, that the patentee, being an alien at the time the patent was granted, "had failed and neglected, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent was issued." The object of this provision was to prevent foreigners from obtaining patents in this country, and afterwards withholding the use of their inventions from the public for an unreasonable length of time.¹

§ 399. Apart, however, from the *general issue*, whether pleaded with or without statutory notice of the evidence to be offered, the defendant may plead *specialty* in bar, that since the action was instituted the plaintiff has surrendered his letters-patent and obtained a reissue. Thus in the case of *Moffitt v. Garr*,² the court said: "A surrender of the patent to the commissioner, within the sense of the provision, means an act which, in judgment of law, extinguishes the patent. It is a legal cancellation of it, and hence can no more be the foundation for the assertion of a right after the surrender, than could an act of Congress which has been repealed. It has frequently been determined that suits pending, which rest upon an act of Congress, fall with the repeal of it. The reissue of the patent has no connection with, or bearing upon, antecedent suits; it has as to subsequent ones. The antecedent suits depend upon the patent existing at the time they were commenced; and unless it exists and is in force at the time of trial and judgment, the suits fail. It is a mistake to

diligence in adapting and perfecting the same, although the second inventor has, in fact, first perfected the same, and reduced the same to practice in a positive form. It thus gives full effect to the well-known maxim, that he has the better right who is prior in point of time, namely, in making the discovery or invention. But if, as the argument of the learned counsel insists, the text of Mr. Phillips means to affirm (what, I think, it does not) that he, who is the original and first inventor of an invention, so perfected and reduced to practice, will be deprived of his right to a patent, in favor of a second and subsequent inventor, simply because the first invention was not then known or used by other persons than the inventor, or not known or used to such an extent as to give the public full knowledge of its existence, I cannot agree to the doctrine; for, in my judgment, our patent acts justify no such construction."

¹ It has been held that this clause does not apply to American patentees; who became such as assignees of alien inventors, under § 6 of Act of March, 1837. *Tatham v. Lowber*, 2 Blatchf. 49.

² 1 Black. 273.

suppose that, upon this construction, moneys recovered on judgment in suits, or voluntary payment under the first patent upon the surrender, might be recovered back. The title to these moneys does not depend upon the patent, but upon the voluntary payment or judgment of the court.”

CHAPTER X.

OF THE REMEDY IN EQUITY TO RESTRAIN INFRINGEMENTS.

§ 400. WE have seen that the common law and the statute both afford a remedy, by an action for damages, for the infringement of patent rights. But this remedy would be wholly inadequate to the protection of such rights, if it were not accompanied and fortified by another remedy, which flows from that great principle of equity jurisprudence, that where there is a legal right, and the nature of the injury to which it is exposed is such that a preventive remedy is indispensable, equity will afford that remedy by an injunction. The grounds of the equity jurisdiction in cases of patents are, the prevention of irreparable mischiefs; the suppression of a multiplicity of suits and vexatious litigation, and the more complete discovery, from the party guilty of infringement, of the extent of the injury done to the patentee, than can be obtained in an action at law.¹ It does not belong to the purposes of this work, to trace the origin of this branch of equity jurisdiction, nor is it necessary to do so, since the patent laws have expressly adopted in the broadest terms the remedy which it affords for the protection of patent rights, and have directed the proper courts "to grant injunctions according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor, as secured to him by any law of the United States, on such terms and conditions as the said courts may deem reasonable."² All that is requisite, therefore, in the present work, is, to develop the application of the doctrines and practice of courts of equity to the rights of inventors, in the remedy by injunction.

§ 401. As a preliminary remark, however, we may notice, that the discretion vested in the court by the terms of the statute above cited, to grant injunctions on such terms and conditions as the court may deem reasonable, is in perfect accordance with the

¹ 2 Story's Eq. Jurisp. § 930, 931, 932, 933.

² Act of July 4, 1836, ch. 357, § 17. Enlarged, as to powers of appeal, by act of February 18, 1861, ch. 37.

principles of equity.¹ This discretion is not a wholly unregulated discretion, but the clause in which it is expressed is to be considered as affected by the previous direction that the injunction is to be granted according to the course and principles of courts of equity, which are guided by certain well-settled rules; so that the terms and conditions to be imposed in each case will be ascertained, by applying to the circumstances of the case those principles and that course of practice which have been usually followed, and which will admit of a “reasonable” application to the particular facts of the case.

§ 402. I. *The Parties.* The parties entitled to relief in equity against the infringement of a patent are, first, the party or parties

¹ In *Bacon v. Jones*, 4 Mylne & Cr. 433, 436, Lord Cottenham made the following remarks on the granting of injunctions in cases of patents: “When a party applies for the aid of the court, the application for an injunction is made either during the progress of the suit or at the hearing; and in both cases, I apprehend, great latitude and discretion are allowed to the court in dealing with the application. When the application is for an interlocutory injunction, several courses are open: the court may at once grant the injunction, simpliciter, without more, — a course which, though perfectly competent to the court, is not very likely to be taken where the defendant raises a question as to the validity of the plaintiff’s title; or it may follow the more usual, and, as I apprehend, more wholesome practice in such a case, of either granting an injunction, and at the same time directing the plaintiff to proceed to establish his title at law, and suspending the grant of the injunction until the result of the legal investigation has been ascertained, the defendant in the mean time keeping an account. Which of these several courses ought to be taken must depend entirely upon the discretion of the court, according to the case made.

“When the cause comes to a hearing, the court has also a large latitude left to it; and I am far from saying that a case may not arise in which, even at that stage, the court will be of opinion that the injunction may properly be granted without having recourse to a trial at law. The conduct and dealings of the parties, the frame of the pleadings, the nature of the patent right, and of the evidence by which it is established, — these and other circumstances may combine to produce such a result; although this is certainly not very likely to happen, and I am not aware of any case in which it has happened. Nevertheless, it is a course unquestionably competent to the court, provided a case be presented which satisfies the mind of the judge, that such a course, if adopted, will do justice between the parties.

“Again, the court may, at the hearing, do that which is the more ordinary course; it may retain the bill, giving the plaintiff the opportunity of first establishing his right at law. There still remains a third course, the propriety of which must also depend upon the circumstances of the case, that of at once dismissing the bill.”

interested in the patent. As the remedy in equity is given in order to protect a legal right, and as the statute gives a right of action to the person or persons interested, whether as patentee, assignees, or grantees of the exclusive right for a particular district, it follows that any person holding the legal title, or the right to bring an action, may bring a bill for an injunction.

§ 403. We have seen when the assignee of a patent may sue at law in his own name, and when he should join his assignor. The same rules will govern in equity, in determining who are necessary parties to the bill. If the assignee has the whole interest, he may sue alone; but if he has less than the whole interest, he must join the patentee. If the assignment has not been recorded, the assignee is not substituted to the right and responsibility of the patentee, so as to maintain any suit at law or in equity, founded upon the patent;¹ and where there is a joint suit by the patentee and the assignee, and a disclaimer has been filed by the patentee, in which the assignee did not join, the disclaimer cannot operate in favor of the complainants in such a bill, or in an action at law.²

§ 404. There is, however, one distinction between an action at law and a suit in equity, in respect to the parties, and that is the case of an assignment of the exclusive right for a particular

¹ *Wyeth v. Stone*, 1 Story's R. 273, 295. Story, J.: "The objection which I deem fatal is, that the bill states and admits, that the assignment to the plaintiff, Tudor (made in February, 1832), has never yet been recorded in the State Department, according to the provisions of the Patent Act of 1793, ch. 55, § 4. That act provides, 'that it shall be lawful for any inventor, his executor or administrator, to assign the title and interest in the said invention at any time; and the assignee, having recorded the said assignment in the office of the Secretary of State, shall thereafter stand in the place of the original inventor, both as to right and responsibility.' It seems a necessary, or, at least, a just inference, from this language, that until the assignee has so recorded the assignment, he is not substituted to the right and responsibility of the patentee, so as to maintain any suit at law or in equity, founded thereon. It is true, that no objection is taken in the pleadings on account of this defect; but it is spread on the face of the bill, and therefore the court is bound to take notice of it. It is not the case of a title defectively set forth, but of a title defective in itself, and brought before the court with a fatal infirmity, acknowledged to be attached to it. As between the plaintiffs and the defendants, standing upon adverse titles and rights (whatever might be the case between privies in title and right), Tudor has shown no joint interest sufficient to maintain the present bill; and therefore it must be dismissed with costs."

² *Ibid.* 294.

district. The grantee of such a right may bring an action at law, within his own district, for an infringement, even against the patentee himself, and, consequently, he may bring such an action always in his own name.¹

§ 405. But in equity the patentee may be joined with the assignee of such an exclusive right, if it be a right to use a limited number of the patented machines in a particular district, because the interest of the patentee is not all vested in the grantee, who, although he may prevent the patentee from licensing other persons within the district, cannot obtain for himself the right to use more machines than the original grant authorized, without paying the patentee for such further license. This interest renders the patentee a proper party in such a bill.² Different persons, who have infringed a patent independently of each other, cannot be made defendants in the same bill.³

§ 405 a. It becomes at times important to know against whom a bill for injunction may be brought. Thus in the English case of *Caldwell v. Van Vliessingen*,⁴ it was held that the Court of Chancery could enjoin the use in England of an English patented invention which had been made abroad, and attached to a foreign vessel as

¹ "The sixth question certified is as follows: whether the plaintiff, if he be an assignee of an exclusive right to use two of the patented machines within the town of Watervliet, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within the said town; or whether, to maintain such action, the plaintiff must be possessed, as to that territory, of all the rights of the original patentee. The plaintiff is the grantee of the exclusive right to construct and use, and to vend to others to be used, two of the patented machines within the town of Watervliet, in the county of Albany. The fourteenth section of the patent law authorizes any person, who is a grantee of the exclusive right in a patent within and throughout a specified portion of the United States, to maintain an action in his own name for an infringement of the right. The plaintiff comes within the very terms of the section. Although limited to the use of two machines within the town, the right to use them is exclusive. No other party, not even the patentee, can use a right under the patent within the territory without infringing the grant." *Wilson v. Rousseau*, 4 How. 646, 686.

² *Woodworth v. Wilson*, 4 How. 712. It had been previously held that the grantee for a particular district can maintain a bill for an injunction and account. *Ogle v. Edge*, 4 Wash. 384.

³ *Dilly v. Doig*, 2 Ves. Jr. 487.

⁴ 9 E. L. and Eq. 51.

part of her equipment. But the Supreme Court of the United States, in the similar case of *Brown v. Duchesne*,¹ held directly the opposite opinion.

In *Munz v. Grenfell*,² an injunction was granted against one who had entered into partnership with the patentee for the joint prosecution of business connected with the invention, and then broken off, to patentee's detriment. The plaintiff was, however, ordered to bring an action at law.

*Bowley v. Hancock*³ presents us with the case of four persons who, having taken out patents relative to the manufacture of goods from gutta-percha, entered into an agreement "that all patents taken out or in the course of being taken out by any or either of them, or on account of and for the benefit of any or either of them, in relation to the preparation or application of gutta-percha, or the manufacture of any articles therefrom, should be assigned to trustees and held for their joint account." Subsequently, one of the parties took out a patent for an apparatus and machinery for giving shape and configuration to elastic substances, and applied it to coating telegraph wires with gutta-percha, but refused to make any assignment. It was held that he could be restrained, as well as compelled to make specific performance.

On the other hand, in the very recent case of *Mathers v. Green*,⁴ the Lord Chancellor decided, on appeal from the Master of the Rolls, that, in the absence of clear and unmistakable evidence of an agreement or contract between joint grantees or patentees, one of such patentees was not entitled to a share in the profits made by another in granting licenses. "The letters-patent grant to the three, their executors, administrators, and assigns, that they and every one of them, by themselves, their servants, and agents, or such others as they may agree with and no others, shall, for the term of fourteen years, use, exercise, and vend the same invention. The right conferred is a right to exclude all the world, other than the grantees, from using the invention. But there is no exclusion in the letters-patent of any one of the patentees. The inability of any one of the patentees to use the invention, if any such inability exists, must be

¹ 19 How. 183 (affirming 2 Curtis, C. C. 371).

² 2 Webs. Pat. Cas. 88.

³ 35 F. L. and Eq. 545.

⁴ 1 Law Rep. Eq. Ser. 29 (1865).

sought elsewhere than in the letters-patent. But there is no principle, in the absence of contract, which can prevent any persons not prohibited by statute from using any invention whatever. Is there, then, any implied contract, where two or more persons jointly obtain letters-patent, that no one of them shall use the invention without the consent of the others, or that if he does, he shall use it for their joint benefit. I can discover no principle for such a doctrine. It would enable one of two patentees either to prevent the use of the invention altogether, or else to compel the other patentee to risk his skill and capital in the use of the invention on the terms of being accountable for half the profit, if profit should be made, without being able to call on his co-patentee for contribution, if there should be loss. This would be placing the parties in a relation to each other which I think no court can assume to have been intended in the absence of express contract to that effect."

Similar language is used by Curtis, J., in *Clum v. Brewer*.¹ "One tenant in common has as good a right to use and to license third persons to use the thing patented as the other tenant has. Neither can come into a court of equity and assert a superior equity, unless it has been created by some contract modifying the rights which belong to them as tenants in common."

§ 406. II. *The Bill.* A bill for an injunction to restrain the infringement of a patent, after the address to the court and the statement of the parties, should recite the application for the letters-patent, by the inventor, and the compliance by him with all the prerequisites for obtaining them, and the issue of the letters, giving the title as it is contained in them, *verbatim*, their attestation by the proper officers, and their delivery to the patentee. Profert of the letters should be made, but it is not necessary to set forth the description of the invention given in the specification.² It is necessary, however, to state that the plaintiff, after the issuing of the patent, put his invention into use, and is, at the time of filing the bill, in the exclusive possession of it.³ If the bill is brought upon the title of an assignee, either of the whole or a part of the interest, or of an administrator, or if the patent has been

¹ 2 Curtis, C. C. 506.

² *Kay v. Marshall*, 1 Mylne & Cr. 373; *Westhead v. Keene*, 1 Bear. 287.

³ *Isaacs v. Cooper*, 4 Wash. 259.

renewed, or extended, or amended by a disclaimer, the facts should be properly set forth, to show the present state of the title and the right for which protection is asked. The bill should further state the infringement complained of, whether it has been actually committed or is threatened; and if the right has been previously established by an action at law, against the same or any other party, or an injunction has been previously obtained against the same or any other party, the fact should be set forth.¹ These averments are usually followed by a statement that the defendant has been requested to desist from the use of the invention, and to account for the damages which the plaintiff has sustained. Then follows the charge of actual combination by the defendant with others, if the facts require it, and of a conspiracy, if one is intended to be proved, to destroy the plaintiff's exclusive privilege. The prayer of the bill is for a discovery upon oath and particular answers to the interrogatories, which should be pointed at all the previous material averments in the bill, for a general answer to the bill, for a decree that the defendant account for and pay over the gains and profits which have accrued to him from using the invention, for an injunction to restrain the defendant from the further use of the invention, and to compel the delivery or destruction of the machines or other things which he has made, and for further relief. The prayer should close with asking for a writ of injunction, and a subpoena. The bill should be sworn to by the usual affidavit.

The omission of the oath is not, however, a ground for demurrer after a hearing and order to file evidence. The objection should be made by motion, on the appearance of the respondents, when the oath will be directed, unless good cause to the contrary be shown.²

§ 407. It may often be a serious question, whether an original bill filed for an injunction and other relief is affected by a subsequent surrender and renewal of the patent, pending the proceedings. In a case where this had happened, and a temporary injunction had been granted on the original bill, in which the patentee and certain assignees were plaintiffs, and upon the new

¹ See the observations of Mr. Justice Story, cited from *Woodworth v. Stone*, *post*. See also *Orr v. Littlefield*, 1 Woodb. & M. 13.

² *Woodworth v. Edwards*, 3 Woodb. & M. 120.

patent a supplemental bill was filed against the defendant for the continuance of the injunction and other relief, the injunction was ordered to stand continued, as to the new patent, stated in the supplemental bill, until the hearing or further order. Hence it appears that, when a patent is surrendered and renewed, pending a temporary injunction, a supplemental bill is necessary, in order to continue the injunction as to the new patent.¹

¹ *Woodworth v. Stone*, 3 Story's R. 749. 750. Story, J.: "If the present case had stood merely upon the original bill, it appears to me clear, that the motion to dissolve the injunction granted upon that bill ought to prevail, because, by the surrender of the patent, upon which that bill is founded, the right to maintain the same would be entirely gone. I agree that it is not in the power of the patentee, by a surrender of his patent, to affect the rights of third persons, to whom he has previously, by assignment, passed his interest in the whole or a part of the patent, without the consent of such assignees. But, here, the supplemental bill admits that the assignees, who are parties to the original and supplemental bill, have consented to such surrender. They have, therefore, adopted it, and it became theirs in the same manner as if it had been their personal act and done by their authority.

"The question, then, is precisely the same as if the suit were now solely in behalf of the patentee. In order to understand with clearness and accuracy some of the objections to the continuance of the injunction, it may be necessary to state that the original patent to William Woodworth (the inventor), who is since deceased, was granted on the 27th of December, 1828. Subsequently, under the eighteenth section of the act of 1836, ch. 357, the Commissioner of Patents, on the 16th of November, 1842, recorded the patent in favor of William W. Woodworth, the administrator of William Woodworth (the inventor), for seven years from the 27th of December, 1849 (to which time the renewed patent extended); and the Commissioner of Patents was directed to make a certificate of such extension in the name of the administrator of William Woodworth (the inventor), and to append an authenticated copy thereof to the original letters-patent, whenever the same shall be requested by the said administrator or his assigns. The Commissioner of Patents, accordingly, on the 3d of March, 1845, at the request of the administrator, made such certificate on the original patent. On the 8th of July, 1845, the administrator surrendered the renewed patent granted to him 'on account of a defect in the specification.' The surrender was accepted, and a new patent was granted on the same day to the administrator, reciting the preceding facts, and that the surrender was 'on account of a defective specification,' and declaring that the new patent was extended for fourteen years from the 27th of December, 1828, 'in trust for the heirs at law of the said William Woodworth (the inventor), their heirs, administrators, or assigns.'

"Now, one of the objections taken to the patent is, that it is for the term of fourteen years, and not for the term of seven years, or for two successive terms of seven years. But it appears to me that this objection is not well founded, and stands *inter Apices juris*; for the new patent should be granted for the whole term of fourteen years from the 27th of December, and the legal effect is the

By supplemental bill the plaintiff may also bring in new parties and enlarge the charges contained in the original bill.¹

same as it would be if the patent was specifically renewed for two successive terms of seven years. The new patent is granted for the unexpired term only, from the date of the grant, viz., for the unexpired period existing on the 8th of July, 1845, by reference to the original grant in December, 1828. It is also suggested that the patent ought not to have been in trust for the heirs at law of the said William Woodworth, their heirs, administrators, or assigns. But this is, at most, a mere verbal error, if indeed it has any validity whatsoever; for the new patent will, by operation of law, enure to the sole benefit of the parties, in whose favor the law designed it should operate, and not otherwise. It seems to me that the case is directly within the purview of the tenth and thirteenth sections of the act of 1836, ch. 357, taking into consideration their true intent and objects.

“ Another objection urged against the continuation of the injunction is, that the breach of the patent assigned in the original bill can have no application to the new patent, and there is no ground to suggest that, since the injunction was granted, there has been any new breach of the old patent, or any breach of the new patent. But it is by no means necessary that any such new breach should exist. The case is not like that of an action at law for the breach of a patent, to support which it is indispensable to establish a breach before the suit was brought. But in a suit in equity, the doctrine is far otherwise. A bill will lie for an injunction, if the patent right is admitted or has been established upon well-grounded proof of an apprehended intention of the defendant to violate the patent right. A bill, *quia timet*, is an ordinary remedial process in equity. Now, the injunction already granted (supposing both patents to be for the same invention) is *prima facie* evidence of an intended violation, if not of an actual violation. And the affidavit of James N. Buffum is very strong and direct evidence to this same effect.

“ But the most material objection taken is, that the new patent is not for the same invention as that which has been surrendered. And, certainly, if this be correct, there is a fatal objection to the prolongation of the injunction. But is the objection well founded in point of fact? It is said, that the present patent is for a combination only, and that the old patent was for a combination and something more, or different. But I apprehend that, upon the face of the present patent, the question is scarcely open for the consideration of the court; and, at all events, certainly not open in this stage of the cause. I have already, in another cause, had occasion to decide, that where the Commissioner of Patents accepts a

¹ *Parkhurst v. Kinsman*, 2 Blatchf. 78. Here the supplementary defendant claimed to be *bonâ fide* purchaser from the original defendant, and as such entitled to defend himself, without regard to the condition of such original defendant, who was precluded by his own agreement from denying the validity of the patent. But the court held, that the supplementary defendant had acquired his interest not merely *pendente lite*, but also with a full knowledge of the nature and state of the litigation, and therefore could take no higher rights than the original defendant possessed. The court added, that the plaintiff might even have enforced his decree without any supplementary bill.

§ 408. III. *The Injunction.* We have now to state, in the first place, the general principles on which courts of equity proceed in granting, continuing, or dissolving injunctions. To obtain an surrender of an old patent and grants a new one, under the act of 1836, ch. 357, his decision, being an act expressly confided to him by law, and dependent upon his judgment, is not re-examinable elsewhere; and that the court must take it to be a lawful exercise of his authority, unless it is apparent upon the very face of the patent that he has exceeded his authority, and there is a clear repugnancy between the old and the new patent, or the new one has been obtained by collusion between the commissioner and the patentee. Now, upon the face of it, the new patent, in the present case, purports to be for the same invention, and none other, that is contained in the old patent. The avowed difference between the new and the old is, that the specification in the old is defective, and that the defect is intended to be remedied in the new patent. It is upon this very ground that the old patent was surrendered and the new patent was granted. The claim in the new patent is not of any new invention, but of the old invention more perfectly described and ascertained. It is manifest that, in the first instance, the commissioner was the proper judge whether the invention was the same or not, and whether there was any deficit in the specification or not, by inadvertence, accident, or mistake; and consequently he must have decided that the combination of machinery claimed in the old patent was, in substance, the same combination and invention claimed and described in the new. My impression is, that at the former trial of the old patent before me, I held the claim substantially (although obscurely worded) to be a claim for the invention of a particular combination of machinery for planing, tonguing, and grooving, and dressing boards, &c.; or, in other words, that it was the claim of an invention of a planing machine or planing apparatus such as he had described in his specification.

“It appears to me, therefore, that *prima facie*, and, at all events, in this stage of the cause, it must be taken to be true, that the new patent is for the same invention as the old patent; and that the only difference is, not in the invention itself, but in the specification of it. In the old, it was defectively described and claimed. In the new, the defects are intended to be remedied. Whether they are effectually remedied is a point not now properly before the court. But as the Commissioner of Patents has granted the new patent as for the same invention as the old, it does not appear to me that this court is now at liberty to revise his judgment, or to say that he has been guilty of an excess of authority, at least (as has been already suggested), not in this stage of the cause; for that would be for the court of itself to assume to decide many matters of fact as to the specification and the combination of machinery in both patents, without any adequate means of knowledge or of guarding itself from gross error. For the purpose of the injunction, if for nothing else, I must take the invention to be the same in both patents, after the Commissioner of Patents has so decided, by granting the new patent.

“Upon the whole, therefore, I do order and direct, that the injunction do stand continued as to the new patent stated in the supplemental bill, until the hearing or further order of the court.”

injunction, the plaintiff must accompany his application with an affidavit that he then believes himself to be the original and first inventor of the thing patented; for, it is said, although when he obtained his patent he might have very honestly sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information may have been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he applied for his patent.¹ Such a special affidavit was required by Mr. Justice Washington to be subjoined to a bill.² And it is the usual practice, on moving for an injunction before the answer has been filed, to read such an affidavit, as well as others to the same purport.³

§ 409. In the courts of the United States, notice that an injunction is to be applied for must be served on the defendant, as no injunction, whether temporary or final, can be granted without reasonable previous notice to the adverse party or his attorneys, of the time and place of moving for the same.⁴ Injunctions, therefore, are not granted in our courts on *ex parte* applications, in cases of patents, although they may be granted on filing the bill and before answer, on notice to the party to be affected, as well as after answer and upon the hearing.

In *Bickford v. Skewes*,⁵ the Vice-Chancellor said that it was unusual to make an order for the indemnity of the defendant by the plaintiff in case the patent should not be sustained, adding that in one instance, *Kay v. Marshall*, where he had gone out of the way of the court to make such order, his order had been overruled on appeal. It results from this that courts of equity are loath to grant an injunction unless the plaintiff's right is very clear, especially in cases where an account will answer all reasonable purposes.

§ 410. The bill and the application being, then, in proper form,

¹ *Hill v. Thompson*, 3 Meriv. 622, 624; *Sturz v. De La Rue*, 5 Russ. Ch. R. 322. The same reason exists at the time of the application, although the bill itself was sworn to when filed.

² *Rogers v. Abbot*, 4 Wash. 514; *Ogle v. Edge*, *Ibid.* 584. See also *Sullivan v. Redfield*, 1 Paine, 441.

³ See, further, as to affidavits, *post*, at the end of this chapter.

⁴ Act 2d March, 1793, ch. 22, § 5; *Perry v. Parker*, 1 Woodbury & M. 280, 281.

⁵ 1 Webs. Pat. Cas. 214.

the first thing to be considered is, whether the court will require the patentee to establish his legal right by an action at law, before it grants the injunction, or whether it will grant the injunction, in the first instance, upon the proof of a legal right, furnished by the bill itself, and the accompanying affidavits. Upon this point, the rule, as it was laid down by Lord Eldon, is, that where a patent has been granted, and there has been an exclusive possession of some duration under it, the court will interpose its injunction, without putting the party previously to establish the validity of his patent by an action. Where the patentee has surrendered his original patent and taken out another one with an amended specification, the action of the commissioner in granting the subsequent patent is *prima facie* evidence that the two patents are for the same invention, and can only be invalidated by clear proof of fraud, excess of authority, or manifest discrepancy.¹ But where the patent is but of yesterday, and, upon an application being made for an injunction, it is endeavored to be shown, in opposition to it, that there is no good specification, or otherwise, that the patent ought not to have been granted, the court will not, from its own notions upon the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will send the patentee to law to establish the validity of his patent in a court of law, before it will grant him the benefit of an injunction.²

§ 411. The rule thus stated has been followed by our own courts, with further explanations, which extend its application to the particular facts of the cases that have arisen. Thus, Mr. Justice Washington laid down the rule, as follows, that the practice is, to grant an injunction upon the filing of the bill, and before a trial at law, if the bill state a clear right, and verify the same by affidavit. If the bill state an exclusive possession of the invention or discovery, an injunction is granted, although the court may feel doubts as to the validity of the patent. But if the defects in the patent or specification are so glaring that the court can entertain no doubt as to that point, it would be most unjust to restrain the defendant from using a machine, or other thing, which he may have constructed, probably, at great expense, until a decision at law

¹ Potter v. Holland, MS. per Ingersoll, J.

² Hill v. Thompson, 3 Meriv. 622, 624.

can be had.¹ Upon another occasion, the same learned judge laid down the general rule in these terms, that, where the bill states a clear right to the thing patented, which, together with the alleged infringement, is verified by affidavit, if he has been in possession of it, by having used or sold it in part, or in the whole, the court will grant an injunction, and continue it till the hearing or further order, without sending the plaintiff to law to try the right. But, if there appeared to be a reasonable doubt as to the plaintiff's right, or as to the validity of the patent, the court will require the plaintiff to try his title at law, sometimes accompanied with an order to expedite the trial, and will permit him to return for an account, in case the trial at law should be in his favor. Mr. Justice Story, in *Washburn v. Gould*, referred to and adopted the general rule laid down by Lord Eldon, in *Hill v. Thompson*. In this case there had been a trial at law, which resulted in favor of the patentee.² Mr. Justice Woodbury has, in several cases, also acted upon it, with modifications, which will presently be stated.³

Where the defendant, in his answer, does not impeach the validity of the complainant's patent, but merely sets up a subsequent patent granted to himself, and denies that it is an infringement of the former one, the court is not precluded by the act of the commissioner in granting the subsequent patent without notice of interference to the prior patentee. According to the act of 1836, § 7, the Commissioner of Patents, when he thinks that there is a possibility of a patent interfering with one previously granted, must give notice to such prior patentee. But his action is not conclusive. For, says Kane, J., in giving the opinion of the court in *Wilson v. Barnum*:⁴ "It cannot be asked that a third person shall have his legal rights impaired or his legal remedies impeded by any proceeding to which he was not made and could not have made himself a party. To hold ourselves concluded by the action of the Patent Office, where that action has been without notice, would be as perilous to the interest of inventors as to that of the public." The conclusion drawn by the learned judge was, that the grant of the subsequent patent, under such circumstances, served merely

¹ *Isaacs v. Cooper*, 4 Wash. 259, 260.

² 3 Story's R. 156, 169.

³ *Orr v. Littlefield*, 1 Woodb. & M. 13; *Woodworth v. Hall*, Ibid. 248; *Hovey v. Stevens*, Ibid. 290. See also *Sullivan v. Redfield*, 1 Paine, 441.

⁴ 1 Wallace, C. C. 347.

to indicate the opinion which highly respectable officers had formed on an *ex parte* examination of the subject, but was not a case where the action of the Patent Office was conclusive or even *prima facie* evidence. In this case it was decided that the District Judge, sitting for the Circuit Court and being well satisfied of the fact of infringement, may grant an interlocutory injunction, although a majority of the experts examined thought that there was no infringement.

§ 412. It appears, therefore, that, upon the question of first sending the plaintiff to law to try the validity of his patent, the general rule must be subdivided according to the aspect and position of the case before the court. The cases may be ranged under three different classes: *first*, where there is nothing before the court, as evidence, but the bill and the affidavits in support of it; *second*, where the injunction is asked before the final hearing, and the respondent offers evidence, either in the answer or by affidavits, affecting the validity of the patent; *third*, where the question comes on upon the hearing, and the full proofs taken in the cause.

§ 413. These different aspects of the cause may now be considered separately, with reference to this question. *First*, where the plaintiff asks for an injunction upon the bill and affidavits, and no opposing evidence is adduced, but the respondent appears and objects. In such cases, the bill and the affidavits must show the issuing of the patent, and an exclusive possession of the right of some duration; and, when these are shown, although the court may feel some doubts as to the validity of the patent, the injunction will be granted without a previous trial at law; but if the patent contains glaring defects, so that no doubt can be entertained, or the bill is defective in material allegations, the injunction will not be granted, but the plaintiff will be required to try his title at law.¹ Some additional evidence, besides the mere issue of the patent, must be offered; and this evidence will be the fact that, after he had procured his patent, the plaintiff proceeded to put that right into exercise or use for some time without being dis-

¹ *Hill v. Thompson*, 3 Meriv. 622; *Harmer v. Plane*, 14 Ves. 130, 133; *Isaacs v. Cooper*, 4 Wash. 259; *Ogle v. Edge*, Ibid. 584; *Woodworth v. Hall*, 1 Woodb. & M. 248. Length of enjoyment is to be looked to in answer to a theoretical objection to the specification. *Bickford v. Skewes*, Webs. Pat. Cas. 211, 213.

turbed ; a circumstance that strengthens the probability that the patent is good, and renders it so likely as alone often to justify the issue of an injunction in aid of it.¹ It will also be further additional evidence, in support of the *prima facie* right to an injunction, that the patentee has successfully prosecuted other persons for violating it.²

If a patentee has established his title under original letters-patent, he is entitled to a temporary injunction under an extension of those letters-patent, without a trial at law or evidence of long possession.³ Furthermore, where the right to a temporary injunction does not depend upon any controverted and doubtful facts, but upon the interpretation to be put upon a written instrument, it is the duty of the court to interpret it and to grant or refuse the injunction accordingly.⁴

With regard to the question of infringement, it may be added, that it is not sufficient to produce the machine of the plaintiff and that of the defendant and submit them to an examination and comparison by the court ; at least where such a comparison would involve more than the usual amount of mechanical knowledge.⁵

§ 414 *Secondly*, where the injunction is asked for before the hearing, but opposing evidence is adduced by the respondent

¹ *Crr v. Littlefield*, 1 Woodb. & M. 13, 16. As to length of possession, see the observations of Mr. Justice Woodbury, cited from this case, *post*.

² *Ibid*.

³ *Clum v. Brewer*, 2 Curtis, C. C. 506.

⁴ *Ibid*. "There may be cases in which there is so much doubt what the parties to an instrument intended to effect by it, that the court may think it proper to suspend its judgment until the surrounding circumstances can be more fully and safely examined on a final hearing. It is possible, also, that where there are grave doubts concerning the legal effect of an instrument, the court might decline to interfere by special injunction, even though, if compelled to decide, their decision must be in favor of the complainant. Probably the circumstances of the case, and the degree of mischief which would be suffered by refusing the injunction, compared with the inconvenience and loss occasioned by granting it, would control the action of the court in the case supposed. But in general, I apprehend, if the title to a temporary injunction depends on the construction of a deed, the court will construe it, and act accordingly, whatever view of that question the answer may have presented." Per Curtis, J. It may be well to add, by way of explanation, that the instrument in discussion was a deed of articles of agreement under the patent, and that the defendants claimed under a license from one of the grantees.

⁵ Per Sprague, J., *Howe v. Morton et al.*, MS.

against the validity of the patent. In these cases, several elements enter into the rule that is to guide the discretion of the court. How far, and for what length of time, there has been an exclusive possession or assertion of the right; how far the respondent has succeeded in raising doubts as to the novelty of the invention, or as to its being a patentable subject, or as to the infringement; and how far a long possession will go to counteract evidence impeaching the validity of the patent, — are some of the circumstances to be weighed in determining whether the plaintiff's *prima facie* right to an injunction has been answered by the respondent, to that extent that the court will suspend the injunction until the plaintiff has established his right by an action. It seems to be the result of all the authorities that there is a *prima facie* right to an injunction, without a trial at law, upon certain things being shown, namely, a patent, long possession, and infringement.¹ The question will therefore be, in cases of opposing evidence, where that right has been shown, whether it has been displaced by the respondent.

Where the patentee has made a partial assignment and entered into an agreement with the assignee in the nature of a copartnership, the assignee cannot, in a bill for an injunction, deny the validity of the patent, or set up in defence an outstanding patent which he has bought up from some third party, by way of impeaching the originality.²

§ 415. When the presumption in favor of the validity of the patent has been strengthened by evidence of enjoyment and possession undisturbed for several years, and recoveries against other persons for violating it, it will not be sufficient to deprive the

¹ In *Neilson v. Thompson*, Webs. Pat. Cas. 277, Sir L. Shadwell, V. C., said: "It seems to me, on these affidavits, that it is sufficiently made out that there has been a use of the patent in this sense, that the right of the patentee to the benefit of the patent has been submitted to where there has been a contest, and it does not at all appear to me that the general way in which the defendants, on their affidavit, state the mode by means of which the plaintiffs succeeded in establishing the patent, is at all an answer to the two cases which are stated in Mr. Blunt's affidavit. Then I have the case of a patent having been obtained in the year 1828, and actually enjoyed by the patentee for upwards of twelve years. *Primâ facie*, I apprehend, that gives a right to the patentee to come into court in a case in which he can show an infringement; and the question is, has there been an infringement?"

² *Kinsman v. Parkhurst*, 18 How. 289.

plaintiff of the injunction before a trial at law, for the defendant to read affidavits tending to cast doubts on the originality of the invention, especially if that evidence is answered by what is stronger on the part of the patentee.¹

¹ *Orr v. Littlefield*, 1 Woodb. & M. 13. In this case, Mr. Justice Woodbury said: "It is not enough that a party has taken out a patent, and thus obtained a public grant, and the sanction or opinion of the Patent Office, in favor of his right, though that opinion, since the laws were passed, requiring some examination into the originality and utility of inventions, possesses more weight. But the complainant must furnish some further evidence of a probable right; and though it need not be conclusive evidence, else additional hearing on the bill would thus be anticipated and superseded, yet it must be something stronger than the mere issue, however careful and public, of the patent, conferring an exclusive right; as, in doing that, there is no opposing party, no notice, no long public use, no trial with any one of his rights. The kind of additional evidence is this: if the patentee, after the procurement of his patent, conferring an exclusive right, proceeds to put that right into exercise or use for some years, without its being disturbed, that circumstance strengthens much the probability that the patent is good, and renders it so likely, as alone often to justify the issue of an injunction in aid of it. *Ogle v. Edge*, 4 Wash. C. C. 584; 2 Story's Eq. Jur. 210; *Drew on Injunc.* 222; *Phil. on Pat.* 462. After that, it becomes a question of public policy, no less than private justice, whether such a grant of a right exercised and in possession so long, ought not to be protected until avoided by a full hearing and trial. *Harmer v. Plane*, 14 Ves. 130.

"In this case, the evidence is plenary and uncontradicted, as to the use and sale of this patent, by the inventor and his representative, for several years, publicly and without dispute. Computing from the original grant, the time is over nine years, and since the reissue of the letters-patent it is nearly three. I concur in the opinion delivered by Judge Sprague, in *Orr v. Badger*, that the time to be regarded under this view is what has elapsed since the original issue or grant. *Law Reporter* for February, 1845. In *Thompson v. Hill*, 3 Meriv. 622, the time was only three years from the first grant. In *Ogle v. Edge*, 4 Wash. C. C. 584, it was but six years. And though, in some cases reported, it had been thirteen, and in others twenty years (14 Ves. 120), yet it is believed, that seldom has a court refused an injunction in applications like this, on account of the shortness of time after the grant, however brief, if long enough to permit articles or machines to be constructed by the patentee in conformity to his claim, and to be sold publicly, and repeatedly, and they have been so used and sold, under the patent, without dispute. Here the sales were extensive and profitable, from 1836, downwards, and the right as well as the possession does not appear to have been contested till 1842. In *Hill v. Thomson*, 3 Meriv. 622, 624, it is true that the court dissolved an injunction when only about one year had elapsed since any work had been completed under the patent, and only two years since the specification was filed, the chancellor calling it a patent 'but of yesterday,' but he added that he would not dissolve it if 'an exclusive possession of some duration' had followed; though an answer had been put in denying all equity, and doubts existed as to the validity

§ 416. But when an injunction is asked before the trial and resisted, and doubts are cast on the originality and validity of the patent, and no sales under it were proved in that case. So, though the patent had been issued thirteen years, and the evidence is doubtful, as to *acquiescence* in the possession or use, an injunction may be refused. *Collard v. Allison*, 4 Mylne & Craig, 1487. But in the present case, the acquiescence appears to have been for several years universal.

“ Another species of evidence, beside the issue of the patent itself, and long use and possession under it, so as to render it probable the patent is good, and to justify an injunction, is the fact that if the patent becomes disputed, the patentee prosecutes for a violation of his rights, and recovers. Same authorities; *Kay v. Marshall*, 1 Mylne & Craig, 373. This goes upon the ground that he does not sleep over his claims or interests, so as to mislead others, and that, whenever the validity of his claim has been tried, he has sustained it as if good. But such a recovery is not regarded as binding the final rights of the parties in the bill, because the action was not between them; though, when the judgment is rendered without collusion or fraud, it furnishes to the world some strong as well as public assurance that the patent is a good one. In this view of the evidence of this character in the present action, it is not contradicted nor impaired at all by the judgments having been given on verdicts and defaults, under agreements. Such judgments, when, as is admitted here, not collusive, are as strong, if not stronger evidence of the patentee’s rights, than they would have been if the claim was so doubtful as to be sent to a jury for decision, rather than to be so little doubtful as to be admitted or agreed to after being legally examined. Both of these circumstances, therefore, possession and judgments, unite in support of an injunction in the present case.

“ The only answer to the motion, as made out on these grounds, is the evidence offered, by affidavits, on the part of the respondents, tending to cast doubt on the originality of the invention of the patentee. I say, tending to this, because some of the affidavits, at least, do not distinctly show that the persons making them intended to assert that the whole of any one of the combination of particulars contained in Dr. Orr’s claim, in his specification, had been used before his patent issued; because they are counteracted by other testimony from the witnesses of the complainants, more explicit and in larger numbers; and because, in this preliminary inquiry, where the evidence is taken without the presence or cross-examination of the opposite party, it would be unsafe to settle and decide against the validity of the patent, when a full and formal trial of it is not contemplated till further progress is made in the case. All that is required in this stage is the presumption before named that the title is good. This presumption is stronger here than usual, as it arises from the issue of the patent, and an enjoyment and possession of it undisturbed for several years, beside the two recoveries against those charged with violating it.

“ After these, other persons can, to be sure, contest the validity of the patent, when prosecuted either in equity or at law; but it is hardly competent for them to deprive the complainant of her right, thus acquired, to an injunction, or, in other words, to be protected in so long a use and possession, till her rights are disproved, after a full hearing; surely it is not reasonable to permit it when the affi-

patent, if the counterbalancing and fortifying circumstances of long possession, use, or sale to a considerable extent, and former affidavits of the respondents to invalidate or cast a shade over her right are met by that which is stronger, independent of the long possession, judgments, and presumptions before mentioned. But another objection has been urged in argument. When an answer to the bill denies all equity in it, the respondents contend that an injunction would be dissolved, and hence it ought not to be imposed, if the respondent denies equity by affidavit. This may be correct, in respect to injunctions termed *common*, as these affidavits and counter-affidavits are inadmissible. *Eden*, 117, 326. Yet, in these, the denial must be very positive and clear. *Ward v. Van Bokkelen*, 1 Paige, 100; *Noble v. Wilson*, *ib.* 164. But the position cannot be correct in the case of injunctions called *special*, like the present one, and where facts and counter-evidence show the case to be different from what is disclosed in the affidavits, or an answer of the respondents alone. No usage or cases are found where the injunctions are dissolved, as a matter of course, on such answers, if the complainant has adduced auxiliary presumptions in favor of his right, like those in the present instance. On the contrary, the cases are numerous where the whole is regarded as still within the sound discretion of the court, whether to issue the injunction or refuse it; or, if issued, to dissolve or retain it. 3 Meriv. 622, 624; 2 Johns. Ch. R. 202; 3 Sumn. 74; *Livingston v. Van Ingen*, 9 Johns. R. 507, 570; *Rodgers v. Rodgers*, 1 Paige, 426. And where the complainant has made out not merely a grant of the patent, but possession and use, and sale under it, for some time, undisturbed, and beside this, a recovery against other persons using it, the courts have invariably held that such a strong color of title shall not be deprived of the benefit of an injunction till a full trial on the merits counteracts or annuls it. In several cases, where the equities of the bill were even denied, and in others, where strong doubts were raised, whether the patent could, in the end, be sustained as valid, the courts decided, that injunctions should issue under such circumstances, as have before been stated in favor of the plaintiff, till an answer or final hearing; or, if before issued, should not be dissolved till the final trial, and then cease, or be made perpetual, as the result might render just. The Chancellor, in *Roberts v. Anderson*, 2 Johns. Ch. R. 202, cites 2 Vesey, 19, and *Wyatt's P. R.* 236; *Boulton v. Bull*, 3 Ves. 140; *Universities of Oxford and Cambridge v. Richardson*, 6 Ves. 689, 705; *Harmer v. Plane*, 14 Ves. 130; and *Hill v. Thompson*, 3 Mer. 622, 624." See also *Sargent v. Seagrave*, 2 Curtis, C. C. 553. *Sargent v. Carter*, 21 Mon. Law Rep. 651. *Newall v. Wilson*, 19 E. L. & Eq. 156, where it was held to be no acquiescence in an infringement, that the patentee had not caused a subsequent patent to be repealed by *scire facias*, such patent not having been put in use. *Potter v. Holland*, MS. per Ingersoll, J.

There was a case before Sir L. Shadwell, V. C., where a good deal of doubt, as to the originality of the invention, was raised, by the introduction of a former patent and specification, but the plaintiff had enjoyed uninterrupted possession for seven years; and the infringement being clearly shown, the injunction was granted before trial, and a trial ordered. *Losh v. Hague*, *Webs. Pat. Cas.* 200. In like manner, Mr. Justice Story held that the affidavit of a single witness, after long possession, and other recoveries on the patent, would not outweigh the oath

recoveries under it, do not exist, the injunction will not be allowed before trial.¹

§ 417. Where the patentee has been guilty of laches in not bringing his injunction bill, the court will not entertain a motion for an interlocutory injunction. Thus, where the bill was filed in July, and it appeared that the plaintiff wrote to the defendant in November of the year preceding, complaining of the infringement, and knew of the same even as far back as August of that year, a motion for an interlocutory injunction was dismissed.²

§ 418. If the respondent succeeds in raising doubts both as to the exclusive possession and as to the novelty of what is claimed, and the evidence on these points is conflicting, the injunction will be refused until a trial.³

§ 418 a. The issue of novelty may, in an injunction bill, be raised in a manner such as to warrant a peremptory refusal of the patentee's application, namely, by the defendants alleging a so-called publication in law. This topic has already been fully discussed in the chapter on Action at Law, and the ruling of the Master of the Rolls quoted at length. Here we only purpose giving the words of the refusal: "I have now examined the affidavits in this case, and I find in them nothing to alter the opinion I have already expressed. I think it is clearly proved that the principle of these targets (plaintiffs') was first discovered by De Brettes, was published in a foreign country by the Vicomte du Moncel, in his book, and that that book was afterwards sold and made common here in 1857. (The plaintiffs' specification was filed in 1860.) As a question of law, therefore, there was an actual publication of the plans claimed by the plaintiffs as theirs; and that question cannot obviously be affected by any consideration of the number of persons among the public who may have thought proper to avail themselves of the publication. It may be

of the patentee, and the general presumption arising from the grant of the patent. *Woodworth v. Sherman*, 3 Story's R. 171, 172. See also *Orr v. Badger*, 10 Law Reporter, 465.

¹ *Hovey v. Stevens*, 1 Woodb. & M. 290. The patent in this case had been issued less than a month before the infringement complained of.

² *Bovill v. Crate*, 1 Law Rep. Eq. 387.

³ *Collard v. Allison*, 4 Mylne & Cr. 487, 488.

very hard on the plaintiffs, especially when they have taken every possible pains to ascertain whether their invention has been previously made public, to find that it has been anticipated ; but still that will not alter the case. There will yet be the question — and, as in this case, the only one — whether the Vicomte du Moncel's book, having been sent, as it was, to this country for the purpose of sale, there was *in law a publication* of the plan claimed by the plaintiffs prior to their specification. As I have said, I think there was such a publication, and the decree must be in accordance with that view.”¹

On the other hand, in a case which at first would appear similar, but in which the questions of identity and sufficiency were as matters of fact involved, the Lord Chancellor said : —

“ But it is contended that the invention is not new, and that the patent is therefore invalid, and reference is made, for the purpose of establishing this case, to a patent obtained by one Collins, as far back as 1800, the object of which was, among other things, to manufacture sheathing of a mixture of copper and zinc ; but although this patent was obtained upwards of forty years ago, it does not appear that the article was ever introduced into use, or a single sheet of sheathing ever manufactured under it. If it ever attracted public notice, it appears to have been long since forgotten. I am satisfied, on the evidence, that it was unknown to Mr. Muntz at the time when he obtained his patent, and I am further satisfied the object would not have been accomplished by ordinary copper and zinc united according to Collins's process ; that any attempt made to effect this would have failed, which may well account for no public use having been made during so long a period of this patent. It was said, indeed, by the defendants, that the sheathing manufactured by them was made according to Collins's specification, but this sheathing appears to have been subjected to a third analysis, and it turns out to be composed of the purest copper and the purest zinc, in the same proportions as are recommended by Mr. Muntz in his specification. It follows, therefore, that the two component articles must either have originally been not of the ordinary but of the purest quality, or, which appears from the evidence to have been the most probable case, that they must have been purified in the course of the process, by some mode which is not described or suggested in Collins's specification. As the evi-

¹ Lang v. Gisborne, 6 Law Times, N. S. 771.

dence, therefore, does not satisfy me that sheathing could be manufactured according to the former patent, I do not consider the novelty of Mr. Muntz's specification successfully impeached by reference to that patent." ¹

§ 419. If the question of infringement is doubtful, it must be tried by a jury; and in a case of this kind, Sir L. Shadwell, V. C., dissolved an injunction, and ordered an action to be brought to try the infringement, the respondents being ordered to keep an account, and to admit the plaintiff's title to the patent.² The same rule would be applicable to the granting an injunction in the first instance.

Thus, in an injunction bill arising under Muntz's patent, Vice-Chancellor Shadwell said, that, although he would not then put any construction on the patent, it was impossible not to see that the rolling hot was a material feature in the invention; and as the defendants did not roll hot, he would not grant the injunction, but would leave the plaintiff to his action.³

It is, however, for the court alone to decide whether there is any doubt as to the matter of infringement, and the granting of a feigned issue is not a matter of right. Thus, in the case of *Van Hook v. Pendleton*,⁴ a motion for a feigned issue was denied. Nelson, J. said: "If we do not entertain doubts on that question (of infringement), it will be our duty to decide it; for we are not aware of any principle that will justify us in sending the case to a jury, unless we shall be brought to doubt on the question of identity." Similarly, Betts, J.: "It is not a matter of course to order a feigned issue; but the party applying must lay a foundation for it. . . . A feigned issue is not to be granted unless the opinion of a jury on the question is found to be needed. And after a jury shall have passed upon the matter, it will be for the court to say, whether the verdict is right, and the court may set it aside."⁵

§ 420. It seems, also, that another element to be considered is,

¹ *Muntz v. Foster*, 2 Webs. Pat. Cas. 95.

² *Morgan v. Seaward*, 1 Webs. Pat. Cas. 167.

³ *Muntz v. Vivian*, 2 Webs. Pat. Cas. 87.

⁴ 2 Blatchf. 87.

⁵ Compare, *infra*, *Goodyear v. Day*, 2 Wall. C. C. 283.

the effect of the injunction on the defendant's business. As the granting of an injunction rests in the discretion of the court exercised upon all the circumstances of the case; and as the object of the injunction is to prevent mischief, it is said that where irreparable mischief would ensue from it to the defendant, it ought not to be granted.¹ But this must be understood as applying to a case where the plaintiff would not be injured by the delay, but would be left in *statu quo* after a trial establishing the validity of his patent; or at least, where the rights of the plaintiff are capable of being fully protected by an account to be kept in the interim; because the object of the court is to preserve to each party the benefit to which he is entitled.²

The ruling of Judge Curtis, in the case of *Forbush v. Bradford*,³ contains a full and clear enunciation of the doctrines of equity applicable to such cases: "In acting on applications for temporary injunctions to restrain the infringement of letters-patent, there is much latitude for discretion. The application may be granted or refused unconditionally, or terms may be imposed on either party as conditions for making or refusing the order. And 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 denying the motion, must all be considered in determining whether it shall be allowed or refused, and if at all, whether absolutely or upon some and what conditions. In this case the thing patented is an improvement on a loom. The loom itself is not claimed; but only a particular modification of a loom already in use.

"The defendants in these cases do not make and sell looms having the patented improvement; they only use in their mills a certain number of such looms. The complainants are makers of looms, but do not use them. So that this particular mode of infringement, by the use of the thing patented, though it is a violation of the exclusive right claimed by the complainants, does not deprive them of a monopoly which they desire to retain in their own hands, because, practically, it deprives them only of what they would be entitled to receive for a license to use the thing pat-

¹ *Neilson v. Thompson*, Webs. Pat. Cas. 278, 286.

² *Ibid.*

³ 21 Mon. Law Rep. 471.

ented, nor does it, like the manufacture and sale of the thing patented, constantly widen the field of litigation, and render it more and more difficult for the complainants to vindicate their rights.

“On the other hand, the defendants cannot be prohibited from using the thing patented without, at the same time, being deprived of the use of the entire loom. For though it is possible to alter the looms and work them without the patented improvement, it is shown that, in the present state of the business, and while this litigation is pending, no prudent man would do this. The practical effect of an injunction would, therefore, be to stop all these looms, and thus deprive the defendants of the use of a large amount of capital lawfully invested, and which they have the right to the benefit of; and it would also throw out of employment a large number of operatives who are now engaged in running the looms, and in the processes of manufacture which depend upon their use. All this would not prevent the court from granting an injunction, if the right had been finally established at law. But a bill of exceptions has been taken, upon points which involve the validity of the patent. This again does not present an insuperable objection to a temporary injunction. The court is bound to exercise its own judgment upon the questions involved in the bill of exceptions, with a view to see whether the litigation that remains presents such serious doubts concerning the title as ought to influence its judgment in granting or withholding the injunction. I can conceive of many cases in which a temporary injunction ought to issue, where there has been a trial at law and a bill of exceptions taken, even though serious questions are raised, upon which the court of errors may reverse the judgment.¹ And *a fortiori*, when the court that tried the cause, and is applied to for an injunction, is fully satisfied of the correctness of its judgment. But even in such a case, when the bill of exceptions is not merely frivolous, as the litigation is not in fact terminated, and its result may be adverse to the complainant's title, it is necessary for the court to contemplate that as a possible result, and look at the consequences in that event of allowing or refusing the injunction.

“Upon the particular facts of these cases, I am of opinion that an injunction should issue, unless, within ten days after notice of the order, the defendants shall give a bond with sufficient

¹ *Budson v. Benecke*, 12 Beavan, 1.

surety, to be judged of by the clerk of this court, conditioned to keep an account of the quantity of cloth made on each of the looms in question, and to file such account under oath, once in three months in the clerk's office of this court, and to pay the amount of any final decree in the cause."

§ 421. Nor will an injunction be granted, where the plaintiff has permitted the defendant to go on and incur expense under the expectation of receiving a certain sum, if the relations between them are such as to allow of the defendant's disputing the plaintiff's right as patentee.¹ But it seems that where the defendant is estopped at law from denying the validity of the patent, an injunction will be granted; but if there is a real question to be tried, and a year's rent for the use of the invention is due, the court will order the money to be paid into court, to wait the event of the trial.²

Where it appeared that the defendant was engaged in fulfilling a contract which was confessedly in violation of the patentee's right, but into which he (defendant) entered with the implied understanding that the question between him and the patentee was to be merely one of damages, it was held that no injunction ought to issue restraining him from completing the contract.³

§ 422. If the plaintiff shows the necessary possession, and an infringement has actually been committed by the defendant, the injunction will be granted, notwithstanding the defendant admits the infringement and promises not to repeat it.⁴

¹ Neilson v. Thompson, Webs. Pat. Cas. 278, 286.

² Neilson v. Fothergill, Webs. Pat. Cas. 287, 289, 290. See further as to injunctions against licensees, *post*. As to effect of previous compromise between patentee and alleged defendant, see Sargent v. Larned, 2 Curtis, C. C. 340.

³ Smith v. Sharp Manuf. Co. 3 Blatchf. 545.

⁴ Losh v. Hague, 1 Webs. Pat. Cas. 200. Sir L. Shadwell, V. C.: "It really seems to me that this is a case in which I must grant the injunction, because, as I understand it, the wheels that the defendant has made are certainly wheels made according to that thing for which, as I understand it, the plaintiff has taken out his patent, — the substance of part of the patent being for making wheels that shall have the spoke and the felloe in parts of the same piece, that is, in other words, the spoke is to be made with an elbow bend, which elbow bend will constitute a part of the felloes. Now it seems to me that there can be no question, but that the wheels complained of as having been made by the defendant do an-

Furthermore, in an application for an injunction, it is not a sufficient answer to allege that the infringement has been discontinued, without offering compensation for such unlawful use.¹

§ 423. *Third.* The third class of cases is where the question of granting the injunction comes on upon the final hearing; and here the situation of the parties is entirely different from the state of things on an interlocutory motion. The object of a bill in equity to protect a patent is a perpetual injunction; and this in general can only be granted at the hearing; and if granted at the hearing, it will necessarily be perpetual. Objections raised by the defendant, therefore, to the validity of the patent, at the hearing, require a very different consideration from the court; because the question is, whether the court will give any assistance to a party, who might have applied for an interlocutory hearing, and so have given the defendant an opportunity to have the legal title investigated, but has not done so. In such cases, where there are no circumstances shown which would have prevented the plaintiff from asking for an injunction in the progress of the cause, it will not only not be granted at the hearing, but the bill will be dismissed with costs, if it has been pending for a long time, and the answer had denied the validity of the patent and the fact of infringement.²

swer the description of the plaintiff's wheels, and I do not think it enough, on a question of injunction, for the defendant to say why he has done the thing complained of, but will not do it again. That is not the point, because, if a threat had been used, and the defendant revokes the threat, that I can understand as making the plaintiff satisfied; but if once the thing complained of has been done, I apprehend this court interferes, notwithstanding any promise the defendant may make not to do the same thing again."

¹ *Sickels v. Mitchell*, 3 Blatchf. 548.

² *Bacon v. Jones*, 4 Mylne & Cr. 433. In this case Lord Cottenham said: "Generally speaking, a plaintiff who brings his cause to a hearing is expected to bring it on in such a state as will enable the court to adjudicate upon it, and not in a state in which the only course open is to suspend any adjudication until the party has had an opportunity of establishing his title by proceedings before another tribunal. And I think the court would take a very improper course, if it were to listen to a plaintiff who comes forward at the hearing, and asks to have his title put in a train for investigation, without stating any satisfactory reason why he did not make the application at an earlier stage. When he comes forward upon an interlocutory motion, the court puts the parties in the way of having their legal title investigated and ascertained; but when a plaintiff has neglected to avail himself of the opportunity thus afforded, it becomes a mere question of discretion,

§ 424. The next question is, supposing that an injunction is not to be granted *simpliciter*, what course is to be taken. This part of the subject embraces the cases where the plaintiff will be sent to try his title at law, without an injunction; and the cases where an injunction will be granted, but the plaintiff will be required to establish his patent at law. The plaintiff will be sent to a court of law to establish the validity of his patent without a previous injunction, if he does not show long possession and exercise of his exclusive right, where the injunction is resisted by evidence which casts doubt on the originality of his invention, or on the question

how far the court will assist him at the hearing, or whether it will then assist him at all.

“If, indeed, any circumstances had occurred to deprive him of that opportunity in the progress of the cause, the question might have been different. But in this case I have not heard any reason suggested why the plain and ordinary course was not taken by the plaintiffs of previously establishing their right at law. They might have brought their action before filing the bill, or they might, after the bill was on the file, have had their right put in a train for trial. Instead of that, they have allowed the suit to remain perfectly useless to them for the last four years. They knew of the alleged infringement in the month of August, 1835; and from that time till the hearing there was no moment at which they might not, by applying to the court, have had liberty to bring an action to establish their title at law. It is obvious that such a line of proceeding exposes a defendant to inconveniences which are by no means necessary for the protection of the plaintiff. It is no trifling grievance to have a chancery suit hanging over him for four years, in which, if the court shall so determine at the hearing, he will have to account for all the profits he has been making during the intermediate period. Is a defendant to be subject to this annoyance without any absolute necessity, or even any proportionate advantage to his adversary, and without that adversary being able to show any reason why he did not apply at an earlier time. It appears to me that it would be very injurious to sanction such a practice, more especially when I can find no case in which the court has thought it right to retain a bill, simply for the purpose of enabling a plaintiff to do that which these plaintiffs might have done at any time within the last four years. It was much more regular and proper that the plaintiffs should have taken steps for putting the legal right in a course of trial. Those steps they have not chosen to take, and it is now impossible to put the defendants in the same position in which they would have stood if such a course had been originally adopted.

“For these reasons, I am of opinion that the Master of the Rolls, finding that the evidence in the cause was not such as he could act upon with safety, came, in the exercise of his discretion, to a sound conclusion, when he refused to grant the injunction or retain this bill. I have purposely abstained from saying anything as to the legal rights of the parties, because I do not think the case in such a state as to enable me to adjudicate upon it. The appeal must be dismissed with costs.”

of infringement, or where the patent contains gross and obvious defects.¹

In a motion for an interlocutory injunction, the defendant, claiming under a patent subsequent to that of the plaintiff, cannot set up the action of the commissioner in granting his own patent as a bar upon the issue of infringement, where the commissioner had given no notice of interference to the prior patentee. In some respects, it is true, the action of the commissioner has a quasi-judicial character; but where he perceives no interference and issues no notice to the prior patentee, such patentee is not bound by his subsequent action. His grant of letters-patent to the subsequent patentee is nothing more than an *ex parte* opinion formed by a highly respectable and intelligent officer.²

In *Sickels v. Young*,³ the court ruled that a motion for a preliminary injunction was not to be granted unless the right was clear in favor of the complainants, and that it, the court, was not even bound by the verdict of a jury appointed to try the special issue of infringement, where the evidence was very conflicting.

§ 425. With regard to the length of time during which possession and exercise of the exclusive right must be shown, it does not appear that any specific lapse of time has been adopted as a standard; and, indeed, it is manifest that no positive rule can be assumed, applicable to all cases. The general principle is, as we have seen, that the time elapsed between the granting of the patent and the application for an injunction must have been sufficient to have permitted articles or machines to be constructed by the patentee in conformity with his claim, and to be sold publicly and repeatedly.⁴ It must also appear, that the thing has in fact been sold publicly, if that is the kind of possession relied on;⁵ and where

¹ *Hovey v. Stevens*, 1 Woodb. & M. 290; *Ogle v. Edge*, 4 Wash. 584; *Collard v. Allison*, 4 Mylne & Cr. 488; *Morgan v. Seaward*, Webs. Pat. Cas. 167. By defects is to be understood such as raise doubts as to the merits, — that is, the originality or usefulness of the patent, or the patentee's own error in the specification. *Woodworth v. Hall*, 1 Woodb. & M. 400. As to defects arising from the acts of public officers, see *post*.

² *Wilson v. Barnum*, 1 Wall. C. C. 347.

³ *Sickels v. Youngs*, 3 Blatchf. 293.

⁴ See the observations of the court, cited *ante*, from *Orr v. Littlefield*, 1 Woodb. & M. 13, 17.

⁵ *Ibid.* *Hovey v. Stevens*, 1 Woodb. & M. 290, 303.

the proof of possession consists of former recoveries, or licenses granted to parties who have been sued and have submitted, if it appears doubtful whether such recoveries and submissions were not collusively obtained, the necessary kind of possession will not be made out, and the right will first have to be tried at law.¹ But it does not impair the effect of such recoveries or submissions, that they were obtained by agreement and without trial, if there was at first a real contest.²

§ 426. Where, however, former use or former recoveries are relied upon, as proof of the possession of the exclusive right, they must have been under the same patent, or under a patent connected in law with that under which the application is made; otherwise it will not appear that they related to the same right.³ But under our system of amending specifications, or of surrendering an old patent and taking out a new one on account of informalities, the right in contemplation of law remains the same, after the issue of the new patent, if it is in fact for the same invention; and, consequently, a former possessor under the old patent will be ground for granting an injunction, without a previous trial, under the amended patent.⁴ Usually, where an injunction is not granted, but the plaintiff is required to establish his title at law, the defendant will be ordered to keep an account until the question is determined.⁵

¹ *Collard v. Allison*, 4 Mylne & Cr. 487, 488; *Kay v. Marshall*, 1 Mylne & Cr. 373; *Orr v. Badger*, 10 Law Reporter, 465; *Orr v. Littlefield*, 1 Woodb. & M. 13, 17, 18.

² *Orr v. Littlefield*, 1 Woodb. & M. 13, 17, 18; *Orr v. Badger*, 10 Law Rep. 465. In *Nelson v. Thompson*, Webs. Pat. Cas. 275, 276, the plaintiff's solicitor proved the preparation and granting of fifty or sixty licenses, and also various infringements by parties who submitted and took a license on proceedings being commenced against them. Sir L. Shadwell, V. C. said: "It seems to me, on these affidavits, that it is sufficiently made out that there has been a use of the patent in this sense, that the right of the patentee to the benefit of the patent has been submitted to where there has been a contest, and it does not at all appear to me that the general way in which the defendants on their affidavit state the mode by means of which the plaintiffs succeeded in establishing the patent is at all an answer to the two cases which are stated in Mr. Blunt's affidavit. Then I have the case of a patent having been obtained in the year 1828, and actually enjoyed by the patentee for upwards of twelve years."

³ *Hovey v. Stevens*, 1 Woodb. & M. 290.

⁴ *Orr v. Badger*, 10 Law R. 465.

⁵ See *post*, as to the account.

§ 427. The cases where an injunction will be granted, but the plaintiff will be required to establish his patent at law, do not admit of any very precise classification under a distinct rule. The court must exercise its discretion upon the circumstances.¹ If the plaintiff has, by proof of possession and enjoyment, made out a *prima facie* case for an injunction, it will then be for the court to consider whether the nature of the case entitles the defendant to a farther investigation into the validity of the patent or into the fact of infringement. The defendant will have a right to farther investigation, if he shows that there are any questions of fact or of law which a court of equity does not ordinarily undertake to

¹ In *Harmer v. Plane*, 14 Ves. 130, 131, Lord Eldon thus explained the grounds on which an injunction should be granted in cases where there is so much doubt as to require further investigation. "The ground upon which, where doubt is excited in the mind of the court, an injunction is granted until the legal question can be tried, a ground that was acted upon in the case of *Boulton v. Watt* (*Boulton v. Bull*, 2 Hen. Black. 453; 3 Ves. 140; *Hornblower v. Boulton*, 8 Term Rep. 95; *Hill v. Thompson*, 3 Mer. 622), in some cases preceding that, and some that have occurred since, is this: Where the crown on behalf of the public grants letters-patent, the grantee, entering into a contract with the crown, the benefit of which contract the public are to have, and the public have permitted a reasonably long and undisputed possession under color of the patent, the court has thought, upon the fact of that possession proved against the public, that there is less inconvenience in granting the injunction until the legal question can be tried, than in dissolving it at the hazard, that the grant of the crown may in the result prove to have been valid. The question is not really between the parties on the record; for, unless the injunction is granted, any person might violate the patent, and the consequence would be that the patentee must be ruined by litigation. In the case of *Boulton and Watt*, therefore, though a case of great doubt, upon which some of the ablest judges in Westminster Hall disagreed, yet upon the ground of the possession by the patentees against all mankind, the injunction was granted until the question could be tried; and the result of the trial, being in favor of the patent; proved that the conduct of the court, in that instance, was at least fortunate.

"The first of these patents, granted in the 27th year of his present majesty, is expired, and the patent for the improvements was granted in the 34th Geo. III. The agreement entered into by this defendant for a license to work under the patentee, would not bind the defendant. If the plaintiff could not legally grant that license, there was no consideration; and the question between them, therefore, is entirely open. Still, however, the patentee has had possession against all the world, and if he can maintain its validity by a due performance of the condition as to enrolment of the specification, by dissolving the injunction in the mean time, I should act both against principle and practice; not only enabling this defendant against law to exercise a right in opposition to the patent, but also encouraging all mankind to take the same liberty."

settle; and this investigation will generally be ordered to take place in an action at law, although it is competent for the court to direct an issue out of chancery.¹

¹ *Harmer v. Plane*, 14 Ves. 130, 131; *Hill v. Thompson*, 3 Meriv. 622, 630; *Wilson v. Tindal*, Webs. Pat. Cas. 730, note. In this case, Lord Langdale, M. R., said: "Having regard to the arguments on the validity of the patent, to the enjoyment of it by the plaintiffs, and to the evidence which appears upon the affidavits which have been made in this case, I am of opinion that the injunction which is applied for ought to be granted.

"The question for consideration is, whether any terms ought to be imposed upon the plaintiffs, or whether any other mode of investigating the facts than that which is adopted in the usual course of proceeding in this court, ought to be adopted. It is to be observed, that all orders made on applications of this kind are merely interlocutory orders; they do not bind the right between the parties. The injunction which I have stated it to be my intention to grant will be an injunction only until further order. It will not be a perpetual injunction; not an injunction to continue during the continuance of the patent. Notwithstanding this order, the defendant may put in his answer, he may displace all the affidavits which have been filed on both sides. The plaintiff and the defendant may respectively proceed to evidence, they may bring their cause on for a hearing, and upon the hearing of the cause, the whole case, the law regarding the patent, and the facts which will appear upon the depositions, will have to be reconsidered; and that reconsideration may, for anything that can be known to the contrary, justly end in a result different from that which I have come to upon the present occasion.

"The defendant having his option to adopt this course of proceeding, has at the bar expressed his desire to have this matter tried at law. If he was left merely to prosecute a *scire facias* for the repeal of the patent, that would be one part of the question which he might in that way try. But there are other questions subsisting between the parties regarding matters of fact, which could not be tried in that way.

"Now it has been stated by Lord Cottenham, that he recollected no instance in which the court has not adopted the course of directing the trial of an action; he has stated that to be the result of his experience. I certainly am very reluctant to try my own memory against that, but I should have supposed that there were instances in which that had been done. It is not the right of parties in every case to have an action tried in a court of law: it is a question of convenience, and the court is to exercise a fair discretion. I have no doubt, whatever, of the competency of this court to grant an injunction *simpliciter*. Neither had Lord Cottenham any doubt of it. But the question is, whether, when there is an opportunity for carrying the matter further, it is not, on the whole, a convenient course of proceeding to have it tried before the tribunal which is most proper for the consideration of the legal question, and by which the facts can be better investigated than they can here. It is not, therefore, upon the ground of any doubt as to the validity of the patent that I make the order which I am about to make, but it is because the nature of the case entitles the defendant to a further investigation in one form or other, and the most convenient and most effective mode ap-

§ 428. Under our system it has been hold, that, if the defendant wishes to have the question of originality tried by an issue out of chancery, he must set out in his answer the names of places and persons where and by whom the invention had previously been used, because the act of Congress peremptorily requires notice of those facts in a trial of this question at law.¹

§ 429. In the previous editions of this work it was intimated that an injunction would not be granted without a trial at law, in cases where both parties claimed under patents, or where generally the question of novelty was directly at issue. The subsequent case of *Goodyear v. Day*² has, however, elicited from Judge Grier a ruling in direct opposition to such opinion. We state the case as it is given by the reporter, and quote also *in extenso* from the decision of the court:—

“The bill prayed a perpetual injunction. The answer denied the allegations, and concluded by praying ‘a trial by jury of the various issues of fact formed by it.’ The argument involved many interesting inquiries; but facts were so interfused throughout the whole case, in the questions of law, that these last have not been found very capable of being reported. The pleadings were long; the proof and exhibits very full, amounting to about 4000 printed pages; and they had been taken under an order that they should be read either at law or in equity. The witnesses were numerous and the questions were of a kind requiring much attention and intelligence. Both parties assumed to act under patents. The case having been set down for final hearing on the proofs and exhibits, and having been fully, ably, and learnedly argued by counsel on both sides for several days, the main question of law was, whether, in the face of the answer, denying positively the

pears to me to be that which has been mentioned, namely, by bringing an action in a court of law. Notwithstanding, therefore, the very forcible arguments I have heard upon this subject, I think I must, in this case, as has been done in so many other cases, direct the plaintiff to bring an action to try this right, the injunction being granted in the terms of the notice of motion.” See also *Stevens v. Keating*, 2 Webs. Pat. Cas. 175.

In *Russell v. Barnsley*, Webs. Pat. Cas. 472, Sir L. Shadwell, V. C. said that he did not recollect a case where a defendant had stated his wish to try the question at law, that the court had refused to give him the opportunity.

¹ *Orr v. Merrill*, 1 Woodb. & M. 376.

² 2 Wall. C. C. Rep. 283.

complainant's merits and all infringement of his patent, and praying for a trial by jury, of the issues involved, the court would, under any circumstances, grant a perpetual injunction without a previous verdict. Another question, partially mingled with a question of fact, was what amount of prior discovery is necessary to deprive a subsequent discoverer of the merit of such originality as the law requires for the protection of a patent."

The court said: "It is true that in England the Chancellor will generally not grant a final and perpetual injunction in patent cases, when the answer denies the validity of the patent, without sending the parties to law to have that question decided. But even there the rule is not absolute or universal; it is a practice founded more on convenience than on necessity. It always rests in the sound discretion of the court. A trial at law is ordered by the Chancellor, to inform his conscience; not because either party may demand it as a right, or that a court of equity is incompetent to judge of questions of facts or of legal titles. In the courts of the United States the practice is by no means so general as in England, or as it would be here, if the trouble of trying issues at law devolved upon a different court. Cases involving inquiries into the most complex and difficult questions of mechanics and philosophy are becoming numerous in the courts. Often questions of originality and infringement of patents do not depend so much on the credibility of witnesses or the weight of oral testimony, as on the application of principles of science and law to admitted facts. It is true that, in matters of opinion, both mechanics and learned professors will differ widely. But still the question is not to be decided by the number, credibility, or respectability of such witnesses, but by the force and weight of the reasons given for their respective opinions. It is no reflection on trial by jury to say that cases frequently occur, in which ten out of twelve jurors do not understand the principles of science, mathematics, or philosophy, necessary to a correct judgment of the case. Besides, much of the time of the courts is lost, where twelve men will not agree upon any verdict; or where they have agreed, the conscience of the Chancellor, instead of feeling enlightened, rejects it altogether. A select or special jury of philosophers, if they could be got, would perhaps not prove more satisfactory, or obviate the difficulty. In a late case, involving the validity of Morse's telegraph patents, which was heard in Phila-

delphia, a final injunction was decreed without a verdict to establish the patents; and many other cases might be cited from other circuits, if necessary, in support of this practice, showing that the courts of the United States do not always consider it a proper exercise of their discretion to order such issues to be tried at law, before granting a final injunction. In the present case there are many reasons why the court will not thus exercise their discretion: —

“1. Because this case has been set down for final hearing on the exhibits and proofs, without any motion or order of the court for such an issue.

“2. After a patient hearing of very able counsel, and a careful consideration of the testimony, the court feel no doubt or difficulty on these questions, which would be removed or confirmed by a verdict.

“3. It would require three or four weeks at least to try this case before a jury, if this library of testimony were read to them; and at least as many months if the witnesses were examined *viva voce*, as they probably would be; and, after all this expenditure of time and labor, it is even more than probable, that, from the confusion created by the great length of the testimony and argument in court, or the force and effect of those urged from without, no verdict would be obtained, and most certainly none that would alter the present conviction of the court. Without requiring the aid of a jury, we shall, therefore, proceed to examine the questions, both of fact and law, which affect the validity of complainant's patent.”

The court then concluded with the following remarks: —

“But notwithstanding the indomitable energy and perseverance with which this attempt to invalidate the patent has been pursued, the volumes of testimony with which it has been oppressed, and the great ability with which it has been canvassed in the argument, we are of opinion that the defendant has signally failed in the attempt to show that himself or any other person discovered and perfected the process of manufacturing vulcanized India-rubber before Goodyear. We shall, therefore, give our decree of perpetual injunction.”

§ 430. The practice of the court in dissolving, reviving, continuing, or making final injunctions, previously granted, is regulated in general by the same rules as the practice of granting them in

the first instance. On a motion on affidavits to dissolve an injunction, the defendant's proofs must overcome the equity of the bill and the evidence in its support.¹ A motion to dissolve an injunction may be made at any time. If made after a trial has been ordered at law, or while an action at law is pending, or while the plaintiff is preparing to bring an action, the decision of the court will be made upon the same principles which governed the granting of the injunction in the first instance; that is to say, the defendant will not succeed in displacing the plaintiff's *prima facie* right to an injunction, merely by filing an answer, or reading affidavits casting doubts on the validity of the patent, provided the plaintiff is guilty of no unreasonable delay in bringing on the trial; especially, if the plaintiff adduces auxiliary evidence in favor of his right.²

§ 431. Where the motion to dissolve is made after a trial at law has been had, the court will have to look at the result of that trial, and will be governed by the position in which the plaintiff's right has been left. If the proceedings at law are not in a state to be regarded as final, the court will choose to be informed as to the further questions which remain to be investigated. If a verdict has been rendered for the plaintiff, but a new trial has been, or is to be moved for, and if the court can see that there is a question on which an argument might be addressed to the court of law, which might induce it to grant a new trial, the injunction will not be continued, as a matter of course, but the court will endeavor to leave the parties in a situation that will produce, on the whole, the least inconvenience, having regard to all the circumstances of their respective situations.³

¹ Sparkman v. Higgins, 1 Blatchf. 205.

² Orr v. Merrill, 1 Woodb. & M. 376; Orr v. Littlefield, *Ib.* 13; Orr v. Badger, 10 Law Rep. 465. In such cases the injunction should be continued to the next term after that at which the suit at law might be tried to test the title. Orr v. Merrill. See also Woodworth v. Rogers, 3 Woodb. & M. 135, where the question of dissolving an injunction is amply discussed.

³ Hill v. Thompson, 3 Meriv. 622, 628. In this case, the injunction had been dissolved, a trial at law had resulted in a verdict for the plaintiff, who came before the court with a motion to revive the injunction. On the part of the defendants, it was stated to be their intention to move for a new trial at law, at the next term, which was as soon as the motion could be made. Lord Eldon said: "In this case, the injunction was first granted upon the strength of the affidavits, which were contradicted, as to their general effect, in the most material points, when it afterwards came before the court upon a motion to dissolve the injunction so ob-

§ 432. Sometimes the court will direct a motion for an injunction to stand over, when none has been granted, until it can be obtained. Many topics were then urged on both sides, and fully discussed in argument. It was insisted, on the part of the plaintiff, and the court agreed to that position, that where a person has obtained a patent, and had an exclusive enjoyment under it, the court will give so much credit to his apparent right, as to interpose immediately, by injunction, to restrain the invasion of it, and continue that interposition until the apparent right has been displaced. On the other hand, it was with equal truth stated, that, if a person takes out a patent, as for an invention, and is unable to support it, except upon the ground of some alleged improvement in the mode of applying that which was previously in use, and it so becomes a serious question, both in point of law and of fact, whether the patent is not altogether invalid, then, upon an application to this court for what may be called the extra relief which it affords on a clear *prima facie* case, the court will use its discretion; and, if it sees sufficient ground of doubt, will either dissolve the injunction absolutely, or direct an issue, or direct the party applying to bring his action, after the trial of which, either he may apply to revive, if successful, or else the other party may come before the court, and say, I have displaced all his pretensions, and am entitled to have my costs and the expenses I have sustained, by being brought here upon an allegation of right which cannot be supported. And as, in this instance, the court will sometimes add to its more general directions, that the party against whom the application is made shall keep an account pending the discontinuance of the injunction, in order that, if it shall finally turn out that the plaintiff has a right to the protection he seeks, amends may be made for the injury occasioned by the resistance to his just demands. In his directions to the jury, the judge has stated it as the law on the subject of patents, — first, that the invention must be novel; secondly, that it must be useful; and thirdly, that the specification must be intelligible. I will go further, and say, that not only must the invention be novel and useful, and the specification intelligible, but also that the specification must not attempt to cover more than that which, being both matter of actual discovery and of useful discovery, is the only proper subject for the protection of a patent. And I am compelled to add, that, if a patentee seeks, by specification, any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise fairly entitled. On the other hand, there may be a valid patent for a new combination of materials, previously in use, for the same purpose, or for a new method of applying such materials. But, in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only, and not lay claim to the merit of original invention in the use of materials. If there be a patent both for a machine and for an improvement in the use of it, and it cannot be supported for the machine, although it might for the improvement merely, it is good for nothing altogether, on account of its attempting to cover too much. Now, it is contended, that what is claimed by the present patent is not a novel invention; that the extraction of iron from slags or cinders was previously known and practised; that the use of lime in obstructing 'cold short' was likewise known. But to all this it is answered, that the patent is not for the invention of these things, but for such an application of them

ascertained what the result of an application for a new trial is to be; and where a rule, to show cause why a new trial should not be had, had been granted, an injunction was refused, it not having been allowed before.¹

as is described in the specification. Now, the utility of the discovery, the intelligibility of the description, &c., are all of them matters of fact proper for a jury. But whether or not the patent is defective, in attempting to cover too much, is a question of law, and as such, to be considered in all ways that it is convenient for the purposes of justice that it should be considered. This specification generally describes the patent to be 'for improvements in the smelting and working of iron'; and it then goes on to describe the particulars in which the alleged improvements consist, describing various proportions in the combination of materials, and various processes in the adhibition of them. The question of law, upon the whole matter, is, whether this is a specification by which the patentee claims the benefit of the actual discovery of lime as a preventive of 'cold short,' or, whether he claims no more than the invention of that precise combination and those peculiar processes which are described in the specification. And, when I see that this question clearly arises, the only other question which remains is, whether I can be so well satisfied with respect to it as to take it for granted that no argument can prevail upon a court of law to let that first question be reconsidered by granting the motion for a new trial. If this be a question of law, I can have no right whatever to take its decision out of the jurisdiction of a court of law, unless I am convinced that a court of law must and will consider the verdict of the jury as final and conclusive. But this only brings it back to the original question; and I see enough of difficulty and uncertainty in the specification, and enough of apparent repugnance between the specification and the patent itself, to say that it is impossible I can arrive at such a conclusion respecting it, as to be satisfied that there is no ground for granting a new trial. In the order I formerly pronounced was contained a direction, that the defendant should keep an account of iron produced by their working in the manner described in the injunction. If the injunction is to be now revived, the whole of their establishment must be discharged between this and the fourth day of next term, when it is intended to move for a new trial, the result of which may be, that the defendants have a right to continue the works; to do which, they will then be under the necessity of recommencing all their operations, and making all their preparations and arrangements *de novo*. It appears to me that this would be a much greater inconvenience than any that can result from my refusal, in the present instance, to revive the injunction. My opinion, therefore, is, that this matter must stand over till the fifth day of next term, when I may be informed of the result of the intended application for a new trial; the account to be taken in the mean time as before."

¹ There is a recent case where an injunction was applied for and refused, and the plaintiff was directed to bring an action, which was tried and a verdict found for the plaintiff. The motion for the injunction was then renewed; but it appeared, on affidavit, that a bill of exceptions had been tendered, and that the defendants also intended to move for a new trial. The Lord Chancellor directed the application to stand over until the result of these proceedings should be known. Shortly afterwards a rule *nisi*, for a new trial, was obtained, and then

§ 433. This course of proceeding shows that when a new trial has been or is intended to be applied for, a court of equity will generally leave the parties in the situation in which they stood before the trial. If no injunction had been previously granted, the court will not increase the defendant's burdens by imposing one, as long as the plaintiff's right remains doubtful at law. But if an injunction has been granted and the plaintiff has succeeded at law, it would seem that the injunction ought not to be dissolved, on the mere suggestion that there is ground for a new trial, unless the court sees what Lord Eldon called "sufficient ground of doubt" of the plaintiff's right; but that the court will exercise its discretion, and if it sees reason for dissolving the injunction, it will direct the defendant to keep an account pending the discontinuance of the injunction, in order that, if it finally turns out that the plaintiff has a valid patent, he may receive amends for the injury occasioned by the resistance to his just demands.¹ After a trial and judgment at law, in favor of the plaintiff, the injunction will be revived or granted as matter of course.² How far the court will undertake to look into the regularity of such a judgment, and to determine, on the suggestion of the defendant, whether there is probable ground for a writ of error, and therefore to suspend the injunction, is a question which has not arisen in this country; but it seems that in England, the Lord Chancellor has so far entertained an application of this kind, as to look into the proceedings at law and the grounds of the judgment, and to satisfy himself that no good reason existed for departing from the usual course of reviving the injunction after a judgment in favor of the plaintiff.³

§ 434. An important part of the remedial process in equity is the account of profits made by the defendant. Sometimes an account is ordered to be kept, in lieu of granting or continuing an injunction. The motion for the injunction was brought on again. The Lord Chancellor said, that under the circumstances in which the case stood at law, a rule to show cause why a new trial should not be had, having been granted, he must consider the legal title of the parties as still undecided; and he therefore refused the application. *Collard v. Allison*, 4 Myl. & Cr. 487, 490.

¹ See the observations cited, *ante*, from *Hill v. Thompson*. See further, as to ordering an account, *post*.

² *Neilson v. Harford* (Cor. Lord Lyndhurst in 1841), *Webs. Pat. Cas.* 373.

³ *Ibid.*

- injunction ; and it is always ordered when the injunction is made perpetual, unless the amount would be very small. The cases in which an account is ordered to be kept, either with or without an injunction, during the pendency of an action in which the right is to be tried, proceeded upon the principle that the plaintiff may turn out to be entitled to the right, and he is more secure of ample justice if the account of the defendant's profits is kept while he is using the invention, than if it were deferred to be taken at a future time, especially if the defendant is left at liberty to make new contracts.¹ Such an account will be ordered, if the injunction is dissolved, by reason of the irreparable injury it would do to the defendant's business.²

¹ *Hill v. Thompson*, 3 Meriv. 626, 631 ; *Crossley v. Derby Gas Light Company*, Webs. Pat. Cas. 119 ; *Neilson v. Fothergill*, Ibid. 290 ; *Morgan v. Seaward*, Ibid. 168 ; *Bacon v. Jones*, 4 Myl. & Cr. 436 ; *Foster v. Moore*, 1 Curtis, C. C. 279.

² *Neilson v. Thompson*, Webs. Pat. Cas. 278, 285. In this case, Lord Cottenham said : " Nothing that took place could preclude the defendants from the right of disputing the plaintiff's right as a patentee, but they have, at very considerable expense, erected this machinery, and from that time to the present have been using it, the plaintiff being aware of it, at least from some time in 1839 (the precise day is not stated), and having stood by and permitted them to do this. If he is entitled as patentee, it would be extremely hard for the court to do anything to prevent his receiving that which he is entitled to receive, and in expectation of which he permitted the defendants to go on with their works. But, on the other hand, it would be extremely hard indeed to tell the defendants that they shall not use the works which, with the plaintiff's knowledge, they have prepared at a very considerable expense ; and as to telling them they may go on with the cold blast instead of the hot blast, I am told that the difference between the use of the one and the other is an expense of nearly double, even if it were possible ; at all events they may sustain that loss in the interval until the right is tried. It seems to me that stopping the works by injunction, under these circumstances, is just inverting the purpose for which an injunction is used. An injunction is used for the purpose of preventing mischief ; this would be using the injunction for the purpose of creating mischief, because the plaintiff cannot possibly be injured. All that he asks, all that he demands, all that he ever expects from these defendants, is one shilling per ton. He has not a right to say to them, you shall not use this apparatus ; he cannot do so after the course of conduct he has adopted ; he may, no doubt, say with success, if he is right, you shall pay me that rent which the others pay, and in the expectation of which I permitted you to erect this machinery. Therefore, in no possible way can the plaintiff be prejudiced ; but the prejudice to the defendants must be very great indeed, if they are for a short period prevented from using at their furnaces that apparatus which, with the consent of the plaintiff, they have erected. The object, therefore, is, pending the question, which I do not mean to prejudice one way or the other by anything I now say, to preserve to the parties the opportunity of trying the question, with the least possible injury to the

§ 435. Sometimes, as a further means of doing justice between the parties, upon the question of infringement, when an action at law is to be tried, the court will order a mutual inspection of the plaintiff's and defendant's works. The object in so doing is to enable the parties, on the trial, to give such evidence as will tend to prove or disprove the fact of infringement. For this purpose inspectors or viewers are appointed, under the direction of the court, who are to be admitted as witnesses on the trial at law. If the parties do not agree on the persons to be appointed, the court will appoint them.¹

§ 436. When the validity of the patent is fully established, an account will be ordered of all the profits made by the defendant, to be taken by a master; and if the patent has expired, the account and the injunction will extend to all the articles piratically made during the existence of the patent, though some of them may remain unsold.²

one party or the other; and I think the injunction would be extremely prejudicial to the defendants, and do no possible good to the plaintiff for the purpose for which it may be used. It may, by operating as a pressure upon the defendants, produce a benefit, but that is not the object of the court; the object of the court is to preserve to each party the benefit he is entitled to, until the question of right is tried, and that may be entirely secured by the defendants undertaking to keep an account, not only for the time to come, but from the time when the connection first commenced, and undertaking to deal with that account in such a way as the court may direct; and if the plaintiff is entitled, the court will have an opportunity of putting the plaintiff precisely in the situation in which he would have stood if the question had not arisen. If it shall turn out that the patent is not valid, the court will deal with it accordingly, and that will, I think, most effectually prevent all prejudice."

¹ *Morgan v. Seaward*, Webs. Pat. Cas. 168; *Russell v. Cowley*, Ibid. 457. See these cases for the decrees appointing such inspectors. Also *Jones v. Lee*, 36 E. L. & Eq. 558.

² *Crossley v. Beverley*, Webs. Pat. Cas. 119; *Crossley v. Derby Gas Light Company*, Ibid. 119, 120. In this case a very curious difficulty occurred in estimating the "profits." The plaintiff was the owner of a patent for making gas-meters, which the defendants had made and sold and employed in their works. The profits to be ascertained were the benefits derived from the use of the meters, in enabling the defendants to furnish gas to their customers at a lower rate than they could have done without them, and so to obtain additional profits from an increased consumption. It was a case, therefore, presenting the uncertain elements of profits made by the application of particular means, and a just distribution of those profits to a particular agent employed. The case, as it is reported, does not furnish any principles. See s. c. 3 Mylne & Cr. 428, 430.

It has been decided, in the case of *Livingston v. Woodworth*,¹ that the account of profits granted by a court of equity comprises only such profits as have been actually made by the defendant, and not such as he might have made with reasonable diligence, nor interest from the date of filing the bill. The original bill filed in the Circuit Court by the appellees concluded with a prayer that the defendants (here the appellants) may be decreed to account for and pay over to the complainants (appellees) “all gains and profits which have accrued from using their said machines since the expiration of the said original patent.” Under this bill the master to whom the account was referred *a*/make a report which was not confirmed; the court made a further decretal order, with instructions to ascertain the amount of profits which may have been, or *with due diligence might have been, realized by the defendants*. The report made in pursuance of this order was confirmed, and interest from the time of filing the bill added by the court. On appeal to the Supreme Court the rulings of the Circuit Court were reversed, and an entirely different measure of damages and profits established. The Supreme Court ruled as follows: “On the part of the appellees (the complainants in the Circuit Court), it has been insisted that the decretal order, made in this cause by consent, covered and ratified in advance all the subsequent proceedings on the part of the court, rendering those proceedings, inclusive of the final decree, a matter of consent, which the appellants could have no right to retract, and from which, therefore, they could not legally appeal. In order to try the accuracy of this argument and of the conclusions sought to be deduced therefrom, it is proper to examine the order which is alleged in support of them. The words of that order are as follows: ‘This cause came on, &c., and by consent of parties it declared by the court,’ — what? ‘That the complainants are entitled to the perpetual injunction and the *account prayed for by the bill*.’ It seems to us incomprehensible, that, by this consent of the defendant below, he had consented to anything precise and unchangeable beyond the perpetual injunction, much more so that he had thereby bound himself to acquiesce in any shape or to any extent of demand which might be made against him, under the guise of an account. Indeed, the complainants below, and the Circuit Court itself, have shown by their own interpretation of this decretal

¹ *Livingston v. Woodworth*, 15 How. 546.

order, that they did not understand it to mean, as in truth by no just acceptation it could mean, anything fixed, definite, or immutable; for the complainants below excepted to the report of the master; and the court recommitted that report with a view to its alteration. Nor can we regard the reference to the master as in the nature of an arbitration; for, if so deemed, the award of that officer must have been binding, unless it could be assailed for fraud, misbehavior, or gross mistake of fact. In truth, the account consented to was the account prayed for by the bill, namely: 'That the defendants may be decreed to account for and pay over all such gains and profits as have accrued to them from using the said machines since the expiration of said original letters-patent.' This language is particularly clear and significant, — such gain and profits, and such only as have actually accrued to the defendants; and we are unable to perceive how, by such an assent, the defendants below could have been concluded against exceptions to anything and everything which might have been evolved by that report, however illegal or oppressive.

“Considering next the decretal order for the recommitment of the first report, the second report made in obedience to that order, and the final decree made upon that second report, we are constrained to regard them all as alike irreconcilable with the prayer of the bill, with the just import of the consent decree, and with those principles which control courts of equity. In the instructions to the master, it will be seen that he is ordered ‘to ascertain and report the amount of profits which may have been, or which with due diligence and prudence might have been, realized by the defendants for the work done by them or by their servants, computing the same upon the principles set forth in the opinion of the court, and that the account of such profits commence from the date of the letters-patent issued with the amended specification. The master, in his report made in pursuance of the instructions just adverted to, admits that the account is not constructed upon the basis of actual gains and profits acquired by the defendants by the use of the inhibited machine, but upon the theory of awarding damages to the complainants for an infringement of their monopoly. He admits, too, that the rate of profits assumed by him was conjectural, and not governed by the evidence; but he attempts to vindicate the rule he had acted upon by the declaration, that he was not aware that he had ‘infused into the case any element

too unfavorable to the defendants. That by the decision of the court they were trespassers and wrongdoers, in the legal sense of these words, and consequently in a position to be mulcted in damages greater than the profits they have actually received, the rule being, not what benefit they have received, but what injury the plaintiffs have sustained.' To what rule the master has reference in thus stating the grounds on which his calculations have been based, we do not know. We are aware of no rule which converts a court of equity into an instrument for the punishment of simple torts; but upon this principle of chastisement the master admits that he has been led, in contravention of his original view of the testimony and upon conjecture as to reality of the facts, and not upon facts themselves, to double the amount which he had stated to be a compensation to the plaintiffs below, and the compensation prayed for by them; and the Circuit Court has, by its decree, pushed this principle to its extreme, by adding to this amount the penalty of interest thereon, from the time of filing the bill to the date of the final decree.

“ We think that the second report of the master, and the final decree of the Circuit Court, are warranted neither by the prayer of the bill, by the justice of this case, nor by the well-established rules of equity jurisprudence. If the appellees, the plaintiffs below, had sustained an injury to their legal rights, the courts of law were open to them for redress, and in those courts they might, according to a practice which, however doubtful in point of essential right, is now too inveterate to be called in question, have claimed not merely compensation but vengeance for such injury as they could show that they had sustained. But before a tribunal which refuses to listen even to any save those acts and motives which are perfectly fair and liberal, they cannot be permitted to contravene the highest and most benignant principle of the being and constitution of that principle.”¹

§ 427. An injunction should not be dissolved merely on account of doubts as to the validity of the patent, which arise from objections to the technical form or signature of the letters, or other acts

¹ These principles have been applied in the subsequent case of *Dean v. Mason*, 20 How. 198. See also *Silby v. Foote*, 20 How. 378; and *Elwood v. Christy*, 18 Com. Ben. N. S. 494.

or omissions of the public officers, and not from any neglect or wrong of the patentee.¹

Nor is it sufficient ground for dissolving an injunction, that there has been delay in the several steps necessary to the acquisition of the patent, provided that such delay was not usual and that the application was followed up with reasonable diligence. Or that the patentee has in the mean while sold the manufactured article. And if third parties, inquiring at the Patent Office, are informed² that no patent has been obtained for such articles, and act on the information, the patentee is not bound by such action of the Patent Office officials, and a temporary injunction granted him cannot be dissolved on that ground.²

§ 438. Upon the question of granting an injunction against a party who has had the use of the invention by permission or grant of the patentee, the doctrine seems to be this. A licensee who derives his license from one tenant in common of a patent cannot be

¹ *Woodworth v. Hall*, 1 Woodb. & M. 389, 400. In this case, Mr. Justice Woodbury said: "Finally, it is contended that if any doubt exists as to the validity of a patent, as some assuredly does here, as before stated, the injunction should be dissolved. This may, with some qualification as to the matters connected with the subject, be true in granting an injunction, as laid down in 4 Wash. C. C. 584, if the doubt relate to the merits, that is, the originality or usefulness of a patent, or a patentee's own error in his specification. But when the objection relates to the technical form or signature of papers connected with the letters, and the doubts arise from acts of public officers, and not any neglect or wrong of the patentee, the position seems to me not sound. More especially should an injunction, once granted, not be disturbed for such doubts, when, as in this case, the term for trial of the merits is near; and the allowing such doubts to prevail, even to the extent of dissolving an injunction, might not merely affect the present patent and present parties, but operate injuriously on all other patents and parties where, for the last ten years, by a contemporaneous and continued construction of the patent law, chief clerks have, under its authority, signed patents or other important papers as acting commissioner, in the necessary absence of the commissioner, or made mistakes of a clerical character in the form of the letters. In my opinion, so far from its being proper, under such circumstances, to dissolve an injunction for doubts on such technical objections, it is rather the duty of the court, if, as here, mischievous consequences are likely to ensue to others from interfering, and if, as here, legislative measures have been recommended by the public officers, which are pending, to remedy or obviate the possible evil from any public mistakes, not to dissolve an injunction already granted, unless required to do it by imperative principles of law, showing the letters-patent to be clearly void."

² *Sparkman v. Higgins*, 1 Blatchf. 205.

enjoined by another co-tenant.¹ A party who has had the use of an invention, under a contract for an annual rent, or other estimated rate of payment, may discontinue the payment, and, if he still use the invention, the patentee may sue him for the rent due, or for an infringement. If an action is brought for the rent, and the defendant is not estopped by the terms of his contract from denying the validity of his patent, the plaintiff cannot recover without giving him an opportunity to do so.² The same is true under an action for the infringement, if the defendant is not estopped.³ Where, therefore, a court of equity does not see that the defendant is estopped from denying the validity of the patent, but that he has a right to resist the patent, it will deal with a defendant who has used under a license or other contract, or under permission, upon the question of injunction, as it deals with other defendants; and, as we have seen, if the bill which prays for an injunction also shows that rent is due by contract, the court will order the money to be paid into court, to await the result of an action at law.⁴

¹ *Clum v. Brewer*, 2 Curtis, C. C. 506.

² *Hayne v. Maltby*, 3 T. R. 438.

³ As to estoppel and failure of consideration, see *Bowman v. Taylor*, 2 Ad. & Ell. 278, and other cases collected in *Webs. Pat. Cas.* 290, note.

⁴ *Neilson v. Fothergill*, *Webs. Pat. Cas.* 287, 288. The bill showed that the plaintiffs had called on the defendants for an account of the iron smelted by the use of the invention, in order to ascertain the sum due, and that the defendants had rendered an account in writing of all the iron smelted by them up to the 2d of August, 1839, and duly paid one shilling per ton on the same; that the plaintiff had applied to the defendants for an account of the iron smelted since the 2d day of August, 1839, and for like payments, but the defendants had refused. It appeared that the draft of a license was sent to the defendants, containing amongst others a clause for revoking the license upon the nonpayment of the rent, and that this license was kept; that the payments were made in conformity to it, and that the plaintiffs, after August, 1839, *revoked the license*. An injunction had been granted, which the defendants now moved to discharge. Lord Cottenham, L. C.: "This case is deprived of those circumstances upon which I acted in the other, namely, the party who claims to be patentee permitting them to incur expense, in the expectation of being permitted to use the furnaces upon the payment of the rent, which is all the plaintiff requires. But here, all that is accounted for, because that was done under a contract, and for two years at least the party has had the benefit of the works which he has so erected, and the patentee has kept his contracts with the defendants; he has not interposed and endeavored to deprive them of the benefit of their expenditure. It is the act of the manufacturer which has put an end to this connection; he has, therefore, exposed himself to any degree of injury that may arise from the expenditure upon these works, and

§ 438 *a.* A licensee, who has obtained a license upon certain terms, will be held by a court of equity to a compliance with those terms. It appears that there is no answer to the claim to this rent from August, 1839, to August, 1840. I shall have to consider, if your client declines to escape from the injunction upon the terms I propose to him, whether the injunction should not go in a case which is deprived of those equitable circumstances which induced me to dissolve it in the others. (Wigram: Your lordship will give me the benefit of the supposition, that, at law, I have a defence if the patent is good for nothing.) If you can show me that there is a real question to try, the money must be paid into court instead of being paid to the parties; but at all events, I do not see how far that year, from August, 1839, to August, 1840, when you went on under the contract without giving notice to determine, you can escape paying it, either into court to abide the event of the trial of the question at law, or paying it to the party, if there is no question to try.

Wigram, in reply. "Your lordship said you should consider, whether, since August, 1840, we were to be considered as holding adversely, and, therefore, whether liable or not to pay for what was gone by, we were at all events wrongdoers. And then you put me to show, whether I could not in law defend myself for what was said to be due in August, 1840. The principle which I have always understood to govern cases of this sort is this, that, excluding the law of estoppel, if you go into a court of law, and can show a total failure of consideration for the contract, there you may always defend yourself; if, on the other hand, you cannot make out a case of total failure of consideration, you are liable upon your contract, and you may or may not have your cross action. This is the general principle in these cases, subject to the question, whether that which has been done may or may not amount to an estoppel. The whole question in the case of *Bowman v. Taylor*, relied upon for the plaintiff, was, whether or not there could be an estoppel by recital, and it was held that there could. In *Hayne v. Maltby*, the question was, whether there was any estoppel, there being no recital of the plaintiff's title, but only an agreement and a covenant to pay, and the court held that there was not. In that case Mr. Justice Ashurst said, the plaintiffs use this patent as a fraud on all mankind, and they state it to be an invention of the patentee, when in truth it was no invention of his. The only right conferred on the defendant by the agreement was that of using this machine, which was no more than that which he in common with every other subject has, without any grant from the plaintiff. That is exactly our case. We say that all mankind have a right to use it, but that some people have taken licenses, supposing it to be the plaintiff's invention. On the money then being paid into court, the injunction should be dissolved."

Lord Cottenham, L. C.: "The case of *Hayne v. Maltby* appears to me to come to this, — that although a party has dealt with the patentee and has carried on business, yet that he may stop, and then the party who claims to be patentee cannot recover without giving the other party the opportunity of disputing his right, and that if the defendant successfully dispute his right, that notwithstanding he has been dealing under a contract, it is competent to the defendant so to do. That is exactly coming to the point which I put, whether at law the party was estopped from disputing the patentee's right, after having once dealt with him as

terms. In such cases, however, the court will act with due regard to the substantial rights of both parties, neither permitting on the one hand the licensee to continue his use in disregard of the agreement, nor on the other hand working an unreasonable forfeiture of the license. Thus, in *Brooks v. Stolley*,¹ the defendant in an injunction bill had been allowed to use the plaintiff's machine on certain conditions, viz. : "that the said John Stolley should pay the said Brooks and Morris one dollar and twenty-five cents for each and every thousand feet of boards he may plane, payable on Monday of every week," &c. The defendant admitted failure of payment. The court ruled that the terms of the agreement made the performance of its stipulations by the defendant a condition to his continued use of the machine, and that the case was one in which equitable relief was in place, but that, unlike an ordinary case of infringement, an unconditional injunction which would virtually annul the agreement would be excessive. Said the court: "The complainants invoke the aid of equity, not to decree a specific performance of the contract, but to protect their rights as assignees of the patent. This right, they allege, has been infringed. The defendant relies on the license contained in the contract; but having failed to make the weekly payments, he has no pretence of right to run the machine. To entitle himself to the benefit of the license, it is incumbent on the defendant to do all that he is bound to do. . . . A question is made whether the failure of the defendant to make the weekly payments operates as a forfeiture of the contract. There is no condition of forfeiture in the contract. Whether it has been abandoned by the defendant must depend upon the circumstances of the case. A court of chancery will not decree the cancelment of a contract, except for fraud or mistake. . . . An injunction is prayed which, in effect, will annul the the proprietor of that right; and it appears from the authority of that case, and from the other cases, that from the time of the last payment, if the manufacturer can successfully resist the patent right of the party claiming the rent, that he may do so in answer to an action for the rent for the use of the patent during that year. That being so, I think that, upon the money being paid into court, that is to say, upon the amount of the rent for that year being paid into court (if required), and the same undertaking being given to account for the subsequent period, the same order ought to be made in this case as in the others. There must be an undertaking to deal with the amount of that in the same way as before. The great difficulty in this case, which, however, is surmounted in the undertaking, is, that the said suit does not go to that year's rent."

¹ 3 McLean, 523.

patent. Now, although it may be admitted that the defendant, as the facts in the case stand, could not successfully invoke in his behalf the action of a court of equity or law, yet, under the relief asked by the complainants, a somewhat different view may be taken. Are the complainants entitled to an absolute injunction, which shall annihilate the contract? It appears to me that short of this adequate relief may be given." It will be observed that the breach in question consisted in a mere nonpayment of money.

In the similar case of *Wilson v. Sherman* (under the same, Woodworth's, patent),¹ the court decided that one ground for granting an injunction failed, inasmuch as the contract constituting the alleged violation of the agreement had been fully completed before the bringing of the bill; also that the grant of an injunction, on the ground of forfeiture of the license, would, under the circumstances of the case, be too rigorous an exercise of the power of the court. The violation was, in this case, selling outside of the county agreed upon in the license the materials manufactured by the patented machine.

But perhaps the fullest exposition of the equitable rights existing mutually between patentee and licensee is contained in the decision of the Lord Chancellor in *Warwick v. Hooper*:² "From what I have stated, it appears that the equity relied on, on the part of the plaintiffs, results from the following facts: that the plaintiff are assignees of a certain patent; that the defendant accepted a license to use the patent invention upon certain terms, one of which was to pay a royalty or rent to the amount of at least £2,000 a year, to be made up at the end of each year, in manner stated in the license, and that in default of such payment being made, the license might be determined; that the defendant has made default in such payment in every year except the first, since the license was granted; and that the plaintiffs have in consequence determined the license according to the proviso in that behalf enabling them to do so. On the defendant's behalf . . . it is insisted, first, that the condition as to the payment of the £2,000 yearly was dispensed with by the agreement embodied in the letter of the 4th of November, 1845; and, secondly, that if the condition as to the payment of the £2,000 yearly was not dispensed with, and the covenant to pay such sum had been broken by nonpayment of such sum, yet that the plaintiffs had elected not to treat such

¹ 1 Blatchf. 536.

² 3 E. L. & Eq. 233.

breach as a forfeiture of the license, but to continue the license by the acceptance of payment of the royalties under the license, accruing due for a period subsequent to the last breach of covenant.

“ I shall first consider the point whether the license granted to the defendant by those under whom the plaintiffs claim, has been legally determined, so as to make the defendant a wrongdoer, as against the plaintiffs, by continuing to use the patented invention ; because, if the license has not determined, there is an entire failure of the equity set forth in the plaintiff's bill ; and I think this point may be determined upon principles and authorities which can be open to very little doubt or dispute. The proviso contained in the license for determining the same, upon default being made in the payment of the £2,000 a year, was inserted exclusively for the benefit of the grantors, and the defendant, the grantee, could in no manner, by any option or act of his, determine the license ; nor were the grantors bound, in the event of default being made in the stipulated payments, to avoid the license or to treat it as determined ; and until they, the grantors, should in the prescribed manner declare the option and exercise the right to treat the default as a ground of forfeiture, the license would continue in full force notwithstanding any breaches of covenants and conditions on the part of the defendant which might have occurred. It is not necessary to cite authority for this well-established proposition. The question to be determined is, whether the plaintiffs, by receiving royalties which accrued for two quarters after the expiration of the year ending July 27, 1849, did not treat and act upon the license as an existing and continuing license, and thereby elect conclusively not to treat the previous breaches of covenant as grounds of forfeiture, and thereby preclude themselves from afterwards determining the license upon the ground of any previous breach of covenant.” The Chancellor then discusses the principles recognized and adopted in similar cases arising between landlord and tenant, and concludes : “ I cannot perceive any distinction between the present case and the case of landlord and tenant under a lease ; and it seems to me to be clear that the receipt of the royalty under the license for the two quarters commencing after the alleged ground of forfeiture had occurred, was a conclusive election by the plaintiffs not to act upon the previous breaches of the covenants as a ground of forfeiture.”

For a full discussion of the question, whether the Federal courts

had or had not jurisdiction in the two American cases above cited, see *infra*, chapter on Jurisdiction. It may suffice here to observe that the question was decided affirmatively, on the ground that a non-compliance with the terms of the license, coupled with a continued use of the patented invention, constituted an infringement of the patent, and on that ground alone was a proper subject of adjudication in the Federal courts. The case of *Goodyear v. The Congress Rubber Co.*¹ may be regarded as modifying, or, to speak perhaps more accurately, limiting, the doctrines already stated. The patentee, Charles Goodyear, had given to Horace Day an exclusive license for a specified purpose, Day covenanting to use it for no other purpose. Day subsequently using it for other purposes, Goodyear brought a bill in New Jersey to restrain the violation, and obtain a decree of account. The decree was granted, but after its rendition, and pending the accounting under it, Day assigned his license to the Congress Rubber Co., who took with full knowledge of the facts. Day also disposed of his property with intent to defeat the decree of account. The Congress Rubber Co. proceeded to manufacture articles under the license assigned to them. The bill in question was thereupon brought to restrain them from so doing, on two grounds, first, that the assignor, the original licensee, had violated his covenant, and that any one holding under him was bound by equities against him; secondly, that the Company had not themselves fulfilled the terms of the license, by paying the fees agreed upon. This last ground was sustained, but the first was overruled on demurrer. The court ruled: 1. That the patentee had no lien on the license to secure the tariffs. 2. That the unpaid tariffs due by the assignor afforded no ground for enjoining the assignees under the license, and that the question whether the assignment was fraudulent or not, did not respect the patentee. 3. That the question respecting any attempt to evade the New Jersey decree could not arise until that decree became final. 4. That the bill could not be sustained against the assignees, to aid either in enforcing that decree or in collecting the tariffs due from the licensee to the patentee at the time of the assignment.

It may be well to observe that this case differs from *Brooks v. Stolly and Wilson v. Sherman*, in that the license here in question was an exclusive one, and from *Warwick v. Hooper*, in that it contained no provision for determining the license in default of non-

¹ 3 Blatchf. 449.

payment. The question of jurisdiction moreover was not raised, inasmuch as the court had jurisdiction for another reason, the plaintiff being a citizen of Connecticut and the defendants citizens of New York.

In conclusion, where the patentee assigns his whole interest in the patent, reserving merely an annual income to be paid by the grantee, he can have no action either at law or in equity under the patent, but his only remedy in case the income is not paid is an action upon the covenant. Thus, in *Hartshorn v. Day*,¹ the recital mentioned that the grantee had stipulated to pay \$1,200 and the expenses, and the body of the instrument declared: "Now I, Chaffee, do hereby in consideration of the premises, &c., &c., nominate, constitute, and appoint said William Judson my trustee and attorney irrevocable, to hold said patent and have the control thereof, &c." This was held to pass the entire equitable and legal title in the letters-patent to said Judson, for the benefit of Goodyear, so that if the annuity was not paid, the patentee had no right to revoke the power of attorney and assign the patent to another party. Nelson, J., in giving the opinion of the Supreme Court, expressly declares the doctrine of *Brooks v. Stolley* inapplicable to this case.

§ 439. It has been held that in a bill in equity for a perpetual injunction, it is a good defence, that, prior to the granting of the patent, the inventor had allowed the invention to go into public use, without objection; but that it should be clearly established by proof, that such public use was with the knowledge and consent of the inventor.² This is the same as one of the statute defences against an action at law, which may all be made, pursuant to the statute, in equity, if the defendant chooses, although the statute has expressly made them defences only in an action at law.

§ 440. The general principle of equity jurisprudence, that the court will not lend its extraordinary aid to any claimant who has encouraged or acquiesced in an infringement of his right, or who has unreasonably delayed prosecuting for such violation, is fully recognized in the case of patentees applying for an injunction. Where a patentee seeks an injunction against an alleged infringer, and the evidence shows that this infringer or others have been in the habit of disregarding the exclusive right conferred upon the pat-

¹ 19 How. 211.

² *Wyeth v. Stone*, 1 Story's R. 273.

entee, and this with knowledge either actual or implied, on the part of the patentee, the court will dismiss the bill on the ground that the plaintiff has been guilty of laches, or that there is a want of that exclusive possession which lies at the foundation of every claim to an injunction.

This principle has been acknowledged and applied in several copyright and patent cases. Thus, in *Lewis v. Chapman*,¹ the Master of the Rolls said: "The two works were preparing for publication at the same time. The publication of the defendants began first, and the attention of the plaintiffs was drawn to it at the commencement and afterwards during the process of the defendants' publication, which was completed six years and a half before the bill was filed; and for more than one year before the bill was filed, a complete copy of the defendants' work was in possession of the plaintiffs, and had been obtained by them for the express and avowed purpose of investigating the contents and comparing them with the contents of the plaintiffs' work and the contents of Fullarton's book, which at that time was under consideration here. The delay of the plaintiffs is accounted for by reasons which affect them and relate to their own convenience only; . . . and although the small extent to which the plaintiffs from time to time made themselves acquainted with the contents of the defendants' work, may in point of fact be entirely true; yet it appears to me that the plaintiffs, having so strong an interest in the subject, having such powerful motives for vigilant attention, and having such means of information, cannot be allowed in a court of justice to state that they remained ignorant of that which they had the perfect means of knowing, and which it was their avowed purpose as well as their strong interest to learn; and under these circumstances I think it my duty to impute to them such a knowledge of the contents of defendants' work as made it their duty to apply for an injunction, if at all, at a much earlier period. And *on the ground of delay and not for any other reason*, I think that the injunction moved for must be refused."

So, also, in *Saunders v. Smith*,² we find the Lord Chancellor ruling as follows: "When I look at this book (the defendants', viz., Smith's *Leading Cases*), I see that it is a work of very great labor, and I find the principle is to take, first, the marginal note, sometimes with some alteration, and then to take the leading case

¹ 3 Bear. 133.

² 3 Mylne & Cr. 711.

as a principle, and then, by very voluminous and obviously very laborious notes, to work out the principle. It is clear, therefore, that the work is one of great labor, and that this was evident from the first volume; and I find that the plaintiffs were informed, in March, 1837, of an intention (on the part of the defendant) to deal with the existing reports (the copyright in which had vested, by assignment, in the plaintiffs) in the manner now complained of. I find the first volume published, announcing the intention of going on with the same plan, which necessarily would run over the period to which the copyrights of the plaintiffs relate, and that no remonstrance is made to Mr. Smith upon the nature of his work, but he is permitted to go on with this laborious undertaking until the period at which the first part of the second volume is published. In the mean time there was a communication between the plaintiffs and Mr. Maxwell, who was interested in the publication of the work, and who has as much right to the protection of the court as Mr. Smith; and in the proposal which he makes to the plaintiffs, he deals with the work as property he is entitled to deal with, wishing to make it the subject of arrangements between himself and the plaintiffs; and I do not find that this leads to any caution or interference on the part of the plaintiffs as to that course which Mr. Smith had pursued in part, and which the plaintiffs must have been aware that he intended to pursue further. I do not give any opinion upon the legal question. I am only to decide whether the plaintiffs are entitled, under the circumstances, to the interposition of the court to protect their legal right, when that legal right has not yet been established. But I assume the existence of the legal right, and I say that whatever legal rights the plaintiffs may have, the circumstances are such as to make it the duty of a court of equity to withhold its hand and to abstain from exercising its equitable jurisdiction, at all events until the plaintiffs shall come here with the legal title established.”¹

In *Collard v. Allison*,² the Chancellor ruled thus: “But then it is said there is possession of the patent, and that possession of a patent for a certain length of time gives such a title as the court will protect until a trial at law can be had. And certainly, if I

¹ See also *Rundell v. Murray*, 1 Jac. 311; *Baily v. Taylor*, 1 Russ. & Myl. 73; *Platt v. Button*, 19 Vesey (Summ. ed.), 447; *Southey v. Sherwood*, 2 Meriv. 435.

² 4 Mylne & Cr. 487.

found that manufacturers of piano-fortes had acquiesced, and that there was no doubt upon that point, to which I have before referred, I should have adopted the course which Lord Eldon adopted and which I have followed, of protecting the right until the trial should have been had. For that purpose, however, I ought to have very satisfactory evidence of exclusive possession. Now, I find here, that certain manufacturers state that they abstained from making piano-fortes in this manner, out of respect for the plaintiffs as having a patent; while other manufacturers, again, say that they have always made them in this way. Which of these statements is true I am not called upon to decide; but the discrepancy does throw sufficient doubt on the case to prevent my interfering by injunction. The result is, that this case, in my opinion, wants that evidence of exclusive possession upon which Lord Eldon acted in the case that has been referred to, and that there is so much doubt as to the novelty of what is claimed, and as to the validity of a patent for such a manufacture, that I do not feel that I ought to interfere."

But the case bearing most strongly on this question, and containing the development and further application of the principles already embodied in those just cited, is that of *Wyeth v. Stone*.¹ Here Mr. Justice Story said: "In the next place, as to Wyeth's supposed abandonment of his invention to the public since he obtained his patent, I agree that it is quite competent for a patentee at any time, by overt acts or by express dedication, to abandon or surrender to the public, for their use, all the rights secured by his patent, if such is his pleasure, clearly and deliberately expressed. So if, for a series of years, the patentee acquiesces, without objection, in the known public use by others of his invention, or stands by and encourages such use, such conduct will afford a very strong presumption of such an actual abandonment or surrender. *A fortiori*, the doctrine will apply to a case, where the patentee has openly encouraged or silently acquiesced in such use by the very defendants, whom he afterwards seeks to prohibit by injunction from any further use; for in this way, he may not only mislead them into expenses, or acts, or contracts, against which they might otherwise have guarded themselves; but his conduct operates as a surprise, if not as a fraud upon them. At all events, if such a defence were not a complete defence at law, in a suit for any infringe-

¹ 1 Story's Rep. 273.

ment of the patent, it would certainly furnish a clear and satisfactory ground why a court of equity should not interfere either to grant an injunction, or to protect the patentee, or to give any other relief. This doctrine is fully recognized in *Rundell v. Murray*,¹ and *Saunders v. Smith*.² But if there were no authority on the point, I should not have the slightest difficulty in asserting the doctrine, as founded in the very nature and character of the jurisdiction exercised by courts of equity on this and other analogous subjects.

“There is certainly very strong evidence in the present case, affirmative of such an abandonment or surrender, or at least of a deliberate acquiescence by the patentee in the public use of his invention by some or all of the defendants, without objection, for several years. The patent was obtained in 1829; and no objection was made, and no suit was brought against the defendants for any infringement until 1839, although their use of the invention was, during a very considerable portion of the intermediate period, notorious and constant, and brought home directly to the knowledge of the patentee. Upon this point I need hardly do more than refer to the testimony of Stedman and Barker, who assert such knowledge and acquiescence for a long period, on the part of the patentee, in the use of these ice-cutters by different persons, (and among others by the defendants,) on Fresh Pond, where the patentee himself cut his own ice. It is no just answer to the facts so stated, that until 1839, the business of Wyeth, or rather of his assignee, the plaintiff, Tudor, was altogether limited to shipments in the foreign ice-trade, and that the defendant’s business, being confined to the domestic ice-trade, did not interfere practically with his interest under the patent. The violation of the patent was the same, and the acquiescence the same, when the ice was cut by Wyeth’s invention, whether the ice was afterwards sold abroad or sold at home. Nor does it appear that the defendants have as yet engaged at all in the foreign ice-trade. It is the acquiescence in the known user by the public without objection or qualification, and not the extent of the actual user, which constitutes the ground upon which courts of equity refuse an injunction in cases of this sort. The acquiescence in the public use, for the domestic trade, of the plaintiff’s invention for cutting ice, admits that the plaintiff no longer claims or insists upon an exclusive right in the domestic

¹ 1 Jacobs, 311.

² 3 Mylne & Cr. 711, 728, 730, 735.

trade under the patent; and then he has no right to ask a court of equity to restrain the public from extending the use to foreign trade or for foreign purposes. If he means to surrender his exclusive right in a qualified manner, or for a qualified trade, he should at the very time give public notice of the nature and extent of his allowance of the public use, so that all persons may be put upon their guard, and not expose themselves to losses or perils, which they have no means of knowing or averting, during his general silence and acquiescence.

“The cases which have been already cited fully establish the doctrine, that courts of equity constantly refuse injunctions, even where the legal right and title of the party are acknowledged, when his own conduct has led to the very act or application of the defendants, of which he complains, and for which he seeks redress. And this doctrine is applied, not only to the case of the particular conduct of the party towards the persons, with whom the controversy now exists, but also to cases where his conduct with others may influence the court in the exercise of its equitable jurisdiction. Under such circumstances, the court will leave the party to assert his rights, and to get what redress he may at law, without giving him any extraordinary aid or assistance of its own.”

§ 441. But although it is a principle of equity, that a patentee must not lie by, and by his silence or acquiescence induce another to go on expending his money and incurring risk, and afterwards, if profit is made, come and claim a share in the profit, without having been exposed to share in the losses; yet delay to institute his proceedings may be explained by the difficulty of getting evidence of the infringement.¹

§ 442. It has already been stated that in all cases of proceedings in equity to restrain the infringement of patents, in the courts of the United States, the injunction can, at no time, be applied for without notice to the adverse party, giving him an opportunity to oppose it; and, therefore, the injunction is always *special*.² Where

¹ Crossley v. Derby Gas Light Company, Webs. Pat. Cas. 119, 120. As to what would be reasonable time, in certain circumstances, see Losh v. Hague, Webs. Pat. Cas. 200, 201.

² For the distinction between *common* and *special* injunctions, see 2 Story's Eq. Jurisp. § 892.

the injunction is applied for before an answer has been filed, the plaintiff, in addition to the allegations in his bill, must read affidavits to show his title, and the fact of infringement, especially if the defendant appears and offers evidence against the one or the other; and these affidavits should, in strictness, cover the issue of the patent, the novelty of the invention, and all other facts necessary to the title.¹ It is believed, however, that in our practice, where the whole title is set out in the bill, which is sworn to, if the defendant does not read affidavits denying the title, it is not usual to read them in support of the title, which is considered as verified by the bill itself. But, if the defendant attacks the title by affidavit, it must be supported by auxiliary proof in addition to the bill, in order to make out the *prima facie* right to an injunction.

§ 443. In one of the circuit courts of the United States some doubt has been thrown over the question, whether the plaintiff is at liberty to read affidavits in support of his title, after an answer denying it. Mr. Justice McLean has held, that on an application for an injunction, after an answer, the plaintiff is not entitled to read affidavits to contradict the answer upon the point of title.² Mr. Justice Woodbury, on the contrary, has held, that the plaintiff may show from counter-evidence that the case is different from that disclosed in the affidavits, or answer of the defendant, and thus proceed to fortify his right to an injunction.³ I am inclined, after some examination of the point, to think that the latter is the more correct opinion.⁴ It is settled, in the first circuit, by a de-

¹ 3 Daniels Ch. Pr. 1890, 1891, Amer. edit. 1846; Hindmarch on Patents, 332, and cases cited.

² Brooks v. Bicknell, 3 McLean, 250, 255.

³ Orr v. Littlefield, 1 Woodb. & Min. 13, 19. See the observations cited from this case, *ante*.

⁴ If Mr. Justice McLean is to be understood to mean that the plaintiff is not at liberty to read affidavits in support of the novelty of his invention, after an answer denying it, it would seem that the practice and other authorities are opposed to his position. In the case above cited (Brooks v. Bicknell), the principal ground of objection to the plaintiff's title was, that the patent had been illegally extended; and the opinion does not expressly affirm that the plaintiff may not adduce evidence against the answer, to support the novelty of his invention, although this is implied in the observations of the court. It is, however, clear, that there is a distinction between common and special injunctions on this point. In Hill v. Thompson, 3 Meriv. 622, 624, the leading case on the subject of injunctions in patent causes, where Lord Eldon laid down the rules that have since been

decision referred to in the note below, by Mr. Justice Story, that the whole question of granting or dissolving injunctions, in cases of

followed by all judges, an injunction had been obtained until answer, or further order; on the coming in of the answer, the defendants moved to dissolve. The report does not expressly state that the answer denied the validity of the patent, but as this was the only question discussed, it is obvious that the answer must have contained such a denial; and it appears that a variety of affidavits were produced on both sides, tending respectively to impeach, and to assert the validity of the patent, and of the injunction to restrain the breach of it; and amongst them, was an affidavit by the plaintiff on the point of novelty. The same reasons for allowing affidavits of title to be read on a motion for dissolving an injunction, apply to motions for granting it, in the first instance, where the answer has been filed. Now, upon the practice of reading such affidavits on a motion to dissolve, there has been a considerable conflict of decisions. But a distinction was adopted, at a very early period, with regard to injunctions for restraining certain wrongful acts of a special nature, as distinguished from the common injunction for staying proceedings at law. It is the settled practice of the court, in England, to allow affidavits to be read, at certain stages, against the answer, in cases of waste, and of injuries in the nature of waste; but, in cases of waste, they must be confined to the acts of waste, and the title, it is said, must be taken from the answer. *Drewry on Injunc.* 429; *Gibbs v. Cole*, 3 P. Will. 255; *Norway v. Rowe*, 19 Ves. 146, 153; *Smythe v. Smythe*, 1 Swanst. 254, and cases collected in the note. The question is, whether the same rule applies to cases of patents, or, whether they do not stand, in respect to the admission of affidavits on the point of title, upon the reason of the rule which permits affidavits in cases of waste upon the facts of waste. The ground of permitting affidavits to be read on the part of the plaintiff, in cases of waste, is, that the mischief is irreparable; the timber, if cut, cannot be set up again, so that the mischief, if permitted, cannot be retrieved. The same reason exists in cases of partnership, by analogy to waste. *Peacock v. Peacock*, 19 Ves. 49. Does not this reason apply to a denial of the novelty of the plaintiff's invention? Such a denial in the answer the defendant has a right to make, and to have it tried at law; but if the denial is to be taken as true, on a motion to grant or to dissolve an injunction, it may work an irreparable mischief before the plaintiff can establish his right at law; and yet, this is the consequence of adopting the rule, that, in cases of patents, the title is to be taken from the answer, on motions for an injunction. The court must either assume that the denial in the answer, upon the point of novelty, is true, and, therefore, the plaintiff cannot have an injunction in any case, of however long possession, where the defendant chooses to make this denial; or it must say, that, however strong the denial in the answer, the plaintiff shall always have his injunction; or it must look into the evidence on both sides sufficiently to determine whether it is probable that the plaintiff will be able to establish his patent, and grant or withhold the injunction accordingly. The latter was the course taken by Mr. Justice Woodbury, in *Orr v. Littlefield*, where, however, an answer had not been filed, the defendant relying on affidavits; but the reasoning of the learned judge makes the same course applicable to cases where the equity of the bill is denied by the answer. See the observations of the court, cited *ante*. There is a dictum of Lord Lang-

irreparable mischief, rests in the sound discretion of the court, after answer, as well as before.

It is also decided, in the second circuit, that where in an application for a provisional injunction the plaintiffs read affidavits in support of the bill, which are met by affidavits from the defendant setting up a license in defence, there the court may, under rule 107, and the emendation of May, 1843, permit the plaintiff to put in proofs of rebuttal of the defence, but that the defendant cannot reply to such rebutting proofs by further evidence on his part. Also, that the order admitting such proofs is regular, although not made until such rebutting proofs are received.¹

dale, M. R., in *Wilson v. Tindal*, Webs. Pat. Cas. 730 note (cited *ante*), that "notwithstanding this order (the injunction) the defendant may put in his answer, he may displace all the affidavits which have been filed on both sides." This I conceive to mean merely, that the defendant may show such a case in his answer, as to control the *prima facie* case made by the plaintiff; and not that the answer necessarily displaces the affidavits before filed. In *Poor v. Carleton*, 3 Sumner, 70, 83, Mr. Justice Story reviewed this whole subject, and laid down the broad doctrine that the granting and dissolving injunctions, in cases of irreparable mischief, rests in the sound discretion of the court, whether applied for before or after answer; and that affidavits may, after answer, be read by the plaintiff to support the injunction, as well as by the defendant to repel it, although the answer contradicts the substantial facts of the bill, and the affidavits of the plaintiff are in contradiction of the answer.

¹ *Day v. New England Car Spring Co.*, 3 Blatchf. 154. "The rule of proceeding applicable to injunctions must govern this case. The plaintiff has set out his rights and his injuries by his bill; and the defendants must be prepared to make their entire defence thereto, by showing in the first instance, by their answer or by affidavits, a want of right in the plaintiffs or a superior right in themselves. The law allows the plaintiff to obviate such defence by suppletory or rebutting evidence, and precludes the defendants from replying to such rebutting evidence by further proofs on their part. This is alike the rule at law and in equity. No court permits a defendant to make a new defence to proofs or arguments made in reply to his own. He has one hearing or chance alone, and must abide the advantage placed in the hands of the plaintiff. But this disadvantage to a defendant is not perpetual. The defendants can file their answer to the bill and move to dissolve the injunction; or they can appeal to the discretion of the court to award only a qualified one, &c.

"As this case stands, the defendants can meet it upon this motion, only by showing, from the depositions and documents before the court, that the plaintiff has no title, or that a paramount legal or equitable right is vested in them. This I understand to be, in a proceeding by injunction bill to stay waste or prevent the infringement of patent rights, the established practice of this court and of the English Court of Chancery." Rule 107 of this Court, in Eq.; Rule, May, 1846; 1 Blatchf. 656; 3 Daniels, Ch. Pract. 1885, 1886, notes; 2 Waterman's Eden on Injunct. 384, 385, notes.

CHAPTER XI.

QUESTIONS OF LAW AND QUESTIONS OF FACT.

§ 444. THE several provinces of the court and the jury in the trial of patent causes have already been incidentally alluded to, but it may be proper to give here a summary of the principal questions which constitute matters of fact and matters of law.

§ 445. As to *novelty*. Under this general head there are several distinctions to be carefully observed. Novelty, as the term is generally employed, embraces only the topics of invention and identity. But it is evident that, where there is no dispute either as to identity or invention, the question may arise: granting the patent to be what the patentee claims it to be, can the *court*, without aid of the jury, say that the invention as it stands has been made known to the public? This issue arose in the case of *Lang v. Gisborne*¹ (already discussed in the chapter on Action at Law). The plan of the target invented and patented by the plaintiff was admitted to be identical with that made by the defendant, and also with one described in a work which was published in Paris before the patentee's application, and of which several copies had been sold in England. The only question, therefore, before the court, was, whether the sale of a few copies, unaccompanied by evidence of subsequent public user, did amount to a publication in law such as would entitle the court to reject the plaintiff's application. The Master of the Rolls held that such a sale was a publication in law, and that the question could not be affected by any consideration of the number of the persons who might or might not be proved to have thought it proper to avail themselves of the publication.

This opinion is, we think, substantially embodied in the ruling of the Court of Common Pleas, in the case of *Stead v. Williams*.² It must, however, be observed, that this latter case differs from that of *Lang v. Gisborne*, inasmuch as the question of identity was also raised, and that therefore it was not only proper, but necessary, for the court to submit the question of prior publication to the jury, upon the whole of the evidence. In *Lang v. Gisborne*, on the con-

¹ 6 Law Times, n. s. 771.

² 2 Webs. Pat. Cas. 126.

trary, no such point was at issue, but the whole resolved itself into a question of pure law. Making, then, this qualification, we think that the Common Pleas and the Master of the Rolls are of accord on the question what effect is to be given to publications. At the jury trial, Cresswell, J. had instructed the jury thus: "But then the defendants do not bring home to the plaintiff the fact of his having seen any of those publications; and it is for you to judge, upon the whole of the matter, whether you think that he had seen those publications, and had derived his information from the stock of knowledge previously given to the public of this country," &c. This ruling was appealed from, and a new trial was granted on the ground of misdirection. Tindal, C. J. observes: "On a full consideration of the subject, we have come to the conclusion that the view taken by the defendants' counsel is substantially correct; for we think, if the invention has already been made public in England, by a description contained in a work whether written or printed, which has been publicly circulated, in such case the patentee is not the first and true inventor within the meaning of the statute, whether he has himself borrowed his invention from such publication or not; because we think the public cannot be precluded from the right of using such information as they were already possessed of at the time the patent was granted. It is obvious that the application of this principle must depend upon the particular circumstances which are brought to bear on each particular case. The existence of a single copy of a work, though printed, brought from a depository where it has long been kept in a state of obscurity, would afford a very different inference from the publication of an encyclopædia or other work in general circulation."

§ 446. Passing then to the question whether the patentee was the inventor of the thing patented, and whether the thing patented is substantially different from anything before known, — an issue which, in distinction from the one treated of in the preceding paragraph, might be called the *material* one, — we find it broadly stated in a number of cases, that it is a question for the decision of the jury, and that the sole province of the court consists in giving the proper instructions as to what constitutes novelty and sufficiency of invention to sustain a patent.¹

¹ *Whittemore v. Cutter*, 1 Gall. 478; *Lowell v. Lewis*, 1 Mas. 182; *Carrer v. Braintree Manuf. Co.*, 2 Story's R. 437; *Washburn v. Gould*, 3 Story's R. 122;

Here, again, there is a distinction, which was formerly much dwelt upon, and which gave rise to much discussion. The defendant, who is charged with infringement of a patent and raises the issue of novelty, may do so in two ways. He may simply allege that the plaintiff's invention is really no invention at all, but that it was in public use at the time the letters-patent were obtained. The evidence to support such an allegation would consist, then, of what is called evidence *in pais*, and as such, could be weighed and decided upon only by the jury. All that the court can do in such cases is to instruct the jury that if they are satisfied that the plaintiff's invention is borrowed from some third party, or *substantially* contained in some printed publication (i. e. where there is a dispute as to identity), or substantially in public use at the time of the alleged invention, they must find for the defendant.¹ On this point all the decisions agree that in such cases the issue of novelty and identity is, under proper instructions, to be left to the jury.

It was, however, supposed — and the supposition lies at the foundation of a number of important English cases — that where the defendant, in a patent suit, claims himself to be acting under a patent, or asserts that the plaintiff's invention is contained in a patent granted to some third party, in such a case the court alone, by virtue of its acknowledged authority to be the sole interpreter of written instruments, could pronounce upon the question of identity. In other words, the court could say that the process or the machine claimed in A's patent is identical with that of B. Thus, in *Bovill v. Pimm*,² the Court of Exchequer say, "We think this is a question of law, where the facts are not disputed." Also, in the recent case (1860) of *Betts v. Menzies*,³ it was held by the Exchequer Chamber, on appeal from the Queen's Bench, that the comparison of two specifications was exclusively within the prov-

Steiner v. Heald, 6 E. L. & Eq. 536, reversing s. c. 2 Carr. & Kirw. N. r. 1022. The patentee here had taken out letters-patent for the manufacture of garancine from spent madder. For a long while this spent madder had been worthless, although still containing a percentage of coloring matter. It was then discovered that by treating *fresh* madder with acid and hot water, *all* the coloring matter could be extracted. The plaintiff's invention consisted in treating the previous spent madder in the same way. Held by the Exchequer Chamber that it was a question for the jury, whether this was a new manufacture of garancine.

¹ *Stead v. Williams*, 2 Webs. Pat. Cas. 126; *Stead v. Anderson*, Ibid. 147.

² 36 E. L. & Eq. 441.

³ 1 Ell. & Ell. Q. B. 990.

ince of the court. The decision assumed that this point had been decided in *Bush v. Fox*,¹ a case which had been before the House of Lords in 1856.

In March, 1862, the case of *Hills v. Evans*² came up before the Lord Chancellor Westbury, and received from him a ruling in direct opposition to that of the Exchequer Chamber, in *Betts v. Menzies*. In rendering his decision his lordship entered into an elaborate discussion of the case of *Bush v. Fox*, and showed that the House of Lords, in that case, had not, as was commonly supposed, pronounced directly upon the question, but that the Exchequer, in giving their decision in *Betts v. Menzies*, had been misled by *obiter dicta* of Lord Cranworth in moving the vote of the House. In June, 1862, *Betts v. Menzies* came up to the House of Lords, on appeal from the Court of Exchequer Chamber. The decision of the Exchequer Chamber was thereupon reversed, and the ruling of Lord Westbury sustained.

In *Hills v. Evans* the Lord Chancellor said: "Now the argument has been, that it is the duty of the court and the right of the court to construe these earlier specifications, and that if I found, from the specifications so construed, when collated and compared with the specification of the plaintiff's patent, that the invention described in the one was identical with the invention described in the other, the court might at once arrive at the conclusion that there was no novelty in the invention, and deal with the whole matter as matter of law, and not as matter to be submitted to the jury, and that undoubtedly is a question deserving of very serious consideration. It is undoubtedly true as a proposition of law, that the construction of a specification, as the construction of all other written instruments, belongs to the court; but a specification of an invention contains, most generally, if not always, some technical terms, some phrases of art, and requires generally the aid of the light derived from what are called surrounding circumstances. It is therefore an admitted rule of law, that the explanation of the words or technical terms of art, the phrases used in commerce, and the proof and results of the processes which are described (and in a chemical patent, the ascertainment of chemical equivalents), that all these are matters of fact, upon which evidence may be given, and upon which undoubtedly it is the province and right of a jury to decide. But when those portions of a specification are abstracted and made

¹ 38 E. L. & Eq. 1.

² 6 Law Times, N. S. 90.

the subject of evidence, and therefore brought within the province of the jury, the direction to be given to the jury must be a direction given only conditionally ; that is to say, a direction as to the meaning of the patent, upon the hypothesis or basis of the jury arriving at a certain conclusion with regard to the meaning of those terms, the signification of those phrases, the truth of those processes, and the result of the technical procedure described in the specification. . . . [Citing from the opinion of Baron Parke, in *Neilson v. Harford*.] Now, adopting that as the rule in the comparison of two specifications, each of which is filled with terms of art and with the description of technical processes, the duty of the court would be confined to this, to give the legal construction of such document taken independently. But after that duty is discharged, there would remain a most important function to be still performed, which is the comparison of the two instruments, when they have received their legal exposition and interpretation ; and, as it is always a matter of evidence what external thing is indicated and denoted by any description, when the jury have been informed of the meaning of the description contained in each specification, the work of comparing the two and ascertaining whether the words (as interpreted by the court) contained in specification *A* do or do not denote the same external matter as the words (interpreted and explained by the court) contained in specification *B*, is a matter of fact, and is, I conceive, a matter within the province of the jury, and not within the function of the court. Granting, therefore, to the full extent the propriety of the expression of the rule which is here contained, and taking either specification as so interpreted, whether the two specifications that are brought into comparison do or do not indicate the same external matter must be determined by the jury, and not as matter of law by the court. And I find that this has been the case and the course adopted by learned judges in a great variety of reported cases at *Nisi Prius*." The Chancellor then cites *Muntz v. Foster*, and *Walton v. Potter*, and proceeds to show that a seemingly contrary opinion, expressed by a former Lord Chancellor in *Bush v. Fox*, in moving the judgment of the House of Lords, was a mere *obiter dictum*, and not embraced in that judgment.

Similar language is employed by Lord Chancellor Westbury, in *Betts v. Menzies*,¹ before the House of Lords : " My Lords, the

¹ 4 Best & Smith, 9 B. 996 ; 7 Law Times, n. s. 110.

second question was this, ' can the court pronounce Betts's patent to be void, simply on the comparison of the two specifications, without evidence to prove identity of invention ; and also without evidence that Dobb's specification disclosed a practicable mode of producing the result or some part of the result described in Betts's patent. The answer of the learned judges involves, therefore, two conclusions which are extremely material to the patent law. One is this, — that even if there be identity of language in two specifications, remembering that those specifications describe external objects, even if the language be verbatim the same, yet if there be terms of art found in the other specification, it is impossible to predicate of the two with certainty that they describe the same identical external object, unless you ascertain that the terms of art used in the one have precisely the same signification and denote the same external objects at the date of the one specification as they do at the date of the other. And, my Lords, this is obvious ; for if we take two specifications dated as the present are, one in 1804 and the other in 1849, even if the terms employed in the one were identical with the terms employed in the other, — supposing that each of them contained a term of art, e. g. a denomination of some engine, some instrument, some drug, some chemical compound, — it might well be that the thing denoted by that name in 1804 is altogether different from the thing denoted by the same name in 1849. If it were necessary to enter into such a subject, I could give numerous examples — say in chemistry — of things that were denoted by one name in 1804 and which have retained the denomination, but which, by improved processes of chemical manufacture, are at present perfectly different in their results, their qualities, and their effects, from the things denoted by the same name some forty or fifty years ago. It is perfectly clear, therefore, that if you compare two specifications, even if the language be the same, you cannot arrive at a certainty that they denote the same external object and the same external process, unless you enter into an inquiry, and ascertain as a fact, that the thing signified by the nouns substantive contained in the one specification are precisely the same as the things signified by the same nouns substantive contained in the other. In all cases, therefore, where the two documents profess to describe an external thing, the identity of signification between the two documents con-