

tific terms, or the existence of the surrounding circumstances. If there are no words of art and no surrounding circumstances to be ascertained, the court, as we have seen, will instruct the jury what the specification has said; and then the jury will determine, the specification having said so and so, whether the description is sufficient to enable a competent workman to put the invention in practice.<sup>1</sup>

§ 463. There is no positive rule by which it can be determined, in a given case, *à priori*, whether the meaning of words of art, or the bearing of surrounding circumstances, affects the sense of the specification; or which limits the right of the plaintiff to offer evidence to show that its meaning is so affected. The plaintiff is always entitled to say that his specification requires the explanation of facts, to determine the extent of his claim and the character of his invention; and the only course that can be taken is for the court to receive and watch the evidence, and to apply it to the construction, taking care that it be not allowed to go so far as to supply positive omissions, which would render the specification defective. Within this limit, the construction, which is nothing more than the ascertaining of the meaning of what is written, may always be affected by evidence; which is to be taken into view, although no conflict arises requiring a finding of the jury, because the court can have no judicial knowledge either of the terms of art, or of the surrounding circumstances, and cannot say, until it has heard the evidence, that the meaning is not to be affected by them.

§ 464. The provinces of the court and the jury, then, are distinct, and upon this particular question of the practicability of the specification, it is of consequence that they should not be confounded. When it is put to a jury to determine whether a specification has so fully and accurately described the invention that others can practise it from the description, the danger sometimes arises of their undertaking to determine what the claim is; because the extent and character of the claim itself may depend on the same words on which they are to decide the intelligibility

<sup>1</sup> It follows, from the proposition that the court are to declare what the specification has said, that it is also a question of law upon the construction of the specification, whether the invention has been specifically described with reasonable certainty. This is a distinct question from the intelligibility of the practical directions, although both may arise upon the same passages.

of the directions, and may thus seem to be inseparably blended with the question of that intelligibility. But in truth these questions are always separable, and care should be taken to separate them. In one aspect, every thing is for the jury which bears on the question whether the specification sufficiently describes the mode of carrying the invention into effect; but on the other hand the meaning of the very passages on which this question arises, in relation to the prior question of what the specification has said, is for the court, after the facts which bear upon that meaning have been ascertained.

Thus, in *Davis v. Palmer*,<sup>1</sup> Marshall, C. J., says: "It may not, perhaps, be easy to draw a precise line of distinction between a specification so uncertain as to claim no particular improvement, and a specification so uncertain as not to enable a skilful workman to understand the improvement and construct it. Yet we think the distinction exists. If it does, it is within the province of the jury to decide whether a skilful workman can carry into execution the plan of the inventor."

§ 465. The case of *Neilson v. Harford* presents an apt illustration of the nicety and importance of these distinctions. Mr. Neilson invented the application of the hot blast to smelting furnaces, by introducing between the blowing apparatus and the furnace a chamber or receptacle, in which the air was to be heated on its passage, before it entered the furnace. After describing the mode in which this was to be accomplished, his specification said: "The form or shape of the vessel or receptacle [the vessel in which the air was to be heated] is immaterial to the *effect*, and may be adapted to the local circumstances or situation." This direction, it was contended, was calculated to mislead a workman, because it was not true; it was said, in point of fact, that the size or shape of the heating vessel was immaterial to the "effect" on the air in that vessel; and this, it was argued, was the "effect" concerning which this delusive statement was made in the specification. On the other hand, the plaintiff contended that the meaning of this passage was, that the size and shape of the heating vessel were immaterial to the effect *on the furnace*, and that it was true, in point of fact, that some beneficial effect might be produced on the furnace, whatever the size or

<sup>1</sup> 2 Brock. 298.

shape of the heating vessel might be, provided the temperature of the air be sufficiently raised.

§ 466. The principal question raised upon the pleadings was, whether the directions were calculated to mislead a workman who might be employed to construct such an apparatus, by stating that which was not true. This, it was allowed, was a question for the jury, but before it could be determined, it was necessary to ascertain what the specification had said; since the fact of its having or not having stated what was not true, would depend altogether upon the sense in which the words were to be received. At the trial, the presiding judge construed the word "effect" to mean the effect on the air in the heating vessel; and the jury having found that the size and shape of the heating vessel were material to the extent of beneficial effect produced, a verdict was entered for the defendants.

§ 467. Upon a motion to enter the verdict for the plaintiff, on this issue, founded on the special verdict, which also ascertained that some beneficial result would be produced from any shape of the heating vessel, it was argued with great force and ingenuity, that the question being whether the specification could or could not be carried into effect, which is confessedly a question for the jury, the whole question of the meaning of the passages on which they were to decide the sufficiency of the specification, was also for the jury, who were to say whether the words were or were not sufficient for carrying into practical effect the invention or discovery which the patentee supposed he had made. It was further argued, that the meaning of the words depended upon evidence; whereas, if the court were to pass upon the meaning of the paper, they must act upon the written paper alone, without evidence. But the court laid down the doctrine that in all cases the meaning of the specification is for the court; and, although the question which goes to the jury is whether the directions in the specification are sufficient or not, it is necessary for the court to declare what the specification has said. This must be done, either by taking into view at the time the evidence which bears upon the meaning, where it is not controverted, or by leaving to the jury, as matters of fact, to pass upon that evidence, in order to ascertain the meaning of scientific words, or the surrounding circumstances on which the construction depends. In the one

case, the construction is given absolutely ; in the other, it is given conditionally, because dependent upon facts to be found by the jury.<sup>1</sup>

<sup>1</sup> Neilson v. Harford, Webs. Pat. Cas. 295, 319. Sir W. Follett argued as follows: " I submit to your lordships that the whole question upon the validity of the specification, that is, on the meaning of the specification, and whether it can or cannot be carried into effect, is a question for the jury and not for the court, and that the jury are to put their construction upon the meaning of the words, and that the jury are to say whether the words are or not sufficient, and that it is for them to say whether the specification does sufficiently show the mode of carrying the invention and discovery which the patentee supposed he had made into practical effect. [Lord Abinger, C. B.: Why is the specification, which is a written instrument, more particularly to be considered by a jury, than any other instrument? The meaning of scientific words must be matter of evidence.] [Alderson, B.: The construction of it is surely for the court.] I do not know quite the extent to which it is supposed the authorities have gone in stating that certain papers are for the court. In many cases, undoubtedly, written papers are for the court, but I apprehend that is by no means a general doctrine of law ; but that written papers, which involve a question of fact like this, whether or not the party has sufficiently described the invention, that that written paper is for the jury and not for the court, because it is for the jury to say, as a matter of fact, whether there be or not a sufficient description in that instrument to enable parties to carry it into effect. That I apprehend to be a question entirely for the jury. Certainly, the whole of this is a question of evidence, and a question of fact. It is a question of fact as relates to the paper ; it is a question of fact as regards the evidence at the trial ; it is not a question of law at all ; and I do not know any rule which is to say that the court is to construe that specification, and to take it from the jury, because, supposing the fact to be that evidence was given at the trial on scientific matters, which evidence would aid the meaning or the construing of the instrument, your lordships can have no judicial notice of that at all. If it be a written paper for your lordships to decide upon, it must be without evidence. It is not that your lordships can come to a conclusion upon the meaning of the paper by looking at the evidence at the trial, but if it comes within the rule, that it is a written paper which the court is to act upon, then it must act upon the written alone. I think I can show your lordships that in every single case in which any question has arisen, it has been submitted to the jury, not decided by the court. [Lord Abinger, C. B.: Not consistently with my recollections ; I have always thought that the meaning of the specification was to be determined by the court. That meaning may be varied by the evidence of particular words. A man must gather as he goes along in order to construe the written instrument. It is quite new to me that it is not to be considered by the court.] [Alderson, B.: Surely the court is to tell the jury what the specification has said. If the specification contains words of art, the court is to say, — If you believe these words of art to mean so and so, the specification has said so and so ; leaving the question of words of art to the jury. But if

§ 468. The question whether the invention disclosed by the specification is a proper subject for a patent, is a question of law, on which the court will instruct the jury. It may involve the finding of a variety of facts; but when the facts are all ascertained, it is purely a question of law, whether the invention or discovery is a patentable subject. This is a distinct and very different question from that of the novelty of the invention. The thing claimed as the subject of a patent may be entirely new, and yet it may not fall within that class of discoveries or inventions recognized by the patent law as the subjects of patents, and as such comprehended within the description of the statute. Thus, the subject-matter may turn out to be the application of an old or well-known thing, to a new purpose, constituting a new use only so far as the occasion is concerned; which the law decides is not the subject of a patent.<sup>1</sup> Or, on the other hand, the claim may be for the use of a known thing in a known manner, to produce effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public; which the law decides is a patentable subject.<sup>2</sup> In these and other

there are no words of art, what the specification has said is to be construed by the court. Then it is to be left to the jury, whether the specification having so said, it is or not a sufficient description of the invention according to their judgment.] I do not mean the validity of the specification as to questions in which you may direct nonsuits in point of law arising out of objections of a different kind, but that this question, whether or not the specification sufficiently describes the mode of carrying the invention into effect: that every thing relating to that is for the jury, and not for the court, — the meaning of the passages in the specification, and every thing. I should submit to your lordships that the whole of it was for the jury, and not for the court. [Alderson, B.: That there are some things in the specification which are questions of fact is true, and there are some things in the specification which are questions of law; the construction is to be given by the court, but the intelligibility of it is for the jury.] That is all I am contending. [Lord Abinger, C. B.: The intelligibility means with reference to words of science, or matters in it which persons may explain so as to satisfy the jury. You are discussing an abstract principle where it is not necessary: if you take an abstract principle, I must say the meaning of the specification is a matter of law, and that the judge must be informed, by evidence, of the facts, and then he must leave those facts to the jury, for them to find whether they be true or not.] See also *ante*, note.

<sup>1</sup> *Losh v. Hague*, Webs. Pat. Cas. 202, 207; *Howe v. Abbott*, 2 Story's R. 190.

<sup>2</sup> *Crane v. Price*, Webs. Pat. Cas. 408, 409.

cases where the question arises, upon all the facts attending and surrounding the alleged invention, whether it is a patentable subject, it is for the court to settle that question. Of course the novelty of the invention is a prerequisite to the validity of the patent, and this is a question of fact; but the alleged invention being ascertained to be new, it is still to be determined whether it is that species of invention to which the law gives the protection of a patent.

§ 469. The question of infringement is, as has already been stated, a question whether the invention of the defendant is substantially the same thing as that of the plaintiff. The identity of two things is a matter of fact, depending upon evidence; and although it is to be determined under the guidance of those principles which determine what constitutes identity and diversity in the sense of the patent law, yet it is for the jury to determine, as matter of fact, under proper instructions, whether the two things are the same or different.<sup>1</sup>

This is true even where there is no dispute as to the particular process or machine employed by the defendant, but only whether that process or machine is an infringement. The court cannot compare the plaintiff's invention with that which is used by the defendant and say that the two are identical.<sup>2</sup>

For a full discussion of the question, what is proper evidence of the infringement, by means of chemical equivalents, of a chemical process, see Heath's patent and the numerous decisions elicited by it,<sup>3</sup> *supra*, chapter on Infringement.

§ 469 *a*. On the question of infringement, the issue is between the plaintiff's machine, as described in his patent, and the machine made, used, or sold by the defendant; and it is no answer for the defendant to show that he is a licensee under another patent, and that his machine is made in accordance with that patent.<sup>4</sup>

<sup>1</sup> *Boulton v. Bull*, 2 H. Bl. 463; *Whittemore v. Cutter*, 1 Gallis. 478; *Pen-nock v. Dialogue*, 4 Wash. 538; *Lowell v. Lewis*, 1 Mason, 191; *Phillips on Patents*, 431.

<sup>2</sup> *Delarue v. Dickenson*, 7 Ell. & Blackb. 738. Compare a similar question as to the provinces of court and jury on the issue of novelty, at the commencement of the present chapter.

<sup>3</sup> 2 Webs. Pat. Cas. 213; 32 E. L. & Eq. 45.

<sup>4</sup> *Blanchard v. Putnam*, 8 Wallace, 420.

## CHAPTER XII.

## EVIDENCE.

§ 470. THE evidence appropriate to the different stages of a patent cause may be divided into (1) the evidence of title, and (2) the evidence upon the point of infringement. Evidence of title relates to the letters-patent and the plaintiff's interest therein, the novelty and utility of the invention, and the sufficiency of the specification. Evidence of the infringement relates to the identity of the thing made, used, or practised by the defendant, with the invention of the patentee.

§ 471. I. *As to the plaintiff's title.* With regard to the letters-patent, the statute of 1836, §§ 4, 5, makes a copy under the seal of the Patent Office and the signature of the commissioner competent evidence that a patent has been granted by the government for the invention described in the specification annexed. If the patent produced in evidence refers to the description in a former patent, it is necessary to produce and read that former patent, in order to show what the invention is, if it is not made entirely clear and intelligible by the patent on which the action is brought.<sup>1</sup>

§ 471 a. Where the patentee has surrendered his original patent and taken out a reissue with an amended specification, the action of the commissioner of patents in granting the reissue is conclusive evidence upon the question of "inadvertence, accident, or mistake." The decision of the commissioner is not re-examinable elsewhere, except upon the ground of fraud or evident want of jurisdiction. 'Such is the ruling of the Supreme Court in the case of *Stimpson v. Westchester Railroad*,<sup>2</sup> confirm-

<sup>1</sup> *Lewis v. Davis*, 3 Carr. & Payne, 502. A drawing filed subsequent to the destruction by fire of the original patent is admissible in evidence. *Emerson v. Hogg*, 2 Blatchf. 1.

<sup>2</sup> 4 How. 380.

ing the decision in *Woodworth v. Stone*,<sup>1</sup> under the provisions of the act of 1836, c. 357, § 13, although the same court had previously decided, in the case of *Philadelphia and Trenton Railroad v. Stimpson*,<sup>2</sup> that the action of the commissioner was only *prima facie* evidence. The opinion of Judge Story in the case of the *Philadelphia and Trenton Railroad*, as cited in the note to the following paragraph, must accordingly be understood with this modification. So also, in the case of an extension of the term of letters-patent, the action of the commissioner is conclusive evidence of all the facts that he is required to find, and is impeachable only for fraud.<sup>3</sup> The signature of one styling himself "acting commissioner," attached to letters-patent, is sufficient in controversies between the patentee and third parties.<sup>4</sup>

§ 472. The letters-patent being thus proved to have issued, they are *prima facie* evidence that the patentee was the first inventor of the thing patented.<sup>5</sup> The reason upon which this is held is that our statute requires the patentee to make oath that he is the first and true inventor of the thing; and when the patent has issued, supported by this oath, the burden of proofs is cast upon the party who would object, to show that the grant has been improperly obtained by the patentee; because the law presumes, in the first instance, that the patent has been granted upon the proofs which the statute requires to be laid before the officers of the government, and that those proofs were satisfactory.<sup>6</sup>

<sup>1</sup> 3 Story's R. 749.

<sup>2</sup> 14 Pet. 448. See *ante*, § 279 *et seq.*

<sup>3</sup> *Clum v. Brewer*, 2 Curt. C. C. 506; *Colt v. Young*, 2 Blatchf. 471.

<sup>4</sup> *Woodworth v. Hall*, 1 Woodb. & Min. 248, 389.

<sup>5</sup> *Alden v. Dewey*, 1 Story's R. 336; *Woodworth v. Sherman*, 3 Story's R. 172; *Stearns v. Barrett*, 1 Mason, 153. It is also held in England that the patent is *prima facie* evidence, on the part of the person claiming the right, that he is so entitled. *Minter v. Wells*, Webs. Pat. Cas. 129.

<sup>6</sup> In the *Philadelphia and Trenton Railroad Company v. Stimpson*, 14 Peters, 458, Mr. Justice Story, delivering the opinion of the Supreme Court of the United States, said: "Now the objection is, that the present patent does not contain any recitals that the prerequisites thus stated in the act have been complied with, viz., that the error in the former patent has arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention; and that without such recitals, as it is the case of a special authority, the patent is a mere nullity and inoperative. We are of opinion that the objection cannot, in point of law, be maintained. The patent was issued under the great seal of the United States, and is signed by the President, and countersigned by the Secretary of State. It is a presumption of law, that all



Where the defendant wishes to set up a merely equitable title against one who possesses the full legal title, he must distinctly allege such defence in his answer, and establish it on the title. The burden of proof is against him.<sup>1</sup>

§ 473. When the patentee wishes to strengthen this evidence, either in the opening of his case or to rebut any evidence offered by the defendant which may have tended to show that he was not the first inventor, he can only call persons who were in the way of hearing of the invention if it had existed before, to testify that they have not heard of it. The proposition which the plaintiff has to establish is, strictly, a negative; he is to prove that the invention did not exist before; and therefore, as has been said, he must proceed by exhausting the affirmative instances of it, by calling those persons who might have known of it, if it had existed before, but who never have heard of it; and the more those persons, from their acquaintance with the particular trade or manufacture, were in the way of hearing of or meeting with it, the stronger the evidence will be.<sup>2</sup>

public officers, and especially such high functionaries, perform their proper official duties until the contrary is proved. And where, as in the present case, an act is to be done, a patent granted upon evidence, and proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act or granted the patent is *primâ facie* evidence that the proofs have been regularly made, and were satisfactory. No other tribunal is at liberty to re-examine or controvert the sufficiency of such proofs, if laid before him, when the law has made such officer the proper judge of their sufficiency and competency. It is not, then, necessary for the patent to contain any recitals that the prerequisites to the grant of it have been duly complied with, for the law makes the presumption; and if, indeed, it were otherwise, the recitals would not help the case without the auxiliary proof that these prerequisites had been, *de facto*, complied with. This has been the uniform construction, as far as we know, in all our courts of justice, upon matters of this sort. Patents for lands, equally with patents for inventions, have been deemed *primâ facie* evidence that they were regularly granted whenever they have been produced under the great seal of the government, without any recitals or proofs that the prerequisites under which they have been issued have been duly observed. In cases of patents, the courts of the United States have gone one step further, and as the patentee is required to make oath that he is the true inventor, before he can obtain a patent, the patent has been deemed *primâ facie* evidence that he has made the invention." See *Pitts v. Hall*, 2 Blatchf. 229.

<sup>1</sup> *Gibson v. Cook*, 2 Blatchf. 144.

<sup>2</sup> *Cornish v. Keene*, Webs. Pat. Cas. 503; *Galloway v. Bleaden*, *ibid.* 526; *Pennock v. Dialogue*, 4 Wash. 538. "The fact of making or exhibiting an

§ 474. Although this evidence is only general and negative, it is not, on that account, without weight. To illustrate its force as well as its proper office, we may suppose a case where the defendant had succeeded in showing that some prior inventor had made experiments in the same line as the patentee, and that this evidence goes so far as to show that that person had probably accomplished the same result as the patentee; but the point is still left in doubt, whether he had actually reached and perfected the invention for which the plaintiff has obtained a patent.<sup>1</sup> The rule of law in such cases is that if the prior efforts of some preceding inventor rested in experiment alone, his experiments, however near they may have been carried to the complete production of the thing, will not prevent a subsequent, more successful inventor, who has produced the perfect result at which both may have aimed, from obtaining a valid patent. The question for the jury will therefore be, in such cases, whether the efforts of the prior inventor rested in experiment alone, without coming to the point of completion, both in the theory and the actual application of the invention. Upon this question, the fact that the invention was never heard of until it was known to have proceeded from the present patentee, is of great weight. If it had been heard of among those persons who make it the business

article never before seen or heard of by the witnesses who prove the fact, is at least *prima facie* evidence of invention, until other evidence is given to prove that the same article was invented, known, or in use, at an antecedent period of time, and that the patentee had only embodied the conceptions and the discovery of some other person."

<sup>1</sup> The remarks of Nelson, J., in *Many v. Jagger*, 1 Blatchf. 372, seem to be here in point: "But there is one fact to which we will call your attention, that is entitled to some consideration, although it is not decisive. The James wheel was in general use on the Harlem R.R. in 1834, and to some extent on the New Jersey R.R. Baldwin in Philadelphia in 1835, and Tiers in the same city in 1836, one of them a year, the other a year and a half after the James wheel was in common use on these two roads, made trial to cast the double-plate wheel; and we think, on the evidence in the case, it is fair to infer that they made their experiments with full knowledge of the James wheel. . . . If this inference be a fair one, and it is for the jury to say whether it is or not, then, with the James wheel before them, Baldwin and Tiers both failed to make a double-plate wheel. They had the idea of such a wheel in their minds, but were unable to perfect it. The conclusion would seem to follow, that the James wheel and the double-plate wheel were not necessarily identical, or that the former would necessarily lead to the latter without any ingenuity other than ordinary mechanical skill."

of their lives to know what is going on in the particular trade or art which it concerns, or to know what inventions in all arts or trades are from time to time produced, prior to the time when it was made by the patentee, the presumption would be very strong, that the person who is proved to have made near experiments towards it had actually accomplished the perfect result.<sup>1</sup> Still the evidence would not be conclusive, because the report that such an invention had been made might have arisen from what had been done in the way of experiment alone. But it would be very strong presumptive evidence that the experiments had terminated successfully, if persons who were in the way of hearing of such inventions should testify that they had heard of such an invention having been announced, although they had not seen it. On the other hand, if such persons had not heard of such an invention, the evidence would not show conclusively that the prior experiments rested in experiment alone, but it would have a very strong tendency to establish this conclusion, because there is an irresistible tendency in inventions to become known, as to their results, if not as to their processes, whenever the results are accomplished.<sup>2</sup>

§ 475. There is one other species of evidence, applicable to the issue of novelty, when the question is as to the time when the patentee had completed his invention. It may be necessary for the plaintiff to rebut evidence offered by the defendant as to the invention and use of the same thing by other persons before the date of his patent, and hence it may be important to show

<sup>1</sup> If such persons had *seen* the thing, no further inquiry would be necessary, for the proof would be positive that the thing existed before. But the evidence we are here considering relates merely to the fact of such persons having or not *heard of* the invention, which fact, if shown in the affirmative, of course must be aided by proof of its having been made by somebody, and would not alone be conclusive proof of its actual previous existence.

<sup>2</sup> The case of *Galloway v. Bleaden*, Webs. Pat. Cas. 521, 525, presents a state of facts similar to that which we have supposed in the text. Two witnesses conversant with subjects of the description of the patented invention, and who devoted themselves to the knowledge of the inventions made from week to week, testified that they had not before heard of such a discovery previous to the issuing of the plaintiff's patent. The court said this was enough to call on the other side to show affirmatively that the invention was not new, and that it was for the jury to say whether the evidence as to what had been done by the antecedent experiments or efforts of others, in the way in which it ought to be understood, had brought their minds to that conclusion.

the precise time when the invention was completed by the patentee. For this purpose the patentee may give in evidence his own declarations, as part of the *res gestæ*, describing the nature and object of the invention, to an extent which has been defined by the Supreme Court of the United States.<sup>1</sup>

But where the inventor has parted with his interest in the letters-patent, e. g. by assignment, any subsequent declarations made by him are wholly inadmissible, either to show a want of title in him, or to affect the quality of the article, or to impair in any way the rights of the assignee.<sup>2</sup>

§ 476. Sometimes the issue of novelty involves the identity or diversity of the thing patented, compared with something before known or used, on which the defendant relies to defeat the

<sup>1</sup> "In many cases of inventions, it is hardly possible in any other manner to ascertain the precise time and exact origin of the particular invention. The invention itself is an intellectual process or operation; and, like all other expressions of thought, can in many cases scarcely be made known, except by speech. The invention may be consummated and perfect, and may be susceptible of complete description in words, a month, or even a year before it can be embodied in any visible form, machine, or composition of matter. It might take a year to construct a steamboat, after the inventor had completely mastered all the details of his invention, and had fully explained them to all the various artisans whom he might employ to construct the different parts of the machinery. And yet, from those very details and explanations, another ingenious mechanic might be able to construct the whole apparatus, and assume to himself the priority of the invention. The conversations and declarations of a patentee, merely affirming that at some former period he invented that particular machine, might 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 to be 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 antecedent time. In short, such conversations and declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ*, and legitimate evidence that the invention was then known to and claimed by him; and thus its origin may be fixed at least as early as that period." *The Philadelphia and Trenton Railroad Company v. Stimpson*, 14 Peters, 462. In *Pettibone v. Derringer*, 4 Wash. 215, the patentee was allowed to give in evidence his letters to the Secretary of State, containing applications and specifications, and certified under the department seal as papers remaining in that office. See *Allen v. Blunt*, 2 Woodb. & Min. 121, where a motion for a new trial, on the ground that such letters had been admitted in evidence, was refused.

<sup>2</sup> *Many v. Jagger*, 1 Blatchf. 376.

patent. The nature of the evidence, and the sources from which it is to be drawn, are the same upon this issue as when the question of identity or diversity arises under the issue respecting an infringement; and the consideration of the principles of evidence on both of these issues may here be postponed until we come to the general discussion of the question of identity.

§ 476 *a*. Where the patent is for a combination, the patentee is not permitted, on the trial, to abandon a part of the combination as useless, still less can he be suffered to prove it useless.<sup>1</sup>

With regard to the evidence of damages in an action for infringement, see *ante*, chapter on Infringement, where this topic is discussed at length. Here it may suffice to state that, in the absence of a license fee, actual damages must be proved by evidence bearing directly on the point, so that the jury may be furnished with sufficient data, and not left to the exercise of their ingenuity in guessing probable damages.<sup>2</sup>

§ 477. The plaintiff must also offer some evidence of the utility of his invention. The degree of utility, as we have seen, is not material; but the invention must be capable of some use, beneficial to society. This is ordinarily proved by the evidence of persons conversant with the subject, who may be called upon to say whether the thing invented is or is not capable of the use for which it is designed, or whether it is an improvement upon what had been in use before. But it may also be proved by other testimony, which will show that large orders have been given for the article by the public, or that licenses have been taken for the exercise of the right.

§ 478. The plaintiff, in addition to the *primâ facie* evidence of the novelty of his subject-matter, must also offer some proof of the sufficiency of his specification. In other words, he must show, to use the language of the statute, that his specification is "in such full, clear, and exact terms, as to enable any person, skilled in the art or science to which it appertains, to make, construct, compound, or use" the thing patented. This may be

<sup>1</sup> *Vance v. Campbell*, 1 Black. 427.

<sup>2</sup> *Seymour v. McCormick*, 16 How. 480; *City of New York v. Ransom*, 23 How. 487; *Suffolk Co. v. Hayden*, 3 Wall. 315. In view of these subsequent cases, it may be questioned whether the rule on the evidence and measure of damages, as laid down by Judge Nelson, in *Stevens v. Felt*, 2 Blatchf. 37, is still to be considered as law.

apparent to the jury on the face of the specification itself, from its simplicity and the absence of technical terms and descriptions; but where the invention is at all complicated, or terms of art or science are made use of, requiring the exercise of technical knowledge to determine whether the specification is sufficient, it is at least advisable, if not necessary, for the plaintiff, in opening his case, to give some evidence that his specification can be applied by those to whom the law supposes it to be addressed. If the sufficiency of the specification is disputed, the plaintiff must go into evidence to sustain it. How much of this evidence may properly be reserved for answer to the defendant's case, and how much should be introduced in the plaintiff's opening, must depend on the circumstances of the trial, although it may be stated, as a general rule, that slight evidence of sufficiency is all that is necessary to be offered at first, in order to make it incumbent on the defendant to falsify the specification.<sup>1</sup>

§ 479. The nature and source of the evidence, to show the sufficiency of a specification, present a topic of much interest, under that somewhat difficult branch of the law of evidence which relates to experts. What is the meaning of the statute, when it refers to the ability of persons "skilled in the art or science" to which the invention appertains, "or with which it is most nearly connected," to make, construct, compound, and use the same? Does it mean to adopt as witnesses those only who have the practical skill of artisans in the art or science, and to make their ability to understand and apply the specification the test of its sufficiency, or does it include that higher class of persons, who, from general scientific knowledge, or from a theoretical acquaintance with the principles of the art or science involved, might be able to teach an artisan or practical workman how to practise the invention? It is apparent that both of these classes of persons may be within the

<sup>1</sup> It seems to be the rule in England that the plaintiff must open with some evidence of the sufficiency of his specification, unless the defendant admits that it was tried and succeeded. *Turner v. Winter*, Webs. Pat. Cas. 81; 1 T. R. 602; *Cornish v. Keene*, Webs. Pat. Cas. 503. And if a whole class of substances be stated as suitable, the plaintiff must show that each of them will succeed. *Bickford v. Hewes*, *ibid.* 218. Under our system of pleading, the same rule should be followed. Although the defendant is obliged to give notice if he intends to rely on the insufficiency of the specification, the plea of not guilty puts the sufficiency of the specification in issue, and the plaintiff must therefore prove it as one of the things necessary to found his action.

literal meaning of the phrase "skilled in the art or science"; but the question is, whether the law contemplates one only, or both of them, as the proper witnesses to determine the sufficiency of a specification. It seems to me very clear that the law means to adopt, as a general standard of the sufficiency of a specification, the ability of skilful practical workmen to practise the invention from the directions given in the specifications. The standard of acquirement and knowledge may vary with the nature of the subject-matter; but where the invention falls within the province of an art or science, which is practised by a particular class of mechanics, operators, manufacturers, or other workmen, who possess and whose vocation it is to apply technical knowledge in that particular branch of industry, the patent law refers to their capacity to take the specification and carry out in practice the direction which it contains, without invention or addition of their own.

§ 480. Thus, if the invention be of a pump, or of some improvement in pumps, the question will be whether a pump-maker of ordinary skill could construct one upon the plan given in the specification, from the directions given.<sup>1</sup> If it be a composition of matter falling within the art of practical chemistry, the question on the specification will be whether its directions are so clear and intelligible that a practical chemist of ordinary skill could make the compound by following out the directions.<sup>2</sup> If it be a process involving the application of a principle in physics to a particular branch of manufacture, to be carried into effect in a particular manner, the question will be whether the directions, if fairly followed out by a competent workman, of the class ordinarily employed to construct an apparatus of that kind, would produce the effect intended.<sup>3</sup> This seems to be the general rule, applicable to a very large proportion of the inventions which become the subjects of patents; and accordingly it may be stated as a general rule that the proper witnesses to determine on the sufficiency of a specification are practical workmen of ordinary skill in the particular branch of industry to which the patent relates, because it is to them that the specification is supposed to be addressed.<sup>4</sup>

<sup>1</sup> *Lowell v. Lewis*, 1 Mason, 182.

<sup>2</sup> *Ryan v. Goodwin*, 3 Sumner, 514.

<sup>3</sup> *Neilson v. Harford*, Webs. Pat. Cas. 371.

<sup>4</sup> *Gibson v. Brand*, Webs. Pat. Cas. 629; *Bickford v. Skewes*, *ibid.* 219;

§ 481. At the same time, there may be another class of witnesses, of much higher character, competent to be examined on

*Arkwright v. Nightingale*, *ibid.* 61; *Elliott v. Aston*, *ibid.* 224; *Huddart v. Grimshaw*, *ibid.* 87; *Morgan v. Seaward*, *ibid.* 174; *Neilson v. Harford*, *ibid.* 371. The following instructive charge, given by Alderson, B., to the jury in *Morgan v. Seaward*, contains an elaborate illustration of the law on this point of intelligibility. "I will now begin with the specification. It is the duty of a party who takes out a patent to specify what his invention really is, and although it is the bounden duty of a jury to protect him in the fair exercise of his patent right, it is of great importance to the public, and by law it is absolutely necessary, that the patentee should state in his specification, not only the nature of his invention, but how that invention may be carried into effect. Unless he be required to do that, monopolies would be given for fourteen years to persons who would not, on their part, do what in justice and in law they ought to do, state fairly to the public what their invention is, in order that other persons may know what is the prohibited ground, and in order that the public may be made acquainted with the means by which the invention is to be carried into effect. That is the fair premium which the patentee pays for the monopoly he receives. The question is, whether Mr. Galloway has in the specification, and which is accompanied by a drawing which you ought to take as part of the specification, described with sufficient clearness and distinctness the nature of his invention, and the mode by which it is to be carried into effect. He has described two inventions, and if either of those inventions is not sufficiently specified, the patent fails; for if a person runs the hazard of putting two inventions into one patent, he cannot hold his patent, unless each can be supported as a separate patent. In order to support each, the invention must be useful, and must be described in the specification in such a manner as to lead people clearly to know what the invention is, and how it is to be carried into effect. That doctrine must be applied to each of the two inventions contained in this patent, that is, to the invention of the steam-engine, and the invention of the machinery for propelling vessels.

"To begin, therefore, with the steam-engine. Has Mr. Galloway sufficiently described it so as to enable any one to know what he has invented, and so as to enable a workman of competent skill to carry the invention into effect? Mr. Justice Buller, in the case of the *King v. Arkwright*, lays down as the criterion that a man, to entitle himself to the benefit of a patent of monopoly, must disclose his secret and specify his invention in such a way that others of the same trade, who are artists, may be taught to do the thing for which the patent is granted, by following the directions of the specification, without any new invention or addition of their own. That is reasonable and proper; for people in trade ought to be told the manner in which the thing may be done in respect of which the patent is granted. How? Not by themselves becoming inventors of a method of carrying it into effect, but by following the specification, without making a new invention, or making any addition to the specification. If the invention can only be carried into effect by persons setting themselves a problem to solve, then they who solve the



this point. These are persons who possess a thorough scientific knowledge, of a theoretical nature, of the principles of the art or

problem become the inventors of the method of solving it, and he who leaves persons to carry out his invention by means of that application of their understanding, does not teach them in his specification that which, in order to entitle him to maintain his patent, he should teach them, the way of doing the thing, but sets them a problem, which, being suggested to persons of skill, they may be able to solve. That is not the way in which a specification ought to be framed. It ought to be framed so as not to call on a person to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have. You may call upon him to exercise all the actual existing knowledge common to the trade, but you cannot call upon him to exercise any thing more. You have no right to call upon him to tax his ingenuity or invention. Those are the criteria by which you ought to be governed, and you ought to decide this question according to those criteria. You are to apply those criteria to the case now under consideration, and you should apply them without prejudice, either one way or the other, for it is a fair observation to make, that both parties here stand, so far as this objection is concerned, on a footing of perfect equality. The public, on the one hand, have a right to expect and require that the specification shall be fair, honest, open, and sufficient; and, on the other hand, the patentee should not be tripped up by captious objections which do not go to the merits of the specification. Now, applying those criteria to the evidence in the cause, if you shall think that this invention has been so specified that any competent engineer, having the ordinary knowledge which competent engineers possess, could carry it into effect by the application of his skill, and the use of his previous knowledge, without any inventions on his part, and that he could do it in the manner described by the specification, and from the information disclosed in the specification, then the specification would be sufficient. If, on the other hand, you think that engineers of ordinary and competent skill would have to set themselves a problem to solve, and would have to solve that problem before they could do it, then the specification would be bad.

“ Further, if a patentee is acquainted with any particular mode by which his invention may be most conveniently carried into effect, he ought to state it in his specification. That was laid down in a case before Lord Mansfield. There the question arose on a patent for steel trusses. It appeared that the patentee, in some parts of his process, used tallow to facilitate the invention for which he had obtained a patent, and in his specification he made no mention of the use of the tallow. The court held the specification to be bad, because, they said, you ought not to put people to find out that tallow is useful in carrying into effect the invention of steel trusses. You ought to tell the public so, if that is the best mode of doing it, for you are bound to make a *bonâ fide* full and candid disclosure. So again in the case of the malt. That was a patent for drying malt, and one of the objections taken was that the patentee did not state in his specification the degree of heat to which the

science to which the patent relates, but who do not, as an habitual occupation, devote themselves to the application of those princi-

malt should be exposed. The argument there was this. They said, it appeared that the specification was not sufficient, inasmuch as it did not describe the extent of heat to which the malt should be exposed, for it only said, 'the proper degree of heat and time of exposure will be easily learned by experience, the color of the internal part of the prepared grain affording the best criterion.' Surely, there it would have been competent to the patentee to say, any person of ordinary skill, in such a business, would be able to judge what color the malt ought to be, and that, by experiment, he would learn what degree of temperature was exhibited at the time when that proper degree of color was obtained; therefore the plaintiff contended that there was enough stated in the specification to enable the public to carry the invention into effect, and that the patent ought to be supported, because skilful malsters and skilful driers of malt would easily know where to stop, and what degree of heat was requisite for the purpose. There is no doubt that when a man was told that a certain effect might be produced upon the malt by shaking it and subjecting it to a certain degree of heat, his mind would be set on float; he would be at work upon it to ascertain what that degree of heat should be, and he would probably find it out. But that is not enough. The specification of a patent must not merely suggest something that will set the mind of an ingenious man at work, but it must actually and plainly set forth what the invention is, and how it is to be carried into effect, so as to save a party the trouble of making experiments and trials. The court in that case said, that a specification that casts upon the public the expense and labor of experiments and trials, is undoubtedly bad. Here, in this case, the defendants take that line of argument; they say that experiments and trials are necessary. If it be said that all these matters will be well or easily known to a person of competent skill (and to such only the patentee may be allowed to address himself), then the invention will not in reality have given any useful or valuable information to the public.

“ Now, let us apply the principle of this case to the present, and see whether or not the patentee here has given that full information by the specification and drawing, which, being addressed to persons of competent skill and knowledge, would enable them, from that specification and drawing, to carry the invention into effect. On that subject there is, undoubtedly, contradictory evidence, but you see a specification is addressed to all the world, and therefore all the world, at least those possessed of a competent skill, ought to be able to construct the machine by following that specification. It is not fair to you or to me, if we happen to be less inventive than our neighbors, that we should be prevented from constructing these machines by reason of the specification not giving a clear exposition of the way in which it is to be done. In the case of the steam-engine, there was put in on the part of the defendants a model made, as it was said, according to the specification, which model would not work. The model was a copy of the drawing, and would not work, because one part happened to be a little too small, whereas, if it had been a little

ples in the practical exercise of that art, science, or manufacture. Such persons may, without doubt, be examined as to the suffi-

larger, it would have worked. Now a workman of ordinary skill, when told to put two things together so that they should move, would of course, by the ordinary knowledge and skill he possesses, make them of sufficient size to move. There he would have to bring to his assistance his knowledge that the size of the parts is material to the working of the machine. That is within the ordinary knowledge of every workman. He says, 'I see this will not work because it is too small,' and then he makes it a little larger, and finds it will work. What is required is, that the specification should be such as to enable a workman of ordinary skill to make the machine; with respect to that, therefore, I do not apprehend you will feel much difficulty, but with respect to the other there is a good deal more difficulty. I will not sum up the evidence upon the subject of the steam-engine, but I will confine myself to the second invention, and see whether that can be carried into effect by means of the specification and the drawings, for it is to that question that the whole is directed. That invention is in two parts: first, he says, it is an improvement on paddle-wheels for propelling vessels, whereby the float-boards or paddles are made to enter and come out of the water at positions the best adapted, as far as experiments have determined the angle, for giving full effect to the power applied. He says, as far as experiments have determined the angle. That clearly speaks of an invention for enabling a party to use paddle-wheels for propelling vessels, which may be adjusted in such a way as that they may enter and come out of the water in angles the best adapted to give effect to the power of the engine, that is to say, at the angle  $a$ , if that shall be the best position for giving full effect to the power of the engine, or at the angle  $b$ , if that shall, hereafter, by experiment, be determined to be the proper angle. It appears from his statement here, that the proper angle was a matter of considerable doubt at that time; and, therefore, he does not profess to set down an individual angle as the best, which appears to have been one of the ideas of the defendant, as to the effect of the plaintiff's specification. But he says, I will give you a method of enabling the paddle-wheels to enter and come out of the water, with the position the best adapted for giving full effect to the power of the engine. Then, at the end of the specification, after having described the manner in which it is to be done, he says, that his claim is 'for the mode hereinbefore described of giving the required angle to the paddles (that is, any angle which may be required by the person ordering the machinery) by means of the rods  $g, h, i, j$ , and  $k$ , the bent stems marked  $f$ , the disk  $a$ , and the crank  $b$ .' Now, I do not think that means he is to give you a machine, the angle of which may now be  $a$ , and now  $b$ , but that if you wish to have a machine, the paddles of which shall enter at angle  $a$ , which you tell him, and go out at angle  $b$ , which you tell him, he ought to be able to construct a machine which shall answer to your order. That I take to be what the inventor says he has enabled the public to do by means of his specification and plan. He then describes the invention. In Fig. 4, you have the shape of the stem, and a particular angle is mentioned, but it is obvious that that is

ciency of a specification; but the question which should be propounded to them, in cases where there is a recognized class of

not an angle to which the parties are necessarily to be confined. Then he says, '*g, h, i, j, and k* are connecting rods attached at one of their ends by pins or belts, *r*, to the bent stems, *f*, of the float-boards, and the other ends of all these rods, excepting *g*, are attached to the disk, *a*, by pins or bolts, *s*, as shown in Fig. 5.' The only observation is, that he gives no dimensions; he fixes no points either for the centre or the eccentric, or for the crank to which the eccentric centre is attached; therefore, if those can only be ascertained by experiments subsequently to be made, then the specification is bad. The whole, in some degree, turns upon the length of the rods and the position of the centre of the eccentric. The principle upon which these parties proceed, and upon which all the inventions in that respect proceed, is that the wheel, with its spokes, to which the floats are attached, turns round on an axis, and the floats are made to turn by means of an eccentric, and therefore the floats bend as the wheel revolves, and they bend in a particular manner, according as the floats are disposed and according to the position of the centre of the eccentric, by which they are regulated. They are regulated by means of a fixed bar, which is attached to the centre of the eccentric disk. The others are movable boards, which are attached apparently to the circumference of that same disk, and the whole is made to revolve by the fixed bar being attached to a fixed point of the wheel itself, and therefore the revolution of the wheel forcing that fixed point round, turns round the eccentric disk, and with it changes continually the position of all those rods which are affixed to the circumference of that disk, and, according to their being on one or the other side of that disk, they operate on the respective float-boards to which they are attached. All that turns upon the position of the eccentric axis and the length of the respective rods operating through the medium of this centre upon the respective float-boards. Now the question is, whether, in the absence of any statement as to the dimensions of these different parts, and of any directions for finding the centre of the eccentric, you think the specification is sufficient or not, and that must be determined by the evidence which has been given by the witnesses on the one side and on the other.

“ Now, gentlemen, you cannot treat the actual picture which is given in the drawing as any guide to the particular angle or to the particular position of the eccentric; and for this simple reason. If that were the criterion, then the substance of the invention would be the particular angle contained in the particular drawing, and, in order to show an infringement, they ought to have shown that Mr. Seaward's wheel entered the water at the same angle as the angle described by the drawing, and therefore, in that case, you would be bound to find the first issue for the defendant, namely, that there was no infringement. If, however, you treat the picture or the drawing as only an illustration of the invention, and not as confining the invention to the particular angle there described, then you ought to find in the specification some directions which should enable you to construct the machine in a new form, or you ought to be satisfied that, without any instructions, a workman of ordinary and

practical workmen, who would be called upon to apply the directions of the specification, is whether a person of that class, of

competent skill and knowledge would be able to do it. Now, I do not think that Mr. Carpmael gives any evidence to that point; but Mr. Brunel says, 'I have read the specification, and I think I could construct by it a machine at any required angle without difficulty.' You see he says, 'I think I could construct by it a machine at any required angle without difficulty'; but whether Mr. Brunel could do it or not, is not the point. I dare say Mr. Brunel, the inventor of the block machinery, could invent any thing of this sort, the moment it was suggested to him, but that is not the criterion. The question is, whether a man of ordinary knowledge and skill, bringing that ordinary knowledge and skill to bear upon the subject, would be able to do it.

"Then the evidence of Mr. Park is much more material. He says, 'I could, without any difficulty, make the machine so that the paddles could enter the water at any angle.' He prepared the models which have been used. Now, the criterion is, whether, at the time when the specification was introduced to the world, Mr. Park would have been able to construct the machine with his ordinary knowledge and skill, without the peculiar knowledge he has since obtained upon the subject, from being employed to make the models for Mr. Morgan, because it would not be at all fair to allow your verdict to be influenced by knowledge so acquired; but he says, with his ordinary knowledge and skill he could, without difficulty, construct a wheel, so that the paddles should enter the water at any angle. He says, if the diameter of the wheel is given, which it is fair should be given, and the immersion of the float, and that is also fair to be given, he could do it. Those are reasonable data for him to require, and if, with his ordinary skill and knowledge, and without that peculiar knowledge which he has obtained, in consequence of his connection with the plaintiffs, and with this cause, he could do it, that would be evidence on which you would be entitled to place reliance. Then he tells you how he could do it: now, I do think it would have been a vast deal better if the specification had given us the same information, for that is what a specification ought to do.

"The specification ought to contain a full description of the way in which it is to be done. The question really is, whether, upon the whole evidence, you are of opinion that the specification does fairly and fully and properly give to the public that information which the public are entitled to receive, that is to say, whether it tells them, without having recourse to experiments, how to do it, or whether it even tells them what is the course their experiments ought to take, — to what point their examinations and experiments should be directed. He says, he could do it with the skill he possesses; and he has described the manner in which he proposes to do it. He says, 'I have seen this drawing'; then he produces a drawing, and he says, 'This represents my plan of drawing it. An engineer of competent skill would have no difficulty in doing it.' His doing it himself I do not consider so material, but he says an engineer of competent skill would have no difficulty in doing it. That is material.

ordinary skill, could practise the invention from these directions. There does not seem to be any authority, which goes the length

“ Then, when that drawing was shown, some of the gentlemen appearing on behalf of the defendants drew an angle upon it as the angle of entering, and asked him how that could be done. No doubt his principle would enable him to work out any angle, but there are a set of angles which would cause the centre of the eccentric to go beyond the wheel itself, which, therefore, it is impossible to carry into effect, but those angles are such as would not be required in ordinary practice by any persons. You should discard, on both sides, all exaggerated cases, and look to the substance of the thing. If you think, in substance, that the information really communicated would be enough in all ordinary cases, or in such cases as are likely to occur, then that would do; but if it is not a clear statement, and if it does not give such information as will render it unnecessary for parties to make experiments, then the specification would, in that respect, be insufficient. It is most important that patentees should be taught that they are bound to set out fully and fairly what their invention is; for, suppose a person were to make an invention, and get a right of making it for fourteen years, to the exclusion of all other persons, it would be a very great hardship upon the public, if he were to be allowed to state his specification in such a way, that, at the expiration of the term of his patent, he might laugh at the public, and say, I have had the benefit of my patent for fourteen years, but you, the public, shall not now carry my invention into effect, for I have not shown you how it is to be done. I have got my secret, and I will keep it.

“ Mr. George Cottam says, ‘ It is a common problem to find a centre from three given points, and a person of ordinary engineering skill ought to be able to do that.’ The question is, whether it ought not to be suggested to him by the specification, that that is the problem to be solved. Then Mr. Curtis says, ‘ I have made wheels on this plan.’ You see he made the two wheels which were sent to the Venice and Trieste Company, but those were made under the direction of Mr. Galloway, the inventor. Now, it somewhat detracts from the weight due to his testimony, not as to his respectability, but as to the value of his evidence to you, that he had received the verbal instructions of Mr. Galloway. It may be, that he could do it, because of his practice under Mr. Galloway; and it must be recollected that people in other places would not have that advantage. He says, he would not have any difficulty in doing it; and he says, ‘ I should not consider my foreman a competent workman unless he were able to make the wheel from the specification and drawings.’ He says, ‘ I could alter the angle by altering the cranks.’ The question is not, whether he could do that, but whether he could alter the angle to a particular angle by altering the cranks in a particular way, that is, whether, having the angle given to him, he could make the alteration that was desired. Then Mr. Joseph Clement says, he is a mechanic, and did the work of Mr. Babbage’s calculating-machine; that he has seen the model of the steam-engine and paddle-wheels. He speaks of the similarity of the plaintiffs’ and defendants’ wheels, and says, ‘ I could make the machine from the specification and drawing. The float

of saying that a specification, in cases of this kind, would be good, if every competent artisan who might be called were to testify

ought to enter the water at a tangent to the epicycloid.' That is only his opinion as to the most convenient angle. The real motion of the boat is this: The wheel keeps turning round and round on its own axis; during that time the boat has a progressive motion. The wheel, therefore, has a double motion; therefore every point of the wheel does not move in a circle, but in a cycloid, that being the curve described by the rolling of a circle on a flat surface. He says, it should enter at a tangent, that is, that the angle should be such that it will enter the water perpendicularly, in consequence of the motion of the boat, and of the point of the wheel. He says, in like manner, it ought to go up. That is, probably, a very correct view of the case. He says, 'I should have no difficulty in constructing a float to enter at any angle ordinarily required. A man, properly instructed in mechanics, would have no difficulty in doing it.' That is his evidence, which it is material for you to consider; and he is a mechanic himself.

“Then, Henry Mornay, a young gentleman in Mr. Morgan's employment, where he has been apparently studying the construction of engines, speaks of a circumstance which does appear to me to be material. He says, Mr. Morgan, in practice, makes his rods of different lengths. He must necessarily do so, in order that the floats may follow at the same angle as that at which the driving float enters the water. The problem which Mr. Park solved is a problem applying to three floats only; but it appears that the other floats will not follow in the same order, unless some adjustment of the rods is made. Now, suppose it was to be desired that the floats should all enter the water at the given or required angle, if one should go in at one angle, and one at another, the operation of the machine would not be uniform; and the specification means that the party constructing a wheel should be able to make a wheel, the floats of which shall all enter at the same angle, and all go out at the same angle. Now, in order in practice to carry that into effect, if there are more than three floats, something more than Mr. Park's problem would be required; and Mr. Mornay says, actually, that Mr. Morgan, in practice, makes his rods of different lengths, and he must necessarily do that, in order that the floats may follow at the same angle as the driving float enters the water. If so, he should have said in his specification, 'I make my rods of different lengths, in order that the rest of my floats may enter at the same angle; and the way to do that is so and so.' Or, he might have said, 'It may be determined so and so.' But the specification is totally silent on the subject; therefore, a person reading the specification would never dream that the other floats must be governed by rods of unequal length; and least of all could he ascertain what their lengths should be, until he had made experiments. Therefore, it is contended that the specification does not state, as it should have stated, the proper manner of doing it. He says, if they are made of equal lengths, though the governing rod would be vertical at the time of entering, and three would be so when they arrived at the same spot, by reason of the operation Mr. Park suggests, yet the fourth would not come vertical

that he could not apply the directions successfully, provided a scientific witness of the other class were to testify that he could

at the proper point, nor would the fifth, sixth, or seventh. Then they would not accomplish that advantage which professes to be acquired. The patentee ought to state in his specification the precise way of doing it. If it cannot completely be done by following the specification, then a person will not infringe the patent by doing it. If this were an infringement, it would be an infringement to do that perfectly, which, according to the specification, requires something else to be done to make it perfect. If that be correct, you would prevent a man from having a perfect engine. He says, practically speaking, the difference in the length of the rods would not be very material, the difference being small. But the whole question is small, therefore it ought to have been specified; and if it could not be ascertained fully, it should have been so stated. Now, this is the part to which I was referring, when, in the preliminary observations I addressed to you, I cited the case before Lord Mansfield, on the subject of the introduction of tallow, to enable the machine to work more smoothly. There, it was held, that the use of the tallow ought to have been stated in the specification. This small adjustment of these different lengths may have been made for the purpose of making the machine work more smoothly; if so, it is just as much necessary that it should be so stated in the specification, as it was that the tallow should be mentioned. The true criterion is this, — has the specification substantially complied with that which the public has a right to require? Has the patentee communicated to the public the manner of carrying his invention into effect? If he has, and if he has given to the public all the knowledge he had himself, he has done that which he ought to have done, and which the public has a right to require from him.

“ I will now read the defendant’s evidence, and you will see whether, upon the whole, there is evidence before you, on which you think you can come to any reasonable conclusion.

“ Now, first of all, Mr. Donkin, a man of considerable experience, is called; but before I go to his evidence, I will remark, that I have always found that there is a great deal of contradiction in questions of this description; but that is not to be attributed, in the least degree, to corruption, or to any intention to misrepresent or mislead, — people’s opinions vary. They come to state to you not matters of fact, but matters of opinion, and they tell you, conscientiously, what their opinion really is. You may have a great difference of opinion among scientific men on a question relating to science; but though, by their evidence, they contradict one another, they are not influenced by a corrupt desire to misrepresent.

“ Now, Mr. Donkin says, ‘ On first reading the specification, I thought there was a defect in its not explaining the mode of obtaining the required angle. In my judgment, a workman of ordinary skill would not be able to find out any mode of obtaining the required angle.’ He says, a geometrician might discover the mode of adjusting the three angles, the angle of immersion, the vertical angle, and the angle of emersion; but, in order to discover



teach or demonstrate to an artisan how to apply them ;<sup>1</sup> although

the mode by which all the paddles may enter at the same angle, another discovery must be made. He says, it requires to be ascertained, by experiment or diagram, whether the adjustment is to be made by altering the bent stem, or by varying the length of the rods, and you have nothing but the drawing to guide you in that respect. He says, he must first ascertain whether he is to produce the effect by altering the centre, or by altering the bent stem, or varying the lengths of the movable rods. What are those but experiments to ascertain how the thing should be done, all of which he ought to have been saved, by its being stated in the specification how to do it. However, that is his evidence; he says, the angle must depend on the dimensions of the several parts of the wheel. Then he goes on to the other parts of the case, and, on his cross-examination, he says, 'I think a competent workman would be able to do it if he made the previous discovery; but he would not do it unless a careful investigation was gone into.' He says, 'Few ordinary workmen would be able to get the desired angle; I think my foreman would. I think a person moderately acquainted with geometry might do it, but he must find it out; he could sit down and determine it. If he possessed proper information, he ought to be able to do it. An engineer properly skilled in geometry ought to be able to find out how the angle was to be determined. If he sat down and referred to his general knowledge, he would find it out.' Now, the criterion is not, whether he could find it out or not, but whether he could do it by means of the information contained in this specification and drawing, calling in aid his general knowledge, and those mechanical means with which he may reasonably be expected to be familiar; but if he is to sit down and consider how it is to be done, that is not sufficient. You will judge, whether or not the evidence of this witness satisfies you on these points, and whether it makes out the proposition for which the defendants contend.

"Then, Mr. Brunton says, 'I think a workman of competent skill could not construct a machine so as to have the floats enter at any particular

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<sup>1</sup> In *Allen v. Blunt*, 3 Story's R. 747, 748, Mr. Justice Story made use of the following language: "As to the relative weight of the evidence of persons practically engaged in the trade, employment, or business of the particular branch of mechanics to which the patent right applies, and the evidence of persons who, although not practical artisans, are thoroughly conversant with the subject of mechanics as a science. It appears to me that the Patent Acts look to both classes of persons, not only as competent, but as peculiarly appropriate witnesses, but for different purposes. Two important points are necessary to support the claim to an invention: First, that it should be substantially new, as, for example, if it be a piece of mechanism, that it shou'd be substantially new in its structure or mode of operation. Secondly, that the specification should express the mode of constructing, compounding, and using the same in such full, clear, and exact terms, 'as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same.'

proof may be offered of the opinions of scientific witnesses, that

angle and leave at a particular angle.' He says, if the required angle was different from the drawing, it would be an exceedingly difficult thing, and he is not prepared to say how he could do it. Then, Mr. Hawkins says, 'I do not think a workman of ordinary skill could, from the plan and specification, make a wheel that should enter and quit the water at a different angle from that given in the drawing, unless he possessed considerable ingenuity for inventing the method of doing it.'

"Then, Mr. Peter Barlow says, 'There are not, I think, sufficient data to adjust the angle.' He says, if the length of the stems was given, the difficulty would be very great, but it would have been a guide, and it ought to have been explained. That appears to me to be a very good common-sense observation. Then, Mr. John Donkin says, 'I think an ordinary workman would find considerable difficulty in altering a paddle-wheel to suit a particular angle, and I doubt whether he could do it.' On his cross-examination, he says, 'It requires more than a common knowledge of geometry; I think a man moderately acquainted with geometry might do it, but he would have to make experiments, and his first experiments would fail. A skilful engineer would have less difficulty in it, but he ought to be able to find it out.' Then, Mr. Bramah says, 'I think I could discover how to do it.' He has been an engineer many years, and he says, 'I think I could discover it, but I do not know at present how to do it. Yesterday I attended to the evidence, and this morning I tried to find out how it was to be done, but I could not.' Supposing Mr. Bramah had to make a machine of this kind, is he to sit down

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Now, for the latter purpose, a mere artisan skilled in the art with which it is connected, may in many cases be an important and satisfactory witness. If, as a mere artisan, he can, from the description in the specification, so make, construct, compound, and use the same, it would be very cogent evidence of the sufficiency of the specification. Still, it is obvious, that, although a mere artisan, who had no scientific knowledge on the subject, and who was unacquainted with the various mechanical or chemical equivalents employed in such cases, might not be able to make and compound the thing patented, from the specification; yet a person who was skilled in the very science on which it depended, and with the mechanical and chemical powers and equivalents, might be able to teach and demonstrate to an artisan, how it was to be made or constructed, or compounded or used. *A fortiori*, he would be enabled so to do, if he combined practical skill with a thorough knowledge of the scientific principles on which it depended." It is not quite clear, upon this passage, whether the learned judge did or did not mean to intimate, that a specification would be good, if a scientific witness could teach an artisan how to make, compound, or use the thing patented, although the artisan could not practise the invention without such aid. The sense in which he seems to oppose the word "artisan" to that class of persons who are not practical artisans, but who are "thoroughly conversant with the subject of mechanics as a science," or are "skilled in the very science on which the

a particular means which might be used to carry out the general

and invent a mode of doing it, or ought he not to have such information afforded as would enable him to do it at once by means of the specification? Then, Mr. Francis Bramah says, 'I have examined the specification: I could not make a machine from the specification, the floats of which should enter and leave the water at any required angle. Till I came into court yesterday, I presumed that the angle given in the drawing was the best angle, that is, that the specification had not only stated how to do it, but had described the best angle.' If so, it would be a specification only for that particular angle. He says, 'I can go as far as I was told yesterday, but no farther.'

"Now, gentlemen, I have gone through the evidence on both sides on this point, and the question, upon this part of the case, revolves itself into this: Do the witnesses on the plaintiff's side satisfy you that the patentee has, in his specification, given to the public the means of making a machine which shall enter and leave the water at any angle that may be ordered: that is, if a man ordered a machine at an angle likely to be required for entering and going out, and to be vertical at the bottom, could an ordinary workman, with competent skill, execute that order by following the directions given in this specification? If you think he could, then the specification would be sufficient. If, on the other hand, you think he would not be able to execute the order, unless he sat down and taxed his invention to find out a method of doing that which has not been sufficiently described in the specification, then the specification would be bad. If you think the specification good, then you ought to find for the plaintiffs upon that issue; if you think the specification bad, then you ought to find for the defendants."

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invention depends," would seem to imply that an obscurity or other defect in a specification, which would embarrass an artisan, may be cured by a scientific person, whose superior knowledge of the principles of the science might be used to teach the workman from the specification; if so, this is not the standard which the same learned judge adopted on other occasions. In *Lowell v. Lewis*, 1 Mas. 190, he instructed the jury, that the question was, whether the specification was so clear and full, that a *pump-maker of ordinary skill* could, from the terms of the specification, construct a pump on the plan described. Perhaps, however, in the more recent case, he intended only to draw a distinction between mere mechanics or laborers in a particular art, manufacture, or trade, and persons conversant with the science on which it depends; and to say that the latter are competent, and often the most satisfactory witnesses, which is certainly obvious. It is scarcely to be presumed that he meant to say, that where the description in a patent is of a thing which a particular class of mechanics would be employed to make, the specification would be sufficient, although it could not be carried out by a workman of that class having ordinary skill, provided it could be understood by a "person thoroughly conversant with the subject of mechanics as a science." This, as a general proposition, would confine the practice of many inventions, after the patent had expired, to the latter class of persons, which the patent law does not intend.

directions of a specification, would succeed, without showing that that means had actually been tried and had succeeded.<sup>1</sup>

§ 482. Whether there is a class of inventions addressed so entirely to scientific witnesses, as to render their knowledge and skill requisite, in the practical application of the directions, so that there cannot be said to be any recognized class of artisans, to whose capacity the directions can be referred, is another question. This must depend on the nature of the invention.

§ 483. Before it can be determined, in any case, what class of persons are to be taken as those, whose ability to apply the directions furnishes the standard of the sufficiency of the specification, it must first be ascertained to what class of persons the specification is presumed to be addressed, as being those who are to carry out the directions. If the inquiry arose after the patent had expired, this class of persons would, in most cases, be readily ascertained by observing what persons applied themselves to the practice of the invention. But it actually arises before the patent has expired, and before its dedication to the public enables us to see what persons will undertake to practise the invention. That state of things must, therefore, be anticipated, so far as to ascertain what persons will undertake practically to carry out the directions of the patent, for the purpose for which the invention is designed. The standard, therefore, will vary greatly, according to the nature of the invention. In some cases the persons who will undertake to practise it will be very numerous, in others very limited, in point of numbers. In some cases the qualifications will be very moderate, in others, a very high state of accomplishment, skill, and knowledge will be requisite. The nature and objects of the invention must be resorted to, to see to what persons the specification is to be presumed to be addressed. If it be a machine destined to a particular use, the workmen whose vocation it is to make similar machines for similar purposes, will be the persons who would be called upon to make the machine after the patent has expired. If it be a composition of matter, involving the knowledge of practical chemists, such persons will attempt to practise the invention, when they are at liberty to do so. If it be a manufacture of an improved character, the persons whose business it has been to make the

<sup>1</sup> Neilson v. Harford, Webs. Pat. Cas. 295, 315, 316.

old article, will be the persons who will make the new one. In all these and similar cases, where there is a class of workmen who are habituated to the practical exercise of the art or science under which the patented invention falls, the specification is to be presumed to be addressed to them; and, although scientific witnesses may be examined as to the clearness and fulness of the specification, its sufficiency must be referred to the ability of competent practical workmen, of ordinary skill, to understand and apply it. This limitation of the evidence follows, necessarily, from the principle that the specification cannot be supported by the fresh invention and correction of a scientific person. The ordinary knowledge and skill of practical workmen being the standard, where the specification is for the benefit of a particular trade, the evidence cannot be carried so far as to include the degree of skill and knowledge possessed by a scientific person, who could, on a mere hint, invent the thing proposed to be accomplished; although such a witness may be asked whether a competent workman could attain the object of the patent by following out the directions.<sup>1</sup>

§ 484. But if the invention be of a character entirely novel, embodying an effect never before produced, and which it is not within the province of any particular class of workmen to produce, but which it belongs rather to the province of men possessed of some science to apply, by directing the labors of common artisans, upon principles which such artisans do not commonly understand or undertake to use, then the specification may be presumed to be addressed to men capable of applying those principles, and not to mere artisans, who have previously been employed in the construction of things of the same class which it is the object of the invention to supersede. Thus, in the case of an invention, which consisted in an improvement on paddle-wheels for propelling vessels, by a mode of constructing them, so that the floats might enter and quit the water at any required angle, the specification would be addressed to engineers capable of determining what angle was required, and it ought to furnish the rules by which such persons could ascertain the angle, and the mechanical means by which it could be applied in practice.<sup>2</sup>

<sup>1</sup> *Morgan v. Seaward*, Webs. Pat. Cas. 174; *Neilson v. Harford*, *ibid.* 371; *The Househill Co. v. Neilson*, *ibid.* 692.

<sup>2</sup> *Morgan v. Seaward*, Webs. Pat. Cas. 170.

The understanding of such a specification would be somewhat above the range of acquirements belonging to mechanics employed in the manual labor of constructing the machinery, that is to say, the specification would be addressed to competent engineers, of ordinary skill in that profession.<sup>1</sup>

§ 485. But it should be remembered that whenever, in a case of this kind, as in all other cases, the persons to whom the specification is to be presumed to be addressed have been ascertained, a rule becomes applicable, which defines the nature and scope of the evidence that may be offered, to explain the specification. This rule is, that the patentee must not, in framing his specification, call upon the persons to whom it is addressed to exercise more than the actual existing knowledge common to their trade or profession. He has a right to exhaust this knowledge; but if, in order to apply his directions, the members of the trade or profession are required to tax their ingenuity or invention, so that, beyond the exercise of ordinary and competent skill, they would have to solve a problem or supply something in the process, by the exercise of the inventive faculty, the specification would be bad.<sup>2</sup>

§ 486. II. *As to the Infringement.* — Upon the question of infringement, the point to be determined is, whether the thing made or used by the defendant is, in the sense of the patent law, identical with the invention of the patentee.<sup>3</sup> This is the same question as that which arises on the issues of novelty, when it is necessary to determine whether the invention of the patentee is the same as some former thing, or different, and therefore entitled to be regarded as a novelty. We may, therefore, here consider the principles of evidence applicable to the inquiry, whether two things are identical in the sense of the patent law.

§ 487. It is obvious that there may be two kinds of evidence applicable to this issue, both of which may be drawn from experts. Whether one thing is like another, is a matter of judg-

<sup>1</sup> *Morgan v. Seaward*, Webs. Pat. Cas. 170.

<sup>2</sup> *Ibid.* It should also be remembered that the court, in construing the *claim*, is not bound to receive the testimony of experts. *Winans v. N. Y. & Erie R.R.*, 21 How. 88.

<sup>3</sup> In equity suits, if the defendant means to contest the alleged infringement at the hearing, he should take proofs of non-infringement. *Bennet v. Fowler*, 8 Wallace, 445.

ment, to be determined on the evidence of our own senses, or the senses of others. If we rely on the senses of others, the sole testimony which they can bear is, either as to the matters of fact which constitute the precise differences or resemblances between the two things, or as to matter of opinion, by which they infer that these differences or resemblances do or do not affect the question of the substantial identity of the two things. Both of these kinds of evidence, however, run so nearly into each other, and the boundaries between them are often so shadowy, that it is sometimes difficult to draw the line between fact and opinion. The actual differences or resemblances between two things are *prima facie* matters of fact, to be observed by the senses; but, with the act of observing these differences or resemblances, we blend the process of reasoning, by which we determine, for our own satisfaction, what is a real, and what only an apparent difference or resemblance; what constitutes a difference or resemblance, in point of principle; and the result of this process, expressed in the conclusion, that the two things are, or are not identical, is matter of opinion. Between these two branches of evidence it is exceedingly difficult to draw the line so as to define the true office of an expert, and to admit all proper evidence of facts and opinions, without leaving to the witness the whole determination of the issue.<sup>1</sup>

§ 488. At the same time it is certain that a boundary exists somewhere. The question whether two things are identical, in the sense of the patent law, is a mixed question of law and fact; and when it is submitted to a jury, it is for the court to instruct them, after the actual differences or resemblances are ascertained, what constitutes, in point of law, a difference or identity.<sup>2</sup> There is, therefore, a most important function to be discharged, if one

<sup>1</sup> In *Dixon v. Moyer*, 4 Wash. 68, 71, Mr. Justice Washington said: "In actions of this kind, persons acquainted with the particular art to which the controversy relates are usually examined for the purpose of pointing out and explaining to the jury the points of resemblance, or of difference, between the thing patented and that which is the alleged cause of the controversy; and the opinions of such witnesses, in relation to the materiality of apparent differences, are always entitled to great respect. But, after all, the jury must judge for themselves, as well upon the information so given to them, as upon their own view, where the articles, or models of them, are brought into court."

<sup>2</sup> *Barrett v. Hall*, 1 Mas. 447, 470.

may so say, by the law itself; for it has to determine, upon all the facts open to the observation of the senses, whether guided by the superior facility for observation enjoyed by experts, or not so assisted, whether, in the sense of the law, there is an identity or a difference. This function is always in danger of being encroached upon by a loose mode of receiving the testimony of experts, by whom the whole question is often in reality left to be decided.<sup>1</sup>

§ 489. The testimony of persons skilled in the particular subject is undoubtedly admissible for two purposes: *first*, to point out and explain the points of actual resemblance or difference; *secondly*, to state, as matter of opinion, whether these resemblances or differences are material; whether they are important or unimportant; whether the changes introduced are merely the substitution of one mechanical or chemical equivalent for another, or whether they constitute a real change of structure or composition, affecting the substance of the invention. But when these facts and opinions have been ascertained, the judgment of the jury is to be exercised upon the whole of the evidence, under the instructions of the court as to what constitutes such a change as will in point of law amount to a fresh invention and therefore will not be an infringement.<sup>2</sup>

§ 490. The duty of giving this instruction should not be surrendered by the court. A scientific witness may be asked, for instance, whether in his opinion a particular machine is substantially new in its structure or mode of operation, or whether it is substantially the same thing as another, with only apparent differences of form and structure. But when the differences or

<sup>1</sup> Thus in *U. S. Annunciato Co. v. Sanderson*, 3 Blatchf. 184, it was held that where two machines were to all appearance the same, the positive testimony of an expert that they were in principle different, was not to be followed, unless such expert should show satisfactorily wherein the difference consisted.

<sup>2</sup> In *Allen v. Blunt*, 3 Story's R. 742, 748, 749, Mr. Justice Story, discussing the relative value of scientific witnesses and mere artisans, said: "The very highest witnesses to ascertain and verify the novelty of an invention, and the novelty or diversity of mechanical apparatus and contrivances and equivalents, are beyond all question, all other circumstances being equal, scientific mechanics; they are far the most important and useful to guide the judgment and to enable the jury to draw a safe conclusion whether the modes of operation are new or old, identical or diverse."



resemblances have been pointed out, and when the view that science takes of their relative importance has been ascertained; when the fact appears of whether a particular change is or is not regarded by mechanics as the substitution of one mechanical equivalent for another, the court must instruct the jury whether the particular change amounts, in point of law, to a change of what is commonly called the principle of the machine. This is a question wholly aside from the function of a witness. The most skilful and scientific mechanic in the world can only say what, in his opinion, are the differences or resemblances between one machine and another, and how far they are regarded by mechanics as material or substantial. But the question of what constitutes a fresh invention, or what, upon a given state of facts, amounts to a change so great as to support an independent patent for a new thing, is a question of law; and this question is involved in every issue as to the identity of two things, whether it relates to the question of infringement or of prior invention.<sup>1</sup>

§ 491. The evidence for the defendant, upon the question of novelty, will of course consist of proof, positive in its nature, that the thing patented existed before; and if any credible evidence of this is adduced, it will outweigh all the negative evidence that can be offered by the plaintiff.<sup>2</sup> Thus, in *Parker v. Ferguson*,<sup>3</sup> where a witness testified to his having assisted in the construction of a single water-wheel exactly similar to that of the plaintiff, for a person who removed it to a place some twelve miles off, so that witness never again saw it, the court instructed the jury, that, if they were satisfied of the credibility of the witness, they must consider the proof of want of novelty as established. But testimony by a witness that he had seen an article which might have been made by a machine similar to that of the plaintiff, is not sufficient to defeat the latter's title.<sup>4</sup> But whenever the defendant relies on the fact of a previous invention, knowledge, or use of the thing patented, he must give notice of the names and

<sup>1</sup> See the instructions of the court in *Walton v. Potter*, Webs. Pat. Cas. 585, 586, 587, 589, 591; *Huddart v. Grimshaw*, *ibid.* 85, 86, 91, 92, 95. See also the examination of certain experts in *Russell v. Cowley*, *ibid.* 462, before Lord Lyndhurst, in the exchequer, cited *ante*.

<sup>2</sup> *Manton v. Manton*, Dav. Pat. Cas. 250.

<sup>3</sup> 1 Blatchf. 407.

<sup>4</sup> *Treadwell v. Bladen*, 4 Wash. 703.

places of residence of the persons whom he intends to prove as having possessed a prior knowledge or had a prior use of it.<sup>1</sup>

§ 491 *a*. In an action for infringement, evidence going to show the superiority of defendant's machine to that of the patentee is improper, except to prove a substantial difference between the two.<sup>2</sup> In one case where the defendant and the plaintiff had executed a bond, in which the former acknowledged the validity of the latter's patent and recited a previous infringement, it was held that this, together with other evidence, might be received as tending to show a subsequent breach, but did not of itself raise any implication.<sup>3</sup>

In a recent English case, where the patentee had a patent for a process of treating chemically sewage matter with the view of thereby obtaining a valuable manure, a similar process used by the Board of Health simply for the purpose of disinfection, so that this product was rejected as a by-product, was to be regarded as no evidence of infringement.<sup>4</sup>

§ 492. Persons who have used the machine patented are not thereby rendered incompetent as witnesses, on account of interest.<sup>5</sup> It has been held that a witness who was patentee in another patent, and had sold to the defendant the right to use the machine, the use of which was complained of as an infringement, was a competent witness, since any verdict that the plaintiff might recover could not be given in evidence by the plaintiff in an action against the witness.<sup>6</sup> A patentee who has assigned the whole of his interest in the patent is a competent witness for the assignee in support of it.<sup>7</sup> It is not, however, admissible to

<sup>1</sup> See *ante*, chapter on Action at Law. The notice need not, however, specify the places in which such user was made. Where the defence is prior publication in some printed work, the notice must specify the particular part of the work referred to, if the same be one of a general character, e. g. a scientific dictionary. *Foote v. Silsby*, 1 Blatchf. 445. Compare *Vance v. Campbell*, 1 Black. 427.

<sup>2</sup> *Alden v. Dewey*, 1 Story, 336.

<sup>3</sup> *Byam v. Eddy*, 2 Blatchf. 521.

<sup>4</sup> *Higgs v. Goodwin*, 1 Ell. Bl. & Ell. 529. See also chapter on Infringement.

<sup>5</sup> *Evans v. Eaton*, 7 Wheat. 356; *Evans v. Hettich*, *ibid.* 453; 2 Greenl. on Evid. § 508. It is no objection to the competency of a witness, that he is sued in another action for infringement of the same patent. *Ibid.*

<sup>6</sup> *Treadwell v. Bladen*, 4 Wash. 704.

<sup>7</sup> *Bloxam v. Elsee*, 1 Carr. & Payne, 563.

offer evidence going to show that the patentee, after assigning his entire interest, had declared the patent abandoned and worthless.<sup>1</sup> The assignee of the exclusive right for a certain county or district is to be received as witness in an action for infringement in another district in which he has no direct interest.<sup>2</sup> Where evidence of prior user by some third party is attempted to be shown, the declaration of such party as to his motives for such user are inadmissible as mere hearsay.<sup>3</sup> A licensee is a competent witness for the patent, in an action for an infringement, for he has no direct pecuniary interest in supporting the patent, but it may be for his advantage that it should not be supported.<sup>4</sup> Evidence, on the part of the plaintiff, that the persons, of whose prior use of a patented machine the defendant had given evidence, had paid the plaintiff for licenses, ought not to be absolutely rejected, though entitled to very little weight.<sup>5</sup>

§ 492 a. In several recent cases, the Supreme Court, in construing the Judiciary Act of 1789, § 34, has decided that where, under the laws of any State, parties may be examined in their own behalf, the plaintiff, in an action for infringement brought in a district embracing such a State, is a competent witness.<sup>6</sup>

§ 493. Where the defence is set up that the patentee being an alien has not complied with § 13 of the act of 1836, which requires that such patentee must put and continue on sale to the public, on reasonable terms, the invention for which the patent was granted, the burden of proof rests on the defendant.<sup>7</sup>

§ 493 a. Fraud in obtaining an extension of a patent can only be tried in a direct proceeding to impeach the patent, and not in a collateral proceeding, as in a suit in equity to recover for infringements.<sup>8</sup>

<sup>1</sup> *Wilson v. Simpson*, 9 How. 109; *Many v. Jagger*, 1 Blatchf. 372.

<sup>2</sup> *Buck v. Hermance*, 1 Blatchf. 322.

<sup>3</sup> *Hyde v. Palmer*, 7 Law Times, N. S. 823.

<sup>4</sup> *Derosne v. Fairie*, Webs. Pat. Cas. 154.

<sup>5</sup> *Evans v. Eaton*, 3 Wheat. 454.

<sup>6</sup> *Vance v. Campbell*, 1 Black. 427; *Haussknecht v. Claypool*, *ibid.* 431.

<sup>7</sup> *Tatham v. Lowber*, 2 Blatchf. 49.

<sup>8</sup> *Rubber Company v. Goodyear*, 9 Wallace, 788.

## CHAPTER XIII.

## JURISDICTION.

§ 494. THE Constitution of the United States confers upon Congress power “to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.” This power is general; there is no distinction which limits it to cases where the invention has not been known or used by the public. Accordingly it is well settled that Congress may pass general or special laws in favor of inventors; and they may leave a particular inventor to the protection afforded by a general law, or they may pass a special law in his behalf, or they may exempt his case from the operation of a general law by extending his exclusive right beyond the term fixed by such general law.<sup>1</sup> They may even grant to an inventor the exclusive right to his invention after the same has gone into public use. The grant does not imply an irrevocable contract with the public that, at the expiration of the period, the invention shall become public property. Where, however, Congress does, by special law, grant to an inventor the monopoly of his invention after the same has gone into public use, such enactment will not, without unmistakable language to that effect, be construed to work retrospectively, by rendering the use of a machine embraced under the patent unlawful for the time previous to the enactment.<sup>2</sup>

<sup>1</sup> *Evans v. Eaton*, 3 Wheat. 454; s. c. Pet. C. C. 332; *Evans v. Hettich*, 7 Wheat. 453; *Blanchard v. Sprague*, 2 Story’s Rep. 164; s. c. 3 Sumn. 535; *Woodworth v. Hall*, 1 Woodb. & Min. 248.

<sup>2</sup> *Blanchard v. Sprague*, *supra*. Letters-patent were granted to the plaintiff, Thomas Blanchard, on the 3th of September, 1819; and being deemed inoperative, by reason of defects in the specification, new letters-patent were granted on the 20th of January, 1820, for the space of fourteen years. Afterward, by act of Congress, passed the 30th of June, 1834, the sole right was granted to the plaintiff to make, use, and vend his invention for the term of fourteen years, from the 12th of January, 1834. This act not being thought

§ 495. In accordance with the general powers thus constitutionally conferred, Congress has regulated the matter of the to describe with sufficient accuracy the letters-patent, to which it was intended to refer, an additional act was passed on the 6th of February, 1839, renewing the act of the 30th of June, 1834, and correcting the date of the 12th of January, 1834, to the 20th of January, 1834. This last act was as follows: “*An act to amend and carry into effect the intention of an act entitled An Act to renew the patent of Thomas Blanchard, approved June 30th, 1834.* Sec. 1. Be it enacted, &c., That the rights secured to Thomas Blanchard, a citizen of the United States, by letters-patent granted on the sixth of September, eighteen hundred and nineteen, and afterwards on a corrected specification on the 20th day of January, Anno Domini eighteen hundred and twenty, be granted to the said Blanchard, his heirs and assigns, for the further term of fourteen years from the 20th of January, eighteen hundred and thirty-four, said invention so secured being described in said last-mentioned letters as an engine for turning or cutting irregular forms out of wood, iron, brass, or other material which can be cut by ordinary tools. Provided, that all rights and privileges heretofore sold or granted by said patentee to make, construct, use, or vend the said invention, and not forfeited by the purchasers or grantees, shall enure to and be enjoyed by such purchasers or grantees respectively, as fully and upon the same conditions during the period hereby granted as for the term that did exist when such sale or grant was made. Sec. 2. And be it further enacted, that any person who had *bonâ fide* erected or constructed any manufacture or machine for the purpose of putting said invention into use, in any of its modifications, or was so erecting or constructing any manufacture or machine for the purpose aforesaid, between the period of the expiration of the patent heretofore granted on the thirtieth day of June, one thousand eight hundred and thirty-four, shall have and enjoy the right of using said invention in any such manufacture or machine erected or erecting as aforesaid, in all respects as though this act had not passed. Provided, that no person shall be entitled to the right and privilege by this section granted, who has infringed the patent right and privilege heretofore granted, by actually using or vending said machine before the expiration of said patent, without grant or license from said patentee or his assignees, to use or vend the same.”

Upon this act, Mr. Justice Story said: “Then it is suggested, that the grant of the patent by the act of Congress of 1839, c. 14, is not constitutional; for it operates retrospectively to give a patent for an invention, which, though made by the patentee, was in public use and enjoyed by the community at the time of the passage of the act. But this objection is fairly put at rest by the decision of the Supreme Court in the case of the patent of Oliver Evans. *Evans v. Eaton*, 3 Wheat. 454. For myself I never have entertained any doubt of the constitutional authority of Congress to make such a grant. The power is general to grant to inventors; and it rests in the sound discretion of Congress to say, when and for what length of time and under what circumstances the patent for an invention shall be granted. There is no restriction which limits the power of Congress to cases where the invention has not been known or used by the public. All that is required is, that the patentee should be the

jurisdiction in patent cases by two enactments. The act of July 4, 1836, c. 357, § 17, declares:—

“That all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as in law, by the circuit courts of the United States, or any district court having the powers and jurisdiction of a circuit court, which courts shall have power, upon bill in equity filed by any party aggrieved, in any such case, 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 said courts may deem reasonable. *Provided*, however, that from all judgments and decrees from any such court, rendered in the premises, a writ of error or appeal, as the case may be, shall lie to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of circuit courts, and in all other cases in which the court shall deem it reasonable to allow the same.”<sup>1</sup>

inventor. The only remaining objection is, that the act is unconstitutional, because it makes the use of a machine constructed and used before the time of the passage of the act of 1834, c. 213, and the grant of the patent under the act of 1839, c. 14, unlawful, although it has been formerly decided that, under the act of 1834, the plaintiff had no valid patent; and so the defendant, if he constructed and used the machine during that period, did lawful acts, and cannot now be retrospectively made a wrong-doer. If this were the true result of the language of the act, it might require a good deal of consideration. But I do not understand that the act gives the patentee any damages for the construction or use of the machine, except after the grant of patent under the act of 1839, c. 14. If the language of the act were ambiguous, the court would give it this construction, so that it might not be deemed to create rights retrospectively, or to make men liable for damages for acts lawful at the time when they were done. The act of Congress passed in general terms ought to be so construed, if it may, as to be deemed a just exercise of constitutional authority; and not only so, but it ought to be construed, not to operate retrospectively or *ex post facto*, unless that construction is unavoidable; for even, if a retrospective act is or may be constitutional, I think I may say that, according to the theory of our jurisprudence, such an interpretation is never adopted without absolute necessity; and courts of justice always lean to a more benign construction. But in the present case there is no claim for any damages but such as have accrued to the patentee from a use of his machine since the grant of the patent under the act of 1839, c. 14.”

<sup>1</sup> See also act of February 15, 1819, c. 19.

The right of appeal, as thus conferred, has been recently modified by the act of 1861, c. 37, § 1, which provides:—

“That from all judgments and decrees of any circuit court rendered in any action, suit, controversy, or case at law or in equity, arising under any law of the United States, granting or confirming to authors the exclusive right to their inventions or discoveries, a writ of error or appeal, as the case may be, shall lie at the instance of either party, to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy in the action.”

§ 496. The judicial interpretation of these enactments has been to the effect, that the jurisdiction thereby conferred upon the circuit and district courts in the first instance, and to the Supreme Court on appeal, is not merely an original one, but also an exclusive one, so that the State courts have no cognizance whatever of actions in which the validity or force of letters-patent is involved.<sup>1</sup>

But where the controversy at issue does not turn upon the letters-patent themselves, but rather upon the force of some contract under them, e. g. an assignment or license, which acknowledges their validity, in such cases the jurisdiction appertains, as in other contracts, to the State courts, and can only be brought into the United States courts on some other ground, e. g. that of citizenship or residence, which would justify the application. Thus, in a recent case,<sup>2</sup> a bill for injunction was brought upon a special agreement entered into between the plaintiff and the defendant, adjusting several suits pending between them concerning patent rights claimed by the plaintiff. It charged a breach of the agreement and prayed for an account. Nelson, J., in dismissing the bill, said: “It was attempted to sustain the jurisdiction on the ground that the suit is brought under the Patent Act, where jurisdiction depends on the subject-matter, and that the *gravamen* laid was the infringement of patent rights. But there is no foundation for this position. The bill is not constructed for the purpose of presenting a question of the

<sup>1</sup> *Dudley v. Mayhew*, 3 Comst. 14; *Elmer v. Pennel*, 40 Maine, 434; *Parsons v. Barnard*, 7 Johns. 144.

<sup>2</sup> *Goodyear v. Day*, 1 Blatchf. 565.

infringement of a patent, but is brought for the violation of a contract.”

Hence a bill brought to enforce the specific performance of a contract to convey a patent is not cognizable in the United States courts; but, *semble*, that an objection, on that account, should be taken before the pleadings are closed and the evidence published.<sup>1</sup> Nor a suit brought to enforce the covenants of a licensee.<sup>2</sup>

While, however, it is true that a contract under a patent, e. g. a license, is not *per se* cognizable in the United States courts, so as to permit a suit to be brought there for the recovery of the sums agreed upon, still a licensee, whose right is conditioned upon the weekly payment of a certain sum, and who neglects to pay the same, but continues to use the invention, is virtually guilty of an infringement of the patent, and may, like any other infringer, be enjoined by a United States court. This point was decided in the case of *Brooks v. Stolley*,<sup>3</sup> where the Court said:—

“It is suggested, that, as the whole controversy in the case arises under the contract of license, the parties to which being citizens of this State, the Federal court cannot take jurisdiction. This objection would be unanswerable if no right were involved in the controversy except what arises out of the contract; as, for instance, the Circuit Court could take no jurisdiction, under the contract, of an action merely to recover the sums agreed to be paid by the defendant; but, in the present aspect of the case, it is not limited to the contract. The complainants set up their right under the patent, and allege that the defendant is infringing that patent; that the license affords no justification to the defendant. The right then of the complainants to an injunction is not founded by them on the contract, but on the assignment of the patent.

“Now the terms of the contract make the performance of its stipulations by the defendant a condition to his continued use of the machine; and if the words of the contract did not import and indeed clearly sustain this view, equitable considerations, arising from the nature of the contract, would require such a

<sup>1</sup> *Nesmith v. Calvert*, 1 Woodb. & Min. 34.

<sup>2</sup> *Goodyear v. Union Rubber Co.*, MS., Ingersoll, J.

<sup>3</sup> 3 McLean, 523.



construction of it. The payment is to be made weekly. Could any reasonable construction of the contract give the right to run the machine by the defendant, in default of such payment? The frequent settlement and payment show that longer indulgence was not intended by the parties, and that a remedy at law would be no adequate relief to the complainants. To enforce the payment by legal means would require a weekly suit; and this would subject the complainants to inconvenience, delay, and expense, which would be nearly, if not quite, equal to the amount recovered. Such a construction of the contract would be as inequitable as the remedy proposed would be inadequate. The complainants invoke the aid of equity, not to decree a specific execution 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 payment, he has no pretence of right to run the machine.”

§ 497. With regard to the question, in what district an action for the infringement of patent rights may or must be brought, it has been held in the case of *Chaffee v. Hayward*,<sup>1</sup> that such action can only be brought in the district in which the defendant resides or in which he is personally served with the summons, and that the commencement of an action by attaching the property of a non-resident defendant was not sufficient to confer jurisdiction. It was urged *arguendo* that the Circuit Court, having jurisdiction of the *subject-matter*, was by the Process Act of 1792, § 2, at liberty to issue its process in the same form as a process from the Supreme Court of any State comprised in that district, and that if the service by attachment was good by the laws of that State, as they stood at the time of the passage of the Process Act, then it was good under the laws of the United States. But the Supreme Court did not accept these conclusions. Catron, J., in rendering the opinion of the court, said: “By § 11 of the Judiciary Act of 1789, it is provided, ‘That no civil suit in a circuit or district court shall be brought against an inhabitant of the United States by any original process in any other district than that whereof he is an inhabitant or in which he shall be found at the time of serving the writ.’ It has been several times

<sup>1</sup> 20 How. 208.

held by this court as the true construction of the foregoing section, that jurisdiction of the person of a defendant (who is an inhabitant of another State) can only be obtained in a civil action, by service of process on his person within the district where the suit is instituted; and that no jurisdiction can be acquired by attaching property of a non-resident defendant, pursuant to a State attachment law.<sup>1</sup> It is insisted, however, that these rulings were had in cases arising where the jurisdiction depended on citizenship; whereas here the suit is founded on an act of Congress conferring jurisdiction on the Circuit Courts of the United States in suits by inventors against those who infringe their patents, including all cases both at law and in equity, arising under the patent laws, without regard to the citizenship of the parties or the amount in controversy, and that therefore the eleventh section of the Judiciary Act does not apply, but the process acts of the State where the suit is brought must govern, and that the act of Congress, May 8, 1792, so declares. . . . That act (§ 2) declares that until further provision shall be made, and except where by this act 'or *other statutes of the United States is otherwise provided,*' the forms of writs and executions and modes of processes in suits at common law shall be the same in each State respectively as are now used or allowed in the Supreme Court of the same. This was to be the mode of process, unless provision had been made by Congress; and to the extent that Congress had provided, the State laws should not operate. Now the only statute of the United States then existing regulating practice was the Judiciary Act of 1789, which is above recited. The eleventh section is excepted out of and stands unaffected by the subsequent process acts, and is as applicable in this case as it was to those where jurisdiction depended on citizenship. It applies in its terms to *all* civil suits; it makes no exceptions, nor can the courts of justice make any. The judicial power extends to all cases in law and equity arising under the Constitution and laws of the United States; and it is pursuant to this clause of the Constitution that the United States courts are vested with power to execute the laws respecting inventors and patented inventions; but where the suits are to be brought is left to the general law, to wit, to the eleventh section of the Judiciary Act, which requires personal

<sup>1</sup> Toland v. Sprague, 12 Pet. 327; also 15 Pet. 171; 17 How. 424.

service of process within the district where the suit is brought, if the defendant be an inhabitant of another State.”

This decision affirms the rulings in *Saddler v. Hudson*,<sup>1</sup> and *Allen v. Blunt*;<sup>2</sup> and is followed in *Goodyear v. Chaffee*.<sup>3</sup>

The case of *Day v. Newark Rubber Co.*<sup>4</sup> goes still further. Here the defendant was a corporation chartered under the laws of New Jersey, but having an agency and store in New York. The suit was commenced by attaching the goods in the store, and also by serving a summons on its president in New York. The motion to quash the writ of foreign attachment and summons was allowed, on the ground that the corporation was not an inhabitant of the New York district, nor found within it at the time of serving the process, — a corporation having no corporate existence out of the State under whose laws it is created. The court said: “Without pursuing the examination of the case further, we are satisfied, for the reasons stated, that neither the levying of the writ of attachment upon the goods of the defendants in this district, nor the service of the summons upon their president within it, nor both together, have the effect to give jurisdiction to the court in this case against the defendants; and further, that, according to the true construction of the eleventh section of the Judiciary Act of 1789, the court would have no jurisdiction in suits instituted against foreign corporations, even in cases where the State practice, if adopted by it, would authorize the institution of such suits by the attachment of their goods found within their jurisdiction.”

§ 498. Where, however, the court has jurisdiction of the person of the defendant, it may restrain him from violating the patent in a district other than the one in which the suit is brought. Still, where it may be necessary to proceed directly against the machine itself, as in cases of extreme contumacy or of fraudulent contrivance to evade an injunction, *semble*, proceedings must be instituted in the district in which the machine is located.<sup>5</sup>

The equity jurisdiction conferred upon the circuit courts by the

<sup>1</sup> *Saddler v. Hudson*, 2 Curtis, C. C. 6.

<sup>2</sup> *Allen v. Blunt*, 1 Blatchf. 480.

<sup>3</sup> *Goodyear v. Chaffee*, 3 Blatchf. 268.

<sup>4</sup> 1 Blatchf. 628.

<sup>5</sup> *Boyd v. McAlpin*, 3 McLean, 427; *Wilson v. Sherman*, 1 Blatchf. 536, citing *Simpson v. Wilson*, 4 How. 709, and *Wilson v. Simpson*, 9 How. 109.

act of 1836, § 17, is irrespective of the right of the plaintiff to an injunction or his demand for one. Consequently the patentee is entitled to a discovery and account after the expiration of the term for which the patent is granted.<sup>1</sup>

§ 499. With regard to the appellate jurisdiction of the Supreme Court, it may be stated that it does not extend by virtue of the act of 1836, § 17, to cases where the matter in controversy is, not the settlement of the claims and rights of a patentee, but the mere amount of costs. Such a question is left for decision under the provisions of the Judiciary Act of 1789, and consequently the amount in issue must exceed \$2,000.<sup>2</sup> This limitation would still seem applicable under the provisions of the act of 1861, c. 37, whereby an appeal lies to the Supreme Court irrespective of the value or amount in controversy.

In *Hogg v. Emerson*, 6 How. 439, it was held, that when a case is sent up to the Supreme Court, under the discretion conferred upon the court below, by the act of 1836, the whole case must go up; the word "reasonable," in the statute, applying rather to the cases themselves than to the points of the cases.

<sup>1</sup> *Nevins v. Johnson*, 3 Blatchf. 80. "The arrangement of the provisions of sec. 17 may be fairly referred to, as implying that the power to award injunctions was introduced by Congress, rather as ancillary to the general equity jurisdiction imparted, than as the substantive and primary purpose of the enactment. It bears more the aspect of an incident to the jurisdiction before conferred than a condition of the jurisdiction itself."

<sup>2</sup> *Sizer v. Many*, 16 How. 98.

## CHAPTER XIV.

## REPEAL OF PATENTS. INTERFERING PATENTS OR APPLICATIONS.

§ 500. THE sixteenth section of the act of 1836 made provision for suits by bill in equity to declare void either of two interfering patents, or an existing patent where a subsequent applicant claimed the invention on the ground of priority, and the application had been refused on the ground that to grant it would interfere with the existing patent. The court was empowered, in the case of two interfering patents, to declare either of them void, in the whole or in part, or invalid or inoperative in any part or portion of the United States, according to the interest which the parties to the suit might possess in the inventions patented; and in the case of an application for a patent rejected on account of interference with an existing patent, to adjudge the patent to the applicant, as the fact of priority of right or invention might appear; *provided*, that the adjudication should not affect the rights of any person except the parties to the action, and those claiming title from or under them subsequent to the rendition of the judgment. With regard to the effect of this *proviso*, it has been held that, in order to affect parties who were not parties to the suit for interference, the judgment must be direct and affirmative, declaring the interference and that one of the patents is void in the whole or in part, or inoperative, or invalid in some particular part of the United States.<sup>1</sup>

§ 501. The act of 1870 makes corresponding but separate provisions on this subject of interference. The case of an application for a patent finally refused, *for any reason whatever*, which, of course, includes a refusal on the ground of interference with an existing patent, is provided for under section fifty-two of the new act, by giving the applicant a remedy by bill in equity; which, in fact, operates as a review of the grounds on which the

<sup>1</sup> Tyler *et al.* v. Hyde *et al.*, 2 Blatchf. 308.

application was finally rejected, the adjudication under the bill being that the applicant is entitled to the patent, if it so appears. Such a decision operates, it would seem, as an annulment of the patent previously granted, so far as the interference extends.

§ 502. The 58th section of the act of 1870 provides, that when there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief by bill in equity against the interfering patentee and all persons interested under him ; the judgment and its effect being the same as under section sixteen of the act of 1836.<sup>1</sup>

§ 503. But neither the act of 1836 nor the act of 1870 has made provision for vacating or declaring void any existing patent excepting upon the ground of interference, and that too at the suit of some rival patentee, or applicant, or of some person claiming under them. Parties who are sued, or are liable to be sued as infringers, — in other words, the general public, — are not embraced in these provisions. It has therefore been held by the Supreme Court of the United States, that when it is sought to vacate or annul a patent, on the ground that it was obtained by a fraud on the government, a private individual cannot maintain a bill in equity in his own name. But it has also been held that the general chancery jurisdiction of the courts of the United States affords a remedy in cases of this kind in the name of the attorney-general, on the relation of some one who is injured specially or as a part of the general public. What was formerly done in England by *scire facias* came afterwards to be done by a bill in chancery, as the more convenient remedy ; and this jurisdiction has been held to extend, in the courts of the United States, to patents granted by the government through mistake or inadvertence as well as fraud. This was so held in the case of a patent for lands,<sup>2</sup> and now patents for inventions have been placed upon the same footing, by a recent decision, which denies that an individual can maintain a suit in chancery for the repeal of a patent, in his own name, excepting in interference cases, but intimates that the proper remedy is in the name of the attorney-

<sup>1</sup> For the provisions respecting the court in which the suit may be brought, notice to adverse parties, and the method of proceeding generally, see §§ 52, 58, act of 1870.

<sup>2</sup> *United States v. Stone*, 2 Wall. 525.

general, or in the name of the United States.<sup>1</sup> Undoubtedly, the proper course is to institute the suit in the name of the attorney-general, or of the United States, *on the relation* of some one who is interested adversely to the patent.

§ 504. Whether this remedy can be resorted to in the case of a patent that has expired, is doubtful. In *Bourne v. Goodyear*, which appears to have been a proceeding in the name of the United States, on the relation of Bourne, to vacate an extended patent, it was held that the extended patent having expired before the bill was filed, there was no equity to support a suit to set it aside, because there was nothing for the bill to operate upon.<sup>2</sup> But this cannot be universally true. A patent may have expired, and yet the patentee may collect for past infringements; and it would seem that in a suit to declare the patent void *ab initio*, the court might entertain a prayer to restrain the patentee from making such collections. In the subsequent case of *Maury v. Whitney*, it was made one ground of demurrer to the bill that the extended patent had expired by its own limitation before the bill was filed. The court did not decide this question, because the suit to declare the patent void was brought in the name of an individual, and not in the name of the United States. But in delivering the opinion of the court, Mr. Justice Miller said that where a case arises in which the United States or the attorney-general shall institute a suit to have a patent declared null *ab initio*, which, though no longer in force as to present or future infringements, *is used* to sustain suits for infringements during its vitality, the question will be considered.<sup>3</sup> *Bourne v. Goodyear*, therefore, is not to be regarded as decisive on this question. It was apparently decided without considering that there may be such a case as Mr. Justice Miller described in the subsequent decision, and was therefore made more comprehensive than it should have been.

<sup>1</sup> *Maury v. Whitney*, 14 Wall. 434.

<sup>2</sup> *Bourne v. Goodyear*, 9 Wall. 811.

<sup>3</sup> *Maury v. Whitney*, 14 Wall. 434.

**A P P E N D I X.**

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**L A W S O F T H E U N I T E D S T A T E S**

**RELATING TO**

**P A T E N T S, & C.**



# PATENT LAWS.

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## ACT OF 1790, CHAPTER 7.

1 STATUTES AT LARGE, 109.

*Repealed by Act of 1793, Chap. 11, § 12.*

An Act to promote the progress of useful arts.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That upon the petition of any person or persons to the Secretary of State, the Secretary for the Department of War, and the Attorney-General of the United States, setting forth that he, she, or they hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, and praying that a patent may be granted therefor, it shall and may be lawful to and for the said Secretary of State, the Secretary for the Department of War, and the Attorney-General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters-patent to be made out in the name of the United States, to bear teste by the President of the United States, reciting the allegations and suggestions of the said petition, and describing the said invention or discovery, clearly, truly, and fully, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery; which letters-patent shall be delivered to the Attorney-General of the United States to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters-patent so certified to the President, who shall cause the seal of the United States to be thereto affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof

shall be entered on the record and indorsed on the patent by the said Secretary at the time of granting the same.

SECTION 2. *And be it further enacted,* That the grantee or grantees of each patent shall, at the time of granting the same, deliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model), of the thing or things by him or them invented or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art of manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term; which specification shall be filed in the office of the said Secretary, and certified copies thereof shall be competent evidence in all courts and before all jurisdictions, where any matter or thing, touching or concerning such patent, right, or privilege shall come in question.

SECTION 3. *And be it further enacted,* That upon the application of any person to the Secretary of State, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the Secretary to give such a copy, and to permit the person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant.

SECTION 4. *And be it further enacted,* That if any person or persons shall devise, make, construct, use, employ, or vend, within these United States, any art, manufacture, engine, machine, or device, or any invention or improvement upon, or in any art, manufacture, engine, machine, or device, the sole and exclusive right of which shall be so as aforesaid granted by patent to any person or persons, by virtue and in pursuance of this act, without the consent of the patentee or patentees, their executor, administrators, or assigns, first had and obtained in writing, every person so offending shall forfeit and pay to the said patentee or patentees, his, her, or their executors, administrators, or assigns, such damages as shall be assessed by a jury, and moreover shall forfeit to the person aggrieved, the thing or things so devised, made, constructed, used, employed, or vended, contrary to the true intent of this act, which may be recovered in an action on the case founded on this act.

SECTION 5. *And be it further enacted,* That upon oath or affirmation made before the judge of the district court where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously by, or upon false suggestion, and motion made to the said court, within one year after issuing the said patent, but not afterwards, it shall and may be lawful to and for the judge of the

said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators, or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee or patentees, his, her, or their executors, administrators, or assigns. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent or patents; and if the party at whose complaint the process issued shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in such manner as costs expended by defendants shall be recovered in due course of law.

SECTION 6. *And be it further enacted,* That in all actions to be brought by such patentee or patentees, his, her, or their executors, administrators, or assigns, for any penalty incurred by virtue of this act, the said patents or specifications shall be *primâ facie* evidence that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers, of the thing so specified, and that the same is truly specified; but that nevertheless the defendant or defendants may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff, or his attorney, thirty days before the trial, in evidence tending to prove that the specification filed by the plaintiff does not contain the whole of the truth concerning his invention or discovery; or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

SECTION 7. *And be it further enacted,* That such patentee as aforesaid shall, before he receives his patent, pay the following fees to the several officers employed in making out and perfecting the same, to wit: For receiving and filing the petition, fifty cents; for filing specifications, per copy-sheet containing one hundred words, ten cents; for making out patent, two dollars; for affixing great seal, one dollar; for indorsing the day of delivering the same to the patentee, including all intermediate services, twenty cents.

Approved April 10, 1790.

## ACT OF 1793, CHAPTER 11.

1 STATUTES AT LARGE, 318.

*Repealed by Act of 1836, Chap. 357, § 21.*

An Act to promote the progress of useful arts, and to repeal the Act heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters-patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters-patent shall be delivered to the Attorney-General of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of State, who shall present the letters-patent, thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed; and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

SECTION 2. *Provided always, and be it further enacted,* That any person who shall have discovered an improvement in the principle of any machine, or in the process of any composition of matter, which shall have been patented, and shall have obtained a patent for such improvement, he shall not be at liberty to make, use, or vend the original discovery, nor shall the first inventor be at liberty to use the improvement: And it is hereby enacted and declared, that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery.

SECTION 3. *And be it further enacted,* That every inventor, before he can receive a patent, shall swear or affirm, that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent, which oath or affirmation may be made before any person authorized to administer oaths, and shall 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 nearly 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; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings, or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description, signed by himself, and attested by two witnesses, shall be filed in the office of the Secretary of State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing, touching such patent right shall come in question. And such inventor shall, moreover, deliver a model of his machine, provided the Secretary shall deem such model to be necessary.

SECTION 4. *And be it further enacted,* 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, and so the assignees of assigns, to any degree.

SECTION 5. *And be it further enacted,* That if any person shall make, devise, and use, or sell the thing so invented, the exclusive right of which shall, as aforesaid, have been secured to any person by patent, without the consent of the patentee, his executors, administrators, or assigns, first obtained in writing, every person so offending shall forfeit and pay to the patentee a sum that shall be at least equal to three times the price for which the patentee has usually sold or licensed, to other persons, the use of the said invention, which may be recovered in an action on the case founded on this act, in the circuit court of the United States, or any other court having competent jurisdiction.

SECTION 6. *Provided always, and be it further enacted,* That the defendant in such action shall be permitted to plead the general issue, and give this act, and any special matter, of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, in 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, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the thing thus secured by patent was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person; in either of which cases judgment shall be rendered for the defendant, with costs, and the patent shall be declared void.

SECTION 7. *And be it further enacted,* That where any State, before its adoption of the present form of government, shall have granted an exclusive right to any invention, the party claiming that right shall not be capable of obtaining an exclusive right under this act, but on relinquishing his right under such particular State, and of such relinquishment, his obtaining an exclusive right under this act shall be sufficient evidence.

SECTION 8. *And be it further enacted,* That the persons whose applications for patents were, at the time of passing this act, depending before the Secretary of State, Secretary at War, and Attorney-General, according to the act passed the second session of the first Congress, entitled, "An Act to promote the progress of useful arts," on complying with the conditions of this act, and paying the fees herein required, may pursue their respective claims to a patent under the same.

SECTION 9. *And be it further enacted,* That in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the Secretary of State; and the decision or award of such arbitrators, delivered to the Secretary of State in writing, and subscribed by them, or any two of them, shall be final, as far as respects the granting of the patent. And if either of the applicants shall refuse or fail to choose an arbitrator, the patent shall issue to the opposite party. And where there shall be more than two interfering applications, and the parties applying shall not all unite in appointing three arbitrators, it shall be in the power of the Secretary of State to appoint three arbitrators for the purpose.

SECTION 10. *And be it further enacted,* That upon oath or affirmation being made before the judge of the District Court where the patentee, his executors, administrators, or assigns reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or upon false suggestion, and motion made to the said court, within three years after issuing the said patent, but not afterwards, it shall and may be lawful for the judge of the said District Court, if the matter alleged shall appear to him to be sufficient, to grant a

rule, that the patentee, or his executor, administrator, or assign show cause why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued against such patentee, or his executors, administrators, or assigns, with costs of suit. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent; and if the party, at whose complaint, the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in due course of law.

SECTION 11. *And be it further enacted,* That every inventor, before he presents his petition to the Secretary of State, signifying his desire of obtaining a patent, shall pay into the treasury thirty dollars, for which he shall take duplicate receipts; one of which receipts he shall deliver to the Secretary of State, when he presents his petition; and the money thus paid shall be in full for the sundry services to be performed in the office of the Secretary of State, consequent on such petition, and shall pass to the account of clerk-hire in that office: *Provided nevertheless,* That for every copy, which may be required at the said office, of any paper respecting any patent that has been granted, the person obtaining such copy shall pay, at the rate of twenty cents, for every copy-sheet of one hundred words, and for every copy of a drawing, the party obtaining the same, shall pay two dollars, of which payments an account shall be rendered, annually, to the treasury of the United States, and they shall also pass to the account of clerk-hire in the office of the Secretary of State.

SECTION 12. *And be it further enacted,* That the act, passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An Act to promote the progress of useful arts," be, and the same is hereby, repealed: *Provided always,* That nothing contained in this act shall be construed to invalidate any patent that may have been granted under the authority of the said act; and all patentees under the said act, their executors, administrators, or assigns, shall be considered within the purview of this act, in respect to the violation of their rights; provided such violations shall be committed after the passing of this act.

Approved February 21, 1793.

## ACT OF 1794, CHAPTER 58.

1 STATUTES AT LARGE, 393.

*Repealed by Act of 1836, Chap. 357, § 21.*

An Act supplementary to the Act intituled "An Act to promote the progress of useful arts."

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That all suits, actions, process and proceedings, heretofore had in any District Court of the United States, under an act passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An Act to promote the progress of useful arts," which may have been set aside, suspended, or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said courts, to the same situation, in which they may have been when they were so set aside, suspended, or abated; and that the parties to the said suits, actions, process or proceedings be, and are hereby, entitled to proceed in such cases, as if no such repeal of the act aforesaid had taken place: *Provided always,* That before any order or proceeding, other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceeding as is used in other cases for compelling the appearance of a party.

Approved June 7, 1794.

## ACT OF 1800, CHAPTER 25.

2 STATUTES AT LARGE, 37.

*Repealed by Act of 1836, Chap. 357, § 21.*

An Act to extend the privilege of obtaining patents for useful discoveries and inventions, to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That all and singular the rights and privileges given, intended or provided to citizens of the United States, respecting patents for new inventions, discoveries, and improvements, by the act intituled "An Act to promote



the progress of useful arts, and to repeal the Act heretofore made for that purpose," shall be, and hereby are, extended and given to all aliens who at the time of petitioning in the manner prescribed by the said act, shall have resided for two years within the United States, which privileges shall be obtained, used, and enjoyed by such persons, in as full and ample manner, and under the same conditions, limitations, and restrictions, as by the said act is provided and directed in the case of citizens of the United States: *Provided always*, That every person petitioning for a patent for any invention, art, or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths before such patent shall be granted, that such invention, art, or discovery hath not, to the best of his or her knowledge or belief, been known or used either in this or any foreign country, and that every patent which shall be obtained pursuant to this act, for any invention, art, or discovery, which it shall afterward appear had been known or used previous to such application for a patent, shall be utterly void.

SECTION 2. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might, by virtue of this or the above-mentioned act, be granted to such person, and shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent, shall devolve on the legal representatives of such person in trust for the heirs at law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions as the same was held, or might have been claimed or enjoyed by such person, in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation, provided in the third section of the before-mentioned act, shall be so varied as to be applicable to them.

SECTION 3. *And be it further enacted*, That where any patent shall be or shall have been granted pursuant to this or the above-mentioned act, and any person without the consent of the patentee, his or her executors, administrators, or assigns, first obtained in writing, shall make, devise, use, or sell the thing whereof the exclusive right is secured to the said patentee by such patent, such person so offending shall forfeit and pay to the said patentee, his executors, administrators, or assigns, a sum equal to three times the actual damage sustained by such patentee, his executors, administrators, or assigns, from or by reason of such offence, which sum shall and may be recovered by action on the case founded on this and the above-mentioned act, in the Circuit Court of the United States, having jurisdiction thereon.

SECTION 4. *And be it further enacted*, That the fifth section of the

above-mentioned act, intituled "An Act to promote the progress of useful arts, and to repeal the Act heretofore made for that purpose," shall be, and hereby is, repealed.

Approved April 17, 1800.

### ACT OF 1819, CHAPTER 19.

3 STATUTES AT LARGE, 481.

*Repealed by Act of 1836, Chap. 357, § 21.*

An Act to extend the jurisdiction of the Circuit Courts of the United States to cases arising under the law relating to patents.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the Circuit Courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable: *Provided however,* That from all judgments and decrees of any Circuit Courts rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such circuit courts.

Approved February 15, 1819.

### ACT OF 1832, CHAPTER 162.

4 STATUTES AT LARGE, 559.

*Repealed by Act of 1836, Chap. 357, § 21.*

An Act concerning patents for useful inventions.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That it shall be the duty of the Secretary of State, annually, in the month of January, to report to Congress, and to publish in two of the newspapers printed in the city of Washington, a list of all the patents for discov-

eries, inventions, and improvements, which shall have expired within the year immediately preceding, with the names of the patentees, alphabetically arranged.

SECTION 2. *And be it further enacted,* That application to Congress to prolong or renew the term of a patent shall be made before its expiration, and shall be notified at least once a month, for three months before its presentation, in two newspapers printed in the city of Washington, and in one of the newspapers in which the laws of the United States shall be published in the State or Territory in which the patentee shall reside. The petition shall set forth particularly the grounds of the application. It shall be verified by oath; the evidence in its support may be taken before any judge or justice of the peace; it shall be accompanied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom.

SECTION 3. *And be it further enacted,* That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of the act of Congress, entitled "An Act to promote the progress of useful arts, and to repeal the Act heretofore made for that purpose," passed on the twenty-first day of February, in the year of our Lord, one thousand seven hundred and ninety-three, or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first-mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of the said act. And, in case of his death, or any assignment by him made of the same patent, the like right shall vest in his executors and administrators, or assignee or assignees: *Provided however,* That such new patent so granted shall, in all respects, be liable to the same matters of objection and defence as any original patent granted under the said first-mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid.

Approved July 3, 1832.

## ACT OF 1832, CHAPTER 203.

4 STATUTES AT LARGE, 577.

*Repealed by Act of 1836, Chap. 357, § 21.*

An Act concerning the issuing of patents to aliens, for useful discoveries and inventions.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the privileges granted to the aliens described in the first section of the act, to extend the privilege of obtaining patents for useful discoveries and inventions to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees, approved April seventeenth, eighteen hundred, be extended in like manner to every alien who, at the time of petitioning for a patent, shall be resident in the United States, and shall have declared his intention, according to law, to become a citizen thereof: *Provided,* That every patent granted by virtue of this act and the privileges thereto appertaining, shall cease and determine and become absolutely void without resort to any legal process to annul or cancel the same in case of a failure on the part of any patentee, for the space of one year from the issuing thereof, to introduce into public use in the United States the invention or improvement for which the patent shall be issued; or in case the same for any period of six months after such introduction shall not continue to be publicly used and applied in the United States, or in case of failure to become a citizen of the United States, agreeably to notice given at the earliest period within which he shall be entitled to become a citizen of the United States.

Approved July 13, 1832.

## ACT OF 1836, CHAPTER 357.

5 STATUTES AT LARGE, 117.

An Act to promote the progress of the useful arts, and to repeal all Acts and parts of Acts heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be established and attached to the Department of State an office to be denominated the Patent Office; the chief officer of which shall be called the Commissioner of Patents, to be appointed by the President, by and with the advice and consent of the Senate, whose duty it shall

be, under the direction of the Secretary of State, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said office. And said commissioner shall receive the same compensation as is allowed by law to the Commissioner of the Indian Department, and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage.

SECTION 2. *And be it further enacted,* That there shall be in said office an inferior officer, to be appointed by the said principal officer, with the approval of the Secretary of State, to receive an annual salary of seventeen hundred dollars, and to be called the Chief Clerk of the Patent Office; who, in all cases during the necessary absence of the commissioner, or when the said principal office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers, machines, models, and all other things belonging to the said office, and shall perform the duties of commissioner during such vacancy. And the said commissioner may also, with like approval, appoint an examining clerk, at an annual salary of fifteen hundred dollars; two other clerks at twelve hundred dollars each, one of whom shall be a competent draughtsman; one other clerk at one thousand dollars; a machinist at twelve hundred and fifty dollars; and a messenger at seven hundred dollars. And said commissioner, clerks, and every other person appointed and employed in said office shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be granted.

SECTION 3. *And be it further enacted,* That the said principal officer, and every other person to be appointed in the said office, shall, before he enters upon the duties of his office or appointment, make oath or affirmation truly and faithfully to execute the trust committed to him. And the said commissioner and the chief clerk shall also, before entering upon their duties, severally give bonds, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, with condition to render a true and faithful account to him or his successor in office, quarterly, of all moneys which shall be by them respectively received for duties on patents, and for copies of records and drawings, and all other moneys received by virtue of said office.

SECTION 4. *And be it further enacted,* That the said commissioner

shall cause a seal to be made and provided for the said office, with such device as the President of the United States shall approve; and copies of any records, books, papers, or drawings belonging to the said office, under the signature of the said commissioner, or, when the office shall be vacant, under the signature of the chief clerk, with the said seal affixed, shall be competent evidence in all cases in which the original records, books, papers, or drawings could be evidence. And any person making application therefor may have certified copies of the records, drawings, and other papers deposited in said office, on paying for the written copies the sum of ten cents for every page of one hundred words; and for copies of drawings the reasonable expense of making the same.

SECTION 5. [See act of 1837, ch. 45, § 6.] *And be it further enacted,* That all patents issued from said office shall be issued in the name of the United States, and under the seal of said office, and be signed by the Secretary of State, and countersigned by the commissioner of the said office, and shall be recorded, together with the descriptions, specifications, and drawings, in the said office, in books to be kept for that purpose. Every such patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design, and in its terms grant to the applicant or applicants, his or their heirs, administrators, executors, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery, referring to the specifications for the particulars thereof, a copy of which shall be annexed to the patent, specifying what the patentee claims as his invention or discovery.

SECTION 6. *And be it further enacted,* That any person or persons, having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application, in writing, to the Commissioner of Patents, expressing such desire, and the commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of any machine, 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; and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. He shall, furthermore, accompany the whole with a drawing or drawings, and written references, where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter; which descriptions and drawings, signed by the inventor and attested by two witnesses, shall be filed in the Patent Office; and he shall moreover furnish a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. The applicant shall also make oath or affirmation that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths.

SECTION 7. [See act of 1839, ch. 88, §§ 7-12, and act of 1863, ch. 102, § 1.] *And be it further enacted*, That, on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the commissioner that the applicant was not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on

filing a notice in writing of such election in the Patent Office, a copy of which, certified by the commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claims for a patent, with or without any alteration in his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing, of the opinion and decision of the commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the commissioner, either in whole or in part, and their opinion being certified to the commissioner, he shall be governed thereby in the further proceedings to be had on such application: *Provided however*, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

SECTION 8. [See act of 1839, ch. 88, § 6.] *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the commissioner to give notice thereof to such applicants, or patentees, as the case may



be; and if either shall be dissatisfied with the decision of the commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters-patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

SECTION 9. [See act of 1861, ch. 88, § 10.] *And be it further enacted,* That before any application for a patent shall be considered by the commissioner as aforesaid, the applicant shall pay into the treasury of the United States, or into the Patent Office, or into any of the deposit banks, to the credit of the treasury, if he be a citizen of the United States, or an alien, and shall have been resident in the United States for one year next preceding, and shall have made oath of his intention to become a citizen thereof, the sum of thirty dollars; if a subject of the king of Great Britain, the sum of five hundred dollars; and all other persons the sum of three hundred dollars; or which payment duplicate receipts shall be taken, one of which to be filed in the office of the Treasurer. And the moneys received into the treasury under this act shall constitute a fund for the payment of the salaries of the officers and clerks herein provided for, and all other expenses of the Patent Office, and to be called the Patent Fund.

SECTION 10. *And be it further enacted,* That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might by virtue of this act be granted, and such person shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent shall devolve on the executor or administrator of such person, in trust for the heirs at law of the deceased, in case he shall have died intestate: but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions as the same was held, or might have been claimed or enjoyed by such person in his or her lifetime; and when application for a patent shall be made

by such legal representatives, the oath or affirmation provided in the sixth section of this act shall be so varied as to be applicable to them.

SECTION 11. *And be it further enacted,* That every patent shall be assignable in law, either as to the whole interest, or any undivided part thereof, by any instrument in writing; which assignment, and also every grant and conveyance of the exclusive right, under any patent, to make and use, and to grant to others to make and use the thing patented within and throughout any specified part or portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof, for which the assignee or grantee shall pay to the commissioner the sum of three dollars.

SECTION 12. [See act of 1861, ch. 88, §§ 9, 10.] *And be it further enacted,* That any citizen of the United States, or alien, who shall have been a resident of the United States one year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire further time to mature the same, may, on paying to the credit of the treasury, in manner as provided in the ninth section of this act, the sum of twenty dollars, file in the Patent Office a caveat, setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right till he shall have matured his invention; which sum of twenty dollars, in case the person filing such caveat shall afterwards take out a patent for the invention therein mentioned, shall be considered a part of the sum herein required for the same. And such caveat shall be filed in the confidential archives of the office, and preserved in secrecy. And if application shall be made by any other person within one year from the time of filing such caveat, for a patent of any invention with which it may in any respect interfere, it shall be the duty of the commissioner to deposit the description, specifications, drawings, and model, in the confidential archives of the office, and to give notice, by mail, to the person filing the caveat, of such application, who shall, within three months after receiving the notice, if he would avail himself of the benefit of his caveat, file his description, specifications, drawings, and model; and if, in the opinion of the commissioner, the specifications of claim interfere with each other, like proceedings may be had in all respects as are in this act provided in the case of interfering applications: *Provided however,* That no opinion or decision of any board of examiners, under the provisions of this act, shall preclude any person, interested in favor or against the validity of any patent which has been or may hereafter be granted, from the right to contest the same in any judicial court in any action in which its validity may come in question.

SECTION 13. [See act of 1837, ch. 45, §§ 5-8, and act of 1861, ch. 88, § 9.] *And be it further enacted,* That whenever any patent which has

heretofore been granted, or which shall hereafter be granted, shall be inoperative, or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention more than he had or shall have a right to claim as new; if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification. And in case of his death, or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assignees. And the patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent. And whenever the original patentee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery which shall have been invented or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the payment of fifteen dollars, as hereinbefore provided, have the same annexed to the original description and specification; and the commissioner shall certify, on the margin of such annexed description and specification, the time of its being annexed and recorded; and the same shall hereafter have the same effect in law, to all intents and purposes, as though it had been embraced in the original description and specification.

SECTION 14. *And be it further enacted*, That whenever, in any action for damages for making, using, or selling the thing whereof the exclusive right is secured by any patent heretofore granted, or by any patent which may hereafter be granted, a verdict shall be rendered for the plaintiff in such action, it shall be in the power of the court to render judgment for any sum above the amount found by such verdict as the actual damages sustained by the plaintiff, not exceeding three times the amount thereof, according to the circumstances of the case, with costs; and such damages may be recovered by action on the case, in any court of competent jurisdiction, to be brought in the name or names of the person or persons interested, whether as patentees, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States.

SECTION 15. [See act of 1837, ch. 45, § 9; and by act of 1839, ch. 88, § 7.] *And be it further enacted*, That the defendant in any such

action shall be permitted to plead the general issue, and to give this act 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 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, 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 had been described in some public work anterior to the supposed discovery thereof by the patentee, or had been in public use or on sale with the consent and allowance of the patentee before his application for a patent, or that he 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; 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 shall be rendered for the defendant with costs. And whenever 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 had been used: *Provided however*, 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.

SECTION 16. [See act of 1839, ch. 88, § 10.] *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any

person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however,* That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

SECTION 17. [See act of 1861, ch. 37.] *And be it further enacted,* That all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, by the Circuit Courts of the United States, or any District Court having the power and jurisdiction of a Circuit Court; which courts shall have power, upon a bill in equity filed by any party aggrieved, in any such case, 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 said courts may deem reasonable: *Provided however,* That from all judgments and decrees from any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of Circuit Courts, and in all other cases in which the court shall deem it reasonable to allow the same.

SECTION 18. [See act of 1848, ch. 47, § 1, and act of 1861, ch. 88, §§ 12, 16.] *And be it further enacted,* That whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and the commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury, as in the case of an original application for a patent, cause to be published in one or

more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence produced before them both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein: *Provided however,* That no extension of a patent shall be granted after the expiration of the term for which it was originally issued.

SECTION 19. *And be it further enacted,* That there shall be provided for the use of said office, a library of scientific works and periodical publications, both foreign and American, calculated to facilitate the discharge of the duties hereby required of the chief officers therein, to be purchased under the direction of the Committee of the Library of Congress. And the sum of fifteen hundred dollars is hereby appropriated for that purpose, to be paid out of the patent fund.

SECTION 20. *And be it further enacted,* That it shall be the duty of the commissioner to cause to be classified and arranged, in such rooms or galleries as may be provided for that purpose, in suitable cases, when necessary for their preservation, and in such manner as shall be conducive to a beneficial and favorable display thereof, the models and

specimens of compositions and of fabrics and other manufactures and works of art, patented or unpatented, which have been, or shall hereafter be, deposited in said office. And said rooms or galleries shall be kept open during suitable hours for public inspection.

SECTION 21. *And be it further enacted*, That all acts and parts of acts heretofore passed on this subject be, and the same are hereby repealed: *Provided however*, That all actions and processes in law or equity sued out prior to the passage of this act may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting and saving the application to any such action of the provisions of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto; *And provided also*, That all applications or petitions for patents, pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage hereof.

Approved July 4, 1836.

## ACT OF 1837, CHAPTER 45.

5 STATUTES AT LARGE, 191.

An Act in addition to the act to promote the progress of science and useful arts.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That any person who may be in possession of, or in any way interested in, any patent for an invention, discovery, or improvement, issued prior to the fifteenth day of December, in the year of our Lord one thousand eight hundred and thirty-six, or in an assignment of any patent, or interest therein, executed and recorded prior to the said fifteenth day of December, may, without charge, on presentation or transmission thereof to the Commissioner of Patents, have the same recorded anew in the Patent Office, together with the descriptions, specifications of claim and drawings annexed or belonging to the same; and it shall be the duty of the commissioner to cause the same, or any authenticated copy of the original record, specification, or drawing which he may obtain, to be transcribed and copied into books of record to be kept for that purpose; and wherever a drawing was not originally annexed to the patent and referred to in the specification, any drawing produced as a delineation of the invention, being verified by oath in such manner as the commissioner shall require, may be transmitted and placed on file, or copied as aforesaid, together with certificate of the oath; or such drawings may be made in the office, under the direction

of the commissioner, in conformity with the specification. And it shall be the duty of the commissioner to take such measures as may be advised and determined by the Board of Commissioners provided for in the fourth section of this act, to obtain the patents, specifications, and copies aforesaid, for the purpose of being so transcribed and recorded. And it shall be the duty of each of the several clerks of the judicial courts of the United States, to transmit as soon as may be, to the Commissioner of the Patent Office, a statement of all the authenticated copies of patents, descriptions, specifications, and drawings of inventions and discoveries made and executed prior to the aforesaid fifteenth day of December, which may be found on the files of his office; and also to make out and transmit to said commissioner, for record as aforesaid, a certified copy of every such patent, description, specification, or drawing, which shall be specially required by said commissioner.

SECTION 2. *And be it further enacted*, That copies of such record and drawings, certified by the commissioner, or, in his absence, by the chief clerk, shall be *prima facie* evidence of the particulars of the invention and of the patent granted therefor in any judicial court of the United States, in all cases where copies of the original record or specification and drawings would be evidence, without proof of the loss of such originals; and no patent issued prior to the aforesaid fifteenth day of December shall, after the first day of June next, be received in evidence in any of the said courts in behalf of the patentee or other person who shall be in possession of the same, unless it shall have been so recorded anew, and a drawing of the invention, if separate from the patent, verified as aforesaid, deposited in the Patent Office; nor shall any written assignment of any such patent, executed and recorded prior to the said fifteenth day of December, be received in evidence in any of the said courts in behalf of the assignee or other person in possession thereof, until it shall have been so recorded anew.

SECTION 3. [See act of 1842, ch. 263, § 2.] *And be it further enacted*, That whenever it shall appear to the commissioner that any patent was destroyed by the burning of the Patent Office building on the aforesaid fifteenth day of December, or was otherwise lost prior thereto, it shall be his duty, on application therefor by the patentee or other person interested therein, to issue a new patent for the same invention or discovery, bearing the date of the original patent, with his certificate thereon that it was made and issued pursuant to the provisions of the third section of this act, and shall enter the same of record: *Provided however*, That before such patent shall be issued the applicant therefor shall deposit in the Patent Office a duplicate, as near as may be, of the original model, drawings, and description, with specification of the invention or discovery, verified by oath, as shall be required by the commissioner; and such patent, and copies of such drawings and



descriptions, duly certified, shall be admissible as evidence in any judicial court of the United States, and shall protect the rights of the patentee, his administrators, heirs, and assigns, to the extent only in which they would have been protected by the original patent and specification.

SECTION 4. *And be it further enacted,* That it shall be the duty of the commissioner to procure a duplicate of such of the models, destroyed by fire on the aforesaid fifteenth day of December, as were most valuable and interesting, and whose preservation would be important to the public; and such as would be necessary to facilitate the just discharge of the duties imposed by law on the commissioner in issuing patents, and to protect the rights of the public and of patentees in patented inventions and improvements: *Provided,* That a duplicate of such models may be obtained at a reasonable expense: *And provided also,* That the whole amount of expenditure for this purpose shall not exceed the sum of one hundred thousand dollars. And there shall be a temporary board of commissioners, to be composed of the Commissioner of the Patent Office and two other persons to be appointed by the President, whose duty it shall be to consider and determine upon the best and most judicious mode of obtaining models of suitable construction; and also to consider and determine what models may be procured in pursuance of, and in accordance with, the provisions and limitations in this section contained. And said commissioners may make and establish all such regulations, terms, and conditions, not inconsistent with law, as in their opinion may be proper and necessary to carry the provision of this section into effect, according to its true intent.

SECTION 5. [See act of 1836, ch. 357, § 13.] *And be it further enacted,* That, whenever a patent shall be returned for correction and reissue under the thirteenth section of the act to which this is additional, and the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented, he shall first pay, in manner and in addition to the sum provided by that act, the sum of thirty dollars for each additional patent so to be issued: *Provided however,* That no patent made prior to the aforesaid fifteenth day of December shall be corrected and reissued until a duplicate of the model and drawing of the thing as originally invented, verified by oath as shall be required by the commissioner, shall be deposited in the Patent Office;

Nor shall any addition of an improvement be made to any patent heretofore granted, nor any new patent be issued for an improvement made in any machine, manufacture, or process, to the original inventor, assignee, or possessor of a patent therefor, nor any disclaimer be admitted to record, until a duplicate model and drawing of the thing originally invented, verified as aforesaid, shall have been deposited in

the Patent Office, if the commissioner shall require the same; nor shall any patent be granted for an invention, improvement, or discovery, the model or drawing of which shall have been lost, until another model and drawing, if required by the commissioner, shall, in like manner, be deposited in the Patent Office;

And in all such cases, as well as in those which may arise under the third section of this act, the question of compensation for such models and drawings shall be subject to the judgment and decision of the commissioners, provided for in the fourth section, under the same limitations and restrictions as are therein prescribed.

SECTION 6. [See act of 1836, ch. 357, § 5.] *And be it further enacted,* That any patent hereafter to be issued may be made and issued to the assignee or assignees of the inventor or discoverer, the assignment thereof being first entered of record, and the application therefor being duly made, and the specification duly sworn to by the inventor. And in all cases hereafter, the applicant for a patent shall be held to furnish duplicate drawings, whenever the case admits of drawings, one of which to be deposited in the office, and the other to be annexed to the patent, and considered a part of the specification.

SECTION 7. *And be it further enacted,* 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 or substantial part of 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 disclaimant 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.

SECTION 8. [See act of 1861, ch. 88, § 9.] *And be it further enacted,* That, whenever application shall be made to the commissioner for any addition of a newly discovered improvement to be made to an existing patent, or whenever a patent shall be returned for correction and reissue, the specification of claim annexed to every such patent shall be subject to revision and restriction, in the same manner as are original

applications for patents; the commissioner shall not add any such improvement to the patent in the one case, nor grant the reissue in the other case, until the applicant shall have entered a disclaimer, or altered his specification of claim in accordance with the decision of the commissioner; and in all such cases, the applicant, if dissatisfied with such decision, shall have the same remedy, and be entitled to the benefit of the same privileges and proceedings as are provided by law in the case of original applications for patents.

SECTION 9. [See act of 1836, ch. 357, § 15.] *And be it further enacted* (any thing 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 or 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 of 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 benefits of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer as aforesaid.

SECTION 10. [See act of 1861, ch. 88, § 6.] *And be it further enacted*, That the commissioner is hereby authorized and empowered to appoint agents, in not exceeding twenty of the principal cities or towns in the United States as may best accommodate the different sections of the country, for the purpose of receiving and forwarding to the Patent Office all such models, specimens of ingredients and manufactures, as shall be intended to be patented or deposited therein, the transportation of the same to be chargeable to the patent fund.

SECTION 11. *And be it further enacted*, That, instead of one examining clerk, as provided by the second section of the act to which this is

additional, there shall be appointed, in manner therein provided, two examining clerks, each to receive an annual salary of fifteen hundred dollars; and also, an additional copying clerk, at an annual salary of eight hundred dollars. And the commissioner is also authorized to employ, from time to time, as many temporary clerks as may be necessary to execute the copying and draughting required by the first section of this act, and to examine and compare the records with the originals, who shall receive not exceeding seven cents for every page of one hundred words, and for drawings and comparison of records with originals, such reasonable compensation as shall be agreed upon or prescribed by the commissioner.

SECTION 12. [See act of 1861, ch. 88, § 9.] *And be it further enacted,* That, wherever the application of any foreigner for a patent shall be rejected and withdrawn for want of novelty in the invention, pursuant to the seventh section of the act to which this is additional, the certificate thereof of the commissioner shall be a sufficient warrant to the treasurer to pay back to such applicant two thirds of the duty he shall have paid into the treasury on account of such application.

SECTION 13. *And be it further enacted,* That in all cases in which an oath is required by this act or by the act to which this is additional, if the person of whom it is required shall be conscientiously scrupulous of taking an oath, affirmation may be substituted therefor.

SECTION 14. *And be it further enacted,* That all moneys paid into the treasury of the United States for patents and for fees for copies furnished by the Superintendent of the Patent Office prior to the passage of the act to which this is additional, shall be carried to the credit of the patent fund created by said act; and the moneys constituting said fund shall be, and the same are hereby, appropriated for the payment of the salaries of the officers and clerks provided for by said act, and all other expenses of the Patent Office, including all the expenditures provided for by this act; and also for such other purposes as are or may be hereafter specially provided for by law. And the commissioner is hereby authorized to draw upon said fund, from time to time, for such sums as shall be necessary to carry into effect the provisions of this act, governed, however, by the several limitations herein contained. And it shall be his duty to lay before Congress, in the month of January, annually, a detailed statement of the expenditures and payments by him made from said fund; And it shall also be his duty to lay before Congress, in the month of January, annually, a list of all patents which shall have been granted during the preceding year, designating, under proper heads, the subjects of such patents, and furnishing an alphabetical list of the patentees, with their places of residence; and he shall also furnish a list of all patents which shall have become public property during the same period; together with such other information of the state and condition of the Patent Office as may be useful to Congress or the public.

Approved March 3, 1837.

## ACT OF 1839, CHAPTER 88.

5 STATUTES AT LARGE, 353.

An Act in addition to "An Act to promote the progress of the useful arts."

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be appointed, in manner provided in the second section of the act to which this is additional, two assistant examiners, each to receive an annual salary of twelve hundred and fifty dollars.

SECTION 2. *And be it further enacted,* That the commissioner be authorized to employ temporary clerks to do any necessary transcribing, whenever the current business of the office requires it; *Provided, however,* That instead of salary, a compensation shall be allowed, at a rate not greater than is charged for copies now furnished by the office.

SECTION 3. *And be it further enacted,* That the commissioner is hereby authorized to publish a classified and alphabetical list of all patents granted by the Patent Office previous to said publication, and retain one hundred copies for the Patent Office and nine hundred copies to be deposited in the library of Congress, for such distribution as may be hereafter directed; and that one thousand dollars, if necessary, be appropriated, out of the patent fund, to defray the expense of the same.

SECTION 4. *And be it further enacted,* That the sum of three thousand six hundred and fifty-nine dollars and twenty-two cents be, and is hereby, appropriated from the patent fund, to pay for the use and occupation of rooms in the City Hall by the Patent Office.

SECTION 5. *And be it further enacted,* That the sum of one thousand dollars be appropriated from the patent fund, to be expended under the direction of the commissioner, for the purchase of necessary books for the library of the Patent Office.

SECTION 6. [See act of 1836, ch. 357, § 8.] *And be it further enacted,* That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided,* That the same shall not have been introduced into public and common use in the United States, prior to the application for such patent: *And provided also,* That in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters-patent.

SECTION 7. [See act of 1836, ch. 357, §§ 7, 15.] *And be it further en-*

*acted*, 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.

SECTION 8. *And be it further enacted*, That so much of the eleventh section of the above recited act as requires the payment of three dollars to the Commissioner of Patents for recording any assignment, grant, or conveyance of the whole or any part of the interest or right under any patent, be, and the same is hereby, repealed; and all such assignments, grants, and conveyances shall, in future, be recorded, without any charge whatever.

SECTION 10. [See act of 1836, ch. 357, § 16.] *And be it further enacted*, That the provisions of the sixteenth section of the before-recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor or otherwise.

SECTION 11. [See act of 1836, ch. 357, § 7.] *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the District Court of the United States for the District of Columbia, by giving notice thereof to the commissioner, and filing in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the commissioner, at such early and convenient time as he may appoint, first notifying the commissioner of the time and place of hearing, whose

duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined. And at the request of any party interested, or at the desire of the judge, the commissioner and the examiners in the Patent Office may be examined under oath, in explanation of the principles of the machine or other thing for which a patent, in such case, is prayed for. And it shall be the duty of said judge, after a hearing of any such case, to return all the papers to the commissioner, with a certificate of his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the commissioner in such case: *Provided however*, That no opinion or decision of the judge in any such case shall preclude any person interested in favor or against the validity of any patent which has been or may hereafter be granted from the right to contest the same in any judicial court, in any action in which its validity may come in question.

SECTION 12. [See act of 1836, ch. 357, § 7, and act of 1861, ch. 88, § 1.] *And be it further enacted*, That the Commissioner of Patents shall have power to make all such regulations, in respect to the taking of evidence to be used in contested cases before him, as may be just and reasonable. And so much of the act to which this is additional, as provides for a board of examiners, is hereby repealed.

SECTION 13. [See act of 1852, ch. 107, § 3.] *And be it further enacted*, That there be paid annually, out of the patent fund, to the said Chief Justice, in consideration of the duties herein imposed, the sum of one hundred dollars.

Approved March 3, 1839.

## ACT OF 1842, CHAPTER 263.

5 STATUTES AT LARGE, 543.

An Act in addition to "An Act to promote the progress of the useful arts," and to repeal all acts and parts of acts heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the Treasurer of the United States be, and he hereby is, authorized to pay back, out of the patent fund, any sum or sums of money, to any person who shall have paid the same into the Treasury, or to any receiver or depositary to the credit of the Treasurer, as for fees accruing at the

Patent Office through mistake, and which are not provided to be paid by existing laws, certificate thereof being made to the said Treasurer by the Commissioner of Patents.

SECTION 2. [See act of 1837, ch. 45, § 3.] *And be it further enacted,* That the third section of the act of March, eighteen hundred and thirty-seven, which authorizes the renewing of patents lost prior to the fifteenth of December, eighteen hundred and thirty-six, is extended to patents granted prior to said fifteenth day of December, though they may have been lost subsequently: *Provided however,* The same shall not have been recorded anew under the provisions of said act.

SECTION 3. [See act of 1861, ch. 88, § 11.] *And be it further enacted,* That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woollen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas relief or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application in writing to the Commissioner of Patents expressing such desire, and the commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent: *Provided,* That the fee in such cases, which by the now existing laws would be required of the particular applicant, shall be one half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section.

SECTION 4. *And be it further enacted,* That the oath required for applicants for patents may be taken, when the applicant is not, for the time being, residing in the United States, before any minister, plenipotentiary, *chargé d'affaires*, consul, or commercial agent holding commission under the government of the United States, or before any notary public of the foreign country in which such applicant may be.



SECTION 5. *And be it further enacted,* That if any person or persons shall paint or print or mould, cast, carve, or engrave, or stamp, upon any thing made, used, or sold, by him, for the sole making or selling which he hath not or shall not have obtained letters-patent, the name or any imitation of the name of any other person who hath or shall have obtained letters-patent for the sole making and vending of such thing, without consent of such patentee, or his assigns or legal representatives; or if any person, upon any such thing not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having the license or consent of such patentee, or his assigns or legal representatives, shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise make or affix the word "patent," or the words "letters-patent," or the word "patentee," or any word or words of like kind, meaning, or import, with the view or intent of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall affix the same, or any word, stamp, or device, of like import, on any unpatented article, for the purpose of deceiving the public, he, she, or they, so offending, shall be liable for such offence to a penalty of not less than one hundred dollars, with costs, to be recovered by action in any of the Circuit Courts of the United States, or in any of the District Courts of the United States having the powers and jurisdiction of a Circuit Court; one half of which penalty, as recovered, shall be paid to the patent fund, and the other half to any person or persons who shall sue for the same.

SECTION 6. [See act of 1861, ch. 88, § 13.] *And be it further enacted,* That all patentees and assignees of patents hereafter granted are hereby required to stamp, engrave, or cause to be stamped or engraved, on each article vended, or offered for sale, the date of the patent; and if any person or persons, patentees, or assignees, shall neglect to do so, he, she, or they shall be liable to the same penalty, to be recovered and disposed of in the manner specified in the foregoing fifth section of this act.

Approved August 29, 1842.

## ACT OF 1848, CHAPTER 47.

9 STATUTES AT LARGE, 231.

An Act to provide additional examiners in the Patent Office, and for other purposes.

SECTION 1. [See act of 1836, ch. 357, § 18.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be appointed, in the manner provided in the second section of the act entitled "An Act to promote

the progress of useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six, two principal examiners, and two assistant examiners, in addition to the number of examiners now employed in the Patent Office; and that hereafter each of the principal examiners employed in the Patent Office shall receive an annual salary of twenty-five hundred dollars, and each of the assistant examiners an annual salary of fifteen hundred dollars: *Provided*, That the power to extend patents, now vested in the board composed of the Secretary of State, Commissioner of Patents, and Solicitor of the Treasury, by the eighteenth section of the act approved July fourth, eighteen hundred and thirty-six, respecting the Patent Office, shall hereafter be vested solely in the Commissioner of Patents; and when an application is made to him for the extension of a patent according to said eighteenth section, and sixty days' notice given thereof, he shall refer the case to the principal examiner having charge of the class of inventions to which said case belongs, who shall make a full report to said commissioner of the said case, and particularly whether the invention or improvement secured in the patent was new and patentable when patented; and thereupon the said commissioner shall grant or refuse the extension of said patent, upon the same principles and rules that have governed said board; but no patent shall be extended for a longer term than seven years.

SECTION 2. [See act of 1861, ch. 88, § 10.] *And be it further enacted*, That hereafter the Commissioner of Patents shall require a fee of one dollar for recording any assignment, grant, or conveyance of the whole or any part of the interest in letters-patent, or power of attorney, or license to make or use the thing patented, when such instrument shall not exceed three hundred words; the sum of two dollars when it shall exceed three hundred and shall not exceed one thousand words; and the sum of three dollars when it shall exceed one thousand words; which fees shall in all cases be paid in advance.

SECTION 3. *And be it further enacted*, That there shall be appointed, in manner aforesaid, two clerks, to be employed in copying and recording, and in other services in the Patent Office, who shall each be paid a salary of one thousand two hundred dollars per annum.

SECTION 4. *And be it further enacted*, That the Commissioner of Patents is hereby authorized to send by mail, free of postage, the annual reports of the Patent Office, in the same manner in which he is empowered to send letters and packages relating to the business of the Patent Office.

Approved May 27, 1848.

## ACT OF 1849, CHAPTER 108.

9 STATUTES AT LARGE, 395.

Extract from the Act entitled "An Act to establish the Home Department, and to provide for the Treasury Department an Assistant Secretary of the Treasury and a Commissioner of the Customs."

SECTION 2. *And be it further enacted,* That the Secretary of the Interior shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents, now exercised by the Secretary of State; and the said Secretary of the Interior shall sign all requisitions for the advance or payment of money out of the Treasury on estimates or accounts, subject to the same adjustment or control now exercised on similar estimates or accounts by the First or Fifth Auditor and First Comptroller of the Treasury.

Approved March 3, 1849.

## ACT OF 1852, CHAPTER 107.

10 STATUTES AT LARGE, 75.

An Act in addition to "An Act to promote the progress of the useful arts."

SECTION 1. [See act of 1839, ch. 88, § 11.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That appeals provided for in the eleventh section of the act entitled An act in addition to an act to promote the progress of the useful arts, approved March the third, eighteen hundred and thirty-nine, may also be made to either of the assistant judges of the Circuit Court of the District of Columbia, and all the powers, duties, and responsibilities imposed by the aforesaid act, and conferred upon the chief judge, are hereby imposed and conferred upon each of the said assistant judges.

SECTION 2. *And be it further enacted,* That in case appeal shall be made to the said chief judge, or to either of the said assistant judges, the Commissioner of Patents shall pay to such chief judge or assistant judge the sum of twenty-five dollars, required to be paid by the appellant into the Patent Office by the eleventh section of said act, on said appeal.

SECTION 3. *And be it further enacted,* That section thirteen of the aforesaid act, approved March the third, eighteen hundred and thirty-nine, is hereby repealed.

Approved August 30, 1852.

## ACT OF 1859, CHAPTER 80.

11 STATUTES AT LARGE, 422.

Extract from "An Act making appropriations for the legislative, executive, and judicial expenses of the government," &c.

SECTION 4. *And be it further enacted,* That the Secretary of the Interior be, and he is hereby, directed to cause the annual report of the Commissioner of Patents on mechanics hereafter to be made to the Senate and House of Representatives to be prepared and submitted in such manner as that the plates and drawings necessary to illustrate each subject shall be inserted so as to comprise the entire report in one volume not to exceed eight hundred pages.

Approved March 3, 1859.

## ACT OF 1861, CHAPTER 37.

12 STATUTES AT LARGE, 130.

An Act to extend the right of appeal from the decisions of Circuit Courts to the Supreme Court of the United States.

SECTION 1. [See act of 1836, ch. 357, § 17.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That from all judgments and decrees of any Circuit Court rendered in any action, suit, controversy, or case, at law or in equity, arising under any law of the United States granting or confirming to authors the exclusive right to their respective writings, or to inventors the exclusive right to their inventions or discoveries, a writ of error or appeal, as the case may require, shall lie, at the instance of either party, to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of such Circuit Courts, without regard to the sum or value in controversy in the action.

Approved February 18, 1861.

## ACT OF 1861, CHAPTER 88.

12 STATUTES AT LARGE, 246.

An Act in addition to "An Act to promote the progress of the useful arts."

SECTION 1. [See act of 1839, ch. 88, § 12.] *Be it enacted by the Senate and House of Representatives of the United States of America*

*in Congress assembled*, That the Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any justice of the peace, or other officer authorized by law to take depositions to be used in the courts of the United States, or in the State courts of any State where such officer shall reside; and in any contested case pending in the Patent Office it shall be lawful for the clerk of any court of the United States for any district or territory, and he is hereby required, upon the application of any party to such contested case, or the agent or attorney of such party, to issue subpoenas for any witnesses residing or being within the said district or territory, commanding such witnesses to appear and testify before any justice of the peace, or other officer as aforesaid, residing within the said district or territory, at any time and place in the subpoena to be stated; and if any witness, after being duly served with such subpoena, shall refuse or neglect to appear, or, after appearing, shall refuse to testify (not being privileged from giving testimony), such refusal or neglect being proved to the satisfaction of any judge of the court whose clerk shall have issued such subpoena, said judge may thereupon proceed to enforce obedience to the process, or to punish the disobedience in like manner as any court of the United States may do in case of disobedience to process of *subpcena ad testificandum* issued by such court; and witnesses in such cases shall be allowed the same compensation as is allowed to witnesses attending the courts of the United States: *Provided*, That no witness shall be required to attend at any place more than forty miles from the place where the subpoena shall be served upon him to give a deposition under this law: *Provided also*, That no witness shall be deemed guilty of contempt for refusing to disclose any secret invention made or owned by him: *And provided further*, That no witness shall be deemed guilty of contempt for disobeying any subpoena directed to him by virtue of this act, unless his fees for going to, returning from, and one day's attendance at the place of examination, shall be paid or tendered to him at the time of the service of the subpoena.

SECTION 2. *And be it further enacted*, That for the purposes of securing greater uniformity of action in the grant and refusal of letters-patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three examiners in chief, at an annual salary of three thousand dollars each, to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters-patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by

the commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners in chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents.

SECTION 3. *And be it further enacted,* That no appeal shall be allowed to the examiners in chief from the decisions of the primary examiners, except in interference cases, until after the application shall have been twice rejected; and the second examination of the application by the primary examiner shall not be had until the applicant, in view of the references given on the first rejection, shall have renewed the oath of invention, as provided for in the seventh section of the act entitled "An Act to promote the progress of the useful arts, and to repeal all Acts and parts of Acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six.

SECTION 4. *And be it further enacted,* That the salary of the Commissioner of Patents, from and after the passage of this act, shall be four thousand five hundred dollars per annum, and the salary of the chief clerk of the Patent Office shall be two thousand five hundred dollars, and the salary of the librarian of the Patent Office shall be eighteen hundred dollars.

SECTION 5. *And be it further enacted,* That the Commissioner of Patents is authorized to restore to the respective applicants, or when not removed by them, to otherwise dispose of such of the models belonging to rejected applications as he shall not think necessary to be preserved. The same authority is also given in relation to all models accompanying applications for designs. He is further authorized to dispense in future with models of designs when the design can be sufficiently represented by a drawing.

SECTION 6. [Repealing act of 1837, § 10.] *And be it further enacted,* That the tenth section of the act approved the third of March, eighteen hundred and thirty-seven, authorizing the appointment of agents for the transportation of models and specimens to the Patent Office, is hereby repealed.

SECTION 7. *And be it further enacted,* That the commissioner is further authorized, from time to time, to appoint, in the manner already provided for by law, such an additional number of principal examiners, first assistant examiners, and second assistant examiners as may be required to transact the current business of the office with despatch, provided the whole number of additional examiners shall not exceed four of each class, and that the total annual expenses of the Patent Office shall not exceed the annual receipts.

SECTION 8. *And be it further enacted,* That the commissioner may require all papers filed in the Patent Office, if not correctly, legibly,

and clearly written, to be printed at the cost of the parties filing such papers; and for gross misconduct he may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons of the commissioner for such refusal shall be duly recorded, and be subject to the approval of the President of the United States.

SECTION 9. [See act of 1836, ch. 357, §§ 7, 12, 13.] *And be it further enacted*, That no money paid as a fee, on any application for a patent after the passage of this act, shall be withdrawn or refunded, nor shall the fee paid on filing a caveat be considered as part of the sum required to be paid on filing a subsequent application for a patent for the same invention. That the three months' notice given to any caveator, in pursuance of the requirements of the twelfth section of the act of July fourth, eighteen hundred and thirty-six, shall be computed from the day on which such notice is deposited in the post-office at Washington, with the regular time for the transmission of the same added thereto, which time shall be intorsed on the notice; and that so much of the thirteenth section of the act of Congress, approved July fourth, eighteen hundred and thirty-six, as authorizes the annexing to letters-patent of the description and specification of additional improvements is hereby repealed, and in all cases where additional improvements would now be admissible, independent patents must be applied for.

SECTION 10. *And be it further enacted*, That all laws now in force fixing the rates of the Patent Office fees to be paid, and discriminating between the inhabitants of the United States and those of other countries, which shall not discriminate against the inhabitants of the United States, are hereby repealed, and in their stead the following rates are established:—

On filing each caveat, ten dollars.

On filing each original application for a patent, except for a design, fifteen dollars.

On issuing each original patent, twenty dollars.

On every appeal from the examiner in chief to the commissioner, twenty dollars.

On every application for the reissue of a patent, thirty dollars.

On every application for the extension of a patent, fifty dollars; and fifty dollars in addition, on the granting of every extension.

On filing each disclaimer, ten dollars.

For certified copies of patents and other papers, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, and other papers, of three hundred words or under, one dollar.

For recording every assignment, and other papers, over three hundred and under one thousand words, two dollars.

For recording every assignment or other writing, if over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making the same.

SECTION 11. [See act of 1842, ch. 263, § 3.] *And be it further enacted*, That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who, by his, her, or their own industry, genius, efforts, and expense may have invented or produced any new and original design, or a manufacture, whether of metal or other material or materials, and original design for a bust, statue, or bas-relief, or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell, and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application, in writing, to the Commissioner of Patents, expressing such desire; and the commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent, for the term of three and one half years, or for the term of seven years, or for the term of fourteen years, as the said applicant may elect in his application: *Provided*, That the fee to be paid in such application shall be for the term of three years and six months, ten dollars, for seven years, fifteen dollars, and for fourteen years, thirty dollars: *And provided*, That the patentees of designs under this act shall be entitled to the extension of their respective patents for the term of seven years, from the day on which said patent shall expire, upon the same terms and restrictions as are now provided for the extension of letters-patent.

SECTION 12. [See act of 1836, ch. 357, § 18.] *And be it further enacted*, That all applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and in default thereof they shall be regarded as abandoned by the parties thereto; unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable; and all applications now pending shall be treated as if filed after the passage of this act, and all applications for the extension of patents shall be filed at least ninety days before the expiration thereof; and notice of the day set for the hearing of the case shall be published, as now required by law, for at least sixty days.



SECTION 13. [See act of 1842, ch. 263, § 6.] *And be it further enacted,* That in all cases where an article is made or vended by any person under the protection of letters-patent, it shall be the duty of such person to give sufficient notice to the public that said article is so patented, either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article patented, that may be impracticable, by enveloping one or more of the said articles, and affixing a label to the package, or otherwise attaching thereto a label on which the notice, with the date, is printed; on failure of which, in any suit for the infringement of letters-patent by the party failing so to mark the article the right to which is infringed upon, no damage shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued after such notice to make or vend the article patented. And the sixth section of the act entitled "An Act in addition to an Act to promote the progress of the useful arts," and so forth, approved the twenty-ninth day of August, eighteen hundred and forty-two, be, and the same is hereby, repealed.

SECTION 14. [See act of 1862, ch. 182.] *And be it further enacted,* That the Commissioner of Patents be, and he is hereby, authorized to print, or in his discretion to cause to be printed, ten copies of the description and claims of all patents which may hereafter be granted, and ten copies of the drawings of the same, when drawings shall accompany the patents: *Provided,* The cost of printing the text of said descriptions and claims shall not exceed, exclusive of stationery, the sum of two cents per hundred words for each of said copies, and the cost of the drawing shall not exceed fifty cents per copy; one copy of the above number shall be printed on parchment to be affixed to the letters-patent; the work shall be under the direction, and subject to the approval, of the Commissioner of Patents, and the expense of the said copies shall be paid for out of the patent fund.

SECTION 15. *And be it further enacted,* That printed copies of the letters-patent of the United States, with the seal of the Patent Office affixed thereto and certified and signed by the Commissioner of Patents, shall be legal evidence of the contents of said letters-patent in all cases.

SECTION 16. [See act of 1836, ch. 357, §§ 5, 18.] *And be it further enacted,* That all patents hereafter granted shall remain in force for the term of seventeen years from the date of issue; and all extension of such patents is hereby prohibited.

SECTION 17. *And be it further enacted,* That all acts and parts of acts heretofore passed, which are inconsistent with the provisions of this act, be, and the same are hereby, repealed.

Approved March 2, 1861.

## ACT OF 1862, CHAPTER 182.

12 STATUTES AT LARGE, 583.

An Act making supplemental appropriations for sundry civil expenses, &c.

SECTION 4. [See act of 1861, ch. 88, § 14.] For the fund of the Patent Office, fifty thousand eight hundred and fifty-five dollars and forty-nine cents, to supply a deficiency existing under the act of March second, eighteen hundred and sixty-one, entitled "An Act in addition to an Act to promote the progress of the useful arts": *Provided*, That the fourteenth section of said act be, and the same is hereby, repealed.

Approved July 16, 1862.

## ACT OF 1863, CHAPTER 102.

12 STATUTES AT LARGE, 796.

An Act to amend an Act entitled "An Act to promote the progress of the useful arts."

SECTION 1. [See act of 1836, ch. 357, § 7.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That so much of section seven of the act entitled "An Act to promote the progress of the useful arts," approved July fourth, eighteen hundred and thirty-six, as requires a renewal of the oath, be, and the same is hereby, repealed.

SECTION 2. *And be it further enacted*, That, whereas the falling off of the revenue of the Patent Office required a reduction of the compensation of the examiners and clerks, or other employees in the office, after the thirty-first day of August, eighteen hundred and sixty-one, that the Commissioner of Patents be, and he is hereby, authorized, whenever the revenue of the office will justify him in so doing, to pay them such sums, in addition to what they shall already have received, as will make their compensation the same as it was at that time.

SECTION 3. [See act of 1864, ch. 159.] *And be it further enacted*, That every patent shall be dated as of a day not later than six months after the time at which it was passed and allowed, and notice thereof sent to the applicant or his agent. And if the final fee for such patent be not paid within the said six months, the patent shall be withheld, and the invention therein described shall become public property as against the applicant therefor: *Provided*, That in all cases where patents have been allowed previous to the passage of this act, the said six months shall be reckoned from the date of such passage.

Approved March 3, 1863.

## ACT OF 1864, CHAPTER 159.

13 STATUTES AT LARGE, 194.

An Act amendatory of "An Act to amend an Act entitled an Act to promote the progress of the useful arts," approved March three, eighteen hundred and sixty-three.

[See act of 1863, ch. 102, § 3.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That any person having an interest in an invention, whether as the inventor or assignee, for which a patent was ordered to issue upon the payment of the final fee, as provided in section three of an act approved March three, eighteen hundred and sixty-three, but who has failed to make payment of the final fee, as provided by said act, shall have the right to make the payment of such fee, and receive the patent withheld on account of the non-payment of said fee, provided such payment be made within six months from the date of the passage of this act: *Provided,* That nothing herein shall be so construed as to hold responsible in damages any persons who have manufactured or used any article or thing for which a patent, as aforesaid, was ordered to be issued.

Approved June 25, 1864.

## ACT OF 1865, CHAPTER 112.

13 STATUTES AT LARGE, 533.

An Act amendatory of "An Act to amend an Act entitled An Act to promote the progress of the useful arts," approved March three, eighteen hundred and sixty-three.

[See act of 1863, ch. 102, § 3.] *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That any person having an interest in an invention, whether as inventor or assignee, for which a patent was ordered to issue upon the payment of the final fee, as provided in section three of an act approved March three, eighteen hundred and sixty-three, but who has failed to make payment of the final fee, as provided in said act, shall have the right to make an application for a patent for his invention, the same as in the case of an original application, provided such application be made within two years after the date of the allowance of the original application: *Provided,* That nothing herein shall be so construed as to hold responsible in damages any persons who have manufactured or used any article or thing for which a patent aforesaid was ordered to

issue. This act shall apply to all cases now in the Patent Office, and also to such shall hereafter be filed. And all acts or parts of acts inconsistent with this act are hereby repealed.

Approved March 3, 1865.

### ACT OF JULY 8, 1870, CHAPTER 230.

An Act to revise, consolidate, and amend the Statutes relating to Patents and Copyrights.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be attached to the Department of the Interior the office, heretofore established, known as the Patent Office, wherein all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved.

SECTION 2. *And be it further enacted,* That the officers and employees of said office shall continue to be: one commissioner of patents, one assistant commissioner, and three examiners-in-chief, to be appointed by the President, by and with the advice and consent of the Senate; one chief clerk, one examiner in charge of interferences, twenty-two principal examiners, twenty-two first assistant examiners, twenty-two second assistant examiners, one librarian, one machinist, five clerks of class four, six clerks of class three, fifty clerks of class two, forty-five clerks of class one, and one messenger and purchasing clerk, all of whom shall be appointed by the Secretary of the Interior, upon nomination of the Commissioner of Patents.

SECTION 3. *And be it further enacted,* That the Secretary of the Interior may also appoint, upon like nomination, such additional clerks of classes two and one, and of lower grades, copyists of drawings, female copyists, skilled laborers, laborers and watchmen, as may be from time to time appropriated for by Congress.

SECTION 4. *And be it further enacted,* That the annual salaries of the officers and employees of the Patent Office shall be as follows:—

Of the commissioner of patents, four thousand five hundred dollars.

Of the assistant commissioner, three thousand dollars.

Of the examiners-in-chief, three thousand dollars each.

Of the chief clerk, two thousand five hundred dollars.

Of the examiner in charge of interferences, two thousand five hundred dollars.

Of the principal examiners, two thousand five hundred dollars each.

Of the first assistant examiners, one thousand eight hundred dollars each.

Of the second assistant examiners, one thousand six hundred dollars each.

Of the librarian, one thousand eight hundred dollars.

Of the machinist, one thousand six hundred dollars.

Of the clerks of class four, one thousand eight hundred dollars each.

Of the clerks of class three, one thousand six hundred dollars each.

Of the clerks of class two, one thousand four hundred dollars each.

Of the clerks of class one, one thousand two hundred dollars each.

Of the messenger and purchasing clerk, one thousand dollars.

Of laborers and watchmen, seven hundred and twenty dollars each.

Of the additional clerks, copyists of drawings, female copyists, and skilled laborers, such rates as may be fixed by the acts making appropriations for them.

SECTION 5. *And be it further enacted,* That all officers and employees of the Patent Office shall, before entering upon their duties, make oath or affirmation truly and faithfully to execute the trusts committed to them.

SECTION 6. *And be it further enacted,* That the commissioner and chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their duties, and that they will render to the proper officers of the treasury a true account of all money received by virtue of their office.

SECTION 7. *And be it further enacted,* That it shall be the duty of the commissioner, under the direction of the Secretary of the Interior, to superintend or perform all the duties respecting the granting and issuing of patents which herein are, or may hereafter be, by law directed to be done; and he shall have charge of all books, records, papers, models, machines, and other things belonging to said office.

SECTION 8. *And be it further enacted,* That the commissioner may send and receive by mail, free of postage, letters, printed matter, and packages relating to the business of his office, including Patent Office reports.

SECTION 9. *And be it further enacted,* That the commissioner shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents; an alphabetical list of the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public.

SECTION 10. *And be it further enacted,* That the examiners-in-chief shall be persons of competent legal knowledge and scientific ability,

whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and when required by the commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

SECTION 11. *And be it further enacted,* That in case of the death, resignation, absence, or sickness of the commissioner, his duties shall devolve upon the assistant commissioner until a successor shall be appointed, or such absence or sickness shall cease.

SECTION 12. *And be it further enacted,* That the commissioner shall cause a seal to be provided for said office, with such device as the President may approve, with which all records or papers issued from said office, to be used in evidence, shall be authenticated.

SECTION 13. *And be it further enacted,* That the commissioner shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in said office; and said rooms and galleries shall be kept open during suitable hours for public inspection.

SECTION 14. *And be it further enacted,* That the commissioner may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the treasury, as other patent moneys are directed to be paid.

SECTION 15. *And be it further enacted,* That there shall be purchased, for the use of said office, a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated by Congress for that purpose.

SECTION 16. *And be it further enacted,* That all officers and employees of the Patent Office shall be incapable, during the period for which they shall hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by said office.

SECTION 17. *And be it further enacted,* That for gross misconduct the commissioner may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior.

SECTION 18. *And be it further enacted,* That the commissioner may require all papers filed in the Patent Office, if not correctly, legibly and clearly written, to be printed at the cost of the party filing them.

SECTION 19. *And be it further enacted,* That the commissioner, sub-

ject to the approval of the Secretary of the Interior, may from time to time establish rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

SECTION 20. *And be it further enacted*, That the commissioner may print or cause to be printed copies of the specifications of all letters-patent and of the drawings of the same, and copies of the claims of current issues, and copies of such laws, decisions, rules, regulations, and circulars as may be necessary for the information of the public.

SECTION 21. *And be it further enacted*, That all patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the commissioner, and they shall be recorded, together with the specification, in said office, in books to be kept for that purpose.

SECTION 22. *And be it further enacted*, That every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the said invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof; and a copy of said specifications and of the drawings shall be annexed to the patent and be a part thereof.

SECTION 23. *And be it further enacted*, That every patent shall date as of a day not later than six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent; and if the final fee shall not be paid within that period, the patent shall be withheld.

SECTION 24. *And be it further enacted*, That any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented, or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the duty required by law, and other due proceedings had, obtain a patent therefor.

SECTION 25. *And be it further enacted*, That no person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country: *Provided*, The same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the

shortest term; but in no case shall it be in force more than seventeen years.

SECTION 26. *And be it further enacted,* That before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the commissioner, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery; and said specification and claim shall be signed by the inventor and attested by two witnesses.

SECTION 27. *And be it further enacted,* That when the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of said drawings, to be furnished by the Patent Office, shall be attached to the patent as part of the specification.

SECTION 28. *And be it further enacted,* That when the invention or discovery is of a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment.

SECTION 29. *And be it further enacted,* That in all cases which admit of representation by model, the applicant, if required by the commissioner, shall furnish one of convenient size to exhibit advantageously the several parts of his invention or discovery.

SECTION 30. *And be it further enacted,* That the applicant shall make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. And said oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, *chargé d'affaires*, consul, or commercial agent, holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be.

SECTION 31. *And be it further enacted,* That on the filing of any such application and the payment of the duty required by law, the



commissioner shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor.

SECTION 32. *And be it further enacted,* That all applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the commissioner that such delay was unavoidable.

SECTION 33. *And be it further enacted,* That patents may be granted and issued or reissued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specification sworn to by the inventor or discoverer; and also, if he be living, in case of an application for reissue.

SECTION 34. *And be it further enacted,* That when any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application shall be made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

SECTION 35. *And be it further enacted,* That any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who has failed to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application: *Provided,* That the second application be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent, as aforesaid, was ordered to issue, prior to the issue thereof: *And provided further,* That when an application for a patent has been rejected or withdrawn, prior to the passage of this act, the applicant shall have six months from the date of such passage to renew his appli-

ation, or to file a new one; and if he omit to do either, his application shall be held to have been abandoned. Upon the hearing of such renewed applications abandonment shall be considered as a question of fact.

SECTION 36. *And be it further enacted,* That every patent or any interest therein shall be assignable in law, by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States; and said assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof.

SECTION 37. *And be it further enacted,* That every person who may have purchased of the inventor, or with his knowledge and consent may have constructed any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or sold or used one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.

SECTION 38. *And be it further enacted,* That it shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented, either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented.

SECTION 39. *And be it further enacted,* That if any person shall, in any manner, mark upon any thing made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor, without the consent of such patentee, or his assigns or legal representatives; or shall in any manner mark upon or affix to any such patented article the word "patent" or "patentee," or the words "letters-patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or shall in any manner mark upon or affix to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, he shall be liable for every such offence

to a penalty of not less than one hundred dollars, with costs; one moiety of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offence may have been committed.

SECTION 40. *And be it further enacted,* That any citizen of the United States, who shall have made any new invention or discovery, and shall desire further time to mature the same, may, on payment of the duty required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention; and such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application shall be made within the year by any other person for a patent with which such caveat would in any manner interfere, the commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person filing the caveat, who, if he would avail himself of his caveat, shall file his description, specifications, drawings, and model within three months from the time of placing said notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto, which time shall be indorsed on the notice. And an alien shall have the privilege herein granted, if he shall have resided in the United States one year next preceding the filing of his caveat, and made oath of his intention to become a citizen.

SECTION 41. *And be it further enacted,* That whenever, on examination, any claim for a patent is rejected for any reason whatever, the commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant shall persist in his claim for a patent, with or without altering his specifications, the commissioner shall order a re-examination of the case.

SECTION 42. *And be it further enacted,* That whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who shall be adjudged the prior inventor, unless the adverse party shall appeal from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe.

SECTION 43. *And be it further enacted,* That the commissioner may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides.

SECTION 44. *And be it further enacted,* That the clerk of any court of the United States, for any district or territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or his agent or attorney, issue [a] subpoena for any witness residing or being within said district or territory, commanding him to appear and testify before any officer in said district or territory authorized to take depositions and affidavits, at any time and place in the subpoena stated; and if any witness, after being duly served with such subpoena, shall neglect or refuse to appear, or after appearing shall refuse to testify, the judge of the court whose clerk issued the subpoena, may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience as in other like cases.

SECTION 45. *And be it further enacted,* That every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States, but no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him, nor be deemed guilty of contempt for disobeying such subpoena, unless his fees and travelling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself.

SECTION 46. *And be it further enacted,* That every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interference[s], in such case to the board of examiners-in-chief, having once paid the fee for such appeal provided by law.

SECTION 47. *And be it further enacted,* That if such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the duty required by law, appeal to the commissioner in person.

SECTION 48. *And be it further enacted,* That if such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

SECTION 49. *And be it further enacted,* That when an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

SECTION 50. *And be it further enacted,* That it shall be the duty of said court, on petition, to hear and determine such appeal, and to revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint, notifying the commissioner of the time and place of hearing; and the revision shall be confined to the points set forth in the reasons of appeal. And after hearing the case, the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SECTION 51. *And be it further enacted,* That on receiving notice of the time and place of hearing such appeal, the commissioner shall notify all parties who appear to be interested therein in such manner as the court may prescribe. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the commissioner shall furnish it with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the commissioner and the examiners may be examined under oath, in explanation of the principles of the machine or other thing for which a patent is demanded.

SECTION 52. *And be it further enacted,* That whenever a patent on application is refused, for any reason whatever, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

SECTION 53. *And be it further enacted,* That whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraud-

ulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or assignment of the whole or any undivided part of the original patent, to his executors, administrators, or assigns, for the unexpired part of the term of the original patent, the surrender of which shall take effect upon the issue of the amended patent; and the commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters-patent. And the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. And the patent so reissued, together with the corrected specification, shall have the effect and operation in law, on the trial of all actions for causes thereafter arising, as though the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

SECTION 54. *And be it further enacted,* That whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the duty required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; said disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

SECTION 55. *And be it further enacted,* That all actions, suits, controversies, and cases arising under the patent laws of the United States shall be originally cognizable, as well in equity as at law, by the circuit

courts of the United States, or any district court having the powers and jurisdiction of a circuit court, or by the Supreme Court of the District of Columbia, or of any territory; and the court shall have power, upon bill in equity filed by any party aggrieved, to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the *claimant* [complainant] shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction, and the court shall have the same powers to increase the same in its discretion that are given by this act to increase the damages found by verdicts in actions upon the case; but all actions shall be brought during the term for which the letters-patent shall be granted or extended, or within six years after the expiration thereof.

SECTION 56. *And be it further enacted*, That a writ of error or appeal to the Supreme Court of the United States shall lie from all judgments and decrees of any circuit court, or of any district court exercising the jurisdiction of a circuit court, or of the Supreme Court of the District of Columbia, or of any territory, in any action, suit, controversy, or case, at law or in equity, touching patent rights, in the same manner and under the same circumstances as in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy.

SECTION 57. *And be it further enacted*, That written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters-patent under the signature of the commissioner or acting commissioner, with the seal of office affixed, shall be competent evidence in all cases wherein the originals could be evidence, and any person making application therefor, and paying the fee required by law, shall have certified copies thereof. And copies of the specifications and drawings of foreign letters-patent, certified in like manner, shall be *primâ facie* evidence of the fact of the granting of such foreign letters-patent, and of the date and contents thereof.

SECTION 58. *And be it further enacted*, That whenever there shall be interfering patents, any person interested in any one of such interfering patents, or in the working of the invention claimed under either of such patents, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court having cognizance thereof, as hereinbefore provided, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the

interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the rights of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

SECTION 59. *And be it further enacted,* That damages for the infringement of any patent may be recovered by action on the case in any circuit court of the United States, or district court exercising the jurisdiction of a circuit court, or in the Supreme Court of the District of Columbia, or of any territory, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict shall be rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

SECTION 60. *And be it further enacted,* That whenever, through inadvertence, accident, or mistake, and without any wil[1]ful default or intent to defraud or mislead the public, a 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 original and first inventor or discoverer as aforesaid, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was *bonâ fide* his own, provided it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the parts so claimed, without right as aforesaid, notwithstanding the specifications may embrace more than that of which the patentee was the original or first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit; nor shall he be entitled to the benefits of this section if he shall have unreasonably neglected or delayed to enter said disclaimer.

SECTION 61. *And be it further enacted,* That in any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:—

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,



Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country, for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defences may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

SECTION 62. *And be it further enacted,* That whenever it shall appear that the patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.

SECTION 63. *And be it further enacted,* That where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of his patent beyond the original term of its limitation, he shall make application therefor, in writing, to the commissioner, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of said invention or discovery. And said application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of said original term.

SECTION 64. *And be it further enacted,* That upon the receipt of such application, and the payment of the duty required by law, the commissioner shall cause to be published in one newspaper in the city of Washington, and in such other papers published in the section of the country most interested adversely to the extension of the patent

as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted.

SECTION 65. *And be it further enacted,* That on the publication of such notice, the commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make to said commissioner a full report of the case, and particularly whether the invention or discovery was new and patentable when the original patent was granted.

SECTION 66. *And be it further enacted,* That the commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence produced, both for and against the extension; and if it shall appear to his satisfaction that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery, a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the said commissioner shall make a certificate thereon, renewing and extending the said patent for the term of seven years from the expiration of the first term, which certificate shall be recorded in the Patent Office, and thereupon the said patent shall have the same effect in law as though it had been originally granted for twenty-one years.

SECTION 67. *And be it further enacted,* That the benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented to the extent of their interest therein.

SECTION 68. *And be it further enacted,* That the following shall be the rates for patent fees:—

On filing each original application for a patent, fifteen dollars.

On issuing each original patent, twenty dollars.

On filing each caveat, ten dollars.

On every application for the reissue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from the primary examiners to the examiners-in-chief, ten dollars.

On every appeal from the examiners-in-chief to the commissioner, twenty dollars.

For certified copies of patents and other papers, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar; of over three

hundred and under one thousand words, two dollars; of over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making them.

SECTION 69. *And be it further enacted,* That patent fees may be paid to the commissioner, or to the treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor. And all money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the treasury as received, without any deduction whatever; and all disbursements for said office shall be made by the disbursing clerk of the Interior Department.

SECTION 70. *And be it further enacted,* That the Treasurer of the United States is authorized to pay back any sum or sums of money to any person who shall have paid the same into the treasury, or to any receiver or depositary, to the credit of the treasurer, as for fees accruing at the Patent Office through mistake, certificate thereof being made to said treasurer by the Commissioner of Patents.

SECTION 71. *And be it further enacted,* That any person who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of wool[en], silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the duty required by law, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.

SECTION 72. *And be it further enacted,* That the commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.

SECTION 73. *And be it further enacted,* That patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

SECTION 74. *And be it further enacted,* That patentees of designs issued prior to March two, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries issued prior to the second day of March, eighteen hundred and sixty-one.

SECTION 75. *And be it further enacted,* That the following shall be the rates of fees in design cases:—

For three years and six months, ten dollars.

For seven years, fifteen dollars.

For fourteen years, thirty dollars.

For all other cases in which fees are required, the same rates as in cases of inventions or discoveries.

SECTION 76. *And be it further enacted,* That all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries, not inconsistent with the provisions of this act, shall apply to patents for designs.

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# GENERAL INDEX.

# GENERAL INDEX.

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N.B. — The references are to the Sections, unless indicated by the abbreviation p., which refers to the page.

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## A.

ABANDONMENT OF EXPERIMENTS, 85–97.

(See EXPERIMENTS.)

ABANDONMENT OF INVENTION,

*before* application for letters-patent, 102, 103.

what is described, but not claimed as new, presumptively abandoned, 117.

matter of defence, 381. (See ACTION AT LAW; EQUITY.)

pleadable, by statute, under General Issue, 382.

how shown against patentee, 383–385.

how far intention of patentee material, to show, 386–388.

no particular length of time required to show, 385.

not shown by mere public experiment on part of patentee, 389.

use for purposes of gain must be shown, 389.

even a profitable public experiment not necessarily an, 389.

piratical user by parties to whom patentee has intrusted his knowledge,  
no, 391.

how affected by special statutory provision, 392–395.

public use by inventor within two years preceding grant of letters-patent,  
no, 393, 394.

by filing an imperfect specification, 395 *a*.

*after* grant of letters-patent, 440. (See EQUITY.)

ACCIDENT, (See also MISTAKE.)

may lead to invention or discovery, 32.

ACCOUNT, (See also EQUITY.)

generally ordered, where patentee sent to law, 426.

ACTION AT LAW,

action on the case, a remedy for infringement, 344.

one suit for repeated infringements, 353.

PARTIES *by* whom brought, 345.

when in name of grantee, 346.

when by patentee in behalf of licensee, 346.

when by assignee alone, 347.

when by patentee and assignee jointly, 347.

discrepancy between English and American decisions, 347.

in name of patentee, where only an agreement to assign, 347.

*against* whom brought, 346.

**ACTION AT LAW, — Continued.**

against one joint-owner by the other (*see* 405 *a*), 346.

against a corporation, 347.

against a covenantee, by administrator under an extension, 348.

**DECLARATION** in, must show title in plaintiff, 349.

must aver plaintiff to be "the original and first inventor," 350.

must aver patent to be "new and useful," not known or used before plaintiff's invention, &c., 350.

need not aver the specific time when invention was made, 350.

need not set forth the description as given in the specification, 352.

must aver citizenship, *quære*, 351.

must aver that letters-patent were obtained in due form, 351.

but need not set forth all the steps, 351.

must aver value of patent right, 353.

breach by defendant and damages to plaintiff, 353.

need not set forth the particular acts complained of as infringing, 353.

should set forth the substance of the invention, 352.

must make profert of the letters-patent, 352.

must show breach before action brought, 353.

not demurrable, if commencing in *trespass* and concluding in *debt*, 353.

by assignee, must allege patentee's title, his own, and due recording of assignment, 354.

omission to allege recording of assignment, when cured by verdict, 354.

**PLEADINGS AND DEFENCES**, statutory provisions for, 356-358.

under *General Issue without Notice*,

defendant may show that he does not infringe, 360.

that he acts under license from patentee, 360.

that plaintiff is an alien and not entitled to patent, 360.

that he has no good title as assignee, 360.

that letters-patent were not duly issued, 360.

that the invention is not patentable, 361.

that the specification is not intelligible as to the invention, 363.

that patentee had direct knowledge of foreign invention (?), 372.

under *General Issue with Notice*,

defendant may show fraudulent concealment or addition in specification, 365-368.

want of novelty, 369-380 *a*.

prior dedication to the public, 381-395.

that patent was surreptitiously obtained, 396, 397.

that the patentee (being an alien) has neglected to put his invention in public use, 398.

*apart* from *General Issue* defendant may plead specially a surrender of the patent since suit begun, 399.

**ADDITIONS**

to patented inventions, now applied for by independent patents, 280.

**ADMINISTRATORS AND EXECUTORS,**

have same right to apply for and hold a patent that the inventor had, 177.

may amend or surrender specification, 286, 287.

**AFFIDAVIT,**

in support of motion for injunction, 406, 408.  
when read supplementally, 443.

**AFFIRMATION,** (See OATH.)

when substituted for oath, p. 576, § 13.

**ALIENS**

may take out patent in U. S., p. 564, § 8; p. 577, § 6; p. 580, § 3;  
p. 588, § 11.  
may file caveat, p. 566, § 12; p. 587, §§ 9, 10.

**ALTERATION,**

very slight, but productive of beneficial result, subject of a patent, 11.  
of SPECIFICATION. (See AMENDMENT.)

**AMBIGUITY,**

in description of the invention, is fatal, 234.  
of claim, distinguishable from want of clear and sufficient description, 235.  
produced by introduction of things unnecessary, 236.  
produced by misuse of terms, 238.

**AMENDED PATENT,**

presumed to be for same invention as the original, 281.  
cannot cover a substantially different invention, 281.  
agreement to convey gives an equitable title, 284.  
relates back to commencement of original term, 284.  
enures to benefit of prior assignee, 284.

**AMENDMENT,** (See also DISCLAIMER.)

of specification, by disclaimer, 266, 267.  
by surrender and reissue, 279, 280.  
right of, does not authorize surrender of valid patents for fraudulent purposes, 281.  
may give an invalid patent validity, 281.  
right of, applies to extended patents, 281, 285.  
right of, gives patentee the power to retain whatever he deems proper, 283.

**ANALOGOUS USE.** (See APPLICATION; DOUBLE USE.)**APPEALS.** (See JURISDICTION.)**APPLICANT,**

who may be, for letters-patent, p. 562, § 6; p. 564, § 8; p. 577, § 6;  
p. 588, § 11.

**APPLICATION,** (See also PRINCIPLE.)

for letters-patent, in form of petition, 271.  
verified by oath, 272, 273.  
if granted, valid, although not verified, 274, 274 a.  
abandoned unless completed within two years, p. 588, § 12; 275 d.  
*analogous*, what is, 66.  
not analogous, where a new result is attained by discovery of a new property of matter, 67-69, 79.  
new, of an old process, held patentable, 10.  
analogous, of well-known machinery, not patentable, 49, 55 *et seq.*

**ART,**

definition of, as used in American statutes, 9.  
advantage of using the term in patent acts, 12.  
patented, how infringed, 304.



ARTS (LOST), 86 note, 93-97.

ARTICLE. (See PRODUCT.)

ASSIGNEE,

rights of, unaffected by a reissue, 197.

entitled to benefit of disclaimer, 210.

rights of, under extension or renewal, 206-209.

rights of, where the term is extended by special enactment, 206.

application by, for patent, 275 *e.*

ASSIGNMENT,

*before* letters-patent are obtained, 168.

confers an inchoate right, 169.

of an incomplete invention, only valid as a contract, 170.

legal formalities of, 171.

whether a particular instrument amounts to, 172, 173.

*after* letters-patent are obtained, regulated by statute, 178.

legal formalities of, 180.

various kinds of, 181.

distinction between, and license, 181.

recording clause interpreted, 181-183.

unrecorded, good except against purchaser for value and in good faith, 183.

*in general,*

implies no warranty of title, 184.

effect of recording a contract to convey inventions not *in esse*, 183, note.

of part of a patent, constitutes joint ownership but not *per se* partnership, 186.

agreement to convey interest in a future term not yet obtained, no, 195.

effect of agreement to assign, 194.

presumption, that nothing but present term assigned, 208, 209.

of exclusive rights within certain limits, what rights conferred by, 297.

by operation of law, e. g. bankruptcy, 174, 175.

ATTORNEY-GENERAL. (See REPEAL.)

## B.

BANKRUPTCY,

effect of, on an invention complete but not patented, 175.

whether creditors have the right to use bankrupt's patent, or merely to sell it, 176.

BILL IN EQUITY. (See EQUITY.)

## C.

CAVEAT,

for incomplete invention, 270.

not conclusive evidence of incompleteness of invention, 270.

CHANCERY. (See EQUITY.)

CHANGE,

produced by omitting a step in the process or an ingredient, 79-81.

**CHANGE, — Continued.**

*simply* of form or proportions, no invention, 39, 44.

a mere colorable, not patentable, 33.

utility of, tested by result, 34, 35.

even slight, may become the subject of a patent, 18.

**CHEAPNESS, (See also SUPERIORITY.)**

mere, of materials, disconnected with novelty of method, not patentable, 72, 73.

**CHEMICAL EQUIVALENTS. (See EQUIVALENTS; INFRINGEMENT.)****CIRCUIT COURT. (See JURISDICTION.)****CLAIM, (See also COURT.)**

object of, not to aid the description, but to ascertain what is claimed as new, 227.

a means of clearly presenting the subject-matter of the patent, 232.

must distinguish between the old and new, 230.

not presumed to cover well-known articles, 231.

need not describe in detail what is old, 233.

ambiguous, where it covers a whole class of subjects, only one of which answers, 234.

not ambiguous, where each method answers, 234 *a*.

for variations in application of a general principle, how to be made, 241.

must not be for an abstract principle, but for a principle embodied in a particular organism, 242, 244.

must be for a machine and not for a "principle," "mode of operation," &c., 242, 269, p. 264-266.

for an applied principle, will cover similar methods, 245-247.

for a combination, how determined, 249.

though clumsily worded, may cover both process and product, 295.

though too broad, does not prevent a subsequent patent by the same inventor, 117.

for a machine, will not cover a process, 12-14.

sufficiency of, decided by the court, 229.

**COMBINATION,**

what a technical, 111.

how claimed, 249.

how infringed. (See INFRINGEMENT.)

**COMMISSIONER (ACTING),**

recognized by law, 278.

action of, in granting reissue, conclusive, 282.

action of, in granting extension, conclusive, 287.

**COMPOSITION OF MATTER, (See MANUFACTURE.)**

in what it consists, 28.

what constitutes novelty of, 29.

novelty of, how determined, 47.

**CONCEALMENT (FRAUDULENT),**

or addition, vitiates letters-patent, 250.

**CONGRESS, (See also JURISDICTION.)**

may pass general or special laws in favor of inventors, 494.

may pass retrospective laws, 494.

**CONSTRUCTION,**

- of patent (claim), by the court, 222, 229, 235, 249.
- judged of by the jury, 222, 223, 235.
- to be liberal, 225, 231.
- principles of, 453, 456.
- of the specifications of several leading patents, 269.

**CONSTRUCTIVE USE,**

- whether infringement by, 292, 293.

**CONSUMPTION,**

- unauthorized, of patented article, an infringement, 301.

**CORRECTION,**

- of mistake in letters-patent, by whom made, 277.
- effect of, 277.

**CORPORATION**

- may be used for infringement, 347.

**COSTS,**

(*See also ACTION AT LAW.*)

- when given, although patentee fails to sustain his action, 372.
- not granted in case of delay in filing disclaimer, 379.

**COUNSEL FEES,**

- not included in damages, 341.

**COURT, (*See also ACTION AT LAW; EQUITY; JURISDICTION; JURY.*)**

- province of, to construe letters-patent, 222.
- to decide whether patentee's claim is explicit, 229.
- may sometimes pass upon the issue of novelty, 445.
- cannot compare two specifications and pronounce them identical, 446.
- to decide whether the invention is useful, i. e. not injurious, 450.
- whether the invention is frivolous, 451.
- to pass upon the claim, 447, 452.
- even where terms of art are used, 452.
- in construing, governed by what principles, 453-461.
- to decide whether invention is patentable, 468.

**D.****DAMAGES,**

- are actual, not vindictive, 337.
- may be trebled by the court, 337.
- are the amount of profits actually made by defendant, 338.
- not what he might have made with reasonable diligence, 338.
- in addition, all losses suffered by patentee through the piracy, 338.
- must be calculated, not guessed at, 338.
- general rule for estimating, note to p. 347, 348.
- for a patented improvement, how calculated, 338.
- not the same, whether patent be for the whole machine or only an improvement, 338.
- nominal, where merely making a machine is proved, 339, 340.
- do not include counsel fees, 341.

**DEATH**

- of inventor before taking out patent, p. 565, § 10.

**DECLARATION.**

(*See ACTION AT LAW.*)

**DEDICATION.** (See **ABANDONMENT OF INVENTION.**)

**DEFENCES.** (See **ACTION AT LAW; EQUITY.**)

**DESCRIPTION,** (See also **JURY.**)

sufficiency of, a question for the jury, 223, 253.

required by statute, 252.

must be sufficient for persons skilled in the art, 253.

must enable skilled workmen to apply without further invention of their own, 255.

must not omit any step or process which facilitates, 256.

faulty, which mentions no mode of removing injurious foreign matter, 257.

faulty, which omits to state where unusual ingredients may be procured, 258.

faulty, which mentions generally a class of substances, some of which do not answer, 258.

how it must state variable proportions of ingredients, 259.

need not explain what is well known, 260.

of a long and complicated process, construed liberally, 260.

invalidated by false statement, 260.

need not explain slight deviations, 261.

of machinery to be accompanied by drawings, 262.

and drawings, mutually explanatory, 262.

what constitutes a prior, 378.

contained in a prior patent, must, to defeat plaintiff's claim, be itself full and clear, 378 *a*.

not sufficient, that it contain a hint of the process, 378 *a*.

**DESIGNS,**

patentable under act of 1870, 29 *a*.

**DIRECTIONS.** (See **DESCRIPTION.**)

**DISCLAIMER,** (See also **AMENDMENT; ACTION AT LAW; COSTS.**)

allowed by statute, 373, 374.

mode of amending imperfect specification, 286.

merely strikes out what is disclaimed, and cannot be read in explanation of what remains, 267.

when allowed, and by whom to be made, 266, 267.

enures to benefit of assignees, 210.

**DISCOVERY,**

meaning of, judicially ascertained, 8.

**DISTRICT COURT.** (See **JURISDICTION.**)

**DISTRICT (JUDICIAL),**

in what, a suit must be brought, 497.

**DOUBLE USE,** (See also **APPLICATION.**)

of machine or process, how decided, 50-56.

examples of, 56 *et seq.*

**DRAWINGS,**

to accompany specifications of machines, 262.

form part of the specification, 262.

ordinarily need not be made on a scale, 263.

attested by inventor and two witnesses, 264.

## E.

- ENTIRETY.** (See **UNITY**).
- EQUITABLE TITLE,**  
how converted into a legal, 284.
- EQUITY,** (See also **JURISDICTION**.)  
court of, may restrain infringements by injunction, 400.  
grounds of jurisdiction of, 400.  
general principles of, regulating the granting of injunctions, 401.
- PARTIES** by whom a bill may be brought, 402.  
same in general as in actions at law, 402, 403.  
distinction in case of assignee for a particular district, 404, 405.  
*against* whom a bill may be brought, 438 *a*.  
*against* whom a bill may not be brought, 405 *a*.  
when injunction granted against a licensee, 438, 438 *a*.
- BILL** in, what it should contain, 406.  
should be sworn to, 406.  
omission of the oath no ground for demurrer, after a hearing, 406.  
how affected by subsequent surrender and reissue, 407.
- INJUNCTION**, on what principles granted, 408.  
application for, to be accompanied with an affidavit, 408, 442.  
denied in case of abandonment or laches, 439-441.  
notice must be served on defendant, 409.  
always special, 442.  
order of indemnity not usual, 409.  
when patentee must first establish his right by action at law, 410.  
rule laid down by Lord Eldon, 410.  
rule adopted by our courts, 411.  
three classes of cases under, 412.  
where no opposing evidence is offered, 413.  
during extended terms of an established patent, 413.  
when opposing evidence is offered, 414-422.  
where novelty is impeached by so-called publication in law, 418 *a*.  
where the question of infringement is doubtful, 419.  
effect of, on defendant's business an element for consideration, 420.  
where there is a full hearing, 423.  
when not granted *simpliciter*, what course taken, 424.  
when patentee first sent to law, 424.  
how affected by questions of time, exclusive possession, &c., 425.  
where there has been possession under a surrendered patent, 426.  
when granted, but patentee sent to law, 427.  
may be granted where the question of novelty is directly in issue, 429.  
*motion to dissolve*, how decided, 430.  
on what grounds, 437.  
when may be made, 430.  
after trial at law, 431.  
when ordered to stand over, 432.  
where new trial at law applied for, 432, 433.

**EQUITY, — Continued.**

**ACCOUNT OF PROFITS**, when ordered, 420, 434.

what comprised under, 436.

**INSPECTION**, when order of mutual, granted, 435.

Evidence when admitted supplementally, 443.

**EQUIVALENTS, (See also INFRINGEMENT.)**

use of *chemical* in the question of infringement, 343 *a*.

*mechanical*, not confined in the patent law to those strictly known as such in mechanics, 332.

**EVIDENCE, (See also ACTION AT LAW.)**

what amounts to, of use of a patented machine, 292, 293.

presumptive, of similarity of process, where the products are identical, 313.

what may be given in as, under the general issue, 359-398.

two kinds of, in a patent cause, 470.

of title, relates to what, 471.

conclusive, action of commissioner in granting a reissue, 471 *a*.

*prima facie*, of novelty and invention, 472.

negative, when to be offered by plaintiff, 473.

effect of such evidence, 474.

of novelty, plaintiff's own declarations, 475.

plaintiff's declarations inadmissible when made after an assignment, 475.

by patentee to show part of a combination useless, inadmissible, 476 *a*.

of damages, must be directly to the point, 476 *a*.

(See DAMAGES.)

of utility, to be offered by patentee, 477.

of sufficiency of the specification, 478.

who may give, as *experts*, 479.

general rules for determining, 479-485.

depends upon the subject-matter, 479, 482.

persons of ordinary skill, 479, 480.

persons thoroughly scientific, 481, 483, 484.

determined by the invention itself, 485.

principles of, as applied to the questions of identity, 487, 489.

of infringement by use of chemical equivalents, 343 *a*.

of experts, to be submitted to the jury under proper instructions, 488, 490.

of experts, admissible both to prove facts and to give opinions, 489.

for defendant, must be positive, 491.

and if credible, outweighs all negative evidence for the plaintiff, 491.

what persons competent to give, 492, 492 *a*.

when admitted in equity supplementally, 443.

**EXECUTORS. (See ADMINISTRATORS AND EXECUTORS.)****EXPERIMENTS,**

abandonment of, 85-97.

distinguished from invention, 87-91.

antecedent, by others, may be used by inventor, 378.

making a patented machine for the sake of, whether an infringement, *quære*, 291.

**EXPERTS,** (*See also EVIDENCE.*)

testimony of, when resorted to, 479-485.

who regarded as, 479-481.

depends on subject-matter, 483, 484.

practical workmen, 254.

**EXTENSION OF PATENT TERM,**

when and by whom granted formerly, 287.

action of commissioner in granting, not re-examinable, 287.

must now be by special act, 287.

term virtually extended to 16 (19) years (287), 395.

does not destroy the right to use a patented machine lawfully acquired, 198-200, 297.

rights of assignees under an, 198-210.

(*See ASSIGNEES; ASSIGNMENT.*)

during an, the specification may be surrendered and reissued, 285.

**F.****FEE-BILL,** 275.**FIRST INVENTOR,**

alone entitled to a patent, 82.

may be the discoverer of a lost art, 86, 93-97.

meaning of, in our statute, 86.

the expression, how construed in England, 88.

he who first adapts his invention to use, 88 note.

in a race of diligence, 91 note.

notwithstanding prior experiments, 91.

how far he may take suggestions from others, 120-123.

may use antecedent experiments, 278.

patentee must believe himself to be, 82.

**FOREIGNER.** (*See ALIEN.*)**FOREIGN INVENTION**

not patentable in this country, 98, 99.

**FOREIGN PATENT,**

when does not defeat a patent in this country, 98, 99.

**FRAUD**

in obtaining reissue, 282-282 *b.*

**FRIVOLOUS INVENTION.** (*See NOVELTY.*)**G.****GENERAL ISSUE,** (*See also ACTION AT LAW.*)

may be pleaded in an action for infringement, 356, 357.

defences under, without notice, 360-363.

requiring notice, 365-398.

**GRANTEE,** (*See also ASSIGNEE.*)

for particular district may bring an action in his own name, 346.

## I.

- IDENTITY,** (See also **INFRINGEMENT.**)  
of machines or of improvements thereon, 23.  
of two or more machines, explained generally, 305-307.  
question of, cannot be decided by fixed rules, 307.
- IMPROVEMENT,**  
of a machine already patented, itself patentable, 24.  
a test of novelty and sufficiency, 32-39.  
in a machine, how to be described and claimed, 233, 239, 240, 241.  
several, embraced under one patent, 108-110.  
subsequent, must now be applied for by a separate patent, 265, 280.  
subject of a patent, 8-19, 22.
- INCIDENTAL**  
production of a patented article no infringement, 300.
- INCOMPLETE INVENTION,**  
protected by caveat, 270.
- INFRINGEMENT,** (See also **ACTION AT LAW; DAMAGES; EQUITY.**)  
repealed, sued for in one action, 353.  
no, to use processes which patentee has kept back, 237.  
no, use of an American invention on a foreign vessel entering our ports,  
289.  
consists in making, using, or vending, 289.  
punishable by action at law, 288.  
of a patented machine, 290.  
no, to make patented machine as an experiment, 291.  
one contracting for articles to be made by a patented machine, an in-  
fringer, *quære*, 292.  
sale of the materials of a patented machine, no, 294.  
articles produced by patented machine, no, 295.  
where patent covers both process and product, the use of either an, 295.  
nonpayment of license-fee may be an, 297.  
no, to continue using a patented machine during an extension of the term,  
297.  
incidental production of a patented article not *per se* an, 300.  
by one who executes an order involving use of patented machine, 303.  
of a *machine*, what constitutes, 308.  
not determinable by fixed rules, 308.  
not a material alteration, 309.  
involves doctrine of mechanical equivalents, 310.  
jury to decide whether mechanical equivalents used, 310.  
by an equivalent which is itself patentable, 311.  
of a *manufacture*, a question of substantial identity, 312.  
of a *process*, presumed, if the effects be similar, 313, 314.  
of an applied *principle*, how determined, 316.  
a question of substantial identity, 320.  
examples of, 317-319.  
a mere variation in the mode, 322.  
a circuitous mode of accomplishing the same result, 323-327.



**INFRINGEMENT, — Continued.**

where the proportions of the ingredients are essential, no, to vary them, 328, 329.

superior utility a test of, 330.

a question of practical and substantial identity, 331.

of a *combination*, in what consists, 332.

may turn upon the use of mechanical equivalents, 332.

mechanical equivalents not merely those known as such in mechanics 333.

use of patented machine after a reissue, 342.

no, use of a machine before patent is granted, 342.

but such use continued after grant, is an, 342.

use of any one of several distinct improvements, 333.

where parts of a combination are novel, 332.

by use of chemical equivalents, 343 *a*.

**INJUNCTION, (See EQUITY.)**

bill for, what it should contain, 406.

on what principles granted, 408.

application for, to be accompanied with affidavit, 408, 442.

denied in cases of abandonment or laches, 439-441.

notice served on defendant, 409.

always special, 442.

order of indemnity not usual, 409.

rules for granting, before trial, 410, 411.

three classes of cases under, 412.

where novelty impeached by publication in law, 418 *a*.

where infringement doubtful, 419.

where defendant's business would be injured, 420.

on a full hearing, 423.

where patentee first sent to law, 424-426.

where granted, but patentee sent to law, 427.

granted where issue of novelty is directly raised, 429.

*motion to dissolve*, how decided, 430.

on what grounds, 437.

when may be made, 430.

after trial at law, 431.

order to stand over, 432.

when new trial at law has been applied for, 432, 433.

**INSPECTION,**

mutual, when ordered, 435.

**INTENTION,**

when material to show abandonment, 386-388.

**INTERFERING PATENTS. (See REPEAL.)****INVENTION, (See also FIRST INVENTOR; NOVELTY.)**

meaning of, judicially ascertained, 8.

sufficiency of, in what consists, 31-40.

frivolous, not the subject of a patent, 32, 33, 45.

does not consist in mere use of cheaper materials, 72, 73.

presumption that patentee is the inventor, 118.

not invalidated by reasons of hints or suggestions from others, 119.

**INVENTION, — Continued.**

belongs to the real inventor, even though he be in patentee's employ, 120.  
valid, even although patentee has been assisted in carrying out his plan,  
120-122.

of workman, whether patentable by employer without an assignment,  
*quære*, 123.

**J.****JOINT INVENTION,**

can be patented, 112-114.

effect of separate patents upon a subsequent joint patent, 113.

whether one of two joint inventors can take out letters in his own name  
alone, 114, 115.

**JOINT OWNERSHIP, (See ASSIGNMENT.)**

whether one co-tenant can sue the other for infringement, 188-190,  
405 *a*.

(See ACTION AT LAW; EQUITY.)

**JURISDICTION,**

of Congress, 494.

original, of Circuit and District Courts, 495.

appellate, of Supreme Court, 495.

of the Federal courts, exclusive, 496.

of the Federal courts does not extend to contracts under a patent, *per se*,  
496.

but may where the violation of a contract amounts to an infringement,  
496.

in what judicial district a suit to be brought, 497.

of the person, gives the right to enjoin violations in other districts, 296,  
498.

equity, irrespective of demand for injunction, 498.

appellate, of Supreme Court, not extended to mere costs, 499.

**JURY, (See also COURT.)**

to pass upon the use of mechanical equivalents, 310.

to decide the question of novelty, 446.

even where two specifications are to be compared, 446.

to decide whether reissue is for the same invention as the original, 448.

whether patentee has abandoned his invention, 448.

whether invention is useful, i. e. of practical utility, 450.

to pass upon sufficiency of specification, 223, 462-467.

but under proper instructions, 462-464.

to decide upon question of infringement, 469.

even where there is no dispute as to machines or processes employed,  
469.

**K.****KNOWLEDGE (PRIOR). (See USE.)****L.****LAW OF NATURE. (See PRINCIPLE.)**

- LAW AND FACT.** (See COURT; JURY.)
- LICENSE,** (See ASSIGNMENT.)  
 whether assignable, 213.  
 whether apportionable, 214.
- LICENSEE,** (See ASSIGNEE.)  
 distinction between, and an assignee, 211, 212.  
 to what extent estopped, 215-217.  
 cannot recover royalties paid, 216.  
 whether he can withhold payments after patent pronounced invalid, 216.  
 who continues to use, estopped, 217.  
 position of, under a violation of the agreement, 218.
- LOST ARTS.** (See ARTS.)

## M.

- MACHINE,**  
 is a function embodied in a particular mechanism, 20, 21.  
 when the subject of a patent, 21.  
 improvement in, when patentable, 22.  
 novelty of, how determined, 46, 48.  
 when entirely new, 110.  
 three classes of, 110, 111.  
 difference between, and a process, 12-15, 57-64, 269.  
 how infringed, 290. (See INFRINGEMENT.)  
 does not in America comprise a fabric or substance, 27.
- MANUFACTURE,**  
 judicial interpretation of, as employed in England, 3-7.  
 embraces in England machinery, fabrics, processes, 25, 26.  
 distinction between, and a machine, 27.  
 how infringed, 298. (See INFRINGEMENT.)
- MARKS,**  
 required to be put on patented article for sale, p. 581, § 6.
- MATERIAL,**  
 change of, not an invention, 72 c, 73, 73 a.
- MATERIALS,**  
 sale of the, of a patented machine, no infringement, 294.
- MECHANICAL EQUIVALENTS.**  
 (See EQUIVALENTS; INFRINGEMENT.)
- MISTAKE,**  
 clerical or typographical, not fatal, 238.  
 corrected by the secretary, 277.  
 conclusively presumed from action of commissioner in granting ~~reissue~~  
 282.
- MODE.** (See PROCESS; MANUFACTURE.)
- MONOPOLY,**  
 distinction between, and grant of letters-patent, 2.

## N.

- NEW PATENT,**  
 issued, on surrender of the old, 280.  
 presumed to be for the same invention, 281.

## NON-PAYMENT

of license fee, when an infringement, 297.

## NOTICE,

in pleading General Issue, 370, 371.

must particularize, 371.

must specify the particular parts of the patent to be attacked, 380.

of evidence showing general state of the art at time of patentee's invention, not necessary, 380 *a*.

## NOVELTY, (See FIRST INVENTOR; INVENTION.)

a statutory requisite, 1, 8.

of a process, in what consists, 15-18.

of a composition of matter, 29.

not determined by fixed rules, 50.

want of, in any one part of the patent, fatal in England, 333.

but not in this country, if such part is distinguishable from the rest, 334.

what is, in machinery, 22, 23.

- what amount of thought implied in, 31, 32, 72 *b*.

the great test of invention, 41.

implies more than a frivolous invention, 33, 45-46 *a*.

- utility a test of, 34-40.

some evidence of, to be offered, 472-474.

*primâ facie* evidence of, 472.

what evidence of, other than the patent, may be given by plaintiff, 473.

two issues concerning, 41, 82, 445, 446.

relates to other countries, 82, 83.

inconsistent with a foreign patent, 98, 99.

inconsistent with prior description in a public work, 98, 99.

failure of, renders patent void, 369, 370.

## O.

## OATH,

to accompany an application for patent, 220, 272, 273.

*primâ facie* evidence of novelty, 472.

form of, when varied, p. 565, § 10.

irregularity in, cured by grant of patent, 274.

affirmation substituted for, p. 576, § 13.

renewal of, repealed, p. 590, § 1.

## OMISSION,

from the specification of what is essential, is fatal, 248.

*aliter* of what affects only the degree of benefit, 247, 248.

of an ingredient or step in well-known process may be patentable, 77, 81.

## FIRST INVENTOR,

how construed sometimes, 233 *a*.

## ORIGIN

of the patent systems of England and America, 1.

## OTHERS,

used by "others," how construed, 82-84.

## P.

**PARTIES.** (See ACTION AT LAW; EQUITY.)

**PATENT,**

for what granted, p. 562, § 6; 580, § 3; 588, § 11.

grant of, confers a peculiar legal estate, 167.

valid, though application be unverified, 274.

defeated by imperfectly worded claim, 447.

itself evidence of novelty, 472.

which of two applicants entitled to, 91.

design of the law of, 331.

construed with the specification, 221, 225.

cannot be more extensive than the invention, 230, 239.

same, may cover two machines, 110.

but not two distinct inventions, 107.

cannot be both joint and several, 109.

who may take (see APPLICANT).

foreign, when does not prevent a patent in the United States, 99.

construction of, by the court, 222, 230, 446, 452.

construed liberally, 225, 231.

application for, how made, 271.

how issued, 276.

mistakes in, how corrected, 277.

when surrendered, and a new one taken out, 280-285.

how extended, 287.

how assigned, 168-178.

assignment of, when recorded, 178-183.

for how long granted, 287, 395.

infringement of (see INFRINGEMENT).

rendered invalid by fraud, 336.

damages for infringing (see DAMAGES), 337-341.

when granted, relates back to time of invention, 342.

remedy for infringement (see ACTION AT LAW; REMEDY IN EQUITY).

**PATENTABILITY,** (See INVENTION; NOVELTY; UTILITY.)

decided by the character of the result, and not by the amount of ingenuity shown, 41.

**PATENTEE,**

who may be (see APPLICANT).

**PERSONAL REPRESENTATIVES.** (See ADMINISTRATORS.)

**PETITION.** (See APPLICATION.)

**PLEADINGS.** (See ACTION AT LAW.)

**PRESUMPTION**

that patentee is the inventor, 118.

**PRINCIPLE,** (See INFRINGEMENT.)

a mere, not a manufacture under the English statute, 5.

what meant by a, 125, 126.

patentability of a, discussed in several leading cases, 127-157.

where the inventor describes some mode of application, 133, 135.

infringed by machinery different from patentee's, but practically attaining the same result, 136, 138, 149.

**PRINCIPLE, — Continued.**

requisites of a patent for, 141.

defined, 146.

mere statement of a general, novel result not construed as a claim for a principle, 148.

claim for, where the machinery is not new, 152.

claim for, apart from all means of application is invalid, 155, 156.

claim for abstract, invalid because preventing subsequent invention, 157.

no fixed rules for deciding, 163-165. †

**PRINTED PUBLICATION. (See PUBLIC WORK.)****PROCESS, (See INFRINGEMENT; OMISSION; SUBSTITUTION.)**

a manufacture, under the English statute, 5.

cannot be claimed as an improvement in machinery, 13, 269.

novelty of, in what consists, 15-18.

and product, may be claimed together, 269.

and product, both new and patentable, 14 *a*.

difference between, and machine, 269.

**PRODUCT,**

sale of, by a patented machine, no infringement, 295. (See PROCESS.)

**PROFERT,**

of letters-patent, part of the declaration, 352.

effect of, 352, note.

in a bill for an injunction, 406.

**PROFITS.**

(See DAMAGES.)

**PROOF,**

(See EVIDENCE.)

burden of, on defendant, to show want of novelty, 472.

on patentee, to show infringement, 314.

on patentee, to show sufficiency, 478.

when on patentee, 237.

on defendant, to show that an alien patentee has not put his invention into public use, 493.

**PUBLICATION,**

(See DESCRIPTION.)

what amounts to a, 376.

ordinarily a question for the jury, 376.

in law, a question for the court, 376.

**PUBLIC USE,**

prior, destroys right to a patent, 83, 381.

meaning of, 91, 97, 386.

difference between English and American law, 390.

how to be specified in defendant's notice, 377.

**PUBLIC WORK, (See ACTION AT LAW; NOVELTY.)**

what is a, 376.

prior description in, inconsistent with novelty, 369.

**R.****RECORDING OF ASSIGNMENT, (See ASSIGNMENT.)**

when necessary, 178-183.

**REINVENTION.**

(See INVENTION.)

## REISSUE,

when allowed, 279-285.

REMEDY. (See ACTION AT LAW; EQUITY.)

RENEWAL, (See REISSUE; EXTENSION.)

distinction between, and reissue, 197 note.

of oath, repealed, p. 590, § 1.

## REPAIR,

lawful owner of a patented machine may repair, 297.

## REPEAL

of patents, how obtained, 500 *et seq.*

## REPUGNANCY

between title of the patent and the description of the specification is fatal, 224.

## RESULT,

beneficial, test of invention, 34, 35.

RULE OF DAMAGES. (See DAMAGES.)

## S.

## SALE,

of patented articles to patentee's agent employed for purposes of detection, not *per se* an infringement, 300.

of the materials of a patented machine, no infringement, 294.

## SCIENCE,

discovery in, disconnected from any method of application, not patentable, 159.

## SECRETARY OF STATE,

functions of, superseded, 276.

## SECRETARY OF INTERIOR,

to exercise general control and supervision, 276.

## SERVANT,

suggestions by, when consistent with novelty, 120-123.

manual dexterity of, may be used by inventor, 121.

when principle is suggested by, 120.

SKILL. (See DESCRIPTION; EXPERTS.)

SPECIFICATION, (See CLAIM; DESCRIPTION.)

occupies in America a different position from that in England, 221.

construed together with the letters-patent, 221.

construction of, for the court, 222.

object of, 227, 228.

examples of construction of various, 233 *a.*

must disclose patentee's best knowledge, 237.

must be attested, 264.

no longer to be amended by the addition of improvements by the same inventor, 265.

amended by disclaimer, 266, 267.

by surrender and reissue, 279-281.

## CLAIM,

object of, not to aid the description, but to ascertain what is claimed as new, 227.

SPECIFICATION, — *Continued.*

- a means of clearly presenting the subject-matter, 232.
- must distinguish between the old and the new, 230.
- not presumed to cover what is well known, 231.
- need not describe in detail what is old, 233.
- when ambiguous, 234.
- when not ambiguous, 234 *a*.
- for variations in application, how to be drawn up, 241.
- not for an abstract principle, 242, 244.
- for a "machine" and not "a mode of operation," 242, 269, p. 264-266.
- covers similar methods of application, 245-247.
- for a combination, 249.
- though clumsily worded, may cover both product and process, 295.
- too broad does not prevent subsequent patents by the same inventor, 117.
- for a machine, does not cover the process, 12-14.
- sufficiency of, decided by the court, 229.

## DESCRIPTION,

- sufficiency of, for the jury, 223, 253.
- required by statute, 252.
- sufficient for persons skilled in the art, 253.
- must enable skilled workmen to apply without invention of their own, 255.
- must not omit any step or process which facilitates, 256.
- must tell how to remove injurious foreign matter, 257.
- must state where unusual ingredients may be procured, 258.
- how it must state variable proportions of the ingredient, 259.
- need not explain what is well known, 260.
- of a long and complicated process, construed liberally, 260.
- invalidated by false statements, 260.
- need not explain slight deviations, 261.
- when to be accompanied with drawings, 262.
- and drawings, mutually explanatory, 262.
- what constitutes a prior, 378.
- contained in a prior patent, must, to defeat plaintiff's invention, be itself full and clear, 378 *a*.
- not sufficient, that it contain a hint of the process, 378 *a*.

SUBJECT-MATTER, (*See APPLICATION; IMPROVEMENT; PRINCIPLE.*)

- what may be the, of letters-patent, p. 562, § 6; p. 580, § 3; p. 588, § 11.
- must be new and useful, 30-40.
- when may be an art, 9-19.
  - a machine, 20-24.
  - a manufacture, 25-27.
  - a composition of matter, 29.
- cannot be a mere theory or principle, 124-166.
- the application of what is old to a new purpose, 49-72.
- not a frivolous invention, 45.

## SUBSTITUTION

- of new for old ingredients in a process, which produces a beneficial result, patentable, 75, 76.



SUFFICIENCY. (*See CLAIM; DESCRIPTION; INVENTION.*)

SUGGESTIONS (*See SERVANTS.*)

of others, when consistent with invention, 120-123, 378.

SUPERIORITY,

mere, of materials employed, not *per se* the subject of a patent, 72, 73.

SUPREME COURT. (*See JURISDICTION.*)

SURRENDER. (*See AMENDMENT; REISSUE.*)

## T.

TERM

of letters-patent virtually extended to 16 (19) years, 287, 395.

THEORY. (*See PRINCIPLE.*)

THOUGHT,

amount of, necessary to constitute invention, 32.

## U.

UNITY, (*See JOINT INVENTION.*)

whether one patent can cover both the entire machine and also the parts, 108, 109.

under head of, machines arranged into three classes, 110, 111.

USE,

incidental, of a patented process, for a different purpose, no infringement, 304.

what kind of use of patented composition or manufacture constitutes an infringement, 299.

*prior, as to time,*

what constitutes, 85-97.

in a single instance subsequently abandoned, does not necessarily defeat invention, 85, 86.

but in certain cases may, 87 and note, 94.

turns upon the inquiry, whether there was a complete invention anterior to the patentee's, 87, 89, 91.

depends upon the subject-matter, 97.

distinction between English and American statutes, 83.

how affected by intermediate abandonment, 91.

two classes of cases under, 94, 95.

relative importance of witnesses' accurate recollections of, 96.

*prior, as to place,*

in a foreign country, not sufficient to defeat an honest inventor, 98, 99.

of the invention at the time of application, with patentee's consent, 100-104.

USEFUL,

twofold meaning of,

1. as opposed to injurious, 449.

2. as capable of practical application, 449.

USELESS,

claim of a useless part will not be fatal, if the machine as a whole is useful, 335.

claiming what patentee knows to be, is fatal, 335.

**UTILITY,**

of invention, what is, 105, 106.

want of, equivalent to want of novelty, 335.

## V.

**VENDOR**

of articles made by a patented machine is responsible if connected with use of the machine, 296.

**VERDICT**

cures what defects, in the declaration, 354.

**VOIDABLE,**

letters-patent are, if patentee claims what he knows to be useless, 335.

a description which withholds any part of the inventor's knowledge renders letters-patent, 256-259.

## W.

**WITNESS.**

(See EVIDENCE.)

**WORKMAN,**

(See INVENTION; SERVANT.)

mere, not liable to suit for infringement, 290.

**WRIT OF ERROR**

lies to the Supreme Court, 495.

*D. H. S.*  
5-2-04.