ASSIGNMENTS

OF

PATENT RIGHTS.

A DIGEST OF DECISIONS OF FEDERAL AND STATE COURTS
AND THE COMMISSIONER OF PATENTS, TOGETHER
WITH THE LAWS AND FORMS.

COMPILED AND ARRANGED BY

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BALTIMORE:
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PREFACE.

As Chief of the Assignment Division and Chief Clerk of the United States Patent Office I have often felt the need of a classified digest of decisions relating to assignments, licenses, &c. Questions respecting assignments before the issue of patents and the rights of States and municipalities to impose a tax on the sale of patent rights have repeatedly arisen. Inquiries of every character pertaining to this subject have been propounded by inventors and dealers in patents, and in order to answer them intelligently it has been necessary to search many works of reference. This experience has prompted me to make a compilation of such decisions, which I now publish with the hope that it will prove of value to all interested in patent-rights.

SCHUYLER DURYEE.

WASHINGTON, D. C.,
December, 1885.

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DIGEST OF DECISIONS.

ACKNOWLEDGMENT.

Under the statutes of New York, assignments of patents duly acknowledged before a notary are sufficiently proved, and it is not incumbent upon the complainant to prove the signatures of the assignors.—*Houghton v. Jones*, 1 *Wall.* 702; *New York Pharmical Association v. Tilden*, 23 *O. G.* 272; *Com. Dec.* 1883, p. 145; 14 *Fed. Rep.* 740; 21 *Blatch.* 190.

ADMINISTRATOR.

An assignment by a person as administrator when he is in fact executor, will pass his title as executor.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 13 *Blatch.* 114; 2 *Bann. & Ard.* 113.

The record of an assignment by a person as administrator when he is in fact executor, is constructive notice of a transfer in his representative character.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 13 *Blatch.* 114; 2 *Bann. & Ard.* 113.

The term "patentee" applies to any person having a right under a patent whether as executor, administrator, or assignee. —*Washburn v. Gould*, 3 *Story* 122; 2 *Robb* 206.

Where a patentee entered into a contract to procure an extension of a patent, and after his death his widow, as executrix, secured such extension and assigned it, it was held that, upon the resignation of the trust as executrix the

administrator subsequently appointed could not make a legal assignment of the extended patent to a different party than the assignee of the executrix.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 2 *Bann. & Ard.* 113; 13 *Blatch.* 114.

"Legal representatives" includes assignees as well as executors and administrators in its terms.—*Hamilton v. Kingsbury*, 14 *O. G.* 448; *Com. Dec.* 1878, p. 339; 15 *Blatch.* 64; 3 *Bann. & Ard.* 346.

"Legal representatives" in the patent act means executors or administrators.—*Shaw Relief Valve Co. v. City of New Bedford*, 28 *O. G.* 283; *Com. Dec.* 1884, p. 289; 19 *Fed. Rep.* 753.

In a suit for the infringement of a patent the bill alleged and the proofs showed that the letters patent became the property of P. as administratrix of the patentee as part of his estate, and that complainant was the sole devisee and legatee under the will of P.; *held*, that no property in the patent passed to complainant, and the bill was dismissed.—*Pelham v. Edelmeyer*, 25 *O. G.* 292; *Com. Dec.* 1883, p. 426; 15 *Fed. Rep.* 262; 21 *Blatch.* 188.

An assignment of a patent by an administrator is valid under the Act of July 8, 1870.—*Bradley v. Dull*, 27 *O. G.* 625; *Com. Dec.* 1884, p. 219; 19 *Fed. Rep.* 913.

A patent-right, like any other personal property, is understood by Congress to vest in the executors and administrators of the patentee, if he has died without having assigned it.—*Shaw Relief Valve Co. v. City of New Bedford*, 28 *O. G.* 283; *Com. Dec.* 1884, p. 289; 19 *Fed. Rep.* 753.

A covenant made by a patentee before the enactment of the law authorizing the extension of patents, that any improvement, alteration or renewal of the patent should inure to the benefit of the assignee, is confined to the original term of the

patent and does not embrace an extension to the administrator.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

A person claiming title under the extension from the administrator, can maintain an action for infringement against any person claiming under a covenant from the patentee.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

An extension of a patent granted to an executor or administrator does not inure to the benefit of prior assignees under the original patent, but to the administrator. Assignees who were using the patented device at the time the extension was granted have a right to continue the use.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

It is not necessary that all the administrators should join in an assignment of a patent. A deed by one of them will convey the entire interest.—*Wintermute v. Redington*, 1 *Fish.* 239.

An assignment from a bankruptcy court to an assignee in bankruptcy of all patents owned by a bankrupt is not required to be recorded in the Patent Office, as Section 5046, Revised Statutes, vests all patent-rights at once in the assignee. A recorded assignment from an administrator of a bankrupt, made after the bankruptcy, cannot prevail over an assignment to the assignee in bankruptcy.—*Prime v. Brandon Mfg. Co.*, 4 *Bann. & Ard.* 379; 16 *Blatch.* 453.

A patent-right, like other personal property, vests in the administrator and not in the heirs, in case the patentee dies intestate.—*Bradley v. Dull*, 19 *Fed. Rep.* 913; 27 *O. G.* 625; *Com. Dec.* 1884, p. 219.

The right of an administrator in a patent is not acquired, and cannot be assigned, under State laws. The Act of Congress directs the mode in which an assignment shall be made and where it shall be recorded. The administrator is trustee for the heirs of the deceased, and he may sell a patent-right the same as any other personal property of the estate, and no

reason is perceived why the right may not be conveyed in parts so as to suit purchasers.—*Brooks v. Jenkins*, 3 *McLean* 432.

Administrators of an estate are not, properly speaking, trustees in whom is vested the legal title. The law clothes them with certain powers by which they are enabled to transmit the legal title of property. Acts done by one of them, which relate to the delivery, gift, sale or release of the testator's goods or personal property, are deemed the acts of all. It is not necessary for all the administrators to unite in an assignment in order to pass the whole interest in a patent. —*Wintermute v. Redington*, 1 *Fish.* 239.

The assignee of an administrator need not show that all the forms of law have been complied with; he can hold the property unless the transaction be fraudulent.—*Brooks v. Jenkins*, 3 *McLean* 432.

AGENT.

An attorney, appointed under an irrevocable power, coupled with an interest, and authorizing him to sell an invention in his discretion, is not a purchaser, but an agent.—*Ex parte Cox*, 2 *O. G.* 491; *Com. Dec.* 1872, p. 235.

If an agent is authorized to assign a patent when obtained, he may assign the invention before the patent issues and have the patent granted to the assignee.—*Ex parte Eveleigh*, 1 *O. G.* 303; *Com. Dec.* 1872, p. 19.

The sale of an interest in a patent after it has been ordered to issue, is valid if executed by an attorney under a power to assign the patent to be obtained on the application.—*Ex parte Eveleigh*, 1 *O. G.* 303; *Com. Dec.* 1872, p. 19.

Two parties owning exclusive patent-rights in different territories, and desiring to affect a community of interest in the whole property, conveyed the rights to a third person as

trustee, authorizing him to sell rights, grant licenses, etc. The legal effect of the instrument was to make the trustee their agent to carry out their joint instructions.—*Ladd v. Mills*, 20 *Fed. Rep.* 792; 22 *Blatch.* 242.

Contracts may be executed by an agent of a corporation, but the agent should in the body of the contract name the corporation as the contracting party, and sign as its agent or officer.—*Gottfried v. Miller*, 21 *O. G.* 711; *Com. Dec.* 1882, p. 120; 104 *U. S.* 521.

If a writing is in words and effect no more than an appointment of a party as the patentee's sole agent, in terms irrevocable, yet giving him only an interest by way of commissions in the proceeds of the sale of the articles manufactured and sold by him in the execution of his agency, it vests in him no title, legal or equitable; and the patentee is not precluded from making an assignment to another party.—*Kempton v. Bray*, 99 *Mass.* 350.

An agent employed to sell having secretly purchased from the owner and afterward sold the invention at considerable advance, is deemed a trustee for the principal as to the surplus realized, and he cannot re-acquire the rights and compel his employer to accept them.—*Jeffries v. Wiester*, 2 *Saw.* 135.

Where an assignee relies upon an assignment executed by an agent, he must produce proof of the agent's authority.—*Sone v. Palmer*, 28 *Mo.* 539.

Every authority to convey an interest in a patent must be by deed, that it may appear whether the agent had a valid commission.—*Bellas v. Hays*, 5 *S. & R.* (*Pa.*) 427.

An agreement which purports to be made by a principal through his agent, and has only the agent's name and seal affixed, is not a good execution of the authority if any existed. *Bellas v. Hays*, 5 *S. & R.* (*Pa.*) 427.

No confirmation short of putting his name and seal to it,

can make a writing imperfectly executed by an agent the deed of the principal.—*Bellas v. Hays*, 5 *S.* & *R.* (*Pa.*) 427.

An assignment of the revenues of a railroad to a preferred creditor, with the privilege of using the property of the company until his debt is paid, does not render the assignee liable for infringement of a patent under which the road has a license, as he is acting merely as an agent for the company.—*Emigh v. Chamberlain*, 2 *Fish.* 192; 1 *Biss.* 367.

A power of attorney derived from several principals, which names their individual interests and gives the attorney authority to act for them jointly or separately, only requires an assignment conveying the interest of one of them to be made in the name of the party whose interest is transferred.—*May v. Chaffee*, 5 *Fish.* 160; 2 *Dillon* 385.

When an instrument under seal is executed by attorney, the attorney must be authorized by deed under seal.—*Stetson v. Patten*, 2 *Greenl.* (*Maine*) 358.

A parol ratification is not sufficient to give validity to a deed made by an agent not having authority under seal to bind his principal.—*Stetson v. Patten*, 2 *Greenl.* (*Maine*) 358.

If one acting as attorney for another, but having no sufficient authority, make a deed in the name of his principal who is not bound thereby, it does not follow that the agent is bound by the deed, unless it contains apt words for that purpose.—*Stetson v. Patten*, 2 *Greenl.* (*Maine*) 358.

AGREEMENT.

An agreement made between the owners of a patent and an infringer, in which mention is alone made of the right secured by the patent set forth, though operating to stop the grantees of original patent from prosecuting such infringers, does not extend to a subsequent reissue obtained by assignees, or estop

them from maintaining a suit against such parties.—*Pickering v. Phillips*, 10 *O. G.* 420; *Com. Dec.* 1876, p. 470; 4 *Cliff.* 383.

An instrument purporting to be an assignment of an interest in all letters-patent to be subsequently obtained by the assignor, embodying improvements on his prior inventions, is not an actual transfer of the subsequent patents, but merely an agreement to transfer, enforcible only in a court of equity.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

After an assignee has, under an agreement with a patentee, manufactured and sold machines, he is estopped from denying that the patentee was the original inventor of the device, when called upon for an accounting.—*Kinsman v. Parkhurst*, 18 *How.* 289.

When a licensor covenants with a licensee that he will not grant to another the same right and license he has granted to him, it is equivalent to a grant of an exclusive right.—*Day v. Cary*, 1 *Fish.* 424.

A licensor may make any covenant he please with his licensees, but he cannot compel the public to notice or regard such agreements, or the right conferred or reserved by them.—*Met. Wash. Mach. Co. v. Earle*, 2 *Fish.* 203; 3 *Wall. Jr.* 320.

A person who purchases a patent with knowledge of an existing agreement thereunder, is bound thereby, and his rights are restricted to that extent.—*Hapgood v. Rosenstock*, 23 *Fed. Rep.* 86.

An agreement by an assignor "to protect the sale from infringements," is a warranty that the sale and use of the device would infringe no existing patent.—*Croninger v. Paige*, 4 *N. W. Rep.* 106; 48 *Wis.* 229.

A contract by an employé to permit his employers to apply for and obtain a patent for a device he has invented, may be proved by parol.—*Lockwood v. Lockwood*, 33 *Iowa* 509.

An agreement which is restricted to the original patent does not estop the assignor from prosecuting for an infringement of the reissue.—*Pickering v. Phillips*, 10 *O. G.* 420; *Com. Dec.* 1876, p. 470; 4 *Cliff.* 383.

Where an agreement to account and pay royalty forms part of the consideration of an assignment, it does not reduce the grantee to the position of a licensee.—*Littlefield v. Perry*, 7 *O. G.* 964; 21 *Wall.* 205.

If a person contracts for the purchase of a patent, and he receives and accepts a deed for a different patent, acts under it, and makes payments on account of it, he cannot in absence of fraud, recover back the consideration paid merely because of a misunderstanding as to the extent of the rights conferred. —*Foss v. Richardson*, 15 *Gray* (*Mass.*) 303.

AGREEMENT TO ASSIGN.

In enforcing specific performance of a contract to assign an interest in a future invention, equity may (after the invention has been perfected and patented) carve out an undivided interest in the patent, so that a valid assignment to a third party will afterward take effect upon the interest remaining in the patentee.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

Where an inventor agrees to assign his invention, he is estopped upon obtaining the patent, from setting up any adverse title if the purchaser tenders the purchase price, because in such case the purchaser becomes the equitable owner of the patent.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 2 *Bann. & Ard.* 113; 13 *Blatch.* 114.

The clause "I do not authorize B. to take possession of the patents. I propose to hold them until he perfects his title to a transfer by actually manufacturing and introducing,"

inserted by an inventor in an amendatory power of attorney, imports an agreement to transfer the patent to be obtained to the attorney, after its issue, upon the perfecting of his right to such transfer in the manner prescribed.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

A court of equity will not decree specific performance of a contract providing for the assignment of an interest in letters-patent by one party, and the manufacture and sale of the patented machines by the other, after the lapse of a long time, and where the party seeking the assignment has failed to carry out his agreements as to manufacturing and selling.—*Werden v. Graham*, 24 *O. G.* 101; *Com. Dec.* 1883, p. 485.

Where a patentee agrees to assign for a valuable consideration a renewed patent as soon as obtained, the assignee becomes equitably entitled to the entire interest in the patent during the extended term, and can invest himself with the legal title by paying, or offering to pay, the stipulated price.—*Hartshorn v. Day*, 19 *How.* 211.

A patentee cannot convey any right in an extended patent before the extension is granted, but he may, for a valuable consideration, agree to convey such right whenever it shall be vested in him.—*Day v. Candee*, 3 *Fish.* 9.

Where a patentee agrees upon certain conditions to convey the extended term of a patent, and the conditions have been fulfilled, the assignee becomes the equitable owner of the extension.—*Aiken v. Dolan*, 3 *Fish.* 197.

Where an inventor covenants to execute deeds of conveyance of the part sold, as soon as may be after letters-patent shall have issued, if this does not give the assignee a legal title, a *jus in re*, it clearly confers on him a *jus ad rem*, an equitable right to the thing itself, and is not a mere executory contract to account for proceeds.—*Clum v. Brewer*, 2 *Curt.* 506.

An inventor having conveyed all his interest in an invention

and to any patents that might be obtained therefor, and having covenanted to take out the patents for the assignee, subsequently takes them out in his own name, holds them in trust for the assignee.—*Emmons v. Sladdin*, 9 *O. G.* 352; *Com. Dec.* 1876, p. 304; 2 *Bann. & Ard.* 199.

A contract may be made to convey a future invention as well as a past one, but the language should be explicit to that effect.—*Nesmith v. Calvert*, 1 *W. & M.* 34; 2 *Robb* 311.

A man can pass by grant or assignment only that which he now possesses, and which is in existence at the time either actually or potentially. His grant or assignment is therefore by its natural interpretation limited to the rights and things which are then in existence; and which he has power to grant, unless he uses other language which imports an intention to grant what he does not now possess, and what is not now in existence. In the latter case the language does not even then operate strictly as an assignment or grant, but only as a covenant or contract which a court of equity will carry into full effect when the right or thing comes *in esse*.—*Woodworth v. Sherman*, 3 *Story* 171; 2 *Robb* 257.

APPLICATION FOR PATENT.

The right by assignment is not a mere equitable right such as ordinarily has to be prosecuted in the name and often at the pleasure of the assignor, but the assignee is as much bound to prosecute the application with diligence, and is as effectually concluded by the fact of his rights under the general patent law of the country and the Rules of Practice in the Patent Office as the inventor himself.—*Fire Extinguisher Mfg. Co. v. Graham, Admr.*, 24 *O. G.* 793; *Com. Dec.* 1883, p. 368; 16 *Fed. Rep.* 543.

Where all rights to apply for and obtain letters-patent under the general law have lapsed by reason of failure to prosecute

the application, and a special act has removed the disabilities of a particular class of persons—to wit: the heirs of the inventor—in the way of applying for and obtaining a patent, the rights of those claiming under the original inventor by assignment are not thereby revived.—*Fire Extinguisher Mfg. Co. v. Graham, Admr.*, 24 *O. G.* 793; *Com. Dec.* 1883, p. 368; 16 *Fed. Rep.* 543.

The assignee of the whole right has entire control of a pending application for a patent.—*Read v. Bowman*, 2 *Wall.* 591.

ARBITRATION.

Where a contract stipulates that an arbitration is to be a condition precedent to the right to sue upon the contract, or if this may be inferred upon construction, no suit can be maintained unless the plaintiff has made all reasonable efforts to comply with the condition.—*Perkins v. U. S. Electric Light Co.*, 24 *O. G.* 204; *Com. Dec.* 1883, p. 322; 21 *Blatch.* 308; 16 *Fed. Rep.* 513.

A company having agreed to pay a certain sum, upon a certain condition to be determined by arbitration, and then prevents arbitration, may be sued at law on a *quantum valebat.*—*Humaston v. Telegraph Co.*, 20 *Wall.* 20.

ASSIGNEE, GENERALLY.

A patent having been reissued to the inventor, will not be reissued also to his assignee whose assignment was not recorded before the reissue to the inventor.—*Ex parte Whitely, Com. Dec.* 1869, p. 79.

If a patent issues in the name of an inventor or his immediate assignee, although they had previously transferred their interest therein to a third party, and the deed was duly recorded, the grant at once inures to the ultimate assignee.—*Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 *O. G.* 1597.

It is not essential to the validity of a patent that it be granted in the name of the owner, as shown by the records of the Patent Office. When the patent issues the legal title vests at once in the person who by the records is entitled to it.—*Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 *O. G.* 1597.

Where an assignee who holds the original term of a patent, and the right to the extension of the same, assigns "all his right, title, and interest," such assignment must be held to convey all the interest of which he has become possessed, including the right to the extension, even though the instrument does not name the extension in terms.—*Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

Assignee of a patent is subject to the limitations which affected the title of his assignor. If the latter is estopped by a decree, the former is.—*Pennington v. Hunt*, 20 *Fed. Rep.* 195.

The assignee of a patent is clothed with the right, as against the assignor, to make articles covered by the patent, although the patent may be void for want of novelty against the rest of the world.—*Curran v. Burdsall*, 20 *Fed. Rep.* 835; 27 *O. G.* 1319; *Com. Dec.* 1884, p. 270.

If one of several joint partners assigns to a third party, the estoppel upon the assignor must operate as a license to the assignee to use the patent, and the co-owners must look to the one who assigns, for an accounting.—*Curran v. Burdsall*, 20 *Fed. Rep.* 835; 27 *O. G.* 1319; *Com. Dec.* 1884, p. 270.

A patentee cannot sell his right to another, and then buy or obtain control of an older patent, and through such older patent dispossess his assignee of the full benefit of what he purchased.—*Curran v. Burdsall*, 20 *Fed. Rep.* 835; 27 *O. G.* 1319; *Com. Dec.* 1884, p. 270.

An assignment of a patent is not void for uncertainty of parties because it does not set forth the first names of the assignees.—*Fisk v. Hollander*, 4 *MacArthur* 355.

"Legal representatives" includes assignees as well as executors and administrators in its terms.—*Hamilton v. Kingsbury*, 14 *O. G.* 448; *Com. Dec.* 1878, p. 339; 15 *Blatch.* 64; 3 *Bann. & Ard.* 346.

An assignee of the exclusive right to manufacture and sell a patented invention throughout the United States, is the proper party to maintain a suit for the violation of this right. —*Nellis v. Pennock Mfg. Co.*, 22 *O. G.* 1131; *Com. Dec.* 1882, p. 417; 13 *Fed. Rep.* 451.

An assignee of a chose in action—as a patent-right—cannot proceed by bill in equity to enforce for his own use the legal right of his assignor merely because he cannot sue at law in his own name.—*Hayward v. Andrews*, 23 *O. G.* 533; *Com. Dec.* 1883, p. 155; 106 *U. S.* 672.

Letters-patent having been issued directly to an assignee, he acquired the legal title.—*Perkins v. U. S. Electric Light Co.*, 24 *O. G.* 204; *Com. Dec.* 1883, p. 322; 21 *Blatch.* 308; 16 *Fed. Rep.* 513.

The right by assignment is not a mere equitable right such as ordinarily has to be prosecuted in the name and often at the pleasure of the assignor, but the assignee is as much bound to prosecute the application with diligence, and is as effectually concluded by the fact of his rights under the general patent law of the country and the Rules of Practice in the Patent Office as the inventor himself.—*Fire Extinguisher Mfg. Co. v. Graham, Admr.*, 24 *O. G.* 793; *Com. Dec.* 1883, p. 368; 16 *Fed. Rep.* 543.

The laws of Congress give the right to a patent to the inventor, whether *sui juris* or under disability, or to the assigns of the inventor. As inventor or assignee of a patented invention, a married woman, an infant, or a person under guardianship, obtains a vested right to the patent.—*Fetter v. Newhall*, 25 *O. G.* 502; *Com. Dec.* 1883, p. 429; 17 *Fed. Rep.* 841; 21 *Blatch.* 445.

An assignee cannot secretly acquire an outstanding right and set it up against his joint owner in derogation of his rights under an existing agreement.—*Kinsman v. Parkhurst*, 18 *How.* 289.

When a person purchases a contract from an assignee, he takes it subject to all the equities existing between the original contracting parties.—*Kinsman v. Parkhurst*, 18 *How.* 289.

After an assignee has, under an agreement with a patentee, manufactured and sold machines, he is estopped from denying that the patentee was the original inventor of the device, when called upon for an accounting.—*Kinsman v. Parkhurst*, 18 *How.* 289.

To enable an assignee to sue in his own name, he must have conveyed to him the entire and unqualified monopoly which the patentee held in the territory specified.—*Gayler v. Wilder*, 10 *How.* 477.

An assignee of an exclusive right to use two machines within a particular district, has such a right as will enable him to maintain an action for infringement of the patent within that district.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

A person claiming title under the extension from the administrator, can maintain an action for infringement against any person claiming under a covenant from the patentee.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

An assignee of part of a patent-right cannot maintain an action on the case for a violation of the patent under the Act of 1793.—*Tyler v. Tuel*, 6 *Cranch* 324.

The assignees of a patent-right take it subject to the legal consequences of the previous acts of the patentee.—*McClurg v. Kingsland*, 1 *How.* 202; 2 *Robb* 105.

An extension of a patent granted to an executor or administrator, does not inure to the benefit of prior assignees under the original patent, but to the administrator. Assignees who

were using the patented device at the time the extension was granted, have a right to continue the use.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

An assignee is one who has transferred to him, in writing, the whole interest of the original patent, or any undivided part of such whole interest, in every portion of the United States.—*Potter v. Holland*, 1 *Fish.* 327; 4 *Blatch.* 206; *Moore v. Marsh*, 7 *Wall.* 515.

There are three classes of persons in whom the patentee can vest an interest of some kind in the patent. They are, an assignee, a grantee of an exclusive sectional right, and a licensee.—*Potter v. Holland*, 1 *Fish.* 327; 4 *Blatch.* 206.

If the Commissioner of Patents refuse to grant a patent to an assignee, it is not a subject of appeal to a judge of the Supreme Court of the District of Columbia, but for a court of general jurisdiction.—*Whitely v. Fisher*, 4 *Fish.* 248.

If a deed is left with a stranger to be delivered to the grantee on the happening of a contingency, the first delivery is complete and irrevocable by death or otherwise.—*Hammond v. Hunt*, 4 *Bann. & Ard.* 111.

An assignee may maintain a suit for infringement without joining the patentee.—*Seibert Cyl. Oil-Cup Co. v. Phillips Lubricator Co.*, 10 *Fed. Rep.* 677; *Nellis v. Pennock Mfg. Co.*, 13 *Fed. Rep.* 451; 22 *O. G.* 1131; *Com. Dec.* 1882, p. 417.

The mere assignment of a patent gives the assignee no right to damages or profits already accrued, unless the language of the instrument shows that such was the intention.—*Merriam v. Smith*, 11 *Fed. Rep.* 588; *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 *Fed. Rep.* 638; 25 *O. G.* 1076; *Com. Dec.* 1883, p. 460; 21 *Blatch.* 519.

An assignee who settled with persons using a machine which infringed on the right he purchased, and subsequently granted them a license to use the machine, is liable in such

case to the assignor for the stipulated royalty.—*Rodgers v. Torrant*, 4 *N. W. Rep.* 507; 43 *Mich.* 113.

Section 4895, Revised Statutes, which provides for the granting of patents to assignees, does not restrict the grant to the *immediate* assignee.—*Seldon v. Stockwell Self-Lighting Gas Burner Co.*, 9 *Fed. Rep.* 390; 19 *Blatch.* 544; 20 *O. G.* 1377; *Com. Dec.* 1881, p. 431; *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 *O. G.* 1597.

An assignee cannot assign the entire right for a particular territory and get its whole value from the vendee, and then sell single machines to be used in the same territory during the extended term.—*Union Paper Bag Machine Co. v. Nixon*, 9 *O. G.* 691; *Com. Dec.* 1876, p. 344; 1 *Flipp.* 491; 2 *Bann. & Ard.* 244.

A subsequently acquired title by a vendor, will inure to the benefit of the vendee under an assignment made when the vendor had no title.—*Sherman v. Champlain Co.*, 31 *Vt.* 162.

An assignment of an imperfect invention with all the improvements upon it that the inventor may make, is equivalent in equity to an assignment of the perfected results, and the assignees become the owners of the patent granted upon the perfected invention, and if it be issued to the assignor he takes it in trust for the assignees and should convey.—*Littlefield v. Perry*, 7 *O. G.* 964; 21 *Wall.* 205.

Where an assignee is a corporation and the patentee is its manager and director, it has notice through him as such of all prior assignments pertaining to his patents.—*Continental Windmill Co. v. Empire Windmill Co.*, 4 *Fish.* 428; 8 *Blatch.* 295.

It seems a necessary, or at least a just inference, that until the assignee has recorded the assignment, he is not substituted to the right and responsibility of the patentee, so as to maintain any suit at law or in equity founded thereon.—*Wyeth v. Stone*, 1 *Story* 273; 2 *Robb* 23.

While an assignee may be entitled to have a deed reformed and the true description inserted, it cannot be done to the prejudice of the title acquired by a *bona fide* purchaser after a lapse of more than three months.—*Gibson v. Cook*, 2 *Blatch.* 144; *Woodworth v. Cook*, 2 *Blatch.* 151.

In an action to recover royalties, the assignee may plead in defence, a decree of the United States Court in a suit between the same parties adjudging the patent void and of no effect.—*Hawks v. Swett*, 11 *N. Y. Sup.* 146; *Marston v. Swett*, 11 *N. Y. Sup.* 153.

An assignee under a license can avail himself of the same means to sustain his title, and repel any attack upon it as the law allows the assignor.—*Day v. New Eng. Car Spring Co.*, 3 *Liv. Law Mag.* 44.

The title of an assignee or purchaser may be impeached the same as when it remained with the assignor, by proving that the assignor had procured it by fraud.—*Day v. New Eng. Car Spring Co.*, 3 *Liv. Law Mag.* 44.

If an asignee has derived profits from the use and sale of an invention, he cannot recover from the assignor the consideration paid therefor, if the patent be subsequently declared void. The contract may be rescinded by a court of equity, but it will compel the parties to account to each other in order that they may be restored to their original positions.—*Edmunds v. Myer*, 16 *Ill.* 207; *Edmunds v. Hildreth*, 16 *Ill.* 214.

The clause of forfeiture for non-performance contained in an assignment, does not reduce the grantee to the position of a licensee. For the non-payment or other non-performance, a forfeiture might be enforced as for a condition broken, but until it is enforced the title granted remains in the assignee.—*Littlefield v. Perry*, 7 *O. G.* 964; 21 *Wall.* 205.

The assignee of the whole right has entire control of a pending application for a patent.—*Read v. Bowman*, 2 *Wall.* 591.

The term "patentee" applies to any person having a right under a patent whether as executor, administrator, or assignee. —*Washburn v. Gould*, 3 *Story* 122; 2 *Robb* 206.

ASSIGNEE AS TO EXTENSIONS.

Where an assignee who holds the original term of a patent and the right to the extension of the same, assigns "all his right, title and interest," such assignment must be held to convey all the interest of which he has become possessed, including the right to the extension, even though the instrument does not name the extension in terms.—*Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

A covenant made by a patentee before the enactment of the law authorizing the extension of patents, that any improvement, alteration or renewal of the patent should inure to the benefit of the assignee, is confined to the original term of the patent and does not embrace an extension to the administrator. —*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

An extension of a patent granted to an executor or administrator does not inure to the benefit of prior assignees under the original patent, but to the administrator. Assignees who were using the patented device at the time the extension was granted, have a right to continue the use.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

A deed which conveys all right, title and interest in an "invention," to the full end of the term for which said letters-patent "may be granted," carries the entire invention and all patents whensoever issued.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

A party having purchased a machine from an infringer, corrected the evil by purchasing from the patentee the entire right for the county where his machine was used, and this

gave him the right to use the machine during the extended term.—*Eunson v. Dodge*, 18 *Wall.* 414; 5 *O. G.* 95.

An owner of a patent who conveys by deed "all his property and estate, whatsoever and wheresoever, of every kind and description," carries the right to the patent.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

Where a patentee agrees upon certain conditions to convey the extended term of a patent, and the conditions have been fulfilled, the assignee becomes the equitable owner of the extension.—*Aiken v. Dolan*, 3 *Fish.* 197.

An assignment of an interest in an invention, and letters-patent therefor, before the expiration of the original term, carries with it no interest in a subsequently extended term, unless there is specific provision to that effect.—*Gear v. Grosvenor*, 6 *Fish.* 314; 1 *Holmes* 215; 3 *O. G.* 380; *Jenkins v. Nicolson Pavement Co.*, 4 *Fish.* 201; 1 *Abbott* 567.

The owner of a patented machine, without any conditions attached to the ownership, has the right to use it during the extended term of the patent or to transfer such right to another. —*Union Paper Bag Mach. Co. v. Nixon*, 105 *U. S.* 766; 21 *O. G.* 1275; *Com. Dec.* 1882, p. 197.

ASSIGNEE AS TO PRIOR ASSIGNMENTS.

An agreement which operates as a transfer of a patent is good as against the patentee and those who purchase with notice, though not recorded.—*Continental Windmill Co. v. Empire Windmill Co.*, 4 *Fish.* 428; 8 *Blatch.* 295; *Peck v. Bacon*, 18 *Conn.* 377.

Where an assignee is a corporation and the patentee is its manager and director, it has notice through him as such of all prior assignments pertaining to his patents.—*Continental Windmill Co. v. Empire Windmill Co.*, 4 *Fish.* 428; 8 *Blatch.* 295.

A conveyance of "all my right, title and interest in and to" a patent, though properly recorded, does not include the right for two counties covered by a prior conveyance, although the prior conveyance was not recorded in the Patent Office.—*Turnbull v. Weir Plow Co.*, 23 *O. G.* 91; *Com. Dec.* 1883, p. 121; 5 *Bann. & Ard.* 288; 14 *Fed. Rep.* 108; 9 *Biss.* 334.

In order to guard against an outstanding title of over three months' duration, the purchaser need only look to the records of the Patent Office.—*Gibson v. Cook*, 2 *Blatch.* 144.

Within the period of three months a purchaser must protect himself in the best way he can, as an unrecorded prior assignment will prevail; but it must be an assignment in writing, that may be recorded within the time limited.—*Gibson v. Cook*, 2 *Blatch.* 144.

A prior unrecorded assignment is good against subsequent purchaser without *valuable consideration.*—*Saxton v. Aultman*, 15 *Ohio St.* 471.

Where a patentee assigns all *his* right, title, and interest for a particular territory, it will not affect a previous unrecorded assignment, if there is a residuary interest left in the patentee on which the second assignment can operate. In the absence of proof it cannot be inferred from the language that the patentee intended fraud upon his assignee.—*Turnbull v. Weir Plow Co.*, 6 *Biss.* 225; 7 *O. G.* 173; 1 *Bann. & Ard.* 544; *Ashcroft v. Walworth*, 5 *Fish.* 528; 1 *Holmes* 152; 2 *O. G.* 546.

ASSIGNEE AS TO REISSUE.

A patent having been reissued to an inventor, although he had previously conveyed all his interest by an assignment which was not of record, the assignee cannot demand a patent to himself.—*Whitely v. Fisher*, 4 *Fish.* 248; *Ex parte Whitely*, *Com. Dec.* 1869, p. 79.

If an assignee accepts the reissue of a patent and transfers a part of the interest in it which was originally vested in him by the patentee, it is a ratification by him of the act of the patentee in securing the reissue, although he did not join in the surrender of the original patent.—*Meyer v. Bailey*, 2 *Bann.* & *Ard.* 73; 8 *O. G.* 437.

An assignee does not take by inurement the benefit of a reissue obtained after his assignment. He must ratify the surrender.—*Burdell v. Denig*, 2 *Fish.* 588.

A concurrence in the surrender of a patent by a transferee of an interest in it, who is not an assignee within the meaning of the statute, is not essential to the validity of a reissued patent.—*Meyer v. Bailey*, 2 *Bann.* & *Ard.* 73; 8 *O. G.* 437.

ASSIGNEE IN BANKRUPTCY AND INSOLVENCY.

Neither an assignee in insolvency nor a receiver can acquire or pass a title to a patent, except by a written instrument, signed by the owner of the patent and duly recorded.—*Gordon v. Anthony*, 16 *O. G.* 1135; *Com. Dec.* 1879, p. 638; 4 *Bann.* & *Ard.* 248; 16 *Blatch.* 234.

An assignee in insolvency, or a receiver of all the property of a debtor appointed under the laws of a State, does not, by virtue of the general assignment or appointment merely, acquire a title in patent-rights.—*Ager v. Murray*, 21 *O. G.* 1197; *Com. Dec.* 1882, p. 188; 105 *U. S.* 126.

An assignment from a bankruptcy court to an assignee in bankruptcy of all patents owned by a bankrupt, is not required to be recorded in the Patent Office, as Section 5046, Revised Statutes, vests all patent-rights at once in the assignee. A recorded assignment from an administrator of a bankrupt, made after the bankruptcy, cannot prevail over an assignment to the assignee in bankruptcy.—*Prime v. Brandon Mfg. Co.*, 4 *Bann.* & *Ard.* 379; 16 *Blatch.* 453.

A receiver of an insolvent debtor is entitled to a patent-right belonging to the debtor; and a court is empowered to order the debtor to convey the right to such receiver, if such conveyance is necessary.—*Petition of Keach, Receiver*, 19 *Reporter* 731.

An assignee under a State insolvent law does not acquire any legal title to any interest the debtor may have in a patent, as the statute contemplates a written instrument signed by the owner of the patent, and duly recorded in the Patent Office, in order to vest the legal title in the purchaser.—*Ashcroft v. Walworth*, 5 *Fish.* 528; 1 *Holmes* 152; 2 *O. G.* 546.

It is competent for a State Court under an insolvent law to compel a debtor to execute an assignment that would transfer a patent-right to an assignee in insolvency.—*Ashcroft v. Walworth*, 5 *Fish.* 528; 1 *Holmes* 152; 2 *O. G.* 546.

Where an agreement between joint owners of a patent to account to each other for profits derived from the use of the invention, is a continuing consideration of the grant of the patent, it is not affected by the bankruptcy of one of the parties, and passes upon an assignment in bankruptcy to the assignee. —*Fraser v. Gates*, 20 *Reporter* 427.

ASSIGNMENT DEFINED.

Any assignment short of the entire and unqualified monopoly, is a mere license.—*Gayler v. Wilder*, 10 *How.* 477.

No person can be considered an assignee under the Act of 1793, unless he has the *whole* right of the original patentee transferred to him.—*Tyler v. Tuel*, 6 *Cranch* 324.

The thing to be assigned is not the mere parchment on which the grant is written, but the monopoly which the grant confers; the right of property which it creates.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

An assignment is a grant in writing of the whole or a part of the exclusive right vested in the patentee by the letters-patent, and it makes no difference whether such part be designated as an undivided part of the whole patent, or as the grant of the exclusive right of the patentee within a particular district.—*Baldwin v. Sibley*, 1 *Cliff.* 150; *Farrington v. Gregory*, 4 *Fish.* 221.

The power of assignment under the statute has been so construed by the courts as to confine it to the transfer of an entire patent, an undivided part thereof, or the entire interest of the patentee or an undivided part thereof, within and throughout a certain specified portion of the United States.—*Littlefield v. Perry*, 7 *O. G.* 964; 21 *Wall.* 205.

An instrument purporting to convey inventions not yet *in esse*, is not an assignment, but only an executory contract.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

ASSIGNMENT—GENERALLY.

The omission from an assignment of a patent of the corporate seal of the company executing the deed is not necessarily a fatal defect, since a court of equity would compel the making of a good assignment.—*Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

A patent having been reissued to the inventor, will not be reissued also to his assignee whose assignment was not recorded before the reissue to the inventor.—*Ex parte Whitely*, *Com. Dec.* 1869, p. 79.

Although an inventor sells his invention to another, who has also aided him in perfecting it by suggesting minor incidental improvements, the latter does not by these means become entitled to a patent as the inventor.—*Yost v. Heston*, *Com. Dec.* 1871, p. 226.

An instrument purporting to convey inventions not yet *in esse* is not an assignment, but only an executory contract.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

Whenever a patentee conveys his "invention" without any other language in the deed of conveyance restricting the right to use the invention, he must be considered to have granted the right to any letters-patent which may be issued thereon.—*Emmons v. Sladdin*, 9 *O. G.* 352; *Com. Dec.* 1876, p. 304; 2 *Bann. & Ard.* 199.

An assignment on which a reissue was based, though alleged to have been forged by the assignee, yet having been recognized by the assignor as valid; *held*, to be good.—*Campbell v. James*, 17 *Blatch.* 42; 18 *O. G.* 979; *Com. Dec.* 1880, p. 633.

An assignment of an interest in a patent to be valid, must be in writing; it cannot be evidenced by parol testimony.—*Baldwin v. Sibley*, 1 *Cliff.* 150.

A purchaser having accepted a deed which described the patent and invention conveyed to him, cannot, in the absence of fraud, recover the money he has paid, on the ground that the invention is not what he thought it was.—*Foss v. Richardson*, 15 *Gray* (*Mass.*) 303.

An assignment of an interest in all patents previously obtained by the assignor, does not convey a subsequent invention of an improvement on an invention covered by a patent obtained before the assignment.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

An instrument which makes no allusion to a patent further than to mention a claim for the use of the invention embraced therein, cannot act to carry the patent. The fact that it is recorded in the Patent Office cannot make it an instrument of title, but can only complete its effect if it was one.—*Campbell v. James*, 18 *O. G.* 1111; *Com. Dec.* 1880, p. 647; 5 *Bann. & Ard.* 354; 2 *Fed. Rep.* 338; 18 *Blatch.* 92.

An assignment purporting to convey all the right, title and interest in letters-patent "excepting thirty-two or thirty-three counties, heretofore sold and assigned," without designating the counties thus previously sold, is not so far ambiguous as that nothing passes thereby, the reservation being such as is capable of being made certain by competent evidence, showing what counties have been actually conveyed.—*Washburn & Moen Mfg. Co. v. Haish*, 19 *O. G.* 173; *Com. Dec.* 1881, p. 76; 4 *Fed. Rep.* 900; 10 *Biss.* 65.

The sale by a patentee for a term of years of the exclusive right in a patent, reserving certain shop-rights, does not debar him from bringing suit against a third party for infringement, as he has a beneficial interest in the right secured by the patent.—*Still v. Reading*, 20 *O. G.* 1025; *Com. Dec.* 1881, p. 394; 9 *Fed. Rep.* 40; 4 *Woods* 345.

Assignments of patents are not required to be under seal.—*Gottfried v. Miller*, 21 *O. G.* 711; *Com. Dec.* 1882, p. 120; 104 *U. S.* 521.

An assignment is not required to be recorded in order to be valid between the parties thereto.—*Holden v. Curtis*, 2 *N. H.* 61; *Black v. Stone*, 33 *Ala.* 327; *Moore v. Bare*, 11 *Iowa* 198.

The absence of the corporate seal from a contract of assignment of a patent-right does not render it invalid or void.—*Gottfried v. Miller*, 21 *O. G.* 711; *Com. Dec.* 1882, p. 120; 104 *U. S.* 521.

A contract by which one person agrees to pay a sum of money for the time, labor and skill of another for a given period, gives the employer no right to an assignment of a patent that is issued to his employé for an invention made during the period of his employment.—*Hapgood v. Hewitt*, 21 *O. G.* 1786; *Com. Dec.* 1882, p. 269; 11 *Biss.* 184; 11 *Fed. Rep.* 422.

A conveyance executed by the signature of a company, with

seal, and by S., president, and another seal, is a good execution both for the company and for S. individually.—*Campbell v. James*, 18 *O. G.* 979; *Com. Dec.* 1880, p. 633; 17 *Blatch.* 42.

An assignment of all property, except such property as is exempt by law from levy and sale under execution, cannot transfer a patent-right.—*Campbell v. James*, 18 *O. G.* 1111; *Com. Dec.* 1880, p. 647; 18 *Blatch.* 92; 2 *Fed. Rep.* 338; 5 *Bann. & Ard.* 354.

All interests in patents are assignable by an instrument in writing. No particular form is required; but still there must be some operative words expressing at least an intention to assign, in order to constitute an assignment.—*Campbell v. James*, 18 *O. G.* 1111; *Com. Dec.* 1880, p. 647; 18 *Blatch.* 92; 2 *Fed. Rep.* 338; 5 *Bann. & Ard.* 354.

Under the statutes of New York, assignments of patents duly acknowledged before a notary are sufficiently proved, and it is not incumbent upon the complainant to prove the signatures of the assignors.—*Houghton v. Jones*, 1 *Wall.* 702; *New York Pharmical Association v. Tilden*, 23 *O. G.* 272; *Com. Dec.* 1883, p. 145; 14 *Fed. Rep.* 740; 21 *Blatch.* 190.

Where all rights to apply for and obtain letters-patent under the general law have lapsed by reason of failure to prosecute the application, and a special act has removed the disabilities of a particular class of persons,—to wit: the heirs of the inventor—in the way of applying for and obtaining a patent, the rights of those claiming under the original inventor by assignment are not thereby revived.—*Fire Extinguisher Mfg. Co. v. Graham, Admr.*, 24 *O. G.* 793; *Com. Dec.* 1883, p. 368; 16 *Fed. Rep.* 543.

Section 4898, Revised Statutes, requires that the assignment of a patent be by an instrument in writing. The ability to make the instrument, however, or the aid to a disability must be found in the laws of the States, where all such rights are

regulated.—*Fetter v. Newhall*, 25 *O. G.* 502; *Com. Dec.* 1883, p. 429; 17 *Fed. Rep.* 841; 21 *Blatch.* 445.

The laws of New York make the property of married women distinctly their own. Where a married woman by her sole deed assigns an interest in a patent, the assignment is valid, and she may join with such assignee in an action involving their joint rights.—*Fetter v. Newhall*, 25 *O. G.* 502; *Com. Dec.* 1883, p. 429; 17 *Fed. Rep.* 841; 21 *Blatch.* 445.

An assignment of a patent by an administrator is valid under the Act of July 8, 1870.—*Bradley v. Dull*, 27 *O. G.* 625; *Com. Dec.* 1884, p. 219; 19 *Fed. Rep.* 913.

Where a patentee has sold all his right, title, and interest in, to and under his patents and subsequently purchases an older patent; *held*, that by such subsequent purchase an assignee cannot be dispossessed of the full benefit of what has been acquired from the patentee.—*Curran v. Burdsall*, 27 *O. G.* 1319; *Com. Dec.* 1884, p. 270; 20 *Fed. Rep.* 835.

Where others are associated with a patentee in the purchase of a prior patent subsequent to a sale by the patentee of all his right, title and interest in, to and under his own patents; *held*, that the prior sale operates as a license as against all of the purchasers.—*Curran v. Burdsall*, 27 *O. G.* 1319; *Com. Dec.* 1884, p. 270; 20 *Fed. Rep.* 835.

A patent-right, like any other personal property, is understood by Congress to vest in the executors and administrators of the patentee, if he has died without having assigned it.—*Shaw Relief Valve Co. v. City of New Bedford*, 28 *O. G.* 283; *Com. Dec.* 1884, p. 289; 19 *Fed. Rep.* 753.

When a person purchases a contract from an assignee, he takes it subject to all the equities existing between the original contracting parties.—*Kinsman v. Parkhurst*, 18 *How.* 289.

Contracts are usually made with reference to established laws, and should be so construed and understood, unless other-

wise clearly indicated by the terms of the agreement.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

An instrument purporting to be an assignment of an expired patent is void as an assignment, although it may be good as a power of attorney to collect for infringements.—*Bell v. McCullough*, 1 *Fish.* 380; 1 *Bond* 194.

It is not necessary that all the administrators should join in an assignment of a patent. A deed by one of them will convey the entire interest.—*Wintermute v. Redington*, 1 *Fish.* 239.

If a power of attorney is executed for the purpose of providing that a right in a patent may inure to the benefit of another, it is, in a court of equity, equivalent to an assignment. Such a power of attorney is a power coupled with an interest in the *thing* itself, and is not revocable.—*Day v. Candee*, 3 *Fish.* 9.

An assignment under a specific patent does not authorize the assignee to use subsequent improvements, although they may have been invented and attached to the original device at the time the transfer was executed.—*Am. Hide and Leather Co. v. Am. Tool and Mach. Co.*, 4 *Fish.* 284; 1 *Holmes* 503.

If an assignee accepts the reissue of a patent and transfers a part of the interest in it which was originally vested in him by the patentee, it is a ratification by him of the act of the patentee in securing the reissue, although he did not join in the surrender of the original patent.—*Meyer v. Bailey*, 2 *Bann. & Ard.* 73; 8 *O. G.* 437.

If a contract is actually made, by which the owner of a patent is bound, and the extension of the patent was intended to be conveyed, a court of equity will treat it as done to carry out the purpose of the parties.—*Labaree v. Peoria, Pekin & Jacksonville R. R. Co.*, 3 *Bann. & Ard.* 180.

A receiver appointed by a State court, can convey no

interest in a patent, for the reason that the law requires the conveyance to be a written instrument signed by the owner of the patent.—*Gordon v. Anthony*, 4 *Bann.* & *Ard.* 248; 16 *Blatch.* 234; 16 *O. G.* 1135; *Com. Dec.* 1879, p. 638.

The cancellation of a deed does not revest the grantor with title, though it is done with that intention.—*Steel v. Steel*, 4 *Allen* (*Mass.*) 417.

Alteration of a deed by a grantor at the request of the grantee, and re-delivery of the deed, is, in legal effect, a re-execution of the deed.—*Malarin v. U. S.*, 1 *Wall.* 282.

The date of an assignment is the day of its delivery, and not the date which appears upon its face, if the latter differs from the former.—*Dyer v. Rich*, 1 *Metcalf* (*Mass.*) 180.

A certified copy of an assignment from the Patent Office is *prima facie* evidence of the genuineness of the original, and may be read in evidence to the jury.—*Lee v. Blandy*, 2 *Fish.* 89; 1 *Bond* 361.

Any assignment of a patent short of the entire and unqualified monopoly, is a mere license.—*Theberath v. Celluloid Mfg. Co.*, 3 *Fed. Rep.* 143; 5 *Bann.* & *Ard.* 577; *Sanford v. Messer*, 5 *Fish.* 411; 1 *Holmes* 149; 2 *O. G.* 470; *Gayler v. Wilder*, 10 *How.* 477.

A person who purchases a patent with knowledge of an existing agreement thereunder is bound thereby, and his rights are restricted to that extent.—*Hapgood v. Rosenstock*, 23 *Fed. Rep.* 86.

The mere assignment of a patent gives the assignee no right to damages or profits already accrued, unless the language of the instrument shows that such was the intention.—*Merriam v. Smith*, 11 *Fed. Rep.* 588; *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 *Fed. Rep.* 638; 25 *O. G.* 1076; *Com. Dec.* 1883, p. 460; 21 *Blatch.* 519.

Under a conveyance of the entire legal title to patents to joint trustees with full power to dispose of them at their dis-

cretion, it requires the joint deed of both to convey any title to or interest in the patents.—*Westcott v. Wayne Agric. Works*, 11 *Fed. Rep.* 298.

A condition in a deed cannot be apportioned. Whenever the reversion is granted by the maker of the condition the condition is gone.—*Tinkham v. Erie R. R.*, 53 *Barb.* (*N. Y.*) 393.

As a general rule, an assignment of an interest in a patent must be in writing, for the reason that such transactions are required to be recorded, and in fact and reality are not authorized to be made in any other way.—*Baldwin v. Sibley*, 1 *Cliff.* 150; *Jordan v. Dobson*, 4 *Fish.* 232; 2 *Abbott* 398; *Davy v. Morgan*, 56 *Barb.* (*N. Y.*) 218; *Galpin v. Atwater*, 29 *Conn.* 93.

Although an invention is misnamed in a conveyance, if the deed furnishes sufficient means for correcting the mistake or identifying the thing sold, it will pass title to the invention patented.—*Harmon v. Bird*, 22 *Wend.* (*N. Y.*) 113.

The thing to be assigned is not the mere parchment on which the grant is written, but the monopoly which the grant confers, the right of property which it creates.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

An assignment by a patentee in such general terms as are usual in speaking of the thing to which the patented part is attached, conveys the right to make and use the thing actually patented.—*Myers v. Turner*, 17 *Ill.* 179; *Hill v. Thuermer*, 13 *Ind.* 351.

The reservation by the assignor of the right to construct a limited number of machines within the territory assigned is not inconsistent with the grant of an exclusive right in the patent for the particular territory.—*Washburn v. Gould*, 3 *Story* 122; 2 *Robb* 206.

The assignment of a patent does not carry with it a transfer

of the right to damages for an infringement committed before such assignment.—*Moore v. Marsh*, 7 *Wall.* 515.

Where an assignee relies upon an assignment executed by an agent he must produce proof of the agent's authority.—*Sone v. Palmer*, 28 *Mo.* 539.

Every authority to convey an interest in a patent must be by deed, that it may appear whether the agent had a valid commission.—*Bellas v. Hays*, 5 *S.* & *R.* (*Pa.*) 427.

An agreement which purports to be made by a principal through his agent, and has only the agent's name and seal affixed, is not a good execution of the authority if any existed. —*Bellas v. Hays*, 5 *S.* & *R.* (*Pa.*) 427.

No confirmation short of putting his name and seal to it, can make a writing imperfectly executed by an agent, the deed of the principal.—*Bellas v. Hays*, 5 *S.* & *R.* (*Pa.*) 427.

A certificate that A. "is the owner of five-fortieth parts of the letters-patent," is not such an assignment of letters-patent as the law requires, and would give the person no interest whatever in the patent.—*Hope Iron Works v. Holden*, 58 *Maine* 146.

An assignment to an incorporated company not at the time organized will inure to its use when organized, at least by way of estoppel, and be good against the grantor, whether it took effect on its delivery to pass any property or not.—*Dyer v. Rich*, 1 *Metcalf* (*Mass.*) 180.

The right of an administrator in a patent is not acquired, and cannot be assigned, under State laws. The Act of Congress directs the mode in which an assignment shall be made, and where it shall be recorded. The administrator is trustee for the heirs of the deceased, and he may sell a patent-right the same as any other personal property of the estate, and no reason is perceived why the right may not be conveyed in parts so as to suit purchasers.—*Brooks v. Jenkins*, 3 *McLean* 432.

A man can pass by grant or assignment only that which he now possesses, and which is in existence at the time, either actually or potentially. His grant or assignment is therefore by its natural interpretation limited to the rights and things which are then in existence, and which he has power to grant, unless he uses other language which imports an intention to grant what he does not now possess, and what is not now in existence. In the latter case the language does not even then operate strictly as an assignment or grant, but only as a covenant or contract which a court of equity will carry into full effect when the right or thing comes *in esse*.—*Woodworth v. Sherman*, 3 *Story* 171; 2 *Robb* 257.

An assignment of a patent by a person having no title, with the written assent of the party in whom the title is, if in the form of a deed, is as effective as a conveyance directly from the owner.—*Sherman v. Champlain Co.*, 31 *Vt.* 162.

A mere assignment of the right, title, and interest of the assignor, and nothing further, will not operate to secure to the purchaser a title subsequently acquired by the vendor.—*Perry v. Corning*, 7 *Blatch.* 195.

An assignment of an invention is valid, notwithstanding it is made after the rejection of the application for patent, by the Commissioner, and the inventor's appeal from that decision.—*Gay v. Cornell*, 1 *Blatch.* 506.

The grant of a future term of a patent, not yet *in esse*, is not the subject of assignment at common law or within the sense of section 11 of the Act of 1836. The right could rest only in contract.—*Gibson v. Cook*, 2 *Blatch.* 144.

While an assignee may be entitled to have a deed reformed and the true description inserted, it cannot be done to the prejudice of the title acquired by a *bona fide* purchaser after a lapse of more than three months.—*Gibson v. Cook*, 2 *Blatch.* 144; *Woodworth v. Cook*, 2 *Blatch.* 151.

One of two joint owners can legally grant, assign, license or sell his own share or right in the patent.—*May v. Chaffee*, 5 *Fish.* 160; 2 *Dillon* 385.

One joint owner can legally grant, assign, license or sell only in respect to his own share or right. He cannot sell and give a good title to his co-owner's right, for the same reason that one joint owner of a chattel cannot transfer the share of his co-proprietor.—*Pitts v. Hall*, 3 *Blatch.* 201.

A power of attorney derived from several principals which names their individual interests and gives the attorney authority to act for them jointly or separately, only requires an assignment conveying the interest of one of them to be made in the name of the party whose interest is transferred.—*May v. Chaffee*, 5 *Fish* 160; 2 *Dillon* 385.

If an assignment contains no warranty, but a simple transfer of title, the vendee cannot set up a parol warranty, for it must be presumed that the article contains the entire contract.—*Jolliffe v. Collins*, 21 *Mo.* 338; *Van Ostrand v. Reed*, 1 *Wend.* (*N. Y.*) 432.

Where a blank piece of paper instead of an assignment was given, the assignee should call upon the assignor for the correction of the mistake, and in the absence of this, or any excuse for the omission, a court of equity can afford no relief. —*Black v. Stone*, 33 *Ala.* 327.

The power of assignment under the statute has been so construed by the courts as to confine it to the transfer of an entire patent, an undivided part thereof, or the entire interest of the patentee or an undivided part thereof, within and throughout a certain specified portion of the United States.—*Littlefield v. Perry*, 7 *O. G.* 964; 21 *Wall.* 205.

An applicant for a patent is estopped from contradicting his deed of assignment, but an estoppel by deed arises alone upon

a recital of a particular fact.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

If the thing granted be only in the *habendum*, and not in the premises of the deed, the deed will not pass it.—*Gear v. Grosvenor*, 6 *Fish.* 314; 1 *Holmes* 215; 3 *O. G.* 380.

The statute authorizes assignments only in writing, and the legal ownership can be acquired only by written instruments.—*Jordan v. Dobson*, 4 *Fish.* 232; 2 *Abbott* 398; *Davy v. Morgan*, 56 *Barb.* (*N. Y.*) 218; *Galpin v. Atwater*, 29 *Conn.* 93.

Where an inventor has sold a part of his invention, he has done that which is quite consistent with an intent to have the assignee participate in all the rights which he, as inventor, can acquire by law.—*Clum v. Brewer*, 2 *Curt.* 506.

If a purchaser of a patent-right relies upon a contract or warranty, then the contract or warranty should be in the deed by which the law requires these rights to be transferred; it cannot be shown by parol.—*Rose v. Hurley*, 39 *Ind.* 77.

A conveyance of a right to use an invention in a limited territory is not required to be recorded in the Patent Office.—*Stevens v. Head*, 9 *Vt.* 174.

To warrant a patent, the invention must be useful, that is, capable of some beneficial use; not frivolous, pernicious or worthless.—*Dickinson v. Hall*, 14 *Pickering* (*Mass.*) 217; *Rowe v. Blanchard*, 18 *Wis.* 462.

If a person contracts for the purchase of a patent, and he receives and accepts a deed for a different patent, acts under it, and makes payments on account of it, he cannot in absence of fraud recover back the consideration paid merely because of a misunderstanding as to the extent of the rights conferred.—*Foss v. Richardson*, 15 *Gray* (*Mass.*) 303.

A parol ratification is not sufficient to give validity to a

deed made by an agent not having authority under seal to bind his principal.—*Stetson v. Patten*, 2 *Greenl.* (*Maine*) 358.

If one acting as attorney for another, but having no sufficient authority, make a deed in the name of his principal who is not bound thereby, it does not follow that the agent is bound by the deed, unless it contains apt words for that purpose.—*Stetson v. Patten*, 2 *Greenl.* (*Maine*) 358.

ASSIGNMENT BEFORE ISSUE OF PATENT.

If an agent is authorized to assign a patent when obtained, he may assign the invention before the patent issues, and have the patent granted to the assignee.—*Ex parte Eveleigh*, 1 *O. G.* 303; *Com. Dec.* 1872, p. 19.

An instrument purporting to convey inventions not yet in being, is not an assignment, but only an executory contract.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

The mere facts of assignment and record do not impose upon the Commissioner the duty of issuing letters-patent to the assignee without further request. The language of the statute is "*may* be made and issued," not "shall be," and it has been the constant practice of the Office to issue patents to the inventor unless otherwise specially requested by him. The rights of the assignee in the patent are precisely the same, whether the patent be issued to him or the inventor.—*Havemeyer, Elder & Loosey, Com. Dec.* 1870, p. 5.

The sale of an interest in a patent after it has been ordered to issue, is valid if executed by an attorney under a power to assign the patent to be obtained on the application.—*Ex parte Eveleigh*, 1 *O. G.* 303; *Com. Dec.* 1872, p. 19.

In determining to whom a patent shall issue, where assignments have been made, the Commissioner of Patents must be governed by the record. He cannot regard mere equitable

claims, but must issue the patent to the person or persons having the legal title, the requirements of the Office having been complied with.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

Whenever a patentee conveys his "invention" without any other language in the deed of conveyance restricting the right to use the invention, he must be considered to have granted the right to any letters-patent which may be issued thereon.—*Emmons v. Sladdin*, 9 *O. G.* 352; *Com. Dec.* 1876, p. 304; 2 *Bann. & Ard.* 199.

Where an invention is assigned before it is patented, the assignor is estopped, upon obtaining the patent, from setting up any adverse title.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 2 *Bann. & Ard.* 113; 13 *Blatch.* 114.

Where an inventor agrees to assign his invention, he is estopped, upon obtaining the patent, from setting up any adverse title if the purchaser tenders the purchase-price, because in such case the purchaser becomes the equitable owner of the patent.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 2 *Bann. & Ard.* 113; 13 *Blatch.* 114.

Inventions may be assigned before they are patented.—*Cammeyer v. Newton*, 11 *O. G.* 287; *Com. Dec.* 1877, p. 182; 94 *U. S.* 225.

In determining to whom a patent shall issue it is neither the duty nor within the power of the Office to reform or cancel assignments, or make decrees on the equitable rights of parties, based upon extraneous or *ex parte* proof.—*Ex parte Paine*, 13 *O. G.* 408; *Com. Dec.* 1878, p. 51.

There being conflicting claimants to ownership in an invention for which letters-patent were to issue, he was excluded from the grant whose assignment deed did not certainly identify the invention in controversy with the one which the deed conveyed.—*Ex parte Paine*, 13 *O. G.* 408; *Com. Dec.* 1878, p. 51.

Where an application is withheld from issue for the sole purpose of ascertaining who is a legal assignee to be included in the grant, an assignment deed will be considered, even though filed of record subsequently to the payment of the final fee.—*Ex parte Paine*, 13 *O. G.* 408; *Com. Dec.* 1878, p. 51.

An instrument purporting to be an assignment of an interest in all letters-patent to be subsequently obtained by the assignor, embodying improvements on his prior inventions, is not an actual transfer of the subsequent patents, but merely an agreement to transfer, enforcible only in a court of equity.—*Hammond v. Pratt* 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

An assignment of inventions not *in esse* does not warrant the issue of the subsequent patents to the assignee as sole or joint grantee, nor does it entitle him to appear as a party to proceedings upon the subsequent application in the Patent Office.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

Where a patent has been allowed and ordered to issue, and an assignment has been made authorizing the Commissioner to issue patent to assignee, and patent issued to inventor, the assignment not having been recorded until after the issue of the patent; *held*, that the legal title to the patent became vested in the assignee on the recording of the assignment.—*United States Stamping Co. v. Jewett*, 18 *O. G.* 1529; *Com. Dec.* 1880, p. 704; 18 *Blatch.* 469; 7 *Fed. Rep.* 869.

No assignment of an unpatented invention is required by Section 4895 of the Revised Statutes to be recorded, unless it is an assignment on which a patent is to be issued to the assignee; and in such case the invention must be so identified in the assignment—by a reference to a specification or application, or otherwise—that there can be no mistake as to what particular invention is intended.—*Wright v. Randel*, 21 *O. G.* 493; *Com. Dec.* 1882, p. 94; 19 *Blatch.* 495; 8 *Fed. Rep.* 591.

To insure the issuing of a patent to an assignee, the assign-

ment should contain a request to that effect.—*Wright v. Randel*, 21 *O. G.* 493; *Com. Dec.* 1882, p. 94; 19 *Blatch.* 495; 8 *Fed. Rep.* 591; *Havemeyer, Elder & Loosey, Com. Dec.* 1870, p. 5.

An assignment recorded in the Patent Office before the patent issues, which is intended to operate upon the perfect legal title which the assignor has a right to obtain as well as upon the inchoate right which he possesses, vests the assignee with the legal title, although the patent is subsequently granted to the assignor.—*Gayler v. Wilder*, 10 *How.* 477.

An assignment before issue of patent should contain a request that the patent be issued to the assignee, or words of a like import, in order to bring it within the sixth section of the Act of 1837.—*Gayler v. Wilder*, 10 *How.* 477; *Railroad Co. v. Trimble*, 10 *Wall.* 367; *U. S. Stamping Co. v. Jewett*, 18 *O. G.* 1529; *Com. Dec.* 1880, p. 704; 18 *Blatch.* 469; 7 *Fed. Rep.* 869; *Wright v. Randel*, 21 *O. G.* 493; *Com. Dec.* 1882, p. 94; 19 *Blatch.* 495; 8 *Fed. Rep.* 591; *Hendrie v. Sayles*, 8 *Otto* 546.

A deed by which an inventor conveys all his right in an invention and in or to the letters-patent that are or *may be* granted therefor, vests the legal title in the assignee.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

If the Commissioner of Patents refuse to grant a patent to an assignee it is not a subject of appeal to a judge of the Supreme Court of the District of Columbia, but for a court of general jurisdiction.—*Whitely v. Fisher*, 4 *Fish.* 248.

The sale of an "invention" carries with it the exclusive right to all present or future patents by the same inventor for the particular invention sold.—*Hammond v. Hunt*, 4 *Bann. & Ard.* 111.

Section 4895, Revised Statutes, which provides for the

granting of patents to assignees, does not restrict the grant to the *immediate* assignee.—*Selden v. Stockwell Self-Lighting Gas-Burner Co.*, 9 *Fed. Rep.* 390; 19 *Blatch.* 544; 20 *O. G.* 1377; *Com. Dec.* 1881, p. 431; *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 *O. G.* 1597.

The discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect by proceeding in the manner prescribed by law. An assignment of his whole interest, whether before or after the patent is issued, is equally within the provisions of the Act. If it is made before the issuing of the patent, it is sufficient to transfer the legal title to the assignee, although the patent afterwards issues to the inventor.—*Gayler v. Wilder*, 10 *How.* 477; *Rathbone v. Orr*, 5 *McLean* 131; *Rich v. Lippincott*, 2 *Fish.* 1; *Herbert v. Adams*, 4 *Mason* 15; 1 *Robb* 505.

An assignment of an invention is valid, notwithstanding it is made after the rejection of the application for patent by the Commissioner, and the inventor's appeal from that decision.—*Gay v. Cornell*, 1 *Blatch.* 506.

An assignment of an imperfect invention with all the improvements upon it that the inventor may make is equivalent in equity to an assignment of the perfected results, and the assignees become the owners of the patent granted upon the perfected invention; and if it be issued to the assignor he takes it in trust for the assignees and should convey.—*Littlefield v. Perry*, 7 *O. G.* 964; 21 *Wall.* 205.

In determining to whom a patent shall issue, the Commissioner of Patents must be governed by the record. He cannot regard mere equitable claims, but must issue the patent to the person having the legal title, the requirements of the Office having been complied with.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

The assignee of the whole right has entire control of a

pending application for a patent.—*Read v. Bowman*, 2 *Wall.* 591.

Where an inventor has sold a part of his invention, he has done that which is quite consistent with an intent to have the assignee participate in all the rights which he, as inventor, can acquire by law.—*Clum v. Brewer*, 2 *Curt.* 506.

Respecting the recording of an assignment of an invention, it is enough, within the terms of the sixth section of the Act of 1837, if it be recorded at any time before the issuing of the patent.—*Gay v. Cornell*, 1 *Blatch.* 506.

If a patent issues in the name of an inventor or his immediate assignee, although they had previously transferred their interest therein to a third party and the deed was duly recorded, the grant at once inures to the ultimate assignee.—*Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 *O. G.* 1597.

It is not essential to the validity of a patent that it be granted in the name of the owner, as shown by the records of the Patent Office. When the patent issues the legal title vests at once in the person who by the records is entitled to it.—*Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 *O. G.* 1597.

Under the Act of 1837, patents cannot be issued jointly to inventors and assignees of part interest, but may be issued to assignees of the *entire* interest.—4 *Opin. Atty. Genl.* 399.

Where an inventor makes a full and complete assignment of all his right in an invention before the issue of the patent, the assignee may have the patent issued in his name.—*In re Wilson Ager*, 9 *Opin. Atty. Genl.* 403.

ASSIGNMENT BY ASSENT.

An assignment on which a reissue was based, though alleged to have been forged by the assignee, yet having been recog-

nized by the assignor as valid; *held*, to be good.—*Campbell v. James*, 17 *Blatch.* 42; 18 *O. G.* 979; *Com. Dec.* 1880, p. 633.

An assignment of a patent by a person having no title with the written assent of the party in whom the title is, if in the form of a deed, is as effective as a conveyance directly from the owner.—*Sherman v. Champlain Co.*, 31 *Vt.* 162.

ASSIGNMENT BY PAROL.

An assignment of an interest in a patent to be valid must be in writing; it cannot be evidenced by parol testimony.—*Baldwin v. Sibley*, 1 *Cliff.* 150.

An interest in an invention cannot be assigned by parol so as to entitle the assignee to appear in the Patent Office and assert the right to become a joint patentee or to conduct the application in place of the inventor.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

A parol ratification is not sufficient to give validity to a deed made by an agent not having authority under seal to bind his principal.—*Stetson v. Patten*, 2 *Greenl.* (*Maine*) 358.

A contract by an employé to permit his employers to apply for and obtain a patent for a device he has invented, may be proved by parol.—*Lockwood v. Lockwood*, 33 *Iowa* 509.

ASSIGNMENT AS TO EXTENSIONS.

The assignment of a *patent*, or of the *invention* or *improvements*, does not convey the extended term, unless the terms used explicitly indicate that it was the intention of the parties to transfer the interest in the extension.—*Holmes & Spaulding*, 4 *O. G.* 581; *Com. Dec.* 1873, p. 166.

Where an *assignee* holding the original term of a patent and the right to an extension of same, assigns "all his right, title and interest," it conveys the right to the extension.—*Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

A court of equity will compel a corporation to execute a valid assignment of a patent in place of one which it has delivered without attaching its seal, and the Patent Office will, therefore, upon an application for an extension, treat the grantee under such an imperfect instrument as the owner of the patent.—*Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

An assignment of all the right, title, and interest in a patent does not convey the extended term. The conveyance of it must be in express terms, and the intention to transfer it must appear from the language.—*Holmes & Spaulding*, 4 *O. G.* 581; *Com. Dec.* 1873, p. 166.

The sale by a patentee of all right in an existing original patent does not extend beyond the term of said patent.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

A deed which conveys all right, title, and interest in an "invention," to the full end of the term for which said letters-patent "may be granted," carries the entire invention and all patents whensoever issued.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

An owner of a patent who conveys by deed "all his property and estate, whatsoever and wheresoever, of every kind and description," carries the right to the patent.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

An assignment of an interest in an invention, and letters-patent therefor, before the expiration of the original term, carries with it no interest in a subsequently extended term, unless there is specific provision to that effect.—*Gear v. Grosvenor*, 6 *Fish.* 314; 1 *Holmes* 215; 3 *O. G.* 380; *Jenkins v. Nicolson Pavement Co.*, 4 *Fish.* 201; 1 *Abbott* 567.

An ordinary assignment of the right in the patentee will not convey any right in the extended patent. When such interest is intended to be assigned it must be expressed.—*Case v. Redfield*, 4 *McLean* 526; 2 *Robb* 741; *Wilson v. Rousseau*, 4

How. 646; 2 *Robb* 372; *Gear v. Grosvenor*, 6 *Fish.* 314; 1 *Holmes* 215; 3 *O. G.* 380; *Woodworth v. Sherman*, 3 *Story* 171; 2 *Robb* 257; *Brooks v. Bicknell*, 4 *McLean* 64; *Wetherill v. Passaic Zinc Co.*, 6 *Fish.* 50; 2 [illegible] *G.* 471.

The extension of a patent is a [illegible]rant, and the right to it is contingent and personal to [illegible] and does not pass as an incident to the in[illegible]pertenant thereto.—*Mowry v. Railroad Co.*, [illegible] *Fish.* 536; *Clum v. Brewer*, 2 *Curt.* 506.

The term "renewal" is a proper and apt word to confer an interest in the extension of a patent.—*Pitts v. Hall*, 3 *Blatch.* 201; *Goodyear v. Cary*, 4 *Blatch.* 271; *Chase v. Walker*, 3 *Fish.* 120.

The phrase "to the full end of the term for which letters-patent are or *may be granted*," includes reissues, renewals, and extensions.—*Railroad Co. v. Trimble*, 10 *Wall.* 367; *Ruggles v. Eddy*, 5 *Fish.* 581; 10 *Blatch.* 52; *Thayer v. Wales*, 5 *Fish.* 448; *Phelps v. Comstock*, 4 *McLean* 353; *Case v. Redfield*, 4 *McLean* 526; 2 *Robb* 741; *Gear v. Holmes*, 6 *Fish.* 595; *Emmons v. Sladdin*, 9 *O. G.* 352; *Com. Dec.* 1876, p. 304; 2 *Bann. & Ard.* 199; *vide Hodge v. Railroad Co.*, 3 *Fish.* 410; 6 *Blatch.* 85.

The terms, "rights and property that I may have from any letters-patent for the same," are broad enough to include the extended letters-patent.—*Clum v. Brewer*, 2 *Curt.* 506.

An assignment of the invention after the patent has been issued, without any other language to indicate the intention of the parties, does not import a conveyance of the right to an extended term.—*Waterman v. Wallace*, 13 *Blatch.* 129; 2 *Bann. & Ard.* 126.

An assignment which, in express words, is limited to the period existing at the time of its execution, cannot be construed to cover a subsequent extension of the patent by special Act of Congress.—*Gibson v. Cook*, 2 *Blatch.* 144.

The grant of a future term of a patent, not yet *in esse*, is not the subject of assignment at common law or within the sense of Section 11 of the Act of 1836. The right could rest only in contract.—*Gibson v. Cook*, 2 *Blatch.* 144.

ATTORNEY.

An attorney appointed under an irrevocable power, coupled with an interest, and authorizing him to sell an invention in his discretion, is not a purchaser, but an agent.—*Ex parte Cox*, 2 *O. G.* 491; *Com. Dec.* 1872, p. 235.

If an agent is authorized to assign a patent when obtained, he may assign the invention before the patent issues and have the patent granted to the assignee.—*Ex parte Eveleigh*, 1 *O. G.* 303; *Com. Dec.* 1872, p. 19.

The sale of an interest in a patent after it has been ordered to issue, is valid if executed by an attorney under a power to assign the patent to be obtained on the application.—*Ex parte Eveleigh*, 1 *O. G.* 303; *Com. Dec.* 1872, p. 19.

Two parties owning exclusive patent-rights in different territories, and desiring to affect a community of interest in the whole property, conveyed the rights to a third person as trustee, authorizing him to sell rights, grant licenses, &c. The legal effect of the instrument was to make the trustee their agent to carry out their joint instructions.—*Laad v. Mills*, 20 *Fed. Rep.* 792; 22 *Blatch.* 242.

An instrument purporting to be an assignment of an expired patent is void as an assignment, although it may be good as a power of attorney to collect for infringements.—*Bell v. McCullough*, 1 *Fish.* 380; 1 *Bond* 194.

If a power of attorney is executed for the purpose of providing that a right in a patent may inure to the benefit of another, it is, in a court of equity, equivalent to an assignment. Such a power of attorney is a power coupled with an interest

in the *thing* itself, and is not revocable.—*Day v. Candee*, 3 *Fish.* 9.

A power of attorney derived from several principals which names their individual interests, and gives the attorney authority to act for them jointly or separately, only requires an assignment conveying the interest of one of them to be made in the name of the party whose interest is transferred.—*May v. Chaffee*, 5 *Fish.* 160; 2 *Dillon* 385.

When an instrument under seal is executed by attorney, the attorney must be authorized by deed under seal.—*Stetson v. Patten*, 2 *Greenl.* (*Maine*) 358.

A parol ratification is not sufficient to give validity to a deed made by an agent not having authority under seal to bind his principal.—*Stetson v. Patten*, 2 *Greenl.* (*Maine*) 358.

If one acting as attorney for another, but having no sufficient authority, make a deed in the name of his principal who is not bound thereby, it does not follow that the agent is bound by the deed, unless it contains apt words for that purpose.—*Stetson v. Patten*, 2 *Greenl.* (*Maine*) 358.

BANKRUPTCY.

Neither an assignee in insolvency nor a receiver can acquire or pass a title to a patent, except by a written instrument, signed by the owner of the patent and duly recorded.—*Gordon v. Anthony*, 16 *O. G.* 1135; *Com. Dec.* 1879, p. 638; 4 *Bann. & Ard.* 248; 16 *Blatch.* 234.

An assignment from a bankruptcy court to an assignee in bankruptcy of all patents owned by a bankrupt is not required to be recorded in the Patent Office, as Section 5046, Revised Statutes, vests all patent-rights at once in the assignee. A recorded assignment from an administrator of a bankrupt, made after the bankruptcy, cannot prevail over an assignment to the assignee in bankruptcy.—*Prime v. Brandon Mfg. Co.*, 4 *Bann. & Ard.* 379; 16 *Blatch.* 453.

A receiver, appointed by a State court, can convey no interest in a patent for the reason that the law requires the conveyance to be a written instrument signed by the owner of the patent.—*Gordon v. Anthony*, 4 *Bann. & Ard.* 243; 16 *O. G.* 1135; *Com. Dec.* 1879, p. 638; 16 *Blatch.* 234.

A receiver of an insolvent debtor is entitled to a patent-right belonging to the debtor; and a court is empowered to order the debtor to convey the right to such receiver if such conveyance is necessary.—*Petition of Keach, Receiver*, 19 *Reporter* 731.

An assignee under a State insolvent law does not acquire any legal title to any interest the debtor may have in a patent, as the statute contemplates a written instrument signed by the owner of the patent, and duly recorded in the Patent Office, in order to vest the legal title in the purchaser.—*Ashcroft v. Walworth*, 5 *Fish.* 528; 1 *Holmes* 152; 2 *O. G.* 546.

Where an agreement between joint owners of a patent to account to each other for profits derived from the use of the invention is a continuing consideration of the grant of the patent, it is not affected by the bankruptcy of one of the parties, and passes upon an assignment in bankruptcy to the assignee.—*Fraser v. Gates*, 20 *Reporter* 427.

BREACH OF CONTRACT.

If assignee refuse to perform conditions that were to be performed subsequently, it cannot revest assignor with title to the invention. His remedy is action for damages.—*Mallory v. Mackaye*, 22 *O. G.* 945; *Com. Dec.* 1882, p. 405; 12 *Fed. Rep.* 328.

Equity will enforce a lien for purchase money, but it does not vacate a transfer because the purchase money has not been paid.—*Perkins v. U. S. Electric Light Co.*, 24 *O. G.* 204; *Com. Dec.* 1883, p. 322; 21 *Blatch.* 308; 16 *Fed. Rep.* 513.

A failure to make stipulated payments does not necessarily terminate a license.—*White v. Lee*, 3 *Fed. Rep.* 222; 5 *Bann. & Ard.* 572.

Where an assignment of a patent is good as between the parties, and there has been a partial performance, it cannot be rescinded; the only remedy is action for damages for breach of contract.—*Moore v. Bare*, 11 *Iowa* 198.

If a licensor seeks to set aside a license on account of a breach of contract, the defendant is not estopped from denying the validity of a patent by the recitals in the contract.—*Burr v. Duryee*, 2 *Fish.* 275; 1 *Wall.* 531.

If the terms of a contract make the performance of its stipulations by the licensee a condition to his continued use of the machine, the conditions must be observed or he forfeits his rights.—*Brooks v. Stolley*, 3 *McLean* 523; 2 *Robb* 281; *Woodworth v. Cook*, 2 *Blatch.* 151.

On breach of condition, the patentee has a right to avoid the contract and to be remitted to his original rights; and the licensee is also remitted to his original position and rights, as the contract must be avoided altogether if at all. It cannot be obligatory upon the one party and not upon the other.—*Woodworth v. Cook*, 2 *Blatch.* 151.

A notice from a licensor forbidding the licensee to use or exercise the right granted by the license, on account of a breach thereof, does not *ipso facto* annul or rescind the contract, and if the licensee continues to use, the licensor may recover the royalties stipulated in the license.—*Union Mfg. Co. v. Lounsbury*, 42 *Barb.* (*N. Y.*) 125.

BURDEN OF PROOF.

Where an unconditional license executed by the complainant is in the possession of the defendant, and is produced by him in the trial, the burden of proof is upon the complainant to

show that it was delivered as an escrow.—*Mellon v. Del. Lack. & Western R. R.*, 21 *O. G.* 1616; *Com. Dec.* 1882, p. 253.

A licensee cannot set up as a defence to the payment of a note, the pretext that the patent infringes previous existing patents. The burden of proof is on him to show it before he can establish a failure of consideration.—*Davis v. Gray*, 17 *Ohio St.* 330.

If a purchaser has had the quiet enjoyment of a patent, the burden of proof is on him to show that no right was conveyed, if he seeks to recover against the vendor.—*Stevens v. Head*, 9 *Vt.* 174.

If the purchaser of an invention with a covenant of warranty yields without suit to a superior title to that of the vendor, he may sue on the covenant and recover; but the burden of proving the superiority of the title to which the vendee yielded rests on him.—*Orr v. Burwell*, 15 *Ala.* 378.

CANCELLING ASSIGNMENTS.

The cancellation of a deed does not revest the grantor with title, though it is done with that intention.—*Steel v. Steel*, 4 *Allen* (*Mass.*) 417.

If an assignee agrees to pay a stipulated amount to the assignor each year, and reserves the right to cancel the agreement on six months' notice to the assignor, he is liable for the proportionate value for the fraction of a year he has had the use of the invention, if he elects to terminate the agreement before the close of a year.—*Gale v. Nourse*, 15 *Gray* (*Mass.*) 300.

The purchaser of a patent-right on the representation that it covers a machine which in fact it does not, may have the deed of assignment and note given for the purchase money cancelled in a court of equity.—*Burrall v. Jewett*, 2 *Paige* (*N. Y.*) 134.

A court of equity will not decree the cancelment of a contract, except for fraud or mistake.—*Brooks v. Stolley*, 3 *McLean* 523; 2 *Robb* 281.

COMPELLING ASSIGNMENT.

A court of equity will compel a corporation to execute a valid assignment of a patent in place of one which it has delivered without attaching its seal, and the Patent Office will, therefore, upon an application for an extension, treat the grantee under such an imperfect instrument as the owner of the patent.—*Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

When the parties to a suit are citizens of the same State, a bill to compel the execution of further transfers under an agreement is not maintainable in the United States Circuit Court.—*Perry v. Littlefield*, 17 *O. G.* 51; *Com. Dec.* 1880, p. 217; 17 *Blatch.* 272.

A patent-right issued under the laws of the United States may be required to be assigned to a receiver, under proceedings supplementary to execution, who may sell the same and apply the proceeds in satisfaction of the judgment.—*Pacific Bank v. Robinson*, 20 *O. G.* 1314; *Com. Dec.* 1881, p. 429; 57 *Cal.* 520.

A court of equity may direct the sale of the interest of an inventor in his patent in order to satisfy a judgment debt against him, and for that purpose may require the patentee to make an assignment of the patent under Section 4898, Revised Statutes, and in default of such assignment within a limited time the court may appoint a trustee to execute the same.—*Murray v. Ager*, 20 *O. G.* 1311; *Com. Dec.* 1881, p. 423; 1 *Mackey* 87.

A State court may compel a judgment debtor to execute and deliver to a receiver an assignment of his interest in letters-

patent.—*Clan Ranald v. Wyckoff*, 41 *N. Y. Supr.* 527; *Barnes v. Morgan*, 10 *N. Y. Supr.* 703.

It is competent for a State court under an insolvent law to compel a debtor to execute an assignment that would transfer a patent-right to an assignee in insolvency.—*Ashcroft v. Walworth*, 5 *Fish.* 528; 1 *Holmes* 152; 2 *O. G.* 546.

CONDITION.

One holding title upon condition must perform the condition at his peril. He cannot come into a court of equity to have the question settled whether the conditions are performed in order to save him from the consequences of a mistake.—*Florence S. M. Co. v. Singer Mfg. Co.*, 4 *Fish.* 329; 8 *Blatch.* 113.

If it be doubtful whether a clause in a deed is a condition or a covenant, the courts will incline against the former construction.—*Hoyt v. Kimball*, 49 *N. H.* 322.

A condition in a deed cannot be apportioned. Whenever the reversion is granted by the maker of the condition, the condition is gone.—*Tinkham v. Erie R. R.*, 53 *Barb.* (*N. Y.*) 393.

CONDITIONAL ASSIGNMENT.

The clause of forfeiture for non-performance contained in an assignment, does not reduce the grantee to the position of a licensee. For the non-payment or other non-performance a forfeiture might be enforced as for a condition broken, but until it is enforced the title granted remains in the assignee.—*Littlefield v. Perry*, 7 *O. G.* 964; 21 *Wall.* 205.

When a patent has been assigned upon condition of re-assignment under certain contingency, the court will decree a re-transfer when the contingency arises.—*Andrews v. Fielding*, 20 *Fed. Rep.* 123.

Where an assignment of an interest in a patent is made upon a condition subsequent, and not precedent, to the vesting of the interest, the question whether the defeasance has taken effect is for the courts, which have, and not for the Patent Office, which has not, the means for its proper adjudication.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

Where a contract stipulates that an arbitration is to be a condition precedent to the right to sue upon the contract, or if this may be inferred upon construction, no suit can be maintained unless the plaintiff has made all reasonable efforts to comply with the condition.—*Perkins v. U. S. Electric Light Co.*, 24 *O. G.* 204; *Com. Dec.* 1883, p. 322; 21 *Blatch.* 308; 16 *Fed. Rep.* 513.

A company having agreed to pay a certain sum, upon a certain condition to be determined by arbitration, and then prevents arbitration, it may be sued at law on a *quantum valebat.—Humaston v. Telegraph Co.*, 20 *Wall.* 20.

One holding title upon condition must perform the condition at his peril. He cannot come into a court of equity to have the question settled whether the conditions are performed in order to save him from the consequences of a mistake.—*Florence S. M. Co. v. Singer Mfg. Co.*, 4 *Fish.* 329; 8 *Blatch.* 113.

The non-performance of conditions subsequent does not affect the right and title vested in a licensee until a forfeiture is enforced.—*Stanley Rule & Level Co. v. Bailey*, 3 *Bann. & Ard.* 297; 14 *Blatch.* 510.

A condition in a deed cannot be apportioned. Whenever the reversion is granted by the maker of the condition, the condition is gone.—*Tinkham v. Erie R. R.*, 53 *Barb.* (*N. Y.*) 393.

A license granted by an assignee who had not fulfilled the conditions of his purchase, but had defaulted in his payments,

is not a defense to infringement.—*Abbett v. Zusi*, 5 *Bann.* & *Ard.* 38.

If a grantee fails to perform the conditions of his contract, and does not claim any right under it, but on the contrary, recognizes the assignor's exclusive right to the interest referred to in the agreement, the contract has no vitality.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

A deed conveys a title, although it may have covenants in it which have not been performed. There are things which rest in grant, and things which rest in covenant. If the covenant fails by the *laches* of the grantor, the grant nevertheless stands. The covenant does not affect the grant; the grant passes the title and operates *in praesenti*.—*Day v. Stellman*, 1 *Fish.* 487.

If an assignee agrees to pay a stipulated amount to the assignor each year, and reserves the right to cancel the agreement on six months' notice to the assignor, he is liable for the proportionate value for the fraction of a year he has had the use of the invention, if he elects to terminate the agreement before the close of a year.—*Gale v. Nourse*, 15 *Gray* (*Mass.*) 300.

The performance of a condition precedent does not necessarily make the grant absolute so as to vest the assignee with title.—*Pitts v. Hall*, 3 *Blatch.* 201.

A covenant in a deed that the assignee shall "enjoy an exclusive use to the said patent within the said territory," limited to a certain number of machines, passes the whole right of the patentee for the particular territory.—*Ritter v. Serrell*, 2 *Blatch.* 379.

Whether the machine is perfected or not at the time of the sale is immaterial, if the inventor agrees to make it perfect and procure a patent.—*Rathbone v. Orr*, 5 *McLean* 131.

CONSIDERATION.

The maker of a note given for a patent-right cannot be compelled to pay it, if the patent for which it was given is utterly worthless.—*Clough v. Patrick*, 37 *Vt.* 421.

The statute of Indiana, which requires promissory notes given for patent-rights to contain above the signature the words "given for a patent-right," declared unconstitutional and void.—*Helm v. First Nat. Bank*, 43 *Ind.* 167.

A purchaser having accepted a deed which described the patent and invention conveyed to him, cannot, in the absence of fraud, recover the money he has paid, on the ground that the invention is not what he thought it was.—*Foss v. Richardson*, 15 *Gray* (*Mass.*) 303.

If an invention cannot be made except at the will or after further agreement with the grantor, then the right to use and sell is valueless, and the consideration paid is without return. —*Hamilton v. Kingsbury*, 14 *O. G.* 448; *Com. Dec.* 1878, p. 339; 3 *Bann. & Ard.* 346; 15 *Blatch.* 64.

Something having been acquired by reason of a license, even though the right was not exclusive as intended, there is not a failure of consideration.—*Laver v. Dennett*, 25 *O. G.* 882; *Com. Dec.* 1883, p. 449; 109 *U. S.* 90.

An agreement to give promissory notes, in consideration of an assignment of the invention, as soon as the patent issued, is not avoided in view of the fact that no patent issued until after the day when the last note would have been payable.—*Read v. Bowman*, 2 *Wall.* 591.

The grant of a license to sell a patented article, if the patent be void, passes nothing to the licensee and consequently does not constitute a valuable consideration for a promissory note given in payment. If, however, the patent be valid, it is in law a valuable right, although it may not be a profitable one,

and the grant of a license under it is a valid consideration for a promise to pay.—*Wilson v. Hentges*, 3 *N. W. Rep.* 338.

The consideration expressed in a conveyance of an interest in a patent is not conclusive upon the parties. Either party is at liberty to show the true consideration of the transfer.—*Wheeler v. Billings*, 38 *N. Y.* 263; *Adams v. Hull*, 2 *Denio* (*N. Y.*) 306.

Upon failure of an assignee to pay the money within the time specified (and in default of which he had agreed to re-assign the patent), the assignor acquires the right to demand a reassignment, and if not reassigned he can recover the value of it.—*Manvel v. Holdredge*, 45 *N. Y.* 151.

A prior unrecorded assignment is good against subsequent purchaser without *valuable consideration.—Saxton v. Aultman*, 15 *Ohio St.* 471.

A promissory note given for a void patent-right is without consideration.—*Dickinson v. Hall*, 14 *Pickering* (*Mass.*) 217; *Bliss v. Negus*, 8 *Mass.* 46; *Cross v. Huntley*, 13 *Wend.* (*N. Y.*) 385; *Head v. Stevens*, 19 *Wend.* (*N. Y.*) 411; *Kernodle v. Hunt*, 4 *Blackf.* (*Ind.*) 57; *Higgins v. Strong*, 4 *Blackf.* (*Ind.*) 182; *McClure v. Jeffrey*, 8 *Ind.* 79; *Nye v. Raymond*, 16 *Ill.* 153; *Jolliffe v. Collins*, 21 *Mo.* 338; *Rowe v. Blanchard*, 18 *Wis.* 462; *Rice v. Garnhart*, 34 *Wis.* 453.

When money has been paid for a patent-right it cannot be recovered back, unless the contract has been rescinded, or was tainted with fraud, or was accompanied by a warranty that has not been fulfilled.—*Case v. Morey*, 1 *N. H.* 347; *Myers v. Turner*, 17 *Ill.* 179; *Hardesty v. Smith*, 3 *Ind.* 39.

If an invention lack novelty or utility in its application to any one of the several objects for which it is patented, it will not prevent a recovery upon a note given therefor.—*Midkiff v. Boggess*, 15 *Ind.* 210.

A licensee cannot set up as a defense to the payment of a

note, the pretext that the patent infringes previous existing patents. The burden of proof is on him to show it before he can establish a failure of consideration.—*Davis v. Gray*, 17 *Ohio St.* 330.

If a patent be utterly frivolous or worthless, it is not within the meaning of the law "useful," and is not, therefore, good consideration for a note, although the vendor may have acted in good faith.—*Lester v. Palmer*, 4 *Allen* (*Mass.*) 145.

A void patent is not a good consideration for a note. In an action for the purchase money for a patent sold, the defendant may show that there was no such patent, or that it was invalid, or that the vendor had no right to sell it.—*Nye v. Raymond*, 16 *Ill.* 153.

The payment of a note given for a patent-right may be defeated for want of consideration, by reason of a breach of warranty on part of the vendor.—*Hawes v. Twogood*, 12 *Iowa* 582.

The assignor of a patent-right must show title in himself to convey according to his contract, before he can sue for the consideration that was to have been paid.—*Edwards v. Richards*, *Wright* (*Ohio*) 596; *Bellas v. Hays*, 5 *Serg.* & *Rawle* (*Penn.*) 427.

If several payees of a note endorse it over to one of their number, payment may be avoided if the note were given for a license under a void patent.—*Saxton v. Dodge*, 57 *Barb.* (*N. Y.*) 84.

The detriment which a purchaser may suffer on account of a failure of a part of the thing patented, does not prejudice the right of the vendor to recover.—*Holchkiss v. Oliver*, 5 *Denio* (*N. Y.*) 314.

A purchaser may avoid the payment of a note if the device patented is not operative. He is not required to use inventive genius in order to construct a different machine to give value

to that which he purchased.—*Craigin v. Fowler*, 34 *Vt.* 326; *Clough v. Patrick*, 37 *Vt.* 421; *Williams v. Hicks*, 2 *Vt.* 36.

If a patented machine and the exclusive right to use it within a certain district is the consideration for which a note is given, and the value of the machine has been paid, the vendor can make no further recovery if the patent be void.—*Earl v. Page*, 6 *N. H.* 477.

If the invention was useful and valuable at the time of the sale, the consideration of the note given therefor will not be impeached by showing that subsequent improvements have rendered the invention useless. The purchaser, when he buys, takes the risk of any new discovery which may destroy the value of his property.—*Harmon v. Bird*, 22 *Wend.* (*N. Y.*) 113.

The purchaser of a patent-right who subsequently transfers it to another is precluded from saying that what he sold is valueless in order to avoid payment of a note which he had given therefor.—*Thomas v. Quintard*, 5 *Duer* (*N. Y.*) 80.

If a patentee is guilty of no fraud, and the purchaser has received what he contracted for, he can not complain, nor can he reduce the amount of the stipulated price, unless there has been a warranty and a breach of it.—*Vaughan v. Porter*, 16 *Vt.* 266.

If an assignment of three patents is in the nature of a quit-claim deed of whatever right, title or interest the assignor has or may acquire in the patents specified, and creates no warranty that either of the patents was valid, the transfer is legal and sufficient consideration for the notes given, even if one of the patents is invalid.—*Gilmore v. Aiken*, 118 *Mass.* 94.

If a contract shows that the parties mutually contemplated the possibility, if not the probability, that the patent was invalid, and provided by the form of the instrument and its stipulations for the contingency, it is very clear that there is

no ground on which the vendee can be permitted to set up a failure of consideration, even if the patent be void.—*Johnson v. Willimantic Linen Co.*, 33 *Conn.* 436.

A covenant of warranty is not a good consideration for a note if the patent is void.—*Dickinson v. Hall*, 14 *Pickering* (*Mass.*) 217.

It is no defense to an action on a note given for a reassignment of an interest in an invention, that a patent subsequently issued to the payee of the note for a part of the theory embraced in the application of the maker of the note.—*Clark v. Smith*, 21 *Minn.* 539.

Where the payment of purchase money is dependent on the conveyance of a right, and the latter is made a condition precedent, and no right passes on account of the imperfect character of the writing, an action for enforcing the payment will not be sustained.—*Bellas v. Hays*, 5 *S. & R.* (*Pa.*) 427.

If the action is in covenant on a sealed instrument, a good consideration is implied from the solemn form of the promise in writing and under seal, and the invalidity of the patent would not be a good bar to any recovery.—*Wilder v. Adams*, 2 *W. & M.* 329.

If a patent is invalid an assignee may have a remedy on a covenant, but he cannot, as a general principle and in ordinary cases, resort to such a defense as a want of consideration, or a failure of consideration, when an action is brought upon a sealed instrument executed in consequence of and founded on another covenant made by the patentee to him.—*Wilder v. Adams*, 2 *W. & M.* 329.

Until a licensee is disturbed in exercising his license by some party claiming to be the owner of the patent, he cannot call upon the vendor in an action for the purchase money agreed to be paid, to establish his title.—*Buss v. Putney*, 38 *N. H.* 44; *Holden v. Curtis*, 2 *N. H.* 61.

If a person purchases and pays for a patent-right, and the vendor sends him an assignment for a different patent, he may refuse to receive it, and demand and recover back the money which he has paid.—*Foss v. Richardson*, 15 *Gray* (*Mass.*) 303.

Where there has been no misrepresentation or concealment of a material fact by the vendor, the purchaser cannot recover the money which was voluntarily paid, with a full knowledge of all the facts in relation to the transaction, although the patent be void.—*Stevens v. Head*, 9 *Vt.* 174.

A contract which provides for the refunding of the purchase money in case the purchaser does not realize a certain amount from the patented article within a specified time, imposes upon the purchaser a proper effort on his part to make sales, although the writing may be silent in this respect.—*Berger v. Peterson*, 78 *Ill.* 633.

A patent-right is not a corporeal thing either real or personal, but something intangible and incorporeal, resting wholly in grant. In contracts for the assignment of such interests, if there be no fraud, the purchaser must depend, in case they prove of no value, wholly upon his covenants. He has no remedy for his money if there is a failure of title.—*Hiatt v. Twomey*, 1 *Dev. & Bat. Eq.* (*N. C.*) 315; *Cansler v. Eaton*, 2 *Jones Eq.* (*N. C.*) 499.

A purchaser cannot recover back the consideration paid, if he has derived any benefits from the use of the patent, although the patent is void.—*Holden v. Curtis*, 2 *N. H.* 61.

A mere representation by the assignor that the device patented is useful and valuable, will not defeat the payment of a note given therefor so long as the patent is valid.—*Kernodle v. Hunt*, 4 *Blackf.* (*Ind.*) 57.

A misrepresentation as to what a patented device would accomplish might be available, under a proper issue, in mitigation of damages; but in an action of covenant on a sealed

note, it should also be averred that the property for which the note was given was of no value, or that it had been returned or tendered to the vendor.—*Mullikin v. Latchem*, 7 *Blackf.* (*Ind.*) 136; *Hardesty v. Smith*, 3 *Ind.* 39.

The purchaser of a patent-right may set up as a defense in an action upon his note, that he was induced to purchase by means of fraudulent representations on the part of the vendor as to the qualities, capabilities, and usefulness of the invention. —*Groff v. Hansel*, 33 *Md.* 161.

If a purchaser, by false and fraudulent representations of the vendor in matters not known to him and which are peculiarly within the knowledge of the vendor, is induced to make the purchase and give his note therefor, and would not have entered into the contract of purchase if it had not been for such representations, the note is without consideration and the vendor cannot recover.—*Bierce v. Stocking*, 11 *Gray* (*Mass.*) 174.

If a person sells an article which he falsely and fraudulently represents to be regularly patented, the bond given therefor is rendered void, and the transaction is a fraud for which action will lie.—*Brown v. Wright*, 17 *Ark.* 9; *Bull v. Pratt*, 1 *Conn.* 342.

A court of equity will not relieve a purchaser of a patent-right from liability upon his bond, if there were no fraud on the part of the assignor, notwithstanding the patent may be void.—*Cansler v. Eaton*, 2 *Jones Eq.* (*N. C.*) 499.

When a party undertakes to sell and does sell a patent-right, he cannot recover on notes given therefor, unless he proves he had a patent from the proper authority of the United States.—*Brown v. Wright*, 17 *Ark.* 9.

In an action on a promissory note given for a patent-right it is not relevant, under the plea of *non assumpsit*, for the assignee to show that it is useless and of no value.—*Williams v. Hicks*, 2 *Vt.* 36.

Where there has been fraud on the part of the vendor in the sale of goods, an offer by the vendee to return them in reasonable time constitutes a good defense in an action for their price.—*Howard v. Cadwalader*, 5 *Blackf.* (*Ind.*) 225; *Wynn v. Hiday*, 2 *Blackf.* (*Ind.*) 123.

CONSTRUING ASSIGNMENTS.

The granting clause in an assignment of a patent being in the usual form, it does not convey the extended term, though the *habendum* clause contains these words: "to be held and enjoyed by the said," etc., "to the full end of the term for which said letters-patent may be granted by reissue or otherwise during said term."—*Ex parte Waterman*, *Com. Dec.* 1869, p. 51.

Where an *assignee* who holds the original term of a patent, and the right to the extension of the same, assigns "all his right, title, and interest," such assignment must be held to convey all the interest of which he has become possessed, including the right to the extension, even though the instrument does not name the extension in terms.—*Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

An assignment of the full and exclusive right to all the improvements made by an inventor, as set forth in the specification of a patent, does not convey his interest in the extension of the patent.—*Holmes and Spaulding*, 4 *O. G.* 581; *Com. Dec.* 1873, p. 166.

An assignment of all the right, title, and interest in a patent does not convey the extended term. The conveyance of it must be in express terms, and the intention to transfer it must appear from the language.—*Holmes and Spaulding*, 4 *O. G.* 581; *Com. Dec.* 1873, p. 166.

The inchoate right to letters-patent, and to any renewals and extensions thereof, may be conveyed by an instrument

containing apt terms to show an intention to convey all the rights springing from the invention.—*Emmons v. Sladdin*, 9 *O. G.* 352; *Com. Dec.* 1876, p. 304; 2 *Bann. & Ard.* 199.

In determining to whom a patent shall issue it is neither the duty nor within the power of the Office to reform or cancel assignments, or make decrees on the equitable rights of parties, based upon extraneous or *ex parte* proof.—*Ex parte Paine*, 13 *O. G.* 408; *Com. Dec.* 1878, p. 51.

The clear meaning of a written instrument cannot be changed in the Patent Office by parol proof that the parties intended something else.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

The expression "right, title, and interest" contained in an assignment from a person holding under the patentee, is enough to put the assignee on inquiry, and to charge him with notice of what such inquiry, if made of the first grantor, would have disclosed.—*Hamilton v. Kingsbury*, 17 *O. G.* 847; *Com. Dec.* 1880, p. 373; 5 *Bann. & Ard.* 157; 17 *Blatch.* 460; 4 *Fed. Rep.* 428.

An assignment by the inventor of a patent, together with the right to improvements to be subsequently invented or patented, does not include a later patent where the construction and mode of operation is substantially different.—*Stebins Hydraulic Elevator Mfg. Co. v. Stebins*, 17 *O. G.* 1348; *Com. Dec.* 1880, p. 498; 4 *Fed. Rep.* 445; 5 *Bann. & Ard.* 199.

A conveyance of "all my right, title, and interest in and to" a patent, though properly recorded, does not include the right for two counties covered by a prior conveyance, although the prior conveyance was not recorded in the Patent Office.—*Turnbull v. Weir Plow Co.*, 23 *O. G.* 91; *Com. Dec.* 1883, p. 121; 5 *Bann. & Ard.* 288; 14 *Fed. Rep.* 108; 9 *Biss.* 334.

A written instrument having imperfectly expressed the intention of the parties, but the parties having acted according

to their actual agreement, and over two years having elapsed, the appellant could only have the mutual mistake in the language of the instrument corrected, and it would be inequitable to absolve him from the obligation of his contract.—*Laver v. Dennett*, 25 *O. G.* 882; *Com. Dec.* 1883, p. 449; 109 *U. S.* 90.

An owner of a patent who conveys by deed "all his property and estate, whatsoever and wheresoever, of every kind and description," carries the right to the patent.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

In giving interpretation to a particular clause in a deed, we must look to every part of it, in order to ascertain whether such interpretation is the true one.—*Day v. Cary*, 1 *Fish.* 424.

The phrase: "term for which the said letters-patent are or may be granted," when found only in the *habendum* clause, will not carry any interest in the extended term.—*Gear v. Grosvenor*, 6 *Fish.* 314; 1 *Holmes* 215; 3 *O. G.* 380; *Jenkins v. Nicolson Pavement Co.*, 4 *Fish.* 20. 1 *Abbott* 567.

Contracts touching the transfer and use of patented inventions are to be construed in the same way as contracts respecting other species of property.—*Star Salt Caster Co. v. Crossman*, 3 *Bann. & Ard.* 281; 4 *Cliff.* 568.

Any assignment which does not convey to the assignee the entire and unqualified monopoly which the patentee holds, or an undivided interest thereof, is a mere license.—*Sanford v. Messer*, 5 *Fish.* 411; 1 *Holmes* 149; 2 *O. G.* 470; *Theberath v. Celluloid Mfg. Co.*, 3 *Fed. Rep.* 143; 5 *Bann. & Ard.* 177.

The word "invention" used in an agreement to assign a patent, refers to the invention described in that patent, and does not include subsequent improvements, although the first patent may be valueless without them.—*United Nickel Co. v. Am. Nickel Plating Works*, 4 *Bann. & Ard.* 74.

If it be doubtful whether a clause in a deed is a condition or a covenant, the courts will incline against the former construction.—*Hoyt v. Kimball*, 49 *N. H.* 322.

An assignment is a grant in writing of the whole or a part of the exclusive right vested in the patentee by the letters-patent, and it makes no difference whether such part be designated as an undivided part of the whole patent, or as the grant of the exclusive right of the patentee within a particular district.—*Baldwin v. Sibley*, 1 *Cliff.* 150; *Farrington v. Gregory*, 4 *Fish.* 221.

Although an invention is misnamed in a conveyance, if the deed furnishes sufficient means for correcting the mistake, or identifying the thing sold, it will pass title to the invention patented.—*Harmon v. Bird*, 22 *Wend.* (*N. Y.*) 113.

In a case of well-founded doubt, the construction should be against the grantor, as he is chargeable with any obscurity in this respect.—*Smith v. Selden*, 1 *Blatch.* 475; *May v. Chaffee*, 5 *Fish.* 160; 2 *Dillon* 385.

Where there is doubt as to the proper construction of an instrument, a subsequent deed of confirmation is entitled to great consideration; but where its meaning is clear in the eye of the law, the error of the parties cannot control its effect.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

The interpretation of a contract is to be determined by the sense in which the parties intended to use the terms employed to express it.—*Wetherill v. Passaic Zinc Co.*, 6 *Fish.* 50; 2 *O. G.* 471.

The sense in which the parties intended to use the terms employed in a contract, must be gathered from the instrument itself, irrespective of declarations written or oral by either party as to his understanding of its meaning or as to his motives in making it.—*Wetherill v. Passaic Zinc Co.*, 6 *Fish.* 50; 2 *O. G.* 471.

In aid of the interpretation of a contract, it is proper to consider facts cognate to the subject of the contract and within the knowledge of the parties to which it may, therefore, be presumed that the stipulations of the contract were intended

to be applied, and by which their effect and meaning were to be governed.—*Wetherill v. Passaic Zinc Co.*, 6 *Fish.* 50; 2 *O. G.* 471.

An assignment of an interest in an invention secured by letters-patent is a contract, and, like all other contracts, is to be construed so as to carry out the intention of the parties.—*Nicolson Pavement Co. v. Jenkins*, 14 *Wall.* 452; 5 *Fish.* 491; 1 *O. G.* 465.

It is not to be presumed that a grantor intends to grant more than he has a right to grant, or that a grantee intends to receive, by way of grant, that to which he has a full right without a grant.—*Goodyear v. Cary*, 4 *Blatch.* 271; *Day v. Cary*, 1 *Fish.* 424.

In giving interpretation to a particular clause of a deed, every part of the deed must be considered in order to ascertain whether such interpretation is the true one.—*Goodyear v. Cary*, 4 *Blatch.* 271; *Baldwin v. Sibley*, 1 *Cliff.* 150.

A certificate that A. "is the owner of five-fortieth parts of the letters-patent," is not such an assignment of letters-patent as the law requires, and would give the person no interest whatever in the patent.—*Hope Iron Works v. Holden*, 58 *Maine* 146.

The terms "rights and property that I may have from any letters-patent for the same," are broad enough to include the extended letters-patent.—*Clum v. Brewer*, 2 *Curt.* 506.

An assignment of the invention after the patent has been issued, without any other language to indicate the intention of the parties, does not import a conveyance of the right to an extended term.—*Waterman v. Wallace*, 13 *Blatch.* 129; 2 *Bann. & Ard.* 126.

A man can pass by grant or assignment only that which he now possesses, and which is in existence at the time either actually or potentially. His grant or assignment is therefore

by its natural interpretation limited to the rights and things which are then in existence, and which he has power to grant, unless he uses other language which imports an intention to grant what he does not now possess, and what is not now in existence. In the latter case the language does not even then operate strictly as an assignment or grant, but only as a covenant or contract which a court of equity will carry into full effect when the right or thing comes *in esse*.—*Woodworth v. Sherman*, 3 *Story* 171; 2 *Robb* 257.

The phrase "to the full end of the term for which letters-patent are *or may be granted*," includes reissues, renewals, and extensions.—*Railroad Co. v. Trimble*, 10 *Wall.* 367; *Ruggles v. Eddy*, 5 *Fish.* 581; 10 *Blatch.* 52; *Thayer v. Wales*, 5 *Fish.* 448; *Phelps v. Comstock*, 4 *McLean* 353; *Case v. Redfield*, 4 *McLean* 526; 2 *Robb.* 741; *Gear v. Holmes*, 6 *Fish.* 595; *Emmons v. Sladdin*, 9 *O. G.* 352; *Com. Dec.* 1876, p. 304; 2 *Bann. & Ard.* 199; *vide Hodge v. Railroad Co.*, 3 *Fish.* 410; 6 *Blatch.* 85.

An assignment which, in express words, is limited to the period existing at the time of its execution, cannot be construed to cover a subsequent extension of the patent by special Act of Congress.—*Gibson v. Cook*, 2 *Blatch.* 144.

Where a patentee assigns all *his* right, title, and interest for a particular territory, it will not affect a previous unrecorded assignment, if there is a residuary interest left in the patentee on which the second assignment can operate. In the absence of proof it cannot be inferred from the language that the patentee intended fraud upon his assignee.—*Turnbull v. Weir Plow Co.*, 6 *Biss.* 225; 7 *O. G.* 173; 1 *Bann. & Ard.* 544; *Ashcroft v. Walworth*, 5 *Fish.* 528; 1 *Holmes* 152; 2 *O. G.* 546.

Purchasers are bound to examine the title of their grantor, and ascertain the extent of his right.—*Hawley v. Mitchell*, 4 *Fish.* 388; 1 *Holmes* 42; 1 *O. G.* 306.

A patentee may so convey the right to make as to involve or include the right either to sell or use what the grantee makes. He may also so convey the right to use as to imply the right to sell within the same limits, as well as to make the thing patented, within them. The circumstances, nature, and words of each grant must decide the construction which is just and legal.—*Woodworth v. Curtis*, 2 *W.* & *M.* 524; 2 *Robb* 603; *Steam Stone Cutter Co. v. Sheldon*, 5 *Fish.* 477; 10 *Blatch.* 1.

If the thing granted be only in the *habendum*, and not in the premises of the deed, the deed will not pass it.—*Gear v. Grosvenor*, 6 *Fish.* 314; 1 *Holmes* 215; 3 *O. G.* 380.

Words stricken out of an instrument may be looked at to ascertain the intention of the parties to it.—*May v. Chaffee*, 5 *Fish.* 160; 2 *Dillon* 385.

CONSTRUING CONTRACTS.

A license or contract for the use of an invention is subject to the same rules of construction as apply to any other contract.—*Wetherill v. Passaic Zinc Co.*, 6 *Fish.* 50; 2 *O. G.* 471.

Where a contract stipulates that an arbitration is to be a condition precedent to the right to sue upon the contract, or if this may be inferred upon construction, no suit can be maintained unless the plaintiff has made all reasonable efforts to comply with the condition.—*Perkins v. U. S. Electric Light Co.*, 24 *O. G.* 204; *Com. Dec.* 1883, p. 322; 21 *Blatch.* 308; 16 *Fed. Rep.* 513.

In giving interpretation to a particular clause in a deed, we must look to every part of it in order to ascertain whether such interpretation is the true one.—*Day v. Cary*, 1 *Fish.* 424.

It is not to be presumed that a grantor intended to grant more than he has a right to grant, or that a grantee intends to receive, by way of grant, that to which he has a full right

without a grant.—*Day v. Cary*, 1 *Fish.* 424; *Goodyear v. Cary*, 4 *Blatch.* 271.

Contracts touching the transfer and use of patented inventions are to be construed in the same way as contracts respecting other species of property.—*Star Salt Caster Co. v. Crossman*, 3 *Bann. & Ard.* 281; 4 *Cliff.* 568.

CONTRACTS.

The inchoate right of an inventor to an extension of his patent may be the subject of a contract of sale; and a contract to convey such a right will be enforced by a bill for specific performance.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 2 *Bann. & Ard.* 113; 13 *Blatch.* 114.

Contracts may be executed by an agent of a corporation, but the agent should in the body of the contract name the corporation as the contracting party, and sign as its agent or officer.—*Gottfried v. Miller*, 21 *O. G.* 711; *Com. Dec.* 1882, p. 120; 104 *U. S.* 521.

A contract by which one person agrees to pay a sum of money for the time, labor, and skill of another for a given period, gives the employer no right to an assignment of a patent that is issued to his employé for an invention made during the period of his employment.—*Hapgood v. Hewitt*, 21 *O. G.* 1786; *Com. Dec.* 1882, p. 269; 11 *Biss.* 184; 11 *Fed. Rep.* 422.

A defendant corporation having violated the conditions of a contract under which a license to manufacture and sell a patented device was granted, and the license having therefore been revoked by the licensor under a provision of the contract, in a suit for infringement against such corporation after the revocation, a plea setting up the license was overruled.—*Wooster v. Singer Mfg. Co.*, 23 *O. G.* 2513; *Com. Dec.* 1883, p. 309.

A written instrument having imperfectly expressed the intention of the parties, but the parties having acted according to their actual agreement, and over two years having elapsed, the appellant could only have the mutual mistake in the language of the instrument corrected, and it would be inequitable to absolve him from the obligation of his contract,—*Laver v. Dennett*, 25 *O. G.* 882; *Com. Dec.* 1883, p. 449; 109 *U. S.* 90.

Courts of equity never decree the specific performance of a contract where the decree would be a vain or imperfect one.—*Werden v. Graham*, 24 *O. G.* 101; *Com. Dec.* 1883, p. 485.

When a person purchases a contract from an assignee, he takes it subject to all equities existing between the original contracting parties.—*Kinsman v. Parkhurst*, 18 *How.* 289.

Contracts in relation to patented articles are regulated by the laws of the State in which situated, and are subject to State jurisdiction.—*Bloomer v. McQuewan*, 14 *How.* 539; *Chaffee v. Boston Belting Co.*, 22 *How.* 217.

Contracts are usually made with reference to established laws, and should be so construed and understood, unless otherwise clearly indicated by the terms of the agreement.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

If a contract is actually made, by which the owner of a patent is bound, and the extension of the patent was intended to be conveyed, a court of equity will treat it as done to carry out the purpose of the parties.—*Labaree v. Peoria, Pekin & Jacksonville R. R. Co.*, 3 *Bann. & Ard.* 180.

The title of an inventor to obtain an extension of a patent may be the subject of a contract of sale.—*Nicolson Pavement Co. v. Jenkins*, 5 *Fish.* 491; 14 *Wall.* 452; 1 *O. G.* 465.

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

A licensee is entitled to protection under his contract until it is set aside, and he can restrain the licensor from violating its terms, although the court may not be able to decree a specific performance.—*Goddard v. Wilde*, 17 *Fed. Rep.* 845.

Under a conveyance of the entire legal title to patents to joint trustees, with full power to dispose of them at their discretion, it requires the joint deed of both to convey any title to, or interest in, the patents.—*Westcott v. Wayne Agric. Works*, 11 *Fed. Rep.* 298.

The sense in which the parties intended to use the terms employed in a contract, must be gathered from the instrument itself, irrespective of declarations written or oral by either party as to his understanding of its meaning, or as to his motives in making it.—*Wetherill v. Passaic Zinc Co.*, 6 *Fish.* 50; 2 *O. G.* 471.

In aid of the interpretation of a contract, it is proper to consider facts cognate to the subject of the contract and within the knowledge of the parties to which it may, therefore, be presumed that the stipulations of the contract were intended to be applied, and by which their effect and meaning were to be governed.—*Wetherill v. Passaic Zinc Co.*, 6 *Fish.* 50; 2 *O. G.* 471.

An assignment of an interest in an invention secured by letters-patent is a contract, and, like all other contracts, is to be construed so as to carry out the intention of the parties.—*Nicolson Pavement Co. v. Jenkins*, 14 *Wall.* 452; 5 *Fish.* 491; 1 *O. G.* 465.

A contract in writing will bind a corporation, although the seal affixed is not the corporate seal, if the officer making it had the authority so to do, or the company had subsequently ratified it.—*Eureka Co. v. Bailey Washing Machine Co.*, 11 *Wall.* 488.

A contract may be made to convey a future invention as

well as a past one, but the language should be explicit to that effect.—*Nesmith v. Calvert*, 1 *W.* & *M.* 34; 2 *Robb* 311.

A person who has under agreement employed an inventor to make inventions, can make no claim to inventions made after the employment has ceased.—*Appleton v. Bacon*, 2 *Black* 699.

A contract by an employé to permit his employers to apply for and obtain a patent for a device he has invented, may be proved by parol.—*Lockwood v. Lockwood*, 33 *Iowa* 509.

A licensee, in order to secure himself against the title of a *bona fide* purchaser, should procure a reformation of his contract and an assignment of it prior to the subsequent transfer, and record the same in the Patent Office within the three months.—*Gibson v. Cook*, 2 *Blatch.* 144.

A contract for the purchase of a portion of a patent-right may be good between the parties as a license, and enforced as such in courts of justice, but the legal right in the monopoly remains in the patentee.—*Sanford v. Messer*, 5 *Fish.* 411; 1 *Holmes* 149; 2 *O. G.* 470.

Where it is contemplated by the licensor and licensee that a license shall be in writing, it is essential to constitute a contract between the parties that the license should be delivered to, and accepted by, the licensee.—*Tilghman v. Hartell*, 9 *O. G.* 886; *Com. Dec.* 1876, p. 365; 2 *Bann.* & *Ard.* 260; *vide Hartell v. Tilghman*, 99 *U. S.* 547.

Under a contract which provides that the net proceeds from all suits for infringement of a patent shall be equally divided between the licensor and licensee, and which forbids the instituting of a suit without the consent of both parties, the licensee is authorized to make settlement with the infringing party.—*Burdell v. Denig*, 2 *Fish.* 588.

A reservation by a licensor that he would hold responsible for the royalty the party for whom a licensee has contracted

to do certain work under a license, is of no effect, as it is inconsistent with the license. The relieving of the parties primarily liable, by a universal rule of law as well as of justice, relieves those who are only secondarily responsible.—*Bigelow v. City of Louisville*, 3 *Fish.* 602.

If a licensee does all that lies in his power to restore the licensor to the same condition he was in before the contract, he may cease to act under the contract, and take issue with the licensor as to the validity of the exclusive right which he claims by virtue of his alleged title to the patent.—*Sherman v. Champlain Co.*, 31 *Vt.* 162.

If a contract is partly executed, the failure of a licensee to fulfill his agreement to purchase does not of itself operate to annul and cancel the agreement.—*Gibson v. Barnard*, 1 *Blatch.* 388.

Joint owners of a patent-right are not co-partners, and in the absence of any express contract each is at liberty to use his moiety as he may think fit, without liability to an accounting to the other for profits or losses.—*Vose v. Singer*, 4 *Allen* (*Mass.*) 226; *De Witt v. Elmira Nobles Mfg. Co.*, 12 *N. Y. Supr.* 301; *vide Pitts v. Hall*, 3 *Blatch.* 201.

The payment of a note given for a patent-right may be defeated for want of consideration, by reason of a breach of warranty on the part of the vendor.—*Hawes v. Twogood*, 12 *Iowa* 582.

The assignor of a patent-right must show title in himself to convey according to his contract, before he can sue for the consideration that was to have been paid.—*Edwards v. Richards*, *Wright* (*Ohio*) 596; *Bellas v. Hays*, 5 *Serg.* & *Rawle* (*Penn.*) 427.

If a contract shows that the parties mutually contemplated the possibility, if not the probability, that the patent was invalid, and provided by the form of the instrument and its

stipulations for the contingency, it is very clear that there is no ground on which the vendee can be permitted to set up a failure of consideration, even if the patent be void.—*Johnson v. Willimantic Linen Co.*, 33 *Conn.* 436.

If an assignor violates a contract with his assignee, it is available to the latter by way of recoupment of damages only, not in bar of an action for accrued royalties.—*Pitts v. Jameson*, 15 *Barb.* (*N. Y.*) 310.

An assignee of a patent-right cannot, in an action to recover on the bonds he has given therefor, assail the validity of the patent, when it has not been questioned by a third party or repealed, in order to avoid payment.—*Ball v. Murry*, 10 *Penn. St.* 111.

If an application for a patent by two partners who are joint inventors be rejected by the Patent Office, and one of the partners subsequently secures a patent for the same invention in his own name, the other partner has a joint interest in the invention and patent therefor.— *Vetter v. Lentzinger*, 31 *Iowa* 182.

Where an alleged warranty is not contained in a written contract, it cannot be proved by parol evidence, unless in addition to the averment that there was such warranty there be an allegation that it was false or fraudulent, and that thereby the vendee was deceived.—*Mc Clure v. Jeffrey*, 8 *Ind.* 79.

An assignee who has repudiated a contract for the purchase of a patent-right on account of fraud, may sue for damages.— *Warren v. Cole*, 15 *Mich.* 265.

A plea that a vendor made false representations, but not alleging that the purchaser relied upon such statements and entered into the bargain supposing and believing them to be true, is not sufficient to constitute the defense of fraud.— *Saxton v. Dodge*, 57 *Barb.* (*N. Y.*) 84.

A court of equity will not decree the cancelment of a

contract, except for fraud or mistake.—*Brooks v. Stolley*, 3 *McLean* 523; 2 *Robb* 281.

The Circuit Courts of the United States have no jurisdiction to enforce the specific performance of a contract under a patent, where the parties live in the same State.—*Brooks v. Stolley*, 3 *McLean* 523; 2 *Robb* 281.

COPY OF ASSIGNMENT.

A certified copy of an assignment from the Patent Office is *prima facie* evidence of the genuineness of the original, and may be read in evidence to the jury.—*Lee v. Blandy*, 2 *Fish.* 89; 1 *Bond* 361.

CORPORATION.

The omission from an assignment of a patent of the corporate seal of the company executing the deed is not necessarily a fatal defect, since a court of equity would compel the making of a good assignment.—*Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

A court of equity will compel a corporation to execute a valid assignment of a patent in place of one which it has delivered without attaching its seal, and the Patent Office will, therefore, upon an application for an extension, treat the grantee under such an imperfect instrument as the owner of the patent.—*Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

Contracts may be executed by an agent of a corporation, but the agent should in the body of the contract name the corporation as the contracting party, and sign as its agent or officer.—*Gottfried v. Miller*, 21 *O. G.* 711; *Com. Dec.* 1882, p. 120; 104 *U. S.* 521.

A conveyance executed by the signature of a company with seal, and by S., president, and another seal, is a good execu-

tion both for the company and for S. individually.—*Campbell v. James*, 18 *O. G.* 979; *Com. Dec.* 1880, p. 633; 17 *Blatch.* 42.

An injunction against a corporation is binding upon all persons acting for or on behalf of it who have notice of the writ and its contents, whether they be actually served with it or not.—*Phillips v. City of Detroit*, 3 *Bann. & Ard.* 150; 16 *O. G.* 627; *Com. Dec.* 1879, p. 562; 2 *Flipp.* 92.

The directors of a company are personally responsible for the infringement of a patent by their workmen, notwithstanding such infringement may be in contravention of orders.—*Betts v. De Vitre*, 16 *W. R.* 529; *L. Rep.* 3 *Ch.* 441; 37 *L. J. Ch.* 325.

Persons who form themselves into a corporation under the Missouri Statute cannot escape individual liability for the infringement of a patent done in their corporate name.—*St. Louis Stamping Co. v. Quinby*, 5 *Bann. & Ard.* 275; 18 *O. G.* 571; *Com. Dec.* 1880, p. 614.

A contract in writing will bind a corporation, although the seal affixed is not the corporate seal, if the officer making it had the authority so to do, or the company had subsequently ratified it.—*Eureka Co. v. Bailey Washing Machine Co.*, 11 *Wall.* 488.

An assignment to an incorporated company not at the time organized will inure to its use when organized, at least by way of estoppel, and be good against the grantor, whether it took effect on its delivery to pass any property or not.—*Dyer v. Rich*, 1 *Metcalf* (*Mass.*) 180.

Where an assignee is a corporation and the patentee is its manager and director, it has notice through him as such of all prior assignments pertaining to his patents.—*Continental Windmill Co. v. Empire Windmill Co.*, 4 *Fish.* 428; 8 *Blatch.* 295.

The reasonable construction of a license to a railroad company is, that it extends no further than the road used, or

which the company was authorized under its charter to construct, at the time the license was given.—*Emigh v. Chicago, B. & Q. R. R. Co.*, 2 *Fish.* 387; 1 *Biss.* 400.

A mere authority to use a patented invention is not usually transferable, but it is transmissible by succession to a corporation formed of a union of two licensees, and succeeding to the rights, duties, and obligations of both.—*Lightner v. Boston & Albany R. R.*, 1 *Lowell* 338.

An assignment of the revenues of a railroad to a preferred creditor, with the privilege of using the property of the company until his debt is paid, does not render the assignee liable for infringement of a patent under which the road has a license, as he is acting merely as an agent for the company.—*Emigh v. Chamberlain*, 2 *Fish.* 192; 1 *Biss.* 367.

A corporation is responsible for the conduct of its superintendent in affixing the word "patented" to unpatented articles.—*Tompkins v. Butterfield*, 25 *Fed. Rep.* 556.

The receiver of a corporation is merely the custodian of its property, and his appointment does not vest him with title to letters-patent.—*Dick v. Struthers*, 25 *Fed. Rep.* 103; 34 *O. G.* 131.

COVENANT.

A covenant made by a patentee before the enactment of the law authorizing the extension of patents, that any improvement, alteration or renewal of the patent should inure to the benefit of the assignee, is confined to the original term of the patent, and does not embrace an extension to the administrator.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

A person claiming title under the extension from the administrator, can maintain an action for infringement against any person claiming under a covenant from the patentee.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

When a licensor covenants with a licensee that he will not grant to another the same right and license he has granted to him, it is equivalent to a grant of an exclusive right.—*Day v. Cary*, 1 *Fish.* 424.

A failure to make stipulated payments does not necessarily terminate a license.—*White v. Lee*, 3 *Fed. Rep.* 222; 5 *Bann. & Ard.* 572.

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

A license given, during the pendency of an application before the Patent Office, to use the invention described without limitation of time, and no right of revocation reserved, cannot be revoked by the licensor without consent of the licensee.—*Kelly v. Porter*, 17 *Fed. Rep.* 519; 8 *Saw.* 482.

If it be doubtful whether a clause in a deed is a condition or a covenant, the courts will incline against the former construction.—*Hoyt v. Kimball*, 49 *N. H.* 322.

A deed conveys a title, although it may have covenants in it which have not been performed. There are things which rest in grant, and things which rest in covenant. If the covenant fails by the *laches* of the grantor, the grant nevertheless stands. The covenant does not affect the grant; the grant passes the title and operates *in praesenti*.—*Day v. Stellman*, 1 *Fish.* 487.

A covenant in a deed that the assignee shall "enjoy an exclusive use to the said patent within the said territory," limited to a certain number of machines, passes the whole right of the patentee for the particular territory.—*Ritter v. Serrell*, 2 *Blatch.* 379.

A man can pass by grant or assignment only that which he now possesses, and which is in existence at the time either actually or potentially. His grant or assignment is therefore

by its natural interpretation limited to the rights and things which are then in existence, and which he has power to grant, unless he uses other language which imports an intention to grant what he does not now possess, and what is not now in existence. In the latter case the language does not even then operate strictly as an assignment or grant, but only as a covenant or contract which a court of equity will carry into full effect when the right or thing comes *in esse*.—*Woodworth v. Sherman*, 3 *Story* 171; 2 *Robb* 357.

An inventor having conveyed all his interest in an invention and to any patents that might be obtained therefor, and having covenanted to take out the patents for the assignee, subsequently takes them out in his own name, he holds them in trust for the assignee.—*Emmons v. Sladdin*, 9 *O. G.* 352; *Com. Dec.* 1876, p. 304; 2 *Bann. & Ard.* 199.

Where an inventor covenants to execute deeds of conveyance of the part sold, as soon as may be after letters-patent shall have issued, if this does not give the assignee a legal title, a *jus in re*, it clearly confers on him a *jus ad rem*, an equitable right to the thing itself, and is not a mere executory contract to account for proceeds.—*Clum v. Brewer*, 2 *Curt.* 506.

If a patentee grants an exclusive license covenanting that he will not grant licenses to other persons in conflict therewith, and subsequently enters into an agreement with a third party that in consideration of a certain sum he will not prosecute for infringement, it is a breach of covenant, as the subsequent writing is essentially a license.—*Jackson v. Allen*, 120 *Mass.* 64.

Selling under a license is a recognition or admission of title in the licensor, and the licensee cannot impeach the validity of the patent as a defense in an action of covenant for the recovery of royalties.—*Wilder v. Adams*, 2 *W. & M.* 329; *Sargent v. Larned*, 2 *Curt.* 340; *Marsh v. Dodge*, 11 *N. Y. Supr.* 278.

A covenant of warranty is not a good consideration for a

note if the patent is void.—*Dickinson v. Hall*, 14 *Pickering* (*Mass.*) 217.

If the action is in covenant on a sealed instrument, a good consideration is implied from the solemn form of the promise in writing and under seal, and the invalidity of the patent would not be a good bar to any recovery.—*Wilder v. Adams*, 2 *W.* & *M.* 329.

If a patent is invalid an assignee may have a remedy on a covenant, but he cannot, as a general principle and in ordinary cases, resort to such a defense as a want of consideration, or a failure of consideration, when an action is brought upon a sealed instrument executed in consequence of and founded on another covenant made by the patentee to him.—*Wilder v. Adams*, 2 *W.* & *M.* 329.

The recitals in a deed are not conclusive on a licensee when the covenant was executed under a mistake as to the validity of the patent.—*Rich v. Atwater*, 16 *Conn.* 409.

In an action to recover license fees alleged to have accrued under an agreement, evidence that machines have been made by the licensees and sent away from their factory, is sufficient to demand of the licensees an account of sales.—*Marsh v. Dodge*, 5 *Lans.* (*N. Y.*) 541.

A misrepresentation as to what a patented device would accomplish might be available, under a proper issue, in mitigation of damages; but in an action of covenant on a sealed note, it should also be averred that the property for which the note was given was of no value, or that it had been returned or tendered to the vendor.—*Mullikin v. Latchem*, 7 *Blackf.* (*Ind.*) 136; *Hardesty v. Smith*, 3 *Ind.* 39.

DAMAGES.

If an assignor violates a contract with his assignee, it is available to the latter by way of recoupment of damages only,

not in bar of an action for accrued royalties.—*Pitts v. Jameson*, 15 *Barb.* (*N. Y.*) 310.

An assignee who has repudiated a contract for the purchase of a patent-right, on account of fraud, may sue for damages.—*Warren v. Cole*, 15 *Mich.* 265.

A misrepresentation as to what a patented device would accomplish might be available, under a proper issue, in mitigation of damages; but in an action of covenant on a sealed note, it should also be averred that the property for which the note was given was of no value, or that it had been returned or tendered to the vendor.—*Mullikin v. Latchem*, 7 *Blackf.* (*Ind.*) 136; *Hardesty v. Smith*, 3 *Ind.* 39.

If assignee refuse to perform conditions that were to be performed subsequently, it cannot revest assignor with title to the invention. His remedy is action for damages.—*Mallory v. Mackaye*, 22 *O. G.* 945; *Com. Dec.* 1882, p. 405; 12 *Fed. Rep.* 328.

A suit may be maintained to recover past damages for infringement, although the parties plaintiff have parted with their interest in the patent at the time suit was brought.—*Spring v. Domestic Sewing Mach. Co.*, 22 *O. G.* 1445; *Com. Dec.* 1882, p. 452; 13 *Fed. Rep.* 446.

An instrument conveying the exclusive right to manufacture and sell a patented article is a mere license, and does not authorize the licensee to maintain an action for damages against infringers who are not infringing the patent in those respects.—*Hayward v. Andrews*, 23 *O. G.* 533; *Com. Dec.* 1883, p. 155; 106 *U. S.* 672.

A decree for nominal damages in a suit for infringement of a patent against the manufacturer of infringing machines, does not operate as a license to the manufacturer or his vendee as to all existing infringing machines made by the manufacturer.—*Blake v. Greenwood Cemetery*, 25 *O. G.* 89; *Com. Dec.* 1883, p. 416; 16 *Fed. Rep.* 676.

The claims for profits and damages arising from infringements prior to the plaintiff's purchase are choses in action, and the assignee takes the title subject to all the equities existing against the assignor.—*N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 25 *O. G.* 1076; *Com. Dec.* 1883, p. 460; 18 *Fed. Rep.* 638; 21 *Blatch.* 519.

When the sale of licenses by the patentee has been sufficient to establish a price for such licenses, that price should be the measure of his damages against an infringer; but a royalty or license-fee to be binding on a stranger to the licenses which established it, must be uniform.—*Westcott v. Rude*, 27 *O. G.* 719; *Com. Dec.* 1884, p. 225; 19 *Fed. Rep.* 830.

The amount of an established license-fee for the use of a patented invention, is what the patentee loses by the use of the invention in violation of the patent without license, and is a proper measure of damages for such infringement.—*Wooster v. Simonson*, 28 *O. G.* 918; *Com. Dec.* 1884, p. 366; 20 *Fed. Rep.* 317.

The mere assignment of a patent gives the assignee no right to damages or profits already accrued, unless the language of the instrument shows that such was the intention.—*Merriam v. Smith*, 11 *Fed. Rep.* 588; *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 *Fed. Rep.* 638; 25 *O. G.* 1076; *Com. Dec.* 1883, p. 460; 21 *Blatch.* 519.

The assignment of a patent does not carry with it a transfer of the right to damages for an infringement committed before such assignment.—*Moore v. Marsh*, 7 *Wall.* 515.

Where an assignment of a patent is good as between the parties, and there has been a partial performance, it cannot be rescinded; the only remedy is action for damages for breach of contract.—*Moore v. Bare*, 11 *Iowa* 198.

In the absence of any warranty or covenant that the licensor is the inventor of the improvement described, he is not estopped from offering to prove the invalidity of the patent as bearing

upon the damages sustained by his licensee on account of his (licensor's) failure to prosecute infringers as he had agreed to.—*Jackson v. Allen*, 120 *Mass.* 64.

DATE OF ASSIGNMENT.

The date of an assignment is the day of its delivery, and not the date which appears upon its face, if the latter differs from the former.—*Dyer v. Rich*, 1 *Metcalf* (*Mass.*) 180.

The date of a deed may always be controlled by evidence of the actual delivery. If an agreement recites the deed and states that it was then made, this is conclusive that the deed was then made, and the date is immaterial.—*Dyer v. Rich*, 1 *Metcalf* (*Mass.*) 180.

DEATH.

A patent-right, like any other personal property, is understood by Congress to vest in the executors and administrators of the patentee, if he has died without having assigned it.—*Shaw Relief Valve Co. v. City of New Bedford*, 28 *O. G.* 283; *Com. Dec.* 1884, p. 289; 19 *Fed. Rep.* 753.

A patent-right, like other personal property, vests in the administrator and not in the heirs, in case the patentee dies intestate.—*Bradley v. Dull*, 19 *Fed. Rep.* 913; 27 *O. G.* 625; *Com. Dec.* 1884, p. 219.

A deed to a dead man is a nullity, and though made to him and "his heirs," the word heirs is not a word of purchase carrying title to the heirs, but only qualifying the title of the grantee.—*Hunter v. Watson*, 12 *Cal.* 363; *vide Price v. Johnston*, 1 *Ohio St.* 390; *Wood v. Ferguson*, 7 *Ohio St.* 288.

DEBTOR.

A State court may compel a judgment debtor to execute and deliver to a receiver an assignment of his interest in letters-

patent.—*Clan Ranald v. Wyckoff*, 41 *N. Y. Supr.* 527; *Barnes v. Morgan*, 10 *N. Y. Sup.* 703.

It is competent for a State court, under an insolvent law, to compel a debtor to execute an assignment that would transfer a patent-right to an assignee in insolvency.—*Ashcroft v. Walworth*, 5 *Fish.* 528; 1 *Holmes* 152; 2 *O. G.* 546.

An assignee in insolvency, or a receiver of all the property of a debtor appointed under the laws of a State, does not, by virtue of the general assignment or appointment merely, acquire a title to patent-rights.—*Ager v. Murray*, 21 *O. G.* 1197; *Com. Dec.* 1882, p. 188; 105 *U. S.* 126.

A receiver of an insolvent debtor is entitled to a patent-right belonging to the debtor; and a court is empowered to order the debtor to convey the right to such receiver if such conveyance is necessary.—*Petition of Keach, Receiver*, 19 *Reporter*, 731.

DEFENSE.

The maker of a note given for a patent-right cannot be compelled to pay it, if the patent for which it was given is utterly worthless.—*Clough v. Patrick*, 37 *Vt.* 421.

A licensee is at liberty to contest the question whether the articles made by him embody the invention or any material part thereof, and a stipulation to the contrary in the contract is of no effect.—*White v. Lee*, 23 *O. G.* 1621; *Com. Dec.* 1883, p. 245; 14 *Fed. Rep.* 789.

A defendant corporation having violated the conditions of a contract under which a license to manufacture and sell a patented device was granted, and the license having therefore been revoked by the licensor under a provision of the contract, in a suit for infringement against such corporation after the revocation, a plea setting up the license was overruled.—*Wooster v. Singer Mfg. Co.*, 23 *O. G.* 2513; *Com. Dec.* 1883, p. 309.

When a license has been revoked by a plaintiff, and a defendant is sued as a naked infringer, he is at liberty to avail himself of any defense ordinarily open to a defendant charged with infringement.—*Wooster v. Singer Mfg. Co.*, 23 *O. G.* 2513; *Com. Dec.* 1883, p. 309.

Where others are associated with a patentee in the purchase of a prior patent subsequent to a sale by the patentee of all his right, title, and interest in, to and under his own patents; *held*, that the prior sale operates as a license as against all of the purchasers.—*Curran v. Burdsall*, 27 *O. G.* 1319; *Com. Dec.* 1884, p. 270; 20 *Fed. Rep.* 835.

An agreement to give promissory notes, in consideration of an assignment of the invention, as soon as the patent issued, is not avoided in view of the fact that no patent issued until after the day when the last note would have been payable.—*Read v. Bowman*, 2 *Wall.* 591.

In the defense of suit for infringement of a prior patent, it is competent for a licensee to put in evidence the patent of his licensor.—*Blanchard v. Puttman*, 3 *Fish.* 186; 2 *Bond* 84.

One holding title upon condition must perform the condition at his peril. He cannot come into a court of equity to have the question settled whether the conditions are performed in order to save him from the consequences of a mistake.—*Florence S. M. Co. v. Singer Mfg. Co.*, 4 *Fish.* 329; 8 *Blatch.* 113.

A licensee cannot put an end to his contract, deny the validity of the patent, and afterward, when the validity of the patent is sustained, set up a license from the patentee as a defense.—*Moody v. Taber*, 1 *Bann. & Ard.* 41; 1 *Holmes* 325; 5 *O. G.* 273; *Cohn v. Nat. Rubber Co.*, 3 *Bann. & Ard.* 568; 15 *O. G.* 829; *Com. Dec.* 1879, p. 448.

In suit for the contract price of a machine purchased under a warranty, the purchaser may defend on the ground of a

breach of warranty in that the device is an infringement of a patent.—*Cronin̄ger v. Paige*, 4 *N. W. Rep.* 106; 48 *Wis.* 229.

A license granted by an assignee who had not fulfilled the conditions of his purchase, but had defaulted in his payments, is not a defense to infringement.—*Abbett v. Zusi*, 5 *Bann.* & *Ard.* 38.

A rescinded contract cannot be resorted to for the purpose of determining the royalty to be paid for infringement, after such contract has ceased to be obligatory.—*Bussey v. Excelsior Mfg. Co.*, 5 *Bann.* & *Ard.* 135; 17 *O. G.* 744; *Com. Dec.* 1880, p. 362; 1 *Fed. Rep.* 640; 1 *McCrary* 161.

A licensee may defend an action for the recovery of royalties accruing after the Patent Office has decided that the licensor was not the original inventor, and has awarded a patent to another.—*Marsh v. Harris Mfg. Co.*, 22 *N. W. Rep.* 516.

Selling under a license is a recognition or admission of title in the licensor, and the licensee cannot impeach the validity of the patent as a defense in an action of covenant for the recovery of royalties.—*Wilder v. Adams*, 2 *W.* & *M.* 329; *Sargent v. Larned*, 2 *Curt.* 340; *Marsh v. Dodge*, 11 *N. Y. Supr.* 278.

A licensee cannot set up as a defense to the payment of a note the pretext that the patent infringes previous existing patents. The burden of proof is on him to show it before he can establish a failure of consideration.—*Davis v. Gray*, 17 *Ohio St.* 330.

A void patent is not a good consideration for a note. In an action for the purchase money for a patent sold, the defendant may show that there was no such patent, or that it was invalid, or that the vendor had no right to sell it.—*Nye v. Raymond*, 16 *Ill.* 153.

A purchaser may avoid the payment of note given under a contract for a patent-right by showing that the vendor sold

a right he did not possess.—*M`Dowell v. Meredith*, 4 *Whart.* (*Pa.*) 311; *Nye v. Raymond*, 16 *Ill.* 153.

If several payees of a note endorse it over to one of their number, payment may be avoided if the note were given for a license under a void patent.—*Saxton v. Dodge*, 57 *Barb.* (*N. Y.*) 84.

The purchaser of a patent-right who subsequently transfers it to another, is precluded from saying that what he sold is valueless in order to avoid payment of a note which he had given therefor.—*Thomas v. Quintard*, 5 *Duer* (*N. Y.*) 80.

It is no defense to an action on a note given for a reassignment of an interest in an invention, that a patent subsequently issued to the payee of the note for a part of the theory embraced in the application of the maker of the note.—*Clark v. Smith*, 21 *Minn.* 539.

If the action is in covenant on a sealed instrument, a good consideration is implied from the solemn form of the promise in writing and under seal, and the invalidity of the patent would not be a good bar to any recovery.—*Wilder v. Adams*, 2 *W.* & *M.* 329.

If a patent is invalid an assignee may have a remedy on a covenant, but he cannot, as a general principle and in ordinary cases, resort to such a defense as a want of consideration, or a failure of consideration, when an action is brought upon a sealed instrument executed in consequence of, and founded on, another covenant made by the patentee to him.—*Wilder v. Adams*, 2 *W.* & *M.* 329.

If an assignor violates a contract with his assignee, it is available to the latter by way of recoupment of damages only, not in bar of an action for accrued royalties.—*Pitts v. Jameson*, 15 *Barb.* (*N. Y.*) 310.

An assignee of a patent-right cannot, in an action to recover on the bonds he has given therefor, assail the validity of the

patent when it has not been questioned by a third party or repealed, in order to avoid payment.—*Ball v. Murry*, 10 *Penn. St.* 111.

A misrepresentation as to what a patented device would accomplish might be available, under a proper issue, in mitigation of damages; but in an action of covenant on a sealed note, it should also be averred that the property for which the note was given was of no value, or that it had been returned or tendered to the vendor.—*Mullikin v. Latchem*, 7 *Blackf.* (*Ind.*) 136; *Hardesty v. Smith*, 3 *Ind.* 39.

A plea that a vendor made false representations, but not alleging that the purchaser relied upon such statements and entered into the bargain supposing and believing them to be true, is not sufficient to constitute the defense of fraud.—*Saxton v. Dodge*, 57 *Barb.* (*N. Y.*) 84.

An assignee under a license can avail himself of the same means to sustain his title, and repel any attack upon it as the law allows the assignor.—*Day v. New Eng. Car Spring Co.*, 3 *Liv. Law Mag.* 44.

Where there has been fraud on the part of the vendor in the sale of goods, an offer by the vendee to return them in reasonable time constitutes a good defense in an action for their price.—*Howard v. Cadwalader*, 5 *Blackf.* (*Ind.*) 225; *Wynn v. Hiday*, 2 *Blackf.* (*Ind.*) 123.

DELIVERY OF DEED.

If a deed is left with a stranger to be delivered to the grantee on the happening of a contingency, the first delivery is complete and irrevocable by death or otherwise.—*Hammond v. Hunt*, 4 *Bann. & Ard.* 111.

Alteration of a deed by a grantor at the request of the grantee, and re-delivery of the deed, is, in legal effect, a re-execution of the deed.—*Malarin v. U. S.*, 1 *Wall.* 282.

If a grantor puts into his own solicitor's hands a deed, as his deed, to be delivered thereafter, the technical delivery is already made.—*Hammond v. Hunt*, 4 *Bann.* & *Ard.* 111.

The date of a deed may always be controlled by evidence of the actual delivery. If an agreement recites the deed and states that it was then made, this is conclusive that the deed was then made, and the date is immaterial.—*Dyer v. Rich*, 1 *Metcalf* (*Mass.*) 180.

An assignment to an incorporated company not at the time organized will inure to its use when organized, at least by way of estoppel, and be good against the grantor, whether it took effect on its delivery to pass any property or not.—*Dyer v. Rich*, 1 *Metcalf* (*Mass.*) 180.

A deed to a dead man is a nullity, and though made to him and "his heirs" the word heirs is not a word of purchase carrying title to the heirs, but only qualifying the title of the grantee.—*Hunter v. Watson*, 12 *Cal.* 363; *vide Price v. Johnston*, 1 *Ohio St.* 390; *Wood v. Ferguson*, 7 *Ohio St.* 288.

DOUBT IN ASSIGNMENT.

In a case of well-founded doubt the construction should be against the grantor, as he is chargeable with any obscurity in this respect.—*Smith v. Selden*, 1 *Blatch.* 475; *May v. Chaffee*, 5 *Fish.* 160; 2 *Dillon* 385.

Where there is doubt as to the proper construction of an instrument, a subsequent deed of confirmation is entitled to great consideration; but where its meaning is clear in the eye of the law the error of the parties cannot control its effect.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

EMPLOYÉ.

A person who has under agreement employed an inventor to make inventions can make no claim to inventions made

after the employment has ceased.—*Appleton v. Bacon*, 2 *Black* 699.

An inventor who is employed to make improvements with the understanding that he is to receive a specific sum for each patentable improvement, must at least put his employer in default before he (the inventor) can assert exclusive ownership of the improvements.—*Continental Windmill Co. v. Empire Windmill Co.*, 4 *Fish.* 428; 8 *Blatch.* 295.

A contract by an employé to permit his employers to apply for and obtain a patent for a device he has invented, may be proved by parol.—*Lockwood v. Lockwood*, 33 *Iowa* 509.

If an employé makes an invention and permits his employer to use it before making application for a patent, without demanding any compensation, a license to continue the use may be implied.—*McClurg v. Kingsland*, 1 *How.* 202; 2 *Robb* 105; *Slemmer's Appeal*, 58 *Penn. St.* 155; *Chabot v. Button Hole Co.*, 6 *Fish.* 71.

A contract by which one person agrees to pay a sum of money for the time, labor, and skill of another for a given period, gives the employer no right to an assignment of a patent that is issued to his employé for an invention made during the period of his employment.—*Hapgood v. Hewitt*, 21 *O. G.* 1786; *Com. Dec.* 1882, p. 269; 11 *Biss.* 184; 11 *Fed. Rep.* 422.

If an employer has any right to the invention made by an employé during the period of his employment, it is a mere naked license to make and sell the patented improvement as a part of his business, and is not transferable.—*Hapgood v. Hewitt*, 21 *O. G.* 1786; *Com. Dec.* 1882, p. 269; 11 *Biss.* 184; 11 *Fed. Rep.* 422.

Whether a company has not an implied license to use an invention of one of its employés, from the fact that the employé did not assert his right thereto while in the company's employ, is a question for the courts and not for the Commissioner of

Patents.—*Hall v. Johnson*, 23 *O. G.* 2411; *Com. Dec.* 1883, p. 39.

While employment to invent and perfect machinery for a particular purpose will operate as a license to the employer, it will not of itself confer upon the employer any legal title to the invention or to the letters-patent protecting it.—*Whiting v. Graves*, 3 *Bann. & Ard.* 222; 13 *O. G.* 455; *Com. Dec.* 1878, p. 208; *Wilkens v. Spafford*, 3 *Bann. & Ard.* 274; 13 *O. G.* 675; *Com. Dec.* 1878, p. 227.

An employé who is the owner of a patent cannot introduce his patented device into his employer's business and demand royalties for its use without the employer's consent.—*Barry v. Crane Mfg. Co.*, 22 *Fed. Rep.* 396.

EMPLOYÉ IN PATENT OFFICE.

A clerk in the Patent Office whose chief employment is to make examinations in relation to assignments and other papers of record in the Patent Office, is as competent to prove what documents were in the Office as the head of the bureau.—*Sone v. Palmer*, 28 *Mo.* 539.

EQUITABLE TITLE.

The legal title to a patent will prevail over the equitable title, unless the rights of the holder of the legal title were acquired with notice of the equities of the party in whom the equitable title is.—*Davis Improved Wrought Iron Wagon Wheel Co. v. Davis Wrought Iron Wagon Co.*, 20 *Fed. Rep.* 699; 22 *Blatch.* 221.

The interest or estate in a patent to the transfer of which a writing is necessary, is such as enables the party receiving it to convey legal title. An equitable interest or an interest in mere proceeds need not be recorded, consequently it need not be in writing.—*Blakeney v. Goode*, 30 *Ohio St.* 350.

Where one person has the legal title to the patent and another an equitable right therein, both must be made parties to a suit in action in equity to restrain infringement.—*Gamewell Fire Alarm Tel. Co. v. City of Brooklyn*, 22 *O. G.* 1978; *Com. Dec.* 1882, p. 512; 14 *Fed. Rep.* 255.

The right by assignment is not a mere equitable right such as ordinarily has to be prosecuted in the name and often at the pleasure of the assignor, but the assignee is as much bound to prosecute the application with diligence, and is as effectually concluded by the fact of his rights under the general patent law of the country and the Rules of Practice in the Patent Office as the inventor himself.—*Fire Extinguisher Mfg. Co. v. Graham, Admr.*, 24 *O. G.* 793; *Com. Dec.* 1883, p. 368; 16 *Fed. Rep.* 543.

Where a patentee agrees to assign for a valuable consideration a renewed patent as soon as obtained, the assignee becomes equitably entitled to the entire interest in the patent during the extended term, and can invest himself with the legal title by paying, or offering to pay, the stipulated price.—*Hartshorn v. Day*, 19 *How.* 211.

Where a patentee agrees upon certain conditions to convey the extended term of a patent, and the conditions have been fulfilled, the assignee becomes the equitable owner of the extension.—*Aiken v. Dolan*, 3 *Fish.* 197.

The rule that a receiver cannot convey title to a patent unless the owner of the legal title joins, does not apply to the transfer of a mere equitable title.—*Adams v. Howard*, 22 *Fed. Rep.* 656.

The discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect by proceeding in the manner prescribed by law. An assignment of his whole interest, whether before or after the patent is issued, is equally within the provisions of the

Act. If it is made before the issuing of the patent, it is sufficient to transfer the legal title to the assignee, although the patent afterwards issues to the inventor.—*Gayler v. Wilder*, 10 *How.* 477; *Rathbone v. Orr*, 5 *McLean* 131; *Rich v. Lippincott*, 2 *Fish.* 1; *Herbert v. Adams*, 4 *Mason* 15; 1 *Robb* 505.

Where an inventor covenants to execute deeds of conveyance of the part sold as soon as may be after letters-patent shall have issued, if this does not give the assignee a legal title, a *jus in re*, it clearly confers on him a *jus ad rem*, an equitable right to the thing itself, and is not a mere executory contract to account for proceeds.—*Clum v. Brewer*, 2 *Curt.* 506.

A person who has under agreement employed an inventor to make inventions, can make no claim to inventions made after the employment has ceased.—*Appleton v. Bacon*, 2 *Black* 699.

In determining to whom a patent shall issue, the Commissioner of Patents must be governed by the record. He cannot regard mere equitable claims, but must issue the patent to the person having the legal title, the requirements of the Office having been complied with.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

ESTOPPEL.

An applicant is estopped from contradicting his deed of assignment, but an estoppel by deed arises alone upon a recital of a particular fact.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

Where an invention is assigned before it is patented, the assignor is estopped upon obtaining the patent from setting up any adverse title.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 2 *Bann. & Ard.* 113; 13 *Blatch.* 114.

Where an inventor agrees to assign his invention, he is estopped upon obtaining the patent from setting up any adverse title if the purchaser tenders the purchase price, because in such case the purchaser becomes the equitable owner of the patent.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 2 *Bann. & Ard.* 113; 13 *Blatch.* 114.

An agreement made between the owners of a patent and an infringer, in which mention is alone made of the right secured by the patent set forth, though operating to stop the grantees of original patent from prosecuting such infringers, it does not extend to a subsequent reissue obtained by assignees, or estop them from maintaining a suit against such parties.—*Pickering v. Phillips*, 10 *O. G.* 420; *Com. Dec.* 1876, p. 470; 4 *Cliff.* 383.

Assignee of a patent is subject to the limitations which affected the title of his assignor. If the latter is estopped by a decree, the former is.—*Pennington v. Hunt*, 20 *Fed. Rep.* 195.

If one of several joint partners assigns to a third party, the estoppel upon the assignor must operate as a license to the assignee to use the patent, and the co-owners must look to the one who assigns for an accounting.—*Curran v. Burdsall*, 20 *Fed. Rep.* 835; 27 *O. G.* 1319; *Com. Dec.* 1884, p. 270.

A patentee cannot sell his right to another and then buy or obtain control of an older patent, and through such older patent dispossess his assignee of the full benefit of what he purchased.—*Curran v. Burdsall*, 20 *Fed. Rep.* 835; 27 *O. G.* 1319; *Com. Dec.* 1884, p. 270.

Having sold and assigned a patent as a valid one, the assignor cannot derogate from his own grant. It does not lie in his mouth to say that the patent is not good.—*Chambers v. Crichley*, 33 *Beavan* 374.

A licensee cannot defend an action for royalties on the ground of the invalidity of a patent, he having admitted the

validity of the patent in the license and had the benefit thereof.—*Marsh v. Harris Mfg. Co.*, 22 *N. W. Rep.* 516.

An assignment to an incorporated company not at the time organized will inure to its use when organized, at least by way of estoppel, and be good against the grantor, whether it took effect on its delivery to pass any property or not.—*Dyer v. Rich*, 1 *Metcalf* (*Mass.*) 180.

A mere assignment of the right, title, and interest of the assignor, and nothing further, will not operate to secure to the purchaser a title subsequently acquired by the vendor.—*Perry v. Corning*, 7 *Blatch.* 195.

In the absence of any warranty or covenant that the licensor is the inventor of the improvement described, he is not estopped from offering to prove the invalidity of the patent as bearing upon the damages sustained by his licensee on account of his (licensor's) failure to prosecute infringers as he had agreed to. —*Jackson v. Allen*, 120 *Mass.* 64.

So long as a licensee retains a license he is estopped from denying that the device he manufactures is the same in all respects as that specified in the license.—*Marsh v. Dodge*, 11 *N. Y. Supr.* 278.

So long as a licensee continues to use machines under a license he is estopped from denying the licensor's title, unless he can show that the latter was guilty of fraud in inducing him to enter into contract.—*Sherman v. Champlain Co.*, 31 *Vt.* 162.

If a license contains a covenant on the part of the licensee by which he admits the validity of the patent, and has had the enjoyment of the license, the licensee is estopped from assailing the validity of the patent.—*Magic Ruffle Co. v. Elm City Co.*, 13 *Blatch.* 151; 8 *O. G.* 773; *Birdsall v. Perego*, 5 *Blatch.* 251.

If a licensor seeks to set aside a license on account of a breach of contract, the defendant is not estopped from denying

the validity of a patent by the recitals in the contract.—*Burr v. Duryee*, 2 *Fish.* 275; 1 *Wall.* 531.

If a contract shows that the parties mutually contemplated the possibility, if not the probability, that the patent was invalid and provided by the form of the instrument and its stipulations for the contingency, it is very clear that there is no ground on which the vendee can be permitted to set up a failure of consideration, even if the patent be void.—*Johnson v. Willimantic Linen Co.*, 33 *Conn.* 436.

The recitals in a deed are not conclusive on a licensee when the covenant was executed under a mistake as to the validity of the patent.—*Rich v. Atwater*, 16 *Conn.* 409.

An agreement which is restricted to the original patent does not estop the assignor from prosecuting for an infringement of the reissue.—*Pickering v. Phillips*, 10 *O. G.* 420; *Com. Dec.* 1876, p. 470; 4 *Cliff.* 383.

An applicant for a patent is estopped from contradicting his deed of assignment, but an estoppel by deed arises alone upon a recital of a particular fact.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

When a party claims to establish his right merely by estoppel, the instrument by which the estoppel is supported, must be precise, clear, and definite, not depending upon doubtful inference.—*Rich v. Atwater*, 16 *Conn.* 409.

EVIDENCE.

A certified copy of an assignment from the Patent Office is *prima facie* evidence of the genuineness of the original, and may be read in evidence to the jury.—*Lee v. Blandy*, 2 *Fish.* 89; 1 *Bond* 361.

A clerk in the Patent Office whose chief employment is to make examinations in relation to assignments and other

papers of record in the Patent Office, is as competent to prove what documents were in the Office as the head of the bureau.—*Sone v. Palmer*, 28 *Mo.* 539.

Under the statutes of New York, assignments of patents duly acknowledged before a notary are sufficiently proved, and it is not incumbent upon the complainant to prove the signatures of the assignors.—*Houghton v. Jones*, 1 *Wall.* 702; *New York Pharmical Association v. Tilden*, 23 *O. G.* 272; *Com. Dec.* 1883, p. 145; 14 *Fed. Rep.* 740; 21 *Blatch.* 190.

EXECUTION.

A court of equity may direct the sale of the interest of an inventor in his patent in order to satisfy a judgment debt against him, and for that purpose may require the patentee to make an assignment of the patent under section 4898, Revised Statutes, and in default of such assignment within a limited time the court may appoint a trustee to execute the same.—*Murray v. Ager*, 20 *O. G.* 1311; *Com. Dec.* 1881, p. 423; 1 *Mackey* 87.

A conveyance executed by the signature of a company with seal, and by S., president, and another seal, is a good execution both for the company and for S. individually.—*Campbell v. James*, 18 *O. G.* 979; *Com. Dec.* 1880, p. 633; 17 *Blatch.* 42.

An assignment of all property, except such property as is exempt by law from levy and sale under execution, cannot transfer a patent-right.—*Campbell v. James*, 18 *O. G.* 1111; *Com. Dec.* 1880, p. 647; 5 *Bann. & Ard.* 354; 2 *Fed. Rep.* 338; 18 *Blatch.* 92.

Under the statutes of New York, assignments of patents duly acknowledged before a notary are sufficiently proved, and it is not incumbent upon the complainant to prove the signatures of the assignors.—*Houghton v. Jones*, 1 *Wall.* 702; *New York Pharmical Association v. Tilden*, 23 *O. G.*

272; *Com. Dec.* 1883, p. 145; 14 *Fed. Rep.* 740; 21 *Blatch.* 190.

If a contract is actually made by which the owner of a patent is bound, and the extension of the patent was intended to be conveyed, a court of equity will treat it as done to carry out the purpose of the parties.—*Labaree v. Peoria, Pekin & Jacksonville R. R. Co.*, 3 *Bann. & Ard.* 180.

Alteration of a deed by a grantor at the request of the grantee, and re-delivery of the deed, is, in legal effect, a re-execution of the deed.—*Malarin v. U. S.*, 1 *Wall.* 282.

Patent-rights are co-extensive with the United States, and are not subject to seizure and sale on execution.—*Stevens v. Gladding*, 17 *How.* 447.

Sale of the *materials* of a patented machine by a sheriff on an execution against the owner, is not such a sale as subjects the sheriff to an action for infringement of the patent-right.—*Sawin v. Guild*, 1 *Gal.* 485; 1 *Robb* 47.

When a party signs a license without reading it, he is bound by its terms unless he lacks capacity to comprehend properly what he was doing.—*McKay v. Jackman*, 17 *Fed. Rep.* 641.

Where an assignee relies upon an assignment executed by an agent he must produce proof of the agent's authority.—*Sone v. Palmer*, 28 *Mo.* 539.

Every authority to convey an interest in a patent must be by deed, that it may appear whether the agent had a valid commission.—*Bellas v. Hays*, 5 *S. & R.* (*Pa.*) 427.

An agreement which purports to be made by a principal through his agent, and has only the agent's name and seal affixed, is not a good execution of the authority if any existed.—*Bellas v. Hays*, 5 *S. & R.* (*Pa.*) 427.

No confirmation short of putting his name and seal to it, can make a writing imperfectly executed by an agent, the deed of the principal.—*Bellas v. Hays*, 5 *S. & R.* (*Pa.*) 427.

Where the payment of purchase money is dependent on the conveyance of a right, and the latter is made a condition precedent, and no right passes on account of the imperfect character of the writing, an action for enforcing the payment will not be sustained.—*Bellas v. Hays*, 5 *S.* & *R.* (*Pa.*) 427.

When an instrument under seal is executed by attorney, the attorney must be authorized by deed under seal.—*Stetson v. Patten*, 2 *Greenl.* (*Maine*) 358.

A parol ratification is not sufficient to give validity to a deed made by an agent not having authority under seal to bind his principal.—*Stetson v. Patten*, 2 *Greenl.* (*Maine*) 358.

EXECUTOR.

Where a patentee entered into a contract to procure an extension of a patent, and after his death his widow, as executrix, secured such extension and assigned it, it was held that, upon the resignation of the trust as executrix the administrator subsequently appointed could not make a legal assignment of the extended patent to a different party than the assignee of the executrix.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 2 *Bann.* & *Ard.* 113; 13 *Blatch.* 114.

"Legal representatives" includes assignees as well as exetors and administrators in its terms.—*Hamilton v. Kingsbury*, 14 *O. G.* 448; *Com. Dec.* 1878, p. 339; 3 *Bann.* & *Ard.* 346; 15 *Blatch.* 64.

"Legal representatives" in the patent act means executors or administrators.—*Shaw Relief Valve Co. v. City of New Bedford*, 28 *O. G.* 283; *Com. Dec.* 1884, p. 289; 19 *Fed. Rep.* 753.

A license will not carry the right to any one but the licensee personally, unless there are express words to show an interest to extend the right to an executor, administrator, or assignee,

voluntary or involuntary.—*Oliver v. Rumford Chemical Works*, 25 *O. G.* 784; *Com. Dec.* 1883, p. 443; 109 *U. S.* 75.

A patent-right, like any other personal property, is understood by Congress to vest in the executors and administrators of the patentee, if he has died without having assigned it.—*Shaw Relief Valve Co. v. City of New Bedford*, 28 *O. G.* 283; *Com. Dec.* 1884, p. 289; 19 *Fed. Rep.* 753.

An extension of a patent granted to an executor or administrator does not inure to the benefit of prior assignees under the original patent, but to the administrator. Assignees who were using the patented device at the time the extension was granted have a right to continue the use.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

A license that reserves no royalty to the owner of the patent, and grants the right not only to the licensee but to his executors, administrators, and assigns, is assignable.—*Adams v. Howard*, 22 *Fed. Rep.* 656.

An assignment by a person as administrator when he is in fact executor, will pass his title as executor.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 13 *Blatch.* 114; 2 *Bann. & Ard.* 113.

The record of an assignment by a person as administrator when he is in fact executor, is constructive notice of a transfer in his representative character.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 13 *Blatch.* 114; 2 *Bann. & Ard.* 113.

The term "patentee" applies to any person having a right under a patent, whether as executor, administrator, or assignee. —*Washburn v. Gould*, 3 *Story* 122; 2 *Robb* 206.

EXECUTORY CONTRACT.

An instrument purporting to convey inventions not yet *in esse* is not an assignment, but only an executory contract.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

An instrument purporting to be an assignment of an interest in all letters-patent to be subsequently obtained by the assignor, embodying improvements on his prior inventions, is not an actual transfer of the subsequent patents, but merely an agreement to transfer, enforcible only in a court of equity.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

A man can pass by grant or assignment only that which he now possesses, and which is in existence at the time either actually or potentially. His grant or assignment is, therefore, by its natural interpretation, limited to the rights and things which are then in existence, and which he has power to grant, unless he uses other language which imports an intention to grant what he does not now possess, and what is not now in existence. In the latter case the language does not even then operate strictly as an assignment or grant, but only as a covenant or contract which a court of equity will carry into full effect when the right or thing comes *in esse*.—*Woodworth v. Sherman*, 3 *Story* 171; 2 *Robb* 257.

EXPIRATION OF PATENT.

The manufacturer of a patented article can continue to affix to it the word "Patented" and the date, even after the patent has expired, without liability, under section 4901, Revised Statutes, which prohibits the marking of any unpatented article "Patented."—*Wilson v. Singer Mfg. Co.*, 9 *Biss.* 173; 16 *O. G.* 1091; *Com. Dec.* 1879, p. 630.

Articles manufactured without authority during the life of a patent cannot be legally sold after the patent has expired.—*Am. Diamond Rock Boring Co. v. Sheldon*, 1 *Fed. Rep.* 870; 18 *Blatch.* 50.

A manufacturer of a patented article, after the expiration of the patent, has a right to represent that it was made according to the patent, and to use the name of the patentee for that

purpose.—*Wilcox & Gibbs S. M. Co. v. Gibbens Frame*, 17 *Fed. Rep.* 623; 24 *O. G.* 1272; *Com. Dec.* 1883, p. 409; 21 *Blatch.* 431.

EXTENSIONS.

The assignment of a *patent*, or of the *invention* or *improvements*, does not convey the extended term, unless the terms used explicitly indicate that it was the intention of the parties to transfer the interest in the extension.—*Holmes & Spaulding*, 4 *O. G.* 581; *Com. Dec.* 1873, p. 166.

Where an *assignee* holding the original term of a patent and the right to an extension of same, assigns "all his right, title, and interest," it conveys the right to the extension. *Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

The granting clause in an assignment of a patent being in the usual form, it does not convey the extended term, though the *habendum* clause contains these words: "to be held and enjoyed by the said," etc., "to the full end of the term for which said letters-patent may be granted by re-issue, or otherwise during said term."—*Ex parte Waterman, Com. Dec.* 1869, p. 51.

A court of equity will compel a corporation to execute a valid assignment of a patent in place of one which it has delivered without attaching its seal, and the Patent Office will, therefore, upon an application for an extension, treat the grantee under such an imperfect instrument as the owner of the patent.—*Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

An assignment of the full and exclusive right to all the improvements made by an inventor, as set forth in the specification of a patent, does not convey his interest in the extension of the patent.—*Holmes & Spaulding*, 4 *O. G.* 581; *Com. Dec.* 1873, p. 166.

An assignment of all the right, title, and interest in a patent does not convey the extended term. The conveyance of it

must be in express terms, and the intention to transfer it must appear from the language.—*Holmes & Spaulding*, 4 *O. G.* 581; *Com. Dec.* 1873, p. 166.

The inchoate right to letters-patent, and to any renewals and extensions thereof, may be conveyed by an instrument containing apt terms to show an intention to convey all the rights springing from the invention.—*Emmons v. Sladdin*, 9 *O. G.* 352; *Com. Dec.* 1876, p. 304; 2 *Bann. & Ard.* 199.

After an assignment of the entire right for a particular territory, the assignor has no right to sell single machines to be used in the same territory during the extended term.—*Union Paper-Bag Mach. Co. v. Nixon*, 9 *O. G.* 691; *Com. Dec.* 1876, p. 344; 1 *Flipp.* 491; 2 *Bann. & Ard.* 244.

The inchoate right of an inventor to an extension of his patent may be the subject of a contract of sale; and a contract to convey such a right will be enforced by a bill for specific performance.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 2 *Bann. & Ard.* 113; 13 *Blatch.* 114.

Where a patentee entered into a contract to procure an extension of a patent, and after his death his widow, as executrix, secured such extension and assigned it, it was held that, upon the resignation of the trust as executrix the administrator subsequently appointed could not make a legal assignment of the extended patent to a different party than the assignee of the executrix.—*Newell v. West*, 8 *O. G.* 598; 9 *O. G.* 1110; *Com. Dec.* 1876, p. 404; 2 *Bann. & Ard.* 113; 13 *Blatch.* 114.

A party seeking protection of section 4928, Revised Statutes, must be a purchaser of the patented article, or protected by some agreement of sale, which the owner of the original patent could rightfully make. A mere license to use such invention would not include the extended term of the patent.—*Wooster v. Seidenberg*, 10 *O. G.* 244; *Com. Dec.* 1876, p. 446; 2 *Bann. & Ard.* 91; 13 *Blatch.* 88.

When a patentee sells a machine without conditions, or authorizes another to construct and use it, he ceases to have any interest whatever in the said machine. The rightful owner of a machine may continue to use it until it is worn out, in spite of any extension of the patent subsequently obtained.—*Mitchell v. Hawley*, 16 *Wall.* 544; 3 *O. G.* 241; 4 *Fish.* 388.

The sale by a patentee of all right in an existing original patent does not extend beyond the term of said patent.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

Where an *assignee* who holds the original term of a patent, and the right to the extension of the same, assigns "all his right, title, and interest," such assignment must be held to convey all the interest of which he has become possessed, including the right to the extension, even though the instrument does not name the extension in terms.—*Ex parte Mason*, 1 *O. G.* 357; *Com. Dec.* 1872, p. 68.

A covenant made by a patentee before the enactment of the law authorizing the extension of patents, that any improvement, alteration or renewal of the patent should inure to the benefit of the assignee, is confined to the original term of the patent and does not embrace an extension to the administrator.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

An extension of a patent granted to an executor or administrator does not inure to the benefit of prior assignees under the original patent, but to the administrator. Assignees who were using the patented device at the time the extension was granted have a right to continue the use.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

A party having purchased a machine from an infringer corrected the evil by purchasing from the patentee the entire right for the county where his machine was used, and this gave him the right to use the machine during the extended term.—*Eunson v. Dodge*, 18 *Wall.* 414; 5 *O. G.* 95.

A deed which conveys all right, title, and interest in an "in-

vention," to the full end of the term for which said letters-patent "*may be* granted" carries the entire invention and all patents whensoever issued.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

An owner of a patent who conveys by deed "all his property and estate, whatsoever and wheresoever, of every kind and description," carries the right to the patent.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

A patentee cannot convey any right in an extended patent before the extension is granted, but he may, for a valuable consideration, agree to convey such right whenever it shall be vested in him.—*Day v. Candee*, 3 *Fish.* 9.

Where a patentee agrees upon certain conditions to convey the extended term of a patent, and the conditions have been fulfilled, the assignee becomes the equitable owner of the extension.—*Aiken v. Dolan*, 3 *Fish.* 197.

An assignment of an interest in an invention and letters-patent therefor, before the expiration of the original term, carries with it no interest in a subsequently extended term, unless there is specific provision to that effect.—*Gear vs. Grosvenor*, 6 *Fish.* 314; 1 *Holmes* 215; 3 *O. G.* 380; *Jenkins v. Nicolson Pavement Co.*, 4 *Fish.* 201; 1 *Abbott* 567.

The owner of a patented machine, without any conditions attached to the ownership, has the right to use it during the extended term of the patent or to transfer such right to another.—*Union Paper-Bag Mach. Co. v. Nixon*, 105 *U. S.* 766; 21 *O. G.* 1275; *Com. Dec.* 1882, p. 197.

If a contract is actually made, by which the owner of a patent is bound, and the extension of the patent was intended to be conveyed, a court of equity will treat it as done to carry out the purpose of the parties.—*Labaree v. Peoria, Pekin and Jacksonville R. R. Co.*, 3 *Bann.* & *Ard.* 180.

The right of an inventor to obtain an extension of a patent

may be the subject of a contract of sale.—*Nicolson Pavement Co. v. Jenkins*, 5 *Fish.* 491; 14 *Wall.* 452; 1 *O. G.* 465.

An ordinary assignment of the right in the patentee will not convey any right in the extended patent. When such interest is intended to be assigned it must be expressed.—*Case v. Redfield*, 4 *McLean* 526; 2 *Robb* 741; *Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372; *Gear v. Grosvenor*, 6 *Fish.* 314; 1 *Holmes* 215; 3 *O. G.* 380; *Woodworth v. Sherman*, 3 *Story* 171; 2 *Robb* 257; *Brooks v. Bicknell*, 4 *McLean* 64; *Wetherill v. Passaic Zinc Co.*, 6 *Fish.* 50; 2 *O. G.* 471.

The extension of a patent is a new grant, and the right to it is contingent and personal to the inventor, and does not pass as an incident to the invention and appurtenant thereto.—*Mowry v. Railroad Co.*, 10 *Blatch.* 89; 5 *Fish.* 536; *Clum v. Brewer*, 2 *Curt.* 506.

The phrase "to the full end of the term for which letters-patent are or *may be granted*," includes reissues, renewals, and extensions.—*Railroad Co. v. Trimble*, 10 *Wall.* 367; *Ruggles v. Eddy*, 5 *Fish.* 581; 10 *Blatch.* 52; *Thayer v. Wales*, 5 *Fish.* 448; *Phelps v. Comstock*, 4 *McLean*, 353; *Case v. Redfield*, 4 *McLean* 526; 2 *Robb.* 741; *Gear v. Holmes*, 6 *Fish.* 595; *Emmons v. Sladdin*, 9 *O. G.* 352; *Com. Dec.* 1876, p. 304; 2 *Bann. & Ard.* 199; *vide Hodge v. Railroad Co.*, 3 *Fish.* 410; 6 *Blatch.* 85.

The term, "renewal" is a proper and apt word to confer an interest in the extension of a patent.—*Pitts v. Hall*, 3 *Blatch.* 201; *Goodyear v. Cary*, 4 *Blatch.* 271; *Chase v. Walker*, 3 *Fish.* 120.

The terms, "rights and property that I may have from any letters-patent for the same," are broad enough to include the extended letters-patent.—*Clum v. Brewer*, 2 *Curt.* 506.

An assignment of the invention after the patent has been issued, without any other language to indicate the intention of

the parties, does not import a conveyance of the right to an extended term.—*Waterman v. Wallace*, 13 *Blatch*, 129 ; 2 *Bann.* & *Ard.* 126.

An assignment which, in express words, is limited to the period existing at the time of its execution, cannot be construed to cover a subsequent extension of the patent by special Act of Congress.—*Gibson v. Cook*, 2 *Blatch.* 144.

The grant of a future term of a patent, not yet *in esse*, is not the subject of assignment at common law or within the sense of section 11 of the Act of 1836. The right could rest only in contract.—*Gibson v. Cook*, 2 *Blatch.* 144.

FALSE REPRESENTATIONS.

An assignee who has manufactured under a patent and paid royalties to the assignor, cannot escape liability for arrears on the plea that he had taken the assignment under a misrepresentation and concealment as to the invention by the assignor. No guaranty of title is binding against the setting up of unfounded claims.—*Shaw v. Soule*, 20 *Fed. Rep.* 790.

A contract concerning the purchase of a patent-right may be rescinded, if it were made under false and fraudulent representations by the patentee.—*Hall v. Orvis*, 35 *Iowa* 366.

In order to make a representation a ground for an action of deceit or fraud, it must be shown that the representation was known to be false, and that it was made with an intent to deceive.—*Jolliffe v. Collins*, 21 *Mo.* 338.

An assignee is entitled to have a contract rescinded which he was induced to make on the false representations of the assignor, as to the receipts from sales of the patented device.—*Newell v. Gatling*, 7 *Ind.* 147; *Gatling v. Newell*, 9 *Ind.* 572.

A misrepresentation as to what a patented device would accomplish might be available, under a proper issue, in mitiga-

tion of damages; but in an action of covenant on a sealed note, it should also be averred, that the property for which the note was given was of no value, or that it had been returned or tendered to the vendor.—*Mullikin v. Latchem*, 7 *Blackf.* (*Ind.*) 136; *Hardesty v. Smith*, 3 *Ind.* 39.

The purchaser of a patent-right may set up as a defense in an action upon his note, that he was induced to purchase by means of fraudulent representations on the part of the vendor as to the qualities, capabilities, and usefulness of the invention. *Groff v. Hansel*, 33 *Md.* 161.

False representations as to the durability, cost and usefulness of a patented article, being only matters of opinion, they will not authorize the rescinding of a contract.—*Miller v. Young's Admr.*, 33 *Ill.* 354.

If a purchaser, by false and fraudulent representations of the vendor in matters not known to him, and which are peculiarly within the knowledge of the vendor, is induced to make the purchase and give his note therefor, and would not have entered into the contract of purchase if it had not been for such representations, the note is without consideration and the vendor cannot recover.—*Bierce v. Stocking*, 11 *Gray* (*Mass.*) 174.

If a person sells an article which he falsely and fraudulently represents to be regularly patented, the bond given therefor is rendered void, and the transaction is a fraud for which action will lie.—*Brown v. Wright*, 17 *Ark.* 9; *Bull v. Pratt*, 1 *Conn.* 342.

A purchaser who was deceived by the misrepresentations of the vendor is entitled to a rescission of the sale.—*Pierce v. Wilson*, 34 *Ala.* 596; *Hall v. Orvis*, 35 *Iowa* 366; *Page v. Dickerson*, 28 *Wis.* 694.

If the patentee correctly described and explained a prior invention, but drew from thence an incorrect inference with regard to the principles and similitudes of the two inventions,

while the purchaser formed a more correct opinion, the latter cannot rely on this erroneous inference as a ground for rescinding the contract.—*West v. Morrison*, 2 *Bibb* (*Ky.*) 376.

A plea that a vendor made false representations, but not alleging that the purchaser relied upon such statements and entered into the bargain supposing and believing them to be true, is not sufficient to constitute the defense of fraud.—*Saxton v. Dodge*, 57 *Barb.* (*N. Y.*) 84.

A misrepresentation as to the legal effect of an instrument executed by one of the parties to the other, is not a misrepresentation upon which fraud can be predicated.—*Rose v. Hurley*, 39 *Ind.* 77.

FORFEITURE OF LICENSE.

An exclusive licensee, under agreement to render an account within a time specified, failing to do so, the patentee granted an exclusive license to a third party, but subsequently accepted the tender made by the first licensee of the amount due and continued to receive royalty from him; *held*, that the time of the accounting was not the essence of the agreement; no good reason for cancelling the first agreement was shown, and that the second license was void.—*Dare v. Boylston*, 19 *O. G.* 725; *Com. Dec.* 1881, p. 148; 18 *Blatch.* 548; 6 *Fed. Rep.* 493.

Where an infringer has repudiated a license formerly held by him, and is acting in defiance of the patent and outside the license, such license is no protection against suit for infringement.—*Fetter v. Newhall*, 25 *O. G*, 502; *Com. Dec.* 1883, p. 429; 17 *Fed. Rep.* 841; 21 *Blatch.* 445.

A licensee cannot put an end to his contract, deny the validity of the patent, and afterwards when the validity of the patent is sustained, set up a license from the patentee as a defense.—*Moody v. Taber*, 1 *Bann. & Ard.* 41; 1 *Holmes* 325; 5 *O. G.* 273.

A purchaser of patented articles from a licensee, with full knowledge that he has put an end to his contract with the patentee, will be held to have infringed and will be liable for the profits on all he has made and sold.—*Moody v. Taber*, 1 *Bann. & Ard.* 41; 1 *Holmes* 325; 5 *O. G.* 273.

The non-performance of conditions subsequent does not affect the right and title vested in a licensee until a forfeiture is enforced.—*Stanley Rule & Level Co. v. Bailey*, 3 *Bann. & Ard.* 297; 14 *Blatch.* 510.

Where the licensees repudiate the license, they may be treated by the owner of the patent as infringers.—*Cohn v. Nat. Rubber Co.*, 3 *Bann. & Ard.* 568; 15 *O. G.* 829; *Com. Dec.* 1879, p. 448.

A failure to make stipulated payments does not necessarily terminate a license.—*White v. Lee*, 3 *Fed. Rep.* 222; 5 *Bann. & Ard.* 572.

If a grantee fails to perform the conditions of his contract, and does not claim any right under it, but on the contrary recognizes the assignor's exclusive right to the interest referred to in the agreement, the contract has no vitality.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

A forfeiture of a license may be enforced according to its terms, by reason of the abandonment or the neglect of the licensee to make the stipulated payments.—*Wilson v. Stolley*, 5 *McLean* 1.

Where a patentee has granted a license, a violation of the patent outside of the license does not work a forfeiture of the right conveyed.—*Wood v. Wells*, 6 *Fish.* 382.

If a licensor declares a license forfeited by failure of the licensee to fulfill its conditions, and the licensee acquiesces, the license will be deemed abandoned.—*Kittle v. Frost*, 5 *Fish.* 213; 9 *Blatch.* 214.

On breach of condition, the patentee has a right to avoid

the contract and to be remitted to his original rights, and the licensee is also remitted to his original position and rights, as the contract must be avoided altogether if at all. It cannot be obligatory upon the one party, and not upon the other.—*Woodworth v. Cook*, 2 *Blatch.* 151.

If a licensee neglects to pay his license price for a long time, and finally when prosecuted abandons his license, or, while relying upon it, defends also upon other grounds, the license will be forfeited and he will be liable as an infringer.—*Bell v. McCullough*, 1 *Fish.* 380; 1 *Bond* 194.

FORGERY.

An assignment on which a re-issue was based, though alleged to have been forged by the assignee, yet having been recognized by the assignor as valid; *held*, to be good.—*Campbell v. James*, 17 *Blatch.* 42; 18 *O. G.* 979; *Com. Dec.* 1880, p. 633.

FRAUD.

The right to use a machine after the expiration of the term of the patent is an incident to the primal right to use it during the original term; if that fails on account of fraud the incident falls with it.—*Union Paper-Bag Mach. Co. v. Nixon*, 9 *O. G.* 691; *Com. Dec.* 1876, p. 344; 1 *Flipp.* 491; 2 *Bann. & Ard.* 244.

An assignee under a license obtained by fraud, can have no relief from the consequences of his engagements and contracts made *after* notice of the fraud.—*Consolidated Fruit Jar Co. v. Whitney*, 1 *Bann. & Ard.* 356.

Where an alleged warranty is not contained in a written contract, it cannot be proved by parol evidence, unless in addition to the averment that there was such warranty, there be an allegation that it was false or fraudulent, and that thereby the vendee was deceived.—*McClure v. Jeffrey*, 8 *Ind.* 79.

If a purchaser has had the quiet enjoyment of a patent, the burden of proof is on him to show that no right was conveyed, if he seeks to recover against the vendor.—*Stevens v. Head*, 9 *Vt.* 174.

If a person purchases and pays for a patent-right, and the vendor sends him an assignment for a different patent, he may refuse to receive it, and demand and recover back the money which he has paid.—*Foss v. Richardson*, 15 *Gray* (*Mass.*) 303.

An assignee who has repudiated a contract for the purchase of a patent-right, on account of fraud, may sue for damages. —*Warren v. Cole*, 15 *Mich.* 265.

In order to make a representation a ground for an action of deceit or fraud, it must be shown that the representation was known to be false, and that it was made with an intent to deceive.—*Jolliffe v. Collins*, 21 *Mo.* 338.

The purchaser of a patent-right may set up as a defense in an action upon his note, that he was induced to purchase by means of fraudulent representations on the part of the vendor as to the qualities, capabilities, and usefulness of the invention. —*Groff v. Hansel*, 33 *Md.* 161.

A purchaser of a patent has a right to rely upon the representations made by the vendor as to what the patent contains, and if fraud has been practiced the contract may be rescinded, but the offer to do so must be in a reasonable time after the discovery of the fraud.—*Rose v. Hurley*, 39 *Ind.* 77.

If a purchaser, by false and fraudulent representations of the vendor in matters not known to him, and which are peculiarly within the knowledge of the vendor, is induced to make the purchase and give his note therefor, and would not have entered into the contract of purchase if it had not been for such representations, the note is without consideration, and the vendor cannot recover.—*Bierce v. Stocking*, 11 *Gray* (*Mass.*) 174.

A purchaser who is induced to purchase a patent-right by fraud on part of the vendor, is not entitled to a rescission of the sale if he has affirmed the contract after the discovery of the fraud.—*Pierce v. Wilson*, 34 *Ala.* 596.

A misrepresentation by the vendor as to the price at which he had been selling the article does not constitute fraud whereby the purchaser can avoid payment of a note.—*Williams v. Hicks*, 2 *Vt.* 36.

If a person sells an article which he falsely and fraudulently represents to be regularly patented, the bond given therefor is rendered void, and the transaction is a fraud for which action will lie.—*Brown v. Wright*, 17 *Ark.* 9; *Bull v. Pratt*, 1 *Conn.* 342.

A purchaser who was deceived by the misrepresentations of the vendor is entitled to a rescission of the sale.—*Pierce v. Wilson*, 34 *Ala.* 596; *Hall v. Orvis*, 35 *Iowa* 366; *Page v. Dickerson*, 28 *Wis.* 694.

What is a reasonable time in which a purchaser of a patent-right must elect to disaffirm a contract on account of fraud, is to be determined from the circumstances in the particular case.—*Pierce v. Wilson*, 34 *Ala.* 596.

The party defrauded and those injured by the fraud are the only ones who can take advantage of it to annul a contract. A subsequent purchaser will not be allowed to make the suggestion of fraud in his grantor.—*Edmunds v. Hildreth*, 16 *Ill.* 214.

A license obtained by fraud is a nullity.—*Day v. New Eng. Car Spring Co.*, 3 *Liv. Law Mag.* 44.

An assignee under a license can avail himself of the same means to sustain his title, and repel any attack upon it, as the law allows the assignor.—*Day v. New Eng. Car Spring Co.*, 3 *Liv. Law Mag.* 44.

The title of an assignee or purchaser may be impeached the

same as when it remained with the assignor, by proving that the assignor had procured it by fraud.—*Day v. New Eng. Car Spring Co.*, 3 *Liv. Law Mag.* 44.

A court of equity will not relieve a purchaser of a patent-right from liability upon his bond, if there were no fraud on the par of the assignor, notwithstanding the patent may be void.—*Cansler v. Eaton*, 2 *Jones Eq.* (*N. C.*) 499.

Where a blank piece of paper instead of an assignment was given, the assignee should call upon the assignor for the correction of the mistake, and in the absence of this, or any excuse for the omission, a court of equity can afford no relief.—*Black v. Stone*, 33 *Ala.* 327.

A court of equity will not decree the cancelment of a contract, except for fraud or mistake.—*Brooks v. Stolley*, 3 *McLean* 523; 2 *Robb* 281.

A misrepresentation as to the legal effect of an instrument executed by one of the parties to the other, is not a misrepresentation upon which fraud can be predicated.—*Rose v. Hurley*, 39 *Ind.* 77.

If a person contracts for the purchase of a patent, and he receives and accepts a deed for a different patent, acts under it, and makes payments on account of it, he cannot, in absence of fraud, recover back the consideration paid merely because of a misunderstanding as to the extent of the rights conferred.—*Foss v. Richardson*, 15 *Gray* (*Mass.*) 303.

Where there has been fraud on the part of the vendor in the sale of goods, an offer by the vendee to return them in reasonable time constitutes a good defense in an action for their price.—*Howard v. Cadwalader*, 5 *Blackf.* (*Ind.*) 225; *Wynn v. Hiday*, 2 *Blackf.* (*Ind.*) 123.

GRANT.

A patent right is not a corporeal thing either real or personal, but something intangible and incorporeal, resting wholly

in grant. In contracts for the assignment of such interests, if there be no fraud, the purchaser must depend, in case they prove of no value, wholly upon his covenants. He has no remedy for his money if there is a failure of title.—*Hiatt v. Twomey*, 1 *Dev. & Bat. Eq.* (*N. C.*) 315; *Cansler v. Eaton*, 2 *Jones Eq.* (*N. C.*) 499.

The grant of the full and exclusive right to use and sell the invention within a limited territory, the grantor reserving a right (not the exclusive right) to make; *held*, under all the circumstances, to vest a right to make in the grantees.—*Hamilton v. Kingsbury*, 14 *O. G.* 448; *Com. Dec.* 1878, p. 339; 3 *Bann. & Ard.* 346; 15 *Blatch.* 64.

When a licensor covenants with a licensee that he will not grant to another the same right and license he has granted to him, it is equivalent to a grant of an exclusive right.—*Day v. Cary*, 1 *Fish.* 424.

It is not to be presumed that a grantor intended to grant more than he has a right to grant, or that a grantee intends to receive, by way of grant, that to which he has a full right without a grant.—*Day v. Cary*, 1 *Fish.* 424.

A deed conveys a title, although it may have covenants in it which have not been performed. There are things which rest in grant, and things which rest in covenant. If the covenant fails by the *laches* of the grantor, the grant nevertheless stands. The covenant does not affect the grant; the grant passes the title and operates *in præsenti*.—*Day v. Stellman*, 1 *Fish.* 487.

The thing to be assigned is not the mere parchment on which the grant is written, but the monopoly which the grant confers, the right of property which it creates.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

The performance of a condition precedent does not necessarily make the grant absolute so as to vest the assignee with title.—*Pitts v. Hall*, 3 *Blatch.* 201.

A man can pass by grant or assignment only that which he now possesses, and which is in existence at the time either actually or potentially. His grant or assignment is, therefore, by its natural interpretation limited to the rights and things which are then in existence, and which he has power to grant, unless he uses other language which imports an intention to grant what he does not now possess, and what is not now in existence. In the latter case the language does not even then operate strictly as an assignment or grant, but only as a covenant or contract which a court of equity will carry into full effect when the right or thing comes *in esse*.—*Woodworth v. Sherman*, 3 *Story* 171; 2 *Robb* 257.

The extension of a patent is a new grant, and the right to it is contingent and personal to the inventor, and does not pass as an incident to the invention and appurtenant thereto.—*Mowry v. Railroad Co.*, 10 *Blatch.* 89; 5 *Fish.* 536; *Clum v. Brewer*, 2 *Curt.* 506.

An assignment which, in express words, is limited to the period existing at the time of its execution, cannot be construed to cover a subsequent extension of the patent by special Act of Congress.—*Gibson v. Cook*, 2 *Blatch.* 144.

A grant to use and sell or dispose of the device patented within a specified territory is not an assignment, but merely a license.—*Farrington v. Gregory*, 4 *Fish.* 221.

GRANTEE.

It is not to be presumed that a grantor intended to grant more than he has a right to grant, or that a grantee intends to receive, by way of grant, that to which he has a full right without a grant.—*Day v. Cary*, 1 *Fish.* 424.

The terms "assignee" and "grantee" are not used in the patent law of 1836 as synonymous terms, though courts, without having their attention particularly called to the sub-

ject, have sometimes used them indiscriminately and in their popular sense.—*Potter v. Holland*, 1 *Fish.* 327; 4 *Blatch.* 206.

A grantee is one who has transferred to him, in writing, the *exclusive* right, under the patent, to make and use, and to grant to others to make and use, the thing patented, within and throughout some specified portion of the United States.—*Potter v. Holland*, 1 *Fish.* 327; 4 *Blatch.* 206.

There are three classes of persons in whom the patentee can vest an interest of some kind in the patent. They are: an assignee, a grantee of an exclusive sectional right, and a licensee.—*Potter v. Holland*, 1 *Fish.* 327; 4 *Blatch.* 206.

If a deed is left with a stranger to be delivered to the grantee on the happening of a contingency, the first delivery is complete and irrevocable by death or otherwise.—*Hammond v. Hunt*, 4 *Bann.* & *Ard.* 111.

If a grantee fails to perform the conditions of his contract, and does not claim any right under it, but, on the contrary, recognizes the assignor's exclusive right to the interest referred to in the agreement, the contract has no vitality.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

The clause of forfeiture for non-performance contained in an assignment, does not reduce the grantee to the position of a licensee. For the non-payment or other non-performance a forfeiture might be enforced as for a condition broken, but until it is enforced the title granted remains in the assignee.—*Littlefield v. Perry*, 7 *O. G.* 964; 21 *Wall.* 205.

Where an agreement to account and pay royalty forms part of the consideration of an assignment, it does not reduce the grantee to the position of a licensee.—*Littlefield v. Perry*, 7 *O. G.* 964; 21 *Wall.* 205.

A territorial grantee cannot be restrained from advertising and selling within his territory, even though the purchasers may take the patented articles outside of the vendor's territory.—*Hatch v. Hall*, 30 *O. G.* 1096; 22 *Fed. Rep.* 438.

HEIRS.

In a suit for the infringement of a patent the bill alleged and the proofs showed that the letters-patent became the property of P. as administratrix of the patentee as part of his estate, and that complainant was the sole devisee and legatee under the will of P.; *held*, that no property in the patent passed to complainant, and the bill was dismissed.—*Pelham v. Edelmeyer*, 25 *O. G.* 292; *Com. Dec.* 1883, p. 426; 15 *Fed. Rep.* 262; 21 *Blatch.* 188.

A patent-right, like other personal property, vests in the administrator and not in the heirs, in case the patentee dies intestate.—*Bradley v. Dull*, 19 *Fed. Rep.* 913; 27 *O. G.* 625; *Com. Dec.* 1884, p. 219.

A deed to a dead man is a nullity, and though made to him and "his heirs," the word heirs is not a word of purchase carrying title to the heirs, but only qualifying the title of the grantee.—*Hunter v. Watson*, 12 *Cal.* 363; *vide Price v. Johnston*, 1 *Ohio St.* 390; *Wood v. Ferguson*, 7 *Ohio St.* 288.

IMPROVEMENTS.

The assignment of a *patent*, or of the *invention* or *improvements*, does not convey the extended term, unless the terms used explicitly indicate that it was the intention of the parties to transfer the interest in the extension.—*Holmes & Spaulding*, 4 *O. G.* 581; *Com. Dec.* 1873, p. 166.

An instrument purporting to convey inventions not yet in being is not an assignment, but only an executory contract.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

Although an inventor sells his invention to another, who has also aided him in perfecting it by suggesting minor incidental improvements, the latter does not by these means become

entitled to a patent as the inventor.—*Yost v. Heston*, *Com. Dec.* 1871, p. 226.

An assignment of the full and exclusive right to all the improvements made by an inventor, as set forth in the specification of a patent, does not convey his interest in the extension of the patent.—*Holmes & Spaulding*, 4 *O. G.* 581; *Com. Dec.* 1873, p. 166.

An assignment of an interest in all patents previously obtained by the assignor, does not convey a subsequent invention of an improvement on an invention covered by a patent obtained before the assignment.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

An instrument purporting to be an assignment of an interest in all letters-patent to be subsequently obtained by the assignor, embodying improvements on his prior inventions, is not an actual transfer of the subsequent patents, but merely an agreement to transfer, enforcible only in a court of equity.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

An assignment of inventions not *in esse* does not warrant the issue of the subsequent patents to the assignee as sole or joint grantee, nor does it entitle him to appear as a party to proceedings upon the subsequent application in the Patent Office.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

An assignment by the inventor of a patent, together with the right to improvements to be subsequently invented or patented, does not include a later patent where the construction and mode of operation are substantially different.—*Stebins Hydraulic Elevator Mfg. Co. v. Stebins*, 17 *O. G.* 1348; *Com. Dec.* 1880, p. 498; 4 *Fed. Rep.* 445; 5 *Bann. & Ard.* 199.

A covenant made by a patentee before the enactment of the law authorizing the extension of patents, that any improvement, alteration, or renewal of the patent should inure to the benefit

of the assignee, is confined to the original term of the patent and does not embrace an extension to the administrator.—*Wilson v. Rousseau*, 4 *How.* 646; 2 *Robb* 372.

An assignment under a specific patent does not authorize the assignee to use subsequent improvements, although they may have been invented and attached to the original device at the time the transfer was executed.—*Am. Hide and Leather Co. v. Am. Tool and Mach. Co.*, 4 *Fish.* 284; 1 *Holmes* 503.

The word "invention," used in an agreement to assign a patent, refers to the invention described in that patent, and does not include subsequent improvements, although the first patent may be valueless without them.—*United Nickel Co. v. Am. Nickel Plating Works*, 4 *Bann. & Ard.* 74.

Under an agreement between a patentee and an inventor of an improvement on his device, a new patent was obtained by them as joint patentees; *held*, that in equity they were joint owners of both patents, and the second inventor could enjoin the first patentee from using his patent except in connection with the second patent.—*Duke v. Graham*, 19 *Fed. Rep.* 647.

An assignment of an imperfect invention with all the improvements upon it that the inventor may make is equivalent in equity to an assignment of the perfected results, and the assignees become the owners of the patent granted upon the perfected invention, and if it be issued to the assignor he takes it in trust for the assignees and should convey.—*Littlefield v. Perry*, 7 *O. G.* 964; 21 *Wall.* 205.

A contract may be made to convey a future invention as well as a past one, but the language should be explicit to that effect.—*Nesmith v. Calvert*, 1 *W. & M.* 34; 2 *Robb* 311.

An inventor who is employed to make improvements with the understanding that he is to receive a specific sum for each patentable improvement, must at least put his employer in default before he (the inventor) can assert exclusive ownership

of the improvements.—*Continental Windmill Co. v. Empire Windmill Co.*, 4 *Fish.* 428; 8 *Blatch.* 295.

INDIANA.

The law of Indiana requiring the words "given for a patent-right" to be inserted above the signature on notes given for purchase of an interest in a patent, is unconstitutional and void. —*Ex parte Robinson*, 4 *Fish.* 186; 2 *Biss.* 309; *Helm v. First Nat. Bank*, 43 *Ind.* 167; *Castle v. Hutchinson*, 25 *Fed. Rep.* 394.

INFRINGEMENTS.

A defendant corporation having violated the conditions of a contract under which a license to manufacture and sell a patented device was granted, and the license having therefore been revoked by the licensor under a provision of the contract, in a suit for infringement against such corporation after the revocation, a plea setting up the license was overruled.—*Wooster v. Singer Mfg. Co.*, 23 *O. G.* 2513; *Com. Dec.* 1883, p. 309.

When a license has been revoked by a plaintiff and a defendant is sued as a naked infringer, he is at liberty to avail himself of any defense ordinarily open to a defendant charged with infringement.—*Wooster v. Singer Mfg. Co.*, 23 *O. G.* 2513; *Com. Dec.* 1883, p. 309.

In a suit for the infringement of a patent the bill alleged and the proofs showed that the letters-patent became the property of P. as administratrix of the patentee as part of his estate, and that complainant was the sole devisee and legatee under the will of P.; *held*, that no property in the patent passed to complainant, and the bill was dismissed.—*Pelham v. Edelmeyer*, 25 *O. G.* 292; *Com. Dec.* 1883, p. 426; 15 *Fed. Rep.* 262; 21 *Blatch.* 188.

Where an infringer has repudiated a license formerly held

by him, and is acting in defiance of the patent and outside the license, such license is no protection against suit for infringement.—*Fetter v. Newhall*, 25 *O. G.* 502; *Com. Dec.* 1883, p. 429; 17 *Fed. Rep.* 841; 21 *Blatch.* 445.

The claims for profits and damages arising from infringements prior to the plaintiff's purchase are choses in action, and the assignee takes the title subject to all the equities existing against the assignor.—*New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 25 *O. G.* 1076; *Com. Dec.* 1883, p. 460; 18 *Fed. Rep.* 638; 21 *Blatch.* 519.

When the sale of licenses by the patentee has been sufficient to establish a price for such licenses, that price should be the measure of his damages against an infringer; but a royalty or license-fee, to be binding on a stranger to the licenses which established it, must be uniform.—*Westcott v. Rude*, 27 *O. G.* 719; *Com. Dec.* 1884, p. 225; 19 *Fed. Rep.* 830.

The amount of an established license-fee for the use of a patented invention, is what the patentee loses by the use of the invention in violation of the patent without license, and is a proper measure of damages for such infringement.—*Wooster v. Simonson*, 28 *O. G.* 918; *Com. Dec.* 1884, p. 366; 20 *Fed. Rep.* 317.

An assignee of part of a patent-right cannot maintain an action on the case for a violation of the patent under the Act of 1793.—*Tyler v. Tuel*, 6 *Cranch* 324.

A party having purchased a machine from an infringer, corrected the evil by purchasing from the patentee the entire right for the county where his machine was used, and this gave him the right to use the machine during the extended term.—*Eunson v. Dodge*, 18 *Wall.* 414; 5 *O. G.* 95.

A grant of an exclusive right to make, use, and vend patented articles within certain territory, confers the right to make and vend within said territory for use elsewhere, and any person

who manufactures said machines within said territory without the consent of the grantee, infringes his right, although the machines may neither be sold nor used within said district.—*Jenkins v. Greenwald*, 2 *Fish.* 37; 1 *Bond* 128.

In the defense of suit for infringement of a prior patent, it is competent for a licensee to put in evidence the patent of his licensor.—*Blanchard v. Puttman*, 3 *Fish.* 186; 2 *Bond* 84.

A licensee may proceed, by a petition in equity, to enjoin any party who has actually infringed his right under the license.—*Brammer v. Jones*, 3 *Fish.* 340; 2 *Bond* 100.

The right of using and vending to others to be used within specified territory is a mere license, and gives the licensee no right of action for an infringement of the patent.—*Hill v. Whitcomb*, 1 *Bann. & Ard.* 34; 1 *Holmes* 317; 5 *O. G.* 430.

A mere licensee cannot bring suit for infringement, either at law or in equity, in his own name alone. He must join with him the owner of the legal title.—*Nelson v. McMann*, 4 *Bann. & Ard.* 203; 16 *Blatch.* 139; 16 *O. G.* 761; *Com. Dec.* 1879, p. 586.

After the granting of an exclusive license, neither the licensee nor patentee can alone maintain a bill in equity for infringement; they must join.—*Hammond v. Hunt*, 4 *Bann. & Ard.* 111.

Where the licensees repudiate the license, they may be treated by the owner of the patent as infringers.—*Cohn v. Nat. Rubber Co.*, 3 *Bann. & Ard.* 568; 15 *O. G.* 829; *Com. Dec.* 1879, p. 448.

Licensees will not be permitted to put an end to a contract, or deny the validity of a patent, and when the validity of the patent is sustained, set up as a defense to infringement the prior license which they had repudiated.—*Cohn v. Nat. Rubber Co.*, 3 *Bann. & Ard.* 568; 15 *O. G.* 829; *Com. Dec.* 1879, p. 448.

The directors of a company are personally responsible for the infringement of a patent by their workmen, notwithstanding such infringement may be in contravention of orders.—*Bells v. De Vitre*, 16 *W. R.* 529; *L. Rep.* 3 *Ch.* 441; 37 *L. J. Ch.* 325.

Sale of the *materials* of a patented machine by a sheriff on an execution against the owner, is not such a sale as subjects the sheriff to an action for infringement of the patent right.—*Sawin v. Guild*, 1 *Gal.* 485; 1 *Robb* 47.

An assignee may maintain a suit for infringement without joining the patentee.—*Seibert Cyl. Oil-Cup Co. v. Phillips Lubricator Co.*, 10 *Fed. Rep.* 677; *Nellis v. Pennock Mfg. Co.*, 13 *Fed. Rep.* 451; 22 *O. G.* 1131; *Com. Dec.* 1882, p. 417.

An assignee who settled with persons using a machine which infringed on the right he purchased, and subsequently granted them a license to use the machine, is liable in such case to the assignor for the stipulated royalty.—*Rodgers v. Torrant*, 4 *N. W. Rep.* 507; 43 *Mich.* 113.

An agreement by an assignor "to protect the sale from infringements" is a warranty that the sale and use of the device would infringe no existing patent.—*Croninger v. Paige*, 4 *N. W. Rep.* 106; 48 *Wis.* 229.

In suit for the contract price of a machine purchased under a warranty, the purchaser may defend on the ground of a breach of warranty in that the device is an infringement of a patent.—*Croninger v. Paige*, 4 *N. W. Rep.* 106; 48 *Wis.* 229.

Persons who form themselves into a corporation under the Missouri Statute cannot escape individual liability for the infringement of a patent done in their corporate name.—*St. Louis Stamping Co. v. Quinby*, 5 *Bann. & Ard.* 275; 18 *O. G.* 571; *Com. Dec.* 1880, p. 614.

A license granted by an assignee who had not fulfilled the

conditions of his purchase, but had defaulted in his payments, is not a defense to infringement.—*Abbett v. Zusi*, 5 *Bann.* & *Ard.* 38.

A rescinded contract cannot be resorted to for the purpose of determining the royalty to be paid for infringement, after such contract has ceased to be obligatory.—*Bussey v. Excelsior Mfg. Co.*, 5 *Bann.* & *Ard.* 135; 17 *O. G.* 744; *Com. Dec.* 1880, p. 362; 1 *Fed. Rep.* 640; 1 *McCrary* 161.

In case of infringement subsequent to an assignment of an undivided part of a patent, action must be brought in the joint names of the parties owning the entire interest.—*Moore v. Marsh*, 7 *Wall.* 515.

The assignment of a patent does not carry with it a transfer of the right to damages for an infringement committed before such assignment.—*Moore v. Marsh*, 7 *Wall.* 515.

An agreement which is restricted to the original patent does not estop the assignor from prosecuting for an infringement of the reissue.—*Pickering v. Phillips*, 10 *O. G.* 420; *Com. Dec.* 1876, p. 470; 4 *Cliff.* 383.

INJUNCTION.

Equity will enjoin a licensee from operating under a patent unless he pays the license-fee, whether the license is forfeited at law or not.—*Day v. Hartshorn*, 3 *Fish.* 32.

A licensee may proceed by a petition in equity to enjoin any party who has actually infringed his right under the license.—*Brammer v. Jones*, 3 *Fish.* 340; 2 *Bond* 100.

An injunction against a corporation is binding upon all persons acting for or on behalf of it who have notice of the writ and its contents, whether they be actually served with it or not.—*Phillips v. City of Detroit*, 3 *Bann.* & *Ard.* 150; 16 *O. G.* 627; *Com. Dec.* 1879, p. 562; 2 *Flipp.* 92.

A licensee is entitled to protection under his contract until it is set aside, and he can restrain the licensor from violating its terms, although the court may not be able to decree a specific performance.—*Goddard v. Wilde*, 17 *Fed. Rep.* 845.

A territorial grantee cannot be restrained from advertising and selling within his territory, even though the purchasers may take the patented articles outside of the vendor's territory.—*Hatch v. Hall*, 30 *O. G.* 1096; 22 *Fed. Rep.* 438.

Under an agreement between a patentee and an inventor of an improvement on his device, a new patent was obtained by them as joint patentees; *held*, that in equity they were joint owners of both patents, and the second inventor could enjoin the first patentee from using his patent except in connection with the second patent.—*Duke v. Graham*, 19 *Fed. Rep.* 647.

INSOLVENCY.

Neither an assignee in insolvency nor a receiver can acquire or pass a title to a patent, except by a written instrument signed by the owner of the patent and duly recorded.—*Gordon v. Anthony*, 16 *O. G.* 1135; *Com. Dec.* 1879, p. 638; 4 *Bann. & Ard.* 248; 16 *Blatch.* 234.

An assignee in insolvency, or a receiver of all the property of a debtor appointed under the laws of a State, does not, by virtue of the general assignment or appointment merely, acquire a title in patent-rights.—*Ager v. Murray*, 21 *O. G.* 1197; *Com. Dec.* 1882, p. 188; 105 *U. S.* 126.

An assignment from a bankruptcy court to an assignee in bankruptcy of all patents owned by a bankrupt is not required to be recorded in the Patent Office, as section 5046, Revised Statutes, vests all patent-rights at once in the assignee. A recorded assignment from an administrator of a bankrupt, made after the bankruptcy, cannot prevail over an assignment to the assignee in bankruptcy.—*Prime v. Brandon Mfg. Co.*, 4 *Bann. & Ard.* 379; 16 *Blatch.* 453.

A patent-right issued under the laws of the United States may be required to be assigned to a receiver, under proceedings supplementary to execution, who may sell the same and apply the proceeds in satisfaction of the judgment.—*Pacific Bank v. Robinson*, 20 *O. G.* 1314; *Com. Dec.* 1881, p. 429; 57 *Cal.* 520.

A receiver, appointed by a State court, can convey no interest in a patent, for the reason that the law requires the conveyance to be a written instrument signed by the owner of the patent.—*Gordon v. Anthony*, 4 *Bann. & Ard.* 248; 16 *O. G.* 1135; *Com. Dec.* 1879, p. 638; 16 *Blatch.* 234.

A receiver of an insolvent debtor is entitled to a patent-right belonging to the debtor; and a court is empowered to order the debtor to convey the right to such receiver if such conveyance is necessary.—*Petition of Keach, Receiver*, 19 *Reporter* 731.

The rule that a receiver cannot convey title to a patent unless the owner of the legal title joins, does not apply to the transfer of a mere equitable title.—*Adams v. Howard*, 22 *Fed. Rep.* 656.

It is competent for a State court under an insolvent law to compel a debtor to execute an assignment that would transfer a patent-right to an assignee in insolvency.—*Ashcroft v. Walworth*, 5 *Fish.* 528; 1 *Holmes* 152; 2 *O. G.* 546.

An assignee under a State insolvent law does not acquire any legal title to any interest the debtor may have in a patent, as the statute contemplates a written instrument signed by the owner of the patent, and duly recorded in the Patent Office, in order to vest the legal title in the purchaser.—*Ashcroft v. Walworth*, 5 *Fish.* 528; 1 *Holmes* 152; 2 *O. G.* 548.

Where an agreement between joint owners of a patent to account to each other for profits derived from the use of the invention is a continuing consideration of the grant of the patent, it is not affected by the bankruptcy of one of the parties, and

passes upon an assignment in bankruptcy to the assignee.—*Fraser v. Gates*, 20 *Reporter* 427.

INVENTION.

If an application for a patent by two partners who are joint inventors be rejected by the Patent Office, and one of the partners subsequently secures a patent for the same invention in his own name, the other partner has a joint interest in the invention and patent therefor.—*Vetter v. Lentzinger*, 31 *Iowa* 182.

The value of a patent not being a subject of precise calculation, the contract must be considered as a chancing bargain, in which the price given, compared with the small value of the thing sold, furnishes no ground for rescinding a contract free from fraud.—*West v. Morrison*, 2 *Bibb* (*Ky.*) 376.

Where an inventor has sold a part of his invention, he has done that which is quite consistent with an intent to have the assignee participate in all the rights which he, as inventor, can acquire by law.—*Clum v. Brewer*, 2 *Curt.* 506.

The word "invention," used in an agreement to assign a patent, refers to the invention described in that patent, and does not include subsequent improvements, although the first patent may be valueless without them.—*United Nickel Co. v. Am. Nickel Plating Works*, 4 *Bann. & Ard.* 74.

Where an inventor makes a full and complete assignment of all his right in an invention before the issue of the patent, the assignee may have the patent issued in his name.—*In re Wilson Ager*, 9 *Opin. Atty. Gen.* 403.

The assignment of a *patent*, or of the *invention* or *improvements* does not convey the extended term, unless the terms used explicitly indicate that it was the intention of the parties to transfer the interest in the extension.—*Holmes & Spaulding*, 4 *O. G.* 581; *Com. Dec.* 1873, p. 166.

Although an inventor sells his invention to another, who

has also aided him in perfecting it by suggesting minor incidental improvements, the latter does not by these means become entitled to a patent as the inventor.—*Yost v. Heston*, *Com. Dec.* 1871, p. 226.

An instrument purporting to convey inventions not yet *in esse* is not an assignment, but only an executory contract.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

In enforcing specific performance of a contract to assign an interest in a future invention, equity may (after the invention has been perfected and patented) carve out an undivided interest in the patent, so that a valid assignment to a third party will afterward take effect upon the interest remaining in the patentee.—*Ex parte Edison*, 7 *O. G.* 423; *Com. Dec.* 1875, p. 42.

Whenever a patentee conveys his "invention" without any other language in the deed of conveyance restricting the right to use the invention, he must be considered to have granted the right to any letters-patent which may be issued thereon.—*Emmons v. Sladdin*, 9 *O. G.* 352; *Com. Dec.* 1876, p. 304; 2 *Bann. & Ard.* 199.

The inchoate right to letters-patent, and to any renewals and extensions thereof, may be conveyed by an instrument containing apt terms to show an intention to convey all the rights springing from the invention.—*Emmons v. Sladdin*, 9 *O. G.* 352; *Com. Dec.* 1876, p. 304; 2 *Bann. & Ard.* 199.

Inventions may be assigned before they are patented.—*Canmeyer v. Newton*, 11 O. G. 287; *Com. Dec.* 1877, p. 182; 94 *U. S.* 225.

There being conflicting claimants to ownership in an invention for which letters-patent were to issue, he was excluded from the grant whose assignment deed did not certainly identify the invention in controversy with the one which the deed conveyed.—*Ex parte Paine*, 13 *O. G.* 408; *Com. Dec.* 1878, p. 51.

A suit in equity to fix title of contesting claimants to an invention will not justify the detention of an application for patent therefor, which has been passed to issue.—*Ex parte Paine*, 13 *O. G.* 408; *Com. Dec.* 1878, p. 51.

An assignment of an interest in all patents previously obtained by the assignor, does not convey a subsequent invention of an improvement on an invention covered by a patent obtained before the assignment.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

An instrument purporting to be an assignment of an interest in all letters-patent to be subsequently obtained by the assignor, embodying improvements on his prior inventions, is not an actual transfer of the subsequent patents, but merely an agreement to transfer, enforcible only in a court of equity.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

An assignment of inventions not *in esse* does not warrant the issue of the subsequent patents to the assignee as sole or joint grantee, nor does it entitle him to appear as a party to proceedings upon the subsequent application in the Patent Office.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

An interest in an invention cannot be assigned by parol so as to entitle the assignee to appear in the Patent Office and assert the right to become a joint patentee or to conduct the application in place of the inventor.—*Hammond v. Pratt*, 16 *O. G.* 1235; *Com. Dec.* 1879, p. 337.

An assignment by the inventor of a patent, together with the right to improvements to be subsequently invented or patented, does not include a later patent where the construction and mode of operation are substantially different.—*Stebins Hydraulic Elevator Mfg. Co. v. Stebins*, 17 *O. G.* 1348; *Com. Dec.* 1880, p. 498; 4 *Fed. Rep.* 445; 5 *Bann. & Ard.* 199.

Section 4898 of the Revised Statutes does not provide for the recording of assignments, grants, and conveyances of

interests in unpatented inventions.—*Wright v. Randel*, 21 *O. G.* 493; *Com. Dec.* 1882, p. 94; 19 *Blatch.* 495; 8 *Fed. Rep.* 591.

No assignment of an unpatented invention is required by section 4895 of the Revised Statutes to be recorded, unless it is an assignment on which a patent is to be issued to the assignee; and in such case the invention must be so identified in the assignment—by a reference to a specification, or application, or otherwise– that there can be no mistake as to what particular invention is intended.—*Wright v. Randel*, 21 *O. G.* 493; *Com. Dec.* 1882, p. 94; 19 *Blatch.* 495; 8 *Fed. Rep.* 591.

A deed which conveys all right, title, and interest in an "invention" to the full end of the term for which said letters-patent "*may be* granted," carries the entire invention and all patents, whensoever issued.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

A deed by which an inventor conveys all his right in an invention and in or to the letters-patent that are or may be granted therefor, vests the legal title in the assignee.—*Railroad Co. v. Trimble*, 10 *Wall.* 367.

The owner of a useful invention has the right, by the general laws of the land, to sell it to all who wish to purchase, subject only to restraint from some party having a conflicting patent. —*Celluloid Mfg. Co. v. Goodyear Co.*, 2 *Bann.* & *Ard.* 334; 13 *Blatch.* 375; 10 *O. G.* 41; *Com. Dec.* 1876, p. 419.

The sale of an "invention" carries with it the exclusive right to all present or future patents by the same inventor for the particular invention sold.—*Hammond v. Hunt*, 4 *Bann* & *Ard.* 111.

Section 7 of the Act of 1839, which provides that every person and corporation may use, and vend to others to be used, any *specific machine*, *manufacture* or *composition* of matter which they have purchased or constructed prior to the application for a patent, is limited to the use of the *particular*

thing bought or made, and not the right to practice the invention.—*Brickill v. N. Y. City*, 7 *Fed. Rep.* 479; 18 *Blatch.* 273; 18 *O. G.* 463; *Com. Dec.* 1880, p. 605.

Section 4895, Revised Statutes, which provides for the granting of patents to assignees, does not restrict the grant to the *immediate* assignee.—*Selden v. Stockwell Self-Lighting Gas-Burner Co.*, 9 *Fed. Rep.* 390; 19 *Blatch.* 544; 20 *O. G.* 1377; *Com. Dec.* 1881, p. 431; *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 33 *O. G.* 1597.

An assignment of an interest in an invention secured by letters-patent is a contract, and, like all other contracts, is to be construed so as to carry out the intention of the parties.—*Nicolson Pavement Co. v. Jenkins*, 14 *Wall.* 452; 5 *Fish.* 491; 1 *O. G.* 465.

Whether the machine is perfected or not at the time of the sale is immaterial, if the inventor agrees to make it perfect and procure a patent.—*Rathbone v. Orr*, 5 *McLean* 131.

An assignment of an imperfect invention with all the improvements upon it that the inventor may make, is equivalent in equity to an assignment of the perfected results, and the assignees become the owners of the patent granted upon the perfected invention, and if it be issued to the assignor, he takes it in trust for the assignees, and should convey.—*Littlefield v. Perry*, 7 *O. G.* 964; 21 *Wall.* 205.

A contract may be made to convey a future invention as well as a past one, but the language should be explicit to that effect.—*Nesmith v. Calvert*, 1 *W. & M.* 34; 2 *Robb* 311.

A person who has under agreement employed an inventor to make inventions, can make no claim to inventions made after the employment has ceased.—*Appleton v. Bacon*, 2 *Black* 699.

An inventor who is employed to make improvements, with the understanding that he is to receive a specific sum for each

patentable improvement, must at least put his employer in default before he (the inventor) can assert exclusive ownership of the improvements.—*Continental Windmill Co. v. Empire Windmill Co.*, 4 *Fish.* 428; 8 *Blatch* 295.

A contract by an employé to permit his employers to apply for and obtain a patent for a device he has invented, may be proved by parol.—*Lockwood v. Lockwood*, 33 *Iowa* 509.

An assignment of the invention after the patent has been issued, without any other language to indicate the intention of the parties, does not import a conveyance of the right to an extended term.—*Waterman v. Wallace*, 13 *Blatch.* 129; 2 *Bann.* & *Ard.* 126.

The unmolested use of an invention prior to an application for a patent, with the knowledge and consent of the inventor, gives the person so using the right to continue the use after the grant of a patent.—*McClurg v. Kingsland*, 1 *How.* 202; 2 *Robb* 105.

JOINT INVENTORS.

If an application for a patent by two partners who are joint inventors be rejected by the Patent Office, and one of the partners subsequently secures a patent for the same invention in his own name, the other partner has a joint interest in the invention and patent therefor.—*Vetter v. Tentzinger*, 31 *Iowa* 182.

JOINT OWNERS. (See Tenants in Common.)

Where an agreement between joint owners of a patent to account to each other for profits derived from the use of the invention is a continuing consideration of the grant of the patent, it is not affected by the bankruptcy of one of the parties, and passes upon an assignment in bankruptcy to the assignee.—*Fraser v. Gates*, 20 *Reporter* 427.

If one joint owner of a patent appropriates any portion of the

exclusive right or common property to his separate use or benefit, by either the use or the sale of a patented machine, he does what is in principle the same as the conversion of the joint property by a tenant in common, which authorizes his co-tenant to maintain trover.—*Pitts v. Hall*, 3 *Blatch.* 201; *vide Vose v. Singer*, 4 *Allen (Mass.)* 226.

Persons interested in a patent are simply joint owners, or tenants in common, of the rights and property secured by the patent; and their rights, powers, and duties, as respects each other, are substantially those of the joint owners of a chattel.—*Pitts v. Hall*, 3 *Blatch.* 201.

Two parties owning exclusive patent-rights in different territories, and desiring to effect a community of interest in the whole property, conveyed the rights to a third person as trustee, authorizing him to sell rights, grant licenses, etc. The legal effect of the instrument was to make the trustee their agent to carry out their joint instructions.—*Ladd v. Mills*, 20 *Fed. Rep.* 792; 22 *Blatch.* 242.

If one of several joint partners assigns to a third party, the estoppel upon the assignor must operate as a license to the assignee to use the patent, and the co-owners must look to the one who assigns for an accounting.—*Curran v. Burdsall*, 20 *Fed. Rep.* 835; 27 *O. G.* 1319; *Com. Dec.* 1884, p. 270.

A license by one patentee to use the thing patented clothes the licensee with the right to use it, and, having that right, he is liable for the price which he agreed to pay for the license.—*Dunham v. Indiana & St. Louis R. R.*, 7 *Biss.* 223; 2 *Bann. & Ard.* 327.

Owners of a patent are tenants in common, and each, as an incident of his ownership, has the right to use the patent or to manufacture under it. But neither can be compelled by his co-owner to join in such use or work, or be liable for the losses which may occur, or to account for the profits which may arise

from such use.—*De Witt v. Elmira Nobles Mfg. Co.*, 12 *N. Y. Supr.* 301.

Under an agreement between a patentee and an inventor of an improvement on his device, a new patent was obtained by them as joint patentees; *held*, that in equity they were joint owners of both patents, and the second inventor could enjoin the first patentee from using his patent except in connection with the second patent.—*Duke v. Graham*, 19 *Fed. Rep.* 647.

In the case of joint patentees, where no agreement of co-partnership exists, the relation of co-partners does not result from their connection as joint patentees; when one joint owner transfers his undivided interest to a stranger, the assignee does not become the partner of his co-proprietor.—*Pitts v. Hall*, 3 *Blatch.* 201.

Joint owners of a patent-right are not co-partners, and in the absence of any express contract each is at liberty to use his moiety as he may think fit without liability to an accounting to the other for profits or losses.— *Vose v. Singer*, 4 *Allen* (*Mass.*) 226; *De Witt v. Elmira Nobles Mfg. Co.*, 12 *N. Y. Supr.* 301; *vide Pitts v. Hall*, 3 *Blatch.* 201.

Where there are several patentees, they are tenants in common. One of them has no superiority of right over another. One of them can manufacture and use the article patented without the consent of the others.—*Dunham v. Ind.* & *St. Louis R. R.*, 7 *Biss.* 223; 2 *Bann.* & *Ard.* 327.

One of two joint owners can legally grant, assign, license or sell his own share or right in the patent.—*May v. Chaffee*, 5 *Fish.* 160; 2 *Dillon* 385.

One joint owner can legally grant, assign, license or sell only in respect to his own share or right. He cannot sell and give a good title to his co-owner's right, for the same reason that one joint owner of a chattel cannot transfer the share of his co-proprietor.—*Pitts v. Hall*, 3 *Blatch.* 201.

Where a party owning less than the whole right makes a grant or license, he shall be answerable to the others, rather than that the other patentees shall look to the grantee or licensee.—*Dunham v. Ind. & St. Louis R. R.*, 7 *Biss.* 223; 2 *Bann. & Ard.* 327.

If one of several assignees agrees with the others that in consideration of a stipulated royalty they should have the exclusive right, the invalidity of the patent may be shown in an action to recover the royalties or license fees.—*Marston v. Swett*, 11 *N. Y. Sup.* 153.

The grant of the exclusive right to make, use, and vend to others to be used, is to the patentees jointly, and not to either severally. The right may be granted to others by assignment or license, or by the sale of machines by the patentees *jointly*. —*Pitts v. Hall*, 3 *Blatch.* 201.

An agreement between joint owners of a patent to account to each other for profits derived from the use of the invention does not constitute them partners; they are merely tenants in common.—*Fraser v. Gates*, 20 *Reporter* 427.

JUDGMENT.

A patent-right issued under the laws of the United States may be required to be assigned to a receiver, under proceedings supplementary to execution, who may sell the same and apply the proceeds in satisfaction of the judgment.—*Pacific Bank v. Robinson*, 20 *O. G.* 1314; *Com. Dec.* 1881, p. 429; 57 *Cal.* 520.

A license to use a patented invention may be subjected to sale for the payment of judgments recovered for money due.—*Matthews v. Green*, 19 *Fed. Rep.* 649.

A State court may compel a judgment debtor to execute and deliver to a receiver an assignment of his interest in letters-patent.—*Clan Ranald v. Wyckoff*, 41 *N. Y. Supr.* 527; *Barnes v. Morgan*, 10 *N. Y. Sup.* 703.

A court of equity may direct the sale of the interest of an inventor in his patent in order to satisfy a judgment against him, and for that purpose may require the patentee to make an assignment of the patent under section 4898, Revised Statutes, and in default of such assignment within a limited time the court may appoint a trustee to execute the same.—*Murray v. Ager*, 20 *O. G.* 1311; *Com. Dec.* 1881, p. 423; 1 *Mackey* 87.

JURISDICTION.

A bill to recover the royalties reserved in a transfer of complainant's patents, and alleged to be wrongfully withheld, does not on its face present a case arising under the patent laws of the United States, and, when the parties are citizens of the same State, does not give jurisdiction to the Courts of the United States.—*Albright v. Teas*, 23 *O. G.* 829; *Com. Dec.* 1883, p. 182; 106 *U. S.* 613.

Contracts in relation to patented articles are regulated by the laws of the State in which situated, and are subject to State jurisdiction.—*Bloomer v. McQuewan*, 14 *How.* 539; *Chaffee v. Boston Belting Co.*, 22 *How.* 217.

A suit on a license for the recovery of royalties is not a question arising under the patent law, and the federal courts have not jurisdiction.—*Kelly v. Porter*, 17 *Fed. Rep.* 519; 8 *Saw.* 482.

The Circuit Courts of the United States have no jurisdiction to enforce the specific performance of a contract under a patent, where the parties live in the same State.—*Brooks v. Stolley*, 3 *McLean* 523; 2 *Robb* 281.

LEGAL REPRESENTATIVES.

"Legal representatives" includes assignees as well as executors and administrators in its terms.—*Hamilton v. Kings-*