

tion, in any country.²³⁹ And an invention is patented in the eye of this law, where it is fully shown in the drawings of a patent, though not described in the specification.²⁴⁰ Patents take rank in an art in the order of their numbers;²⁴¹ except where that order is different from the order of the dates upon which they were applied for, in which case they take rank in the order of those dates.²⁴²

§ 184a. The prior state of other arts, may also be considered in construing a claim; because that construction may depend on the area of the territory which was open to the claimant to cover; and because that territory may have been reduced by inventions in other arts, as well as in the art to which the claimed invention belongs.²⁴³ But an invention which was not designed by its maker, nor actually used, nor apparently adapted to perform the function of the claimed invention, but which was used in a remote art, under radically different conditions, to per-

²³⁹ Section 43 of this book.

²⁴⁰ *Wright v. Yuengling*, 155 U. S. 53, 1894.

²⁴¹ *Underwood v. Gerber*, 149 U. S. 224, 1893; *Writing Mach. Co. v. Elliott & Hatch Co.*, 106 F. R. 508, 1900.

²⁴² *Barbed Wire Patent*, 143 U. S. 281, 1892.

²⁴³ *Crescent Brewing Co. v. Gottfried*, 128 U. S. 169, 1888; *Peters v. Active Mfg. Co.*, 129 U. S. 537, 1889; *Peters v. Hanson*, 129 U. S. 541, 1889; *Aron v. Manhattan Railway Co.*, 132 U. S. 85, 1889; *St. Germain v. Brunswick*, 135 U. S. 231, 1890; *Gates Iron Works v. Fraser*, 153 U. S.

347, 1894; *Steiner Fire Extinguisher Co. v. Adrian*, 52 F. R. 731, 1891, and 59 F. R. 133, 1893; *Forgie v. Oil Well Supply Co.*, 57 F. R. 747, 1893; *Schreiber & Sons v. Grim*, 65 F. R. 221, 1895, and 72 F. R. 671, 1896; *Frederick R. Stearns & Co. v. Russell*, 85 F. R. 226, 1898; *Solvay Process Co. v. Michigan Alkali Co.*, 90 F. R. 818, 1898; *Thomson-Houston Electric Co. v. Rahway Electric Co.*, 95 F. R. 660, 1899; *Indiana Novelty Mfg. Co. v. Crocker Chair Co.*, 103 F. R. 496, 1900; *Farrell v. Boston, etc., Silver Mining Co.*, 121 F. R. 847, 1903.

form another function, does not limit the scope of the invention as claimed.²⁴⁴

§ 185. "While it is undoubtedly true that a patentee may so restrict his claim as to cover less than what he invented, or may limit it to one particular form of a machine, excluding all other forms, though they also embody his invention, yet such an interpretation should not be put upon his claim if it can fairly be construed otherwise."²⁴⁵ "Patents for inventions are to receive a liberal construction, and under the fair application of the rule, *ut res magis valeat quam pereat*, are, if practicable, to be so interpreted as to uphold and not to destroy the right of the inventor."²⁴⁶ "A patent should be construed in a liberal spirit to sustain the just claims of the inventor. This principle is not to be carried so far as to exclude what is in it, or to interpolate anything which it does not contain. But liberality, rather than strictness, should prevail where the fate of the patent is involved, and the question to be decided is whether the inventor shall hold or lose the fruits of his genius, and his labors."²⁴⁷ "The court should proceed in a liberal spirit, so as to sustain the patent and the construction claimed by the patentee himself, if this can be done consistently with the language which he has employed."²⁴⁸ "In a case of doubt, where the claim is fairly susceptible of two constructions, that one will be adopted, which will preserve to the patentee his actual invention."²⁴⁹ "The object of the patent law is to secure

²⁴⁴ *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 F. R. 702, 1901; *Electric Candy Machine Co. v. Morris*, 156 F. R. 972, 1905.

²⁴⁵ *Winans v. Denmead*, 15 Howard, 330, 1853.

²⁴⁶ *Turrill v. Railroad Co.*, 1 Wallace, 491, 1863.

²⁴⁷ *Rubber Co. v. Goodyear*, 9 Wallace, 788, 1869.

²⁴⁸ *Klein v. Russell*, 19 Wallace, 433, 1873.

²⁴⁹ *McClain v. Ortmayer*, 141 U. S. 425, 1891.

to inventors, a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation."²⁵⁰

These are the declarations of the Supreme Court relevant to the proper liberality to be observed in construing patents. That liberality as often shows itself in a narrow construction as in a broad one; for narrow construction may be as necessary to establish the validity of a patent, as a broad construction is to lay the foundation for proof of its infringement.²⁵¹ Therefore when it becomes necessary to construe a claim narrowly, in order that its novelty may not be negatived by the prior art, or its validity otherwise overthrown, courts will give such a narrow construction, if they can do so consistently with the language of the claim and of the description.²⁵² On the other hand, a claim will not be narrowed by importing into it, by construction, any dispensable element, in order to enable an infringer to escape the consequences of his infringement.²⁵³

§ 185*a*. It has been held in several circuits that when no practical use has been made of the patent the claims will be narrowly construed, the reason for so holding

²⁵⁰ *Topliff v. Topliff*, 145 U. S. 171, 1892.

²⁵¹ *McEwan Bros. Co. v. McEwan*, 91 F. R. 790, 1899.

²⁵² *Klein v. Russell*, 19 Wallace, 433, 1873; *Jones v. Barker*, 11 F. R. 600, 1882; *Stevenson v. Magowan*, 31 F. R. 826, 1887; *Consolidated Roller-Mill Co. v. Coombs*, 39 F. R. 30, 1889; *Steam Gauge and Lantern Co. v. Wil-*

liams, 50 F. R. 931, 1892; *Van Ness v. Layne*, 213 F. R. 804, 1914; *Fowler & Wolfe Mfg. Co. v. M'Crum-Howell Co.*, 215 F. R. 905, 1914.

²⁵³ *Lamson Cash Reg. Co. v. Keplinger*, 45 F. R. 249, 1890.

But see *Crown Cork & Seal Co. v. Sterling Cork & Seal Co.*, 217 F. R. 381, 1914.

being that in such a case the patent lacks the support that comes from public acquiescence.²⁵⁴ And as a corollary to this proposition it is held that where the invention is a practical success and constitutes a distinct advance in the art the claims are entitled to a liberal construction.²⁵⁵

Nor will claims be narrowed where the proceedings in the Patent Office clearly show that the inventor intended to claim and the Patent Office intended to grant the broader monopoly.²⁵⁶

In view of the principles of the doctrine of equivalents as laid down in the cases cited in Section 359 of this book it is not clear what the Supreme Court meant when it said in *Continental Paper Bag Co. v. Eastern Paper Bag Co.*²⁵⁷

“The invention, of course, must be described and the mode of putting it to practical use, but the claims measure the invention. They may be explained and illustrated by the description. They cannot be enlarged by it. *Yale Lock Co. v. Green-Leaf*, 117 U. S. 554. *Snow v. Lake Shore &c. Railway Co.*, 121 U. S. 617, is a case where a claim was limited by a description of the device, with reference to drawings. The court, in rejecting the contention that the description of the particular device was to be taken as a mere recommendation of the patentee of

²⁵⁴ *Boston Woven Hose & Rubber Co. v. Pennsylvania Rubber Co.*, 164 F. R. 557, 1908; *National Malleable Castings Co. v. Buckeye Malleable Iron & Coupler Co.*, 171 F. R. 847, 1909; *Westinghouse Electric & Mfg. Co. v. Toledo P. C. & L. Ry. Co.*, 172 F. R. 371, 1909; *F. Wesel Mfg. Co. v. Printing Machinery Co.*, 218 F. R. 178, 1914.

²⁵⁵ *Hall Signal Co. v. General Ry. Signal Co.*, 169 F. R. 290, 1909; *Goodwin Film & Camera Co. v. Eastman Kodak Co.*, 213 F. R. 231, 1914.

²⁵⁶ *Win. B. Scaife & Sons Co. v. Falls City Woolen Mills*, 209 F. R. 210, 1913.

²⁵⁷ *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 1908.

the manner in which he contemplated to arrange the parts of his machine, said there was nothing in the context to indicate that the patentee contemplated any alternative for the arrangement of the parts of the device. Therein the description is distinguished from the description in the Liddell patent. Liddell was explicit in the declaration that there might be alternatives for the device described and illustrated by him. He was explicit in saying that in place of the device for controlling the movement of the forming plate relatively to the cylinder that the plate might "be moved or operated by any other suitable means."

While it is true that by statutory provision ²⁵⁸ an inventor, in the case of a machine patent, "shall explain . . . the best mode in which he has contemplated applying that principle," it is not clear how this requirement has any bearing on the scope of his claims. The court has apparently given a broader construction to a patent in which the inventor has stated as a conclusion that there might be alternatives for the device described and shown by him, than it would have done had that statement been absent.

§ 186. "The developed and improved condition of the patent law, leaves no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits those rights. The genius of the inventor should not be restrained by vague and indefinite descriptions of claims in existing patents, from the right of improving on that which has already been invented. It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he

²⁵⁸ Revised Statutes, Section 4888.

has invented, and for what he claims a patent.”²⁵⁹ “As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or, if broader, they must be held to have surrendered the surplus to the public.”²⁶⁰ “It is well known that the terms of the claim in letters patent are carefully scrutinized in the Patent Office. Over this part of the specification the chief contest generally arises. It defines what the Office, after a full examination of previous inventions and the state of the art, determines the applicant is entitled to. The courts, therefore, should be careful not to enlarge, by construction, the claim which the Patent Office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms.”²⁶¹

“In view of the statute, the practice of the Patent Office, and the decisions of this Court, we think that the scope of letters patent should be limited to the invention covered by the claim, and that though the claim may be illustrated, it cannot be enlarged by the language used in other parts of the specification.”²⁶² “Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from what its words express. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is

²⁵⁹ *Merrill v. Yeomans*, 94 U. S. 573, 1876.

²⁶⁰ *Keystone Bridge Co. v. Iron Co.*, 95 U. S. 278, 1877.

See Section 176.

²⁶¹ *Burns v. Myer*, 100 U. S. 672, 1879.

²⁶² *Railroad Co. v. Mellon*, 104 U. S. 118, 1881.

unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.”²⁶³ “Since the inventor must particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery; the specification and drawings are usually looked at only for the purpose of better understanding the meaning of the claim, and certainly not for the purpose of changing it and making it different from what it is.”²⁶⁴ “We know of no principle of law which would authorize us to read into a claim, an element which is not present, for the purpose of making out a case of novelty or infringement.”²⁶⁵

These are the declarations of the Supreme Court relevant to the proper strictness to be observed in construing patents; and they apply to primary patents as much as to secondary patents.²⁶⁶ Therefore, when a claim clearly covers a combination of certain elements, it cannot, by construction, be so altered as to cover more elements, so as not to be invalid,²⁶⁷ or to cover fewer elements, and thus be rendered more likely to be infringed,²⁶⁸ or to cover other elements in place of some that may be omitted, but which are not equivalents therefor.²⁶⁹ So, also, a claim for a process, substantially as described, cannot be construed

²⁶³ *White v. Dunbar*, 119 U. S. 51, 1886.

²⁶⁴ *Howe Machine Co. v. National Needle Co.*, 134 U. S. 394, 1890.

²⁶⁵ *McCarty v. Lehigh Valley Railroad Co.*, 160 U. S. 116, 1895.

²⁶⁶ *Groth v. Postal Supply Co.*, 61 F. R. 287, 1894.

²⁶⁷ *McCarty v. Lehigh Valley Railroad Co.*, 160 U. S. 116, 1895; *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 429, 1894;

Stiles v. Rice, 29 F. R. 445, 1887; *Wollensak v. Sargent*, 41 F. R. 55, 1890; *Westinghouse v. Edison Electric Light Co.*, 63 F. R. 592, 1894; *Anderson Foundry & Mach. Works v. Potts*, 108 F. R. 384, 1901.

²⁶⁸ *Shepard v. Carrigan*, 116 U. S. 597, 1885; *Sutter v. Robinson*, 119 U. S. 541, 1886; *McClain v. Ortmyer*, 141 U. S. 425, 1891.

²⁶⁹ *Sackett v. Smith*, 42 F. R. 852, 1890.

to cover an incidental process set forth in the description, but merely recommended there, instead of being required, or being stated to be essential to the principal process of the patent.²⁷⁰ Likewise a patentee of a manufacture is not restricted to a construction which he describes in the specification merely as "preferable," unless specifically limited by the claims.²⁷¹ And so in the case of a patent for a process where the use of a specified chemical agent is described as "preferable" to a method which the defendant uses.²⁷² In fact as the Supreme Court has said: "An inventor must describe what he conceives to be the best mode, but he is not confined to that. If this were not so most patents would be of little worth."²⁷³ And so in case of a patent for a machine.²⁷⁴ Nor can a claim for a dye stuff as produced from any one of many substances, be construed to be confined to that dye stuff as produced from only one of those substances, where it is proved that none of the others will produce it.²⁷⁵

§ 186a. The acts and conduct of the owner of a patent may also give a construction to a claim which will avoid infringement. For instance, where the patentee had for a number of years placed a certain construction on a claim, with knowledge that the defendant during that time had been selling a device for a similar purpose to that of the complainant, but which did not infringe the claim as so construed, complainant was held to be stopped from

²⁷⁰ Sewell *v.* Jones, 91 U. S. 185, 1875; Holliday *v.* Pickhardt, 29 F. R. 858, 1887.

²⁷¹ Smeeth *v.* Perkins & Co., 125 F. R. 285, 1903; Rollman Mfg. Co. *v.* Universal Hardware Co., 207 F. R. 97, 1913.

²⁷² Fullerton Walnut Growers Ass'n *v.* Anderson Barngrover

Mfg. Co., 166 F. R. 443, 1908.

²⁷³ Continental Paper Bag Co. *v.* Eastern Paper Bag Co., 210 U. S. 405, 1908.

²⁷⁴ Steiger *v.* Waite Grass Carpet Co., 194 F. R. 878, 1912.

²⁷⁵ Matheson *v.* Campbell, 78 F. R. 910, 1897.

claiming infringement.²⁷⁶ This holding may perhaps more properly be placed on the ground of laches. The doctrine applies also to the case of an assignor of a patent who is sued for infringement by the assignee.²⁷⁷

§ 187. Letters patent may be construed in the light of the contemporaneous intention of the inventor and of the Patent Office; and to this end recourse may be had to the files of the application papers to see what changes were made in the description and claims while the application was pending in the Patent Office.²⁷⁸ Where the change made in the Patent Office was a broadening one, it cannot be construed away in order to ascribe validity to the patent.²⁷⁹ But no subsequent application by the same inventor for another patent is admissible in this behalf;²⁸⁰ except where the patent contains a disclaimer of matter said therein to be claimed in another patent or application of the same inventor, in which case that other patent or application is admissible to aid in ascertaining the scope of the disclaimer.²⁸¹

§ 187a. Where an applicant, on the rejection of his application, inserted in consequence of that rejection,

²⁷⁶ *Westinghouse Elec. & Mfg. Co. v. Wagner Co.*, 129 F. R. 604, 1904; *McGill v. Whitehead & Hoag Co.*, 137 F. R. 97, 1905.

²⁷⁷ *Hurwood Mfg. Co. v. Wood*, 138 F. R. 835, 1905.

²⁷⁸ *Crawford v. Heysinger*, 123 U. S. 602, 1887; *Trader v. Messmore*, 1 Bann. & Ard. 639, 1875; *Bate Refrigerating Co. v. Eastman*, 24 F. R. 649, 1885; *Williams v. Rubber Shoe Co.*, 49 F. R. 251, 1892; *Western Engineering & Const. Co. v. Risdon Iron &*

Locomotive Works, 174 F. R. 224, 1909.

²⁷⁹ *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 429, 1894; *Johnson v. Olsen*, 61 F. R. 833, 1894.

²⁸⁰ *Edison Electric Light Co. v. U. S. Electric Lighting Co.*, 47 F. R. 462, 1891.

But see *Lewis Blind-Stitch Mach. Co. v. Arbetter Felling Mach. Co.*, 208 F. R. 992, 1913.

²⁸¹ *National Typographic Co. v. New York Typogtaph Co.*, 46 F. R. 115, 1891.

limitations and restrictions into his specification, for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as it would have been if such limitations and restrictions were not contained in it,²⁸² and this is particularly so where the broad construction claimed would have put the application in interference with another pending application.²⁸³ And where an applicant materially modified a claim, in obedience to a requirement of the Patent Office, it will not be construed as it would have been if it had not been modified,²⁸⁴ even where the modification was made under protest, accompanied by notice that the applicant would insist that the modification should be construed away, after the granting of the patent.²⁸⁵

But the applicant is not precluded from securing by an amended claim every improvement and combination that he has invented and that is not disclosed by the referen-

²⁸² *Roemer v. Peddie*, 132 U. S. 317, 1889; *Hubbell v. United States*, 179 U. S. 80, 1900; *Greene v. Buckley*, 135 F. R. 520, 1904; *St. Louis Street, etc., Co. v. Am. Street, etc., Co.*, 156 F. R. 574, 1907; *Johnson Furnace & Eng. Co. v. Western Furnace Co.*, 178 F. R. 819, 1910; *Campbell v. American Shipbuilding Co.*, 179 F. R. 498, 1910; *Cotto-Waxo Chemical Co. v. Perolin Co. of America*, 185 F. R. 267, 1911; *W. W. Sly Mfg. Co. v. Russell & Co.*, 189 F. R. 61, 1911; *O'Brien-Worthen Co. v. Stempel*, 209 F. R. 847, 1913; *Ventilated Cushion & Spring Co. v. D'Arcy* (citing authorities in the Sixth Circuit), 232 F. R. 468, 1916.

²⁸³ *Ajax Forge Co. v. Morden Frog, etc., Works*, 156 F. R. 594, 1907.

²⁸⁴ *Phoenix Caster Co. v. Spiegel*, 133 U. S. 368, 1890; *Williams v. Rubber Shoe Co.*, 49 F. R. 251, 1892; *Motion Picture Patents Co. v. Independent Moving Pictures Co.*, 200 F. R. 411, 1912; *Grever v. United States Hoffman Co.*, 202 F. R. 923, 1913.

²⁸⁵ *Thomas v. Rocker Spring Co.*, 77 F. R. 431, 1896; *Victor Talking Mach. Co. v. Am. Graphophone Co.*, 151 F. R. 601, 1907; *Gray Telephone Pay Station Co. v. Baird Mfg. Co.*, 174 F. R. 417, 1909; *Sharp & Smith v. Physicians & Surgeons Appliance Co.*, 174 F. R. 424, 1909.

ces on which the original claim was rejected.²⁸⁶ And it has been held that where his claims as restricted by amendment have been rejected by the Examiner but finally allowed on appeal on the broad ground that the basic idea involved invention, the amendments do not restrict the claim to the precise construction therein described.²⁸⁷ It may be remarked that of late years courts generally have been disposed to give much consideration to the fact that an applicant for practical reasons of expediency is often compelled to unduly narrow his claims while the application is pending, and in such cases lean as far as possible in the direction of liberality where the limitations imposed by the Patent Office appear to have been unwarranted. It may be noted that the Court of Appeals of the second circuit gives effect to limitations imposed by the Patent Office only in so far as an estoppel has been created.²⁸⁸

Neither can a patentee, who canceled a claim in his application, after it was rejected by the Patent Office for want of invention or for want of novelty, afterward successfully contend that some other claim of his patent shall be construed to be co-extensive with the one rejected,²⁸⁹

²⁸⁶ *Wayne Mfg. Co. v. Benbow-Brammer Mfg. Co.*, 168 F. R. 271, 1909; *Vrooman v. Penhallow*, 179 F. R. 296, 1910; *Drum v. Turner*, 219 F. R. 188, 1914; *New York Scaffolding Co. v. Whitney*, 224 F. R. 452, 1915; *Weber Electric Co. v. Union Electric Co.*, 226 F. R. 482, 1915.

²⁸⁷ *Gray Telephone Pay Station Co. v. Baird Mfg. Co.*, 174 F. R. 417, 1909.

²⁸⁸ *Westinghouse Electric, etc., Co. v. Condit Electrical Mfg. Co.*,

194 F. R. 427, 1911. See notes 286 and 287 above.

²⁸⁹ *Royer v. Coupe*, 146 U. S. 532, 1892; *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U. S. 40, 1893; *Douglas v. Abraham*, 50 F. R. 422, 1892; *J. L. Mott Iron Works v. Standard Mfg. Co.*, 53 F. R. 821, 1893; *Kelly v. Clow*, 89 F. R. 306, 1898; *Cotto-Waxo Chemical Co. v. Perolin Co. of America*, 185 F. R. 267, 1911; *Besser v. Merillat Culvert Core Co.*, 226 F. R. 783, 1915; *Com-*

even though the cancellation was the result of an adverse decision on an interference proceeding.²⁹⁰ But the doctrine of limitation by amendment applies only to material modifications which alter the mode of operation, and so if the mode of operation is not affected the limitation can properly be disregarded.²⁹¹ Nor can a disclaimer, which was inserted by an applicant in his application in pursuance of a requirement of the Patent Office, be eliminated from his patent by construction.²⁹² And where an applicant canceled a portion of his application, in pursuance of a decision in the Patent Office that it could not be covered in any application with the other portions thereof, a patent granted upon the application thus reduced, cannot be construed to be co-extensive with what it would have been but for such cancellation.²⁹³ So also, where an applicant filed two applications for two patents on related subjects, and withdrew one of them, as a condition of the allowance of the other, the patent granted on the allowed application will not be construed as covering the subject of the application which was withdrawn.²⁹⁴ And these rules apply even where the action of the Patent Office was erroneous, or that of the applicant unnecessary.²⁹⁵ It has been held, however, that in order that pro-

puting Scale Co. *v.* Automatic Scale Co., 204 U. S. 609, 1907.

But see *Veneer Machinery Co. v. Grand Rapids Chair Co.*, 227 F. R. 419, 1915; *Bullock Electric Mfg. Co. v. Crocker-Wheeler Co.*, 141 F. R. 101, 1905.

²⁹⁰ *Marshall & Stearns Co. v. Murphy Mfg. Co.*, 199 F. R. 772, 1912.

²⁹¹ *Automatic Recording Safe*

Co. v. Bankers' Registering Safe Co., 224 F. R. 506, 1915.

²⁹² *Stahl v. Williams*, 52 F. R. 651, 1892.

²⁹³ *Macbeth v. Gillinder*, 54 F. R. 170, 1889.

²⁹⁴ *Frederick R. Stearns & Co. v. Russell*, 85 F. R. 225, 1898.

²⁹⁵ *Lapham Dodge Co. v. Severin*, 40 F. R. 763, 1889; *Shaw Stocking Co. v. Pearson*, 48 F. R. 236, 1891.

ceedings in the Patent Office shall positively operate as an estoppel they must relate to the "pith and marrow" of an alleged improvement.²⁹⁶

But merely incidental amendments, which are not made in pursuance of any references or real reasons given by the Patent Office, but are made in deference to Patent Office preferences for particular phraseology, will not be construed to limit claims so as to make them narrower than the inventions they were designed to cover.²⁹⁷ And no amendment made to meet an objection of the Patent Office, will be construed to disclaim the patentee's actual invention, if that construction can be avoided without doing violence to the obvious meaning of the language.²⁹⁸ Furthermore, concessions addressed to the Examiner made in arguments of the applicant which are not carried into the claims do not limit the claims as finally allowed,²⁹⁹ and an amendment proposed but subsequently withdrawn cannot be construed to impose a limitation on the claim as issued.³⁰⁰

§ 188. The laws which were in force when any particular patent was granted, are the laws according to which it must be construed;³⁰¹ and a special statute relevant to any particular patent is ingrafted on the general patent

²⁹⁶ *U. S. Peg-Wood Co. v. B. F. Sturtevant Co.*, 125 F. R. 382, 1903.

²⁹⁷ *Rhodes v. Lincoln Press Drill Co.*, 64 F. R. 220, 1894; *Hillborn v. Hale & Kilburn Mfg. Co.*, 69 F. R. 960, 1895; *Consolidated Fastener Co. v. Columbian Fastener Co.*, 79 F. R. 798, 1897.

²⁹⁸ *Westinghouse v. Brake Co.*, 65 F. R. 1006, 1895.

²⁹⁹ *Boyer v. Keller Tool Co.*, 127 F. R. 130, 1904; *Fullerton Walnut Growers Ass'n v. Anderson Barngrover Mfg. Co.*, 166 F. R. 443, 1908; *M'Cormick W. P. Cement Co. v. Medusa Concrete Waterproof Co.*, 222 F. R. 288, 1915.

³⁰⁰ *Diamond Match Co. v. Ruby Match Co.*, 127 F. R. 341, 1904.

³⁰¹ *McClurg v. Kingsland*, 1 Howard, 202, 1843.

statutes, and must be construed harmoniously with them.³⁰²

§ 189. Since letters patent are contracts,³⁰³ questions of construction are questions of law for the judge, not questions of fact for the jury.³⁰⁴ As it cannot be expected, however, that judges will always possess the requisite knowledge of the meaning of the terms of art or science used in letters patent, it often becomes necessary that they should avail themselves of the light furnished by experts relevant to the significance of such words and phrases.³⁰⁵ Such is especially the case when electric, magnetic and chemical patents are involved.³⁰⁶ Some courts have held that it is proper to disregard patents put in evidence to prove anticipation when they are not explained.³⁰⁷ Experts are not required and in fact the use of their testimony is discouraged in cases in which the

³⁰² *Evans v. Eaton*, 3 Wheaton, 454, 1818; *Bloomer v. McQuewan*, 14 Howard, 539, 1852.

³⁰³ *Denning Wire & Fence Co. v. Am. Steel & Wire Co.*, 169 F. R. 793, 1909; *Century Electric Co. v. Westinghouse Electric Mfg. Co.*, 191 F. R. 350, 1911; *Fried, Krupp Aktien-Gesellschaft v. Midvale Steel Co.*, 191 F. R. 588, 1911; *O'Brien-Worthen Co. v. Stempel*, 209 F. R. 847, 1913; *Am. Roll Gold Leaf Co. v. W. H. Coe Mfg. Co.*, 212 F. R. 720, 1914; *Railroad Supply Co. v. Hart Steel Co.*, 222 F. R. 261, 1915; *O. H. Jewell Filter Co. v. Jackson*, 140 F. R. 340, 1905.

³⁰⁴ *Winans v. Denmead*, 15 Howard, 330, 1853; *Coupe v. Royer*, 155 U. S. 565, 1894; *Pre-*

payment Car Sales Co. v. Orange County Traction Co., 221 F. R. 939, 1915; *Brothers v. Lidgerwood Mfg. Co.*, 223 F. R. 359, 1915.

See Section 499.

³⁰⁵ *Loom Co. v. Higgins*, 105 U. S. 580, 1881; *Fay v. Mason*, 127 F. R. 325, 1903; *Charmbury v. Walden*, 141 F. R. 373, 1905; *Fried, Krupp Aktien-Gesellschaft v. Midvale Steel Co.*, 191 F. R. 588, 1911.

³⁰⁶ *Sundh Electric Co. v. General Electric Co.*, 204 F. R. 277, 1913.

³⁰⁷ *Benbow-Brammer Mfg. Co. v. Heffron-Tanner Co.*, 144 F. R. 429, 1906; *Bell v. MacKinnon*, 148 F. R. 205, 1906; *General Electric Co. v. Germania Electric Co.*, 174 F. R. 1013, 1909.

mechanical details are simple and the issue of infringement sharply defined.³⁰⁸ The judges are not obliged to follow blindly the testimony of experts. They may disregard it if it appears to them to be unreasonable.³⁰⁹ While the testimony of experts relevant to the meaning of particular words or phrases in letters patent, is to this extent admissible, such testimony is inadmissible on the question of the construction of the letters patent as a whole.³¹⁰

§ 190. In the absence of contrary evidence, the invention covered by a particular letters patent is presumed to be identical with that covered by the application on which those letters patent were granted.³¹¹

§ 191. All persons are chargeable with notice of the contents of all letters patent of the United States, because those letters patent are matters of public record.³¹² But those letters patent are so numerous and so various, and many of them are so abstruse and so complicated, that it is far beyond the power of the strongest intellect, to learn in a lifetime the contents of them all.

More than four hundred thousand letters patent of the United States were in force in 1903; and nearly as many others expired before the end of that year. The unexpired patents contained more than two millions of claims; the validity of each of which depends on the question whether its subject was a new and useful invention, as compared with all prior patents and printed publications anywhere in the world. And the question whether any process can

³⁰⁸ *Fay v. Mason*, 127 F. R. 325, 1903; *Hardinge Conical Mill Co. v. Abbe Engineering Co.*, 195 F. R. 936, 1912.

³⁰⁹ *Winans v. Railroad Co.*, 21 Howard, 88, 1858.

³¹⁰ *Corning v. Burden*, 15 Howard, 252, 1853.

³¹¹ *Loom Co. v. Higgins*, 105 U. S. 580, 1881.

³¹² *Boyden v. Burke*, 14 Howard, 575, 1852.

be performed, or any machine, manufacture, composition of matter or design, can be copied, made, used or sold, without infringing any unexpired United States patent, is a question which depends on its non-conformity with every one of the two millions of claims of those patents. To investigate and answer such of these questions as arise in a particular manufacturing enterprise, or in a particular litigation, is a work which can be done only by a patent expert; and a patent expert who performs that work in a large variety of complicated cases, in many different arts, must employ extensive information, exercise penetrating power of analysis, and carry as best he may, a heavy responsibility.

§ 191*a*. Property in patents is not taxable by state authority; because such taxation would constitute interference with rights created by national authority, and would, therefore, be contrary to the Constitution of the United States.³¹³ Patents for inventions are taxable by national authority; though no statute providing for any such taxation has ever been enacted by Congress. Such taxation, if it were to be prescribed, would be direct taxation as distinguished from being a duty, impost or excise;³¹⁴ and would, therefore, necessarily be apportioned among the several States, in proportion to their respective populations as ascertained by the last preceding national census.³¹⁵ That constitutional plan of direct taxation would operate so unequally, if it were to be applied to property in patents, that no enlightened statesman or publicist would support any proposal to enact a national statute providing for such taxation. For these reasons,

³¹³ *M'ulloch v. Maryland*, 4 Wheaton, 436, 1819. & Trust Co., 158 U. S. 601, 1895.

³¹⁴ *Pollock v. Farmers' Loan*

³¹⁵ Constitution of the United States, Article 1, Section 9.

the freedom from taxation, which letters patent of the United States have had, from the beginning of their issuance in the eighteenth century, will undoubtedly continue as long as the Constitution of the United States continues unchanged in respect of the subject of taxation, and in respect of the relations of the Nation to the States.

CHAPTER VIII

DISCLAIMERS

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| 192. Statutory authorization of disclaimers. | 202. Fraudulent or deceptive intention. |
| 193. Statutory prescriptions, relevant to disclaimers. | 203. Effect of unreasonable delay to file a disclaimer. |
| 194. Errors which justify disclaimers. | 204. Beginning of unreasonable delay to file a disclaimer. |
| 195. Mistakes of fact, relevant to novelty. | 205. Costs, where a necessary disclaimer has not been filed. |
| 196. Mistakes of law, relevant to invention. | 206. Extent of disclaimant's interest. |
| 197. Claims void for want of utility. | 207. Construction of letters patent after a disclaimer. |
| 198. Proper disclaimers. | 208. Disclaimers filed pending litigation. |
| 199. Improper disclaimers. | 209. Disclaimers required by judicial decisions. |
| 200. Immaterial parts. | |
| 201. Reissue claims. | |

§ 192. THE statutory provisions relevant to disclaimers originated in 1837, and have never been substantially changed. Sections 7 and 9 of the Patent Act of that year,¹ embodied those provisions; and those sections continued in force till July 8, 1870, when they were substantially re-enacted as Sections 54 and 60 of the Consolidated Patent Act of that date.² In 1874, the latter sections were, in their turn, re-enacted, without any material change, as Sections 4917 and 4922 of the Revised Statutes. It would have been better statute writing, if those two sections had

¹ 5 Statutes at Large, Ch. 45, Sections 7 and 9, p. 193.

² 16 Statutes at Large, Ch.

230, Sections 54 and 60, p. 206; Taylor v. Archer, 8 Blatch. 318, 1871.

always been blended together into one clear and comprehensive paragraph. Referring to the same subject, and standing, as they always have, in the same statute, they must undoubtedly be construed together;³ and the law they embody, must be set forth, by extracting from both sections, all the material meaning of both, and by incorporating that meaning, together with the case law of the subject, into one systematic explanation. Let that therefore be the present attempt.

§ 193. Whenever through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has, in his specification, claimed materially more than that of which he was the first inventor, his patent shall be valid for whatever is justly his own; and every such patentee, his executors, administrators, or assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of such part, if it is a material and substantial part of the thing patented, and is definitely distinguishable from the parts claimed without right. But in every such case, in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered, unless the proper disclaimer was entered in the Patent Office, before the commencement of the suit. But no patentee shall be entitled to maintain any such suit, if he has unreasonably neglected or delayed to enter a disclaimer. And any such patentee, his heirs or assigns, whether of the whole or of any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the subject-matter of the patent, as he shall not choose to longer claim, stating therein the extent of his interest in such patent. Such disclaimer

³ *Hailes v. Stove Co.*, 123 U. S. 588, 1887; *Sessions v. Romadka*, 145 U. S. 41, 1892.

shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, and shall thereafter be considered a part of the original specification, to the extent of the interest possessed by the disclaimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.⁴

§ 194. The primary fact which brings the law stated in the last section into play, is the claiming by a patentee of materially more in his patent than he was entitled to claim.⁵ Such errors may spring from inadvertence. That is to say, they may spring from failure, on the part of the writer of the claims, to exercise proper care in penning them. So also, they may arise from accident: from chances against which even diligent care cannot always guard. But mistake is the most common source of such errors; and such errors may arise from mistake of fact or from mistake of law.⁶

§ 195. Mistakes of fact, relative to how much of a described process, machine or manufacture was first invented by its patentee, frequently follow from lack of full information touching what was previously invented by others. Litigation may alone disclose the fact that the patentee's claims are too numerous or too broad to be consistent with novelty. Whenever this occurs, it is clear that the patentee ought no longer to appear to hold an exclusive right to anything which he was not the first to invent. To this end, the statute provides that he must disclaim

⁴ Revised Statutes, Sections 4917 and 4922 blended together.

⁵ *Hailes v. Stove Co.*, 123 U. S. 588, 1887; *Brush Electric Co. v.*

Ft. Wayne Electric Light Co., 40 F. R. 835, 1889.

⁶ *Electrical Accumulator Co. v. Julien Electric Co.*, 38 F. R. 134, 1889.

that part, within a reasonable time, or, in default thereof, must suffer the statutory consequences. On the other hand, it is equally clear, that if the patentee is willing to eliminate from his claims, everything which later information shows had been invented before him, he ought to be allowed to retain his exclusive right to the residue. To this end, the statute provides that if within a reasonable time, he disclaims what was another's, he shall be enabled to enforce his patent as far as it covers what was his own invention. But a disclaimer cannot confine a claim to ground which does not appear in the patent to constitute an invention; even where that ground is narrower than that which was originally claimed in the patent.⁷

§ 196. A mistake of law, which consists in claiming something not patentable, may also be remedied by disclaimer.⁸ The law which permits a patentee to disclaim, is remedial. It is intended for the protection of the patentee, as well as for the protection of the public. The evil to be remedied is the same, where a patentee has claimed more than he ought, whether that result sprang from the fact that another invented it before him, or sprang from the fact that what he produced was not an invention at all. For this reason, the Supreme Court held that the eighth claim of Morse might be disclaimed, after having been held void for want of patentability, with the same effect as though it had been held void for want of novelty. The same reason would also permit a patentee to disclaim any claim which is void for want of invention. Indeed the statute expressly applies to such a case, for no man can be the first inventor of anything which is not an invention. He may be its first discoverer, if it is a law of nature, or its first constructor, if it is a

⁷ *Hailes v. Albany Stove Co.*,
123 U. S. 587, 1887.

⁸ *O'Reilly v. Morse*, 15 Howard,
120, 1853.

product of mere mechanical skill, but its first inventor he cannot be. And a mistake of law, which consisted in unlawfully claiming, in separate claims, in one patent, several independent inventions, may be remedied by disclaiming enough claims to give to the patent the necessary unity.⁹

§ 197. There appears to be no warrant in the statute, for disclaiming any claim which is void for want of utility, and for no other cause. An inventor of a new thing may generally ascertain its character in point of utility before applying for a patent. If he can do so, he ought to do so, and thus shield the public from a waste of time involved in examining and judging useless contrivances. Where a patent has but one claim, and where the matter covered by that claim is useless, no disclaimer could make that patent valid. Where a part only of the claims of a patent are void for want of utility, and for no other cause, the void claims are not injurious to the valid ones, and therefore no disclaimer is needed in any such case.¹⁰

And no disclaimer is necessary where some, but not all, of the claims of a patent are void, by reason of constructive abandonment, resulting from public use or sale of the subjects of those particular claims, more than two years prior to the application for the patent.¹¹

Where two patents are applied for on the same day, and are granted on the same day, to the same inventor, for the same invention; the owner of them has the lawful power to choose which one of those patents he will retain, but he must somehow relinquish the other.¹² He cannot rid

⁹ *Sessions v. Romadka*, 145 U. S. 40, 1892; *Manhattan General Const. Co. v. Helios-Eyton Co.*, 135 F. R. 785, 1905.

¹⁰ See Section 205.

¹¹ *Whitney v. B. & A. L. Co.*, 50 F. R. 72, 1892.

¹² *Electrical Accumulator Co. v. Brush Electric Co.*, 52 F. R. 138, 1892.

himself of his superfluous patent, in such a case, by means of a disclaimer under the disclaimer statutes; but he can undoubtedly do so by means of a surrender of his superfluous patent, uncoupled with any application for a reissue thereof.

§ 198. The statute provides that a disclaimer, to be effective, must leave claimed by the patent, at least one definitely distinguishable and material part of the original subject of the patent. That result is commonly accomplished by disclaiming one or more claims, while leaving one or more other and independent claims undisturbed in the patent. But that result can be sometimes accomplished in some other way.

For example, where two or more claims in substance, are combined in one claim in form, by the use of the words "with or without" or by use of the word "or" alone, a disclaimer may be made to expunge one of those inventions from that claim, without disturbing any other.¹³

And where a patent contains a proper specific claim, and also a generic claim which covers not only the subject of the specific claim, but also covers other matter which requires to be disclaimed, that result can be accomplished by a disclaimer of the generic claim, without any injury resulting to the specific claim, from that disclaimer.¹⁴

And where an invention is limited by the prior art, in some particular in which the patent states that it is not limited, that statement may be removed by a disclaimer, so as to confine the construction of the claim of the pat-

¹³ *Tuck v. Bramhill*, 6 Blatch. Electric Co., 38 F. R. 134, 95, 1868; *Taylor v. Archer*, 8 Blatch. 318, 1871; *Electrical Accumulator Co. v. Julien* 1889.

¹⁴ *Graham v. Earl*, 82 F. R. 740, 1897.

ent, to the boundaries to which the invention is limited by the prior art.¹⁵

And where the actual invention of a patentee, consisted of the parts specified in a combination claim, plus some other element specified in the description, as being usable with the parts specified in the claim, the claim may be restored to its proper limits, by the addition of that element thereto, by means of a disclaimer; if that result can be accomplished by disclaiming such statements in the description, as indicate that that element can be omitted from the subject of the patent.¹⁶

§ 199. Where the invention of a patentee consisted in a combination of less than all of the parts specified in a combination claim in his patent, he cannot disclaim the surplus parts, and afterward hold as infringers, those who make, use or sell the other parts alone, in addition to thus holding those who make, use or sell all the parts of the original claim; because that operation would broaden the patent instead of narrowing it; and because that result would be contrary to the purpose of the statutes of disclaimers.¹⁷

And where the only invention left to a patentee by the prior art, is shown in the drawings of his patent, but is not mentioned in the description, or attended to in any claim of that document; that invention is not such a part of the subject of the patent, as can be monopolized by disclaiming all that the patent described.¹⁸

§ 200. There is one difference between the two dis-

¹⁵ *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 436, 1902; *Schwarzwalder v. New York Filter Co.*, 66 F. R. 152, 1895.

¹⁶ *Hurlbut v. Schillinger*, 130 U. S. 463, 1889.

¹⁷ *Cerealine Mfg. Co. v. Bates*, 77 F. R. 883, 1897.

¹⁸ *Hailes v. Albany Stove Co.*, 123 U. S. 587, 1887.

claimer sections of the Revised Statutes, which it is proper to mention and explain in this place. Section 4917 contemplates disclaimers as being proper whenever a patentee has claimed more than that of which he was the first inventor; while Section 4922 attends only to cases wherein the excess is a material or substantial part of the thing patented. This qualification should be inserted in the two sections, as construed together, because Section 4922 is the only one that prescribes any evil result from a failure to disclaim. Neither section visits any infliction on the patentee, for omitting to disclaim anything which is an immaterial part of the thing patented. If, therefore, a patentee omits to disclaim such a part when he discovers it to have been known before his invention thereof, or learns that it is not an invention at all, he thereby loses no right, and incurs no inconvenience.¹⁹ To file a disclaimer, in such a case, is an act which is at once harmless and unnecessary.

§ 201. Reissue patents, as well as original patents, are entitled to the benefits of the law relevant to disclaimers; and that too, even where the matter disclaimed was not claimed in the original, but only in a reissue granted upon its surrender.²⁰ But no claim which was in an original patent, and is absent from a reissue thereof, can be reclaimed by a disclaimer of the changes made by the reissue.²¹ Where an original patent was surrendered, and then reissued in several divisions; that is to say, where several reissue patents were granted for separate inven-

¹⁹ *Hall v. Wiles*, 2 Blatch. 199, 1851; *Peek v. Frame*, 5 Fisher, 212, 1871.

²⁰ *O'Reilly v. Morse*, 15 Howard, 62, 1853; *Gage v. Herring*, 107 U. S. 646, 1882; *Yale Lock Co. v.*

Sargent, 117 U. S. 553, 1886; *Schillinger v. Gunther*, 17 Blatch. 69, 1879; *Tyler v. Galloway*, 12 F. R. 567, 1882.

²¹ *McMurray v. Mallory*, 111 U. S. 109, 1883.

tions described in an original patent, a suit based upon one of those divisions will be unaffected by the fact that a claim in another division is invalid for want of novelty, or for want of invention. The statute relevant to disclaimers has no application to such cases.²²

§ 202. Fraudulent or deceptive intention, if it existed on the part of a patentee, when claiming materially more than that of which he was the first inventor, or when claiming that which was not patentable, will rightly prevent him from receiving any benefit from a disclaimer. The statutory provision is in harmony with the principles of equity: a system which always declines to extract persons from trouble which arose from their own moral turpitude.

§ 203. The statement in Section 4917, that under the circumstances therein mentioned, a patentee's patent shall be valid as to all that part of the invention which is truly and justly his own, is to be construed in connection with the provision in Section 4922, that the patentee shall not be entitled to recover in any suit, if he unreasonably neglects or delays to enter a disclaimer. When so construed, the two sections enact that where a patentee claims materially more than that which he was the first to invent, his patent is void, unless he has preserved the right to disclaim the surplus; and that he may fail to preserve that right, by unreasonable neglect or delay to enter a disclaimer in the Patent Office.

This enactment is in harmony with that point in the common law which made a patent wholly void, if any claim in it, was out of conformity with the actual invention of the inventor on whose application it was granted.²³

§ 204. Neglect or delay to file a necessary disclaimer, be-

²² *Elastic Fabrics Co. v. Smith*,
100 U. S. 111, 1879.

²³ *Hailes v. Albany Stove Co.*,
123 U. S. 588, 1887.

gins when knowledge is brought home to the patentee, that the inventor upon whose account the patent was granted, was not the first inventor of a particular thing claimed in the patent, and material to the subject of the patent as a whole.²⁴ If, however, there is reasonable ground for difference of opinion relevant to the question whether the prior patent, or prior printed publication, or the prior process, or the prior thing, so brought home to the knowledge of the patentee, really negatives the novelty of anything claimed by him, then unreasonable delay to file a disclaimer will not begin until that question is finally settled by the courts.²⁵ Even a still further very short delay is not fatal to the right to disclaim;²⁶ and if the patent has expired when the occasion for a disclaimer is established, no disclaimer can be filed or is necessary.²⁷ The question whether the delay to enter a disclaimer, in a particular case, was or was not unreasonable, is a mixed question of law and fact, to be decided by the jury in accordance with proper instructions from the court.²⁸ In the case of *Seymour v. McCormick*,²⁹ the Supreme Court, when speaking of the question of the necessity for a disclaimer in that case, and of the question of unreasonable delay in entering one, said: "Under the circumstances, the question is one of law." The peculiar collocation of the paragraph, has caused some courts to suppose that

²⁴ *O'Reilly v. Morse*, 15 Howard, 121, 1853; *Singer v. Walmsley*, 1 Fisher, 558, 1860; *Parker v. Stiles*, 5 McLean, 44, 1849.

²⁵ *Seymour v. McCormick*, 19 Howard, 106, 1856; *Potter v. Whitney*, 1 Lowell, 87, 1866; *Hill v. Biddle*, 27 F. R. 561, 1886.

²⁶ *Kittle v. Hall*, 30 F. R. 39, 1887.

²⁷ *Yale Lock Co. v. Sargent*, 117 U. S. 553, 1885.

²⁸ *Brooks v. Jenkins*, 3 McLean, 449, 1844; *Washburn v. Gould*, 3 Story, 122, 1844; *Burden v. Corning*, 2 Fisher, 477, 1864; *Office Specialty Co. v. Globe Co.*, 65 F. R. 605, 1895.

²⁹ *Seymour v. McCormick*, 19 Howard, 106, 1856.

the question thus characterized, was the question of delay;³⁰ but really it must have been the question of necessity. The latter depended wholly upon the construction of the patent, and was therefore a question of law. Whether or not a particular instance of delay was unreasonable, must largely depend upon the circumstances which surrounded the person chargeable therewith. What those circumstances were is a question of fact. Whether they constitute an excuse for the delay is a question of law. Whether or not a particular instance of delay to enter a necessary disclaimer was unreasonable, is therefore a mixed question of law and of fact.

§ 205. No costs can be recovered by the plaintiff in any infringement suit, the final decision of which shows a necessity for a disclaimer, unless such a disclaimer was entered in the Patent Office before the commencement of the suit.³¹ This rule applies even to cases where the delay to enter the disclaimer was not unreasonable.³² But a verdict on all the claims of a patent entitles the plaintiff to costs, even if, after that verdict, he files a disclaimer to one or more of the claims of that patent.³³ Failure on the part of the plaintiff to enter the proper disclaimer does not, however, entitle the defendant to costs as the effect of the failure to disclaim is negative merely.³⁴

The case where a disclaimer is necessary to save the patent must, however, be distinguished from the case

³⁰ *Singer v. Walmsley*, 1 Fisher, 558, 1860; *Parker v. Stiles*, 5 McLean, 44, 1849.

³¹ Revised Statutes, Section 4922; *Reed v. Cutter*, 1 Story, 591, 1841; *Burdett v. Estey*, 5 Bam. & Ard. 309, 1880; *Proctor v. Brill*, 16 F. R. 791, 1883; *Nov-*

elty Glass Mfg. Co. v. Brookfield, 172 F. R. 221, 1909.

³² *O'Reilly v. Morse*, 15 Howard, 121, 1853; *Yale Lock Co. v. Sargent*, 117 U. S. 553, 1885.

³³ *Peek v. Frame*, 5 Fisher, 212, 1871.

³⁴ *Novelty Glass Mfg. Co. v. Brookfield*, 172 F. R. 221, 1909.

where a disclaimer would be merely proper, as, for instance where a claim is invalid for incompleteness of description, as in the latter case the foregoing rule as to costs does not apply.³⁵

Judge JOHN LOWELL remarked that where a plaintiff sues on a part of the claims of his patent only, the defendant will not be permitted to raise any issue relevant to the validity of any other claim, with intent to show a necessity for a disclaimer, and thus to escape costs.³⁶ His Honor based this opinion on the fact that more expense might be incurred in litigating such a collateral issue, than would be justified by the amount of the costs depending upon its decision. But general rules of law can hardly be based on considerations of what is expedient in a part only of the cases to which those rules purport to apply. It may happen that the costs involved in a particular litigation are large, while the expense involved in proving a necessity for a disclaimer of some one claim of the patent is small. The difference between the two sums may sometimes be measured by thousands of dollars. A judgment or a decree may be largely lessened, and justly lessened, if a defendant is permitted to prove a necessity for a disclaimer of a claim not sued upon. In view of these considerations, it is possible that the law will finally be settled otherwise than as Judge LOWELL'S remark would seem to forecast.

§ 206. Disclaimers are required to state the extent of the interest which is held by the disclaimant in the patent involved.³⁷ If, however, the disclaimant is the original patentee, and the disclaimer states that fact, and is silent

³⁵ National Electric Signalling Co. v. De Forest Wireless Telegraph Co., 140 F. R. 449, 1905.
See Section 197.

³⁶ American Bell Telephone Co. v. Spencer, 8 F. R. 512, 1881.

³⁷ Revised Statutes, Section 4917.

respecting any transfer of any part of it, the fair implication is that he still owns the whole, and that implication is a sufficient statement of the interest of the patentee.³⁸ So also, if an executor or administrator, in whose name a patent has been granted, states in his disclaimer that he is the patentee, and refers to the patent as showing his interest, that is a sufficient statement of his interest in the patent.³⁹ But if only one of several joint owners or owners in common of a patent, should file a disclaimer, no other owner could avail himself of its benefits, nor could it affect a suit brought by all the owners jointly.⁴⁰

§ 207. The construction of a patent, after a disclaimer has been properly entered, must be the same that it would have been if the matter so disclaimed had never been claimed.⁴¹ The mere fact of disclaimer is no evidence that the matter disclaimed is a part of the prior art.⁴² And where a disclaimer disclaims a particular thing specifically, that thing cannot afterward be covered by the patent as being an equivalent of another thing which was not disclaimed.⁴³ No disclaimer, in order to be effectual, needs to eliminate anything from the description; though no harm will follow from such elimination, if it is confined to matter which is disclaimed, and which is not needed to show the nature of the invention which, after disclaimer, the patent continues to cover.⁴⁴

§ 208. Disclaimers may be filed pending a suit on the

³⁸ *Silsby v. Foote*, 14 Howard, 221, 1852.

³⁹ *Brooks v. Jenkins*, 3 McLean, 432, 1844.

⁴⁰ *Wyeth v. Stone*, 1 Story, 294, 1840.

⁴¹ *Dunbar v. Myers*, 94 U. S. 187, 1876; *Schwarzwalder v. Filter Co.*, 66 F. R. 157, 1895; *Brace-*

well v. Passaic Print Works, 107 F. R. 467, 1901.

⁴² *Manhattan General Const. Co. v. Helios-Upton Co.*, 135 F. R. 785, 1905.

⁴³ *Cartridge Co. v. Cartridge Co.*, 112 U. S. 639, 1884.

⁴⁴ *Schillinger v. Gunther*, 17 Blatch. 69, 1879.

patent,⁴⁵ even though an appeal has been had;⁴⁶ but the plaintiff, even if he prevails in the suit, can recover no costs.⁴⁷ The filing of a disclaimer at that stage of affairs does not affect the pending action; except so far as it may bear upon the question whether or not there was unreasonable delay before filing it.⁴⁸ That question is an open one until decided on its merits, regardless of whether the disclaimer was filed before or after the bringing of the suit.⁴⁹ The sooner a necessary disclaimer is filed, the less danger exists that the preceding delay will be held unreasonable. For that reason, and for that reason alone, it is sometimes wiser to file a disclaimer pending a suit than to wait till the case is heard, or still longer, till it is decided.

§ 209. An important question arises when a District Court, before any disclaimer has been filed, decides that a part of the claims of the patent in suit are valid, and have been infringed by the defendant, while another part are void for want of novelty, or for want of invention, and ought therefore to be disclaimed. Ought the judge in such a case, to enter a decree for an injunction and an account on the valid claims, and allow the complainant to disclaim the others or not, as he deems most prudent; or should he decline to enter any decree till the complainant shall have filed a disclaimer? The second of these courses has been the practice in the first circuit,⁵⁰ in

⁴⁵ *Filley v. Stove Co.*, 30 F. R. 434, 1887; *Simplex R'y Appliance Co. v. Pressed Steel Car Co.*, 189 F. R. 70, 1911.

⁴⁶ *Sample v. Am. Soda Fountain Co.*, 134 F. R. 402, 1905.

⁴⁷ *Smith v. Nichols*, 21 Wallace, 117, 1874; *Suddard v. American Motor Co.* (in which the subject

is discussed at length), 163 F. R. 852, 1908.

⁴⁸ Revised Statutes, Section 4917; *Sessions v. Romadka*, 145 U. S. 41, 1892; *Tuck v. Bramhill*, 6 Blatch. 95, 1868.

⁴⁹ *Reed v. Cutter*, 1 Story, 590, 1841.

⁵⁰ *Suddard v. American Motor Co.*, 163 F. R. 852, 1908.

the sixth,⁵¹ and, prior to the decision of *Page Machine Co. v. Dow, Jones & Co.*,⁵² in the second circuit; ⁵³ prior to the *Page Machine Co.* case one of the judges in the second circuit criticised that practice as arbitrary and unjust,⁵⁴ and in at least one case in the sixth circuit the practice has not been followed by the Circuit Court, the reason being given that such a requirement would deprive the complainant of the benefit of an appeal from the decree in so far as it held the disclaimed claim invalid.⁵⁵ The same reason is stated in the *Page Machine Co.* case. And one of the Judges of the third circuit has held the first course to be the proper practice.⁵⁶

⁵¹ *Odell v. Stout*, 22 F. R. 169, 1884; *Herman v. Youngstown Car Mfg. Co.*, 191 F. R. 579, 1911; *F. D. Cummer & Son Co. v. Atlas Dryer Co.*, 193 F. R. 993, 1912; *Houser v. Starr*, 203 F. R. 264, 1913.

⁵² *Page Machine Co. v. Dow, Jones & Co.*, 168 F. R. 703, 1909.

⁵³ *Myers v. Frame*, 8 Blatch. 446, 1871; *Burdett v. Estey*, 15 Blatch. 349, 1878; *Christman v. Rumsey*, 17 Blatch. 148, 1879; *Tyler v. Galloway*, 12 F. R. 567, 1882; *Brainard v. Cramme*, 12 F. R. 621, 1882; *Matthews v.*

Spangenberg, 14 F. R. 350, 1882; *Hake v. Brown*, 37 F. R. 783, 1889; *Union Paper Bag Mach. Co. v. Waterbury*, 39 F. R. 392, 1889; *Steam Gauge & Lantern Co. v. Kennedy*, 41 F. R. 39, 1889; *Smead v. School District*, 44 F. R. 617, 1890.

⁵⁴ *Brush Electric Co. v. Accumulator Co.*, 47 F. R. 56, 1891; *Ballard v. McCluskey*, 58 F. R. 884, 1893.

⁵⁵ *Plecker v. Poorman*, 147 F. R. 528, 1905.

⁵⁶ *Williams v. McNeely*, 64 F. R. 768, 1894.

CHAPTER IX

REISSUES

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230. Surrender of patent.
231. Effect of surrender with, and also without, reissue.
232. Reissues of reissued patents and of extended patents, but not of expired patents, are proper.
233. Same invention.
239. "Where there is neither model nor drawing."
240. New matter.
242. Reissues must be for same invention as prior reissues, and also for same invention as originals.
243. Legal presumption of sameness of invention.
244. Omission, as it affects sameness of invention.
245. Reissues for sub-combinations.
246. Reissues for single devices.

247. Reissues as affected by substitution of equivalents.
248. Reissues entitled to a liberal construction.
249. Reissued patents may be valid as to some claims while void to as others.
250. Executors, administrators, and assigns may procure reissues.
251. One of several executors may procure a reissue.
252. Rights of assignees in reissues.
253. The rights of grantees in reissues.
254. The legal effect of reissued patents.

§ 210. IN 1821 James Grant, of Providence, Rhode Island, received letters patent of the United States for an improved mode of manufacturing hat bodies. In 1825 he presented a petition to Henry Clay, Secretary of State, stating that the specification of his patent was defective, and praying that his patent might be canceled, and a new and correct one granted, embracing the same improvements, so far as they were set forth in certain new specifications, drawings and explanations which accompanied the petition. Though there was, at that time, no statute which authorized any such proceeding, yet, on the advice of William Wirt, the Attorney General, and in the name of John Quincy Adams, the President of the United States, Mr. Clay canceled the letters patent of Mr. Grant, and thereupon issued to him new letters patent, for the same invention, and for the residue of the term covered by the original document. Annexed to the new letters, and forming part thereof, were the new specifications, drawings and explanations,¹ which had accompanied Mr. Grant's petition.

In the case of *Grant v. Raymond*,¹ the validity of this proceeding was called in question in the Supreme Court, and was argued in the negative by Daniel Webster. The

¹ *Grant v. Raymond*, 6 Peters, 243, 1832.

Supreme Court sustained the validity of the reissued patent, on the general spirit and object of the patent law, not on its letter. In delivering the opinion Chief Justice MARSHALL said: "If the mistake should be committed in the Department of State, no one would say that it ought not to be corrected. All would admit that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet the Act does not in terms authorize a new patent, even in that case. Its emanation is not founded on the words of the law, but it is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken for the same purpose, if the mistake has innocently been committed by the inventor himself?" And his Honor further said: "If, by an innocent mistake, the instrument introduced to secure his privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery without paying the stipulated consideration. The attempt would be disreputable in an individual, and a Court of Equity might interpose to restrain him."

In pursuance of the doctrines of the first four sentences quoted above from Chief Justice MARSHALL, the Commissioner may cancel a patent and issue a corrected one in its stead, where the first one was caused, by an inadvertent error in the Patent Office, to grant less to the inventor than he had applied for and was entitled to receive, and where the inventor refuses to accept the patent thus limited.²

And it was in accordance with the same doctrine, that the Commissioner of Patents once reissued a patent to correct an error in its drawing, without making any

² Railway Register Mfg. Co. v. Railroad Co., 23 F. R. 593, 1885.

change in specification; ³ for the reissue in that case was not provided for by the statute.⁴

§ 211. In accordance with the spirit of the decision in *Grant v. Raymond*, and within a few months after that decision was made, Congress enacted a statute to regulate the granting of reissued letters patent.⁵ That statute provided, in effect, that whenever any patent should be invalid or inoperative, because the inventor, by inadvertence, accident or mistake, and without any fraudulent or deceptive intention, failed to conform his specification to the then existing statutory requirements; it should be lawful for the Secretary of State, upon the surrender to him of such patent, and the delivery to him of a sufficient statutory specification, to cause a new patent to be granted to the same inventor, for the same invention, and for the residue of the term of the original patent. That statute also provided that the right to receive a reissue, should extend to executors, administrators or assigns; and that the reissue patent should be liable to the same defences as the original; and that no public use of the invention, after the grant of the original patent, should prejudice the right of the patentee to recover for infringement of the reissue patent, committed after the grant thereof.

§ 212. The Patent Act of 1836⁶ repealed all prior statutes relevant to patents, and provided a more elaborate system in place of the repealed laws. Section 13 of that Act referred to reissues, and provided, in effect, that whenever any patent should be inoperative or invalid because the inventor had, by inadvertence, accident, or mistake, and without any fraudulent or deceptive inten-

³ *Hobbs v. Beach*, 180 U. S. 394, 1901.

⁴ Revised Statutes, Section 4916.

⁵ 4 Statutes at Large, Ch. 162, Section 3, p. 559.

⁶ 5 Statutes at Large, Ch. 357, p. 117.

tion, made his description or specification defective or insufficient, or had claimed in his specification more than he had a right to claim as new; it should be lawful for the Commissioner of Patents, upon the surrender to him of such patent, to cause a new patent to be issued to the same inventor, for the same invention, in accordance with the inventor's corrected description and specification, and for the residue of the term of the original patent. This statute also provided that the right to receive a reissue should extend to executors, administrators and assigns, and that the reissued patent, together with the corrected description and specification, should have the same effect in law, on the trial of all actions thereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form before the issuing of the original patent.

§ 213. The Patent Act of 1837 ⁷ made some additions to the statute of 1836, relevant to reissues. Section 5 recognized a right in a patentee to demand and receive several reissued patents for distinct parts of the subject-matter of his surrendered patent. And Section 8 provided, that whenever a patent should be returned for reissue, the claims thereof should be subject to revision and restriction, in the same manner as were original applications for patents; and that the Commissioner should not grant any reissue, until the applicant should have entered a disclaimer, or altered his claim, in accordance with the decision of the Commissioner; and that the applicant, if dissatisfied with such decision, should have the same remedy by way of appeal, that the law provided in cases of original applications.

§ 214. The Patent Act of 1870 ⁸ substantially re-enacted

⁷ 5 Statutes at Large, Ch. 45,
p. 191.

⁸ 16 Statutes at Large, Ch. 230,
p. 198.

the law of reissues as it had been embodied, for more than thirty years, in the statutes of 1836 and 1837, but re-enacted that law with a few modifications and additions. Where the old law used the phrase "defective or insufficient description or specification," the new law used the words "defective or insufficient specification." Where the old statute made it lawful for the Commissioner to reissue a patent, the new statute made it obligatory upon him to do so. Where the old law recognized a right in a patentee to demand and receive several reissue patents in the place of one surrendered patent, the new law provided that the Commissioner might, in his discretion, cause several such patents to be issued upon the demand of the applicant. The provision of the old statute, that the applicant, if dissatisfied with the decision of the Commissioner, should have the same remedy and be entitled to the same privileges and proceedings, as were provided by law in the case of original applications for patents, was omitted in the new statute; but its effect was retained, by expressly mentioning reissues in those sections of the new statute, which provided for that remedy, and for those privileges and proceedings.⁹ Section 33 of the new statute provided further, that where a patent was to be reissued to an assignee of the inventor, the application should be made, and the specification be sworn to, by the inventor, if he be living. The Patent Act of March 3, 1871,¹⁰ prescribed that the provision of Section 33, just mentioned, should not be construed to apply to any patent, issued and assigned before July 8, 1870; the date of the approval of the Act of which that section formed a part. Another new provision of the statute of 1870, was

⁹ 16 Statutes at Large, Ch. 230, Sections 46 to 52, p. 204; *Ingersoll v. Holt*, 104 F. R. 682, 1900.

¹⁰ 16 Statutes at Large, Ch. 132, p. 583.

as follows: "No new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except by each other; but where there is neither model nor drawing, amendments may be made upon proof, satisfactory to the Commissioner, that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid."¹¹

§ 215. Section 4916 of the Revised Statutes is substantially a copy of Section 53 of the Statute of 1870. Section 4895 of the Revised Statutes, re-enacted the provision above cited from Section 33 of the Act of 1870, coupled with the statutory construction of that provision, which was contained in the Patent Act of 1871, and which was above explained. Sections 46 to 52 of the Act of 1870, were re-enacted as Sections 4909 to 4915 of the Revised Statutes. Thus the law of reissues underwent no change when the Revised Statutes were approved. The reissue provisions which were embodied in the Act of 1870, are still the statutes which govern the subject.

The meritorious ground for reissues, as stated by the Supreme Court in *Grant v. Raymond*, has now been set forth; and the subsequently enacted and gradually developed statutory law on the subject has been explained. To explore the great mass of relevant adjudicated cases, and to extract from those cases the detailed doctrines of the law of reissues, is the engaging work upon which it is now in order to enter.

§ 216. To be the subject of a reissue under the statutory law, a patent must be invalid, or it must be at least inoperative.¹² All patents that are invalid, are also in-

¹¹ 16 Statutes at Large, Ch. 132, Section 53, p. 206.

¹² Act of 1832, Section 3; Act of 1836, Section 13; Act of 1870, Sec-

operative. If the two words had, in the statutes, been always connected with the word "and," there would be ground for an argument that they were used synonymously. In fact, however, they have always been connected with the word "or," thus indicating that they were not intended to signify the same thing. What they do respectively mean is to be ascertained by considering other provisions of the statute; namely, those provisions which indicate the causes from which either invalidity or inoperativeness must have sprung, in order to make patents reissuable. To have that effect, either of those faults must have resulted from a defective or insufficient specification, or from the patentee claiming more than he had a right to claim as new. This last cause of fault was first mentioned in the statute of 1836. In the following year Congress provided that patents should no longer be held to be invalid on that ground, provided proper disclaimers were reasonably entered.¹³ Ever since 1837, therefore, faults in patents, arising from patentees claiming more than they had a right to claim, have generally been curable by disclaimers.¹⁴

§ 216*a*. But in some cases, the matter in a patent, which the patentee had no right to claim as new, is so blended with the other matter in the patent, that it cannot be simply cut away by a disclaimer, and can best be removed by rewriting part or all of the specification, and a narrow reissue obtained. In such cases the remedy by reissue is undoubtedly lawful, but it cannot be invoked after an excessively unreasonable delay to invoke it;¹⁵ though

tion 53; Revised Statutes, Section 4916.

¹³ 5 Statutes at Large, Ch. 45, Sections 7 and 9, p. 193.

¹⁴ Certain distinctions between reissues and disclaimers are

brought out in the case of Motion Picture Patents Co. *v.* Laemmle, 214 F. R. 787, 1914.

¹⁵ *Pelzer v. Meyberg*, 97 F. R. 969, 1899.

the strict two-year rule of *Miller v. Brass Co.*, hereinafter discussed in connection with broadened reissues, does not apply,¹⁶ and such delay will not be held to begin till the patentee is informed of the facts which make a narrower claim necessary.¹⁷ The remedy by disclaimer, where it can be applied, is better than the other, because the remedy by reissue involves the loss of the rights of action under the patent, for infringements committed before the reissue is granted.

§ 217. The meaning of the word "specification" is that of the words "description and claim" when it is used, in the statutes, separately from both those words.¹⁸ In the reissue section of the Statute of 1836, the word "description" was used in connection with the word "specification," and thus limited the meaning of the latter to the signification of the word "claim."¹⁹ On the other hand, in the fourth sentence of Section 4916 of the Revised Statutes the word "specification" is used in immediate connection with the word "claim," and is therefore limited, in that place, to the meaning of the word "description."

The word "defective" and the word "insufficient" are not synonymous in this statute, as at first thought they may appear to be. The former word means "bad," and

¹⁶ *Conroy v. Penn Electrical & Mfg. Co.*, 173 F. R. 299, 1909; *Sirocco Engineering Co. v. B. F. Sturtevant Co.*, 173 F. R. 378, 1909; *Specialty Machine Co. v. Ashcroft Mfg. Co.*, 213 F. R. 35, 1914.

¹⁷ *Matthews v. Flower*, 25 F. R. 834, 1885; *Electrical Accumulator Co. v. New York & Harlem R. R. Co.*, 50 F. R. 82, 1892; *Steiner &*

Voegtly Hardware Co. v. Tabor Sash Co., 178 F. R. 831, 1910. See *Autopiano Co. v. American Player Action Co.*, 222 F. R. 276, 1915.

¹⁸ *Wilson v. Coon*, 18 Blatch. 535, 1880; *M'Dowell v. Ideal Concrete Machine Co.*, 187 F. R. 814, 1911.

¹⁹ *Wilson v. Coon*, 18 Blatch. 536, 1880.

the latter means "lacking." A description may be complete, while it is obscure in some of its parts. In such a case, it is defective. On the other hand, it may be perfectly clear, as far as it goes, while omitting all references to some parts of the thing described. In such a case it is insufficient. So also, a claim may mistily cover the whole invention described, but being liable to be misunderstood, it is defective. On the other hand, it may be entirely clear, while it is narrower than the invention, and therefore insufficient to cover and secure the latter.

§ 218. From the foregoing it follows that, ever since 1836, those patents which were invalid or inoperative by reason of defective or insufficient descriptions or claims, have been reissuable under the statutes; provided their faults arose from inadvertence, accident or mistake, and without any fraudulent or deceptive intention. This proviso is equally imperative in all cases.²⁰ Assuming it to be satisfied in all, and passing the provisions relevant to reissues when the patentee has claimed too much, it appears that the remaining faults which make patents reissuable, under the statutes, are four in number: 1. Invalidity arising from defective description. 2. Invalidity arising from insufficient description. 3. Invalidity arising from defective claims. 4. Inoperativeness arising from insufficient claims.

§ 218*a*. Invalidity arising from defective description, or from insufficient description, or from defective claims, where that invalidity arose by inadvertence, accident or mistake, and without any fraudulent or deceptive intention, may undoubtedly be remedied by a reissue, where the reissue does not add nor broaden any claim.²¹ No

²⁰ *Coon v. Wilson*, 113 U. S. 277, 1884; *Parker & Whipple Co. v. Yale Clock Co.*, 123 U. S. 103, 1887.

²¹ *Hart & Hegeman Mfg. Co. v. Anchor Electric Co.*, 92 F. R. 658, 1899.

reissue of this class has ever been held to be void, as a reissue, in any adjudicated case. Such reissues are indeed particularly consistent with the policy of the patent law, because they improve the information of an invention, which the public can derive from a patent, and thus increase the benefit which the public will enjoy on account of the patent after it shall have expired. There appears to be no reason why the remedy of reissue may not be invoked, in a case of this class, at any time during the life of a patent.²²

§ 219. Claims are the only operative parts of specifications. If an inventor has produced two or more inventions so allied that they may properly be secured to him in one letters patent, and if he fully describes all of those inventions in the descriptive part of his specification, but covers only one of them by his claims, then his patent is operative as to one of those inventions, and inoperative as to the others. Inoperativeness of that kind is sufficient to lay the foundation of a right to a reissue.²³ And where an inventor claims his invention only in combination with something else, his patent is inoperative as to that invention alone.²⁴ Reissues granted in these classes of cases are called broadened reissues. Though the statute does not, under that name, authorize reissues of that kind, they are authorized by the general terms of the law;²⁵ and have been upheld by the Supreme Court in many

²² *Sewing Machine Co. v. Frame*, 24 F. R. 596, 1884.

²³ *Thompson v. Wooster*, 114 U. S. 115, 1884; *Anilin v. Higgin*, 15 Blatch. 291, 1878; *Wilson v. Coon*, 18 Blatch. 535, 1880; *Giant Powder Co. v. Nitro Powder Co.*, 19 F. R. 510, 1884; *Fay v. Mason*, 120 F. R. 510, 1903.

²⁴ *Jenkins v. Stetson*, 32 F. R. 400, 1887; *Universal Caster & Foundry Co. v. M. B. Schenck Co.*, 165 F. R. 344, 1908.

²⁵ *Miller v. Brass Co.*, 104 U. S. 354, 1881; *A. D. Howe Machine Co. v. Coffield Motor Washer Co.*, 197 F. R. 541, 1912.

cases;²⁶ and have been expressly approved by that tribunal.²⁷

§ 220. Inadvertence, accident or mistake, must have been the source of the fault in letters patent, in order to make them reissuable under the statute.²⁸ Such inadvertence or accident may have been suffered, or such mistake may have been committed, by the patentee or by the Commissioner of Patents.²⁹ The statute is satisfied on this point, where the patent was inoperative by reason of insufficient claims, if those claims were made too few or too narrow because the patentee was mistaken about the state of the art,³⁰ or because the patentee or his solicitor, when concerting the claims, inadvertently failed to make them as extensive as the invention.³¹ So also, the statute is satisfied, where the patent was inoperative by reason of insufficient claims, if those claims were made too narrow because the Commissioner, on account of an erroneous opinion entertained by him, refused to allow them to be made as broad as they ought to have been,³² or because of an erroneous decision made by him in an interference

²⁶ *Battin v. Taggert*, 17 Howard, 74, 1854; *Morey v. Lockwood*, 8 Wallace, 230, 1868; *Rubber Co. v. Goodyear*, 9 Wallace, 788, 1869; *Corn-Planter Patent*, 23 Wallace, 217, 1874; *Marsh v. Seymour*, 97 U. S. 356, 1877.

²⁷ *Topliff v. Topliff*, 145 U. S. 170, 1892.

²⁸ Revised Statutes, Section 4916; *Fay v. Mason*, 120 F. R. 510, 1903; *Stafford Co. v. Coldwell-Gildard Co.*, 202 F. R. 744, 1913.

²⁹ *Grant v. Raymond*, 6 Peters, 218, 1832.

³⁰ *National Spring Co. v. Mfg. Co.*, 12 Blatch. 89, 1874; *Bowers v. San Francisco Bridge Co.*, 69 F. R. 644, 1895; *Dunbar v. Eastern Elevating Co.*, 75 F. R. 570, 1896; *Autopiano Co. v. American Player Action Co.*, 222 F. R. 276, 1915.

³¹ *Miller v. Brass Co.*, 104 U. S. 352, 1881. In connection with the subject-matter of this section see *M'Dowell v. Ideal Concrete Machine Co.*, 187 F. R. 814, 1911.

³² *Morey v. Lockwood*, 8 Wallace, 230, 1868.

proceeding.³³ But the statute is not satisfied where the applicant or his attorney cancels a rejected claim and afterward seeks to reclaim it by a reissue;³⁴ or to make a new claim which, though narrower than the rejected claim, is broader in the same direction than the claim in the patent;³⁵ even where the rejected claim was canceled from a prior application of the same inventor, and not from the particular application for the original of the reissue.³⁶ Nor is the statute satisfied in any case where the new claims of the reissue were intentionally omitted from the original patent,³⁷ or where a disclaimer is sought to be narrowed by means of a reissue,³⁸ nor where the claim was merely for the function of a machine to do what had previously been done by hand.³⁹

§ 221. Many courts have recognized the fact that patents have been reissued by the Commissioner of Patents in some cases where there was no statutory ground therefor; that is to say, in some cases where the patents surrendered were neither invalid nor inoperative; or if invalid or inoperative, were not so by reason of a defective or insufficient specification; or if invalid or inoperative by reason of a defective or insufficient specification, were not so because of inadvertence, accident, or mistake. It is,

³³ *American Shoe-tip Co. v. Protector Co.*, 2 Bann. & Ard. 551, 1877.

³⁴ *Union Paper Bag Mach. Co. v. Waterbury*, 39 F. R. 392, 1889; *Moneyweight Scale Co. v. Toledo Computing Scale Co.*, 187 F. R. 826, 1911; *Grand Rapids Show Case Co. v. Baker*, 216 F. R. 341, 1914.

³⁵ *Denton v. Commissioner of Patents*, 83 O. G. 1347, 1898.

³⁶ *Yale Lock Co. v. Berkshire Bank*, 135 U. S. 379, 1890.

³⁷ *Dobson v. Lees*, 137 U. S. 265, 1890.

³⁸ *Westinghouse Electric & Mfg. Co. v. Stanley Electric Mfg. Co.*, 115 F. R. 810, 1902; *Franklin & Co. v. Illinois Moulding Co.*, 128 F. R. 48, 1904.

³⁹ *Penn Electrical Mfg. Co. v. Conroy*, 185 F. R. 511, 1911.

however, still an unsettled question, whether the decision of the Commissioner, that the existence of the statutory ground for a reissue exists when he grants a reissue, is conclusive; or is a subject of review and possible reversal in a suit for infringement of a reissue. It has been held in so far as the findings of the commissioner are based on disputed questions of fact they are not reviewable, "but in so far as they depend upon the legal interpretation and effect of admittedly genuine documents or other undisputed evidence, they are reviewable in court."⁴⁰ Another court states that it is proper to review the decision of the Patent Office as to matters apparent from the record,⁴¹ which includes the question of sameness of invention if it so appears.⁴² In the first two editions of this book, the then existing deliverances of the courts upon this subject, were marshalled and explained on the sides of the question which they respectively support; because in the years of those editions, the question was one of practical importance. But the decision of the Supreme Court in *Miller v. Brass Co.*, which was made early in 1882, on another part of the law of reissues, operated so strongly to discourage patentees from surrendering their original patents and applying for reissues thereof, that only forty-two hundred reissues have been granted during the thirty-five years which have passed since then; though nearly one million original patents have been issued during that time. And the few hundred reissues which have not now expired, were granted with more circumspection than was formerly exercised in the Patent Office, in such

⁴⁰ *General Electric Co. v. Richmond Street & Ry. Co.*, 178 F. R. 84, 1909.

⁴¹ *Grand Rapids Show Case Co. v. Baker*, 216 F. R. 341, 1914;

Wayne Mfg. Co. v. Coffield Motor Washer Co., 227 F. R. 987, 1915.

⁴² *Wayne Mfg. Co. v. Coffield Motor Washer Co.*, 227 F. R. 987, 1915.

cases; so that the question whether the courts have any authority to review the decision of the Commissioner of Patents, that some statutory ground exists therefor, when he grants a reissue, is a question of much diminished import. If any lawyers have occasion to argue, or any judges have occasion to decide, that question hereafter, they may consult the principal cases which support the negative,⁴³ and the principal cases which support the affirmative of the issue.⁴⁴

⁴³ Philadelphia & Trenton Railroad Co. *v.* Stimpson, 14 Peters, 448, 1840; Stimpson *v.* Railroad Co., 4 Howard, 404, 1846; Seymour *v.* Osborne, 11 Wallace, 516, 1870; Collar Co. *v.* Van Dusen, 23 Wallace, 558, 1874; Ball *v.* Langles, 102 U. S. 129, 1880; Topliff *v.* Topliff, 145 U. S. 171, 1892; Smith *v.* Merriam, 6 F. R. 713, 1881; Selden *v.* Gas Burner Co., 9 F. R. 390, 1881; Peoria Target Co. *v.* Cleveland Target Co., 58 F. R. 239, 1893; Beach *v.* American Box Machine Co., 63 F. R. 603, 1894; American Sulphite Pulp Co. *v.* Howland Falls Pulp Co., 70 F. R. 991, 1895; Beach *v.* Hobbs, 82 F. R. 925, 1897; Justi *v.* Clark, 108 F. R. 667, 1901; Asbestos Shingle, etc., Co. *v.* H. W. Johns-Manville Co., 184 F. R. 620, 1910; John Kitchen, Jr., Co. *v.* Levison, 188 F. R. 658, 1911.

⁴⁴ Burr *v.* Duryce, 1 Wallace, 571, 1863; Rubber Co. *v.* Goodyear, 9 Wallace, 795, 1869; James *v.* Campbell, 104 U. S. 371, 1881;

Mahn *v.* Harwood, 112 U. S. 359, 1884; Coon *v.* Wilson, 113 U. S. 277, 1884; Yale Lock Co. *v.* Berkshire Bank, 135 U. S. 378, 1890; Dobson *v.* Lees, 137 U. S. 265, 1890; Electric Gas Co. *v.* Boston Electric Co., 139 U. S. 502, 1891; Huber *v.* Nelson Mfg. Co., 148 U. S. 290, 1893; Olin *v.* Timken, 155 U. S. 148, 1894; Eby *v.* King, 158 U. S. 371, 1895; Whitely *v.* Swayne, 4 Fisher, 123, 1865; Wicks *v.* Stevens, 2 Bann. & Ard. 318, 1876; Odell *v.* Stout, 22 F. R. 161, 1885; Peoria Target Co. *v.* Cleveland Target Co., 47 F. R. 737, 1891; Featherstone *v.* Cycle Co., 57 F. R. 635, 1893; Idealite Co. *v.* Protection Light Co., 103 F. R. 973, 1900; Westinghouse Electric & Mfg. Co. *v.* Stanley Electric Mfg. Co., 115 F. R. 810, 1902; S. Franklin & Co. *v.* Illinois Moulding Co., 138 F. R. 58, 1905; McDowell *v.* Ideal Concrete Machine Co., 187 F. R. 814, 1911; Moneyweight Scale Co. *v.* Toledo Computing Scale Co., 187 F. R. 826, 1911.

§ 226. *Miller v. Brass Co.*⁴⁵ is a celebrated case, which introduced a new doctrine into the patent laws of the United States. That doctrine is precisely this. The right to obtain a broadened reissue, is lost by a lapse of some time, after the date of the original, and before the application for that reissue. If that doctrine has any prototype in any prior deliverance of any United States judge, that prototype must be found in a charge which Chief Justice TANEY delivered to a jury somewhat early in his judicial career.⁴⁶ In that case, the third paragraph of his Honor's instruction was as follows: "The plaintiff, at the time of his application for the patent of 1834, had a right to surrender the patent of 1829, and take out a corrected one, if the said patent was invalid, either by reason of the defective description of the improvement, or by reason of his having claimed as new, more than he was entitled to; provided, the error had arisen from inadvertence or mistake, and the plaintiff proceeded to correct it within a reasonable time after it was discovered." The last proviso of this instruction differs from the doctrine of *Miller v. Brass Co.*, in that the latter makes the fatal lapse of time to begin at the date of the original patent, whereas the former makes it begin when the fault of the original patent is discovered. This difference is a substantial one; because reissuable faults in letters patent are often, and perhaps generally, of such a character that they can be detected only by persons learned in the patent law; and because a patentee may honestly keep his patent by him for years, without subjecting it to professional scrutiny. The doctrine of *Miller v. Brass Co.* must therefore find its foundation and genesis elsewhere than in the

⁴⁵ *Miller v. Brass Co.*, 104 U. S. 350, 1882.

⁴⁶ *Knight v. Railroad Co.*, Taney's Circuit Court Decisions, 107, 1840.

opinion of Chief Justice TANEY; and elsewhere than in any United States decision made and reported before that doctrine was promulgated in that case in January, 1882.

But that doctrine has been emphatically reaffirmed by the Supreme Court in the use of the following language: "We deem it proper to say, once for all, that the views announced in *Miller v. Brass Co.*, on the subject of reissuing patents for the purpose of extending and enlarging the claim, were deliberately expressed and are still adhered to."⁴⁷

The Supreme Court has also decided and announced that the rule in *Miller v. Brass Co.* is not qualified by any question relevant to the presence or absence of intervening rights of other inventors, accruing between the date of the original patent, and the date of the application for a reissue thereof;⁴⁸ for "it is not alone those persons who are shown to have taken action upon the faith that the patent defines the character of the invention who may raise the objection to a change in its claims which makes it cover other ground than that claimed before."⁴⁸ And that court has also held that the operation of the rule is not ousted by the fact that the invention sought to be covered by a broadened reissue, had, during the preceding life of the original patent, been apparently, though erroneously, secured to the same patentee, in another patent.⁴⁹

§ 227. The length to which delay must be drawn out, in order to lose the right to apply for a broadened reissue, cannot be fixed and laid down for all cases. Where the specification is complicated, and the claim is ambiguous

⁴⁷ *Mahn v. Harwood*, 112 U. S. 358, 1884.

⁴⁸ *White v. Dunbar*, 119 U. S. 52, 1886.

⁴⁹ *Milloy Electric Co. v.*

Thomson-Houston Electric Co., 148 F. R. 843, 1906.

⁴⁹ *Hartshorn v. Barrel Co.*, 119 U. S. 674, 1886.

or involved, the patentee may be entitled to greater indulgence than he would be if the case were simpler or clearer; and the courts will always exercise a proper liberality on this point in favor of patentees.⁵⁰ In *Miller v. Brass Co.* itself, the delay continued for fifteen years. In three later Supreme Court cases, the delay was for fifteen, fourteen, and thirteen years, respectively.⁵¹ In still later Supreme Court cases much shorter delays have been held to be fatal to broadened reissues;⁵² and indeed, in one simple case where adverse rights had intervened, a delay of ninety-seven days was decided to have a fatal effect on such a reissue.⁵³ The general rule is that a delay for two years or more invalidates a broadened reissue, unless that delay is accounted for and excused by special circumstances.⁵⁴ What special circumstances will have that effect, cannot now be stated, because none such have yet been found by the Supreme Court to have that operation, and because one case in which a Circuit Court sustained so late a broadened reissue,⁵⁵ on account of such circumstances, was disapproved in the Supreme Court.⁵⁶ In a later case a delay of nearly three years was excused; because the inventor was in poor health, and at times mentally deranged, and once wholly insane, during the delay.⁵⁷

⁵⁰ *Mahn v. Harwood*, 112 U. S. 361, 1884.

⁵¹ *Johnson v. Railroad Co.*, 105 U. S. 539, 1881; *Mathews v. Machine Co.*, 105 U. S. 54, 1881; *Bantz v. Frantz*, 105 U. S. 160, 1881.

⁵² *Leggett v. Standard Oil Co.*, 149 U. S. 292, 1893; *Dunham v. Dennison Mfg. Co.*, 154 U. S. 110, 1894.

⁵³ *Coon v. Wilson*, 113 U. S. 277, 1884.

⁵⁴ *Wollensak v. Reiher*, 115 U. S. 101, 1884; *Hoskin v. Fisher*, 125 U. S. 222, 1887; *Topliff v. Topliff*, 145 U. S. 171, 1892; *Franklin & Co. v. Illinois Moulding Co.*, 128 F. R. 48, 1904.

⁵⁵ *Hartshorn v. Roller Co.*, 18 F. R. 92, 1883.

⁵⁶ *Hartshorn v. Barrel Co.*, 119 U. S. 674, 1886.

⁵⁷ *Whitcomb v. Coal Co.*, 47 F. R. 658, 1891.

But the reception of erroneous advice from a solicitor of patents, not to apply for a particular reissue, is no excuse for waiting a long time, and then doing so.⁵⁸ A delay of less than two years is enough to defeat a broadened reissue in a plain case, even in the absence of intervening rights;⁵⁹ and in such a case, six months is probably as long a delay as can be excused,⁶⁰ though seven months' delay was excused in one peculiar case.⁶¹

A decision even on an appeal from an order granting or denying a preliminary injunction to the effect that two patents are for the same invention and that there is therefore a case of double patenting makes it urgent on the later patentee to take immediate steps to procure a reissue.⁶²

§ 229. The statutory provision which makes a patent void, if the invention it covers was in public use or on sale more than two years before that patent was applied for, is a matter which does not apply to reissue patents, and the applications therefor.⁶³ The reissue application is considered as appended to the original application,⁶⁴ and the two years cease to run with the filing of the latter.

§ 230. A surrender of a patent, when made with an application for a reissue, need not be made in writing; and therefore the statement in a reissue that it is a reissue of a

⁵⁸ *Wollensak v. Sargent*, 151 U. S. 227, 1894.

⁵⁹ *Farmers' Mfg. Co. v. Corn-Planter Co.*, 128 U. S. 506, 1888; *New v. Warren*, 22 O. G. 588, 1882; *Haines v. Peck*, 26 F. R. 625, 1884; *Union Paper Bag Machine Co. v. Waterbury*, 39 F. R. 391, 1891.

⁶⁰ *McArthur v. Supply Co.*, 19 F. R. 263, 1884.

⁶¹ *Crown Cork & Seal Co. v. Aluminum Stopper Co.*, 108 F. R. 852, 1901.

⁶² *Thomson-Houston Electric Co. v. Western Electric Co.*, 158 F. R. 813, 1907.

⁶³ *Shaw v. Lead Co.*, 11 F. R. 714, 1882.

⁶⁴ *Grant v. Raymond*, 6 Peters, 218, 1832.

surrendered former reissue, is not negatived by the production of a document purporting to be a surrender of the original patent, and apparently intended to have been a surrender of the former reissue.⁶⁵ The presumption that the proper patent was surrendered, by parol if not otherwise, is not negatived by proof of an ineffectual attempt to surrender it in writing.

§ 231. Patents surrendered prior to July 8, 1870, were thereby canceled in law, whether a reissue was granted thereon or not.⁶⁶ Patents surrendered since July 8, 1870, were also canceled thereby if reissues were granted thereon, but not otherwise.⁶⁷ But a surrendered patent cannot be enforced while the application for a reissue is pending.⁶⁸ After an application for a reissue has been rejected or withdrawn, the original patent stands unaffected by anything that occurred in the Patent Office while the application for the reissue was pending there.⁶⁹

No damages or profits can ordinarily be recovered, for any infringement of a surrendered patent committed prior to its cancellation, by means of any judgment or decree entered after that time; but money recovered or voluntarily paid, on account of such infringement, prior to such cancellation, cannot be recovered back.⁷⁰ Nor will any such cancellation have any effect upon any unpaid judgment or decree which was entered before that cancellation took effect. The right of the patentee, in such

⁶⁵ *Dental Vulcanite Co. v. Wetherbee*, 2 Cliff. 563, 1866.

⁶⁶ *Moffitt v. Garr*, 1 Black, 273, 1861; *Peck v. Collins*, 103 U. S. 664, 1880.

⁶⁷ 16 Statutes at Large, Ch. 132, Section 53, p. 206; Revised Statutes, Section 4916; *Allen v. Culp*, 166 U. S. 505, 1897.

⁶⁸ *Burrell v. Hackley*, 35 F. R. 833, 1888; *Coffield v. Fletcher Mfg. Co.*, 167 F. R. 321, 1909.

⁶⁹ *McCormick Machine Co. v. Aultman*, 169 U. S. 606, 1898.

⁷⁰ *Moffitt v. Garr*, 1 Black, 273, 1861; *Eby v. King*, 158 U. S. 373, 1895.

a case, rests upon his judgment or decree, and not on his patent.⁷¹

The only exception yet established, to what the last paragraph states is the ordinary rule relevant to profits and damages which accrued from the infringement of a surrendered patent before its cancellation, was established in a case where the defendant infringer was himself the patentee, and where the plaintiffs were his equitable grantees, as to that part of the territory of the United States, included within the boundaries of Connecticut and New York. In that case, the patentee infringed his grantees' rights, and afterward surrendered and reissued the patents involved. The Supreme Court decided that the defendant held his patents, all the time in trust for the plaintiffs, to the extent of their territory; and that he must therefore account to them for the profits which he had made from the use of the trust property, within that territory, regardless of the fact that he had surrendered and reissued those patents, after making a part of those profits.⁷²

§ 232. A reissue patent may be surrendered and again reissued, under the same circumstances as those which make an original patent reissuable,⁷³ and the last reissue may be identical with the original patent.⁷⁴ So also, a patent might be reissued during its extended term, as well as during its first term, when, as formerly, extensions of patents were provided for by law.⁷⁵ No reissue can be

⁷¹ *Mevs v. Conover*, 125 U. S. 144, 1876.

⁷² *Littlefield v. Perry*, 21 Wallace, 205, 1874.

⁷³ *French v. Rogers*, 1 Fisher, 136, 1851; *Selden v. Gas Burner Co.*, 9 F. R. 390, 1881.

⁷⁴ *Giant Powder Co. v. Nitro*

Powder Co., 19 F. R. 510, 1884; *Celluloid Mfg. Co. v. Zylonite Co.*, 27 F. R. 291, 1886; *Sawyer Spindle Co. v. Eureka Spindle Co.*, 33 F. R. 836, 1888.

⁷⁵ *Wilson v. Rousseau*, 4 Howard, 646, 1846; *Gibson v. Harris*, 1 Blatch. 167, 1846.

granted of a patent after its final expiration; even where that expiration resulted from the fact that the same invention had been patented in a foreign country before it was patented in the United States; and from the fact that the foreign patent has expired, though the United States patent sought to be reissued, does not appear, on its face, to have done so.⁷⁶

§ 233. Only "the same invention" can be covered by a reissued patent.⁷⁷ This quoted phrase occurs, in this relation, in all the relevant statutory provisions, now or heretofore in force in the United States. But not any of those statutes obviously indicates whether the phrase refers to whatever invention was made by the patentee, and actually described in his original application; or refers to whatever invention was substantially suggested, indicated or described in the patentee's original letters patent, drawing or model; or refers to whatever invention was described or indicated in the original letters patent or drawing of the patentee; or refers to whatever invention was described by him in his original letters patent; or refers to whatever invention was actually claimed by the inventor in his original patent; or refers to whatever invention was described in the original letters patent, and appears therein to have been intended to be secured thereby. During many years, debate ranged in the courts around these various constructions; and large masses of *obiter dicta* and some actual adjudications can be collected out of the books, in favor of each

⁷⁶ C. W. Simons' Appeal, 11 O. G. 1107, 1877.

⁷⁷ Patent Act of 1832, Section 3; Patent Act of 1836, Section 13; Patent Act of 1870, Section 53; Revised Statutes, Section 4916;

M'Dowell v. Ideal Concrete Machine Co. (discussing question and citing authorities), 187 F. R. 814, 1911; Stafford Co. v. Coldwell-Gildard Co., 202 F. R. 744, 1913.

of them. But the Supreme Court put a period to the controversy in the case of the *Parker & Whipple Co. v. the Yale Clock Co.* decided in 1887.⁷⁸ That decision adopted the last of the above stated constructions, and thus established the meaning of the phrase "the same invention" to be whatever invention was described in the original letters patent, and appears therein to have been intended to be secured thereby. This rule has already been repeatedly reaffirmed and reapplied by the Supreme Court,⁷⁹ and is now as well established as its companion rule in *Miller v. Brass Co.* Therefore no re-issue claim can stand any longer upon a model alone, nor even alone upon a drawing of an original patent;⁸⁰ and indeed neither models, drawings, nor descriptions, nor all of them together, can support a re-issue claim, except where the description in the original letters patent shows that the invention covered by that claim was intended to be secured in the original.⁸¹

§ 239. The last clause of Section 4916 of the Revised Statutes provides, that "where there is neither model nor drawing, amendments may be made upon proof, satisfactory to the Commissioner, that such new matter or amendment was a part of the original invention, and was

⁷⁸ *Parker & Whipple Co. v. Yale Clock Co.*, 123 U. S. 99, 1887.

⁷⁹ *Hoskin v. Fisher*, 125 U. S. 223, 1887; *Flower v. Detroit*, 127 U. S. 571, 1887; *Pattee Plow Co. v. Kingman & Co.*, 129 U. S. 294, 1889; *Freeman v. Asmus*, 145 U. S. 240, 1895; *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U. S. 42, 1893.

⁸⁰ *Hailes v. Stove Co.*, 123 U. S. 587, 1887.

⁸¹ *Carpenter Machine Co. v. Searle*, 52 F. R. 814, 1892; *Idé v. Trorlicht, Duncker & Renard Carpet Co.*, 115 F. R. 147, 1902; *United States Whip Co. v. Hassler*, 134 F. R. 398, 1905; *Weston Electrical, etc., Co. v. Stevens*, 134 F. R. 574, 1904; *Stafford Co. v. Coldwell-Gildard Co.*, 202 F. R. 744, 1913; *Marvel Buckle Co. v. Alma Mfg. Co.*, 180 F. R. 1002, 1910.

omitted from the specification by inadvertence, accident, or mistake." The meaning of that clause is not perfectly known; but it is known not to enlarge the power of the Commissioner, in reference to the invention for which a reissue may be granted.⁸²

§ 240. The provision, first enacted in 1870,⁸³ that "no new matter shall be introduced into the specification" is merely another way of saying that a reissued patent shall be for the same invention as the original.⁸⁴ That provision, therefore, neither enlarged nor restricted the reissuability of letters patent; and, accordingly, it is not new matter, within its meaning, to state a new use of the invention shown in the original;⁸⁵ nor to explain, in a reissue, the operation of a device which in the original was only described;⁸⁶ nor to vary the description of anything described in the original.⁸⁷

§ 242. Reissued patents, which were granted on the surrender of former reissues, must be able to endure comparison, on the point of identity of invention, not only with the original letters patent, but also with the surrendered reissues, which preceded them.⁸⁸

§ 243. There is a legal presumption that the necessary identity of invention exists in all reissued patents; and that presumption controls the point, unless the contrary is shown to be true.⁸⁹ That can be done

⁸² *Powder Co. v. Powder Works*, 98 U. S. 128, 1878.

⁸³ 16 Statutes at Large, Ch. 230, Section 53, p. 206.

⁸⁴ *Powder Co. v. Powder Works*, 98 U. S. 138, 1878.

⁸⁵ *Broadnax v. Transit Co.*, 5 Bann. & Ard. 611, 1880.

⁸⁶ *Putnam v. Yerrington*, 2 Bann. & Ard. 243, 1876; *Potter*

v. Stewart, 18 Blatch. 561, 1881.

⁸⁷ *O'Reilly v. Morse*, 15 Howard, 62, 1853.

⁸⁸ *Knight v. Railroad Co.*, Taney's Circuit Court Decisions, 106, 1840.

⁸⁹ *O'Reilly v. Morse*, 15 Howard, 62, 1853; *Klein v. Russell*, 19 Wallace, 433, 1873.

only by introducing the original letters patent in evidence.⁹⁰

§ 244. To omit from a reissue, anything which the original specification stated to be essential to the invention, is fatal to identity of invention.⁹¹ Indeed, it has been held in one case that the omission of one bolt from a reissue patent for a reaper and mower, was enough to negative identity with the original, because, with the bolt, the machine was a reaper only, and not a mower.⁹² A process is not the same invention as a machine which may perform that process;⁹³ and a process consisting of one stage is not the same as a process consisting of that stage and one or more others.⁹⁴ Where, however, an original patent described and claimed several different inventions, one or more of those inventions may be omitted from the claims of a reissue of that patent.⁹⁵ It is necessary to the requisite identity of invention, that the reissue should claim no invention not described and intended to be claimed in the original; but it is not necessary to that identity, that the original should describe or claim no invention not described or claimed in the reissue.

§ 245. A sub-combination may be claimed in a reissue, if it was shown in the original as performing the same function; even though it was claimed in the original only as a part of a larger combination.⁹⁶ But a sub-combina-

⁹⁰ *Seymour v. Osborne*, 11 Wallace, 516, 1870.

⁹¹ *Gill v. Wells*, 22 Wallace, 1, 1874; *Russell v. Dodge*, 93 U. S. 460, 1876; *Atwood v. Portland Co.*, 10 F. R. 286, 1880.

⁹² *Kirby v. Mfg. Co.*, 10 Blatch. 307, 1872.

⁹³ *Eachus v. Broomall*, 115 U. S. 436, 1885.

⁹⁴ *Wood-Paper Patent*, 23 Wallace, 599, 1874.

⁹⁵ *Rubber Co. v. Goodyear*, 9 Wallace, 788, 1869.

⁹⁶ *Battin v. Taggert*, 17 Howard, 74, 1854; *Corn-Planter Patent*, 23 Wallace, 181, 1874; *Jordan v. Dobson*, 4 Fisher, 232, 1870; *Pearl v. Ocean Mills*, 2 Bann. & Ard. 469, 1877; *Herring v. Nelson*, 3 Bann.

tion cannot be legally claimed in a reissue, if it is there shown to perform a substantially different function from any which it could perform in its original environment.⁹⁷ In the former case, the invention, consisting of the sub-combination, existed in the original specification. In the latter case, the sub-combination may have existed in the original, but it did not compose, in that place, the same invention which it constitutes in the reissue.

§ 246. A single device may also be made the subject of a separate claim in a reissue, though in the original it was claimed only in combination with other devices; provided that device was a new and useful invention of the patentee, and might have been separately claimed by him in the original patent, and appears therein to have been intended to be secured thereby.⁹⁸

§ 247. Whether a patentee, in effecting a reissue, may describe an equivalent of one of the elements of the originally patented combination, and may claim the combination broadly enough to cover that equivalent, is a question which depends upon the effect, in particular cases, of the application of the rule in *Miller v. Brass Co.* Where such a reissue is applied for promptly after the granting of the original patent, it may be sustained;⁹⁹ but the right to obtain such a reissue, is lost by long lapse of time after the date of the original, and before the application for that reissue.¹⁰⁰

& Ard. 55, 1877; Kerosene Lamp Heater Co. *v.* Littell, 3 Bann. & Ard. 312, 1878; Turrell *v.* Spaeth, 3 Bann. & Ard. 461, 1878; Odell *v.* Stout, 22 F. R. 163, 1884; Jenkins *v.* Stetson, 32 F. R. 398, 1887.

⁹⁷ Gill *v.* Wells, 22 Wallace, 24, 1874; Johnson *v.* Railroad Co., 105 U. S. 539, 1881.

⁹⁸ Parker & Whipple Co. *v.* Yale Clock Co., 123 U. S. 87, 1887; Galahue *v.* Butterfield, 10 Blatch. 237, 1872.

⁹⁹ McArthur *v.* Supply Co., 19 F. R. 263, 1884.

¹⁰⁰ White *v.* Dunbar, 119 U. S. 51, 1886.

§ 248. Reissue patents are not to be held void for want of identity with the originals, where a liberal construction of the two documents can avert that result.¹⁰¹ Courts are accordingly inclined, where claims apparently illegal are inserted in reissue patents, to modify those claims by construction, in order to make them conform to propriety.¹⁰² This inclination is not, however, to be relied upon, in a case where a patent was surrendered and reissued solely to broaden its claim, and where the broadened claim is void for want of novelty, as well as for want of identity with the original invention.¹⁰³ The claims of the reissued patent will be given the due effect intended and expressed in the proceeding.¹⁰⁴

§ 249. Where some, but not all, of the claims of a reissue patent are void because they are obnoxious to the doctrine of *Miller v. Brass Co.*, or because they are not for the same invention as the original; that fact does not vitiate the other claims of that patent. The reissue will, in either of those cases, have whatever validity it would have had if it had not contained the invalid claims, provided there is no unreasonable delay to file a proper disclaimer of them.¹⁰⁵

§ 250. Executors, administrators, or assigns have the

¹⁰¹ *Milligan & Higgins Glue Co. v. Upton*, 1 Bann. & Ard. 505, 1874.

¹⁰² *Mfg. Co. v. Ladd*, 102 U. S. 412, 1880; *Brainard v. Cramme*, 12 F. R. 624, 1882.

¹⁰³ *Wisner v. Grant*, 7 F. R. 922, 1880.

¹⁰⁴ *Thomson-Houston Electric Co. v. Black River Traction Co.*, 135 F. R. 759, 1905.

¹⁰⁵ *Gage v. Herring*, 107 U. S.

640, 1882; *Gould v. Spicer*, 15 F. R. 344, 1882; *Cote v. Moffitt*, 15 F. R. 345, 1882; *Schillinger v. Brewing Co.*, 24 O. G. 495, 1883; *National Pump Cylinder Co. v. Gunnison*, 17 F. R. 812, 1883; *Havemeyer v. Randall*, 21 F. R. 405, 1884; *International Terra Cotta Co. v. Maurer*, 44 F. R. 622, 1890; *Rawson & Morrison Mfg. Co. v. C. W. Hunt Co.*, 147 F. R. 239, 1906.

same right to surrender and reissue a patent, that the patentee himself has; ¹⁰⁶ except that the application must be made, and the new specification be signed, by the inventor himself if living, ¹⁰⁷ and sane. ¹⁰⁸ The title to the reissued patent will, in such a case, vest at once in the assignee, by operation of the assignment of the original patent, and without the execution of any new document. ¹⁰⁹

§ 251. Where several executors are appointed in a will, but only one of them receives letters testamentary, a patent of the testator may be lawfully reissued to that executor, and the legal title to the reissued patent will thereupon vest exclusively in him. ¹¹⁰ A grant of a reissue to a person as administrator, is conclusive evidence in an infringement suit that the person was in fact administrator; ¹¹¹ and the same rule doubtless applies as well to executors. A reissue to a person in trust for the heirs at law of the patentee, will confer the legal title to the reissue upon that person, and the equitable title upon the persons beneficially interested, whoever they may be. ¹¹²

§ 252. An assignee of a patent is a person to whom the entire legal interest, or an undivided part of the entire legal interest, in a patent has been duly assigned by an instrument in writing. A grantee differs from an assignee

¹⁰⁶ Revised Statutes, Section 4916.

¹⁰⁷ Revised Statutes, Section 4895.

¹⁰⁸ *Whitcomb v. Coal Co.*, 47 F. R. 659, 1891.

¹⁰⁹ *Woodworth v. Hall*, 1 *Woodbury & Minot*, 248, 389, 1846; *McBurney v. Goodyear*, 11 *Cushing (Mass.)*, 569, 1853.

¹¹⁰ *Rubber Co. v. Goodyear*, 9 *Wallace*, 788, 1869.

¹¹¹ *Woodworth v. Hall*, 1 *Woodbury & Minot*, 248, 389, 1846; *Goodyear v. Hullihen*, 3 *Fisher*, 251, 1867.

¹¹² *Woodworth v. Stone*, 3 *Story*, 752, 1845; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 1 *Bann. & Ard.* 177, 1874.

in that the rights conveyed to him are confined to a part or to parts of the territory of the United States. A licensee is one who receives either an exclusive or a concurrent right to make or to use or to sell the thing covered by the patent.¹¹³ A reissue may be granted to an assignee of the executor or administrator of the patentee;¹¹⁴ or to an assignee of an assignee;¹¹⁵ or indeed to an assignee of any degree, however far removed from the original patentee by mesne assignments;¹¹⁶ and if the reissued patent recites those assignments, it becomes at least *prima facie* evidence thereof, in an infringement suit.¹¹⁷ If a patent is owned jointly by two or more patentees, or by two or more assignees, or by one or more patentees and one or more assignees, all the owners must join in a reissue, or must ratify it, or it will be void; but neither grantees nor licensees are required to do either.¹¹⁸ The right of a patentee or assignee to receive a reissue is not affected by his having made grants, or issued licenses under his patent;¹¹⁹ but where a patentee grants away his rights in a part of the territory of the United States, and afterward conveys the residue to another vendee, it is doubtful whether that vendee is entitled to apply for a reissue.¹²⁰

§ 253. Grantees may continue to hold their rights under an original patent after it is surrendered and re-

¹¹³ Sections 274, 287, and 296 of this book.

¹¹⁴ *Carew v. Fabric Co.*, 1 Holmes, 45, 1871.

¹¹⁵ *Swift v. Whisen*, 2 Bond, 115, 1867.

¹¹⁶ *Selden v. Gas Burner Co.*, 9 F. R. 390, 1881.

¹¹⁷ *Middletown Tool Co. v. Judd*, 3 Fisher, 141, 1868; *Hoff-*

heins v. Brandt, 3 Fisher, 218, 1867.

¹¹⁸ *Potter v. Holland*, 4 Blatch. 206, 1858; *Forbes v. Stove Co.*, 2 Cliff. 379, 1864; *Meyer v. Bailey*, 2 Bann. & Ard. 73, 1875.

¹¹⁹ *Smith v. Mercer*, 3 Penn. L. J. Reports, 529, 1846.

¹²⁰ *Commissioner of Patents v. Whiteley*, 4 Wallace, 522, 1866.

issued by the patentee or assignee; or they may take corresponding rights under the reissued patent. They have their choice between the two.¹²¹ It follows from this rule, that in theory at least, a given invention may be the subject of letters patent in one part of the United States, at the same time that it is free to the public in other parts of the country. If this were a practical result, it would be highly unjust, because it would operate to prohibit given manufactures in one State, while in another State the same pursuits would be free to all. In fact, however, patentees or assignees seldom surrender any claims which it is worth while for any interested person to retain; and, on the other hand, grantees are generally ready to ratify and adopt broadened reissues. It may hereafter happen, that in order to retain his rights of action for accrued damages or profits, or in order to avoid the risk of exchanging a valid original patent for a reissue patent of uncertain validity, now and then a grantee will elect to continue to hold under the original, while the patentee holds under a reissue patent. If such cases become numerous and important, they will probably lead to a change in the statute. The remedy would be to enact that, in such cases, all the assignees and grantees must join in the surrender, in order to authorize a reissue.

§ 254. The legal effect of a valid reissue patent has always been the same under the different statutes which have, from time to time, been in force. The provision of the Revised Statutes upon the subject is as follows: "Every patent so reissued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter aris-

¹²¹ Washburn *v.* Gould, 3 *v.* Holland, 4 Blatch. 206, Story, 122, 1844; Woodworth *v.* 1858.
Stone, 3 Story, 749, 1856; Potter

ing, as if the same had been originally filed in such corrected form.”¹²²

It follows from this provision, that a reissued patent cannot be affected, in point of novelty, by anything done after the date of the original application. Novelty still dates from the original invention.¹²³ Nor will any invention produced after that time, be taken into account as showing the state of the art, and therefore as being relevant to the question of construction of a reissued patent.¹²⁴ On the other hand, when reissued patents are introduced in evidence to negative the novelty or limit the scope of other patents, they operate as of their own dates, and not as of the dates of the originals.¹²⁵

It also follows from said statutory law, that persons who use or sell, after the date of a reissued patent, specimens of the thing covered by it, are liable as infringers; even though those persons made or bought, or used those specimens before that date, and when, on account of the omission to cover them by the original patent, they had a legal right to appropriate the invention.¹²⁶

¹²² Revised Statutes, Section 4916.

¹²³ *Grant v. Raymond*, 6 Peters, 218, 1832.

¹²⁴ *Carroll v. Morse*, 9 O. G. 453, 1876.

¹²⁵ *United States Stamping Co. v. King*, 17 Blatch. 64, 1879.

¹²⁶ *Stimpson v. Railroad Co.*, 4 Howard, 380, 1846; *Agawam Co. v. Jordan*, 7 Wallace, 609, 1868; *Carr v. Rice*, 1 Fisher, 211, 1856; *Bliss v. Brooklyn*, 8 Blatch. 534, 1871; *Coffield Motor Washer Co. v. A. D. Howe Co.*, 172 F. R. 668, 1909.

CHAPTER X

EXTENSIONS

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§ 255. THE constitutional provision relevant to the duration of patent rights, is that such rights, when granted, shall be granted for limited times.¹ The Patent Act of 1790² provided, that under the circumstances and conditions prescribed therein, the Secretary of State, and the

¹ Constitution of the United States, Article I, Section 8.

² 1 Statutes at Large, Ch. 7, Section 1, p. 109.

Secretary of War, and the Attorney General, or any two of them, might issue letters patent for an invention, for any term not exceeding fourteen years. The same provision was made in the Patent Act of 1793.³ Under that law, patents were generally, if not universally, granted for the full fourteen years; but whether so granted or not, there was, prior to 1832, no mention in the statutes of any way in which any patent, once granted, could be extended, and its duration thus prolonged. In July of the last-mentioned year, it was enacted: "That application to Congress to prolong or renew the term of a patent, shall be made before its expiration."⁴ The same section also provided a method of proceeding, to be followed by applicants in such cases. The entire section was, however, merely a self-imposed limitation on a constitutional power of Congress; and it was repealed by the Patent Act of July 4, 1836.⁵ Since that date, the extending of patents by Congress, has been regulated by no other law than the Constitution.

§ 256. Patents may be extended by Congress at any time, either before or after their expiration.⁶ This power was exercised as early as 1808.⁷ In one later case such an extension was granted nearly three years before the then existing exclusive right was to expire;⁸ and in another, more than twenty-one years intervened between the expiration of the original term of the patent, and the granting of the extension.⁹ Congressional extensions, when

³ 1 Statutes at Large, Ch. 11, Section 1, p. 321.

⁴ 4 Statutes at Large, Ch. 162, Section 2, p. 559.

⁵ 5 Statutes at Large, Ch. 357, Section 21, p. 125.

⁶ *Bloomer v. Stolley*, 5 McLean, 161, 1850; *Jordan v. Dobson*, 2

Abbott, 407, 1870; *The Fire Extinguisher Case*, 21 F. R. 42, 1884.

⁷ *Evans v. Jordan*, 9 Cranch, 199, 1815.

⁸ *Bloomer v. McQuewan*, 14 Howard, 539, 1852.

⁹ *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

granted, are usually granted for the term of seven years; but they may lawfully be granted for any limited length of time, whether longer or shorter than that.

§ 257. Some special acts, for the extension of patents, merely extend their duration by a simple legislative edict, and do no more.¹⁰ Others instruct the Commissioner of Patents to ascertain the truth relevant to sundry questions of fact mentioned therein; and authorize him to decide whether in view of those facts, and of sundry considerations of justice and of public policy, the patent ought to be extended; and direct him to extend it, if his decision is in the affirmative.¹¹ When patents are extended in this latter method, those provisions of the special act which limit the operation of the extension, need not be recited in the certificate of extension, which the Commissioner indorses upon the patent or otherwise puts forth. The law reads the certificate in the light of that statute, without any such recital.¹²

§ 258. Special Acts of Congress granting or authorizing extensions of patents, come within the general rule, that the validity of a statute cannot be questioned in courts, on any allegation that its passage was procured by fraud or bribery.¹³ Such Acts are considered as engrafted on the general patents laws, and are to be construed in connection with them.¹⁴ Although the Constitution authorizes Congress to grant exclusive rights in inventions only to inventors, Congress may provide, when exercising its power in

¹⁰ *Bloomer v. McQuewan*, 14 Howard, 539, 1852; *Woodworth v. Edwards*, 3 Woodbury & Minot, 123, 1847.

¹¹ *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

¹² *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

¹³ *Gibson v. Gifford*, 1 Blatch. 529, 1850.

¹⁴ *Bloomer v. McQuewan*, 14 Howard, 539, 1852; *Jordan v. Dobson*, 2 Abbott, 408, 1870.

particular cases, that assignees of the inventors shall have the same rights under the extended term, that they had under the original term of the patent extended.¹⁵

§ 259. Patent Office extensions of patents, were first authorized by the Patent Act of July 4, 1836.¹⁶ By the Patent Act of March 3, 1861, they were prohibited, as to all patents thereafter granted.¹⁷ The last extension of the kind, was granted in 1875, and expired in 1882. But Congress is now being asked, by a number of able and influential patent lawyers, to enact a general statute, authorizing the Commissioner of Patents or some other tribunal, to extend such patents as may be found, on judicial investigation, to be ethically entitled thereto. For this reason, and because many of the rules and doctrines of law, which were established in suits for infringements of Patent Office extensions, are equally applicable to suits based on Congressional extensions, it is expedient to explain those rules and doctrines in this book.

§ 260. The Patent Act of 1836 provided¹⁸ that, whenever any patentee of an invention should desire an extension of his patent, he might make application therefor in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and that the Commissioner should thereupon, and on the payment of a specified fee, cause to be published a notice of the application, and of the time and place when and where the same would be considered. The Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury, were constituted a board to hear and decide upon the evidence

¹⁵ Blanchard's Gun-Stock Turning Factory v. Warner, 1 Blatch. 259, 1848.

¹⁶ 5 Statutes at Large, Ch. 357, Section 18, p. 124.

¹⁷ 12 Statutes at Large, Ch. 88, Section 16, p. 249.

¹⁸ 5 Statutes at Large, Ch. 357, Section 18, p. 124.

produced before them, both for and against the extension. If, upon such hearing in any particular case, it appeared to the board, having a due regard to the public interest, that it was just and proper that the term of the patent should be extended by reason of the patentee, without neglect or fault on his part, having failed to obtain from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and upon its introduction into public use; the statute made it the duty of the Commissioner to extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term. The statute also provided that no such extension should be granted after the expiration of the term for which it was originally issued; and that when so extended, a patent should have the same effect in law as though it had been originally granted for the term of twenty-one years; and that the benefit of such renewal should extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein.

The Patent Act of 1848¹⁹ amended the above provisions by vesting the power of the board, in the Commissioner of Patents alone; and by directing him to take into consideration the original patentability and novelty of the inventions covered by patents sought to be extended, as well as to be governed by the rules and principles that had theretofore governed the board.

No other change was ever made in the statute relevant to the subject, until in 1861 it was repealed as to future patents. As to patents granted before March 2, 1861, it was re-enacted in the Patent Act of 1870,²⁰ and again

¹⁹ 9 Statutes at Large, Ch. 47, Section 1, p. 231.

²⁰ 16 Statutes at Large, Ch. 230, Sections 63 to 67, p. 208.

re-enacted in the Revised Statutes.²¹ In both these re-enactments, one provision is found, which did not exist in the former law, namely, the provision that the application should be filed not more than six months nor less than ninety days before the expiration of the original term of the patent.

§ 261. All the statutes which provided for extensions of patents, specified "patentees" as being persons entitled to apply for extensions, and mentioned no others. When the first of those statutes was enacted in 1836, nobody but an inventor or his executor or administrator, could be a patentee. In 1837, however, Congress enacted, that any patent thereafter issued, might be made and issued to the assignee or assignees of the inventor.²² In all subsequent cases, where that course was pursued, the inventors and the patentees were not the same persons; but no corresponding change was ever made in the statutes relevant to extensions. The question has therefore arisen, whether, in such cases, it was the inventor who had a right to apply for an extension, or whether the patentee was the person who had that right, or whether both the inventor and the patentee must have joined in such an application. Where the inventor would have an equitable interest in the extension if granted, it was proper for him to apply for that extension alone.²³ When granted, the legal title to such an extension would vest in the patentee, because such an extension was in the nature of an amendment of his patent; but the equitable title might vest wholly in the inventor, or vest partly in the inventor and partly in the patentee, or vest partly in the inventor and

²¹ Revised Statutes, Sections 4924 to 4928.

²² 5 Statutes at Large, Ch. 45, Section 6, p. 193.

²³ *Sayles v. Dubuque & Sioux City Railroad Co.*, 5 Dillon, 220, 1878.

partly in third persons, according to the equitable facts of each case. When the inventor would have no equitable interest in the extension if granted, no extension could be obtained, either on his application, or on that of the patentee, or on that of both together; because it was not the intention or scope of the statute to grant extensions of patents for the sole benefit of others than the inventors of the things secured thereby.²⁴

Whether the executor or administrator of an inventor-patentee, had a right to apply for an extension, was the first of the ten questions which were submitted to the Supreme Court in the celebrated case of *Wilson v. Rousseau*. That question was argued in the affirmative by Webster, Seward, and Latrobe, and decided in the affirmative by the court.²⁵

Where a joint patent was taken out by joint inventors, all had to join in an application for an extension of that patent, if all were living; and if any were dead, the legal representatives of the deceased had to unite in such an application.²⁶

§ 262. No Patent Office extension was ever grantable after the expiration of the original term.²⁷ Such extensions could be granted at any time before the midnight at the end of the last day of that term; because fourteen-year patents did not expire till the last hour of the fourteenth anniversary of the day of their respective dates.²⁸ Patents limited in law to the term of fourteen years from the date of earlier foreign patents, were extendible, at the

²⁴ *Wilson v. Turner*, Taney's Circuit Court Decisions, 292, 1845.

²⁵ *Wilson v. Rousseau*, 4 Howard, 673, 1846.

²⁶ *Wickersham's Case*, 4 O. G. 155, 1873.

²⁷ Act of 1836, Section 18; Act of 1870, Section 63; Revised Statutes, Section 4924.

²⁸ *Johnson v. McCullough*, 4 Fisher, 170, 1870.

discretion of the Commissioner of Patents, as well as those not so limited;²⁹ but in such a case the extension had to be granted before the expiration of the foreign patent, even though the extended patent purported on its face to run for some time longer.³⁰

§ 263. Whether an inventor-patentee needed to possess any interest in the first term of his patent at the time of applying for an extension thereof, was the fifth question submitted to the Supreme Court in the case of *Wilson v. Rousseau*.³¹ That question was decided in the negative. Even where the assignee of the first term of a patent surrendered and reissued it, the inventor-patentee had a right to ignore the reissue, and to apply for and receive an extension of the original patent.³²

§ 264. It was against the policy of the law, if not against its letter, to extend any patent, in the extension of which, if granted, the inventor would have no property right. The right to an extension was given by the law, chiefly with a view to the advantage of the inventor, and not of his assignee or grantee.³³ It never was necessary, however, that the inventor should be in a condition to receive the legal title to the extension, or even that the entire equitable estate in it should belong to him. An interest in the proceeds of the exclusive right during the extended term, was enough to satisfy the policy of the law in this respect.³⁴ Even where the original patent was granted to an assignee, and where the extension was, therefore,

²⁹ *Tilghman v. Mitchell*, 9 Blatch. 27, 1871.

³⁰ *New American File Co. v. Nicholson File Co.*, 8 F. R. 816, 1881.

³¹ *Wilson v. Rousseau*, 4 Howard, 673, 1846.

³² *Potter v. Braunsdorf*, 7

Blatch. 97, 1869; *Crompton v. Belknap Mills*, 3 Fisher, 536, 1869.

³³ *Wilson v. Turner*, Taney's Circuit Court Decisions, 292, 1845.

³⁴ *Gear v. Grosvenor*, 1 Holmes, 215, 1873.

in point of legal title, a prolongation of his patent, the extension was held to be valid, because the inventors had interests in its proceeds.³⁵ Moreover, inventors were presumed in law to have had a sufficient interest to support extensions actually granted, unless the contrary was proved to have been the fact.³⁶

§ 265. The certificate of extension, which was provided for by the statute,³⁷ was generally indorsed on the original parchment letters patent; but where the original document was lost or was out of the control of the person applying for the extension, that certificate was indorsed upon a certified copy of the letters patent and was equally valid.³⁸

§ 266. Jurisdiction to extend a particular patent, was acquired by the Commissioner, under the statutes in force prior to July 8, 1870, whenever the proper person filed an application for such an extension, and paid the requisite fee; ³⁹ provided the application was filed, and the fee paid, long enough before the expiration of the original term of the patent, to enable the Commissioner to investigate the matter in the way prescribed by statute.⁴⁰ After July 8, 1870, the law remained the same on this point, except that under the statute of that date, and under the Revised Statutes, the application had to be filed not more than six months, nor less than ninety days before the first term of the patent would expire.⁴¹ The jurisdiction always depended, therefore, upon the application being filed and the fee paid by the proper person at the proper

³⁵ *Sayles v. Dubuque & Sioux City Railroad Co.*, 5 Dillon, 220, 1878.

³⁶ *Ruggles v. Eddy*, 10 Blatch. 56, 1872.

³⁷ Patent Act of 1836, Section 18.

³⁸ *Potter v. Braunsdorf*, 7 Blatch. 108, 1869.

³⁹ *Gear v. Grosvenor*, 1 Holmes, 218, 1873.

⁴⁰ *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

⁴¹ 16 Statutes at Large, Ch. 230, Section 63, p. 208; Revised Statutes, Section 4924.

time. The decision of the Commissioner, relevant to the existence of his jurisdiction, was never conclusive in any case.⁴² The validity of a Patent Office extension, was therefore open to inquiry in an infringement suit, when it was questioned on the theory that the person who applied for it, was not such a person as had the legal right to do so. In deciding that question, however, the courts regarded with respect the practical construction of the statute, which was necessarily involved in the granting of the extension.⁴³ Indeed the Supreme Court has held that the practical construction given to a statute, by the executive branch of the government charged with its execution, is entitled to great weight, when the true meaning of that statute is drawn into judicial inquiry.⁴⁴

§ 267. The meritorious facts which entitled an inventor-patentee to a Patent Office extension were that, without fault or neglect on his part, he had failed to obtain from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and upon its introduction into public use.⁴⁵ Unlike the foundation facts which entitle a patentee to a reissue, these points were not required by the statute to exist absolutely. The statutory provision was that they should appear to the satisfaction of the Commissioner of Patents. It was therefore immaterial whether the courts were satisfied of their existence or not. The fact that a particular extension was granted, showed that the Commissioner was satisfied of the existence of those facts in that case; and evidence that they did not in fact exist,

⁴² *Wilson v. Rousseau*, 4 Howard, 687, 1846.

⁴³ *Brooks v. Bicknell*, 3 McLean, 250, 1843.

⁴⁴ *Grant v. Raymond*, 6 Peters, 244, 1832.

⁴⁵ Patent Act of 1836, Section 18; Patent Act of 1870, Section 66; Revised Statutes, Section 4927.

was therefore inadmissible in a suit for infringement of the patent during that extension.⁴⁶

§ 268. The statute made it the duty of the Commissioner to advertise all applications for extensions, and to refer such cases to the principal examiner having in charge the class of inventions to which the patent sought to be extended belonged, and having received the report of the examiner, to hear and decide each particular case at the time and place designated in the advertisement. All these provisions were directory, and none of them were jurisdictional. The validity of no extension could therefore be affected by proof, in an infringement suit, that some or all of those acts were omitted by the Commissioner, or were irregularly performed.⁴⁷

§ 269. No fraud, practiced upon or by the Commissioner, relevant to securing or granting an extension, could ever become the subject of inquiry in any suit for infringement. The decision of the Commissioner, in granting an extension, did not, however, foreclose all inquiry into allegations of fraud, as it did into allegations of inadvertence, error, or ministerial irregularity. The law was not so absurd as to make a man's own decision that he had committed no fraud, and suffered none to be committed upon him, a conclusive adjudication of that point. But charges so grave were thought to deserve a special proceeding for their investigation. They were not to be bandied about as collateral makeweights in infringement suits. When investigated, they had to be investigated in a special proceeding brought to repeal the grant of the extension.⁴⁸

⁴⁶ *Clum v. Brewer*, 2 Curtis, 506, 1855; *Jordan v. Dobson*, 2 Abbott, 408, 1870.

⁴⁷ *Brooks v. Jenkins*, 3 McLean,

435, 1844; *Colt v. Young*, 2 Blatch. 473, 1852; *Tilghman v. Mitchell*, 9 Blatch. 27, 1871.

⁴⁸ *Rubber Co. v. Goodyear*, 9

§ 270. "The benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented, to the extent of their interest therein."⁴⁹ This enactment, in almost precisely the same words, was always found in statutes providing for extensions of patents.⁵⁰ The purport of this law was never learned from its perusal.

The duty of ascribing a definite meaning to the enactment, devolved upon the courts. But the clause was so ambiguous that the judges could not agree in its construction. The provision was enacted in 1836, but it was still a subject of controversy in the Supreme Court, more than thirty-seven years later. When more than forty years had passed after its enactment, a text-writer collated the adjudicated cases, and stated the full adjudicated meaning of the statutory language. That meaning was then found to be as follows.

§ 271. Every person who, at the beginning of any extended term of any patent, had a right to use a particular specimen of any thing covered by that patent, had the same right to use that specimen during that extended term, unless his right was expressly limited so as not to include that term; and if such a person was the owner of such a specimen, he might sell it to be used by others during that extension.⁵¹

Wallace, 796, 1869; *Mowry v. Whitney*, 14 Wallace, 434, 1871.

⁴⁹ Revised Statutes, Section 4928.

⁵⁰ Patent Act of 1836, Section 18; Patent Act of 1870, Section 67.

⁵¹ *Wilson v. Rousseau*, 4 Howard, 677, 1846; *Bloomer v. McQuewan*, 14 Howard, 539, 1852; *Chaffee v. Belting Co.*, 22 How-

ard, 217, 1859; *Bloomer v. Millinger*, 1 Wallace, 340, 1863; *Mitchell v. Hawley*, 16 Wallace, 544, 1872; *Eunson v. Dodge*, 18 Wallace, 414, 1873; *Paper-Bag Cases*, 105 U. S. 766, 1881; *Woodworth v. Curtis*, 2 Woodbury & Minot, 524, 1847; *Goodyear v. Rubber Co.*, 1 Cliff. 349, 1859; *Wooster v. Sidenberg*, 13 Blatch.

The limitations expressed in this rule are not to be overlooked. 1. It applied only to persons whose right to use existed at the beginning of the extension. It was therefore possible for patentees to avoid the rule altogether, by making their licenses expire one day before the end of the existing terms of their respective patents. 2. The rule conferred no right upon any person on account of his having had a right to make or sell specimens of the patented thing. 3. The rule did not apply to any patent for a process.⁵² 4. The rule conferred no right under an extension, that did not exist under the former term. Accordingly, if the former right was subject to a royalty, the right under the extension was subject to the same royalty.⁵³ 5. The rule conferred no right to make or use or sell any new specimen of the patented thing;⁵⁴ though it did confer a right to repair the articles to which it applied.⁵⁵ 6. The rule did not apply where the right to use, when granted by the patentee, was expressly limited to the existing term of the patent.⁵⁶ The right provided by the rule was a property right; and the specimens to which it referred, and the right to use those specimens, might be transferred by sale, devise, or assignment in insolvency.⁵⁷

88, 1875; *Black v. Hubbard*, 3 Bann. & Ard. 39, 1877.

⁵² *Wetherell v. Zinc Co.*, 6 Fisher, 50, 1872.

⁵³ *Union Mfg. Co. v. Lounsbury*, 41 New York, 363, 1869.

⁵⁴ *Hodge v. Railroad Co.*, 6 Blatch. 165, 1868; *Wood v. Railroad Co.*, 2 Bissell, 62, 1868.

⁵⁵ *Wilson v. Simpson*, 9 Howard, 109, 1850; *Aiken v. Print Works*, 2 Cliff. 435, 1865; *Farrington v. Detroit*, 4 Fisher, 216, 1870.

⁵⁶ *Mitchell v. Hawley*, 16 Wallace, 544, 1872.

⁵⁷ *Woodworth v. Curtis*, 2 Woodbury & Minot, 524, 1847.

CHAPTER XI

TITLE

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| 273. Title by occupancy. | 283. No implied warranty of validity. |
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§ 272. TITLES to patent rights are capable of two independent classifications. One relates to the nature of title, and the other relates to the methods by which title may be acquired. In the first of these aspects, titles are divisible into those which are purely legal, those which are purely equitable, and those which are both legal and equitable. In the second aspect, they are divisible into those: 1. By occupancy. 2. By assignment. 3. By grant. 4. By creditor's bill. 5. By bankruptcy. 6. By death. Titles which are both legal and equitable may be

acquired in either of these methods. Titles which are purely equitable may be acquired by either, except the first; and those which are purely legal may be transferred by either, except the first, fourth and fifth. It is the plan of this chapter to treat the subject of title under this six-fold division; and, in general, to treat it with a view to title which is both legal and equitable, and is therefore complete; but also, to incorporate into that treatment such statements as may show the relations which purely legal and purely equitable titles bear to each other and to the law, and to conclude the whole with a discussion of such points as relate to patents owned contemporaneously by a plurality of persons.

§ 273. Title by occupancy is that title to a patent which any person may acquire by inventing any new and useful process, machine, manufacture, composition of matter or design, and by applying for and obtaining a patent thereon. During the time between the day of invention and the date of letters patent therefor, that title is inchoate.¹ Such an inchoate right may be assigned; and an assignment thereof will convey the legal title to the letters patent, as soon as the letters patent are granted;² whether or not the assignment requests the Commissioner of Patents to issue the letters patent to the assignee.³ This rule applies not only to cases where the assignments are recorded before the granting of the patents,⁴ but also to cases where, though executed before, they are not recorded till after that event.⁵ So also, it applies to cases

¹ *Gayler v. Wilder*, 10 Howard, 493, 1850; *Hendrie v. Sayles*, 98 U. S. 551, 1878.

² See Section 274.

³ *Harrison v. Morton*, 83 Md. 477, 1896.

⁴ *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 25 F. R. 719, 1885.

⁵ *United States Stamping Co. v. Jewett*, 7 F. R. 869, 1880.

where applications are divided after they are assigned,⁶ and to cases where the assignments are executed after the applications for patents are rejected, and before those rejections are reversed.⁷ The inchoate right to a Patent Office extension of a patent, when such a right was provided by law,⁸ was also a proper subject of assignment, even while it remained inchoate;⁹ and such an assignment also operated to convey the legal title to such an extension, whenever such an extension was granted by the Commissioner of Patents.¹⁰ An assignment of an inchoate title to a patent, which does not request the Commissioner to issue the letters patent to the assignee, will convey not only the equitable title but also the legal title thereto, as soon as the letters patent are granted.¹¹

The title by occupancy, which an inventor acquires when he invents, is not affected by the fact that he is at the time in the employ of another;¹² for persons employed, as much as employers, are entitled to their own independent inventions.¹³ The original title of a patentee to a patent issued to him, is presumed to continue till he is shown to have parted with it;¹⁴ and the grantee named in a reissue patent is presumed to be the lawful owner of that patent until he is shown not to have owned the patent which he surrendered in order to obtain that reissue, or

⁶ *Puetz v. Bransford*, 31 F. R. 461, 1887.

⁷ *Gay v. Cornell*, 1 Blatch. 510, 1849.

⁸ From July 4, 1836, to March 2, 1875.

⁹ *Nicholson Pavement Co. v. Jenkins*, 14 Wallace, 456, 1871.

¹⁰ *Railroad Co. v. Trimble*, 10 Wallace, 380, 1870.

¹¹ See Section 274.

¹² *Hapgood v. Hewitt*, 119 U. S. 226, 1886; *Solomons v. United States*, 137 U. S. 346, 1890; *Dalzell v. Dueber Mfg. Co.*, 149 U. S. 320, 1893.

¹³ *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

¹⁴ *Fischer v. Neil*, 6 F. R. 89, 1881.

is shown to have parted with the title to the reissue after that date.¹⁵

§ 274. An assignment of a patent is an instrument in writing, which, in the eye of the law, purports to convey the entire title to that patent, or to convey an undivided share in that entire title.¹⁶ An assignment may purport to convey the ownership of the patent, or an undivided share of that ownership, or it may purport to convey the exclusive right, or an undivided share thereof, to make, use and sell the invention throughout the United States. Such a document, in the latter form, is as truly an assignment, as is a document which employs the other phraseology.¹⁷ And an assignment in either form, is not less an assignment because it is coupled with a license back to the assignor.¹⁸

There has been some doubt as to whether an assignment of a pending application without a request to the Commissioner of Patents that the patent issue in the name of the assignee conveyed more than the equitable title to the patent. It now appears to be settled that such an assignment carries with it the whole interest, legal and equitable.¹⁹

Assignments of legal titles to patents must be in writing,

¹⁵ Washburn & Moen Mfg. Co. v. Haish, 4 F. R. 900, 1880.

¹⁶ Gayler v. Wilder, 10 Howard, 477, 1850; Waterman v. Mackenzie, 138 U. S. 255, 1891; Pope Mfg. Co. v. G. & J. Mfg. Co., 144 U. S. 249, 1892.

¹⁷ Rapp v. Kelling, 41 F. R. 792, 1890; Johnson Signal Co. v. Union Signal Co., 59 F. R. 23, 1893; Paulus v. M. M. Buck Mfg. Co., 129 F. R. 594, 1904.

¹⁸ Pope Mfg. Co. v. Clark, 46

F. R. 792, 1891; Russell v. Kern, 58 F. R. 384, 1892; Sirocco Engineering v. Monarch Ventilator Co., 184 F. R. 84, 1910; Lock Joint Pipe Co. v. Melber, 234 F. R. 319, 1916.

¹⁹ Wende v. Horine, 191 F. R. 620, 1911; Hildreth v. Auerbach, 200 F. R. 972, 1912; Individual Drinking Cup Co. v. Osmun-Cook Co. (reviewing authorities on both sides of the question), 220 F. R. 335, 1915.

because the statute provides no other method of effecting such an assignment;²⁰ and because, since patent rights are creatures of statutes and not of common law, the transfer of the legal title thereto cannot be regulated by the rules of the latter system.²¹ An equitable title may be created by parol,²² and may be transferred by the same method.²³ But a recital in a writing that a particular person is an owner with the subscriber of a patent granted to the latter, is not even an equitable assignment.²⁴ Persons who issue signed assignments in blank, are estopped from denying the propriety of the filling, when the filled assignments are invoked by purchasers for valuable considerations, who had no notice of any fraud or error in the filling.²⁵

§ 274*a*. Titles conveyed by assignments are usually unconditional, but they may also be held upon special tenures. One instance of such a tenure is presented where the assignment contains a condition that the assignee shall pay a specified royalty to the assignor during the life of the patent assigned,²⁶ and shall make enough of the patented articles to supply the demand therefor;²⁷ or shall sell the patent and pay the proceeds to the assignor

²⁰ Revised Statutes, Section 4898; *Jewett v. Atwood Suspender Co.*, 100 F. R. 648, 1900.

²¹ *Gayler v. Wilder*, 10 Howard, 498, 1850; *Atherton Mach. Co. v. Atwood-Morrison Co.*, 102 F. R. 949, 1900.

²² *Dalzell v. Dueber Mfg. Co.*, 149 U. S. 320, 1893; *Whiting v. Graves*, 3 Bann. & Ard. 225, 1878; *Cook v. Sterling Electric Co.*, 118 F. R. 47, 1902; *Prest-O-Lite Co. v. Avery Portable Lighting Co.*, 164 F. R. 60, 1908.

²³ *Whitney v. Burr*, 115 Ill. 293,

1885; *Burr v. De La Vergne*, 102 N. Y. 422, 1886; *Scarle v. Hill*, 73 Iowa, 367, 1887; *Jones v. Reynolds*, 120 N. Y. 215, 1890; *Schmitt v. Nelson Valve Co.*, 125 F. R. 754, 1903.

²⁴ *Kearney v. Railroad Co.*, 27 F. R. 701, 1886.

²⁵ *National Heeling-Mach. Co. v. Abbott*, 70 F. R. 56, 1895.

²⁶ *Littlefield v. Perry*, 21 Wallace, 220, 1874; *Boesch v. Graff*, 133 U. S. 701, 1890.

²⁷ *Dow v. Harkin*, 67 N. H. 383, 1892.

or to others for his benefit; ²⁸ or shall not make any assignment of the patent, or license under it.²⁹ Where a title is to be held upon such a special tenure, the condition of that tenure should be stated in the assignment conveying the title; but the tenure may be expressed, and the condition be defined, in a separate unrecorded paper, with equal effect upon the parties, to the assignment;³⁰ though not with any effect upon purchasers from the assignee, who never had any notice of the special tenure, or of the condition upon which it was established. The burden of proving non-compliance with such a condition, rests upon him who asserts it; ³¹ but where non-compliance is proved, and no intervening rights are involved, the title reverts to the assignor by operation of law.³²

Where an assignment conveys a title to a patent, to be held permanently, upon condition of the payment of certain notes given for the purchase thereof, it is said that the non-payment of the notes will cause the title to revert to the assignor, but the reversion of the title will not discharge the notes.³³

Other estates than a complete one, may be created in patents by assignments. An estate for years and an estate in remainder are examples of these.³⁴ But a paper giving an unassignable exclusive right for a term of years, and limited to less than the entire rights of the patent, is only a license.³⁵

²⁸ Jonathan Mills Mfg. Co. v. Whitehurst, 56 F. R. 594, 1893.

²⁹ Platt v. Fire Extinguisher Co., 59 F. R. 901, 1894.

³⁰ Pierpoint Boiler Co. v. Penn Iron & Coal Co., 75 F. R. 292, 1896.

³¹ De Beaumont v. Williames, 71 F. R. 812, 1896.

³² Pierpoint Boiler Co. v. Penn Iron & Coal Co., 75 F. R. 293, 1896.

³³ Ockington v. Law, 66 Maine, 551, 1877; but see Section 276.

³⁴ Solomons v. United States, 21 Court of Claims, 481, 1886.

³⁵ Moore Mfg. & Foundry Co.

§ 275. The patent assigned ought to be described in the assignment by its number and date, and by the name of the patentee, and by the name of the invention which it purports to cover; but an assignment will be valid though it is lacking or erroneous in one or more of these particulars, if the description which it contains excludes doubt as to the patent intended to be conveyed,³⁶ as for example of all the property of the assignor "including good will, patents, trade marks," etc., even though such an assignment could not be recorded.³⁷ An assignment of an invention or patent for a machine will not convey any patent for a process, in the performance of which that machine finds its only utility.³⁸

An assignment by a natural person requires no other authentication than the assignor's signature; and where such an assignment is executed by an attorney in fact, it must be executed in the name of the assignor, and cannot lawfully be executed by the attorney in his own name.³⁹ Where a power of attorney provides that assignments made under it, must be approved by the giver of the power; an assignment made without any such approval is void.⁴⁰ Though an assignment is fully executed by the signature of the assignor; its subsequent proof is facilitated by a certificate of acknowledgment, made by a notary public or other magistrate, under the statute of 1897; for such a

v. Cronk Hanger Co., 69 F. R. 999, 1895.

³⁶ Case *v. Morey*, 1 New Hampshire, 349, 1818; *Holden v. Curtis*, 2 New Hampshire, 63, 1819; *Harmon v. Bird*, 22 Wendell (N. Y.), 113, 1839; *Hill v. Thuermer*, 13 Indiana, 351, 1859; *Aeolian Co. v. Hallet & Davis Piano Co.*, 134 F. R. 872, 1905.

³⁷ *Delaware Seamless Tube Co. v. Shelby Steel Tube Co.*, 160 F. R. 928, 1908.

³⁸ *Downton v. Mfg. Co.*, 9 F. R. 402, 1879; *Downton v. Allis*, 9 F. R. 771, 1881.

³⁹ *Machesney v. Brown*, 29 F. R. 145, 1886.

⁴⁰ *Chauche v. Pare*, 75 F. R. 285, 1896.

certificate is *prima facie* evidence of the genuineness, and of the execution, of the assignment to which it is attached or otherwise made applicable.⁴¹ The designation of the assignee in an assignment, is sufficient where the person intended can be identified, even where evidence outside of the assignment is required for that purpose.⁴²

A patent may be assigned to a partnership, by the partnership name, even where that name is artificial, and does not contain the name of any partner;⁴³ and a patent may likewise be assigned, in the partnership name, by the partnership to which it has belonged.

An assignment by a corporation needs not to be authenticated by its corporate seal, but is properly executed, if executed in the name and by the authority of the corporation, and by a proper officer, who signs for the corporation, and signs as an officer thereof.⁴⁴ An assignment to a corporation confers no title upon any stockholder therein;⁴⁵ and an assignment to a corporation, which is not organized till after the date of the assignment, will, at least by way of estoppel, inure to its benefit when organized, and will be good as against the assignor.⁴⁶

A married woman, an infant, or a person under guardianship may be the assignee of an invention or of a patent. Such persons may also assign their inventions or patents by complying, not only with the United States law which requires assignments of patents to be in writing, but also with those laws of their particular States which

⁴¹ 29 Statutes at Large, p. 693, Ch. 391, Section 5.

⁴² *Fisk, Clark & Flagg v. Hollander, MacArthur & Mackay*, 360, 1883.

⁴³ *Fresno Home-Packing Co. v. Fruit-Cleaning Co.*, 101 F. R. 826, 1900.

⁴⁴ *Gottfried v. Miller*, 104 U. S. 527, 1881.

⁴⁵ *Gottfried v. Miller*, 104 U. S. 528, 1881.

⁴⁶ *Dyer v. Rich*, 1 Metcalf (Mass.), 180, 1840.

govern analogous acts of such persons, in respect of other personal property.⁴⁷

§ 276. An assignment for which the consideration was never paid, and which was never acted upon by either of the parties thereto, conveys no title to the assignee;⁴⁸ but no assignment, which has been acted upon by the parties thereto, can be revoked on the ground of a partial failure to pay the promised price.⁴⁹ And total failure to pay any consideration for an assignment, does not derogate from the rights of those who take title under it, without any notice of that failure.⁵⁰ Where no rights have accrued to any third party under an unrecorded assignment, the assignee may restore the title to the assignor, by burning the assignment up, or otherwise completely destroying it, for the avowed purpose of its cancellation.⁵¹

§ 276a. The consideration of the validity or invalidity, under the anti-trust laws, of price and use restrictions on patented articles and processes is taken up in another part of this book.⁵² There is, however, a large class of contracts consisting generally of those that seek to impose upon an inventor an obligation to assign to another certain or all inventions which he may make, that have received the attention of courts of equity with reference to the common-law principle governing the validity of contracts in restraint of trade, and also with reference to the equitable defence to suits for specific performance of unconscionableness of the contract sought to be enforced. It may be safely stated that any contract which broadly

⁴⁷ *Fetter v. Newhall*, 17 F. R. 343, 1883.

⁴⁸ *Railroad Co. v. Trimble*, 10 Wallace, 380, 1870; *Buck v. Timony*, 78 F. R. 488, 1897.

⁴⁹ *Hartshorn v. Day*, 19 How-

ard, 222, 1856; *Mackaye v. Mallory*, 12 F. R. 328, 1882.

⁵⁰ *Piaget Novelty Co. v. Headley*, 108 F. R. 870, 1901.

⁵¹ *Winfrey v. Gallatin*, 72 Mo. App. 191, 1897.

⁵² See Sections 315 *et seq.*

obligates an inventor to assign without further consideration than the mere payment of money or the transfer of property to the inventor, all inventions which he may make during his lifetime, is invalid.⁵³ It may be gathered from the cases, however, that broadly speaking, if the purpose intended and effected by the contract is the protection of the other's business from advantages that have or may be gained by the inventor from his relations with the other, the contract is not void.⁵⁴ It is not necessary that there be a grant from the inventor, as for instance the assignment of a patent or a business.⁵⁵

In *Hulse v. Bonsack Mach. Co.*⁵⁶ the court said:

"We have seen the reason for the adoption of this form of contract by the company. It was to protect it from improvements discovered by its own servants, under its pay, in cigarette machines. The company lets them into an intimate knowledge of its cigarette machines, affords them the opportunity of discovering any needed improvements in them, gives them at hand the means of testing any improvements which may suggest themselves. Naturally it seeks to protect itself from an abuse of these results. The protection sought is a fair one for the interests of the company. . . . In the most recent cases the validity of contracts in partial restraint of trade is tested, not by any inflexible rule, but by their reasonableness

⁵³ *Littlefield v. Perry*, 21 Wallace, 205, 226, 1874; *Westinghouse Air Brake Co. v. Chicago Brake Mfg. Co.*, 85 F. R. 786, 1898.

⁵⁴ *Littlefield v. Perry*, 21 Wallace, 205, 226, 1874; *Hulse v. Bonsack Mach. Co.* (and cases cited), 65 F. R. 864, 1895; *Fairchild v.*

Dement, 154 F. R. 200, 1908; *A. B. Dick Co. v. Fuller*, 198 F. R. 404, 1912; *Thompson v. Automatic Fire Protector Co.*, 211 F. R. 120, 1914.

⁵⁵ *Lion Tractor Co. v. Bull Tractor Co.*, 231 F. R. 156, 1916.

⁵⁶ *Hulse v. Bonsack Mach. Co.*, 65 F. R. 864, 1895.

when considered in connection with the protection necessary for the particular business and the modern methods of conducting the enterprise."

In line with the general principle stated, a contract by an inventor to assign all inventions already made by him as well as all future inventions which he may make for an indefinite period relating to the same subject-matter, is valid.⁵⁷ If the assignee has acquired or is to acquire the prior invention it is proper for him to protect himself against the acquisition by his rivals of improvements. And so a contract of employment which provides that the employee shall assign to the employer all inventions made during the term of the employment which relate to specified articles manufactured by the employer, is valid.⁵⁸ And the contract will be enforced with respect to an invention which relates both to the specified articles and other articles, but only so far as it concerns the specified articles.⁵⁹ A contract to assign inventions to a corporation formed or to be formed by the inventor and others for the purpose of carrying on a business to which the inventions specified relate, is valid and will be specifically enforced.⁶⁰ The assignment of a patent by an agreement which provides for the assignment of all future improvements thereon to be made by the patentee is valid, for without the improvements the value of the basic patent might be wholly destroyed.⁶¹ An interest of the inventor in the future profits of a corporation or partnership is

⁵⁷ *Reece Folding Machine Co. v. Fenwick*, 140 F. R. 287, 1905; *A. B. Dick Co. v. Fuller*, 198 F. R. 404, 1912.

⁵⁸ *Lion Tractor Co. v. Bull Tractor Co.*, 231 F. R. 156, 1916.

⁵⁹ *Wright v. Vocalion Organ Co.*, 148 F. R. 209, 1906.

⁶⁰ *Davis & Roesch Temperature, etc. Co. v. Tagliabue*, 148 F. R. 705, 1906; *Fairchild v. Dement*, 164 F. R. 200, 1908.

⁶¹ *Westinghouse Air Brake Co. v. Chicago Air Brake & Mfg. Co.*, 85 F. R. 786, 1898.

also sufficient to sustain the validity of such a contract.⁶²

In *A. B. Dick Co. v. Fuller*⁶³ it was urged that the contract of assignment of future inventions was invalid because it covered all inventions relating to the subject-matter of certain patents assigned and was not confined to improvements. The court, however, held that if the contract were construed as confined to such inventions, improvements or otherwise, as bore some relation to the processes already assigned, the contract was valid and stated that the same reasoning which would sustain the validity of a contract to assign future improvements would apply to such a contract as the one in question, namely, that the future inventions, while they might not be improvements, would nevertheless form a possible basis for hostile competition. Indeed it would seem that the reason was all the more forcible in the case of such a contract. The ownership by a stranger of the improvement could not be the basis of hostile competition during the life of the basic patent, but could only prevent the use of the improvement by the owner of the basic patent. A patented invention for a similar purpose as that of the basic patent but not in the nature of an improvement could be utilized with perfect freedom by one acquiring it and thus be a source of competition to the owner of the basic patent. It should be noted that in the *A. B. Dick Co.* case above referred to the court considered the validity of a contract to assign all inventions affecting inventions or improvements in any article made by the assignee, but as the question was not involved did not pass upon it.

§ 277. Rights of action for past infringements of a patent are not conveyed by any mere assignment of that

⁶² *Aspinwall Mfg. Co. v. Gill*,
32 F. R. 697, 1887.

⁶³ *A. B. Dick Co. v. Fuller*, 198
F. R. 404, 1912.

patent;⁶⁴ but they may be conveyed by any assignment which purports to convey them, whether that document purports also to convey the patent,⁶⁵ or purports to convey the rights of action alone.⁶⁶

§ 278. The construction of assignments depends primarily upon the meaning of all the language in which they are composed, rather than upon that of any particular words they contain;⁶⁷ and if that language is clear in the eye of the law, its effect cannot be varied by any parol evidence;⁶⁸ but if that language is ambiguous, it may be construed in the light of certain classes of parol proof. The parties will never be permitted to testify what they intended to signify by the language they used, because if they were, assignors might narrow, and assignees might widen, the scope of the rights conveyed, by simply making oath to alleged former states of their own minds. Perjury could seldom be detected in such a case, and such a rule would put property at the mercy of avarice. Nor is any evidence admissible which merely shows that one of the parties to an assignment made such declarations, or did such acts, in pursuance of that assignment, as indicate that he understood the document in a sense most favorable to himself. If such evidence were admissible, the honest mistake of an assignor, in construing his contract, would often deprive an assignee of rights which he had honestly bought; and the honest mistake of an assignee would often

⁶⁴ *Moore v. Marsh*, 7 Wallace, 515, 1868; *May v. County of Juneau*, 30 F. R. 245, 1887; *Koalatype Co. v. Hoke*, 30 F. R. 444, 1887; *May v. County of Saginaw*, 32 F. R. 629, 1888; *Superior Drill Co. v. Ney Mfg. Co.*, 98 F. R. 734, 1899.

⁶⁵ *Hamilton v. Rollins*, 3 Bann.

& Ard. 160, 1877; *Jones v. Berger*, 58 F. R. 1007, 1893.

⁶⁶ *Hayward v. Andrews*, 12 F. R. 786, 1882.

⁶⁷ *Washburn v. Gould*, 3 Story, 122, 1844.

⁶⁸ *Railroad Co. v. Trimble*, 10 Wallace, 367, 1870; *Ralya v. Atkins*, 157 Ind. 336, 1901.

deprive an assignor of rights which he never had sold. But parol evidence is admissible to construe an ambiguous assignment, if that evidence shows the existence of such collateral documents, or surrounding circumstances, attending the execution of that assignment, as throw light upon the meaning of its words;⁶⁹ or show that both parties to that assignment, practically construed it, after its execution, and in so doing construed it alike.⁷⁰ If ambiguities still remain in an assignment, after all other recognized methods of solving them have been employed, they are to be solved against the grantor, in a suit between him and the grantee, or their respective privies, as he is supposed to have written the document, and therefore to be chargeable with the obscurity;⁷¹ but as between the grantee or his privies, and strangers to the assignment, ambiguities in such cases are solved against the grantee.⁷²

§ 279. Reformation of an assignment may be had by means of a bill in equity filed for that purpose, if that assignment does not conform to the mutual intention of the parties to its execution; but neither party can secure such reformation on proof of what his intention was, unless he also proves that the intention of the other party was the same.⁷³ But no reformation of an assignment can affect the right of any innocent purchaser, for a valua-

⁶⁹ *Read v. Bowman*, 2 Wallace, 591, 1864; *Phelps v. Classen*, 1 Woolworth, 212, 1868; *Wetherill v. Zinc Co.*, 6 Fisher, 50, 1872; *Lowry v. Cowles Co.*, 56 F. R. 492, 1893, and 68 F. R. 366, 1895.

⁷⁰ *Topliff v. Topliff*, 122 U. S. 131, 1886; *Wilcoxon v. Bowles*, 1 Louisiana An'l, 230, 1846; *Parrott v. Wikoff*, 1 Louisiana An'l, 232, 1846; *Coleman v. Grubb*, 23 Penn.

St. 409, 1854; *Levy v. Dattlebaum*, 63 F. R. 994, 1894.

⁷¹ *Smith v. Selden*, 1 Blatch. 475, 1849; *May v. Chaffee*, 2 Dillon, 385, 1871; *Falley v. Giles*, 29 Indiana, 114, 1867; *Keith v. Engineering Co.*, 136 Cal. 181, 1902.

⁷² *Levy v. Dattlebaum*, 63 F. R. 994, 1894.

⁷³ *Downton v. Allis*, 9 F. R. 771, 1881.

ble consideration, who had no notice, at the time of his purchase, that the mutual intention of the parties was different from the assignment which passed between them.⁷⁴ Where several patents are sold, but one of them is omitted by mistake from the assignment which was intended to convey them all; the assignee has an equitable right to have the assignment reformed, so as to convey the omitted patent, and that equitable right is transferable from him, in the same ways in which other equitable rights in patents may be transferred.⁷⁵

§ 280. No extension of a patent is conveyed by an assignment of the first term thereof.⁷⁶ Nor is any extension, which is not provided for by the general law when an assignment is made, covered by the word "renewal" in such an assignment. In such a case, that word is held to mean "reissue" and not to mean "extension."⁷⁷ But if, at the time such an assignment is made, the patent statutes do provide for extensions of patents of the class to which the assigned patent belongs, then the word "renewal" is a sufficient word to convey such an extension.⁷⁸ An assignment of an invention, without limitation or qualification, will convey, not only the original term, but also any Patent Office extension, of the patent granted for that invention.⁷⁹ Whether such an assignment will convey any Congressional extension is an undecided point. An affirmative decision upon it will not necessarily follow the rule in *Hendrie v. Sayles*, but it is not improbable

⁷⁴ *Gibson v. Cook*, 2 Blatch. 149, 1850; *Woodworth v. Cook*, 2 Blatch. 151, 1850.

⁷⁵ *Newton v. Buck*, 77 F. R. 614, 1896.

⁷⁶ *Wilson v. Rousseau*, 4 Howard, 646, 1846.

⁷⁷ *Wilson v. Rousseau*, 4 Howard, 646, 1846.

⁷⁸ *Pitts v. Hall*, 3 Blatch. 201, 1854; *Goodyear v. Cary*, 4 Blatch. 303, 1859; *Chase v. Walker*, 3 Fisher, 122, 1866.

⁷⁹ *Hendrie v. Sayles*, 98 U. S. 554, 1878.

that the courts will take the step required to pass from the one doctrine to the other, whenever the question arises.

§ 281. Recording in the Patent Office, within three months after its date, is necessary to the validity of an assignment or grant of a patent as against any subsequent purchaser or mortgagee, for a valuable consideration, without notice.⁸⁰ This statutory provision operates to give constructive notice to subsequent purchasers and mortgagees, of the assignments which are duly recorded thereunder; but it does not apply to any assignment executed prior to the granting of letters patent, unless that assignment is one upon which a patent is to be issued to the assignee, and also identifies with certainty the invention conveyed thereby.⁸¹ Nor is an instrument which does not purport to convey any existing interest in any patent or application an "assignment, grant or conveyance" within the meaning of the statute, and consequently the recording of such an instrument does not operate as constructive notice to subsequent purchasers of the legal title.⁸² But where an assignment conveys a patent, and also conveys all improvements that the assignor may thereafter make on the invention claimed therein, the due recording of that assignment operates to give constructive notice of the sale of that patent, and, it has been held, of the sale of those improvements.⁸³ The correctness of the proposition that such an assignment is constructive

⁸⁰ Revised Statutes, Section 4898.

⁸¹ *Wright v. Randel*, 8 F. R. 599, 1881; *New York Paper Bag Co. v. Union Paper Bag Co.*, 32 F. R. 788, 1887.

⁸² *National Cash Register Co.*

v. New Columbus Watch Co., 129 F. R. 114, 1904.

⁸³ *Aspinwall Mfg. Co. v. Gill*, 32 F. R. 701, 1887; *Westinghouse Air-Brake Co. v. Chicago Brake & Mfg. Co.*, 85 F. R. 792, 1898. See *Davis & Roesch, etc., Co. v. Tagliabuc*, 150 F. R. 372, 1906.

notice of the sale of improvements which may thereafter be made is somewhat doubtful.⁸⁴ The provision of Section 4898 of the Revised Statutes, relevant to recording assignments of patents, does not apply to those conveyances, by operation of law, of the patents and patent rights of bankrupts, to trustees in bankruptcy, which are provided for by the bankrupt law of 1898;⁸⁵ any more than it did to the corresponding conveyances, which were provided for by the bankrupt law in the Revised Statutes.⁸⁶ Neither does that provision apply to any assignment which conveyed accrued rights of action only.⁸⁷ In such a case, the assignee, in order to protect his right, should give the infringer notice of the assignment; so that if the infringer afterward pays the assignor, or pays some subsequent assignee, for that right of action, he will do so at his peril, and will not discharge his liability to the first assignee.⁸⁸ Recording an assignment of a patent is not necessary to its validity, as between the parties to that assignment;⁸⁹ nor as against an infringer of the patent;⁹⁰

⁸⁴ *Eastern Dynamite Co. v. Keystone Powder Mfg. Co.*, 164 F. R. 47, 1908.

⁸⁵ 30 Statutes at Large, p. 565, Ch. 541, Section 70. See Bankruptcy Act of 1910, Section 8, 36 Statutes, 838.

⁸⁶ *Prime v. Mfg. Co.*, 16 Blatch. 456, 1879.

⁸⁷ *Gear v. Fitch*, 3 Bann. & Ard. 573, 1878.

⁸⁸ *Woodbridge v. Perkins*, 3 Day (Connecticut), 364, 1809; *Vanbuskirk v. Hartford Fire Insurance Co.*, 11 Connecticut, 144, 1841; *Campbell v. Day*, 16 Vermont, 558, 1844; *Clodfelter v. Cox*, 1

Sneed (Tenn.), 330, 1853; *Loomis v. Loomis*, 26 Vermont, 198, 1854; *Murdock v. Finney*, 21 Missouri, 138, 1855; *McWilliams v. Webb*, 32 Iowa, 577, 1871.

⁸⁹ *Holden v. Curtis*, 2 New Hampshire, 61, 1819; *Case v. Redfield*, 4 McLean, 527, 1849; *Black v. Stone*, 33 Alabama, 327, 1858; *Moore v. Bare*, 11 Iowa, 198, 1860; *Turnbull v. Plow Co.*, 6 Bissell, 229, 1874.

⁹⁰ *Brooks v. Byam*, 2 Story, 525, 1843; *Pitts v. Whitman*, 2 Story, 609, 1843; *Boyd v. M'Alpin*, 3 McLean, 427, 1844; *Case v. Redfield*, 4 McLean, 526, 1849; *McKernan*

nor as against an innocent purchaser for a valuable consideration without notice, who takes his assignment within three months after the date of the prior unrecorded assignment;⁹¹ nor as against any subsequent purchaser who had actual notice thereof, when purchasing;⁹² nor as against any subsequent purchaser who paid no valuable consideration for the assignment which he took.⁹³ A merely good consideration will, therefore, not support an assignment as against any prior unrecorded assignment of the same patent, given for a valuable consideration.

The notice which will protect a prior unrecorded assignment, against a subsequent assignment for a valuable consideration, may be actual, or it may be constructive only. Such constructive notice may be based on any fact within the knowledge, or means of knowledge, of the purchaser of the unrecorded assignment, and which fact should logically lead him, upon inquiry, to a knowledge of the existence and purport of that assignment itself.⁹⁴ For example, such constructive notice may be based on any statement of fact of that kind, which is in any paper in the chain of title through which the subsequent assignee derives his own claim.⁹⁵ And such constructive notice may be based on the fact that the subsequent assignee was informed, at the time of his purchase, that the prior assignee was making, using, or selling specimens of the

v. Hite, 6 Indiana, 428, 1855; *Sone v. Palmer*, 28 Missouri, 539, 1859.

⁹¹ *Gibson v. Cook*, 2 Blatch. 144, 1850.

⁹² *Peck v. Bacon*, 18 Connecticut, 377, 1847; *Continental Windmill Co. v. Empire Windmill Co.*, 8

Blatch. 295, 1871; *Ashcroft v. Walworth*, 1 Holmes, 152, 1872.

⁹³ *Saxton v. Aultman*, 15 Ohio State, 471, 1864.

⁹⁴ *Westinghouse Air-Brake Co. v. Chicago Brake & Mfg. Co.*, 85 F. R. 796, 1898.

⁹⁵ *Jonathan Mills Mfg. Co. v. Whitehurst*, 72 F. R. 501, 1896.

invention covered by the patent involved. For such making, using, or selling is such a possession of the invention, as charges all purchasers who are cognizant thereof, with notice of whatever title the maker, user, or seller may possess.⁹⁶ Whether such constructive notice may also be based on the fact that the subsequent purchaser was a corporation in which the assignor was a director, is a question upon which the precedents are now opposing.⁹⁷ Where title has once vested in a subsequent purchaser, for a valuable consideration, without notice of a prior, unrecorded assignment more than three months old; that title becomes absolute and may be purchased by persons who had actual knowledge of the prior assignment.⁹⁸ If this rule were otherwise, titles thus derived might become valueless for want of qualified purchasers.⁹⁹

The foregoing parts of this section contemplate cases where the things covered by several assignments of the same assignors, are unquestionably identical; and where there is no ground for controversy relevant to the respective dates of the conflicting transactions. Where either or both of these circumstances are otherwise, other points of law will also arise. Where, for example, the subsequent assignment purported to convey no more than the right, title, and interest of the assignor, in the specified patent, that assignment can never prevail against any prior unrecorded assignment which left any interest in the

⁹⁶ *Prime v. Mfg. Co.*, 16 Blatch. 455, 1879; *Dueber Watch Case Co. v. Dalzell*, 38 F. R. 597, 1889.

⁹⁷ *Continental Windmill Co. v. Empire Windmill Co.*, 8 Blatch. 295, 1871; *Cutter Co. v. Sheldon*, 10 Blatch. 1, 1872; *Davis Wheel Co. v. Davis Wagon Co.*, 20 F. R. 700, 1884.

⁹⁸ *Wright v. Randel*, 8 F. R. 599, 1881; *National Heeling-Mach. Co. v. Abbott*, 70 F. R. 55, 1895.

⁹⁹ *Varick v. Briggs*, 6 Paige (N. Y.), 329, 1837; *Empire State Nail Co. v. Faulkner*, 55 F. R. 824, 1893.

assignor;¹⁰⁰ if indeed it can prevail against one which left no such interest.¹⁰¹

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;¹⁰² and the three months within which, after that date, an assignment is required to be recorded, are calendar months.¹⁰³

§ 282. Warranty of title is implied in every assignment of a patent right; unless that assignment purports to convey merely the right of the assignor; or unless it is otherwise limited to narrower ground than the entire patent right which it describes. Every such assignment will therefore transfer whatever title the assignor may subsequently acquire by purchase or otherwise.¹⁰⁴ But an assignment of the right, title, and interest of the assignor without anything more, will not operate to convey any title which is subsequently acquired by him.¹⁰⁵

§ 283. No warranty of validity is implied in any assignment of a patent right. If the assignor knows the patent to be invalid, at the time he makes the assignment, he is guilty of fraud, and the assignee may have relief against him, on that ground; but if both parties are equally innocent of knowledge of invalidity, the loss consequent on any

¹⁰⁰ *Brown v. Jackson*, 63 Wheaton, 449, 1818; *Ashcroft v. Walworth*, 1 Holmes, 152, 1872; *Turnbull v. Plow Co.*, 6 Bissell, 230, 1874; *Regan Vapor Engine Co. v. Pacific Gas Engine Co.*, 47 F. R. 513, 1891.

¹⁰¹ *Oliver v. Piatt*, 3 Howard, 363, 1845; *May v. Le Claire*, 11 Wallace, 232, 1870.

¹⁰² *Dyer v. Rich*, 1 Metcalf (Mass.), 180, 1840.

¹⁰³ *Guaranty Trust Co. v. Railroad Co.*, 139 U. S. 145, 1890.

¹⁰⁴ *Sherman v. Champlain Transportation Co.*, 31 Vt. 175, 1858; *Faulks v. Kamp*, 17 Blatch. 433, 1880; *Brush Electric Co. v. California Electric Light Co.*, 52 F. R. 963, 1892.

¹⁰⁵ *Perry v. Corning*, 7 Blatch. 195, 1870.

invalidity afterward brought to light, must fall upon the then owner of the patent.¹⁰⁶

Some State courts have held that, when sued by an assignor for the purchase price of a patent, any assignee may defend on any ground of invalidity which he can prove to exist. This view is based on the theory that in such a case there is a failure of consideration. This theory is not correct, because an assignor may lose, and an assignee may gain as much on account of the assignment of an invalid patent as on account of a valid one. An assignment of an invalid patent is a sufficient consideration to support a promissory note, in any case where there is neither warranty nor fraud.¹⁰⁷ To allow an assignee, who has made profit from the patent assigned, to defend against a suit for the promised price, on the ground of some defect he has been able to discover in the patent, would be unjust.¹⁰⁸ Such a rule might enable an assignee to reap enormous gains from practically exclusive rights, and then to avert payment for those rights, on some far-fetched ground of invalidity, which never for one moment had disturbed his exclusive possession of the patented privilege. Even where an assignee is not shown to have derived any benefit from the assignment of a particular patent, he ought not to be permitted to defend against a suit for the price he promised to pay therefor; because that assignment operated, at least to prevent the assignor from making, using, or selling specimens of the patented thing. It is perfectly well settled that loss or disadvantage to the promisee, is a sufficient consideration to support a con-

¹⁰⁶ *Hiatt v. Twomey*, 1 *Devereux & Battle's Equity Cases* (N. C.), 315, 1836; *Cansler v. Eaton*, 2 *Jones' Equity Cases* (N. C.), 499, 1856.

¹⁰⁷ *Thomas v. Quintard*, 5 *Duer* (N. Y.), 80, 1855.

¹⁰⁸ *Milligan v. Mfg. Co.*, 21 *F. R.* 570, 1884.

tract, even where that contract resulted in no benefit to the promisor.¹⁰⁹

§ 284. Express warranties of validity may be incorporated in assignments of patents; and where so incorporated, they will subject assignors to actions for damages, if the patents assigned are found to be in fact invalid.¹¹⁰ Parol warranties of validity, when they accompany written assignments of patents, are inadmissible as foundations for actions for damages based on alleged invalidity of those patents;¹¹¹ but such parol statements may be admissible as aiding to prove fraud, in a case where other evidence shows that the assignor knew the patent to be invalid when he made the assignment.¹¹² In such a case, however, the assignee's right of action rests upon the fraud and not upon the parol warranty.¹¹³

§ 285. Equitable titles to patent rights may arise in different ways. Such a title accrues to an assignee when a patent is granted to an inventor,¹¹⁴ or to a subsequent assignee chargeable with notice,¹¹⁵ for an invention made or completed or patented, after the execution of an assignment adapted to convey it; and a document which conveys a patent, and which also purports to convey all improvements on the invention covered thereby, which may thereafter be made by the assignor, is an example

¹⁰⁹ Parsons on Contracts, Book 2, Ch. 1, Section 2.

¹¹⁰ Wright *v.* Wilson, 11 Richardson (S. C. Law Reports), 151, 1856.

¹¹¹ Van Ostrand *v.* Reed, 1 Wendell (N. Y.), 432, 1828; Jolliffe *v.* Collins, 21 Missouri, 341, 1855.

¹¹² McClure *v.* Jeffrey, 8 Indiana, 83, 1856.

¹¹³ Rose *v.* Hurley, 39 Indiana, 78, 1872.

¹¹⁴ Littlefield *v.* Perry, 21 Wallace, 226, 1874; Nesmith *v.* Calvert, 1 Woodbury & Minot, 34, 1845; Continental Windmill Co. *v.* Empire Windmill Co., 8 Blatch. 295, 1871.

See Section 274.

¹¹⁵ Pontiac Boot Co. *v.* Merino Shoe Co., 31 F. R. 286, 1887.

of such an assignment.¹¹⁶ An improvement on an invention covered by a patent, may be an addition thereto, which is adapted to increase its value. Or it may be a substitute therefor, which is adapted to supplant it entirely, by performing its function more efficiently or more inexpensively.¹¹⁷

An equitable title accrues to an inventor when a patent is granted to his assignee, in pursuance of an assignment, which was accompanied by a contract providing that the assignee should pay to the inventor all or some portion of the proceeds of the patent.¹¹⁸ Such a title accrues to an assignee of a term for years, in a patent right, if that term is limited to expire before the expiration of the existing term of the patent.¹¹⁹ Such a title accrues to a consolidated corporation in patents owned by its constituent corporations.¹²⁰ Such a title accrues to an employer, where an employee makes an invention in pursuance of a contract to invent for that employer;¹²¹ but in order that the employer may acquire such title the employment must be specifically for the purpose.^{121 a} Such a contract may be an oral one, and not be within the statute of frauds.¹²² And such a title will doubtless arise out of any contract which purports to give a person a beneficial

¹¹⁶ *Aspinwall Mfg. Co. v. Gill*, 32 F. R. 699, 1887.

See Section 592, *post*.

¹¹⁷ *Westinghouse Air-Brake Co. v. Chicago Brake & Mfg. Co.*, 85 F. R. 790, 1898.

¹¹⁸ *Sayles v. Dubuque & Sioux City Railroad Co.*, 5 Dillon, 563, 1878.

¹¹⁹ *Cook v. Bidwell*, 8 F. R. 452, 1881.

¹²⁰ *Edison Electric Light Co. v.*

New Haven Electric Co., 35 F. R. 236, 1888.

¹²¹ *Bonsack Mach. Co. v. Hulse*, 57 F. R. 523, 1893; *Hulse v. Bonsack Mach. Co.*, 65 F. R. 864, 1894.

^{121 a} *Johnson Furnace & Engineering Co. v. Western Furnace Co.*, 178 F. R. 819, 1910.

¹²² *Dalzell v. Dueber Mfg. Co.*, 149 U. S. 320, 1893.

interest in a patent right; but which does not amount to an assignment or grant of legal title, nor to a license to make, to use, or to sell the invention. So also, any facts which would create a constructive or a resulting trust, if they related to other kinds of intangible personal property, will doubtless have the same effect upon property in patents when they relate thereto. And finally, an equitable title may arise to unspecified persons, when a patent is assigned to some specified person as trustee, without any statement in the assignment, of the character of the trust, or of the identity of the beneficiaries thereof.¹²³ In such a case, both those points can be established by parol evidence, and the equitable title of the beneficiaries may thereupon be enforced against the trustee.¹²⁴

§ 286. In whatever way an equitable title to a patent right may have arisen, it can be translated into a legal title in a proper case,¹²⁵ by means of a bill for specific performance of contract or other action in equity;¹²⁶ and where no affirmative relief is sought by the holder of an equitable title to a patent, such a title will be upheld by a court of equity, as against all claims made under the naked legal title.¹²⁷ But if the holder of the legal title assigns the patent to a purchaser for a valuable consideration, without notice of the equitable title, such a purchaser will take the entire ownership of the patent, freed from the prior equitable encumbrance.¹²⁸ One district judge has

¹²³ *National Heeling-Mach. Co. v. Abbott*, 70 F. R. 54, 1895.

¹²⁴ *Railroad Co. v. Durant*, 95 U. S. 576, 1877.

¹²⁵ *Kennedy v. Hazelton*, 128 U. S. 667, 1888; *Westinghouse Air-brake Co. v. Chicago Brake & Mfg. Co.*, 85 F. R. 796, 1898.

¹²⁶ *Hapgood v. Rosenstock*, 23 F. R. 87, 1885; *New York Paper Bag Machine Co. v. Union Paper Bag Machine Co.*, 32 F. R. 783, 1887.

¹²⁷ *Cook v. Sterling Electric Co.*, 118 F. R. 47, 1902.

¹²⁸ *Hendrie v. Sayles*, 98 U. S. 549, 1878.

decided this point the other way, holding that the maxim *caveat emptor* applies to such a case.¹²⁹ But that decision was rendered before that in *Hendrie v. Sayles*; and was made in evident forgetfulness of the really applicable maxim that, "between equal equities the law will prevail;" and of the well-established doctrine, that, if a purchaser for a valuable consideration, without notice of a prior equitable right, obtains a legal title at the time of his purchase, he will be entitled to priority in equity, as well as in law.¹³⁰ The maxim of *caveat emptor* applies where a seller has no title whatever.¹³¹ When a seller has the legal title, but not the equitable, then the other maxim governs the rights of assignees. But the first of two purely equitable assignments will prevail over the second, whether the taker of the second had notice of the other or not.¹³²

§ 287. A grant, from one person to another, of a patent right, is a conveyance in writing of the entire right, or of an undivided interest therein, within and throughout a certain specified portion of the territory of the United States.¹³³ The title to the subject-matter of letters patent is not divisible in any other category than a territorial one;¹³⁴ and therefore grants cannot be made to convey one of several inventions covered by a patent;¹³⁵ nor to convey an exclusive right to make, use and sell a patented

¹²⁹ *Consolidated Fruit Jar Co. v. Whitney*, 2 Bann. & Ard. 385, 1876.

¹³⁰ *Bispham's Principles of Equity*, Section 40; *McMichael & Wildman Mfg. Co. v. Ruth*, 128 F. R. 706, 1904.

¹³¹ *Abbett v. Zusi*, 5 Bann. & Ard. 38, 1879.

¹³² *Farrison v. Morton*, 83 Md. 747, 1896.

¹³³ *Gayler v. Wilder*, 10 Howard, 494, 1850; *Moore v. Marsh*, 7 Wallace, 521, 1868; *Littlefield v. Perry*, 21 Wallace, 219, 1874.

¹³⁴ *Goodyear v. Railroad Co.*, 1 Fisher, 627, 1853; *Suydam v. Day*, 2 Blatch. 21, 1846; *Washing Machine Co. v. Earle*, 3 Wallace, Jr., 320, 1861.

¹³⁵ *Pope Mfg. Co. v. Gormully Mfg. Co.*, 144 U. S. 250, 1892.

invention for one of several purposes to which it is applicable. The rules which relate to the form, authentication, construction, revocation, reformation and effect of assignments, refer with equal force to grants; except as otherwise stated or implied in this section, and except as the explained nature of a grant clearly indicates otherwise. In addition to those rules, there are several which refer to grants and not to assignments; and to the latter it is now in order to attend.

A grant is not void for ambiguity where it purports to convey all of the territory of the United States except a number of counties theretofore conveyed to others, but not specified in the grant; because the reservation is such an one as is capable of being made certain by competent evidence.¹³⁶ It is not inconsistent with the character of a document as a grant, that it contains a clause of forfeiture in case of non-payment of royalties, or a clause providing that the grantor shall prosecute and defend suits relating to the exclusive right granted.¹³⁷ And a grant is not forfeited by failure to pay a royalty; or to keep some other promise made by the grantee therein, unless the grant provides that such a failure shall work such a forfeiture.¹³⁸ Nor is it inconsistent with a grant that it is subject to an outstanding license;¹³⁹ or that the document limits the exercise of the exclusive right to the making, using and selling of a particular number of specimens of the patented invention involved.¹⁴⁰ But no instrument

¹³⁶ Washburn & Moen Mfg. Co. v. Haish, 4 F. R. 908, 1880.

¹³⁷ Littlefield v. Perry, 21 Wallace, 220, 1874.

¹³⁸ Atkins v. Park, 61 F. R. 957, 1894.

¹³⁹ Russell v. Kern, 58 F. R. 384, 1893.

¹⁴⁰ Wilson v. Rousseau, 4 Howard, 646, 1846; Waterman v. Mackenzie, 138 U. S. 256, 1891; Washburn v. Gould, 3 Story, 122, 1844; Ritter v. Serrell, 2 Blatch. 379, 1852.

can be a grant which reserves a right to the grantor to make, but not to sell or use,¹⁴¹ or to sell, but not to make or use,¹⁴² specimens of the patented thing, within the territory covered by the instrument.

§ 288. A grant of an exclusive right to make, use, and sell a particular patented invention, within a particular part of the United States, confers the right to use and sell, anywhere within the United States, those specimens of that invention which are made and sold under the grant, and within the territory covered thereby.¹⁴³ And an agreement between owners, not to permit any sale or use of the subject of their patent, in the territory of each other, is not binding upon purchasers of the patented articles, from either of those owners, even where the purchasers knew of the agreement.¹⁴⁴

A lawful sale in a foreign country, of an article patented in that country, and also in the United States, does not authorize the use or sale in the United States of the article thus sold in the foreign country,¹⁴⁵ even though the maker and seller in the foreign country had the right from the United States patentee to there make and sell, and the article is used only for personal use and not for profit.¹⁴⁶ And a patentee owning a United States patent, and also a patent of some foreign country, on the same article, may couple his sales of that article in any foreign country, with a restriction prohibiting its importation into the United States; and that restriction will be binding upon

¹⁴¹ *Waterman v. Mackenzie*, 138 U. S. 256, 1891.

¹⁴² *Pitts v. Jameson*, 15 Barbour (N. Y. Supreme Court), 315, 1853.

¹⁴³ *Adams v. Burke*, 17 Wallace, 453, 1873; *Hobbie v. Jennison*, 149

U. S. 355, 1893; *Keeler v. Folding Bed Co.*, 157 U. S. 659, 1895.

¹⁴⁴ *Jackson v. Vaughan*, 73 F. R. 837, 1896.

¹⁴⁵ *Boesch v. Graff*, 133 U. S. 703, 1890.

¹⁴⁶ *Daimler Mfg. Co. v. Conklin*, 170 F. R. 70, 1909.

all persons in the United States who have knowledge or other notice thereof.¹⁴⁷

§ 288a. A mortgage may be executed to cover an entire patent, or an undivided part thereof; or the entire right, or an undivided interest therein, within a certain specified part of the United States. And the due recording of such a mortgage in the Patent Office makes the title of the mortgagee complete; so that he is entitled to grant licenses, receive royalties, bring suits against infringers, and recover profits or damages from them, as long as his mortgage continues in force; and it will continue in force until it is ended by a payment of the debt secured thereby, at the time provided for therein, or by redemption, on a bill in equity, within a reasonable time thereafter.¹⁴⁸ But such a mortgage will not affect an outstanding license, particularly where the mortgagee is chargeable with notice thereof.¹⁴⁹

§ 289. A creditor's bill may operate to transfer a complete title, or an equitable title, to a patent right, whenever a judgment is obtained against its owner, and an execution issued on that judgment is returned *nulla bona*; and the court in which the creditor's bill is filed may appoint a trustee or master to execute a proper assignment.¹⁵⁰ But a suit, instituted by the filing of such a bill, is not a patent suit in such a sense as to confer jurisdiction on a Federal court.¹⁵¹ Where jurisdiction is not conferred upon such a court by variant citizenship, or other cause known to the law, it will be necessary to proceed in some court of

¹⁴⁷ Dickerson *v.* Matheson, 57 F. R. 524, 1893; Dickerson *v.* Tinling, 84 F. R. 192, 1897.

¹⁴⁸ Waterman *v.* Mackenzie, 138 U. S. 256, 1891.

¹⁴⁹ Waterman *v.* Shipman, 55 F. R. 984, 1893.

¹⁵⁰ Ager *v.* Murray, 105 U. S. 126, 1881; Wilson *v.* Fire Alarm Co., 151 Mass. 515, 1890.

¹⁵¹ Ryan *v.* Lee, 10 F. R. 917, 1882.

a State. In such of the States as have preserved equity pleadings and proceedings, a creditor's bill is the proper document to file in such a court, when pursuing such relief; but in the States which have adopted codes of civil procedure, in place of the common law and equity plans of judicature, the end in view may be reached by proceedings supplementary to executions.¹⁵² Or where the unsatisfied judgment was entered for costs against an unsuccessful patentee, his patents may be reached and sold to raise money to pay that judgment, by means of a petition in the same suit in which it was entered.¹⁵³

§ 290. Adjudication of bankruptcy and appointment and qualification of the trustee of the estate of a bankrupt, operates, under the bankrupt law of 1898, to vest in such trustee, and his successor and successors if he shall have any, whatever title the bankrupt had, in any patent or patent right or right of action thereunder, at the date on which he was adjudged a bankrupt.¹⁵⁴ The rights so acquired include any estoppel which may have existed in the bankrupt's favor against his assignor,¹⁵⁵ as is likewise true in the case of a purchase from a receiver, at least when the suit in which the receiver was appointed was instigated by the person against whom the estoppel is invoked.¹⁵⁶ The bankrupt law of 1867, excepted from the corresponding transfer of property, which was provided for by that law, all patents and other property held in trust by the bankrupt;¹⁵⁷ but the bankrupt law

¹⁵² *Pacific Bank v. Robinson*, 57 California, 522, 1881; *Newton v. Buck*, 77 F. R. 615, 1896.

¹⁵³ *Maitland v. Gibson*, 79 F. R. 136, 1897.

¹⁵⁴ 30 Statutes at Large, p. 565, Ch. 541, Section 70. But see the Bankruptcy Act of 1910 and L. E.

Waterman Co. v. Kline, 234 F. R. 891, 1916.

¹⁵⁵ *Fishel Nessler Co. v. Fishel & Co.*, 204 F. R. 790, 1913.

¹⁵⁶ *Schiebel Toy & Novelty Co. v. Clark*, 217 F. R. 760, 1914.

¹⁵⁷ Revised Statutes, Section 5053.

of 1898 contains no such exception. A title to a patent passed to an assignee in bankruptcy, under the law of 1867, subject to his election not to accept it, if in his opinion it was worthless, or would be burdensome and unprofitable.¹⁵⁸ And it is probable that the same rule will be adjudged to be applicable to the bankrupt law of 1898. Under the latter statute a pending application is neither a "patent right" within the meaning of clause 2 of the statute, nor "property" within the meaning of clause 5 thereof and so does not pass to the trustee.¹⁵⁹

Corresponding proceedings in insolvency under State laws, do not have the operation of bankruptcy proceedings in this particular. They do not confer upon the assignee in insolvency any legal title to the patent rights of the insolvent.¹⁶⁰ But a State court which has jurisdiction of such proceedings may compel the insolvent to execute such an assignment to the assignee in insolvency, as will convey the same rights to the latter, as those which, without such a document, are conveyed to a trustee in bankruptcy under the bankrupt law of 1898;¹⁶¹ for a State may subject the patent rights of an insolvent citizen, to the payment of his debts.¹⁶²

And the title to the patents of dissolved corporations will generally pass, under the operation of State laws, to the receivers, or other officials who are appointed to wind up their affairs.¹⁶³

¹⁵⁸ *Sessions v. Romadka*, 145 U. S. 37, 1892.

¹⁵⁹ *In re Dann*, 129 F. R. 495, 1904. But see *In re Myers v. Wolf Mfg. Co.*, 205 F. R. 289, 1913.

¹⁶⁰ *Ashcroft v. Walworth*, 1 Holmes, 154, 1872; *McCulloh v. Association*, 45 F. R. 479, 1891;

Newton v. Buck, 72 F. R. 780, 1896.

¹⁶¹ *Ager v. Murray*, 105 U. S. 131, 1881; *Jewett v. Atwood Suspender Co.*, 100 F. R. 647, 1900.

¹⁶² *Barton v. White*, 144 Mass. 283, 1887.

¹⁶³ *McCulloh v. Association*, 45 F. R. 479, 1891.

§ 291. Death of an inventor, before the grant of a patent for his invention, causes a transfer of his inchoate title to his executor or administrator, in trust for the heirs at law of the deceased in case he dies intestate, or in trust for his devisees in case he leaves a will disposing of the invention.¹⁶⁴ Such an inchoate title has several of the same qualities, in the hands of the executor or administrator, that it had in the hands of the deceased. If it was an unassigned inchoate title in the hands of the inventor, it is likewise so in the hands of his legal representative. If the deceased had parted with the equitable title, and had, at his death, only the inchoate legal title, the equitable title will be unaffected by the death of the inventor, and will remain the property of its purchaser.¹⁶⁵ So also, if the inventor had parted, prior to his death, with the inchoate legal title, and retained the equitable title, then the latter, and not the former, will devolve upon his executor or administrator.

Death of the owner of any legal or equitable title to a patent right already in existence, causes a transfer of that title to his executor or administrator, in like manner as it causes the transfer of any other intangible personal property of the deceased.¹⁶⁶ Such a legal representative may convey the title by assignment or by grant, by means of any suitable instrument in writing, and in pursuance of such general or special authority from the probate court as is prescribed, in that behalf, by the laws of the particular

¹⁶⁴ Revised Statutes, Section 4896, as amended by Act of May 23, 1908, Chap. 188, Section 4896, 35 Stat. 245; *De La Vergne Mach. Co. v. Featherstone*, 147 U. S. 209, 1893.

¹⁶⁵ *Northwestern Extinguisher*

Co. v. Philadelphia Extinguisher Co., 1 Bann. & Ard. 177, 1874.

¹⁶⁶ *Brooks v. Jenkins*, 3 McLean, 441, 1844; *Hodge v. North Missouri Railroad Co.*, 1 Dillon, 104, 1870; *Shaw Valve Co. v. New Bedford*, 19 F. R. 753, 1884; *Bradley v. Dull*, 19 F. R. 913, 1884.

State whose court that tribunal is.¹⁶⁷ Where there are several joint executors or administrators, the assignment or grant of one of them is legally the assignment or grant of them all;¹⁶⁸ and if an administrator denominates himself an executor, or if an executor calls himself an administrator, in such a document, that document will be none the less efficacious to convey the title which he holds in his true capacity.¹⁶⁹ Where the executor or administrator takes no action relevant to a patent which belonged to him whose estate is being administered, and is discharged after settling the estate; the ownership of the patent devolves on those who are the heirs at law of the deceased.¹⁷⁰

§ 292. Tenancy in common, in a patent right, will arise whenever the sole owner of such a right, in all or in part of the territory of the United States, conveys to another an undivided interest in the whole or in part of the right which he owns. Mutual ownership of the same sort arises when a plurality of persons are joint inventors of a process or thing, for which they obtain a joint patent;¹⁷¹ and also when a plurality of persons obtain, by one assignment or grant, the undivided ownership of a patent, or the undivided ownership of a patent right in a part of the territory of the United States. The ordinary incidents of tenancy in common therefor appertain to such ownership and each owner becomes entitled to use the invention without accounting to the other.¹⁷²

¹⁶⁷ *Brooks v. Jenkins*, 3 McLean, 441, 1844.

¹⁶⁸ *Wintermute v. Redington*, 1 Fisher, 239, 1856.

¹⁶⁹ *Newell v. West*, 13 Blatch. 114, 1875.

¹⁷⁰ *Winkler v. Studebaker Mfg. Co.*, 105 F. R. 190, 1900.

¹⁷¹ *Drake v. Hall*, 220 F. R. 905, 1914.

¹⁷² *Drake v. Hall*, 220 F. R. 905, 1914; *Central Brass & Stamping Co. v. Stuber*, 220 F. R. 909, 1915.

§ 294. One tenant in common of a patent right may exercise that right to any extent he pleases, without the consent of any co-tenant. He may make, use and sell specimens of the patented invention to any extent, and may license others to do so; and neither he nor his licensees can be enjoined from a continuance in so doing.¹⁷³ Nor can any recovery of profits or damages be had against any such licensee at the suit of any co-tenant of any such licensor.¹⁷⁴ And no recovery of profits or damages can be had against one co-tenant who, without the consent of the others, has made, used or sold specimens of the patented thing.¹⁷⁵ It is said that the same rules apply as between two or more joint licensees.¹⁷⁶

But where a patent belonging to tenants in common, has been infringed by a third party, the right of action for that infringement belongs in common to all the owners, and cannot be fully released by either of them alone.¹⁷⁷

Either one of several co-tenants in a patent right may of course sell his right independently of any other;¹⁷⁸ but where joint trustees are appointed to hold the legal title to a patent, and to manage it according to their mutual judgment and discretion, a joint deed of all those trustees is necessary to convey that right to another.¹⁷⁹

¹⁷³ *Clum v. Brewer*, 2 Curtis, 523, 1855; *Aspinwall Mfg. Co. v. Gill*, 32 F. R. 697, 1887; *Grier v. Baynes*, 49 F. R. 367, 1893; *Lalance & Grosjean Mfg. Co. v. National Enameling Co.*, 108 F. R. 78, 1901.

¹⁷⁴ *Dunham v. Railroad Co.*, 7 Bissell, 223, 1876.

¹⁷⁵ *Vose v. Singer*, 4 Allen (Mass.), 232, 1862; *De Witt v. Mfg. Co.*, 5 Hun (N. Y.), 301, 1875; *Whiting v. Graves*, 3 Bann.

& Ard. 225, 1878; *Blackledge v. Weir & Craig Mfg. Co.*, 108 F. R. 71, 1901.

¹⁷⁶ *Rudge-Whitworth v. Houk Mfg. Co.*, 221 F. R. 678, 1914.

¹⁷⁷ *Lalance & Grosjean Mfg. Co. v. Haberman Mfg. Co.*, 93 F. R. 197, 1899; and 107 F. R. 487, 1901.

¹⁷⁸ *May v. Chaffee*, 2 Dillon, 388, 1871.

¹⁷⁹ *Wiscott v. Agricultural Works*, 11 F. R. 302, 1882.

An agreement by a trustee of a patent for the benefit of several beneficiaries of whom the trustee himself is one, to sell the patent cannot be specifically enforced even as to the trustee's own interest, where the object of the creation of the trust was to prevent less than all of the joint owners from conveying the same or granting licenses without the consent of all, and where the vendee had notice of the trust.¹⁸⁰

§ 295. Partition of a patent right, held by tenancy in common, may of course be made by the common consent and mutual action of all the owners of that right; but no such partition can be made against the will of either owner. But equity has jurisdiction to remove a cloud from a title to a patent, where that cloud consists in an express or an implied assertion of adverse ownership or encumbrance.¹⁸¹

¹⁸⁰ *M'Duffee v. Hestonville, M. & F. Pass. Ry Co.*, 162 F. R. 36, 1908.

¹⁸¹ *Dredging Co. v. Miller*, 20 App. D. C. 253, 1902; *Burpee v. Guggenheim*, 226 F. R. 214, 1915.

CHAPTER XII

LICENSES

- 296. Licenses defined and described.
- 297. Express licenses to make, with implied leave to use, or implied leave to sell the things made.
- 298. Express licenses to use, with implied leave to make for use.
- 299. Express licenses to sell, with implied leave to the vendees to use and to sell the things they purchase.
- 300. Licenses to make and use, without implied leave to sell.
- 301. Licenses to make and sell, or to use and sell, with implied leave to the vendees to use and to sell the articles they buy.
- 302. Express licenses so restricted as not to convey implied rights.
- 302*a*. Implied licenses to repair or improve.
- 303. Written and oral licenses.
- 304. Recording and notice.
- 305. Licenses given by one of several owners in common, and licenses given to one of several joint users.
- 306. Construction of licenses.
- 307. Warranty of validity of patent, and eviction.
- 307*a*. Warranty of validity of license.
- 308. Clauses of forfeiture.
- 309. Effects of forfeiture.
- 310. Assignability of licenses.
- 311. Purely implied licenses.
- 312. Implied licenses from conduct, and first by acquiescence.
- 313. Implied license from conduct by estoppel.
- 313*a*. Implied license from employment of inventor.
- 314. Implied license from actual recovery of a full license fee.
- 314*a*. License restrictions on the use and resale of patented articles.
- 314*b*. The patent monopoly an aggregation of rights.
- 314*c*. Specific decisions considered.
- 314*d*. The same subject continued.
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- 314*f*. The same subject continued.
- 314*g*. The same subject continued.
- 314*h*. The same subject continued.
- 314*i*. The Clayton Act.
- 314*j*. The Clayton Act construed.

§ 296. ANY conveyance of a right under a patent, which does not amount to an assignment or to a grant, is a

license,¹ and may be granted at any time after the application for patent is filed.² It is a license, if it does not convey the entire and unqualified monopoly, or an undivided interest therein, throughout the particular territory to which it refers.³ Consistently with this definition, the following have been held to constitute licenses only: an exclusive right to make and sell, but not to use:⁴ an exclusive right to make and use, but not to sell:⁵ an exclusive right to use and sell, but not to make:⁶ an exclusive right to make, to use, and to sell to be used, for certain purposes, but for no other:⁷ and the exclusive conveyance of some, but not all, of the claims of a patent.⁸ "The right to manufacture, the right to sell, and the right to use, are each substantive rights, and may be granted or conferred separately by the patentee."⁹ Any one or two of these rights may be expressly conveyed by a patentee,

¹ See Section 274; *Waterman v. Mackenzie*, 138 U. S. 255, 1891; *Seibert Oil Cup Co. v. Lubricator Co.*, 34 F. R. 221, 1888; *Hatfield v. Smith*, 44 F. R. 355, 1890; *Rice v. Boss*, 46 F. R. 195, 1891; *Standard Button-Fastener Co. v. Ellis*, 159 Mass. 449, 1893; *Ft. Wayne, Cincinnati & Louisville R. R. Co. v. Haberkorn*, 1 Ind. App. 481, 1896; *Kilburn v. Holmes*, 121 F. R. 750, 1903; *Paulus v. M. M'Buck Mfg. Co.*, 129 F. R. 594, 1904.

² *St. Louis Street Flushing Mach. Co. v. Sanitary Street Flushing Mach. Co.*, 178 F. R. 923, 1910.

³ *Gayler v. Wilder*, 10 Howard, 494, 1850; *Sanford v. Messer*, 1 Holmes, 149, 1872; *Hill v. Whitcomb*, 1 Holmes, 321, 1874.

⁴ *Hayward v. Andrews*, 106 U. S. 673, 1882; *Dorsey Rake Co. v. Mfg. Co.*, 12 Blatch. 203, 1874.

⁵ *Mitchell v. Hawley*, 16 Wallace, 544, 1872; *Rice v. Boss*, 46 F. R. 195, 1891.

⁶ *Hamilton v. Kingsbury*, 17 Blatch. 265, 1879; *Brush Electric Co. v. California Electric Light Co.*, 52 F. R. 959, 1892.

⁷ *Gamewell Telegraph Co. v. Brooklyn*, 14 F. R. 255, 1882; *Jaros Underwear Co. v. Fleece Underwear Co.*, 60 F. R. 623, 1894; *De Forest v. Collins Wireless Telephone Co.*, 174 F. R. 821, 1909.

⁸ *Pope Mfg. Co. v. Gormully Mfg. Co.*, 144 U. S. 249, 1892.

⁹ *Adams v. Burke*, 17 Wallace, 456, 1873.

while the other is expressly retained by him. In the absence of express reservation, however, some licenses are extended by implication, so as to convey, not only what they expressly cover, but also some right which is necessary to the full enjoyment of the right expressly conveyed. This practice is not in conflict with the rule which prohibits the enlargement of an instrument in writing by parol evidence; because that rule is directed only against the admission of oral evidence of the language, used by the parties in a contract which was reduced to writing.¹⁰ This practice relates to the legal effect of the language actually written, and is based on that maxim of the common law which prescribes, that any one granting a thing, impliedly grants that, without which, the thing expressly granted would be useless to the grantee.¹¹

§ 297. An express license to make specimens of a patented thing, is without value, unless it implies a right to use, or a right to sell, the specimens made thereunder. It is not to be presumed that a right so nugatory as a bare right to make, was the only subject of a license for which a valuable consideration was paid. Whether the implied right, which accompanies such a license, is a right to use or a right to sell, can best be determined by ascertaining the circumstances which surrounded the giving of the particular license in question. If the licensee was engaged in a business which made it convenient for him to use the thing involved; then the right to use will be implied in preference to the right to sell, because it is the more natural implication in such a case. On the other hand, if the licensee had no occasion to use the thing in

¹⁰ Greenleaf on Evidence, Section 277.

¹¹ Steam Stone Cutter Co. v. Shortsleeves, 16 Blatch. 382, 1879;

Brush Electric Co. v. California Electric Light Co., 52 F. R. 960, 1892.

view, but was engaged in making and selling similar things, for the use of others, then a right to sell will be implied from a right to make.¹² Rights to both use and sell will not be implied from an express license to make, because only one of those rights is necessary to the beneficial enjoyment of such a license. An express license to make specimens of a particular thing, does not imply a license to use a particular patented machine for that purpose, even where the patent on that machine was owned by the licensor, at the time of the license, and even where that machine was then the best known means of making the thing licensed.¹³

§ 298. An express license to use a limited or unlimited number of specimens of a patented article, implies a right to make those specimens, and to employ others to make them, and will protect those others in making them for the use of the licensee.¹⁴ If the license to use, covers a greater length of time than one specimen of the thing to be used will last; then there is an implied right in the licensee to repair or to rebuild that specimen, or to replace it by another specimen made or purchased for that purpose.¹⁵

§ 299. An express license to sell specimens of a patented thing, does not imply any right to make those specimens, if it can be presumed that they may be obtained by purchase; because no person requires any license to enable him to lawfully buy an article covered by any patent.

¹² *Steam Cutter Co. v. Sheldon*, 10 Blatch. 8, 1872.

¹³ *Troy Nail Factory v. Corning*, 14 Howard, 193, 1852.

¹⁴ *Steam Stone Cutter Co. v. Shortsleeves*, 16 Blatch. 381, 1879; *Johnson Signal Co. v. Union Switch & Signal Co.*, 55 F. R. 487, 1893; *Edison Electric Light Co. v.*

Peninsular L. P. & H. Co., 95 F. R. 676, 1899.

¹⁵ *Wilson v. Stolley*, 4 McLean, 275, 1847; *Bicknell v. Todd*, 5 McLean, 236, 1851; *Woodworth v. Curtis*, 2 Woodbury & Minot, 524, 1847; *Steam Cutter Co. v. Sheldon*, 10 Blatch. 8, 1872.

But a license to sell does imply that a right to use and to sell again shall be conferred on the vendees of the licensee, for otherwise no person would buy except for exportation, and sales for exportation are seldom sufficiently practicable to raise a presumption that they alone were contemplated by the parties to a license to sell.

§ 300. A license to make and use does not authorize any sale of the thing so made, nor authorize any purchaser of that thing to use the same.¹⁶ Nor does a sale, coupled with an express license to use, give any right to use after the license has been forfeited or has expired.¹⁷ The purchaser of a patented thing gets no other right to use it than such right as the seller had an express or an implied right to convey.¹⁸ And the purchaser of a thing which is useful only in producing a patented article,¹⁹ or in being combined with other things to constitute a patented article,²⁰ or when used to perform a patented process,²¹ gets thereby no right to use his purchased thing for such a purpose; for such a right would derogate from the exclusive rights of the owner of the patent on that article, combination, or process. But the purchaser of a patented apparatus, from the owner of the patent thereon, acquires whatever right that patent covers, to use that apparatus in accordance therewith, even where it is capable of a different use.²² And a purchaser of an apparatus which

¹⁶ *Wilson v. Stolley*, 3 McLean, 277, 1847.

¹⁷ *Wortendyke v. White*, 2 Bann. & Ard. 25, 1875; *Porter Needle Co. v. National Needle Co.*, 17 F. R. 536, 1883.

¹⁸ *Chambers v. Smith*, 5 Fisher, 14, 1870; *International Pavement Co. v. Richardson*, 75 F. R. 594, 1896.

¹⁹ *Stevens v. Cady*, 14 Howard, 528, 1852; *Stevens v. Gladding*, 17 Howard, 447, 1854; *Elgin Wind Power Co. v. Nichols*, 65 F. R. 220, 1894.

²⁰ *Roosevelt v. Electric Co.*, 20 F. R. 724, 1884.

²¹ *United Nickel Co. v. Electrical Works*, 25 F. R. 479, 1885.

²² *Edison Electric Light Co. v.*

can be used only in connection with a device of a patent owned by the seller acquires an implied license to use the device not only in connection with the apparatus so purchased but also in connection with similar apparatus purchased from other makers.²³

§ 301. A license to make and sell, implies a right in the purchaser to use and to sell again, the thing thus lawfully sold to him. When a specimen of a patented invention is sold with the authority of the owner of the patent which covers it, and without any restriction on the ownership or use of the thing conveyed; that specimen passes out of the exclusive right which is secured by the patent, and may be used as long, or sold as often, as though it had never been subject to a patent.²⁴ This principle, however, goes only to the extent of permitting the unrestricted use of the patented thing in the condition as purchased or acquired and does not permit the purchaser to use any of the parts in union with the parts of another machine and thus construct a new infringing device.²⁵ The same results also follow from a sheriff's sale of a patented article, where that sale was made in pursuance of an execution, issued against the owner of the patent right, and lawfully levied on that article, as the property of that owner.²⁶ Restrictions in respect of methods or purposes of use, and pre-

Peninsular L. P. & H. Co., 101 F. R. 831, 1900.

²³ Thomson-Houston Electric Co. v. Illinois Tel. Const. Co., 152 F. R. 631, 1907.

²⁴ Morgan Envelope Co. v. Albany Paper Co., 152 U. S. 432, 1894; Bloomer v. McQuewan, 14 Howard, 539, 1852; Chaffee v. Belting Co., 22 Howard, 217, 1859; Adams v. Burke, 17 Wal-

lace, 453, 1873; Paper-Bag Cases, 105 U. S. 771, 1881; McKay v. Wooster, 2 Sawyer, 373, 1873; May v. Chaffee, 2 Dillon, 385, 1871; Detweiler v. Voegel, 8 F. R. 600, 1881; Holiday v. Mattheson, 24 F. R. 185, 1885.

²⁵ National Cash Register Co. v. Grobet, 153 F. R. 905, 1907.

²⁶ Wilder v. Kent, 15 F. R. 217, 1883.

scriptions in respect of prices and conditions of leasing or reselling, may properly accompany any sale of a patented article;²⁷ but no such restriction or prescription is operative upon any subsequent purchaser of that article, who had no notice thereof, at the time of his purchase.²⁸

§ 302. Express licenses which, if unrestricted, would convey implied rights, may be so restricted that they will not have that effect.²⁹ A license to make and sell, may be restricted to certain parts of the United States, for the making, and to certain parts for the selling; and may be so restricted as not to cover any making or selling, for export to any foreign country.³⁰ A license to make and use may likewise be restricted to limited territory for either or both of its branches;³¹ and to a limited time as well as a limited territory.³² And a license to use may be restricted in respect of materials operated on,³³ or in any other manner.

§ 302a. A purchaser may repair a patented machine which he has purchased, by replacing broken or worn-out unpatented parts, so long as the identity of the machine is not destroyed,³⁴ provided the machine itself is not an

²⁷ Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co., 77 F. R. 288, 1896; Edison Phonograph Co. v. Kaufmann, 105 F. R. 960, 1901; Cortelyou v. Lowe, 111 F. R. 1005, 1901; Whitson v. Phonograph Co., 18 App. D. C. 573, 1901; Edison Phonograph Co. v. Pike, 116 F. R. 863, 1902; Victor Talking Mach. Co. v. The Fair, 123 F. R. 424, 1903. See Sections 314 *et seq.*

²⁸ Edison Electric Light Co. v. Goelet, 65 F. R. 614, 1894.

²⁹ Hamilton v. Kingsbury, 15

Blatch. 64, 1878; Hamilton v. Kingsbury, 17 Blatch. 264, 1879.

³⁰ Dorsey Rake Co. v. Mfg. Co., 12 Blatch. 204, 1874.

³¹ Wicke v. Kleinknecht, 1 Bann. & Ard. 608, 1874.

³² Mitchell v. Hawley, 16 Wallace, 544, 1872.

³³ Tubular Rivet & Stud Co. v. O'Brien, 93 F. R. 200, 1898.

³⁴ Young v. Foerster, 37 F. R. 203, 1889; Shickle, Harrison & Howard Iron Co. v. St. Louis Car-Coupler Co., 77 F. R. 739, 1896; Thomson-Houston Electric Co. v.

infringement.³⁵ Likewise another who furnishes the repair parts on the order of the purchaser is not liable for infringement in the absence of a license reservation to the patentee to supply such parts.³⁶ The right of him furnishing repair parts is measured by the right of the user to repair.^{36a} And he may improve such a machine for his own peculiar use, by substituting for an unpatented part thereof, a corresponding part originally purchased, or not purchased, from the patentee.³⁷ But no unauthorized person can lawfully engage in the business of reconstructing patented machines for their owners, by omissions and substitutions of parts; where those machines do not require any repair, but are thus changed with a view to their improvement.³⁸ Nor can even an owner of a patented machine lawfully replace any part or combination thereof, which is patented to another person alone.³⁹ And no person acquiring the ownership of mutilated portions of a specimen of a patented thing, can lawfully reconstruct that specimen by adding the missing parts; nor can

H. W. Johns Mfg. Co., 78 F. R. 364, 1896; Alaska Packers' Association v. Pacific Steam Whaling Co., 93 F. R. 672, 1899; and 100 F. R. 462, 1900; Goodyear Shoe Machinery Co. v. Jackson, 112 F. R. 149, 1901; Morrin v. Robert White Eng. Works, 143 F. R. 519, 1905 (see also opinion of court below in 138 F. R. 68); Wagner Typewriter Co. v. F. S. Webster Co., 144 F. R. 405, 1906; F. F. Slocumb & Co. v. A. C. Layman Machine Co., 227 F. R. 94, 1915.

³⁵ Union Special Mach. Co. v. Maimin, 161 F. R. 748, 1908. See Sections 404-407.

³⁶ Morgan Gardner Electric Co. v. Buettner & Shelburne Mach. Co., 203 F. R. 490, 1913; F. F. Slocumb & Co. v. Layman Machine Co., 227 F. R. 94, 1915.

^{36a} National Malleable Castings Co. v. American Steel Foundries, 182 F. R. 626, 1910.

³⁷ Thomson-Houston Electric Co. v. Kelsey Ry. Specialty Co., 75 F. R. 1010, 1896.

³⁸ National Phonograph Co. v. Fletcher, 117 F. R. 149, 1902.

³⁹ Morgan Envelope Co. v. Albany Paper Co., 152 U. S. 435, 1894.

he lawfully use or sell the entire articles when reconstructed.⁴⁰

§ 303. Licenses may be written, or they may be oral.⁴¹ The former have advantages over the latter; because they can be made exclusive, and can usually be proved with more ease and more certainty; and because the latter may sometimes be obnoxious to some State statute of frauds and be rendered non-enforceable, by being non-performable within one year from the dates of their origins.⁴² These points constitute abundant reasons for embodying all such contracts in plain black and white documents, rather than committing them to the "slippery memory of man." And a written license, which purports to be exclusive, will operate as a non-exclusive license, if it was given by one who had authority to give the latter, but not the former kind of license.⁴³ A license is valid, if made before the patent is issued, as well as if made afterward;⁴⁴ and a contract for a license is enforceable as a license, if no formal license is ever given in pursuance of the contract.⁴⁵

§ 304. No license is required to be recorded,⁴⁶ and no

⁴⁰ *American Cotton Tie Co. v. Simmons*, 106 U. S. 89, 1882; *Davis Electrical Works v. Edison Electric Light Co.*, 60 F. R. 276, 1894.

⁴¹ *Jones v. Berger*, 58 F. R. 1007, 1893; *Union Switch & Signal Co. v. Johnson Signal Co.*, 61 F. R. 944, 1894; *Sharpless v. Moseley & Stoddard Mfg. Co.*, 75 F. R. 595, 1896; *Cook v. Sterling Electric Co.*, 150 F. R. 766, 1907; *St. Louis Street Flushing Mach. Co. v. Sanitary Street Flushing Mach. Co.*, 178 F. R. 923, 1910.

⁴² *Buhl v. Stephens*, 84 F. R. 922, 1898.

⁴³ *Union Switch & Signal Co. v. Johnson Signal Co.*, 61 F. R. 943, 1894.

⁴⁴ *Brush Electric Co. v. California Electric Light Co.*, 52 F. R. 963, 1892; *St. Louis Street Flushing Machine Co. v. Sanitary Street Flushing Machine Co.*, 178 F. R. 923, 1910.

⁴⁵ *American Paper Bag Co. v. Van Nortwick*, 52 F. R. 752, 1892.

⁴⁶ *Brooks v. Byam*, 2 Story, 525, 1843; *Consolidated Fruit Jar Co.*

record of a license affects the rights of any person; for a license is good against the world,⁴⁷ whether it is recorded or not,⁴⁸ and a purchaser of a patent takes it subject to all outstanding licenses.⁴⁹ So also, if a license is embodied in two papers, one of which limits the scope of the other, an assignee of the broader document will take subject to the limitations of the narrower, even if he had no notice of its provisions, nor even of its existence. Nor will the fact that the broader document was recorded, and the narrower one unrecorded, alter or affect the operation of this rule.⁵⁰ It follows, that where two licenses conflict, the first must prevail, even though the taker of the second had no notice of the existence of the first; and it also follows that any license will prevail as against the claims of any subsequent assignee or grantee of the patent right involved.⁵¹

§ 305. A license from one of several owners in common of a patent right, is as good as if given by all those owners;⁵² and a license given to one of several joint makers or users of a patented thing is as good as if given to all, if the licensor gives it with the understanding that the thing licensed to be done is to be done jointly, or is to be done by the express licensee on behalf of the other party.⁵³

v. Whitney, 2 Bann. & Ard. 38, 1875; *Buss v. Putney*, 38 N. H. 44, 1859; *Jones v. Berger*, 58 F. R. 1007, 1893; *Ft. Wayne, Cincinnati & Louisville R. R. Co. v. Haberkorn*, 1 Ind. App. 481, 1896.

⁴⁷ *Chambers v. Smith*, 5 Fisher, 14, 1870.

⁴⁸ *Farrington v. Gregory*, 4 Fisher, 221, 1870.

⁴⁹ *Pratt v. Wilcox Mfg. Co.*, 64 F. R. 592, 1893.

⁵⁰ *Hamilton v. Kingsbury*, 17 Blatch. 264 and 460, 1880.

⁵¹ *Continental Windmill Co. v. Empire Windmill Co.*, 8 Blatch. 295, 1871; *New York Phonograph Co. v. Edison*, 136 F. R. 600, 1905.

⁵² *Dunham v. Railroad Co.*, 7 Bissell, 224, 1876; *Paulus v. M. M. Beck*, 129 F. R. 594, 1904.

⁵³ *Bigelow v. Louisville*, 3 Fisher, 603, 1869.

§ 306. The construction of a license in writing depends upon the same general rules as the construction of other written contracts.⁵⁴ For example, it is to be construed in the light of the circumstances which surrounded its execution.⁵⁵ Accordingly, where the owner of several patents licenses a person to make, use or sell a particular class of things which, if made, used or sold without a license, would infringe all those patents, then that license confers a right under them all.⁵⁶ And this is the rule even where the licensor's title accrued to him, after the date of the license.⁵⁷ In the absence of language to the contrary in a license, the royalties provided for therein, are construed as being payable during the lives of the patents to which they respectively relate, and not any longer.⁵⁸ The grant of a "license under said letters" patent conveys the full right to make, use, and sell under the patent, if the license contains no qualifying provisions.^{58a}

§ 307. No warranty of validity of the letters patent is implied in any license given thereunder; and unattended proof of invalidity is therefore no defence to any suit for promised royalties.⁵⁹ As long as a licensee continues to enjoy the benefit of the exclusive right, he must pay the

⁵⁴ *Wetherill v. Zinc Co.*, 6 Fisher, 50, 1872.

⁵⁵ *Burdell v. Denig*, 92 U. S. 722, 1875.

⁵⁶ *Dey v. Stellman*, 1 Fisher, 487, 1859.

⁵⁷ *Pratt v. Wilcox Mfg. Co.*, 64 F. R. 591, 1893.

⁵⁸ *Sproull v. Pratt & Whitney Co.*, 101 F. R. 265, 1900; and 108 F. R. 963, 1901.

^{58a} *Buffalo Specialty Co. v.*

Indiana Rubber & I. Wire Co., 234 F. R. 334, 1916.

⁵⁹ *Birdsall v. Perego*, 5 Blatch. 251, 1865; *Sargent v. Larned*, 2 Curtis, 340, 1855; *Marsh v. Dodge* 4 Hun (N. Y.), 278, 1875; *Bartlett v. Holbrook*, 1 Gray (Mass.), 118, 1854; *Marston v. Sweet*, 66 N. Y. 207, 1876; *Pope Mfg. Co. v. Owsley*, 27 F. R. 105, 1886; *Marsh v. Harris Mfg. Co.*, 63 Wis. 283, 1885; *Moore v. National Boiler Co.*, 84 F. R. 347, 1897.

royalty which he promised to pay, and he cannot escape from so doing by offering to prove the patent to be void.⁶⁰ It has been held, however, that a licensee may purchase a patent which was pending in the Patent Office at the time of issuance of the patent under which the license was granted and that he may assert the patent so purchased against the licensor even though by so doing he proves the former invalid by reason of anticipation.⁶¹ The licensee must pay the promised royalty, not only on the exact invention claimed in the patent, but also on whatever is near enough like that invention to infringe the patent.⁶² Nor can a licensee renounce his license without the consent, acquiescence or fault of the licensor;⁶³ but a false representation by the licensor to the licensee, of the rate of the royalty paid by other licensees, is such a fault as will entitle the licensee to renounce his license.⁶⁴ A license implies that the licensee shall not be evicted from its enjoyment, and such an eviction is a defence to a suit for royalties accruing after it occurred.⁶⁵

Such an eviction occurs whenever the patent is adjudged void in an interference suit prosecuted in equity in pursuance of Section 4618 of the Revised Statutes, or whenever the patent is repealed by the decree of a court in which an action is brought by the United States for that purpose,⁶⁶

⁶⁰ *Burr v. Duryee*, 2 Fisher, 285, 1862; *Deane v. Hodge*, 35 Minn. 153, 1886; *Godell v. Wells & French Co.*, 70 F. R. 319, 1895; *Holmes, Booth & Haydens v. McGill*, 108 F. R. 238, 1901.

⁶¹ *Victor Talking Machine Co. v. Am. Graphophone Co.*, 189 F. R. 359, 1911. See section 362a.

⁶² *St. Paul Plow Works v. Starling*, 140 U. S. 195, 1891.

⁶³ *St. Paul Plow Works v. Starling*, 140 U. S. 195, 1891.

⁶⁴ *Hat-Sweat Mfg. Co. v. Waring*, 46 F. R. 106, 1891; *Hat-Sweat Mfg. Co. v. Porter*, 46 F. R. 757, 1891.

⁶⁵ *White v. Lee*, 14 F. R. 791, 1882.

⁶⁶ *McKay v. Smith*, 39 F. R. 557, 1889.

or whenever the patent is held to be void in a suit based on its infringement.⁶⁷

Such eviction also occurs whenever the licensee is enjoined from acting under it at the suit of the owner of a senior patent;⁶⁸ and, by parity of reasoning, it occurs whenever a judgment or decree is obtained by the owner of a senior patent, against the licensee, for an infringement which consisted of acting under the license, but not when such a suit is merely proposed to be brought by the owner of a senior patent.⁶⁹

While such an eviction might possibly be held to occur whenever the patent is defied by unlicensed persons, so extensively and so successfully as to deprive the licensee of the benefit of his share in the exclusive right which it was supposed to secure, a single successful defiance is not enough to constitute such an eviction.⁷⁰ Nor does such an eviction result from the patentee granting later licenses at lower rates.⁷¹

In the absence of an express warranty of validity of a patent, from a license given thereunder; the licensor, when sued by the licensee for damages on account of having violated the license, by granting a competing license or by not suing an infringer, may prove his patent to be void, as relevant to the amount of damages suffered by the licensee, by reason of the breach.⁷²

§ 307*a*. An implied warranty of validity of the license itself, is appurtenant to every license given under a pat-

⁶⁷ *Ross v. Fuller & Warren Co.*, 105 F. R. 510, 1900.

⁶⁸ *Pacific Iron Works v. Newhall*, 34 Connecticut, 67, 1867.

⁶⁹ *American Electric Co. v. Consumers' Gas Co.*, 47 F. R. 43, 1891; *Consumers' Gas Co. v. Electric Co.*, 50 F. R. 778, 1892.

⁷⁰ *Pope Mfg. Co. v. Owsley*, 27 F. R. 100, 1886.

⁷¹ *McKay v. Smith*, 39 F. R. 557, 1889; *National Rubber Co. v. Rubber Shoe Co.*, 41 F. R. 48, 1890.

⁷² *Jackson v. Allen*, 120 Mass. 78, 1876.

ent; and therefore the licensor cannot repudiate the license, on the ground that he had no authority to execute it, at the time he did, even where that fact was known to the licensor at that time.⁷³ This implied warranty of validity of a license, will render the licensor liable to an injunction, if he presumes to employ the patented invention in any way covered by the license; and it will operate to confer upon the licensee, the benefit of any estate which the licensor may afterward acquire in the patent, so far as that benefit would have been appurtenant to the license, if that estate had belonged to the licensor, at the time he executed the license.

§ 308. A license not expressly limited in duration, continues till the patent expires,⁷⁴ or the license is surrendered in pursuance of its own provision,⁷⁵ or is terminated by a new agreement,⁷⁶ or is forfeited by the licensee.⁷⁷

Forfeiture of a license does not follow from the single fact that the licensee has broken covenants which were made by him when accepting the license;⁷⁸ unless the parties expressly agreed that such a forfeiture should follow such a breach.⁷⁹ For example, in the absence of

⁷³ *Seal v. Beach*, 113 F. R. 831, 1901.

⁷⁴ *Sproull v. Pratt & Whitney Co.*, 101 F. R. 265, 1900; and 108 F. R. 963, 1901.

⁷⁵ *Stimpson Computing Scale Co. v. W. F. Stimpson Co.*, 104 F. R. 893, 1900.

⁷⁶ *American Street Car Advertising Co. v. Jones*, 122 F. R. 808, 1903.

⁷⁷ *St. Paul Plow Works v. Starling*, 140 U. S. 195, 1891.

⁷⁸ *Chadeloid Chemical Co. v. Johnson*, 203 F. R. 993, 1913.

⁷⁹ *White v. Lee*, 5 Bann. & Ard. 572, 1880; *Consolidated Purifier Co. v. Wolf*, 28 F. R. 814, 1886; *Densmore v. Tanite Co.*, 32 F. R. 544, 1887; *Seibert Oil Cup Co. v. Lubricator Co.*, 34 F. R. 221, 1888; *Hammacher v. Wilson*, 26 F. R. 241, 1886; *Washburn & Moen Mfg. Co. v. Wire Fence Co.*, 42 F. R. 675, 1890; *Brush Electric Co. v. California Electric Light Co.*, 52 F. R. 964, 1892; *Platt v. Fire Extinguisher Mfg. Co.*, 59 F. R. 900, 1894.

such an agreement, a mere non-payment of a license fee does not entitle a party to a decree of annulment.⁸⁰ And even where such an agreement is made, it will not always be enforced by the courts, and will never be self-enforcing.⁸¹ For example, non-payment of royalty on the very day it becomes due, will not work a forfeiture, if that non-payment arose from lack of certainty relative to the place of payment, and from lack of demand from the licensor.⁸² Nor will forfeiture result from the fact that in a suit by the owner of the patent against a third person, the licensee appeared and filed briefs in aid of the defendant.⁸³ Nor will forfeiture of a license result from the fact that the licensee has infringed the patent by doing acts, with the invention, which were unauthorized by the license. The license will not protect him in such doings, but it will continue to protect him in doing the acts which it did authorize.⁸⁴ Indeed, forfeitures are not favored by the law; and courts are always prompt to seize upon any circumstance which indicates an agreement or an election to waive one;⁸⁵ and an injunction will issue to prevent a threatened wrongful declaration of forfeiture.⁸⁶

⁸⁰ *Wagner Typewriter Co. v. Watkins*, 84 F. R. 62, 1897; *Foster Hose Supporter Co. v. Taylor*, 184 F. R. 71, 1911; *Rowland v. Biesecker*, 185 F. R. 515, 1911.

⁸¹ *Standard Dental Mfg. Co. v. National Tooth Co.*, 95 F. R. 294, 1899; *Hanifen v. Lupton*, 95 F. R. 470, 1899; *Chadeloid Chemical Co. v. Johnson*, 203 F. R. 993, 1913; *Foster Hose Supporter Co. v. Taylor*, 180 F. R. 994, 1910 (see appeal); *contra*, *Foster Hose Supporter Co. v. Taylor*, 184 F. R. 71, 1911.

⁸² *Dare v. Boylston*, 6 F. R. 493, 1880.

⁸³ *Comptograph Co. v. Burroughs Adding Machine Co.* (containing discussion of question of forfeiture of licenses), 175 F. R. 792, 1909 (affirmed with opinion in 183 F. R. 321, 1910).

⁸⁴ *Wood v. Wells*, 6 Fisher, 383, 1873; *Steam Cutter Co. v. Sheldon*, 10 Blatch. 1, 1872.

⁸⁵ *Insurance Co. v. Eggleston*, 96 U. S. 572, 1877.

⁸⁶ *Baker Mfg. Co. v. Washburn & Moen Mfg. Co.*, 18 F. R. 172,

A surrender of a license in pursuance of its own provision, restores the parties to their former relation, and enables the licensee to thereafter act in respect of the patent, with the rights and responsibilities of strangers to the licensor.⁸⁷ And a termination of a license by a new agreement will end or will modify the relation of the parties to the license, according to the provisions of the new agreement.

At any rate where the license does not contain a forfeiture clause the owner may sue his licensee for infringement only on a showing that the license has terminated by mutual consent or that it has been forfeited by decree of a court. It is not open to the owner of the patent to prove in an infringement suit in which such a license is involved, the fact that the licensee has committed such a breach as would entitle the owner to forfeiture if the question came before a court of equity in a direct proceeding brought for that purpose.⁸⁸

§ 309. Where a license is really forfeited, and the licensee continues to work under it as though it were still in force, the licensor has an option to sue him as an infringer, or to sue him for the promised royalties.⁸⁹ If he selects the first of these remedies, the act of the owner of the patent is regarded as a repudiation of the license, and the license being at an end and the contractual relation having ceased, the infringer may interpose any defence

1883. See *Dixie Cotton Picker Co. v. Bullock*, 188 F. R. 921, 1911, wherein the court discusses various considerations bearing upon the question of right to forfeiture.

⁸⁷ *Stimpson Computing Scale Co. v. W. F. Stimpson Co.*, 104 F. R. 893, 1900.

⁸⁸ *American Graphophone Co. v.*

Victor Talking Machine Co., 188 F. R. 431, 1911.

⁸⁹ *Woodworth v. Weed*, 1 Blatch. 166, 1846; *Cohn v. Rubber Co.*, 3 Bann. & Ard. 572, 1878; *Union Mfg. Co. v. Lounsbury*, 42 Barbour (N. Y.), 125, 1864; *Starling v. Plow Works*, 32 F. R. 290, 1887.

that he could have set up in the absence of a license.⁹⁰ An exception is where the licensee continues to hold forth to the public by marking the articles with the patented stamp that he is manufacturing under the patent.⁹¹ And similarly where the license contained an agreement of the licensee not to contest the validity of the patent⁹² the licensee is estopped for the life of the patent. And when such a covenant is made, the estoppel continues for the full term of the patent as expressed therein, even though the patent may in fact expire before that time by reason of the expiration of a foreign patent for the same invention.⁹³ If the licensor selects the second of the remedies mentioned, he must sue at law;⁹⁴ except where he sues an assignee of the licensee for royalties accruing before the assignment, in which case the action for their recovery must be brought in equity.⁹⁵ Wherever the licensor sues for the promised royalties, the defendant may introduce evidence of the prior art, to guide the court to the construction of the patent, and thus to aid in the ascertain-

⁹⁰ *Woodworth v. Cook*, 2 Blatch. 150, 1850; *Burr v. Duryce*, 2 Fisher, 283, 1862; *Brown v. Lapham*, 27 F. R. 77, 1886; *Antisdel v. Chicago Hotel Cabinet Co.*, 89 F. R. 311, 1898; *Tate v. Baltimore & Ohio Railroad*, 229 F. R. 141, 1915.

⁹¹ *Regina Music Box Co. v. Newell*, 131 F. R. 606, 1904.

⁹² *Dunham v. Bent*, 72 F. R. 60, 1885; *Philadelphia Creamery Supply Co. v. Davis & Rankin Bldg. & Mfg. Co.*, 77 F. R. 879, 1896; *Consolidated Rubber Tire Co. v. Finlay Rubber Tire Co.*, 116 F. R. 638, 1902.

⁹³ *United Shoe Mach. Co. v. Caunt*, 154 F. R. 239, 1904; *New York Phonograph Co. v. National Phonograph Co.*, 163 F. R. 534, 1908.

⁹⁴ *Consolidated Purifier Co. v. Wolf*, 28 F. R. 816, 1886; *Crandall v. Plano Mfg. Co.*, 24 F. R. 738, 1885; *Washburn & Moen Mfg. Co. v. Freeman Wire Co.*, 41 F. R. 410, 1890; *Washburn & Moen Mfg. Co. v. Barbed Wire Co.*, 42 F. R. 675, 1890.

⁹⁵ *Goodyear Shoe Machinery Co. v. Dancel*, 119 F. R. 692, 1902.

ment of the extent of those doings of the licensee, which are subject to the payment of royalties.⁹⁶

Where a license to make and sell patented articles, conferred also a right to designate those articles by an arbitrary identifying name, a forfeiture of the license, will disentitle the licensee to use that name to designate competing articles.⁹⁷

§ 310. No license is assignable by the licensee to another, unless it contains words which show that it was intended to be assignable.⁹⁸ The most suitable phrase with which to express such an intention, would include the word "assigns"; but in one case it was held that the words "legal representatives" would answer the purpose, because the license fairly indicated that the parties understood that phrase to include "assigns" as well as "executors or administrators."⁹⁹ Also extrinsic facts and circumstances and the conduct of the parties may give an assignable character to a license which on its face is not assignable.¹⁰⁰ And unassignable licenses may sometimes be invoked by persons who are not exactly identical with the licensees. A railroad company which was formed by the consolidation of prior railroad companies, may invoke the licenses which were given to either of its constituent corporations; because the consolidated company

⁹⁶ *Andrews v. Landers*, 72 F. R. 666, 1896.

⁹⁷ *Adam v. Folger*, 120 F. R. 264, 1903; *Bowers v. Lake Superior, etc., Co.*, 149 F. R. 983, 1906.

⁹⁸ *Troy Factory v. Corning*, 14 Howard, 193, 1852; *Rubber Co. v. Goodyear*, 9 Wallace, 788, 1869; *Hapgood v. Hewitt*, 119 U. S. 226, 1886; *Baldwin v. Sibley*, 1 Clif-

ford, 150, 1858; *Searls v. Bouton*, 12 F. R. 143, 1882; *Bull v. Pratt*, 1 Connecticut, 342, 1815; *Adams v. Howard*, 22 F. R. 657, 1884; *Waterman v. Shipman*, 55 F. R. 986, 1893.

⁹⁹ *Hamilton v. Kingsbury*, 15 Blatch. 69, 1878.

¹⁰⁰ *Bowers v. Lake Superior, etc., Co.*, 149 F. R. 983, 1906.

is a successor rather than an assignee of those companies.¹⁰¹ So also, a license to a corporation, will protect a receiver who is authorized to manage its business during its embarrassments.¹⁰² But a receiver who is appointed in supplementary proceedings, under the New York Code of Civil Procedure, to settle the business of an insolvent individual, does not acquire any right to an unassignable license which belonged to the insolvent person.¹⁰³

Where a license is given to a partnership, composed of several persons, and where that partnership is dissolved, and its business is continued by one of the partners, that partner is entitled to that license;¹⁰⁴ but where such a dissolution ends the business of the partnership, the license lapses;¹⁰⁵ except that a receiver appointed to wind up the partnership affairs, may invoke the license to protect him in so doing.¹⁰⁶ But a license to one person gives no right to any partner of that person, or to any corporation organized by the licensee;¹⁰⁷ although of course such a licensee may employ such agents as he wishes to manufacture the patented article for him;¹⁰⁸ and if it authorizes the licensee to act only at a particular place, it will not protect any of his doings elsewhere.¹⁰⁹ And no license to a man and any partner he may take, will protect any assignee of that man when acting alone.¹¹⁰ Nor does an

¹⁰¹ *Lightner v. Railroad Co.*, 1 Lowell, 338, 1869.

¹⁰² *Emigh v. Chamberlin*, 2 Fisher, 192, 1861; *Schmidt v. Central Foundry Co.*, 218 F. R. 466, 1914.

¹⁰³ *Waterman v. Shipman*, 55 F. R. 985, 1893.

¹⁰⁴ *Belding v. Turner*, 8 Blatch. 321, 1871.

¹⁰⁵ *Haffcke v. Clark*, 50 F. R. 531, 1892.

¹⁰⁶ *Montrose v. Mabie*, 30 F. R. 234, 1887.

¹⁰⁷ *Eclipse Windmill Co. v. Windmill Co.*, 24 F. R. 650, 1885.

¹⁰⁸ *Foster Hose Supporter Co. v. Thomas P. Taylor Co.*, 191 F. R. 1003, 1912.

¹⁰⁹ *Rubber Co. v. Goodyear*, 9 Wallace, 788, 1869.

¹¹⁰ *Gibbs v. Hoefner*, 19 F. R. 324, 1884.

unassignable license pass to an executor or administrator of a deceased licensee.¹¹¹ The non-assignability of a license may be waived by the licensor; and will be so waived if he accepts the promised royalty from the assignee of the license;¹¹² or ratifies the transfer of the license, by otherwise treating the assignee as the licensee was entitled to be treated.¹¹³

A reservation in an assignment, reserving the right to the assignor to operate fully under the patent but restricting the right to him personally will, it is held, prevent the assignor from authorizing a third party to operate under the license when the assignor has no interest in the business otherwise than a reservation of a royalty.^{113a} It is surmised that this ruling would be the same even in the absence of the restriction as to personal use.

Assignable licenses are assignable only in their entirety; unless they expressly or impliedly authorize their assignment in parts, and to a plurality of persons.¹¹⁴ And the royalties payable to a licensor are assignable by him; and the assignee's rights to those royalties follow the license, when it is assigned to a person who has notice of those rights.¹¹⁵ The purchaser of a license takes it subject to all the restrictions connected therewith, whether he has notice of those restrictions or not;¹¹⁶ and subject to liability for the same rate of royalty for his doings,

¹¹¹ *Oliver v. Chemical Works*, 109 U. S. 81, 1883.

¹¹² *Bloomer v. Gilpin*, 4 Fisher, 55, 1859.

¹¹³ *Hammond v. Organ Co.*, 92 U. S. 724, 1875; *Lane & Bodley Co. v. Locke*, 150 U. S. 196, 1893.

^{113a} *Lockjoint Pipe Co. v. Melber*, 234 F. R. 319, 1916.

¹¹⁴ *Brooks v. Byam*, 2 Story,

545, 1843; *Consolidated Fruit Jar Co. v. Whitney*, 1 Bann. & Ard. 356, 1874; *Adams v. Howard*, 22 F. R. 656, 1884; *Brush Electric Co. v. California Electric Light Co.*, 52 F. R. 964, 1892.

¹¹⁵ *Grier v. Baynes*, 46 F. R. 524, 1891.

¹¹⁶ *Chambers v. Smith*, 5 Fisher, 12, 1870.

that the licensee would have had to pay for similar acts; ¹¹⁷ but not subject to any royalty, or other money, due from the licensee to the licensor, at the time of the assignment of the license. ¹¹⁸

§ 311. Purely implied licenses may arise from the conduct of patentees and grantees of patents, or from recoveries by them, of profits or damages for certain classes of infringements. Many of the rules which have thus far in this chapter, been stated and explained in connection with purely express licenses, and in connection with express licenses having implied incidents, are also applicable to licenses which are purely implied. Little or nothing remains to be said about the latter, except to state the classes of circumstances out of which they are found to spring.

§ 312. Implied licenses, from conduct of owners of patent rights, may arise out of any one of a considerable number of classes of facts; but, when analyzed, those facts will probably always be found to thus operate by virtue of the doctrines of acquiescence, or the doctrines of estoppel. For example, where a patentee joins a partnership, the business of which involves the employment of his patented invention, an implied license passes to the partnership, as part of the partnership property. ¹¹⁹ And where the owner of a patent right acquiesces in the doings of one who makes, uses, or sells specimens of the patented invention, and where that owner also accepts partial compensation for such doings; a license will be implied, unless the case also presents other facts which negative such an implication. ¹²⁰ Payment of full compensation would be

¹¹⁷ *Paper Stock Co. v. Disinfecting Co.*, 147 Mass. 323, 1888.

¹¹⁸ *Goodyear v. Rubber Co.*, 3 Blatch. 449, 1856.

¹¹⁹ *Mueller v. Mueller*, 95 F. R. 155, 1899.

¹²⁰ *Blanchard v. Sprague*, 1 Cliff. 297, 1859; *Seibert Oil Cup Co. v. Lubricator Co.*, 34 F. R.

a still more convincing ground upon which to base an implied license; and such a license may be based on a clear case of acquiescence, even if no special payment is proved to have been received.¹²¹ But acquiescence in unpaid-for use, does not always imply that no compensation is to be expected. Where the user knew of the patent, and the patentee knew of the use, and did not object thereto; it is more reasonable to imply an agreement for a *quantum meruit* or a royalty, than to imply that the patentee donated the use of his invention to the user, or to imply that the user unlawfully seized upon the invention of the patentee.¹²² In the absence of an established royalty, a *quantum meruit* is ascertained by general and expert evidence, showing what a reasonable royalty would be.¹²³ In no case, however, can a license be implied from acquiescence, unless the licensor had knowledge of the thing acquiesced in; nor can acquiescence be predicated even of knowledge and omission to interfere with the doings of the infringer, if that omission is fairly accounted for on other grounds.

§ 313. If the owner of a patent right were to explain the patented invention to a person ignorant of the patent; and were to advise him to make, to use, or to sell a specimen of that invention, with intent to induce him to infringe the patent unknowingly; and if that person were thereby induced to incur expense in infringing or in preparing to infringe that patent; an implied license would result by estoppel, to the person thus misled. The same

221, 1888; *Keyes v. Eureka Mining Co.*, 158 U. S. 150, 1895.

¹²¹ *Gill v. United States*, 160 U. S. 437, 1896.

¹²² *United States v. Palmer*, 128 U. S. 269, 1888; *McKeever v.*

United States, 23 O. G. 1527, 1883; *Drainage Construction Co. v. Chelsea*, 41 F. R. 47, 1890.

¹²³ *Deane v. Hodge*, 35 Minn. 154, 1886.

result would follow, if the owner of a patent right were to conceal the existence of the patent from a person who, to his knowledge, was about to infringe it unknowingly; if that concealment were done with intent to allow that person to infringe; and if that person incurred expense in infringing or in preparing to infringe, which he would not have incurred if he had known of the patent. And where a patentee sees an infringing article sold without authority from him, but makes no objection to the sale; an implied license by estoppel results to the purchaser.¹²⁴

So, also, where a person sells a patented machine to another without having any interest in or under the patent, he will be estopped from prosecuting his vendee for infringement on the basis of any after acquired title. Such estoppel, however, extends only to machines made or sold by permission or with the co-operation of the person acquiring the title. For instance, a partner who, after dissolution of the partnership, acquires a patent covering machines made by the partnership is not estopped from claiming infringement of the patent by machines made or sold by the other partner after the dissolution.¹²⁵ And where a person sells a patent which employs an invention which infringes a prior patent; the person selling is estopped from bringing an action against his grantee for that infringement; even though the earlier patent is acquired after the sale of the later patent.¹²⁶ And that estoppel operates as a license, not only as against the seller but also as against owners in common with him of the

¹²⁴ *Societe Fabriques, etc., v. Franco-American Trading Co.*, 82 F. R. 439, 1897.

¹²⁵ *Dull v. Reynolds Electric*

Flasher Mfg. Co., 161 F. R. 129, 1908.

¹²⁶ *United Printing Machinery Co. v. Cross Paper Feeder Co.*, 220 F. R. 322, 1915.

prior patent.¹²⁷ And where an inventor before applying for a patent thereon, sells a specimen of his invention to a manufacturer who avowedly buys it to copy it, by making other specimens for sale, and where the seller gives the buyer no notice of intention to apply for a patent on that invention; the inventor is estopped from bringing an action on such a patent against anyone, for using or selling a specimen of the invention which was made by that purchaser.¹²⁸ And so is the patentee estopped when he has sold to the defendant the necessary parts to make the patented article, even as respects articles made by the defendant partly from parts procured from a stranger if such a course was necessary to enable the defendant to use up all of the parts supplied by the patentee.¹²⁹ But a license to use a patented device may not be implied from the fact that the patentee has sold to the alleged infringer an article which constitutes one element of the patented combination, where the article is capable of other uses, even though the article is usually sold by the patentee as a part of the complete patented device.¹³⁰

§ 313*a*. Where a man is employed by another party, to work in a particular business of the employer; and where, at any time before the end of that employment, he conceives an invention which appears to be applicable to his employer's business; and where during that employment, he uses the property of the employer in reducing that invention to practice; and where he sees the employer thereupon proceed to make, use, or sell, specimens of that invention, and does not thereupon demand any present

¹²⁷ *Curran v. Burdsall*, 20 F. R. 835, 1883.

¹²⁸ *Anderson v. Eiler*, 50 F. R. 775, 1892.

¹²⁹ *Auto Spring Repairer Co. v. Grinberg*, 175 F. R. 799, 1910.

¹³⁰ *Davis v. Hall Mammoth Incubator Co.*, 200 F. R. 958, 1912.

or prospective compensation therefor, on account of any present or prospective patent thereon; an implied license, or "shop right" results to the employer, under any patent that may be granted on that invention, in pursuance of any application of that employed man.¹³¹ Such an implied license will cover all the specimens of the invention which the employer may make or use or sell during the life of any such patent; or it will be confined to some or all of those specimens which were made or used or sold with the inventor's knowledge, during the time of his employment, according to the particular equities of each case in which such a license is implied.¹³² Where an employee contracts to devote his time to the "cheapening of the processes" used by his employer, and in the course of his employment invents a process relating to the business of his employer and machines for carrying out the process, and thereafter constructed six of the machines in the employer's plant at the latter's expense, a license to the employer is implied to use the machines and to replace them and also to practice the process, even though there was no provision in the contract of employment that would give such right.¹³³ And the benefit of such an implied license will pass to the assigns or the successors of the employer; according to the particular circumstances which may justify such passage in particular cases, respectively.¹³⁴

¹³¹ *Gill v. United States*, 160 U. S. 426, 1896; *Blauvelt v. Interior Conduit & Insulation Co.*, 80 F. R. 906, 1897; *Wilson v. American Circular Loom Co.*, 187 F. R. 840, 1911; *Schmidt v. Central Foundry Co.*, 218 F. R. 466, 1914.

See *American Stoker Co. v.*

Underfeed Stoker Co., 182 F. R. 642, 1910.

¹³² *Fuller & Johnson Mfg. Co. v. Bartlett*, 68 Wis. 73, 1887; *Brickill v. New York*, 112 F. R. 70, 1901.

¹³³ *Barber v. National Carbon Co.*, 129 F. R. 370, 1904.

¹³⁴ *Lane & Bodley Co. v. Locke*,

§ 314. An actual recovery of a full royalty for making, and selling to others to be used, operates as an implied license to any purchaser of the thing thus made and sold, to use it to the same extent that he could lawfully have done, if the maker had been licensed to make and sell it.¹³⁵ But where there is a recovery of mere nominal damages in an infringement suit for unlicensed making and selling a specimen of a patented thing, that recovery does not operate as an implied license authorizing the use of that specimen.¹³⁶ And where an action in equity, against an infringing user of a patented thing, is brought to recover the profits which he derived from that use; that action cannot be successfully resisted on the ground that the profits, which the infringing maker, or an infringing seller of that thing, derived from his infringement, have already been recovered from him; because each infringer is liable, in equity, for his own profits only;¹³⁷ and because the payment to the owner of a patent, of the profits which one infringer has reaped from infringement, cannot operate in equity, to relieve another infringer from liability to the owner of the patent for other profits which he derived, either from the same infringement or from a different

150 U. S. 193, 1893; *Withington-Cooley Mfg. Co. v. Kinney*, 68 F. R. 500, 1895.

¹³⁵ *Spaulding v. Page*, 1 Sawyer, 709, 1871; *Gilbert & Barker Mfg. Co. v. Bussing*, 12 Blatch. 426, 1885; *Perrigo v. Spaulding*, 13 Blatch. 391, 1876; *Steam Stone Cutter Co. v. Mfg. Co.*, 17 Blatch. 31, 1879; *Booth v. Seevers*, 19 O. G. 1140, 1881; *Stutz v. Armstrong*, 25 F. R. 147, 1885; *Fisher v. Amador Mine*, 25 F. R. 201, 1885; *Tuttle v. Matthews*, 28 F. R.

98, 1886; *American Bell Telephone Co. v. Albright*, 32 F. R. 287, 1887.

¹³⁶ *Birdsell v. Shaliol*, 112 U. S. 445, 1884; *New York Filter Co. v. Schwarzwald*, 58 F. R. 579, 1893; *Philadelphia Trust Co. v. Edison Electric Light Co.*, 65 F. R. 554, 1895.

¹³⁷ *Elizabeth v. Pavement Co.*, 97 U. S. 140, 1877; *Tatham v. Lowber*, 4 Blatch. 87, 1857; *Covert v. Sargent*, 38 F. R. 238, 1889.

infringement, connected or disconnected therewith. Therefore the existence of a decree for profits against a manufacturer for making and selling a patented article, does not constitute any defence to a suit for infringement brought against a user of the very same article.¹³⁸ But if a patentee makes and sells under his patent, a recovery of both damages and profits from another who infringes by making and selling is a bar to further suits for infringement by users of specific articles covered by the decree.^{138a} And no action of a patentee, by way of suit, or by way of amicable collection of money for infringement against an infringing maker or seller of a patented article, can deprive any licensee of the patentee, who has the exclusive right to use the patented article in a given territory, of the right to collect money from the user in that territory, of the very infringing article which was involved in the suit or settlement between the patentee and the manufacturer or seller of that article. Recoveries based on unlicensed use of a patented process or thing, are necessarily confined to such use as occurred before the suit was brought, if the action be at law, or to such as occurred before the final decree, if the action is in equity; and it follows that no such recovery can operate to license anyone to continue such use, or to begin a new use of that thing or that process.¹³⁹

§ 314a. Section 1 of the so-called Sherman Anti-Trust Act provides that "every contract, combination in the form of trust or otherwise, or conspiracy in restraint of trade or commerce, among the several States or with foreign nations, is hereby declared to be illegal"; and

¹³⁸ Tuttle *v.* Matthews, 28 F. R. 98, 1886.

^{138a} Stebler *v.* Riverside Heights Orange Growers Ass'n, 214 F. R. 550, 1914; Sherman, Clay & Co. *v.*

Searchlight Horn Co., 225 F. R. 497, 1915.

¹³⁹ Suffolk Co. *v.* Hayden, 3 Wallace, 315, 1865.

Section 2 of the same Act provides that "every person who shall monopolize, or attempt to monopolize any part of the trade or commerce, among the several States, or with foreign nations, shall be deemed guilty of a misdemeanor."¹⁴⁰

Since the fourth edition of this book the question has arisen as to what extent, if any, this statute circumscribes or limits in any way the monopoly which a patentee possesses by virtue of the ownership of a patent. Putting the question in another way it is as to what extent the owner of a patent may legitimately create restrictions on the resale or use in the hands of another of articles made under his patent either by himself or by one licensed to manufacture under his patent.

It has been many times said, as in *National Phonograph Co. v. Schlagel*,¹⁴¹ that "it rests with the owner to say what part of (his) property he will reserve to himself and what part he will transfer to others and upon what terms he will make the transfer," or, as expressed by the Supreme Court in another way "the general rule is absolute freedom in the use or sale of rights under the patent laws of the United States. The very object of these laws is monopoly and the rule is with few exceptions that any conditions, which are not in their very nature illegal with regard to this kind of property, imposed by the patentee and agreed to by the licensee for the right to manufacture or use or sell the article, will be upheld by the courts. The fact that the conditions in the contracts keep up the monopoly of fixed prices does not render them illegal."¹⁴²

¹⁴⁰ Act of July 2, 1890, Chapter 647, 26 Stat. 209.

¹⁴¹ *National Phonograph Co.*

v. Schlagel, 128 F. R. 733, 1904.

¹⁴² *Bement v. National Harrow Co.*, 186 U. S. 70, 1902.

§ 314*b*. These holdings and others similar to them obviously mean that in legal conception the owner of a patent is possessed of a certain aggregation of rights which are assembled in his statutory rights to exclude others from making, selling or using articles within the scope of his patent, and with those holdings as the premises the logical deduction is that he may grant to others the right to make under certain circumstances, the right to use under certain circumstances, or the right to sell under certain circumstances, retaining to himself or bestowing as he sees fit, the right to make, use, or sell all under other circumstances.

§ 314*c*. Prior to the decision of *Bauer v. O'Donnell*,¹⁴³ known as the "Sanatogen" case, there was practically no judicial dissent from the proposition stated in the foregoing section. In *Bement v. National Harrow Co.*, which was the leading case in the Supreme Court where the *Dick* case was decided, the owner of the patent granted a license to a manufacturer to manufacture harrows under the patent. The suit against the manufacturer was in the form of one to recover damages for a violation of licenses and to restrain further violation of them. Mr. Justice PECKHAM said in his opinion: "but that statute (Sherman Anti-Trust Law) clearly does not refer to that kind of a restraint of interstate commerce which may arise from reasonable and logical conditions imposed upon the assignee or licensee of a patent by the owner thereof restricting the terms upon which the article may be used, and the price to be demanded therefor. Such a construction of the Act we have no doubt was never contemplated by its framers." He further said: "The owner of a patented article can, of course, charge such price as he may choose, and the owner of a patent may assign it

¹⁴³ *Bauer v. O'Donnell*, 229 U. S. 1, 1913.

or sell the right to manufacture and sell the article patented upon the condition that the assignee shall charge a certain amount for such article. The Bement case therefore stands squarely for the proposition that when there is a license to manufacture and sell under a patent, a provision in the license agreement that the articles made under the patent shall be sold at a fixed price, is not contrary to the Sherman Anti-Trust Law and this holding has not been overruled."

§ 314*d*. The next case directly involving the question under discussion that came before the Supreme Court was the *Henry v. Dick* case.¹⁴⁴ The essential facts involved in that case were that the owner of the patent involved, who was also a manufacturer of mimeographs, made under the patent, affixed to his machines a notice stating that the machine was sold "with the license restriction that it may be used only with the stencil paper, ink and other supplies" made by the manufacturer, and that the defendant, a dealer in inks, sold a can of ink to a purchaser of one of the mimeographs, both the dealer and the purchaser having actual knowledge of the license restriction and of the intention of the purchaser to use the ink on the patented mimeograph. It further appeared that the machine had been purchased for a cash consideration, but which yielded no profit to the manufacturer whose method it was to make its profits on the sale of the inks and supplies. Five only of the nine judges who sat upheld the restriction. As the suit was for infringement it is obvious that the court considered that the patentee by virtue of the license restriction had retained to himself some part of the monopolistic rights granted to him by the patent.

To the objection that the entire title in the patented

¹⁴⁴ *Henry v. Dick Co.*, 224 U. S. 1, 1912.

article had passed by virtue of the sale and that therefore there was no patent right left in the patentee which the defendant could infringe, Justice LURTON said:

“The argument for the defendants ignores the distinction between the property right in the materials composing a patented machine, and the right to use for the purpose and in the manner pointed out by the patent. The latter may be and often is the greater element of value, and the buyer may desire it only to apply to some or all of the uses included in the invention. But the two things are separable rights. If sold unreservedly the right to the entire use of the invention passes, because that is the implied intent; but this right to use is nothing more nor less than an unrestricted license presumed from an unconditional sale. A license is not an assignment of any interest in the patent. It is a mere permission granted by the patentee. It may be a license to make, sell and use or it may be limited to any one of these separable rights. If it be a license to use, it operates only as a right to use without being liable as an infringer. If a licensee be sued he can escape liability to the patentee for the use of his invention by showing that the use is within his license. But if his use be one prohibited by the license, the latter is of no avail as a defence.”

A situation where the possessor of a patented machine had, without the permission of the owner of the patent, manufactured it for himself and subsequently obtained permission from the patentee to use it in a particular manner, or for a particular purpose, may serve to bring out more strongly the distinction mentioned by the court. In such a case it would hardly be open to question that permission by the owner of the patent would carry to the possessor of the machine only the right to use it in the manner provided, although title to the physical machine

would at all times have belonged to the maker of the machine.

§ 314e. The question next came before the Supreme Court in the case of *Standard Sanitary Mfg. Co. v. United States*.¹⁴⁵ This case was a prosecution under the Sherman Anti-Trust Law. The sixteen corporate defendants were the manufacturers of about 85% of the enameled iron ware made in the United States. Originally the Standard Co. was the manufacturer of about 50% of such ware and was the owner of a certain process patent for enameling under which it operated. The remaining manufacturers were, however, compelled to use older and inferior processes of enameling with the result that they produced a large quantity of "seconds" or inferior ware, which, however, came into competition with the high grade ware made by the Standard Co. At least such was the contention of the defendants, who also contended that in forming the combination attacked by the Government, they produced a healthy condition in the trade, eliminating "seconds" and making possible free competition in equal grade ware.

The essence of the combination involved in the case so far as the Sherman Law was concerned, was a license agreement substantially as follows: Right was granted to the licensee to use the process of the patent, royalties of a fixed sum were established, preferential discounts from the regular selling prices were announced, a commission was established to have supervision of all the royalties and transactions between the parties to the agreements, covenants were entered into to adhere to and maintain the conditions, regulations and prices and preferential discounts established by the licensor, and provision was made for the return of eighty per cent of the royalties

¹⁴⁵ *Standard Sanitary Mfg. Co. v. United States*, 226 U. S. 20, 1912.

paid if the agreements should be complied with by all concerned. Each licensee agreed to sell no "seconds." There was also a jobbers' license agreement that required the purchaser to pay the price fixed and in short the plan sought to be put into execution was to control the prices of enamel iron ware from the manufacturer to the ultimate consumer by means of license restrictions.

Mr. Justice McKENNA who rendered the opinion, said: "In this statement certain things are prominent. Before the agreements the manufacturers of enameled ware were independent and competitive. By the agreements they were combined, subjected themselves to certain rules and regulations, among others not to sell their product to the jobbers except at a price fixed not by trade and competitive conditions but by the decision of the committee of six of their number, and zones of sales were created. And the jobbers were brought into the combination and made its subjection complete and its purpose successful. Unless they entered the combination they could obtain no enameled ware from any manufacturer who was in the combination, and the condition of entry was not to resell to plumbers except at the prices determined by the manufacturers. The trade was, therefore, practically controlled from producer to consumer, and the potency of the scheme was established by the co-operation of 85% of the manufacturers and their fidelity to it was secured not only by trade advantages but by what was practically a pecuniary penalty, not inaptly termed in the argument, 'cash bail.' The royalty for each furnace was \$5.00, 80% of which was to be returned if the agreement was faithfully observed; it was to be 'forfeited as a penalty' if the agreement was violated. And for faithful observance of their engagements the jobbers, too, were entitled to rebates from their purchases. It is testified that 90% of the job-

bers in number and more than 90% in purchasing power joined the combination.

“The agreements clearly, therefore, transcended what was necessary to protect the use of the patent or the monopoly which the law conferred upon it. They passed to the purpose and accomplished a restraint of trade condemned by the Sherman law. It had, therefore, a purpose and accomplished a result not shown in the Bement case. There was a contention in that case that the contract of the National Harrow Company with Bement & Sons was part of a contract and combination with many other companies and constituted a violation of the Sherman law, but the fact was not established and the case was treated as one between the particular parties, the one granting and the other receiving a right to use a patented article with conditions suitable to protect such use and secure its benefits. And there is nothing in *Henry v. A. B. Dick Co.*, 224 U. S. 1, which contravenes the views herein expressed.”

§ 314*f*. In *Bauer v. O'Donnell*,¹⁴⁶ the sole licensee under the patent sold a food composition known as Sanatogen made under the patent, subject to the following license restriction:

“This size package of Sanatogen is licensed by us for sale and use at a price not less than one dollar (\$1.00). Any sale in violation of this condition, or use when so sold, will constitute an infringement of our patent No. 601,995, under which Sanatogen is manufactured, and all persons so selling or using packages or contents will be liable to injunction and damages.

“A purchase is an acceptance of this condition. All rights revert to the undersigned in the event of violation. The Bauer Chemical Co.”

¹⁴⁶ *Bauer v. O'Donnell*, 229 U. S. 1, 1913.

Certain jobbers purchased packages of the Sanatogen from the licensee and resold them to the defendant, a retail dealer. The defendant in turn sold them to consumers at less than one dollar a package, an act which was charged by the owner of the patent as being an infringement. The matter came before the Supreme Court on a certification from the Court of Appeals. The question certified was as follows: "Did the acts of the appellee (defendant) in retailing at less than the price fixed in said notice, original packages of 'Sanatogen' purchased of jobbers as aforesaid, constitute infringement of appellant's (plaintiff's) patent?"

Mr. Justice DAY, in his opinion, paraphrased the question as follows: "May a patentee by notice limit the price at which future retail sales of the patented articles may be made, such articles being in the hands of a retailer by purchase from a jobber who has paid to the agent of the patentee the full price asked for the article sold?" The decision, holding that when the owner of the patent had received from the jobber the full price for the packages he had deprived himself of all rights secured by his patent monopoly, was based on the consideration of Section 4884 of the Revised Statutes which grants to the patentee "the exclusive right to make, *use and vend* the invention or discovery." The Patent Statute was held to be similar in its purpose and meaning to the Copyright Statute (Section 4952 of the Revised Statutes) which, as the court said: "secures to an author, inventor, designer or proprietor of books, maps, charts or dramatic or musical compositions the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending them." The meaning of the word "vend" in the Patent Statute and "vending" in the Copyright Statute, was held to be identical, the court saying: "So far

as the use of the terms 'vend' and 'vending' is concerned, the protection intended to be secured is substantially identical. The sale of a patented article is not essentially different from the sale of a book. In each case to vend is to part with the thing for a consideration."

§ 314*g*. There is, however, one distinction between the statutes in the respect that the Patent Statute gives the inventor the exclusive right to "use," a fact which was strongly urged upon the court by the plaintiff, and the *Henry v. Dick Co.* case was cited in support of the contention. The court distinguished the case from the *Henry v. Dick* case and also from the case of *Bobbs-Merrill v. Straus*,¹⁴⁷ by saying with reference to the facts in those cases: "While the title was transferred, it was a qualified title, giving the right to use the machine only with certain specified supplies." In response to the contention that the facts in the *Bauer v. O'Donnell* case dealt with the use of the invention, because the notice stated that the package was licensed "for sale and use at a price not less than One Dollar (\$1.00)," the court said: "The jobber from whom the appellee purchased had previously bought at a price which must be deemed to have been satisfactory, the packages of Sanatogen afterwards sold to the appellee. The patentee had no interest in the proceeds of the subsequent sales, no right of any royalty therein or to participation in the proceeds thereof. The packages were sold with as full and complete title as any article could have when sold in the open market, excepting only the attempt to limit the sale or use when sold for not less than one dollar. In other words, the title transferred was full and complete with an attempt to reserve the right to fix the price at which subsequent sales could be made. There is

¹⁴⁷ *Bobbs-Merrill Co. v. Straus*, 210 U. S. 339, 1908.

no showing of a qualified sale for less than value for limited use with other articles only, as was shown in the Dick case. There was no transfer of a limited right to use this invention, and to call the sale a license to use is a mere play upon words.

“The real question is whether in the exclusive right secured by statute to ‘vend’ a patented article there is included the right, by notice, to dictate the price at which subsequent sales of the article may be made. The patentee relies solely upon the notice quoted to control future prices in the resale by a purchaser of an article said to be of great utility and highly desirable for general use. The appellee and the jobbers from whom he purchased were neither the agents nor the licensees of the patentee. They had the title to, and the right to sell, the article purchased without accounting for the proceeds to the patentee and without making any further payment than had already been made in the purchase from the agent of the patentee. Upon such facts as are now presented we think the right to *vend* secured in the patent statute is not distinguishable from the right of *vending* given in the copyright act. In both instances it was the intention of Congress to secure an exclusive right to sell, and there is no grant of a privilege to keep up prices and prevent competition by notices restricting the price at which the article may be resold. The right to vend conferred by the patent law has been exercised, and the added restriction is beyond the protection and purpose of the act. This being so, the case is brought within that line of cases in which this court from the beginning has held that a patentee who has parted with a patented machine by passing title to a purchaser has placed the article beyond the limits of the monopoly secured by the patent act.”

§ 314*h*. Next came the case of Victor Talking Machine

Co. v. Straus,¹⁴⁸ decided by the Court of Appeals for the second circuit in which it appeared that a manufacturer of talking machines affixed thereto a very elaborate notice of license restrictions which was construed by the court as a grant of "only the right to use the particular machine unaltered without parts not manufactured by the Victor Co., maker and owner of the patents, and only with records and needles made by the Victor Co., and to use it only so long as the notice, unaltered and unerasable, remains on the machine." The term for which the right to use was granted was a fixed period, "for the term of the patent having the longest term to run." The court said: "The character of the use is not the same in all cases:

"1. To 'Victor distributors' there is given a right to use only for 'demonstrating.'

"As the sole result of demonstration is to induce the public to get the machines it may be assumed that these distributors are paid by the Victor Company.

"2. To regularly licensed 'Victor dealers' there is also given a right to use for 'demonstrating' purposes. Sometimes conveyance of such right to use is made directly by the Victor Company, to the licensed Victor dealer. Sometimes the conveyance is made to the 'dealer' by the 'demonstrator,' who by the terms of the notice is expressly authorized to convey such right to the dealer. These dealers, of course, do not use these machines for their personal enjoyment; their demonstrations are given to induce the public to apply for machines and they are paid by a commission on the amount paid by every person who may be induced by them to take one.

"3. To the public, *i. e.*, to individuals who wish to use the machines generally."

Every machine sold was paid for in a lump sum which

¹⁴⁸ Victor Talking Machine Co. v. Straus, 230 F. R. 449, 1916.

the notice described as a royalty, although it was not expected or understood that any further payments should be made. The notice stated that the manufacturer reserved title to the machine and could take it into his possession upon breach of any of the restrictions. It did not appear in the case, as it did in the Dick case, that the machines were sold at less than cost with the expectation upon the part of the manufacturer of making his profit out of the sale on supplies. The defendant was a purchaser of talking machines in the open market and the bill was brought to enjoin him from selling the talking machines at less than the price fixed by the notice. The bill was sustained on the ground that the plaintiff had never passed complete title to any of the talking machines, the court saying: "A study of these various documents leads to the conclusion that complainant has undertaken to avoid making such a sale of its machine, as would permanently pass it beyond any further control by itself. We think it has succeeded in so doing; this is not a sale outright, or a conditional or restricted sale or any sale at all.

"Under the authorities the owner of a patent who manufactures machines under such patent can give the right to use to whom he pleases upon what conditions he may choose to impose. Some of these conditions may involve pecuniary return, such as royalties, rentals for fixed periods, specified lump sum compensation for the whole period. We do not see why he may not give to one person a more restricted right to use than he does to another. The Dick case, 224 U. S. 1, established the proposition that a restriction to use only with other products of the patentee is legitimate. Of course the giving to any person of a 'right to use' things of this sort is an idle thing, unless the person is also supplied with the physical thing to be

used, to hold the same while he is enjoying the use and complying with its terms.”

§ 314*i*. It may be noted that in the Straus case the court gave no consideration to the fact that it did not appear that the plaintiff sold its talking machines at less than cost or that it depended for its profits on the future sale of supplies.

Since the decision in the Dick case legislation has largely nullified its practical results so far as they favor those undertaking to impose use restrictions. If the effect of such a restriction is to “substantially lessen competition or tend to create a monopoly in any line of commerce,” the plan comes within the prohibition of the so-called Clayton Law in effect October 15, 1914.¹⁴⁹ Section 3 of that law provides as follows:

“That it shall be unlawful for any person engaged in commerce, in the course of such commerce to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies, or other commodities, whether patented or unpatented, for use, consumption or resale within the United States, or any territory thereof . . . on the condition, agreement or understanding that the lessee or purchaser thereof shall not use or deal in the goods, wares, merchandise, machinery, supplies or other commodities of a competitor or competitors of the lessor or seller, where the effect of such lease, sale or contract for sale or such condition, agreement or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce.” Act of October 15, 1914, c. 323, Section 3, 38 Stat. 731.

§ 314*j*. The construction of this Act in one aspect came before the Court of Appeals, second circuit, in Motion

¹⁴⁹ Act of October 15, 1914, Chapter 323, Sec. 3, 38 Stat. 731.

Picture Patents Co. *v.* Universal Film Co.,¹⁵⁰ in which a license notice was affixed to a machine for projecting motion pictures, restricting the machine to use only with films, whether patented or unpatented, manufactured by the plaintiff. It appeared from the testimony in the case that the plaintiff had a monopoly under its patents on projecting machines with the result that it would have a consequent monopoly of the film business if the restriction were enforced. The court held that for that reason the license restriction came within the prohibition of the Clayton Law. The Clayton Law was not, however, the sole ground of the decision, the court holding that the case came within the doctrine of *Bauer v. O'Donnell* for the reason that the title to the machine had once passed by virtue of the sale. It may be noted that likewise in the *Dick* case did the title of the patented mimeograph pass by the sale, at least to as great an extent as the projecting machine in the *Motion Picture Patents Co.* case. The case was distinguished from the case of *Victor Talking Machine Co. v. Straus* for the same reason.

As this book goes to press, the decisions in both the *Victor Talking Machine Co.* case and the *Motion Picture Patents Co.* case are being reviewed by the Supreme Court. However, the law to date appears to be that the patentee may, if he chooses, reserve to himself title to the patented article, in which event he may impose such restrictions as he pleases.

Other cases following or based upon the Supreme Court decisions cited in the foregoing sections, are found in the note.¹⁵¹

¹⁵⁰ *Motion Picture Patents Co. v. Universal Film Co.*, 235 F. R. 398, 1916.

¹⁵¹ *Automatic Pencil Sharpening*

Co. v. Goldsmith Bros., 190 F. R. 205, 1911; *Winchester Repeating Arms Co. v. Buengar*, 199 F. R. 786, 1912; *Crown Cork & Seal Co.*

v. Brooklyn Bottle Stopper Co., 200 F. R. 592, 1912; *Waltham Watch Co. v. Keene*, 202 F. R. 225, 1913; *Robt. H. Ingersoll & Bro. v. McColl*, 204 F. R. 147, 1913; *Free Sewing Machine Co. v. Bry-Block Mercantile Co.*, 204 F. R. 632, 1913; *Kellogg Toasted Cornflake Co. v. Buck*, 208 F. R. 383, 1913; *Ford Motor Co. v. International Automobile League*, 209 F. R. 235, 1913; *Rajah Auto Supply Co. v. Rex Ignition Mfg. Co.*, 209 F. R. 622, 1913; *United States v. Kellogg Toasted Cornflake Co.*, 222 F. R. 725, 1915; *Ford Motor Co. v. Union Motor Sales Co.*, 225 F. R. 373, 1915; *American Graphophone Co. v. Boston Store*, 225 F. R. 785, 1915 (in which case a price restriction was upheld on the ground that there was a specific agreement so requiring, between the patentee and the manufacturer); *Eliot Machine Co. v. Center*, 227 F. R. 124, 1915; *Sheridan-Clayton Paper Co. v. U. S. Envelope Co.*, 232 F. R. 153, 1916.

CHAPTER XIII

· INTERFERING PATENTS

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| 315. Characteristics and causes of interfering patents. | 318. The evidence in such actions. |
| 316. Actions in equity between interfering patents. | 319. Injunctions in such actions. |
| 317. The questions and issues in such actions. | 320. The proper decrees in such actions. |

§ 315. PATENTS which contain one or more claims in common, are interfering patents.¹ But a generic claim, and a specific claim, the first of which secures a particular process or mechanism, with its indispensable characteristics, with or without its minor features, and the last of which secures the same process or mechanism, with but not without its minor features, are not co-extensive claims, and therefore do not interfere with each other.² All but one of several interfering patents are necessarily void, as to the interfering claim or claims; though all may be valid as to the other claims which they respectively contain.³

There are two causes which lead to the granting of interfering claims. Such claims may be granted because of inadvertence or erroneous judgment on the part of the Patent Office; and they may be granted because applications do not always happen to be made in the order of in-

¹ Nathan Mfg. Co. *v.* Craig, 49 F. R. 370, 1892; Dederick *v.* Fox, 56 F. R. 717, 1893; Simplex Railway Appliance Co. *v.* Wands, 115 F. R. 520, 1902.

² Stonemetz Mach. Co. *v.*

Brown Mach. Co., 57 F. R. 605, 1893.

³ Gold and Silver Ore Co. *v.* Disintegrating Ore Co., 6 Blatch. 311, 1869.

ventions. The first cause may operate when the Patent Office examiners overlook an anticipating patent, while examining an application in point of novelty; or when they form an erroneous opinion that an existing patented claim is substantially different from the claim under immediate inspection. The second cause may operate when one person who is not the first inventor of a particular thing, applies for and receives a patent thereon, before another person, who is the first inventor of that thing, files his application in the Patent Office. Under such circumstances, it is the duty of the Commissioner to declare an interference between the patent, and the unpatented application, and if, in that interference proceeding, the later applicant is adjudged to be the prior inventor, and if the application is otherwise unobjectionable, it becomes the duty of the Commissioner to grant him a patent.⁴ The Commissioner has, however, no authority to recall the patent theretofore granted to the wrong party. That patent can be repealed by the courts alone.

§ 316. An action in equity is the prescribed proceeding by means of which the interfering claims of two or more issued patents may be adjudicated, in point of relative priority.⁵ Such an action may be joined with an action for infringement,⁶ where the complainant's patent was issued first. But where the defendant's patent was issued first, an action for infringement of the complainant's patent by the defendant, cannot be joined with such an interference action.⁷

In previous editions of this book it has been stated that

⁴ Revised Statutes, Section 262, 1883; *Swift v. Jenks*, 29 F. R. 4904; *Hubel v. Dick*, 28 F. R. 139, 642, 1887; *Holliday v. Pickhardt*, 1886. 29 F. R. 853, 1887.

⁵ Revised Statutes, Section 4915.

⁶ *Leach v. Chandler*, 18 F. R.

⁷ *American Roll-Paper Co. v. Knopp*, 44 F. R. 611, 1891.

where such a suit in equity is brought without joining an action for infringement therewith, a cross-bill, based on alleged infringement by the complainant of the defendant's patent, is not proper,⁸ and that a cross-bill is improper, which seeks to institute an interference action, in response to an action for infringement alone.⁹

These decisions cited on these points probably still hold good in spite of the second paragraph of Equity Rule 30 promulgated November 4, 1912, wherein it is provided that the answer may, without cross-bill, set out any set-off or counterclaim which might be the subject of an independent suit in equity against the plaintiff.^{9a}

The complainant in an interference suit may be the patentee or assignee of either of the interfering patents, or a grantee or licensee thereunder; for all these persons fall within the category mentioned in the statute; a category which includes every person interested in any one of the patents, or in the working of the invention claimed under any of them. The defendant may be any patentee, assignee, grantee or licensee who is interested in another of the interfering patents. And if the interfering patents were originally applied for by a single inventor and assigned to different parties, the latter may be plaintiffs and defendants in such a suit.¹⁰ It is neither necessary that all the possible complainants should join in a suit, nor that all the possible defendants should be brought before the court. The statute provides that no decree entered in such a suit, shall affect either patent, except so far as the patent affected is owned by parties to the suit, or by persons deriving title under them after the ren-

⁸ *Stonemetz Mach. Co. v. Brown Mach. Co.*, 46 F. R. 851, 1891.

⁹ *New Departure Bell Co. v. Hardware Co.*, 62 F. R. 462, 1894.

^{9a} See Section 591.

¹⁰ *Keystone Trading Co. v. Zapota Mfg. Co.*, 210 U. S. 456, 1913.

dition of such decree. The proper practice is to make all persons complainants who have a right, and who are willing, to be so made; and to make all persons defendants who are liable to be made so, and who are inhabitants of the district where the suit is brought, or who shall be found in that district.¹¹

A bill cannot be filed in an interference suit until the complainant's patent is actually granted,¹² and until the defendant's patent is actually granted there is no occasion for such a bill. No cross-bill or counterclaim is either necessary or proper in a suit of this kind, because the statute provides that in such a suit the court may adjudge either of the patents to be void, which provision is held to refer to any grounds of invalidity which may be found to exist.¹³ The defendant may therefore obtain all rightful affirmative relief without becoming himself a complainant in a cross-bill,¹⁴ or setting out a counterclaim. And the defendant's right to such relief prevents the complainant from dismissing his bill without the defendant's consent.¹⁵ Since, by the terms of the statute, the judgment binds only the parties to the suit and those deriving title from them subsequent to the rendition of the judgment, it is proper for the court to enjoin the defendant from transferring his patent pending the outcome of the suit.¹⁶

§ 317. The questions which may arise in an interference suit are the following: 1. The presence or absence

¹¹ 18 Statutes at Large, Part 3, Ch. 137, Section 1, p. 470; *In re Hohorst*, 150 U. S. 661, 1893.

¹² *Hoeltge v. Hoeller*, 2 Bond, 338, 1870.

¹³ *Nikola Tesla Co. v. Marconi Wireless Telegraph Co.*, 227 F. R. 903, 1915.

¹⁴ *Lockwood v. Cleveland*, 6 F. R. 721, 1884.

¹⁵ *Electrical Accumulator Co. v. Brush Electric Co.*, 44 F. R. 606, 1890.

¹⁶ *Keystone Trading Co. v. Zapota Mfg. Co.*, 210 F. R. 456, 1913.

of an interference between the patents.¹⁷ 2. The question whether the subject of the interference was patentable at all or whether either of the patents is void on any ground.¹⁸ 3. The question whether the first party to conceive the invention involved in the suit, was also the first to reduce it to practice, or to file an application for a patent thereon, as the case may be. 4. The question whether the first party to conceive the invention, if he neither reduced it to practice nor applied for a patent thereon, till after another party to the suit did one or the other of those things, was negligent of the invention, before that other party conceived the invention himself.

The first and second of these questions may depend on the construction of the patent; and that construction may depend on evidence of the prior art. Where that construction can be based on the words of the patents, with or without taking judicial notice of facts not stated therein, the first and second questions may be decided on demurrer,¹⁹ but not otherwise.²⁰ The interfering claims of the two patents must be substantially identical, else there is no jurisdiction under Section 4918. The identity of the claims is the sole test of the question of the existence of an interference.²¹ The second question involves lack of invention, want of novelty and any other defence which may constitute a defence to an ordinary patent suit.²²

¹⁷ Revised Statutes, Section 1918.

¹⁸ *Palmer Pneumatic Tire Co. v. Lozier*, 90 F. R. 732, 1898; *General Chemical Co. v. Blackmore*, 156 F. R. 968, 1907; *Dittgen v. Racine Paper Goods Co.*, 181 F. R. 394, 1910; *Nikola Tesla Co. v. Marconi Wireless Telegraph Co.*, 227 F. R. 903, 1915.

¹⁹ *Morris v. Mfg. Co.*, 20 F. R. 121, 1884.

²⁰ *Simplex Railway Appliance Co. v. Wands*, 115 F. R. 517, 1902.

²¹ *Boston Pneumatic Power Co. v. Eureka Patents Co.*, 139 F. R. 29, 1905.

²² *Nikola Tesla Co. v. Marconi Wireless Telegraph Co.*, 227 F. R. 903, 1915.

The third and fourth of the questions defined in the first paragraph of this section are properly investigated and decided by means of the rules which are stated and explained under the head of interferences, in that chapter of this book which is devoted to applications for patents.²³ Those two questions relate to the same issue of fact. If the complainant's invention is the older, the defendant's interfering claim is void for want of novelty.²⁴ And the complainant's interfering claim is void for want of novelty, if the defendant's invention is found to antedate the other.²⁵

§ 318. The evidence upon which interference suits are decided, may consist of documents and exhibits, proved and supplemented by depositions of witnesses. Such depositions may be taken in the same ways in which depositions may be taken in infringement cases.²⁶ And any deposition which was taken in an interference in the Patent Office, between the same inventions, is admissible, or not admissible as the case may be, in an interference suit, according to those rules of the law of evidence, which relate to the use in one case, of depositions which were taken in another.²⁷

A properly authenticated copy of the decision of the Commissioner of Patents in such an interference, or of the Court of Appeals of the District of Columbia reviewing such a decision of the Commissioner, is admissible in evidence in an interference suit between patents on inventions which were involved in such an interference.

²³ Sections 140-141c of this book.

²⁴ *Pacific Cable Ry. Co. v. Butte City Ry. Co.*, 52 F. R. 865, 1892.

²⁵ *National Cash Register Co. v.*

Lamson Store-Service Co., 60 F. R. 603, 1894.

²⁶ Section 639 of this book.

²⁷ Section 640 of this book; *Clow v. Baker*, 36 F. R. 692, 1888.

If not reversed by that court; the decision of the Commissioner is *prima facie* evidence in favor of the patent last granted, because he would not have granted it if he had not decided it to be entitled to priority in point of date of invention.²⁸ And any decision of that court, is also *prima facie* evidence in favor of the patent last granted, for that patent would never have existed, if that court had decided the interference against the applicant therefor.

§ 319. Injunctions are not expressly authorized by that section of the statute, which provides for interference suits. But Justice NELSON decided in 1863, that a preliminary injunction can be granted in such a case, on the ground that "the power conferred upon the Circuit Court to entertain bills in equity, in controversies arising under the patent act, is a general equity power, and carries with it all the incidents belonging to that species of jurisdiction."²⁹ And that decision has been reaffirmed and repeated in recent times.³⁰

§ 320. The hearing of an interference case may disclose that there is no interference between the patents before the court; or that there is such an interference. In the former event, the proper decree to enter is one dismissing the complainant's bill; and in the latter event, the proper decree is one adjudging the patent issued on the later of the inventions to be void, so far as it covers the interfering matter, and so far as the title of the parties to the suit extends.³¹ Such a decree should be entered regardless of whether the patent to be voided is that of the defendant

²⁸ *Pacific Cable Ry. Co. v. Butte City Ry. Co.*, 52 F. R. 865, 1892.

²⁹ *Potter v. Dixon*, 5 Blatch. 165, 1863.

³⁰ *Palmer Pneumatic Tire Co. v. Lozier*, 69 F. R. 348, 1895.

³¹ *Gilmore v. Golay*, 3 Fisher, 522, 1869; *Sturges v. Van Hagan*, 6 Fisher, 572, 1873.

or that of the complainant. If it is the latter, a decree merely dismissing the complainant's bill will not answer the purpose; because such a decree does not necessarily involve such a conclusion.³² It may mean only that there is no interference; or it may merely mean that the complainant has no proper title to the patent which he invokes.

³² *Tyler v. Hyde*, 2 Blatch. 310, 1851.

CHAPTER XIV

REPEAL OF PATENTS.

321. Patents obtained by fraud, or granted by mistake. repeal patents so obtained or so granted.
322. Jurisdiction of equity to re- 323. Practice in such cases.

§ 321. PATENTS and reissues may sometimes be obtained by fraud; and sometimes be granted by mistake. The facts which constitute the fraud, or which make the granting a mistaken one, may generally be interposed as one of the defences to an infringement suit; but where those facts are such that no one of those defences can be based upon them, they cannot be interposed merely because they constitute a fraud,¹ or constitute a mistake.² Nor can any individual bring any action to repeal or otherwise set aside a patent, on any ground of fraud; or indeed on any ground whatever, except that of an interference.³ Where frauds are ingenious enough to keep clear of all known defences to infringement suits, the wrongs which they cause are without a remedy, unless the United States courts will repeal a patent which United States officers have fraudulently been induced to grant, or to reissue. For when a patent has been signed and sealed in the Patent Office, it cannot be revoked or canceled by the President of the United States, or any other

¹ Railroad Co. v. Dubois, 12 Wallace, 64, 1870; Western Glass Co. v. Schmerz Wire-Glass Co., 185 F. R. 788, 1911.

² Doughty v. West, 6 Blatch.

433, 1869; Calculagraph Co. v. Wilson, 132 F. R. 20, 1904.

³ Mowry v. Whitney, 14 Wallace, 439, 1871.

officer of the Government.⁴ For the same reason, where a patent is granted by mistake, instead of being refused, as it ought; and where the ground of refusal does not constitute ground of defence to a suit for infringement; the wrongs which such a mistake will occasion must be remedied by a repeal of the patent, or they are remediless.

§ 322. Equity has jurisdiction to repeal letters patent for inventions where they were obtained by fraud, whenever the United States files a bill of complaint, stating the facts and praying that the letters patent may be annulled.⁵ And the same jurisdiction exists, where such letters patent are issued by any such mistake as those for which courts of equity grant relief, except so far as the peculiar provisions of the patent statutes may limit the general rule; but this jurisdiction to repeal letters patent, which may be claimed to have been issued by mistake, does not extend to error of judgment in deciding any debatable question of difference of invention.⁶

§ 323. A bill to repeal a patent must be filed before the expiration of the patent,⁷ and in some District Court of the United States,⁸ which has jurisdiction of the owner of the patent sought to be repealed. The District Court for the district in which that owner is an inhabitant, is such a court; as also probably is the District Court for any district wherein that owner can be found.⁹ In beginning and prosecuting an action in equity to repeal a patent, the United States acts through the United States District Attorney of the district in which the action is

⁴ McCormick Mach. Co. v. Aultman, 169 U. S. 608, 1898.

⁵ United States v. Bell Telephone Co., 128 U. S. 373, 1888.

⁶ United States v. Bell Telephone Co., 167 U. S. 264, 1897.

⁷ Bourne v. Goodyear, 9 Wallace, 811, 1869.

⁸ Revised Statutes, Section 629, paragraph 9.

⁹ 18 Statutes at Large, Part 3, Ch. 137, Section 1, p. 470; *In re Hohorst*, 150 U. S. 661, 1893.

brought; ¹⁰ and he acts under the direction of the Attorney General of the United States; ¹¹ who may be prompted by the Commissioner of Patents; ¹² or by any private person. But no citizen has any power to compel the Attorney General, or the District Attorney, to begin such a suit, or to control its prosecution after it is begun.¹³ The pendency of a bill to repeal a patent, will not affect the progress of an infringement suit based on that patent;¹⁴ and no injunction will issue to restrain a patentee from bringing infringement suits, pending a bill in equity to repeal the patent upon which he proposes to bring them.¹⁵

¹⁰ Attorney General *v.* Rumford Chemical Works, 2 Bann. & Ard. 308, 1876.

¹¹ United States *v.* Bell Telephone Co., 128 U. S. 350, 1888.

¹² McCormick Mach. Co. *v.* Aultman, 169 U. S. 612, 1898.

¹³ New York & Baltimore Cof-

fee Polishing Co. *v.* New York Coffee Polishing Co., 9 F. R. 580, 1881.

¹⁴ American Bell Telephone Co. *v.* National Telephone Co., 27 F. R. 666, 1886.

¹⁵ United States *v.* Colgate, 21 F. R. 318, 1884.

CHAPTER XV

QUI TAM ACTIONS

324. *Qui tam* actions, defined and described as they exist in the patent laws.
325. The wrongs which are the foundations of such actions.
326. The first two of those three classes of wrongs.
327. The third of those three classes of wrongs.
328. Wrongs of either class are completed when the articles are illegally marked, without any subsequent using or selling.
329. The amount of the recoverable penalty.
330. The parties in *qui tam* patent cases.
331. The forum for *qui tam* patent actions.
332. The form of the suit, and the requisites of a declaration, in such an action.
333. Injunctions to restrain the commission of wrongs of either of the first two classes.
334. Appeals in *qui tam* patent cases.

§ 324. THESE are certain actions at law, which derive their name from the Latin words *qui tam*, used at the beginning of the declaration in such an action, in times when all declarations were written in the Latin language. No such action was known to the common law of England; but several actions of the kind have long been prescribed by statute, in that country, and in this. *Qui tam* actions relevant to patents are authorized by Section 4901 of the Revised Statutes. That statute forbids certain classes of acts; and provides that whoever commits an act of either of those classes, shall be liable to a penalty of not less than one hundred dollars, with costs; and that any person may sue for that penalty, in any District Court of the United States within whose jurisdiction the offence

was committed; and that one-half of the penalty, when recovered, shall go to the plaintiff, and the other half to the United States.

§ 325. The forbidden acts are: 1. Unauthorized marking, upon any patented article, of the name, or any imitation of the name, of the patentee. 2. Unauthorized marking, upon any patented article, of the word "patent" or "patentee," or the words "letters patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee. 3. Marking upon any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public.

§ 326. The first two of these three classes of acts are injurious to the public, and to the patentees. They are injurious to the public in that they are adapted to mislead persons into buying and using articles which were made and sold in violation of patents, and which therefore cannot be lawfully used even by innocent purchasers. The law provides that those who have a right to make and sell patented articles shall mark those articles with the word "patented";¹ and that other persons shall not so mark such articles.² When buying anything which is not so marked, a purchaser properly concludes that it is not patented, and that he may therefore use it without risk of a suit for infringement; and when buying anything that is so marked, the purchaser concludes, with equal propriety, that it was made and sold by the patentee or some one lawfully authorized by him, and that therefore it may be lawfully used to any extent desired. It is clear, that on these accounts, the first two of the forbidden acts are detrimental to public security, and therefore opposed

¹ Revised Statutes, Section 4900.

² Revised Statutes, Section 4901.

to public policy. The same acts are also injurious to patentees, and they will be considered in that aspect in a subsequent section. But the second of the forbidden acts is not committed by marking the word "patented" upon a case containing patented articles of such a character that they could themselves have been thus marked.³

§ 327. The last of the three forbidden classes of acts is injurious to the public, in that it is adapted to mislead persons into an opinion that they have no right to make and use, or make and sell, other specimens of the thing marked as being patented. When an unpatented thing is so marked, it is immaterial whether it is a patentable thing or not.⁴ Whether a thing is patentable or not depends on considerations of which the public as a whole are necessarily ignorant. They may therefore be deceived by seeing the word "patented" upon an unpatentable unpatented article, as readily as by seeing the same word upon a patentable unpatented article. That word warns them not to copy that article. They are as reluctant to disregard that warning on a supposition that the article is not patentable, as they are on the hypothesis that it is not patented; and they are as effectually diverted from exercising their right to copy it in the one case as in the other.

Intent to deceive the public is a necessary element of the forbidden act now under consideration; and that intent must exist at the time of the marking;⁵ and it does not exist when the person marking, is himself mistaken relevant to his right so to mark;⁶ or where the word "patented"

³ *Smith v. Walton*, 51 F. R. 17, 1892; 56 F. R. 499, 1893.

⁴ *Oliphant v. Salem Flouring Mills Co.*, 5 Sawyer, 128, 1878; *Winne v. Snow*, 19 F. R. 509, 1844.

⁵ *Hotchkiss v. Woodley Ware*

Co., 53 F. R. 1018, 1891; *Loudon v. Everett H. Dunbar Corporation*, 179 F. R. 506, 1910.

⁶ *Walker v. Hawxhurst*, 5 Blatch. 494, 1867; *Russell v. New-ark Mach. Co.*, 55 F. R. 300, 1893.

is accompanied by other words or characters which indicate that the article was once the subject of a patent, but that the patent has expired at the time of the marking.⁷ Inasmuch as all persons are presumed to intend the natural consequences of their acts, proof of an act which was adapted to deceive the public, is sufficient proof of the intent to deceive, unless the doer establishes his innocence of that intent. The burden of proof therefore lies upon the defendant, in this particular.⁸ That burden can be carried by showing that the person marking, honestly believed that the thing marked was really patented by a particular patent; but it cannot be carried by showing that the person marking did not know whether the article marked was patented or not; and the question whether a particular thing marked "patented" is really patented by a particular patent, is a question of construction for the court.⁹ Where the defendant is a corporation, the intent to deceive the public may be that of an officer or agent, who acted within the scope of his authority, in causing the marked article to be made and prepared for sale.¹⁰ The forbidden act treated in this section, is not committed by marking upon a patented article the number and date of a patent which does not cover it, where it is also marked with the number and date of a patent which does cover it.¹¹

§ 328. Proof that the article illegally marked "patented" was afterward sold, or was otherwise presented to the notice of the public, is not a necessary element in either of the acts which are forbidden by the statute; but proof that the intent to deceive the public existed when

⁷ *Wilson v. Mfg. Co.*, 12 F. R. 57, 1882.

⁸ *Brig Struggle v. United States*, 9 Cranch, 74, 1815.

⁹ *Tompkins v. Butterfield*, 25 F. R. 556, 1885.

¹⁰ *Tompkins v. Butterfield*, 25 F. R. 559, 1885; *Hotchkiss v. Wooden Ware Co.*, 53 F. R. 1018, 1891.

¹¹ *Russell v. Newark Machine Co.*, 55 F. R. 300, 1893.

the marking was done is such an element. Accordingly, if a person illegally marks an article, his offence is complete, and is not condoned by a subsequent omission to profit by that offence; but where a person marks an article without any intent to deceive, and afterward uses the article so marked for purposes of deception, he does not violate the statute.¹² Where a person illegally marks an article in one judicial district of the United States, and offers it for sale in another, he violates the statute in the former district but not in the latter.¹³

§ 329. The penalty prescribed by the statute for either of the forbidden acts is "not less than one hundred dollars"; and that language must, in a penal statute like this, be strictly construed, and when so construed, it authorizes a penalty of precisely one hundred dollars and no more.¹⁴ Judge THAYER once instructed a jury that where several unpatented articles are marked "patented" on the same day, and at the same time, so that the act of marking is practically continuous, but one offence is committed under the statute, and only a single penalty is recoverable for all the articles thus marked.¹⁵

§ 330. The plaintiff in a *qui tam* action for illegally marking a patented or unpatented article may be any "person,"¹⁶ whether he was injured by the doings of the defendant or not.¹⁷ It was decided under a similar statute relevant to copyrights, that a plurality of persons could not join as plaintiffs in an action of the kind.¹⁸ The lan-

¹² *Nichols v. Newall*, 1 Fisher, 647, 1853.

¹³ *Pentlarge v. Kirby*, 19 F. R. 504, 1884.

¹⁴ *Stimpson v. Pond*, 2 Curtis, 502, 1855.

¹⁵ *Hotchkiss v. Wooden Ware Co.*, 53 F. R. 1021, 1891; *Loudon*

v. Everett H. Dunbar Corporation, 179 F. R. 506, 1910.

¹⁶ Revised Statutes, Section 4901.

¹⁷ *Winne v. Snow*, 19 F. R. 508, 1884.

¹⁸ *Ferrett v. Atwill*, 1 Blatch. 153, 1846.

guage of that copyright statute was identical with that of the present patent statute in this particular; and the same reasoning which carried the court to its conclusion in the copyright case, will probably carry any court to the same conclusion in any *qui tam* action under the patent statute. The person who sues must be a natural and not an artificial person; and he must sue in his own name and not in that of the United States,¹⁹ though it is not improper for him to state that he sues for the United States, as well as for himself.²⁰

The defendant may be the particular natural person who did the marking complained of, or the particular corporation which caused it to be done, or which otherwise became responsible therefor.²¹ The death of the defendant, if a natural person, will end a *qui tam* patent case, and will terminate the right of action on which it is based.²²

§ 331. Jurisdiction in *qui tam* actions, unlike that in other kinds of patent suits, has always been conferred solely upon District Courts, and has never been conferred upon Circuit Courts of the United States, and is conferred for each case, upon the particular District Court within the district of which the forbidden act was committed.²³

§ 332. The proper form of common-law action in *qui tam* cases is that of debt.²⁴ Inasmuch, however, as no particular form is prescribed by the Federal statute, the

¹⁹ United States *v.* Morris, 2 Bond, 27, 1866.

²⁰ Winne *v.* Snow, 19 F. R. 508, 1884.

²¹ Hotchkiss *v.* Wooden Ware Co., 53 F. R. 1020, 1891; Loudon *v.* Everett H. Dunbar Corporation, 179 F. R. 506, 1910.

²² Schreiber *v.* Sharpless, 17 F. R. 589, 1883.

²³ Revised Statutes, Section 4901; Winne *v.* Snow, 19 F. R. 509, 1884; Pentlarge *v.* Kirby, 19 F. R. 505, 1884.

²⁴ Stimpson *v.* Pond, 2 Curtis, 505, 1855; Jacob *v.* United States, 1 Brockenbrough, 520, 1821.

code forms of complaints or petitions are to be used in code States.²⁵ The declaration, complaint, or petition, as the case may be, ought to state all the elements of the forbidden act upon which it is based;²⁶ and to charge that the act was contrary to the form of the statute in such cases made and provided.²⁷ It is not necessary to aver the uses to which the penalty, when recovered, is to be applied.²⁸ A declaration, complaint or petition in a *qui tam* patent case, is tested in point of sufficiency, by the rules applicable to civil actions in the State in which the District Court is established, when that sufficiency is drawn in question in that court.²⁹ And each "marking" complained of, must be separately stated, as a separate cause of action, in order to recover on all the "markings" cumulatively.³⁰

§ 333. The first two of the classes of acts forbidden by Section 4901 of the Revised Statutes are not only injurious to the public, in the manner already explained, but they are also injurious to the rightful patentees. Such acts enable infringers to increase the amount of their infringements, by inducing the public to believe that the articles they sell were lawfully made, and may be lawfully sold and used. So also, such an act may enable an infringer to palm off on the public an inferior article, the using of which will disappoint the purchaser, and thus operate to injure the reputation of the genuine thing. For these reasons, it has been held that a person who is guilty of an act of

²⁵ Revised Statutes, Sections 721, 914; *Hoyt v. Computing Scale Co.*, 96 F. R. 251, 1899.

²⁶ *Ferrett v. Atwill*, 1 Blatch. 155, 1846.

²⁷ *Sears v. United States*, 1 Gallison, 259, 1812; *Smith v. United States*, 1 Gallison, 264, 1812; *Ken-*

rick v. United States, 1 Gallison, 273, 1812.

²⁸ *Sears v. United States*, 1 Gallison, 259, 1812.

²⁹ *Fish v. Manning*, 31 F. R. 340, 1887.

³⁰ *Hoyt v. Computing Scale Co.*, 96 F. R. 251, 1899.

either of the first two classes, may be restrained by an injunction from any repetition of such an act.³¹

§ 334. A writ of error lies to the Circuit Court of Appeals for the circuit, from the final judgment of a District Court in a *qui tam* patent case; but no such writ of error lies from a Circuit Court of Appeals to the Supreme Court of the United States; though such a case may go to the latter tribunal upon a certificate from the former, or upon a certiorari from the Supreme Court.³²

³¹ Washburn & Moen Mfg. Co. v. Haish, 4 Bann. & Ard. 571, 1879.

³² Judicial Code, Sections 128, 238 and 240.

CHAPTER XVI

INFRINGEMENT

- 335. Infringement of process patents, illustrated by the case of *Tilghman v. Proctor*.
- 336. Illustrated by the case of *Mowry v. Whitney*.
- 337. Illustrated by the case of *Cochrane v. Deener*.
- 338. Equivalents in processes and additions thereto.
- 339. Infringement of patents for machines or manufactures.
- 340. Comparative results.
- 341. Comparative modes of operation.
- 342. Comparative modes of operation as illustrated by the case of the Cawood patent.
- 343. As illustrated by the Driven-Well cases.
- 344. As illustrated by Blanchard's patent for turning irregular forms.
- 345. As illustrated by Hayden's Brass-Kettle machine.
- 346. As illustrated by the case of *Burr v. Duryee*.
- 346a. As illustrated by The Electric Signal case.
- 347. Addition.
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- 365. Subject of the last section illustrated by the case of *Ives v. Hamilton*.
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| <p>369. Infringement of patents for compositions of matter.</p> <p>370. Substitution of ingredients.</p> <p>370a. Equivalent, and non-equivalent, ingredients.</p> <p>371. Substitution of ingredients, as illustrated by the Giant-Powder cases.</p> <p>372. Disclaimers of particular equivalents.</p> | <p>373. Changes of proportion in compositions of matter.</p> <p>375. Infringements of patents for designs.</p> <p>376. Comparative utility as a criterion of infringement.</p> <p>377. Knowledge of a patent by an infringer, not a necessary element in its infringement.</p> |
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§ 335. A PATENT for a process is infringed by him, who, without ownership or license, uses substantially the process which the patent claims; whether or not he uses substantially the apparatus which the patent describes,¹ and whether he uses the materials prescribed by the patent, or uses equivalents therefor.² Infringement of a process patent may occur even where precise identity does not exist in respect of the process claimed by the patent, and that used by the infringer.^{2a} In the leading case first cited, the apparatus used by the infringer was totally unlike that described by the patent; and the process used by the infringer differed from the patented process in several particulars. The claim of the patent was: "The manufacturing of fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure." The description of the process which was contained in the specification of the patent, stated that the water should be mixed with the fatty body in the proportion of two or three parts of fat to one of water; and that the mixture should be heated to about 612° Fahrenheit; and should be subjected to a pressure sufficient to prevent the heat from converting the water into steam.

¹ *Tilghman v. Proctor*, 102 U. S. 730, 1880. 66 F. R. 158, 1895. See Section 362.

² *Schwarzwalder v. Filter Co.*, ^{2a} See Section 338.

The infringer mixed from four to seven per cent of lime with the water and the fat; and heated the mixture to only about 310° Fahrenheit; and subjected it to a pressure correspondingly lower than what would have been necessary to prevent the conversion of the water into steam, if he had used the higher degree of heat. So also, he heated his mixture by means of superheated steam introduced into the vessel containing it, instead of applying heat to the outside of the vessel; and he maintained the intimacy of the mixture by continuously pumping the water from the bottom to the top of the mingled mass, instead of continuously forcing the mixture through a coil of tubes. Notwithstanding all these differences, the Supreme Court held the defendant's process to substantially include that of the patent, and therefore to be an infringement of the latter. This holding was not inconsistent with the opinion that the addition of the lime to the mixture, was a useful addition to the patented process, nor with the possibility that the defendant's method of maintaining the intimacy of the mixture, was superior to that of the patent, nor with the probability that the heating by the introduction of superheated steam, was more perfect than by conducting the heat into the mixture through the walls of the inclosing vessel, nor with the fact that the lower degree of heat and of pressure used by the defendant was more safe, and perhaps more economical, than the higher degree of each, which was suggested in the patent.

§ 336. Similar circumstances characterized the question of infringement in the case of *Mowry v. Whitney*.³ The patent in that case covered a process, which consists in taking cast iron car-wheels from their moulds as soon as they become solid enough to retain their shape; and in immediately placing the wheels in a furnace or chamber,

³ *Mowry v. Whitney*, 14 Wallace, 620, 1871.

previously heated to about the temperature of the wheels when taken from the moulds; and in thereupon reheating those wheels; and then in causing them to finally cool with a great degree of slowness.

The infringer's process consisted in taking the wheels red hot from the moulds; and in thereupon putting them in an unheated chamber, interlaying them with charcoal, and covering the whole with a perforated metal plate; and in then causing the charcoal to burn so as to reheat the wheels to a somewhat indefinitely high temperature; and in so adjusting the draft, as to make the charcoal burn out, and the wheels to consequently cool down, with a great degree of slowness. The Supreme Court found all of the steps of the complainant's process in the defendant's doings, though confessedly the reheating was done by different means, and the slow cooling regulated on different principles, from those which caused and controlled the corresponding parts of the complainant's process.

§ 337. The case of *Cochrane v. Deener*⁴ involved the infringement of a patent for a process of winnowing impurities out of ground wheat, while the flour is being separated from the other parts of the meal by means of fine cloth sieves, commonly called "bolts." The patent described a suitable apparatus by means of which to practice this process. It consisted of a series of cylindrical sieves, covered with cloth of progressively finer meshes, and having within them a series of air pipes, so disposed that when the ground wheat was in the sieves, and the sieves were revolving, air blasts were blown from the ends of those pipes, into and among the particles of ground wheat. Those air blasts operated to blow the impurities through the opening in the top of the bolting chamber, at the same time that the revolutions of the sieves operated

⁴ *Cochrane v. Deener*, 94 U. S. 787, 1876.

to separate the flour from the middlings. The result of the whole operation was to separate the ground wheat into three sorts of matter, and to place those three sorts in three different receptacles.

The defendant accomplished the same result, by winnowing the impurities out of the ground wheat, while the flour was being separated from the other parts of the meal by means of fine cloth sieves. But the defendant's sieves were flat, and the air blasts were blown through those sieves from below and reached the impurities through the cloth, instead of reaching them from the ends of pipes located on the same side of the cloth, as that occupied by the ground wheat. The Supreme Court, however, held that process to infringe the complainant's patent, notwithstanding these differences.

§ 338. No process patent is infringed where any one of the series of acts which constitute the process is omitted by the supposed infringer, unless some equivalent act is substituted for the one omitted.⁵ Precisely what constitutes equivalency, as between acts, has never been decided or stated by the Supreme Court. Reason seems to indicate that one act is the equivalent of another when it works in substantially the same way to accomplish the same result. Accordingly, it has been held that tamping oil wells with benzine, is equivalent to tamping them with water in respect of the series of acts which constitute the process covered by the Roberts torpedo patent.⁶ An addition to a patented process does not avert infringement,

⁵ *Royer v. Coupe*, 146 U. S. 531, 1892; *Dittmar v. Rix*, 1 F. R. 342, 1880; *Hammerschlag v. Garrett*, 10 F. R. 479, 1882; *Cotter v. Copper Co.*, 13 F. R. 234, 1882; *Arnold v. Phelps*, 20 F. R. 315, 1884; *Brush Electric Co. v. Julien*

Electric Co., 41 F. R. 679, 1890; *Brush Electric Co. v. Accumulator Co.*, 47 F. R. 49, 1891; *Kennedy v. Solar Refining Co.*, 69 F. R. 718, 1895.

⁶ *Roberts v. Roter*, 5 Fisher, 290, 1872.

even where the addition is an improvement.⁷ Neither is infringement avoided by merely reversing the steps in the process, when the same result is accomplished in substantially the same way,⁸ nor by the fact that the process is used by the infringer for the attainment of a different object,⁹ nor by the mere fact that two or more steps in the process are not taken simultaneously, where simultaneous action is not necessary to the result or to invention.¹⁰ But infringement of a process patent, is absent from a process which does not proceed with substantially the same mode of operation as that of the process described and claimed in the patent.¹¹

A process patent is not infringed by the purchase in the open market of a product of the process made by an infringing user of the process.^{11^a}

§ 339. Machines and manufactures may well be treated together in respect of infringement, because no exact line can be drawn between them, and because the same rules

⁷ *Lalace & Grosjean Mfg. Co. v. Habermann Mfg. Co.*, 53 F. R. 380, 1892; *Tuttle v. Matthews*, 28 F. R. 98, 1886; *New York Filter Co. v. Schwarzwald*, 58 F. R. 579, 1893; *Edison Electric Light Co. v. Philadelphia Trust Co.*, 60 F. R. 398, 1894; *Ford Morocco Co. v. Tannage Patent Co.*, 84 F. R. 644, 1898.

⁸ *Burdon Wire & Supply Co. v. Williams*, 128 F. R. 927, 1904; *Malignani v. Germania Electric Lamp Co.*, (citing numerous cases), 169 F. R. 299, 1909; *General Electric Co. v. Hill-Wright Electric Co.*, 174 F. R. 996, 1909; *Malignani v. Hill-Wright Electric*

Co., 177 F. R. 430, 1910; *Chadloid Chemical Co. v. F. W. Thurston Co.*, 220 F. R. 685, 1915.

⁹ *U. S. Mitis Co. v. Midvale Steel Co.*, 135 F. R. 103, 1904.

¹⁰ *Fullerton Walnut Growers' Ass'n v. Anderson-Barngrover Mfg. Co.*, 166 F. R. 443, 1908.

¹¹ *Philadelphia Creamery Supply Co. v. Davis & Rankin Bldg. & Mfg. Co.*, 79 F. R. 357, 1897; *Electric Smelting & Aluminum Co. v. Pittsburg Reduction Co.*, 111 F. R. 742, 1901.

^{11^a} *American Graphophone Co. v. Gimbel Bros.*, 234 F. R. 361, 1916.

of infringement are applicable to both those classes of tangible things. A patent for a machine or manufacture is infringed by him who, without ownership or license, makes, or uses, or sells any specimen of the thing covered by any claim of that patent. Merely making without selling is an infringement.¹² It is not an infringement of a patent, to make, use, or sell any specimen of any invention described but not claimed therein;¹³ because a patent covers only what it claims. But whoever infringes any one claim of a patent infringes the patent, whether or not it contains other claims which he does not infringe.¹⁴

Whether a particular thing made or used or sold by a particular person, infringes a particular claim of a particular patent, is always a question of fact. In some cases that question can readily be decided by the application of one rule of law, and sometimes by the application of another, and sometimes it can be decided only by the judicial sagacity of the tribunal before which the question is tried. Such relevant rules of law as are well established, will now be stated, and, as far as necessary, will be illustrated by describing the leading cases which embody them.

§ 340. The respective results of a machine or manufacture covered by the claim of a patent, and of a machine or manufacture alleged to infringe that claim, do not

¹² *Carter Crume Co. v. Am. Sales Book Co.*, 124 F. R. 903, 1903.

¹³ *Howe v. Williams*, 2 Cliff. 262, 1863; *Waterbury Brass Co. v. Miller*, 9 Blatch. 93, 1871; *Toohey v. Harding*, 4 Hughes, 253, 1880; *Buffington's Iron Building Co. v. Eustis*, 65 F. R. 807, 1895.

¹⁴ *Moody v. Fiske*, 2 Mason, 115, 1820; *Wyeth v. Stone*, 1

Story, 273, 1840; *Pitts v. Whitman*, 2 Story, 609, 1843; *Colt v. Arms Co.*, 1 Fisher, 108, 1851; *Pitts v. Wemple*, 2 Fisher, 10, 1855; *Foss v. Herbert*, 1 Bissell, 121, 1856; *Morris v. Barrett*, 1 Bond, 254, 1859; *Singer v. Walmsley*, 1 Fisher, 558, 1860; *McComb v. Brodie*, 1 Woods, 153, 1871; *McComb v. Ernest*, 1 Woods, 195, 1871.

furnish a criterion by which to decide the question of infringement.¹⁵ Those results may be identical, while the things which produce them are substantially different. Any person may accomplish the result performed by a patented thing without infringing the patent, if he uses means substantially different from those of the patent.¹⁶ To hold the contrary of this rule would be to retard, and not to promote the progress of the useful arts.¹⁷ So also, on the other hand, the result of an alleged infringing machine or manufacture may be different from the result described in the patent without causing that machine or manufacture to escape the charge of infringement, even when that charge is based on unlicensed using. This rule results from the well-established point of law that it is an infringement of a patent to use any machine or manufacture claimed therein, though such use is for a purpose which is not mentioned in the patent.¹⁸ But a machine, which can do a particular kind of work, is not an infringement of a patent on a different machine, which cannot do the same work.¹⁹

¹⁵ *Westinghouse v. Boyden Power-Brake Co.*, 170 U. S. 562, 1898; *Powell v. Leicester Mills Co.*, 103 F. R. 485, 1900; *American Fur Refining Co. v. Cimiotti Unhairing Mach. Co.*, 123 F. R. 874, 1903.

¹⁶ *O'Reilly v. Morse*, 15 Howard, 62, 1853; *Steam Gauge & Lantern Co. v. Mfg. Co.*, 29 F. R. 447, 1886; *Johnson Furnace Co. v. Western Furnace Co.*, 178 F. R. 819, 1910.

¹⁷ *Smith v. Downing*, 1 Fisher, 84, 1850.

¹⁸ *Mabie v. Haskell*, 2 Cliff. 511,

1865; *McComb v. Brodie*, 1 Woods, 159, 1871; *Zinn v. Weiss*, 7 F. R. 916, 1881; *Union Stone Co. v. Allen*, 14 F. R. 353, 1882; *Cincinnati Ice Machine Co. v. Brewing Co.*, 31 F. R. 472, 1887.

¹⁹ *Norton v. Jensen*, 49 F. R. 875, 1892; *Ford v. Bancroft*, 98 F. R. 309, 1899; *Miller v. Last Co.*, 105 F. R. 525, 1900; *Branson v. Kutz*, 105 F. R. 974, 1901; *Davey Pegging Mach. Co. v. Prouty*, 107 F. R. 510, 1901; *General Electric Co. v. Brooklyn Heights R. Co.*, 118 F. R. 154, 1902.

§ 341. Mode of operation is a criterion of infringement on one side of that question, but not on the other. If the mode of operation of an alleged infringing thing is substantially different from that covered by the claim alleged to be infringed, it follows that the charge of infringement must be negatived;²⁰ but if the mode of operation is substantially the same, it does not follow that the charge of infringement must be affirmed.²¹ In that case the question must be decided by some additional criterion. To establish an infringement of a claim, the facts must be subjected to several successive tests. If the case fails on either of those tests, no further inquiry need be made; but an infringement cannot be affirmed till all those tests have been applied and have been withstood. The first of these is that which relates to identity of mode of operation. It is therefore important to know wherein this requisite identity consists. A dogmatic statement on that point has probably never been ventured by any court. The nature of the question seems not to admit of an answer which shall be at once short and sufficient. The best way to investigate the subject is probably to reason by analogy from precedents; and accordingly several of the sections which immediately follow, are devoted to an analysis of cases, with a view to furnishing the investigator with data for such reasoning.

§ 342. The Cawood patent²² covered a machine which combined the mode of operation of an anvil, with the mode

²⁰ *Field v. De Comeau*, 116 U. S. 187, 1886; *Yale Lock Co. v. Sargent*, 117 U. S. 378, 1886; *Smith v. Downing*, 1 Fisher, 83, 1850; *Eames v. Cook*, 2 Fisher, 149, 1860; *Enterprise Co. v. Snow*, 80 F. R. 537, 1897; *Westinghouse Air-Brake Co. v. New York Air-*

Brake Co., 119 F. R. 884, 1902; *American Steel & Wire Co. v. Denning Wire & Fence Co.*, 194 F. R. 117, 1912.

²¹ *Diamond Drill & Mach. Co. v. Kelly Bros.*, 120 F. R. 293, 1903.

²² *Cawood Patent*, 94 U. S. 706, 1876.

of operation of a vise. A drawing of the machine is printed on page 492 of 1 Wallace. The railroad rail mended upon it, was supported by it as by an anvil; and at the same time was clasped by it as by a vise. The Supreme Court held that the "Michigan Southern" machine did not infringe the Cawood patent, because while that machine did clasp the rail as a vise, it did not support the rail as an anvil. The same tribunal also held that the Beebe and Smith machine did not infringe the Cawood patent, because its mode of operation was different. It both supported and clasped the rail; but it clasped it by holding it between two jaws, which jaws, when in position, rested in a V-shaped notch in the anvil. The exterior of the jaws were also V-shaped, in order to fit the notch, and they clasped the rail because of their gravity, and not in the manner of a vise. They also supported the rail, but in a manner peculiar to themselves, and not in the manner of an anvil.

§ 343. The driven-well patent, reissue No. 4372, covers an interesting invention. That invention is practiced by driving into the ground a long tube closed and pointed at its lower end, and having perforations through its sides just above that end; and by attaching a pump to its upper end; and by working that pump whenever water is desired. The mode of operation of that well is as follows: The working of the pump rarefies the air in the tube, and outside of the tube in the neighborhood of its lower end, and that rarefaction causes the air above the ground to force the water in several millions of cubic feet of the surrounding earth, into and up the tube.

The alleged infringer in one case,²³ followed the patent in every particular except that instead of driving the tube into the earth, or into a hole previously made by driving

²³ Andrews v. Long, 12 F. R. 871, 1880.

down a rod smaller than the tube, he bored a hole into the earth with an auger larger than the tube which he placed in the hole after the auger was withdrawn. This apparently slight change caused the well to have a substantially different mode of operation from that covered by the patent. The pump, indeed, rarefied the air in the tube as before, but that rarefaction did not extend into the ground around the outside of the tube, because the space outside of the lower end of the tube was in direct communication with external air, through the annular space which surrounded the tube throughout its entire length, and which was due to the fact that the tube was smaller than the hole in which it was placed. Because of this difference, Judge McCrary, with excellent discrimination, held that the well of the defendant did not infringe the driven-well reissue.

§ 344. Blanchard's patent for a machine for turning and cutting irregular forms consisted of a combination of a model, a guide, and a cutter-wheel. When the machine was in operation, the guide followed the irregularities of the model, as the model revolved; and the guide also caused the cutter to follow the same irregular curves, while the rough block was revolved under the cutting edges. Both model and block had a continuous lateral motion, as well as a continuous rotary motion, and therefore the guide and the cutter-wheel proceeded in corresponding spiral courses. In that way, the guide traversed all parts of the surface of the model, and the cutter-wheel traversed all portions of the rough block, and thus reduced the latter to conformity with the shape of the model. An infringer in one case²⁴ so combined the parts of the machine that the model and rough block both rotated by an intermittent motion, and moved laterally by a rectilinear recipro-

²⁴ Blanchard v. Reeves, 1 Fisher, 103, 1850.

eating motion. Justice GRIER held that this mode of operation was substantially unchanged from that of the patent.

§ 345. Hayden's patent for a machine for making brass kettles consisted of two general divisions. 1. An engine lathe with its mandrel to revolve the pulleys and the gearing, and having special devices for the special work in hand. 2. A burnishing or spinning tool and tool carriage, secured to the frame of the lathe, and having special devices to make it work harmoniously with the lathe in producing the kettles which the two divisions of the machine jointly operated to manufacture. These two divisions were operated by one moving thing, like a shaft, which might be connected with a water wheel, or with a steam engine, or with any other suitable motor.

The infringer in one case ²⁵ operated the first division of the machine by one such motive power; but he operated the second division by another, namely, by the hand of a workman turning a crank. Judge WOODRUFF held that this was not such a change of mode of operation as amounted to enough to negative infringement.

§ 346. The Wells hat-body machine consisted of a revolving brush to separate and throw fibres of fur; a perforated vacuum cone to receive the fur on its exterior surface; and an intermediate tunnel, to guide the fur from the brush to the cone. The patent which was granted for that invention was three times surrendered and reissued. The second reissue was involved in a celebrated Supreme Court case.²⁶ That reissue described the machine which Wells invented, and it claimed the mode of operation, substantially as described, of forming "bats" (hat bodies) of fur fibres. The object of this claim was to cover

²⁵ Waterbury Brass Co. v. Miller, 9 Blatch. 94, 1871.

²⁶ Burr v. Duryee, 1 Wallace, 531, 1863.

the machine of Seth Boyden; a machine which had the same general mode of operation as that of Wells, but which was substantially different from the latter in one of its parts. This attempt to base a charge of infringement on sameness of "mode of operation" alone was occasioned by the fact that Justice CURTIS, in delivering the opinion of the Supreme Court in the case of *Winans v. Denmead*,²⁷ had used the phrase with great frequency. He used it exactly twenty times in that case; and the counsel for the Wells patent, when arguing the case of *Burr v. Duryee*, formulated seven doctrines which they stated were deducible from that score of instances. Among those doctrines the fourth was this: That copying a mode of operation is an infringement. But Justice GRIER, who was one of the majority of the court which decided *Winans v. Denmead*, was convinced that the latter decision was erroneous, or that it did not mean what it was generally understood to signify, for in *Burr v. Duryee* he delivered the unanimous opinion of the Supreme Court rejecting the complainant's contention. The case of *Winans v. Denmead* cannot therefore be fairly cited as an authority on this point, for if it is not consistent with *Burr v. Duryee*, it was overruled by the latter, and if it is consistent with the latter case, its expressions are likely at least to mislead the reader, as they misled the counsel for the Wells patent. Harmoniously with its decision in *Burr v. Duryee*, the Supreme Court has since had a positive tendency to disregard whatever is abstract and intangible in questions of infringement, and to base its conclusions upon the concrete features of the issues at bar.

§ 346a. The Pope electric railroad signal consisted of the combination of an electric battery; a peculiar arrangement of electric circuits; and two or more circuit closers,

²⁷ *Winans v. Denmead*, 15 Howard, 330, 1853.

operating two or more visual or audible signals, situated at intervals along the line of a railroad. That peculiar arrangement of electric circuits essentially consisted in attaching two line wires to the positive and negative poles of a battery, respectively; and in extending both of those wires any required distance in a direction substantially parallel to the line of the railroad; and insulating both from the earth and from each other; and in connecting one of them at intervals with insulated rails in one of the two lines of rails of the railroad track; and in connecting the other one of those wires at the same intervals with insulated rails in the other line of rails of the same track; and interposing an electromagnet at some point in each of these latter connections. An alleged infringer in one case²⁸ used an electric railroad signal differing from that of Pope mainly in the peculiar arrangement of the electric circuits. That difference consisted mainly in disconnecting the negative pole of the battery from its line wire, and in connecting that pole with the earth adjacent thereto, and in connecting the remote end of the disconnected line wire with the earth adjacent to that end. These changes of arrangement changed the mode of operation of the apparatus, in that they caused the electricity to traverse circuits of equal length when the series of circuit closers were successively operated, whereas Pope's arrangement caused the electricity to traverse circuits of widely variant lengths at such times. This change of mode of operation resulted in a uniformity of electrical resistance among all the circuits, and thus much increased the utility of the apparatus. The Supreme Court therefore held the alleged infringer's combination to be an independent invention, substantially different from that of Pope, and not an infringement of his patent.

²⁸ *Electric Signal Co. v. Hall Signal Co.*, 114 U. S. 87, 1885.

§ 347. Addition to a patented machine or manufacture does not enable him who makes, uses, or sells the patented thing with the addition, to avoid a charge of infringement.²⁹ This is true even where the added device facilitates the working of one of the parts of the patented combination, and thus makes the latter perform its function with more excellence and greater speed;³⁰ or where the added part hinders the patented combination from having some of its minor merits.³¹ And duplication in a machine or manufacture, of one of its parts or features, is but a form of addition thereto; and falls in the same category, in respect of not avoiding infringement of a patent on that machine or manufacture.³² But if a patented combination differs from some older combination, only in the omission of one of the parts of the latter; and in a resulting difference of mode of operation, the restoration of the older structure by adding the part which the patented combination omitted, would not constitute an infringement of the latter.³³

²⁹ *Western Electric Co. v. La Rue*, 139 U. S. 607, 1891; *Carr v. Rice*, 1 Fisher, 209, 1856; *Roemer v. Simon*, 20 F. R. 197, 1884; *Royer v. Coupe*, 29 F. R. 366, 1886; *Filley v. Stove Co.*, 30 F. R. 434, 1887; *Williames v. Barnard*, 41 F. R. 358, 1890; *Goshen Sweeper Co. v. Bissell Sweeper Co.*, 72 F. R. 67, 1895; *Sprague Electric Railway & Motor Co. v. Union Ry. Co.*, 84 F. R. 641, 1898; *Western Electric Co. v. Capital Tel. & Tel. Co.*, 86 F. R. 778, 1898; *Newton v. McGuire*, 97 F. R. 614, 1899; *1900 Washer Co. v. Cramer*, 169 F. R. 629, 1909.

See Section 376.

³⁰ *Cochrane v. Deener*, 94 U. S. 786, 1876; *Brislin v. Carnegie Steel Co.*, 118 F. R. 597, 1902; *Columbia Wire Co. v. Kokomo Steel & Wire Co.*, 143 F. R. 116, 1905.

³¹ *Sawyer Spindle Co. v. Morrison Co.*, 52 F. R. 593, 1892; *Am. Laundry Mach. Mfg. Co. v. Adams Laundry Mach. Co.*, 161 F. R. 556, 1908.

³² *Goldie v. Diamond State Iron Co.*, 81 F. R. 176, 1897; *General Compressed Air, etc., Co. v. American Air Cleaning Co.*, 177 F. R. 272, 1910.

³³ *Shoemaker v. Merrow*, 61

§ 348. Changing the relative positions of the parts of a machine or manufacture does not avert infringement, where the parts transposed perform the same respective functions after the change as before.³⁴ In the first of the cases just cited, the thing transposed was a beater shaft in a corn-sheller. Both in its original and in its new position, its function was to force the ears of corn into the throat of the sheller. In the second case, the thing transposed was the outlet vapor flue of a quicksilver furnace; and that flue operated in the same way to perform the same function in the infringing apparatus that it did in the patented furnace.

But changing the relative positions of the parts of a machine does avert infringement, where the changing of these positions so changes the functions of the parts, that the machine acquires a substantially different mode of operation, even though the result of the machine remains the same.³⁵ A suit for infringement cannot be sustained against him who makes, uses, or sells a substantially different combination, even though it includes exactly the same ingredients as those claimed in combination by the patent in suit.³⁶ The owner of a patent for a combination can-

F. R. 948, 1894; *Am. Laundry Mach. Mfg. Co. v. Adams Laundry Mfg. Co.*, 161 F. R. 556, 1908.

³⁴ *Adams v. Mfg. Co.*, 3 Bann. & Ard. 1, 1877; *Knox v. Quicksilver Mining Co.*, 6 Sawyer, 438, 1878; *Northwestern Horse Nail Co. v. Horse Nail Co.*, 28 F. R. 234, 1886; *Consolidated Roller Mill Co. v. Coombs*, 39 F. R. 33, 1889; *Devlin v. Paynter*, 64 F. R. 400, 1894; *Huntington Dry Pulverizer Co. v. Whittaker Cement Co.*, 89 F. R. 328, 1898; *Union*

Steam-Pump Co. v. Battle Creek Steam-Pump Co., 104 F. R. 342, 1900; *Metallic Extraction Co. v. Brown*, 104 F. R. 352, 1900; *Brislin v. Carnegie Steel Co.*, 118 F. R. 591, 1902; *Anchor Cap & Closure Corp. v. Pritchard*, 232 F. R. 156, 1916.

³⁵ *Brooks v. Fiske*, 15 Howard, 221, 1853; *Union Steam-Pump Co. v. Battle Creek Steam-Pump Co.*, 104 F. R. 343, 1900.

³⁶ *Gill v. Wells*, 22 Wallace, 14, 1874; *Snow v. Railway Co.*, 121

not suppress a newer, better, and substantially different combination of the same ingredients.³⁷

§ 349. Omission of one element or ingredient of a combination covered by any claim of a patent, averts any charge of infringement based on that claim,³⁸ whether or not the omitted ingredient was essential to the combination of the patent, and whether or not it was necessary to the operativeness of the device.³⁹ And it makes no difference that another element is made to do the work of itself and of the omitted element.⁴⁰ A combination is an entirety. If one of its elements is omitted, the thing claimed disappears. Every part of the combination claimed is conclusively presumed to be material to the combination, and no evidence to the contrary is admissible

U. S. 629, 1886; *Singer Mfg. Co. v. Brill*, 54 F. R. 384, 1892.

³⁷ *Seymour v. Osborne*, 11 Wallace, 555, 1870.

³⁸ *Prouty v. Ruggles*, 16 Peters, 341, 1842; *Eames v. Godfrey*, 1 Wallace, 78, 1863; *Case v. Brown*, 2 Wallace, 328, 1864; *Dunbar v. Myers*, 94 U. S. 187, 1876; *Fuller v. Yentzer*, 94 U. S. 297, 1876; *Rowell v. Lindsay*, 113 U. S. 102, 1884; *Shepard v. Carrigan*, 116 U. S. 597, 1885; *Sharp v. Riessner*, 119 U. S. 636, 1886; *Derby v. Thompson*, 146 U. S. 482, 1892; *Weatherhead v. Coupe*, 147 U. S. 335, 1893; *Dobson v. Cubley*, 149 U. S. 120, 1893; *Wright v. Yuengling*, 155 U. S. 52, 1894; *Black Diamond Coal Co. v. Excelsior Coal Co.*, 156 U. S. 617, 1895; *Levy v. Harris*, 130 F. R. 711, 1904; *Mallon v. Gregg & Co.*, 137

F. R. 68, 1905; *Central Foundry Co. v. Coughlin*, 141 F. R. 91, 1905; *Consolidated Engine Stop Co. v. Landers, Frary & Clarke*, 160 F. R. 79, 1908; *Portland Gold Mining Co. v. Hermann*, 160 F. R. 91, 1908; *Electric Protection Co. v. American Bank Protection Co.*, 184 F. R. 916, 1910; *National Cash Register Co. v. Gratigny*, 213 F. R. 463, 1914; *Steiger v. Waite Grass Carpet Co.*, 213 F. R. 798, 1914; *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 198 U. S. 399, 1905; *Proudfit Loose Leaf Co. v. Kalamazoo Loose Leaf Binder Co.*, 230 F. R. 120, 1915.

³⁹ *Hall-Mammoth Incubator Co. v. Teabout*, 215 F. R. 109, 1914.

⁴⁰ *Underwood Typewriter Co. v. Royal Typewriter Co.*, 224 F. R. 477, 1915.

in any case of alleged infringement.⁴¹ The patentee makes all the parts of a combination material, when he claims them in combination and not separately.⁴² A patentee may, however, describe all the devices in his machine or manufacture, and instead of claiming all or any particular portion of them in combination, may claim so much of the described mechanism as produces a particular described result.⁴³ Such a claim is infringed by him who, without ownership or license, makes, uses, or sells any apparatus made up of enough of the described devices to produce the specified result, by the specified mode of operation.⁴⁴ The rule stated at the head of this section is perhaps the best known and most frequently applied of all the rules which pertain to infringement; but it has no application to anything which depends upon a particular form for patentability, and which, for convenience, may be made in several sections. A shoe last, for example, even if made in only two sections, may infringe a patent for a last of the same shape, but which is made in three sections instead of in two.⁴⁵ And infringement is not averted by uniting two elements of a machine or manufacture into one integral part, if the united part performs

⁴¹ *Vance v. Campbell*, 1 Black, 430, 1861; *Fay v. Cordesman*, 109 U. S. 420, 1883; *Sargent v. Lock Co.*, 114 U. S. 86, 1884; *Shepard v. Carrigan*, 116 U. S. 597, 1885; *Yale Lock Co. v. Sargent*, 117 U. S. 378, 1885; *McClain v. Ort-mayer*, 141 U. S. 425, 1891; *Hubbell v. United States*, 179 U. S. 82, 1900.

⁴² *Water-Meter Co. v. Desper*, 101 U. S. 332, 1879; *Brown v. Davis*, 116 U. S. 249, 1885; *Williams v. Stolzenbach*, 23 F. R.

41, 1885; *Otley v. Watkins*, 36 F. R. 324, 1888; *Levy v. Harris*, 124 F. R. 71, 1903; *Electric Protection Co. v. American Bank Protection Co.*, 184 F. R. 916, 1910.

⁴³ *Parsons v. Seelye*, 100 F. R. 458, 1900.

⁴⁴ *Silsby v. Foote*, 14 Howard, 218, 1852.

⁴⁵ *Mabie v. Haskell*, 2 Cliff. 511, 1865; *White v. Walbridge*, 46 F. R. 526, 1891.

the same function in substantially the same way, as did the separate parts before the union; ⁴⁶ nor by the separation of one integral part into two, the two parts doing substantially what was done by the single part. ⁴⁷

§ 350. No substitution of an equivalent, for any ingredient of a combination covered by any claim of a patent, can avert a charge of infringement of that claim, ⁴⁸ whether or not the equivalent is mentioned in the patent. ⁴⁹ But like substitution of something which is not an equivalent, will have that effect. ⁵⁰ The doctrine of equivalents may be invoked by any patentee, whether he claimed

⁴⁶ *Bundy Mfg. Co. v. Detroit Time-Register Co.*, 94 F. R. 538, 1899; *Nathan v. Howard*, 143 F. R. 889, 1906; *Lidgerwood Mfg. Co. v. Lambert Hoisting Engine Co.*, 150 F. R. 364, 1906; *Weber v. Automobile & Accessories Mfg. Co.*, 190 F. R. 189, 1911; *Hall Mammoth Incubator Co. v. Teabout*, 205 F. R. 906, 1913; *Grupe Drier & Boiler Co. v. Geiger, Fiske & Koop*, 215 F. R. 110, 1914; *New York Scaffolding Co. v. Whitney*, 224 F. R. 452, 1915.

But distinguished from *Underwood Typewriter Co. v. Royal Typewriter Co.*, 224 F. R. 477, where after the omission a remaining element is made to do double work.

⁴⁷ *Nathan v. Howard*, 143 F. R. 889, 1906; *Kelsey Heating Co. v. James Spear Stove, etc., Co.*, 155 F. R. 976, 1907; *Western Tube Co. v. Rainer*, 156 F. R. 49, 1907;

Kings County Raisin, etc., Co. v. U. S. Consolidated, etc., Co., 182 F. R. 59, 1910; *Hall Mammoth Incubator Co. v. Teabout*, 205 F. R. 906, 1913; *Proudfit Loose Leaf Co. v. Kalamazoo Loose Leaf Binder Co.*, 230 F. R. 120, 1915; *Yancey v. Enright*, 230 F. R. 641, 1916.

⁴⁸ *O'Reilly v. Morse*, 15 Howard, 62, 1853; *Imhaeuser v. Buerk*, 101 U. S. 655, 1879; *Reed v. Chase*, 25 F. R. 94, 1885; *American Box Machine Co. v. Day*, 32 F. R. 585, 1887; *Ligowski Clay-Pigeon Co. v. Clay-Bird Co.*, 34 F. R. 331, 1888.

⁴⁹ *Treibacher-Chemische Werke, etc., Co. v. Roessler & Hasslacher Chemical Co.*, 219 F. R. 210, 1914.

⁵⁰ *Railway Co. v. Sayles*, 97 U. S. 562, 1878; *Brown v. Puget Sound Reduction Co.*, 110 F. R. 388, 1901.

equivalents in his claim,⁵¹ or described any in his specification,⁵² or omitted to do either or both of those things. The patentee, having described his invention and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of these forms.⁵³ Combination patents would generally be valueless in the absence of a right to equivalents, for few combinations now exist, or can hereafter be made, which do not contain at least one element, an efficient substitute for which could readily be suggested by any person skilled in the particular art.⁵⁴ But where a patentee states in his specification that a particular part of his invention is to be constructed of a particular material, and states or implies that he does not contemplate any other material as being suitable for the purpose, it is not certain that any other material will be treated by a court as an equivalent of the one recommended in the patent;⁵⁵ though celluloid has been held an equivalent of metal, in one well-considered case which depended upon the point.⁵⁶

§ 352. One thing, to be the equivalent of another,

⁵¹ *Dental Vulcanite Co. v. Davis*, 102 U. S. 229, 1880; *Hunt Bros. Fruit Packing Co. v. Cassidy*, 53 F. R. 261, 1892; *McCormick Mach. Co. v. Aultman*, 69 F. R. 393, 1895.

⁵² *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 2 Bann. & Ard. 594, 1877; *Welsbach Light Co. v. Sunlight Lamp Co.*, 87 F. R. 224, 1898.

⁵³ *Western Electric Co. v. La Rue*, 139 U. S. 606, 1891.

⁵⁴ *Thrall v. Poole*, 89 F. R. 721, 1898.

⁵⁵ *Aiken v. Bemis*, 3 Woodbury & Minot, 348, 1847; *Harris v. Allen*, 15 F. R. 106, 1883; *Schilling v. Cranford*, 37 O. G. 1349, 1885; *Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co.*, 61 F. R. 965, 1894; *Seabury v. Johnson*, 76 F. R. 456, 1896.

⁵⁶ *Thrall v. Poole*, 89 F. R. 718, 1898.

must perform the same functions as that other.⁵⁷ If it performs the same function, the fact that it also performs another function is immaterial to any question of infringement.⁵⁸ Therefore, it sometimes happens that a junior device is an equivalent of a senior device in a sense that will constitute it an infringement of a patent for the latter; at the same time that the senior device is not an equivalent of the junior device in a sense that will cause the former to negative invention or novelty in the latter.⁵⁹ One thing may accordingly be an equivalent of another, though it does more than that other, but it cannot be such an equivalent if it does less.⁶⁰ But the test of function is only the first of several tests of equivalency. The fact that one thing performs the same function as another, though necessary, is not sufficient to make it an equivalent thereof.⁶¹

§ 353. Function must be performed in substantially the same way by an alleged equivalent, as by the thing

⁵⁷ *Machine Co. v. Murphy*, 97 U. S. 125, 1877; *Rowell v. Lindsay*, 113 U. S. 103, 1884; *Roller Mill Patent*, 156 U. S. 271, 1895; *Railway Mfg. Co. v. Railroad Co.*, 30 F. R. 238, 1887; *Seeley v. Brush Electric Co.*, 44 F. R. 420, 1890; *Farmers' Mfg. Co. v. Spruks Mfg. Co.*, 119 F. R. 599, 1902.

⁵⁸ *Foss v. Herbert*, 2 Fisher, 31, 1856; *Sarven v. Hall*, 9 Blatch. 524, 1872; *Wheeler v. Reaper Co.*, 10 Blatch. 195, 1872; *Kendrick v. Emmons*, 3 Bann. & Ard. 623, 1878; *Norton v. California Can Co.*, 45 F. R. 638, 1891; *Masseth v. Palm*, 51 F. R. 825, 1892; *Comptograph Co. v. Mechanical*

Accountant Co., 145 F. R. 331, 1906. See Section 376.

⁵⁹ *In re Hebard*, 1 McArthur's Patent Cases, 550, 1857; *Loercher v. Crandall*, 11 F. R. 857, 1881; Section 36 of this book; *Curry v. Union Electric Welding Co.*, 230 F. R. 422, 1916.

⁶⁰ *Bliss v. Haight*, 3 Fisher, 626, 1869; *Engle Sanitary & Cremation Co. v. City of Elwood*, 73 F. R. 486, 1896.

⁶¹ *Eames v. Godfrey*, 1 Wallace, 78, 1863; *Westinghouse v. Boyden Power-Brake Co.*, 170 U. S. 569, 1898; *Conover v. Roach*, 4 Fisher, 12, 1857; *Merriam v. Drake*, 5 Fisher, 259, 1872.

of which it is alleged to be an equivalent, in order to constitute it such.⁶² This substantial sameness of way is not necessarily an identity of merit,⁶³ nor a theoretical scientific sameness.⁶⁴ In a purely scientific sense, a screw always performs its function in a substantially different way from a lever, and in substantially the same way as a wedge. Screws and wedges are equally inclined planes, while a lever is an entirely different elementary power. But screws and levers can practically be substituted for each other in a larger number of machines than screws and wedges can be similarly substituted. When a lever and a screw can be interchanged and still perform the same function with a result that is beneficially the same, they are said to perform the same function in substantially the same way.⁶⁵ Levers and springs are also used interchangeably in the arts, and constitute another example of equivalency.⁶⁶

But one thing may be an equivalent of another in one environment, and not such an equivalent in another

⁶² *Burr v. Duryee*, 1 Wallace, 573, 1863; *Werner v. King*, 96 U. S. 230, 1877; *Dryfoos v. Wiese*, 124 U. S. 37, 1887; *Fornerook v. Root*, 127 U. S. 181, 1887; *Sargent v. Burgess*, 129 U. S. 19, 1889; *Sickles v. Borden*, 3 Blatch. 535, 1856; *Peard v. Johnson*, 23 F. R. 509, 1885; *Tonduer v. Chambers*, 37 F. R. 337, 1889; *Pacific Cable Railway Co. v. Butte City Ry. Co.*, 58 F. R. 420, 1893; *Carter Mach. Co. v. Hanes*, 70 F. R. 865, 1895; *Engle Sanitary & Cremation Co. v. City of Elwood*, 73 F. R. 486, 1896; *Pittsburg Meter Co. v. Pittsburg Supply Co.*, 109

F. R. 644, 1901; *Farmers' Mfg. Co. v. Spruks Mfg. Co.*, 119 F. R. 599, 1902.

⁶³ *Brush v. Condit*, 132 U. S. 49, 1889; *Roosevelt v. Telegraph Co.*, 33 F. R. 510, 1887; *Standard Folding Bed Co. v. Osgood*, 58 F. R. 584, 1893; *National Binding Machine Co. v. James D. M'Laurin Co.*, 186 F. R. 992, 1911.

⁶⁴ *Gordon v. Warder*, 150 U. S. 52, 1893.

⁶⁵ *Turrell v. Spaeth*, 3 Bann. & Ard. 458, 1878.

⁶⁶ *Gould Coupler Co. v. Pratt*, 70 F. R. 627, 1895.

situation.⁶⁷ Springs and weights are generally equivalents; ⁶⁸ but where the environment is such that a spring will operate successfully while a weight will not so operate, there they are not equivalents.⁶⁹ While in most cases a mere handle is not an equivalent of a lever, it is such an equivalent where its connections are such that it performs the same function in substantially the same way.⁷⁰ But infringement is averted by using a hand, instead of a lever of a claimed combination, to work a rod.⁷¹ However, in one case, the Supreme Court went to the length of deciding a confined column of water in a cylinder, worked by a pump and working a piston, to be an equivalent of a combination of a vibrating arm, toggle joint, and other mechanical devices, when used to transmit vibratory power.⁷² This decision may seem, superficially, to be inconsistent with the much later declaration of the same court, that interchangeability or non-interchangeability, is an important test in determining the question of infringement.⁷³ That view has already been recognized by several lower courts,⁷⁴ and is likely to persist. But in-

⁶⁷ *Cochrane v. Deener*, 94 U. S. 789, 1876; *Hubel v. Dick*, 28 F. R. 136, 1886.

⁶⁸ *Imhaeuser v. Buerk*, 101 U. S. 656, 1879; *American Roll Paper Co. v. Weston*, 45 F. R. 692, 1891; *Taws v. Laughlins*, 70 F. R. 108, 1895.

⁶⁹ *Cross v. Mackinnon*, 11 F. R. 601, 1882.

⁷⁰ *Corn-Planter Patent*, 23 Wallace, 235, 1874; *Steam Gauge & Lantern Co. v. Mfg. Co.*, 28 F. R. 619, 1886.

⁷¹ *Brown v. Davis*, 116 U. S. 249, 1885.

⁷² *Blake v. Robertson*, 94 U. S. 732, 1876.

⁷³ *Miller v. Eagle Co.*, 151 U. S. 208, 1894.

⁷⁴ *Campbell Printing-Press Co. v. Duplex Printing-Press Co.*, 86 F. R. 322, 1898; *Pittsburg Meter Co. v. Pittsburg Supply Co.*, 109 F. R. 651, 1901; *Crown Cork & Seal Co. v. Imperial Bottle Cap Co.*, 123 F. R. 669, 1903; *American Pneumatic Tool Co. v. Philadelphia Pneumatic Tool Co.*, 123 F. R. 896, 1903.

terchangeability usually requires change of form, in order to fit the thing interchanged to its new environment. Therefore it appears that the non-interchangeability referred to by the Supreme Court in this connection, involves such radical unfitness for a proposed position and function, as cannot be removed by any change of form.⁷⁵ There was no such radical unfitness in the hydraulic apparatus involved in the case of *Robertson v. Blake*, for the position and function of the mechanical apparatus for which it was substituted; and therefore there is no inconsistency between that case, and the later cases which have been developing the doctrine of the test of interchangeability.

§ 354. Whether a device, in order to be an equivalent of another, must have been known at the time of the invention of the machine which contains the latter, is a question which was elaborately investigated and discussed in Sections 354 to 358 of the first two editions of this book; because it appeared to be not only important, but also unsettled. But the weight of reason was always much on the side of the negative of that question; and the weight of authority has now accumulated so preponderatingly upon the same side, that the question may now be held to be settled in the negative.⁷⁶ An apparent excep-

⁷⁵ *Alaska Packers' Association v. Letson*, 119 F. R. 611, 1902.

⁷⁶ *O'Reilly v. Morse*, 15 Howard, 123, 1853; *Burr v. Duryee*, 1 Wallace, 573, 1863; *Mason v. Graham*, 23 Wallace, 275, 1874; *Cochrane v. Deener*, 94 U. S. 780, 1876; *Union Paper Bag Machine Co. v. Murphy*, 97 U. S. 125, 1877; *Clough v. Mfg. Co.*, 106 U. S. 178, 1882; *Cantrell v. Wallick*, 117

U. S. 695, 1885; *Sickles v. Borden*, 3 Blatch. 535, 1856; *Cahoon v. Ring*, 1 Cliff. 620, 1861; *Roberts v. Harnden*, 2 Cliff. 506, 1865; *Graham v. Mason*, 5 Fisher, 11, 1869; *Harwood v. Mfg. Co.*, 3 Fisher, 530, 1869; *Vogler v. Semple*, 7 Bissell, 382, 1877; *Potter v. Stewart*, 18 Blatch. 563, 1881; *Evory v. Burt*, 15 F. R. 112, 1883; *United Nickel Co. v.*

tion has been made by one court which held a material which the patentee had tried unsuccessfully to use as an element of his combination but which was later successfully used by another cannot be an equivalent of the material actually described in the patent.⁷⁷ It is therefore safe to define an equivalent as a thing which performs the same function, and performs that function in substantially the same manner, as the thing of which it is alleged to be an equivalent.

§ 359. Primary inventions are entitled to a somewhat looser application of this definition of an equivalent than those inventions which are secondary.⁷⁸ But a patentee is not to be denied the benefit of the doctrine of equiv-

Pendleton, 15 F. R. 745, 1883; *Murphy v. Trenton Rubber Co.*, 45 F. R. 570, 1891; *Norton v. California Can Co.*, 45 F. R. 638, 1891; *Jones Co. v. Munger Co.*, 49 F. R. 67, 1891; *National Cash Register Co. v. American Cash Register Co.*, 53 F. R. 373, 1893; *Morrow v. Shoemaker*, 59 F. R. 128, 1893; *Beach v. Box Mach. Co.*, 63 F. R. 606, 1894; *Edison Electric Light Co. v. Boston Lamp Co.*, 62 F. R. 399, 1894; *Stahl v. Williams*, 64 F. R. 124, 1894; *McCormick Harvesting Mach. Co. v. Aultman*, 69 F. R. 386, 1895; *Gould Coupler Co. v. Pratt*, 70 F. R. 627, 1895; *Read Holliday & Sons v. Schulze-Berge*, 78 F. R. 496, 1896; *Kinloch Tel. Co. v. Western Electric Co.*, 113 F. R. 652, 1902.

⁷⁷ *Folger & Moriarty v. Dow*

Portable Electric Co., 128 F. R. 45, 1904.

⁷⁸ *Miller v. Eagle Co.*, 151 U. S. 207, 1894; *Westinghouse v. Boyden Power-Brake Co.*, 170 U. S. 562, 1898; *Dederick v. Seigmund*, 51 F. R. 235, 1892; *Welsbach Light Co. v. Sunlight Lamp Co.*, 87 F. R. 224, 1898; *National Cash Register Co. v. Leland*, 94 F. R. 513, 1899; *Bundy Mfg. Co. v. Detroit Time Register Co.*, 94 F. R. 540, 1899; *McBride v. Kingman*, 97 F. R. 219, 1899; *William Mann Co. v. Hoffmann*, 104 F. R. 254, 1900; *Rich v. Baldwin Tuthill & Bolton*, 133 F. R. 920, 1904; *Brothers v. Lidgerwood Mfg. Co.*, 223 F. R. 359, 1915; *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 198 U. S. 399, 1905; *Computing Scale Co. v. Automatic Scale Co.*, 204 U. S. 609, 1907.

alents to the extent necessary to protect his actual invention, although the invention may be a narrow one.⁷⁹ A fair statement of the rule is that "the range of equivalents covered by the patent corresponds with the character of the invention, and includes all forms which embody the substance of the invention, and by like mechanical co-operation effect substantially the same result."⁸⁰ Another very clear statement of the correct rule is found in the case of *Mallon v. Gregg & Co.*⁸¹ Other substantially similar expressions of the rule are found in the reported cases.⁸² In *Cimiotti Unhairing Co. v. American Fur Refining Co.*⁸³ the Supreme Court made the very confusing statement that "where the patent does not embody

⁷⁹ *Levy v. Harris*, 124 F. R. 69, 1903.

⁸⁰ *Dowagiac Mfg. Co. v. Brennan & Co.*, 127 F. R. 143, 1903.

⁸¹ *Mallon v. Gregg & Co.*, 137 F. R. 68, 1905.

⁸² *Sloan Filter Co. v. Portland Gold Mining Co.*, 139 F. R. 23, 1905; *Columbia Wire Co. v. Kokomo Steel & Wire Co.*, 143 F. R. 116, 1905; *Union Match Co. v. Diamond Match Co.*, 162 F. R. 148, 1908; *Lewis Blind Stitch Machine Co. v. Premium Mfg. Co.*, 163 F. R. 950, 1908; *Veneer Machinery Co. v. Grand Rapids Chair Co.*, 227 F. R. 419, 1915.

An apparently contrary doctrine is announced in some cases as, for instance: *Cumming v. Baker & Hamilton*, 144 F. R. 395, 1906, where the statement is made that in improvement patents "the

patentee is limited to the precise devices and combinations shown and claimed in his patent." If this and similar expressions mean literally what they say, it is suggested that the doctrine has little support either in logic or authority.

Other cases where expressions of the various doctrines are found are: *St Louis Street, etc., Co. v. Am. Street, etc., Co.*, 156 F. R. 574, 1907; *Hardison v. Brinkman*, 156 F. R. 962, 1907; *W. W. Sly Mfg. Co. v. Russell & Co.* (containing discussion of rule in Sixth Circuit) 189 F. R. 61, 1911; *Grand Rapids Show Case Co. v. Baker*, 216 F. R. 341, 1914; *Yancey v. Enright*, 230 F. R. 641, 1916.

⁸³ *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 198 U. S. 399, 1905.

a primary invention, but only an improvement on the prior art, and if defendant's machines can be differentiated the charge of infringement is not sustained," a statement which was substantially repeated in *Computing Scale Co. v. Automatic Scale Co.*⁸⁴ The doubt, however, was cleared up in the case of *Continental Paper Bag Company v. Eastern Paper Bag Company*,⁸⁵ where it was said, referring to the *Cimiotti* case and the *Computing Scale Co.* case: "It is manifest, therefore, that it was not meant to decide that only pioneer patents are entitled to invoke the doctrine of equivalents, but that it was decided that the range of equivalents depends upon and varies with the degree of invention." The latter proposition is therefore finally definitely settled as the law to be applied in determining the range of equivalents to which an inventor is entitled. In view of the "Paper Bag Patent Case," therefore, those who claim a proper range of equivalents in a secondary or narrow patent should not be alarmed by the statement in the later case of *Diamond Rubber Co. v. Consolidated Rubber Co.*⁸⁶ that a patent that is a "step only in the march of improvement" is "limited therefore to its precise form and elements."

A primary invention is one which performs a function never performed by any earlier invention;⁸⁷ while a secondary invention is one which performs a function previously

⁸⁴ *Computing Scale Co. v. Automatic Scale Co.*, 204 U. S. 609, 1907.

⁸⁵ *Continental Paper Bag Company v. Eastern Paper Bag Company*, 210 U. S. 405, 1908.

⁸⁶ *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U. S. 428, 1911.

⁸⁷ *Morley Machine Co. v. Lan-*

caster, 129 U. S. 273, 1889; *Cel-
luloid Mfg. Co. v. Arlington Mfg.
Co.*, 44 F. R. 86, 1890; *Norton v.
Jensen*, 49 F. R. 862, 1892; *Na-
tional Cash Register Co. v. Amer-
ican Cash Register Co.*, 53 F. R.
372, 1892; *Boston Lasting Mach.
Co. v. Woodward*, 53 F. R. 481,
1893.

performed by some earlier invention, but which performs that function in a substantially different way from any that preceded it.⁸⁸ The six leading Supreme Court cases, which have attended to the distinction now under treatment, attended thereto in the following terms.

In the first of these cases the court said: "If the patentee be the original inventor of the device or machine called the divider, he will have a right to treat as infringers all who make dividers operating on the same principle, and performing the same functions, by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original, and patentable as such. But if the invention claimed be itself but an improvement on a known machine by a mere change of form or combination of parts, the patentee cannot treat another as an infringer who has improved the original machine by use of a different form or combination performing the same functions. The inventor of the first improvement cannot invoke the doctrine of equivalents to suppress all other improvements which are not mere colorable invasions of the first."⁸⁹

In the second of these cases the court said: "In such cases, if one inventor precedes all the rest, and strikes out something which includes and underlies all that they produce, he acquires a monopoly, and subjects them to tribute. But if the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete whole, then each is entitled only to the specific form of device which he produces, and every other

⁸⁸ Butz Thermo-Electric Co. v. Howard, 405, 1857; also Wesel v. Electric Co., 36 F. R. 192, 1888; Writing Mach. Co. v. Book Typewriter Co., 108 F. R. 629, 1901.

⁸⁹ McCormick v. Talcott, 20 United Mattress Mach. Co., 139 F. R. 11, 1905; Central Foundry Co. v. Coughlin, 141 F. R. 91, 1905.

inventor is entitled to his own specific form, so long as it differs from those of his competitors, and does not include theirs.⁹⁰

In the third of these cases the court said: "Where an invention is one of a primary character, and the mechanical functions performed by the machine are, as a whole, entirely new, all subsequent machines which employ substantially the same means to accomplish the same result, are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine." And the court also said that secondary patents ought to receive a narrower construction than this.⁹¹

In the fourth of these cases, the Supreme Court concurred with the Circuit Court, and the Circuit Court of Appeals, in holding that the question of infringement depended upon the question whether the patents in suit were primary or were secondary. The Circuit Court had held them to be secondary, and had found non-infringement. The Circuit Court of Appeals had held one of the four patents in suit to be primary, and had found it to be infringed by the defendant's machine. The Supreme Court concurred with the Circuit Court on this issue of fact, and found non-infringement accordingly.⁹²

In the fifth of these cases the court said: "It is well settled that a greater degree of liberality and a wider range of equivalents are permitted where the patent is of a pioneer character than where the invention is simply an improvement, may be the last and successful step,

⁹⁰ *Railway Co. v. Sayles*, 97 U. S. 556, 1878.

⁹¹ *Morley Machine Co. v. Lancaster*, 129 U. S. 273, 1889.

⁹² *Kokomo Fence Mach. Co. v. Kitzelman*, 189 U. S. 8, 1903.

in the art theretofore partially developed by other inventors in the same field.”⁹³

The sixth of these cases was that of *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, and as shown in the first part of this section definitely settled the law to be that an inventor is entitled to a range of equivalents commensurate with the scope of his invention. Thus the old distinction between primary and secondary patents in respect to range of equivalents, if such distinction ever really existed, has been eradicated.

§ 362. The four leading cases and other cases on this subject,⁹⁴ teach general doctrines rather than precise rules; and those general doctrines may be concisely stated as follows:

There are two tests of equivalency. 1. Identity of function. 2. Substantial identity of way of performing that function.⁹⁵ Primary as well as secondary patents are infringed by no substitutions that do not fully respond to the first of these tests. The second of these tests is somewhat elastic, because it contains the word “substantial.” That word is allowed to condone more and more important differences in the case of a primary patent, than in the case of a secondary one.⁹⁶ In the case of

⁹³ *Cimiotto Unhairing Co. v. American Fur Refining Co.*, 198 U. S. 399, 1905.

⁹⁴ *Pope Mfg. Co. v. Gormully Mfg. Co.*, 144 U. S. 242, 1892; *Sessions v. Romadka*, 145 U. S. 45, 1892; *Knapp v. Morss*, 150 U. S. 230, 1893; *Miller v. Eagle Co.*, 151 U. S. 204, 1894.

⁹⁵ *Steam Gauge & Lantern Co. v. Rogers*, 29 F. R. 453, 1886; *Clark v. Wilson*, 30 F. R. 373, 1887; *Butz Thermo-Electric Co.*

v. Electric Co., 36 F. R. 195, 1888; *Harmon v. Struthers*, 43 F. R. 443, 1890; *National Typographic Co. v. New York Typograph Co.*, 46 F. R. 116, 1891; *New Departure Bell Co. v. Bevin Mfg. Co.*, 64 F. R. 864, 1894; *Read Machine Co. v. Jaburg*, 221 F. R. 662, 1915.

⁹⁶ *Miller v. Eagle Co.*, 151 U. S. 207, 1894; *McCormick Harvesting Mach. Co. v. Aultman*, 69 F. R. 393, 1895; *Welsbach Light Co. v. Sunlight Lamp Co.*, 87 F. R. 224,

a patent narrowed in construction by an extensive state of the preceding art, the word "substantial" will give but little elasticity to the application of the doctrine.⁹⁷ If fewer inventions preceded the one at bar, the word will have somewhat more of carrying power.⁹⁸ When the invention at bar is strictly primary, and especially if it is extremely useful, then the word "substantial" will be made to cover differences alike numerous and important, and even highly creditable to the infringer who invented them.⁹⁹

1898; *Eldred v. Kessler*, 106 F. R. 517, 1900; *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 F. R. 710, 1901; *Western Electric Co. v. Williams-Abbott Electric Co.*, 108 F. R. 955, 1901; *Adams Co. v. Schreiber & Conchar Mfg. Co.*, 111 F. R. 186, 1901; *Adam v. Folger*, 120 F. R. 263, 1903; *Carnegie Steel Co. v. Brislin*, 124 F. R. 220, 1903.

⁹⁷ *Duff v. Pump Co.*, 107 U. S. 639, 1882; *Knapp v. Morss*, 150 U. S. 230, 1893; *Boyd v. Janesville Hay Tool Co.*, 158 U. S. 267, 1895; *Dashiell v. Grosvenor*, 162 U. S. 432, 1896; *Dederick v. Seigund*, 51 F. R. 235, 1892; *Standard Folding Bed Co. v. Osgood*, 51 F. R. 678, 1892; *Joslin v. Northern Pacific Ry. Co.*, 55 F. R. 68, 1893; *Bundy Mfg. Co. v. Time Recorder Co.*, 64 F. R. 853, 1894; *Schuyler Electric Co. v. Electric Supply Co.*, 66 F. R. 315, 1895.

⁹⁸ *Reminder Lock Co. v. Adler*, 71 F. R. 185, 1895; *Boston & R.*

Electric St. Ry. Co. v. Bemis Car Box Co., 80 F. R. 287, 1897; *Penfield v. Chambers Bros. Co.*, 92 F. R. 649, 1899; *Brammer v. Schroeder*, 106 F. R. 920, 1901; *Writing Mach. Co. v. Book-Type-writer Co.*, 108 F. R. 629, 1901; *Dowagiac Mfg. Co. v. Minnesota Moline Plow Co.*, 118 F. R. 141, 1902; *Lamson Consolidated Store Service Co. v. Hillman*, 123 F. R. 423, 1903.

⁹⁹ *The Telephone Cases*, 126 U. S. 537, 1888; *American Bell Telephone Co. v. Spencer*, 8 F. R. 509, 1881; *American Bell Telephone Co. v. Dolbear*, 15 F. R. 488, 1883; *Hubel v. Dick*, 28 F. R. 136, 1886; *Brush Electric Co. v. Ft. Wayne Electric Co.*, 40 F. R. 833, 1889; *Rapid Store Service Ry. Co. v. Taylor*, 43 F. R. 256, 1887; *Harmon v. Struthers*, 43 F. R. 443, 1890; *Brush Electric Co. v. Electric Co.*, 43 F. R. 541, 1890; *Brush Electric Co. v. Electric Imp. Co.*, 52 F. R. 977, 1892; *National Cash Register Co. v.*

The rule has also been laid down that even though an invention is not generic, if it is one of exceptional merit, it is entitled to a liberal construction and a fair range of equivalents.¹⁰⁰

§ 362a. The broad statement is frequently made that the grant of a subsequent patent raises a legal presumption of patentable difference from an earlier invention.¹⁰¹ And the doctrine finds apparent support in the Supreme Court case of *Kokomo Fence Machine Co. v. Kitselman*.¹⁰² Such a general rule, however, ignores the distinction between improvements over prior structures and inventions of a different species.¹⁰³ As said in *Electric Candy Machine Co. v. Morris*:¹⁰⁴

“But it is claimed that the Kochs patent raises a *prima facie* presumption that there is a patentable difference between defendant’s machine and complainant’s machine. But this presumption does not exclude the fact that the

American Cash Register Co., 53 F. R. 372, 1892; *Mergenthaler Co. v. Press Pub. Co.*, 57 F. R. 505, 1893; *Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co.*, 61 F. R. 964, 1894; *Bowers v. Von Schmidt*, 63 F. R. 580, 1894; *Beach v. Box Mach. Co.*, 63 F. R. 606, 1894; *Rogers Typograph Co. v. Mergenthaler Co.*, 64 F. R. 803, 1894; *Bredin v. Solmson*, 132 F. R. 161, 1904.

¹⁰⁰ *Benbow-Brammer Mfg. Co. v. Straus*, 166 F. R. 114, 1908; *Hagan v. Swindell*, 204 F. R. 442, 1913.

¹⁰¹ *Milwaukee Carving Co. v. Brunswick-Balke-Collender Co.* (9th Circuit), 126 F. R. 171, 1903; *Century Electric Co. v. Westing-*

house Electric & Mfg. Co., 191 F. R. 350 (8th Circuit), 1911; *General Electric Co. v. Allis-Chalmers Co.*, 197 F. R. 558 (N. J.), 1912; *Gillette Safety Razor Co. v. Durham Duplex Razor Co.*, 197 F. R. 574, 1912; *Crowe v. Oscar Barnett Foundry Co.*, 206 F. R. 164, 1913; *Simplex Electric Heating Co. v. Leonard*, 180 F. R. 763, 1910.

¹⁰² *Kokomo Fence Machine Co. v. Kitselman*, 189 U. S. 8, 1903.

¹⁰³ *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, 1894.

See Section 184.

¹⁰⁴ *Electric Candy Machine Co. v. Morris*, 156 F. R. 972 (Mo.), 1905.

later patent may embody things which are the exclusive property of the complainant under a prior patent. In other words, it may be that Kochs' patent contains improvements which this complainant cannot use, but it does not follow that therefore Kochs' patent also absorbs improvements theretofore invented by and patented to complainant's assignors. If, therefore, as the court has found, defendant's machine infringed on certain essential features of complainant's machine, the mere fact that it is constructed in accordance with a subsequent patent issued to another party is no defense."

In the Kokomo case it will be noted that the court had before it two patents both of which were improvements on the prior art and it was said that "the presumption from the grant of the letters patent is that there was a substantial difference between the inventions." As there may be and in fact are, in the cases of a multitude of patents, improvements upon improvements as well as improvements of different species it must be admitted that the Kokomo case lends considerable judicial support to the doctrine, unless the court meant by the phrase "substantial difference" a difference in species. If, however, the court meant, as is said in substance in *Autopiano Co. v. Amphion Piano Player Co.*,¹⁰⁵ that the presumption arises only when one patent is not an improvement upon the other, the doctrine as thus modified would seem to be a reasonable application of the rule of presumption attaching to the issuance of a patent.

In view of the fact that the great bulk of patents issued are for improvements over the structures of prior patents the doctrine of the *Autopiano* case would seem to be sub-

¹⁰⁵ *Autopiano Co. v. Amphion Piano Player Co.*, 186 F. R. 159 (Second Circuit), 1911.

stantiated by actual facts. Further, it seems to be sustained by the weight of authority.¹⁰⁶ Of course if subordination to the patent in suit is expressly recognized in the subsequent patent no such presumption could be raised in any jurisdiction.¹⁰⁷ One court has said that if the Commissioner of Patents has held that no interference exists between the two patents the presumption is overcome.¹⁰⁸ Here again the same consideration exists that the subsequent patent may be merely an improvement over the prior patent and if such be the case and the claims be confined to the actual invention, the Commissioner would not declare that an interference existed. Another court has held that when the prior patent is for a primary invention the presumption that the later patent is for an improvement on the former is at least as strong as the presumption of the rule that the later patent is not an infringement,¹⁰⁹ with the result apparently that in such a case there is no presumption at all. The arguments for and against the doctrine in question and the modifications of it are well set forth in the case of *Herman v. Youngstown Car Mfg. Co.*¹¹⁰ where the Circuit Court of Appeals of the sixth circuit said:

“Defendant’s device is manufactured under patent No. 765,406, issued July 19, 1904, to J. H. Wagenhorst, and the court below gave to this fact some force in reaching his conclusion that the device did not infringe. We think that the granting of the later patent and defendant’s

¹⁰⁶ *Ries v. Barth Mfg. Co.*, 136 F. R. 850 (7th Circuit), 1905; *Cutler-Hammer Mfg. Co. v. Union Electric Mfg. Co.*, 147 F. R. 266 (Wisconsin), 1906.

¹⁰⁷ *Columbia Wire Co. v. Kokomo Steel & Wire Co.*, 143 F. R. 116 (2nd Circuit), 1905.

¹⁰⁸ *Century Electric Co. v. Westinghouse Electric & Mfg. Co.*, 191 F. R. 350, 1911.

¹⁰⁹ *Century Electric Co. v. Westinghouse Electric & Mfg. Co.*, 191 F. R. 350, 1911.

¹¹⁰ *Herman v. Youngstown Car Mfg. Co.*, 191 F. R. 579, 1911.

conformity thereto are not of importance in this case, on the infringement issue. There are expressions in some reported cases implying that by the later patent the government has granted a right to make and use the article so patented, and that such grant is inconsistent with any construction of the earlier patent which would forbid the manufacture of the later structure. Such implication rests on a fundamental error. A patent is not the grant of a right to make or use or sell. It does not, directly or indirectly, imply any such right. It grants only the right to exclude others. The supposition that a right to make is created by the patent grant is obviously inconsistent with the established distinctions between generic and specific patents, and with the well-known fact that a very considerable portion of the patents granted are in a field covered by a former relatively generic or basic patent, are tributary to such earlier patent, and cannot be practiced unless by license thereunder.

“Another reason sometimes advanced for supposing that the structure of the second does not infringe the claim of the first patent is that the Patent Office has declared that a patentable difference exists. The premise is sound, but not the conclusion. In examining the second application, the Patent Office has no concern with the scope of the claim of the first, and does not and must not pay any attention thereto. It is concerned only with the early disclosure by the specification and drawings. Patentable difference does not of itself tend to negative infringement. It may just as well be based upon infringement, plus improvement; an improvement may lie in addition, simplification, or variance. This is well illustrated by this Wagenhorst patent. The drawings show, and the specifications describe, a structure generally similar to Herman's, but each one of the 10 claims is found to be confined to some

modification and supposed improvement added to the underlying combinations of the earlier art.

“As the necessary result of the fundamental principles, it seems that the existence of the later patent can have no tendency to disprove infringement, unless, for other reasons, we have first reached the conclusion that the earlier patent is, as to the later structure, specific, and not generic. If we have reached that conclusion, and the correlative conclusion that the earlier patent is entitled only to a narrow range of equivalents, and if we find that the claims of the later patent embody no improvement feature whatever, we will then find our conclusion fortified by the Patent Office declaration that the two structures are different species of the same genus; but before we can so interpret the Patent Office action, we must have given to the earlier patent a construction which will of itself probably determine the question of infringement, and it is difficult to see how in deciding the underlying question material aid can be had from such Patent Office declaration.

“We find no authoritative decisions which go beyond the limits we have indicated. *Corning v. Burden*, 15 How. 252, 270, 14 L. Ed. 683, seems to be the basis of the later rulings. Its language is general. The report does not show the two patents fully enough to indicate any inconsistency with the ideas we have formulated; and the opinion antedates the Patent Office practice in force while all now existing patents were issued. *Blanchard v. Putnam*, 8 Wall. 420, 19 L. Ed. tends to limit, if not overrule, *Corning v. Burden*. The remark of Mr. Justice JACKSON in *Miller v. Eagle Co.*, 151 U. S. 186, 208, 14 Sup. Ct. 310, 38 L. Ed. 121, refers to patentable difference, not to non-infringement, and the case to which he refers (*Duff v. Sterling*, 107 U. S. 636, 2 Sup. Ct. 487, 27 L. Ed. 517) did

not involve the evidential force of the junior patent. In *Boyd v. Janesville, etc., Co.*, 158 U. S. 260, 15 Sup. Ct. 837, 39 L. Ed. 973, the court reaches the conclusion that the Boyd patent is specific, and then, in referring to defendant's patent, considers the structural differences which put the two patents in two specific classes. The sentence quoted with apparent approval from *Pavement Co. v. City of Elizabeth*, 4 Fish. 189, Fed. Cas. No. 312, was appropriate to that case, but, if applied generally, would overlook the distinction between patentable difference and non-infringement. The opinions of the Supreme Court in *Kokomo, etc., Co. v. Kitselman*, 189 U. S. 8, 23, 23 Sup. Ct. 521, 47 L. Ed. 689, and of this court in *Ney v. Ney Mfg. Co.*, 69 Fed. 405, 407, 408, 16 C. C. A. 293, show situations like that in *Boyd v. Janesville Co.*, and do not lend support to the idea that the junior patent tends to prove anything more than patentable difference."

The broad doctrine is rejected in the cases cited in the note,¹¹¹ but the exception noted in the *Herman v. Youngstown Car Mfg. Co.* case seems to be recognized, and that case may be considered to state the law on the question.

§ 363. A change of form does not avoid an infringement of a patent, unless the form shown in the patent is necessary to the functions which the patent ascribes to the invention;¹¹² or unless that form is the distinguishing characteristic of the invention;¹¹³ or is essential to its patent-

¹¹¹ *Murray v. Detroit Wire Spring Co.*, 206 F. R. 465 (6th Circuit), 1913; *J. F. Rowley Co. v. Columbus Pharmaceutical Co.*, 220 F. R. 127, 1915; *Munising Paper Co. v. American Sulphite Pulp Co.*, 228 F. R. 700, 1915; *Curry v. Union Electric Welding Co.*, 230 F. R. 422, 1916.

¹¹² *Long v. Pope Mfg. Co.*, 75 F. R. 839, 1896; *Columbia Wire Co. v. Kokomo Steel & Wire Co.*, 143 F. R. 116, 1905.

¹¹³ *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 F. R. 711, 1901; *Ide v. Trorlicht, Duncker & Renard Carpet Co.*, 115 F. R.

ability;¹¹⁴ or unless the patentee specifies a particular form as the means by which the effect of the invention is produced;¹¹⁵ or otherwise confines himself to a particular form of what he describes.¹¹⁶ Even where a change of form somewhat modifies the construction, the action or the utility of a patented thing, non-infringement will seldom result from such a change.¹¹⁷ The best way to show the scope and meaning of these rules is to collect and explain some of the instances in which changes of form have been held to be immaterial to questions of infringement.

§ 365. *Ives v. Hamilton*¹¹⁸ was a case wherein the patent

149, 1902; *Dowagiac Mfg. Co. v. Superior Drill Co.*, 115 F. R. 904, 1902; *Benbow-Brammer Mfg. Co. v. Simpson Mfg. Co.*, 132 F. R. 614, 1904; *O. H. Jewell Filter Co. v. Jackson*, 140 F. R. 340, 1905; *J. L. Owens Co. v. Twin City Separator Co.*, 168 F. R. 259, 1909; *Wayne Mfg. Co. v. Benbow-Brammer Mfg. Co.*, 168 F. R. 271, 1909; *Wm. B. Scaife & Sons Co. v. Falls City Woolen Mills*, 209 F. R. 210, 1913; *Zittlosen Mfg. Co. v. Boss*, 219 F. R. 887, 1914.

¹¹⁴ *Adam v. Folger*, 120 F. R. 263, 1903; *Glauber v. H. Mueller Mfg. Co.*, 169 F. R. 110, 1909; *M. Solmson v. Bredin*, 136 F. R. 187, 1905; *Cazier v. Mackie-Lovejoy Co.*, 138 F. R. 654, 1905; *B. F. Avery & Sons v. J. I. Case Plow Works*, 148 F. R. 214, 1906; *Detroit Copper Mining Co. v. Mine & Smelter Supply Co.*, 215 F. R. 100, 1914.

¹¹⁵ *O'Reilly v. Morse*, 15 Howard, 123, 1853; *Ewart Mfg. Co. v. Iron Co.*, 31 F. R. 150, 1887; *Pacific Cable Ry. Co. v. Butte City Ry. Co.*, 55 F. R. 763, 1893.

¹¹⁶ *Pope Mfg. Co. v. Mfg. Co.*, 34 F. R. 890, 1888; *Union Steam Pump Co. v. Battle Creek Steam Pump Co.*, 104 F. R. 342, 1900.

¹¹⁷ *Risdon Iron & Locomotive Works v. Trent*, 92 F. R. 389, 1899; *McSherry Mfg. Co. v. Dowagiac Mfg. Co.*, 101 F. R. 721, 1900; *Dowagiac Mfg. Co. v. Brennan & Co.*, 127 F. R. 143, 1903; *Diamond Match Co. v. Ruby Match Co.*, 127 F. R. 341, 1904; *Hutter v. DeQ. Bottle Stopper Co.*, 128 F. R. 283, 1904; *Lourie Implement Co. v. Lenhart*, 130 F. R. 122, 1904; *Letson v. Alaska Packers' Assoc'n*, 130 F. R. 129, 1904.

¹¹⁸ *Ives v. Hamilton*, 92 U. S. 431, 1875.

covered a combination of a saw-mill saw, with a pair of curved guides at the upper end of the saw; and a lever, connecting rod or pitman, straight guides, pivoted cross-head, and slides or blocks, and crank-pin, or their equivalents, at the opposite end; whereby the toothed edge of the saw was caused to move unequally forward and backward at its two ends while sawing. The result was a rocking or vibratory motion in the saw, instead of a straight reciprocating motion theretofore characteristic of saw-mill saws. The defendant substituted for the curved guides of the patent, similar guides made crooked by a broken line. But the Supreme Court held this change of form not to avoid infringement, saying that a curve is often treated even in mathematical science as constituting a succession of very short straight lines, or as one broken line constantly changing its direction.

§ 366. *Morey v. Lockwood*,¹¹⁹ was a case in which the bill was based on the patent for the Davidson syringe; an invention which furnishes a good illustration of one of the rules which relate to infringement, as well as of one of those which relate to novelty. In it the bulb was placed in an axial line with two flexible tubes, and received fluid at one of its ends, from one of those tubes, and discharged the same, from its other end, into and through the other of those tubes. The Supreme Court held the patent to have been infringed by the Richardson syringe, in which the bulb was placed above the axial line of the two flexible tubes, and received the fluid from one of those tubes near the point where it discharged the same into the other.

§ 367. *The American Diamond Rock Boring Co. v. The Sullivan Machine Co.*,¹²⁰ was a case involving a patent

¹¹⁹ *Morey v. Lockwood*, 8 Wallace, 230, 1868.

¹²⁰ *American Diamond Rock*

Boring Co. v. Sullivan Machine Co., 14 Blatch. 119, 1877.

for a rock-boring implement, consisting of a hollow metal boring head armed with diamonds, and which, when moved with a combined rotary and forward motion, bored an annular hole into rock, leaving a central core to be subsequently broken by a wedge and then readily removed. The defendant used a rock-boring tool, consisting of a hollow metal boring head, but having its bottom partly plugged so as to leave two holes elsewhere than in the centre of the head, and having a convex surface armed with diamonds. This tool bored a simple hole into rock without leaving any core to be afterward removed. The change of form involved a modification of the action, and perhaps a modification of the utility of the invention, but it was held not to avoid infringement of a claim which did not mention the annular form of the implement.

§ 368. *Elizabeth v. Pavement Co.*¹²¹ was a case based on the Nicholson pavement patent. That pavement consisted primarily of rows of parallel-sided wood blocks, set endwise, on a continuous foundation, the rows being separated by parallel-sided strips of board, set edgewise between them, and resting on the same foundation, and about half as wide as the blocks were long. The defendant made a pavement differing from the Nicholson in nothing, except that the sides of the strips were not parallel with each other, the strips being thicker at the top than at the bottom edge, and except that the upper angles of the strips were let into corresponding notches cut in the sides of the blocks. The Supreme Court held that though this change in the form of the blocks and of the strips might constitute an improvement in point of utility, it did not operate to avoid infringement.

§ 368a. Structures which are designed merely for the purpose of evading the spirit of the invention but which

¹²¹ *Elizabeth v. Pavement Co.*, 97 U. S. 137, 1877.

contain all the elements of the claims, are infringements of the patent. For example, infringement may not be evaded by adding to the structure of the patent an easily discarded part which may or may not be used by the purchaser, although if used the structure would not be within the scope of the patent.¹²² Likewise the charge of infringement is not averted by a showing that the structure may be and occasionally is used in good faith in a manner that would not infringe if it would infringe when used in the normal, easiest and most effective way.¹²³

§ 369. Patents for compositions of matter give rise to questions of infringement somewhat peculiar to themselves. Infringement depends, in such cases, upon sameness or equivalence of ingredients, and upon substantial sameness of the proportions of those ingredients. Omission of one or more of the ingredients of a patented composition of matter avoids infringement, as truly as omission of one of its parts avoids infringement of a patent for a combination of mechanical devices.¹²⁴ Addition to a patented composition of matter, of an ingredient which the patent purposely avoided, and which when added substantially changes the character of the composition, also avoids infringement.¹²⁵ But an addition which results in no substantial change of character, and which was

¹²² *Weed Chain Tire Grip Co. v. Cleveland Chain & Mfg. Co.*, 196 F. R. 213, 1910; *Parsons Non-Skid Co. v. Atlas Chain Co.*, 198 F. R. 399, 1912; *Parsons Non-Skid Co. v. Asch*, 196 F. R. 215, 1912.

See *Wright Co. v. Herring-Curtis Co.*, 211 F. R. 654, 1914.

¹²³ *Marconi Wireless Telegraph*

Co. v. DeForest Telephone & Telegraph Co., 225 F. R. 65, 1914; *Parsons Non-Skid Co. v. Atlas Chain Co.*, 198 F. R. 399, 1912.

¹²⁴ *Otley v. Watkins*, 36 F. R. 324, 1888; *Lane v. Levi*, 104 O. G. 1898, 1903.

¹²⁵ *Byam v. Eddy*, 5 Blatch. 521, 1853.

made merely for the purpose of an attempt to evade the patent, will not have that effect.¹²⁶

The ascertainment of the character of a composition of matter, is a work for chemists; and that work consists in the application of proper tests to each particular case. The same mysterious forces through whose action and reaction a compound was produced, must be availed of to disintegrate and disrupt that compound, in order to ascertain its ingredients, and the mode of their mixture or their union. All the tests of identity specified in a patent, on a composition of matter, and all proper tests of identity, whether thus specified or not, may be invoked by a defendant in support of his contention of non-infringement. But a patentee is confined to proper tests of identity, and cannot impose an improper test upon any defendant, by stating it in his patent, as being legitimate.¹²⁷

§ 370. Substitution of one equivalent for another, in a patented composition of matter, is generally as ineffectual to avoid infringement as is like substitution in a machine. An equivalent for one ingredient of a patented composition of matter is anything which in that composition performs the same function as that ingredient.¹²⁸ Chemical equivalency is not necessary to legal equivalency between substances, in respect of a non-chemical use of those substances.¹²⁹ The term "equivalent" means "equally good" when it refers to the ingredients of compositions of matter.^{129a} Nor will the fact that two substances are classified by chemists in the same group necessarily

¹²⁶ Rich *v.* Lippincott, 2 Fisher, 6, 1853.

¹²⁷ Matheson *v.* Campbell, 78 F. R. 910, 1897.

¹²⁸ Woodworth *v.* Morrison, 1 Holmes, 131, 1872.

¹²⁹ Welsbach Light Co. *v.* Sun-

light Lamp Co., 87 F. R. 221, 1898; Treibacher-Chemische Werke Gesellschaft, etc., *v.* Roessler & Hasslacher Chemical Co., 219 F. R. 210, 1914.

^{129a} Tyler *v.* Boston, 7 Wallace, 330, 1868.

make them legal equivalents.¹³⁰ Where the composition of matter involved, is a compound of metals, an equivalent of either of those, is another metal having similar properties, and producing substantially the same effect in that composition.¹³¹ And a substitute is not less an equivalent, because it is derived from a different source than that for which it is a substitute, or because the patentee had no knowledge of it when he received his patent.¹³²

§ 370*a*. Where a patent states that each member of a group of substances can be used to compose the matter which is the subject of the patent, and where some of those members cannot be thus used, the patentee cannot invoke the doctrine of equivalents to enable him to monopolize all of them which are afterward found to be suitable for the purpose. If such a patent has only a generic claim, purporting to cover the matter of the patent as made from any of the prescribed starting materials, that patent is void.¹³³ But if such a patent has a specific claim, limited to the matter of the patent as made from one starting material which is suitable for the purpose, that claim may be valid, though a generic claim in the same patent is not.¹³⁴

§ 371. A substituted ingredient may perform the required function better than the patented ingredient, and may perform that function in a somewhat different manner, and still be an equivalent for the latter.¹³⁵ In

¹³⁰ *General Electric Co. v. Laco-Philips Co.*, 233 F. R. 96, 1916.

¹³¹ *Matthews v. Skates*, 1 Fisher, 609, 1860.

¹³² *Standard Paint Co. v. Bird*, 65 F. R. 511, 1894.

¹³³ *Matheson v. Campbell*, 78 F. R. 921, 1897.

¹³⁴ *Consolidated Electric Light Co. v. McKeesport Light Co.*, 159 U. S. 465, 1895.

¹³⁵ *Atlantic Giant Powder Co. v. Mowbray*, 2 Bann. & Ard. 447, 1876.