

Ed. 357, the pleadings are thus summarized by the Supreme Court.

“His bill begins by a statement that he is the original inventor and patentee of a process for cutting and engraving stone, glass, metal and other hard substances. It is the one known as the sand-blast process.

“He then sets out what we understand to be a contract with defendants for the use by the latter of his invention. He declares that defendants paid him a considerable sum for the machines necessary in the use of the invention, and also paid him the royalty which he asked, for several months, for the use of the process, which he claims to be the thing secured to him by patent. He alleges that after this defendants refused to do certain other things which he charges to have been a part of the contract, and thereupon he forbade them further to use his patent process, and now charges them as infringers.

“The defendants admit the validity of plaintiff’s patent. They admit the use of it and their liability to him for its use under the contract. They set up in a plea the contract as they understand it, and the tender of all that is due to plaintiff under it, and their readiness to perform it.”

The conclusion of the Supreme Court was:

“Complainant assumes that he has, under the condition of things as proved, the right in himself to abandon the contract, to treat it as a nullity, and to charge the defendants as infringers, liable as trespassers under the Act of Congress to pay both profits and damages  
\* \* \* Such a case is not cognizable in a court of the United States by reason of its subject-matter, and as the parties could not sustain such a suit in the circuit court by reason of citizenship, this bill should have been dismissed.

“The decree of that court is, therefore, reversed, with directions to dismiss the bill without prejudice.”

By way of criticism of the logic of that opinion the reader is referred to the dissenting opinion of Mr. Justice Bradley, concurred in by the Chief Justice and Mr. Justice Swayne. The case was decided by a bare majority of four to three, Justices Strong and Hunt not sitting. The majority opinion is merely a legal curiosity. In a case in which its doctrine was invoked, Judge Woods said:

“The bill in this case is in the customary form for infringement of letters patent, and the proposition contended for necessarily implies that the jurisdiction invoked by the filing of such a bill—of which, it is to be observed, no court except a Federal court can take cognizance—may be defeated by a plea of license which admits the use and validity of the patent sued on. If the decision in *Hartell v. Tilghman* ever meant that much it has been explained and limited by later decisions, which leave no doubt of the Federal jurisdiction in cases like the present.”<sup>163</sup>

The established doctrine has been briefly stated by Judge Gray as follows:

“The complainant in this case has stated in its bill that it is the owner of the patent in suit, and derives title through an assignment from the patentee. An averment of title in the complainant must necessarily be made, and is the necessary foundation for all rights asserted or litigated by the complainant. It is an averment without which complainant has no proper standing in court. It matters not whether the title be that of the patentee, derived directly from the grant made by the government, or that of an assignee of the patentee or the assignee of an assignee. In either case it is the state-

163. *Elgin Wind Power & Pump Co. v. Nichols*, 65 Fed. Rep. 215, 217, 45 C. C. A. 49; citing *White v. Rankin*, 144 U. S. 628, 36 L. Ed. 569; *Dale Tile Manufac-*

*turing Co. v. Hyatt*, 125 U. S. 46, 31 L. Ed. 683; *Marsh v. Nichols, Shepard & Co.*, 140 U. S. 344, 35 L. Ed. 413.

ment of a *prima facie* qualification to institute the suit, and such title, whether direct to the patentee, or derivative from him by assignment or assignments, is the creature of the patent law, and not of the common law; and, whether admitted or attacked by the opposing party, the questions raised are raised under the patent laws, and are, therefore, within the meaning of the Revised Statutes of the United States, justiceable in the circuit (now district) court.”<sup>164</sup>

The rule is thus stated by Judge Baker:

“When a contract is made respecting a right under a patent, and the parties get into litigation, confusion has sometimes arisen over the question whether the cause of action originates in the contract or in the patent laws. The test is this: If the plaintiff is seeking a judgment for debt or damages, or a decree for cancellation or specific performance, on account of the defendant’s breach of his covenants, the cause of action arises out of the contract; and, though the determination of the issue of breach or no breach may involve the interpretation of the patent and of the prior art, the insistence of the defendant that his device, according to the true construction of the patent and of the prior art, is not within the patent right granted him in the contract, cannot change the nature of the action.”<sup>165</sup>

That the plaintiff may have an additional remedy for breach of contract does not defeat the jurisdiction of the Federal Courts.

Where the plaintiff brings suit for infringement in the Federal courts, it is immaterial that the pleadings or proofs disclose the fact that there has been a breach of

164. *Atherton Mach. Co. v. Atwood-Morrison Co.*, 102 Fed. Rep. 949, 956, 43 C. C. A. 72. Applied in *Kurtz v. Straus*, 106 Fed. Rep. 414, 415, 45 C. C. A. 366.

165. *Victor Talking Mach. Co. v. The Fair*, 123 Fed. Rep. 424, 425, 61 C. C. A. 58.

contract on the part of the defendant, in addition to his act of infringement. "The remedy of the complainant may be a double one; for liability may rest either upon the broken contract, or for the tortious use of the invention."<sup>166</sup> The court of appeals of the Eighth Circuit has thus expressed this principle, "It is, we think, the general rule in patent cases that a limited license conveys only the rights defined therein, and that if the licensee makes any other or different use, either as to time or place, than that authorized by the license, he becomes an infringer, and his limited license is no justification."<sup>167</sup>

§ 516. The relationship of receivers to patent rights.

Upon the appointment of a receiver for a partnership or corporation, the assignable patent rights of the partnership or corporation do not become vested in the receiver,<sup>168</sup> unless so decreed by an order under a creditors' bill.<sup>169</sup> In the case of bankruptcy under the present Bankruptcy Act the trustee in bankruptcy is vested with the title of the bankrupt to all interests in patents or patent rights, as of the date of the adjudication in bankruptcy (Act of July 1, 1898, c. 541, § 70, 30 Stat. at L. 565, 3 Comp. Stat., p. 3451).<sup>169a</sup> But as to receiver-

166. Lurton, J., in *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. Rep. 288, 291, 25 C. C. A. 267, 35 L. R. A. 728.

167. *St. Louis Street Flushing Mach. Co. v. Sanitary Street Flushing Mach. Co.*, 178 Fed. Rep. 923, 927, — C. C. A. —.

168. *Newton v. Buck*, 72 Fed. Rep. 777, 779. Contra, see *Douglas v. Campbell*, 24 Ohio Cir. Ct. 241; *Matter of Woven Tape Skirt Co.*, 12 Hun. 111.

169. *Gordon v. Anthony*, 16 Blatchf. 234, 248, Fed. Case 5605;

*Ager v. Murray*, 105 U. S. 126, 26 L. Ed. 942; *Jewett v. Atwood Suspender Co.*, 100 Fed. Rep. 647.

169a. Under this section, it has been held in one case that where the bankrupt has made an invention, but has not applied for a patent, the bankruptcy court may compel him to make such application and assign it to the trustee in bankruptcy. *Fisher v. Cushman*, 103 Fed. Rep. 860, 43 C. C. A. 381, 51 L. R. A. 292. Following this decision it has been held that an application for patent is "property" which passes

ships, title does not vest in the receiver save when it is so specifically decreed, and he consequently cannot convey title to a purchaser.<sup>170</sup> Though, as Judge Wallace has said, "the rule that a receiver cannot convey title to a patent unless the owner of the legal title joins, does not apply to the transfer of a mere equitable title."<sup>171</sup>

Inasmuch as a license is personal to the licensee, and not assignable unless made so in express terms,<sup>172</sup> "an executor, administrator, or assignee, voluntary or involuntary, does not succeed to the privilege of the grant."<sup>173</sup>

#### Receivers as defendants.

As a general rule, no action can be brought against a receiver without the leave of the court under which he holds his appointment.<sup>174</sup> But he may be sued for patent infringement, when acting as receiver under the appointment of a state court, without the leave of that court. In an early case Judge Treat based his

to the trustee in bankruptcy under this section, even where the invention has been made by the president and manager of a bankrupt corporation, under circumstances indicating that the invention lawfully belongs to the corporation. In *re Cantelo Mfg. Co.*, 185 Fed. Rep. 276. This decision is opposed by cases which hold that the section refers only to letters patent actually issued at the date of the adjudication in bankruptcy, although the application was made before bankruptcy, and was pending at the time of the adjudication. In *re McDonnell*, 101 Fed. Rep. 239; In *re Dann*, 129 Fed. Rep. 495.

170. *Gordon v. Anthony*, 16

*Blatchf.* 234, 248; *Newton v. Buck*, 72 Fed. Rep. 777, 779.

171. *Adams v. Howard*, 22 Fed. Rep. 656, 658.

172. *Hapgood v. Hewitt*, 119 U. S. 226, 30 L. Ed. 369; *Adams v. Howard*, 22 Fed. Rep. 656; *Waterman v. Shipman*, 55 Fed. Rep. 983, 5 C. C. A. 371.

173. *Treat, J.*, in *Curran v. Craig*, 22 Fed. Rep. 101; citing *Oliver v. Rumford Chem. Works*, 109 U. S. 75, 27 L. Ed. 862. To the same effect, see *Waterman v. Shipman*, 55 Fed. Rep. 983, 5 C. C. A. 371.

174. *Barton v. Barbour*, 104 U. S. 126, 26 L. Ed. 672; *American L. & T. Co. v. Central Vermont R. Co.*, 84 Fed. Rep. 917.

ruling upon the ground that the receiver had taken possession of the alleged infringing property without authority, and was "personally liable for the trespass committed."<sup>175</sup> In a later case, Judge Lacombe held the same way, but put his ruling upon broader grounds.

"The defendant De Frece was appointed receiver of the defendant corporation by the chancery court of New Jersey, and subsequently was appointed ancillary receiver by the Supreme Court of this State. Motion to dismiss as to him is made upon the ground that complainant has not obtained leave to sue him from either of the courts appointing him. Leave was obtained from the New York court, but the order giving it has since been vacated. The general rule undoubtedly is that a court will not entertain jurisdiction of a suit against a receiver appointed by another court until the appointing court has given its consent that he be sued. This rule rests on principles of comity, and is considered for the protection of the receiver as an officer of the court appointing him against unnecessary and expensive litigation touching controversies wherein it may often be within the power of the appointing court to give ample relief to any person aggrieved. But the rule has its qualifications, and the case at bar does not fall within it. This suit is one under the Federal laws, involving questions as to the validity and infringement of United States letters patent, which the state courts have no jurisdiction to determine<sup>176</sup> The Federal courts cannot assent to the proposition that they have no jurisdiction, without leave of the State courts first obtained, to enjoin individuals, even though they be officers of State courts, from infringing upon the rights of the owner of a patent. To

175. Curran v. Craig, 22 Fed. Rep. 101.

176. Citing Continental Store Service Co. v. Clark, 100 N. Y. 370, 3 N. E. 335.

do so would be to abdicate functions which, under the Federal Constitution, are confided to them, and to them exclusively, by the Federal laws. Such a refusal would leave it within the power of the State courts to exclude the holder of rights granted to him by the United States from the only tribunals which have jurisdiction to vindicate those rights. The reasoning in *Barron v. Burnside*, 121 U. S. 186, 30 L. Ed. 915, and other similar authorities applies to such a case as this.”<sup>177</sup>

A receiver of a licensee is not liable as an infringer for selling goods made under a license from the plaintiff, which license was terminated because of the receivership proceeding.<sup>178</sup>

#### Receivers in patent causes.

While the practice has been rarely resorted to, there can be no doubt of the propriety of appointing a receiver for an insolvent defendant's business pending a suit for patent infringement, where the case does not warrant preliminary injunction. In making such an order, Judge Betts said: “A proper case is established against \* \* \* defendants for the appointment of a receiver. It is shown that both of them have debts outstanding to a very large amount, for machines sold by them \* \* \*. The plaintiff, if his right is finally established, will be entitled to a large part of these moneys, and both defendants are proved to be irresponsible in their circumstances. The peril of a fund in litigation is cause for the interference of the court to secure and protect it by the appointment of a receiver.”<sup>179</sup>

#### § 517. The liability of States and counties for patent infringement.

A State government is not liable for patent infringement.<sup>180</sup> That such actions arise solely under the patent

177. *Hupfeld v. Automaton Piano Co.*, 66 Fed. Rep. 788, 789.

178. *Montross v. Mable*, 30 Fed. Rep. 234; *Emigh v. Chamberlain*, 2 Fisher 192, Fed. Case 4447.

179. *Parkhurst v. Kinsman*, 1 Fish. 180, 2 Blatchf. 78, Fed. Case 10,760.

180. *Standard Fireproofing Co. v. Toole*, 122 Fed. Rep. 649, 652.

laws of the United States is immaterial. The Supreme Court has said "that a State cannot be sued by a citizen of another State, or of a foreign state, on the mere ground that the case is one arising under the Constitution or laws of the United States, is clearly established by the decisions of this court."<sup>181</sup> In so holding, the court was merely applying the Eleventh Amendment of the Constitution, which provides that "the judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by citizens of another State, or by citizens or subjects of any foreign State."

In the early case of *Jacobs v. Hamilton County*, 1 Bond 500, Fed. Case 7, 161, it was held upon the authority of *Hamilton County v. Mighels*, 7 Ohio St. 110, that a county was not liable for the infringement of a patent.<sup>182</sup> In the later cases this ruling has been disapproved, Judge Jackson saying "the State could not, by either direct or indirect legislation, exempt its counties from liability for the infringement of patents."<sup>183</sup>

#### § 518. Liability of public officers for patent infringement.

Where suit for patent infringement is brought against an officer of a State who has performed the alleged infringing acts in the course of his official duties, the suit is virtually against the State itself, and cannot be maintained.<sup>184</sup>

181. Mr. Justice Bradley, in *Hans v. Louisiana*, 134 U. S. 1, 33 L. Ed. 842; citing *Louisiana v. Jumel*, 107 U. S. 711, 27 L. Ed. 448; *Hagood v. Southern*, 117 U. S. 52, 29 L. Ed. 805; *Ex parte Ayers*, 123 U. S. 443, 31 L. Ed. 216.

182. To the same effect, see *May v. County of Juneau*, 30 Fed. Rep. 241.

183. *May v. Logan County*, 30 Fed. Rep. 250, 260. To the same effect, see *May v. County of Fond du Lac*, 27 Fed. Rep. 695; *May v. Mercer County*, 30 Fed. Rep. 246; *May v. County of Ralls*, 31 Fed. Rep. 473.

184. *Hans v. Louisiana*, 134 U. S. 1, 33 L. Ed. 842; *Standard Fireproofing Co. v. Toole*, 122 Fed. Rep. 649, 652.



So where the defendant is an officer of the United States, who has acted only for and on behalf of the government, suit for patent infringement against him "is substantially a suit against the United States itself, which cannot be maintained under the guise of a suit against its officers and agents, except in the manner provided by law."<sup>185</sup>

*Belknap v. Schild*, 161 U. S. 10, 40 L. Ed. 599, was, however, the first case in which the jurisdiction of the United States Courts in cases of this kind was squarely denied. In *James v. Campbell* (104 U. S. 356, 26 L. Ed. 786) and *Hollister v. Benedict Mfg. Co.* (113 U. S. 59, 28 L. Ed. 901) that court entertained jurisdiction and dismissed the bills upon the merits. And even after *Belknap v. Schild*, the Supreme Court again assumed the jurisdiction, and dismissed the bill upon its merits, in *Dashiell v. Grosvenor* (162 U. S. 425, 40 L. Ed. 1025). This remarkable situation continued to perplex the bench and bar,<sup>186</sup> until Congress, by the Act of June 25, 1910,<sup>187</sup> cut the Gordian knot by giving a remedy against the government for patent infringement.

Of course the fact that a contractor infringes a patent in the course of executing a contract with a State or with the United States does not exempt him from liability for the infringement.<sup>188</sup>

#### § 519. Reduction to Practice.

The question of reduction to practice is attended with some difficulty, much of which is due to the oft-quoted dictum of Mr. Justice Clifford: "He is the first inventor,

185. *James v. Campbell*, 104 U. S. 359, 26 L. Ed. 786.

186. *International Postal Supply Co. v. Bruce*, 114 Fed. Rep. 509.

187. *Hopkins*, The Judicial Code, p. 153.

188. *Brady v. Atlantic Works*, 4 Cliff. 408, Fed. Case 1794; reversed on other grounds in *Atlantic Works v. Brady*, 107 U. S. 192, 27 L. Ed. 438.

in the sense of the patent law, and entitled to a patent for his invention, who first perfected and adapted the same to use, and it is well settled that until the invention is so perfected and adapted to use it is not patentable under the patent laws."<sup>188</sup> The dictum of the latter part of this sentence is not supported by either of the two cases cited in support of it, if it is to be construed literally. If it means actual practice, as distinguished from the capacity for being practiced, it is not sound; and it should be read in the latter sense. Much of the confusion in the cases would have been avoided had it always been kept in mind that the invention is perfected when it is ready for the use of those skilled in the art. Reduction to practice means this and nothing more. Of course, the right of the first producer of the completed invention is another matter. He may abandon the invention or he may forfeit his right to a patent by two years' public use, or he may sleep upon his rights while another independent inventor conceives, reduces to practice, and applies for a patent with diligence.

The application as constructive reduction to practice.

The filing of the application for patent is a constructive reduction to practice,<sup>189</sup> and its weight and benefit as such is not affected by the fact that it subsequently requires and receives amendment.<sup>190</sup>

The benefit of the filing date, as concerns reduction to practice, is extended to divisional applications<sup>191</sup> even though the divisional application was filed after the time limit for amendment had expired.<sup>192</sup> So in interference

188. *Seymour v. Osborne*, 78 U. S. (11 Wall.) 516, 20 L. Ed. 33. Citing *Washburn v. Gould*, 3 Story 122, Fed. Case 17, 214; *Cahoon v. Ring*, 1 Cliff. 612, Fed. Case 2, 292.

189. *Lotz v. Kenny*, 31 App. D. C. 205, 135 Off. Gaz. 1801.

190. *Hulett v. Long*, 15 App. D. C. 284, 89 Off. Gaz. 1141.

191. *Lotz v. Kenny*, 31 App. D. C. 205, 135 Off. Gaz. 1801.

192. *Duryea v. Rice*, 28 App. D. C. 423, 126 Off. Gaz. 1357.

proceedings each of the parties is entitled to his filing date as the date of his invention<sup>193</sup> and he may carry back his date of actual invention as far prior to that filing date as the facts justify;<sup>194</sup> as can the plaintiff in infringement litigation,<sup>195</sup> provided neither has been guilty of laches<sup>196</sup> or concealment,<sup>197</sup> after his conception of the invention.

**What constitutes reduction to practice.**

It is not necessary to constitute reduction to practice, in the case of a machine, as a general rule, that it has actually performed work, provided that it was capable of doing the work for which it was designed.<sup>198</sup> But the application of this rule depends upon the character of the machine involved. Thus in the case of a tobacco-stemming machine "which did fairly good work, but occasionally permitted some of the tobacco leaves to pass the blades without having the stems properly removed," it was held that "this inaccuracy, or this imperfection, as we may call it, would not necessarily have prevented the machine from coming into universal use, even though it had never been perfected so as to permit no leaf to pass unstemmed. The escaping leaves might well be gathered and thrown back; and the machine might have been found remarkably useful, notwithstanding the imperfection." And in this connection the general rule has been expressed to be that "when a machine accomplishes its purpose in a manner reasonably satisfactory to practical men and fairly promising good results, although not then

193. *Christie v. Seybold*, 54 Off. Gaz. 957.

194. *Consolidated Ry. Co. v. Adams & Westlake Co.*, 161 Fed. Rep. 343, 88 C. C. A. 351.

195. *Locke v. Boch*, 17 App. D. C. 75, 93 Off. Gaz. 1722.

196. *Christie v. Seybold*, 55 Fed. Rep. 69, 76, 5 C. C. A. 33.

197. *Thomson v. Weston*, 19 App. D. C. 373, 99 Off. Gaz. 864.

198. *Troy Iron & Nail Factory v. Odiorne*, 17 How. 73, 15 L. Ed. 37.

constructed with thorough mechanical skill in all its parts, it may be regarded as a successful reduction to practice.”<sup>199</sup> So it is no objection to the efficiency of a device claimed to be a reduction to practice, that it was half the size of the commercially practicable machine.<sup>200</sup> Whether, when the nature of the machine requires actual working to complete its reduction to practice, its working must be made under the conditions of the service for which it is intended, again depends upon the nature of the function which it is intended to perform. Judge Shepard has thus summarized the cases. “Just what does amount to reduction to practice of a machine, as contradistinguished from unsatisfactory and abandoned experiments, presents a question of constant difficulty in this class of cases, and depends, chiefly, upon the special circumstances of each case in which it is sought to be established. A rule cannot be laid down in one case to govern all others. At one time it may be held reduction to practice, where the machine, though defective in mechanical construction and working crudely in practical, public trials, nevertheless demonstrates its practical efficacy and utility, and the subsequent failure to perfect by the application of the necessary mechanical skill, has been satisfactorily accounted for, as in cases like that of *Coffee v. Guerrant* (68 O. G. 279; 3 App. D. C. 497). Again it may be held as falling short of reduction to practice, where a machine, though skillfully constructed, at great expense, has only been tested by the inventor once in the presence of a witness, and then all testimony fails in respect of its subsequent use for the only purpose of its alleged invention, as in cases like that of *Reichenbach v. Kelley* (94 Off. Gaz. 1185) and others therein

199. *Morris, J., in McKenzie v. Cummings*, 112 Off. Gaz. 1481, 24 App. D. C. 137, interpreting *Coffee*

*v. Guerrant*, 68 Off. Gaz. 279, 3 App. D. C. 497.

200. *Gallagher v. Hein*, 25 App. D. C. 77, 115 Off. Gaz. 1330.

cited.”<sup>201</sup> Thus where the novelty resides in the specific details of a new device of an old type, actual use may be dispensed with altogether; but if the device is of a new type, whose value in practice is not obvious, practical operation is necessary to complete its reduction to practice.<sup>202</sup> The simplicity of the device, as well as its purpose and efficiency, may be so obvious that an illustrative model, without actual use or test, may be quite as efficacious as a perfected device subjected to actual test.<sup>203</sup> The environment of the inventor may be considered in determining what constitutes reduction to practice. Where the inventor was a machinery manufacturer, and not engaged in manufacturing matches, the fact that he tested the match machine of his invention with uncoated splints, or dummies, instead of matches, was held to be no objection to the sufficiency of his reduction to practice.<sup>204</sup> On the other hand, a preliminary test of a gun by government officers, not made under the conditions of actual service, even though it resulted in an order sending the gun to the proving-grounds for a complete test, was held not to be a reduction to practice.<sup>205</sup>

“No patentee is held, in reducing his patent to application, to strictly and entirely follow the mere mechanical device shown in his drawings of the patent. He may deviate, so long as he does not violate the principle involved.”<sup>206</sup>

As to a process, its reduction to practice consists in its actual performance; wherefore the construction of a device for practicing the invention is not a reduction to

201. *Latham v. Armat*, 17 App. D. C. 345, 95 Off. Gaz. 232.

202. *Paul v. Hess*, 24 App. D. C. 562, 115 Off. Gaz. 251.

203. *Loomis v. Hauser*, 19 App. D. C. 401, 99 Off. Gaz. 1172.

204. *Wyman v. Donnelly*, 21 App. D. C. 81, 104 Off. Gaz. 310.

205. *Dashiell v. Tasker*, 21 App. D. C. 64, 103 Off. Gaz. 2174.

206. *Blodgett, J., in Weir v. North Chicago Rolling Mill Co.*, 14 Fed. Rep. 42.

practice.<sup>207</sup> As to designs, their reduction to practice is effected by the application of the design to any material; and no practical use in a mechanical sense is necessary.<sup>208</sup>

#### Diligence in reduction to practice.

The general doctrine as to diligence has been thus comprehensively treated by Judge Morris. "If there is any provision of our Federal Constitution which more than any other is intended to give practical effect to that portion of the preamble to that instrument which recites that one of its six avowed purposes is to promote the general welfare, it is that clause which vests in the Congress of the Federal Union the power:

" 'To promote the progress of science and useful arts, by securing for limited times, to authors and inventors the exclusive right to their respective writings and discoveries.'

"The provision, it will be noticed, is not to benefit the inventor primarily, but the public. The purpose is:

'to promote the progress of science and useful arts,'

which are necessarily for the people at large, and this result is to be reached in the shape of a bounty to inventors by the offer to them of a monopoly for a limited time. The interests of the public are therefore the primary consideration, and to these the privileges granted to inventors are secondary and subordinate. The consideration of the exclusive right secured to the inventor is the present and prospective benefit to accrue to the public from the use of the invention, and when that consideration fails or when the purpose is thwarted by the in-

207. *Croskey v. Atterbury*, 9 App. D. C. 207, 76 Off. Gaz. 163.

208. *Tyler v. St. Amand*, 17 App. D. C. 464, 94 Off. Gaz. 1969.

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ventor the exclusive right ceases and is determined. When the inventor in any manner or for any reason refuses to give to the public the benefit of his invention, the public are entitled to withdraw from him the special protection accorded to him for his discovery. On this principle the inventor is required to be diligent in reducing his conception or invention to practice, and it is usually the first who reduces to practice and not the first who conceives that is entitled in law to be regarded as the inventor. On this principle all our laws on the subject are based. By them a premium is placed upon diligence, and delay requires to be excused, and a delay of two years is in many cases regarded as an abandonment to the public. Even a much shorter delay without sufficient explanation or excuse is often regarded as evidence of laches, such as should preclude one guilty of it from advantage or benefit under the law. Can one who has made an invention and who has locked it up in the secrets of his own exclusive knowledge and who produces it only when some rival inventor has entered the field be held to have acted in accordance with the policy of the law or with the spirit and purpose of the constitutional provision? Such action, or inaction, as we might more properly term it, not only contravenes the interests of the public, but also operates to injure the rival inventor who in the meantime enters the field of invention upon the faith of the conditions as they appear to exist and upon which he is entitled to rely. Such rival inventor expends his time, his efforts, and his money in the elaboration of his conception in ignorance of the fact that any one else has been in the same field before him, and he goes into the Patent Office only to be confronted after several months of effort there with the claim of some one else, who then comes forward for the first time and alleges that he had the same invention long before. Probably such claimant is not barred by any statute from

making his claim, and if he sufficiently proves it he and not his competitor will be entitled to the patent, for it is to the first inventor, the first to conceive and to reduce into practice, that the law awards priority. But such conditions make it imperative upon him that he should prove his claim beyond all reasonable doubt, and the Patent Office and the court are justified in presuming in such cases that what is claimed to be reduction to practice is no more than mere experiment until the contrary is clearly shown.”<sup>209</sup>

Upon the question of diligence, President Taft, when Circuit Judge, reviewed the reasoning of the authorities as follows: “It is obvious \* \* \* that the man who first reduces an invention to practice is prima facie the first and true inventor, but that the man who first conceives, and, in a mental sense, first invents, a machine, art, or composition of matter, may date his patentable invention back to the time of its conception, if he connects the conception with its reduction to practice by reasonable diligence on his part, so that they are substantially one continuous act. The burden is on the second reducer to practice to show the prior conception, and to establish the connection between that conception and his reduction to practice by proof of due diligence. It has sometimes been held, in the decisions in the Patent Office, that the necessity for diligence on the part of the first conceiver does not arise until the date of the second conception; but this, we think, cannot be supported on principle. The diligence of the first reducer to practice is necessarily immaterial. It is not a race of diligence between the two inventors in the sense that the right to the patent is to be determined by comparing the diligence of the two, be-

209. Warner v. Smith, 13 App. D. C. 111; 84 Off. Gaz. 311.



cause the first reducer to practice, no matter what his diligence or want of it, is prior in right unless the first conceiver was using reasonable diligence at the time of the second conception and the first reduction to practice. The language of the statute (section 4920) in the use of the imperfect tense, 'was using reasonable diligence,' shows the legislative intent to confer a prior right on a first conceiver in a case where, after his mental act of invention, and pending his diligent reduction to practice, another inventor enters the field and perfects the invention before his rival. The reasonable diligence of the first conceiver must be pending at the time of the second conception, and must therefore be prior to it. Reasonable diligence by the first conceiver, beginning when his rival enters the field, could only carry his invention back to the date of the second conception, and in the race from that time the second conceiver must win because of his first reduction to practice. *Milward v. Barnes*, 11 O. G. 1060. The elaborate opinion of the commissioner of patents, Mr. Mitchell, in the interference proceeding between Christie and Seybold, reported in 54 O. G. 957, cites all the authorities, and is quite convincing on this point. We fully concur therein. As Christie reduced the invention to practice nearly a year before Seybold's press was made, the burden is on Seybold to show that from the time of his original conception, which antedated that of Christie, he was using reasonable diligence in adapting and perfecting his idea to practical use. Has he sustained that burden? It is quite clear to us that he has not. The question of reasonable diligence in any case depends, of course, upon all the circumstances. A complicated invention, requiring many experiments and much study to give it practical form, would reasonably delay a reduction to practice after the first conception for a greater length of time than where the idea and the machine embodying it were of a simple character. Then,

too, the sickness of the inventor, his property, and his engagement in other inventions of a similar kind are all circumstances, which may affect the question of reasonable diligence.”<sup>210</sup>

The burden of proof as to reduction to practice.

The burden of proof as to reduction to practice in interference proceedings is initially fixed by the respective filing dates upon the junior party. The degree of proof varies with the circumstances. Where the junior party files his application after the issuance of the patent of the other party, the burden is upon him to establish his case by proof beyond a reasonable doubt.<sup>211</sup> As between employer and employee, where the employee claims an improvement to have been devised by him while working upon the general conception of the employer, the burden is usually upon him to show that the invention is his own, regardless of the question of priority in filing dates.<sup>212</sup>

In infringement litigation, the question of reduction to practice arises as follows. The plaintiff relies upon the prima facies of his patent. The initial burden of establishing the existence of an anticipating device is on the defendant. When the defendant has established the prior existence of the anticipating device, as of a date prior to the application for the patent in suit, the burden shifts to the plaintiff to carry his date of invention back to antedate the alleged anticipation.

The cases have been thus summarized by Judge Seaman:

“With the above-mentioned facts of complete anticipation in construction and use—known to the patentee several months prior to his application for a pat-

210. *Christie v. Seybold*, 55 Fed. Rep. 69, 76, 5 C. C. A. 33.

211. *Cherney v. Clauss*, 25 App. D. C. 15, 116 Off. Gaz. 597.

212. *Robinson v. McCormick*, 29 App. D. C. 98, 128 Off. Gaz.

3289.

ent—settled by the evidence, we are of opinion that the presumption of invention by the patentee, which arises from the patent application, and grant, is overcome, *prima facie*, by such anticipation in Sherbondy's *prima facie* conception reduced to practice, so that the burden of proof is transferred to the patentee to establish priority in fact.<sup>213</sup> This view of shifting the burden of proof in such event is upheld in well-considered opinions at the circuit.<sup>214</sup> In *Clark Thread Co. v. Willimantic Linen Co.*, 140 U. S. 481, 492, 35 L. Ed. 521, however, the opinion by Mr. Justice Bradley states the rule in like case, in qualified form, as requiring 'the plaintiffs in rebuttal, to show, if not with equal certainty, yet to the satisfaction of the court, that the invention' claimed in the patent preceded the date thus shown with certainty, in respect of a device which anticipated the patent dates.'<sup>215</sup>

§ 520. The dissolution of the preliminary injunction because of complainant's inequitable conduct.

The conduct of a complainant who has been granted a preliminary injunction may be ground for dissolving the injunction. Just as laches in making the motion to dissolve is ground for overruling that motion,<sup>216</sup> so the failure of the plaintiff to prosecute the cause with due diligence is ground for dissolving the temporary injunction which is protecting him during his delay.<sup>217</sup>

213. Citing *Westinghouse Electric & Mfg. Co. v. Catskill Illuminating & Power Co.*, 121 Fed. Rep. 831, 834, 58 C. C. A. 167.

214. Citing *Webster Loom Co. v. Higgins*, 15 Blatchf. 446, Fed. Case 17, 342; *Thayer v. Hart, Jr.*, 20 Fed. Rep. 693; *Westinghouse Elec. & Mfg. Co. v. Saranac Lake Elec. L. Co.*, 108 Fed. Rep. 221, 222; *Westinghouse, etc., v. Mutual*

*Life Ins. Co.*, 129 Fed. Rep. 213, 216.

215. *Consolidated Ry. Elec. Lighting & Equipment Co. v. Adams & Westlake Co.*, 161 Fed. Rep. 343, 350, 88 C. C. A. 355

216. *Read v. Consequa*, 4 Wash. C. C. 174, Fed. Case 11,606.

217. *Read v. Consequa*, 4 Wash. C. C. 174, Fed. Case 11, 606; *Bradley v. Reed*, Fed. Case 1,785.

Again, the use made of the preliminary order by the complainant, by way of threats against others than the defendant, may serve to dissolve the injunction. In such a case Judge Blodgett said:

“It appears that immediately on the entry of the order in this case, circulars and notices were sent outside this district to parties engaged in the trade, dealing with the complainants’ competitors, intended to alarm such persons and injure the trade of competing manufacturers. This strikes me as hardly justifiable under the circumstances. I think complainants, if they have faith in their patents, should make their attack directly on such competitors as they claim are infringing their patents, and contest the question squarely with them. This class of goods has now, according to the proofs, gone into very general use as an article of food, and can be found for sale in most family groceries; and it seems to me not the right course to attack these dealers, and annoy and intimidate them by threats of patent suits. The course taken by complainants suggests the charge that they intended to obtain many of the advantages of an injunction by harassing and interfering with the business of a rival without taking the risk of a direct suit with that rival, when they would be responsible for the consequence of their act. Such may not have been their purpose, but it is liable to such construction. The injunction is dissolved.”<sup>218</sup>

Certainly, when the complainant sees fit to misrepresent the scope of the injunctive order, or to use it as the basis of mere intimidating threats, the injunction should be dissolved, even though entered by consent.<sup>219</sup>

218. *Wilson Packing Co. v. Clap*, 13 Off. Gaz. 368, Fed. Case 17, 850.

219. *Meyers v. Skinner*, 186 Fed. Rep. 347.

In sustaining a motion to dissolve an injunction *pendente lite* entered by consent, Judge Chatfield has said:

“The complainant has apparently used the injunction *pendente lite*, obtained by consent upon the claims referred to, for the purpose of advertising, and for the legitimate purpose of warning the trade generally, as well as individual customers of the defendants, that he will protect his rights under the patent against infringers, but has intimated that he will seek to establish rights against so-called contributory infringers. He has thus warned customers of the defendant, MacFarland, that the complainant will seek to prosecute and punish any purchaser or user of a product of any machine which infringes the patent in suit, even though the product be not covered by the patent.

“Not only would it seem with reference to such a patent, that there is no basis upon the record as it stands for a warning against becoming contributory infringers, so far as parties are concerned, who do not knowingly assist or participate in or encourage the infringing use of the patent itself, but the general condition of the testimony, and the relation which the defendant MacFarland seems to have had with the acts claimed to be infringements by the complainant, do not seem to justify the use which has been made of the injunction obtained by consent.

“Although the defendant MacFarland did, however, consent to the issuance of this injunction, upon claim by him that he had no intention of infringing in any way, and as the consent was given after the court had refused to grant such an injunction upon an unadjudicated patent, if diligent action was taken toward final hearing, it seems to the court that he (defendant MacFarland) is justified in asking that, so far as he is concerned, the injunction *pendente lite* be vacated, upon condition that the

case be promptly completed. The complainant may have the right to ask for immediate restoration of the injunction, if any action occur on the part of McFarland which would indicate an attempt on his part to make use of any device that can legitimately be held to infringe the claims in question, or to improperly advertise this opinion and decision, beyond making it known that the injunction *pendente lite* has been vacated as to MacFarland, unless he be guilty of evident infringement, assuming that the complainant's rights will be fully established, both as to validity or prior infringement." <sup>220</sup>

§ 521. Segregation of the invention from its environment for purposes of construction.

As is well known to those familiar with inventions, the addition of insignificant improvements to complex mechanisms frequently serves as the basis of stock-selling fraud, and imposition upon purchasers of the machine; the relevancy of the small patented feature to the unpatented (or infringing) entire machine being unknown to the victim. There is also the danger, in construing the patent relating to the minor patented detail, of confusing it with the entire mechanism of which it is a part. This danger has been pointed out and illustrated by Judge Coxe in two of his admirable opinions, delivered over twenty years apart (1888-1911), from which we extract the following:

“The patentee appears to employ a wire signal-bell to summon a servant in a railway car; but can it be that it required an exercise of the inventive faculties to do this, in view of the fact that the identical apparatus had previously been used for the identical purpose in dwelling-houses, hotels, and steamboats? The additional fact

220. *Meyers v. Skinner*, 186 Fed. Rep. 348.

should also be remembered that similar signaling appliances had been used in horse cars and in railway cars. The only novel feature that can by the most liberal construction be discovered, is the location of the apparatus in railway cars. The operation is the same; the result is the same. If it be invention to place a jingle bell in a passenger car, then each successive applicant who finds a new situation for such a bell is entitled to the rewards of an inventor. If this claim is held to be valid, with what consistency could a patent be refused to a person who, for the first time, should connect in a similar manner a row of bath-houses at the sea-side, or the boxes in a theatre, or the tables in a restaurant? To remove a bell from the state-room of a passenger steamer, and place it in the state-room of a passenger car, requires no more of the inventive faculty than to take a steam whistle from a tug-boat and place it on a woolen mill—no more than to place a doctor's speaking-tube at the front door of a lawyer. The supreme court has over and over again decided that it was not invention to find a new place for an old device without change in the result, or in the manner of operation."<sup>221</sup>

“In approaching this subject it is wise to disabuse the mind of the notion that an exceptionally high order of intellect is required because the improvements relate to type-writers. The Remington machines in evidence have a notice prominently printed thereon stating that ‘This machine is protected by sixty-seven American and foreign patents.’ There is danger that the court in contemplating a machine so complicated and delicately organized may become imbued with the idea that no changes or additions can be made unless the party making them

221. Mann's Boudoir Car Co. v. Monarch Parlor Sleeping Car Co., 34 Fed. Rep. 132.

is possessed of an extraordinary degree of ingenuity. Mechanical skill is not converted into invention because it is applied to a structure showing the highest degree of inventive genius. If the problem be to construct a key for a lock, it can make no difference whether the lock be attached to a typewriter or an ice box.”<sup>222</sup>

In the views thus expressed, the learned court is amply supported by authority.<sup>223</sup>

### § 522. Is the repairer an infringer?

We have heretofore considered,<sup>224</sup> the extent to which the purchaser of a patented mechanism may replace or repair its worn parts. The liability of the person who merely makes repairs under contract with the owner of the device is a different matter, concerning which there is much less authority in the cases, and which is attended with a degree of difficulty in its determination.

In a case in which the defendant was an engineering works which repaired boilers, made under complainant's patent, by installing new tubes, in one case supplying “4 out of 19 tiers,” Judge Thomas, after analyzing the cases relating to replacement and repair by the owner, deduces the general doctrine that “a part of a combination may not be replaced by the purchaser when it is the vital element of the combination, in fact, and in regard to patentability, especially when it is not intended to be of short life by the action of external forces thereon. The generalization,” he continues, “is probably imperfect, but it is considered that the spirit of the law, as expressed in the decisions, is at least that a part that gives sole patentability to the combination may not be

222. *Hillard v. Remington Typewriter Co.*, 186 Fed. Rep. 337, — C. C. A. —.

223. *Aron v. Manhattan R. Co.*,

132 U. S. 84, 33 L. Ed. 272; *Stephenson v. Brooklyn R. R. Co.*, 114 U. S. 149, 29 L. Ed. 58.

224. *Ante*, p. 334.



replaced by a purchaser without the patentee's consent." 225 From this premise he argues that the repairer's "attitude is that of a trespasser," under the facts of the case at bar. "It is not as if a tube or a few tubes had been broken, and in an exigency the purchaser applied to a local mechanic to supply them. What would be equitable in such an instance need not be determined, for here the defendant has entered the business for the general purpose of supplying tubes, few or many, and should be enjoined from such general business." 226

Judge Archbald has carried the doctrine a little further.

"No doubt, within certain bounds," is his opinion, "a patented article may be repaired without making the repairer an infringer, but not where it is done for one who is. It is only where the device in patented form has come lawfully into the hands of the person for or by whom it is repaired that this is the case. In other words, if one without right constructs or disposes of an infringing machine, it affords no protection to another to have merely repaired it; the repairer, by supplying an essential part of the patented combination, contributing by so much to the perpetuation of the infringement." 227 With which doctrine we agree, with this important proviso; that the repairer, to be held as a contributory infringer, must be shown to have that intent which is a vital element in contributory infringement, under the rules heretofore discussed. 228

§ 523. Sales to complainant's agent as evidence of infringement.

Mr. Justice Curtis, in an action at law for damages for patent infringement, where the evidence (on an

225. *Morrin v. Robert White Engineering Works*, 138 Fed. Rep. 68-81.

226. *Ibid*, at page 82.

227. *Union Special Mach. Co. v. Maimin*, 161 Fed. Rep. 748, 750.

228. *Ante*, pp. 328, 331.

agreed statement) showed a single sale of matches "of the value of six cents" to an agent of the plaintiff, held that a sale to the agent was a sale to the plaintiff; that the common law rule of "*volenti non fit injuria*" applied, and that such a sale is not an infringement, and that judgment should go for the defendant.<sup>229</sup>

This doctrine may be sound, but if it is it must be limited to the action at law. Where the thing made in infringement of the plaintiff's patent is on hand for sale by the defendant, it is certainly a mere quibble that it was sold to the complainant's agent, instead of some other purchaser, so far as the transaction furnishes evidence upon which an injunction should be based. In such a case Judge Lacombe has said "there is no force in the suggestion that the sale was made to a purchaser who bought in the interest of complainants, in order to secure proof of infringement. We are not now dealing with any question of damages, but with the mere fact of sale in conformity to the patent. The sale of such a device is an act of infringement, although it may be made under such circumstances that complainants cannot recover damages for it."<sup>230</sup>

#### § 524. A single sale as basis for injunction.

A single sale, as Judge Lacombe has said, "may, in connection with other proof, be persuasive evidence of other sales, and convincing proof of an intention to sell whenever the opportunity of doing so without detection is presented."<sup>231</sup> This doctrine is sound. A single sale of a machine or article of manufacture or composition of matter will always suffice as the basis of injunction,

229. *Byam v. Bullard*, 1 Curtis 100, Fed. Case 2, 262.

*Co. v. Phila. Pneumatic Tool Co.*, 118 Fed. Rep. 852.

230. *Chicago Pneumatic Tool*

231. *Lever Bros., Ltd., v. Pasfield*, 88 Fed. Rep. 484.

assuming that it was not prepared at the instance of the complainant. There are many instances of injunction being awarded upon proof of a single sale.<sup>232</sup> In what has been said it should be understood that we are considering only the question of injunction, preliminary or on final hearing, and without regard to the question of the right to an accounting. In fact, the rule has been properly limited by Judge Cox, who says "a single sale made in circumstances which indicate a readiness to make other similar sales upon application is sufficient to make out a prima facie case."<sup>233</sup> It must be borne in mind that unless the prima facie case indicates that a substantial recovery of profits may be had, the court may refuse to order an accounting;<sup>234</sup> notwithstanding the general rule that the right to an account of profits is incidental to the right to an injunction.<sup>235</sup>

What has been said is entirely consistent with Judge Lurton's doctrine, "that a single infringement by making and selling a single infringing machine would not justify the interposition of a court of equity for the purpose of restraining further infringement by the making and sale of other infringing machines, if it appeared clearly that there was no reason to apprehend any further infringement."<sup>236</sup> The cases in which the sale of a single machine made by the defendant would not give reason to apprehend further infringement are, of course, rare and extraordinary.

232. Chicago Pneumatic Tool Co. v. Phila. Pneumatic Tool Co., 118 Fed. Rep. 852; Wooster v. Clark, 9 Fed. Rep. 854.

233. Hutter v. De Q. Bottle Stopper Co., 128 Fed. Rep. 233, 62 C. C. A. 652.

234. Ludington v. Leonard, 127 Fed. Rep. 155, 62 C. C. A. 269.

235. Stevens v. Gladding, 58 U. S. 447, 15 L. Ed. 155.

236. Johnson v. Foos Mfg. Co., 141 Fed. Rep. 73, 72 C. C. A. 123.

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§ 525. Single violation of injunction.

In contempt proceedings, while the number of instances of violation of the injunction has no bearing upon the question of the technical guilt or innocence of the defendant, a single violation, in the absence of evidence that it was but one of a contemplated series of violations of the order, will never be punished as severely as will the commission of a series of such acts. The courts are inclined, in the case of a single violation of the injunction to consider favorably the defence that it was inadvertent, or accidental; while these defenses will be usually disregarded when the offense is repeated.<sup>237</sup> Thus, in a case where the defendant was charged with a single violation of an injunctive order, Judge Lacombe said "the court is not disposed to discredit the affidavits submitted by defendants, which show that the occurrence was a sporadic one, not likely to occur again, and not planned by defendants as a cover for deliberate, or even careless, infringement. Of course, if the same thing should happen again, that circumstance might indicate design."<sup>238</sup> In a case where the violations of the order were repeated, Judge Reed said "the evidence leaves no room to doubt that the defendant himself sold a number of these phonograph records, and received the pay therefor after the preliminary injunction was served upon him. The violation of the writ was deliberate and intentional, and cannot be overlooked. Parties must know that writs of injunction are not issued by the courts as a mere pastime and for their own pleasure, to be observed or not as those against whom they are issued may elect, but are issued to protect and preserve the property rights of parties

237. Christensen Engineering Co. v. Westinghouse Air Brake Company, 135 Fed. Rep. 774, 780, 68 C. C. A. 476.

238. Motion Picture Patents Co. v. Laemmle, 189 Fed. Rep. 641.

pending litigation between them; and those against whom they are issued and upon whom they are served must be given to understand that any intentional violation of them will not be tolerated, but will be punished, and by imprisonment if necessary, to vindicate the authority of the court and protect the rights of parties involved in the controversy in which they are issued.”<sup>239</sup>

§ 526. Testimony taken out of time.

The time fixed by the Sixty-ninth Rule in Equity for the taking of testimony is three months; the rule reading, “Three months and no more shall be allowed for the taking of testimony after the cause is at issue, unless the court or a judge thereof shall, upon special cause shown by either party, enlarge the time; and no testimony taken after such period shall be allowed to be read in evidence at the hearing. Immediately upon the return of the commissions and depositions containing the testimony into the clerk’s office, publication thereof may be ordered in the clerk’s office, by any judge of the court upon due notice to the parties, or it may be enlarged, as he may deem reasonable under all the circumstances. But by consent of the parties publication of the testimony may at any time pass in the clerk’s office, such consent being in writing, and a copy thereof entered in the order book or indorsed upon the deposition or testimony.”

The three months’ period allowed by this rule is for the taking of the testimony of all of the parties.<sup>240</sup> Mr. Justice Blatchford in an early case said, “Rule 69 is imperative, that no testimony taken after time shall be al-

239. *New Jersey Patent Co. v. Martin*, 186 Fed. Rep. 513, 517.

240. *Ingle v. Jones*, 9 Wall. 486, 19 L. Ed. 621.

lowed to be read at the hearing.”<sup>241</sup> A little later it was held by Judge Wheeler that testimony taken and filed out of time, in the absence of a motion to suppress, would be considered upon the hearing, notwithstanding the objection of the opposing party to its consideration.<sup>242</sup>

The failure of a complainant to take any proof for a long time after the filing of the bill has always been ground for a motion to dismiss,<sup>243</sup> but the practice generally is that of accommodation between counsel, under their agreement to extend the time for taking testimony, and is for the most part by verbal stipulation, and without procuring any order of extension from the court. This is undeniably loose practice, but it has obtained to such an extent as to be recognized by the courts. Thus, Judge Lacombe has said, “Whatever may be the condition elsewhere, it became apparent long since that in this district it is very rarely that either side desires or expects to complete its proofs within ninety days. Very often it is not physically possible for them to do so. Of course, the court has always been willing to entertain a motion to enlarge the time, and to grant it, if both sides agree, or if good cause be shown.

“In order to avoid a multiplicity of such motions, it gradually became the settled practice here to assume that both sides had agreed to an enlargement when, during the ninety days, neither completed their proof, but testimony was taken without objection after the ninety days expired, or when neither side put in any evidence at all within the time limited, and neither side had moved to apportion the time, and defendant had not moved either to set the cause down for final hearing on bill and answer

241. *Wooster v. Clark*, 9 Fed. Rep. 854.

243. *Mackaye v. Mallory*, 80 Fed. Rep. 256.

242. *Matthews v. Spangenberg*, 19 Fed. Rep. 823.

or to dismiss it for failure to prosecute. This ruling has been made many times, but apparently the brief memoranda have not got into the reports, since defendant says he has not found any such statement of the practice.”<sup>244</sup>

§ 527. Letters patent as the subject of eminent domain.

The right of eminent domain extends both to real property and personal property. It has been referred to by the United States Supreme Court as “the power of appropriating private property to public uses vested in the General Government—its right of eminent domain, which Vattel defines to be the right of disposing, in case of necessity and for the public safety, of all the wealth of the country.”<sup>245</sup>

Does this right of eminent domain extend to letters patent for invention? If it does, it is solely the right of the United States, and cannot be transferred to a State.<sup>246</sup>

From the inception of the British patent system until 1883, the Crown might make whatever use it pleased of any inventions without any recognition of any right in the inventor or the patentee.<sup>247</sup> But by the Act of 1883, § 27, it was provided,

1. “A patent shall have to all intents the like effects as against her Majesty the Queen, her heirs and successors, as it has against a subject.

2. “But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors,<sup>248</sup> or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use there-

244. Jackson v. Wolverine Copper Mining Co., 186 Fed. Rep. 643.

245. United States v. Jones, 109 U. S. 513, 27 L. Ed. 1015.

246. Ibid.

247. Feather v. Rex, 6 B. & S. 257.

248. Dixon v. The London Small Arms Co., 1875, L. R. 10 Q. B. 130; L. R. 1 App. Cas. 641.

of agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.”

The obligation of Sovereignty to make compensation for the use of an invention without the consent of the inventor or patentee, does not contravene the right of eminent domain, or negative its existence. The United States Supreme Court has held that “the provision found in the Fifth Amendment to the Federal Constitution, and in the Constitutions of the several States, for just compensation for the property taken, is merely a limitation upon the use of the power (of eminent domain). It is no part of the power itself, but a condition upon which the power may be exercised.”<sup>249</sup>

The Act of June 25, 1910, 36 Stat. at L., p. 851, provides:

“That whenever an invention described in and covered by a patent of the United States shall hereafter be used by the United States without license of the owner thereof or lawful right to use the same, such owner may recover reasonable compensation for such use by suit in the Court of Claims: *Provided, however,* That said Court of Claims shall not entertain a suit or award compensation under the provisions of this Act where the claim for compensation is based on the use by the United States of any article heretofore owned, leased, used by, or in the possession of the United States; *Provided further,* That in any such suit the United States may avail itself of any and all defenses, general or special, which might be pleaded by a defendant in an action for infringement, as set forth in Title Sixty of the Revised Statutes, or otherwise: *And provided further,* that the benefits

249. United States v. Jones, 109 U. S. 513, 27 L. Ed. 1015.



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of this Act shall not inure to any patentee, who, when he makes such claim is in the employment or service of the Government of the United States; or the assignee of any such patentee; nor shall this Act apply to any device discovered or invented by such employee during the time of his employment or service.”

Under the doctrine just alluded to, this Act is entirely in harmony with the theory of the right of the Government of the United States to exercise the power of eminent domain over letters patent “in case of necessity and for the public safety.” The existence of this right has been judicially affirmed by the Circuit Court of Appeals for the Fourth Circuit in a notable opinion from which we take the following:

“We think that the consent of the owner of a patented device, while it is desirable, and should be obtained, if it conveniently and reasonably can, is not positively necessary in order to enable the United States to use the invention described in the letters patent, particularly in cases where it relates to the mode of construction of implements of warfare required by the government, and indispensable to the armament of its vessels of war. Such right to take and use the property of the citizen for government purposes is indisputable, an inborn element of sovereign power essential to the independence and perpetuity of the nation. \* \* \* The fifth amendment to the Constitution of the United States contains the provision that private property shall not be taken for public use without just compensation, and this we must consider as an implied assertion that on making such compensation it may be so taken. It will be noted that this is not a restriction of the power to take private property for public use, but that it is a requirement that when such property is so taken just compensation shall be made therefor to the owner. That incident of sovereignty—

the right to take—belonging to every independent government is not disturbed, nor is the manner in which such right is to be exercised, or the mode by which the proper compensation is to be ascertained and paid, set forth. And because Congress has provided by statutes a procedure for the condemnation of private property required for public purposes in certain instances, and not in others, we are not therefore to infer that the power to take does not exist as to the other matters; nor should we construe such legislation as a limitation of that power relative to other cases of like character not embraced in such enactments. In other words, the nonuser of a power is not to be used to disprove its existence.

“The title the individual citizen has to his property is good as against all other citizens, but it must yield to the necessity of the government, and submit to the social requirements and rights of the general public; and this right of the government to protect itself and defend its own is not to be controlled by any other power, nor is it to depend on the consent of any person, company, or corporation. The only restriction, as we have already remarked, is the constitutional requirement that just compensation shall be made to the owner for property so taken. The proper mode of proceeding in order to secure compensation for private property taken for public use without the consent of the owner, and in the absence of legal action for condemnation, has received judicial consideration, the Supreme Court of the United States having at different times plainly indicated the same, particularly in cases where the government has used an invention without the permission of the owner of the letters patent protecting the same.”<sup>250</sup>

250. Goff, J., in *Dashiell v. Grosvenor*, 66 Fed. Rep. 334, 337, 338, 13 C. C. A. 593, 27 L. R. A. 67; affirmed, 162 U. S. 425, 40 L. Ed. 1025. Citing *Kohl v. U. S.*, 91 U. S. 367, 374, 23 L. Ed. 449; *James v. Campbell*, 104 U. S. 356, 26 L. Ed. 786; *U. S. v. Great Falls*

§ 528. The effect upon letters patent of the co-pendency of the applications on which they were issued.

In considering the effect, in the construction and comparison of two or more letters patent, of the fact that the applications upon which they were issued were contemporaneously pending in the Patent Office, we must base our examination of the law upon the elementary proposition that each of the issued patents is attended by the presumption that it was providently issued. In the language of Judge Putnam, "The law is settled that, as to every point touching the validity of a claim, the patent itself is *prima facie* evidence, although in many cases the presumption which it affords is very slight and purely technical."<sup>251</sup>

As between any two patents, the fact that both were issued is "virtually a decision by the Patent Office that there was a substantial difference between the two inventions,"<sup>252</sup> and that the difference between them is patentable;<sup>253</sup> and these presumptions attach to them even though the applications upon which they are based were not pending at the same time in the Patent Office.<sup>254</sup>

Where patents result from co-pending applications, without an interference having been instituted between them, "it is obvious that it must have been the judgment

Mfg. Co., 112 U. S. 645, 656, 28 L. Ed. 846; *Hollister v. Benedict & B. Mfg. Co.*, 113 U. S. 59, 28 L. Ed. 901; *U. S. v. Palmer*, 128 U. S. 262, 32 L. Ed. 442; also, the following cases in the court of claims: *Schillinger's Case*, 24 Ct. Cl. 278, 298; *Gill's Case*, 25 Ct. Cl. 415; *Berdan's Case*, 26 Ct. Cl. 48.

251. *Chase v. Fillebrown*, 58 Fed. Rep. 374, 376.

252. *Ricks, J.*, in *Keuffel v. Lufkin Rule Co.*, 74 Fed. Rep. 553, 555.

253. *Miller v. Eagle Mfg. Co.*, 151 U. S. 186, 38 L. Ed. 121; *Ransome v. Hyatt*, 69 Fed. Rep. 148, 16 C. C. A. 185.

254. *Ney v. Ney Mfg. Co.*, 69 Fed. Rep. 405, 16 C. C. A. 293.

of the officials (of the Patent Office) that there was no occasion for an interference.”<sup>255</sup>

In the case of co-pending applications, where the purpose of the invention was the same in each application, and where the principal parts of the respective machines described were substantially similar, the Supreme Court has held that it was evidently “the judgment of the Office that the distinguishing features were to be found in some of the smaller and, perhaps, less important devices described and claimed.”<sup>256</sup>

But despite the technical presumptions to which we have adverted, where the court concludes that both patents “are for the same thing, so far as any inventive quality is concerned, and that only one of them can stand,” it becomes necessary for the court to determine the question of priority of invention between the patents, in order to determine which of them is valid.<sup>257</sup>

As between the co-pending applications of the same inventor, the law is well settled that his omission to claim what he describes in one application will not operate as a disclaimer or an abandonment of the matter not claimed provided that the matter in question is properly and adequately claimed in his other co-pending application.<sup>258</sup>

A companion rule to the one just stated is that under such circumstances neither of the inventor’s patents can be used to anticipate the other. “Even where each of

255. *Boyd v. Janesville Hay Tool Co.*, 158 U. S. 260, 261, 39 L. Ed. 973, 975.

256. *Boyd v. Janesville Hay Tool Co.*, 158 U. S. 260, 261, 39 L. Ed. 973, 975. Following *Burns v. Meyer*, 100 U. S. 671, 25 L. Ed. 738.

257. *Brooks v. Sacks*, 81 Fed. Rep. 403, 405, 26 C. C. A. 456.

258. *Thomson-Houston Elec. Co. v. Elmira R. Co.*, 71 Fed. Rep. 396; *Kinnear Mfg. Co. v. Wilson*, 142 Fed. Rep. 970, 74 C. C. A. 232; *Suffolk Co. v. Hayden*, 3 Wall. 315, 18 L. Ed. 76; *Barbed Wire Case*, 143 U. S. 275, 36 L. Ed. 154.

several applications which subsequently ripen into patents to the same inventor discloses all the inventions claimed in all the applications, and they are all pending at the same time, no one of the applications or patents can be used to anticipate any of the claims of the others which it does not itself claim and secure.”<sup>259</sup>

Where one of a series of co-pending applications of the same inventor is attacked by the defense of prior public use, that defense may be met, and the patent saved, by showing that the invention was described in another of the co-pending applications, which was filed at a time when the bar of public use had not been created.<sup>260</sup>

The defense of double patenting does not apply to either of a series of patents issued upon co-pending applications, where each has claims distinct from those of the others; and in this regard, it is immaterial whether the broader patent issues before or after the others. “When the patent first granted is distinctly and only for an improvement on another invention which is already the subject of a prior application then pending, and on which a later patent is granted, the patent for the improvement in no wise interferes with the other application or the patent issued thereon, for the reason that the patents are for separate and distinct inventions. In just such a case as this we held that the later patent, being one for the generic invention, was not invalidated by reason of the issue of a previous patent in which improvements upon the other only had been patented. We had already so held in *Thompson-Houston Electric Co. v.*

259. Sanborn, J., in *Anderson v. Collins*, 122 Fed. Rep. 451, 458, 58 C. C. A. 669. Following *Graham v. Geneva Lake Crawford Mfg. Co.*, 11 Fed. Rep. 138; *Graham v. McCormick*, 11 Fed. Rep. 859; *Westinghouse Elec. & Mfg.*

*Co. v. Dayton Fan & Motor Co.*, 106 Fed. Rep. 724; *Ide v. Trorlicht, Duncker & Rennard Carpet Co.*, 115 Fed. Rep. 137, 53 C. C. A. 341.

260. *Victor Talking Machine Co. v. American Graphophone Co.*, 145 Fed. Rep. 350, 76 C. C. A. 180.

Ohio Brass Co., 80 Fed. Rep. 712, 26 C. C. A. 107. It is true that in the applications for these patents for improvements there was no express disclaimer or renunciation of the matter of the former application. But that was unnecessary. The application was pending and being prosecuted in the Patent Office, and the fact that the applicant for the improvement patents did not intend to release his former invention to the public was as well understood as if he had in express terms said so. In order to explain the basis of the improvement patents, it was necessary to state what the improvement was upon, and how it fitted it. Having done this, he claimed what was new, and thereby distinguished what his patent was intended to include.”<sup>261</sup>

§ 529. Limitation of actions to compel the grant of letters patent.

We have heretofore considered the pleading and practice in proceedings under § 4915, R. S. U. S., to compel the grant of letters patent. That section provides no limitation of time within which the action must be brought. The Supreme Court, however, has by construction provided a limitation, in the following way. It has construed the proceeding under § 4915, R. S. U. S., to be a part of the application. “Although, as was said by this court in *Butterworth v. U. S.*, 112 U. S. 50, 61, 28 L. Ed. 656, 659,<sup>262</sup> the proceeding by bill in equity, under section 4915, on the refusal to grant an application for a patent, intends a suit according to the ordinary course of equity practice and procedure, and is not a technical appeal from the Patent Office, nor confined to the case as made

261. Severens, J., in *Cleveland Foundry Co. v. Detroit Vapor Stove Co.*, 131 Fed. Rep. 853, 858, 68 C. C. A. 233.

262. Citing *Whipple v. Miner*, 15 Fed. Rep. 117; *Ex parte Squire*, 3 Ban. & Ard. 133, Fed. Case 13269; *Butler v. Shaw*, 21 Fed. Rep. 321.

in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits, yet the proceeding is, in fact and necessity, a part of the application for the patent.”<sup>263</sup>

Being a part of the application, it follows that the statutory limitation as to amendments applies to the time for filing the suit; and the limitation is as follows:

Section 4894, R. S. U. S. “All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.”

Prior to its amendment, § 4894, R. S. U. S., provided a two years' period for amendment; and under the section as it then stood the Supreme Court held, “The presumption of abandonment, under section 4894, unless it is shown that the delay in prosecuting the application for two years and more after the last prior action, of which notice was given to the applicant, was unavoidable, exists as fully in regard to that branch of the application involved in the remedy by bill in equity as in regard to any other part of the application, whether so much of it as is strictly within the Patent Office, or so much of it as consists of an appeal to the Supreme Court under section 4911. The decision of the court on a bill in equity becomes, equally with the judgment of the Supreme Court of the District of Columbia on a direct appeal under section 4911, the decision of the Patent Office and is to gov-

263. Blatchford, J., in *Gandy v. Marble*, 122 U. S. 432, 30 L. Ed. 1223.

ern the action of the commissioner. It is, therefore, clearly a branch of the application for the patent, and to be governed by the rule as to laches and delay declared by section 4894 to be attendant upon the application.”<sup>264</sup>

The same application has been made of the section as amended, in an opinion in which Judge Rellstab says of the question of delay, “ ‘unavoidable,’ as defined by the lexicographers, means inevitable; a condition of affairs impossible to avert. Perhaps the word as here used is not to be given such a strict meaning; but certainly it was intended to penalize a year’s delay due simply to negligence. The legislative purpose was to spur the litigants to activity. To delay without cause, or, when the cause is completely within the control of the party charged with the duty to act, the failure to act, is neglect, and negligence is antithetical to unavoidableness.

\* \* \* Failure to prosecute within the year because of clerical error in noting the dates, mistaking the remedy to obtain a new hearing, sickness for only a part of the limited period, mislaying the papers, as well as neglect of the attorney to prosecute, contrary to desire of applicant, have been held by the Patent Office tribunals as not unavoidable.”<sup>265</sup>

§ 530. The complainant’s liability to the defendant on the dissolution of a preliminary injunction.

We have heretofore referred to the practice of exacting security from the defendant in lieu of a preliminary

264. Blatchford, J., in *Gandy v. Marble*, 122 U. S. 432, 30 L. Ed. 1223.

265. *Westinghouse Elec. & Mfg. Co. v. Ohio Brass Co.*, 186 Fed. Rep. 518, 520. Following *Ex parte Warren*, 96 Off. Gaz. 2410; *Ex parte Collins*, 97 Off. Gaz. 1372; *Ex parte Bohlecke*, 97 Off. Gaz.

2743; *Ex parte Fritts*, 101 Off. Gaz. 1131; *Ex parte Beecher*, 101 Off. Gaz. 1132; *Ex parte McElroy*, 101 Off. Gaz. 2823; *Ex parte Miller*, 105 Off. Gaz. 2057; *Ex parte Marconi*, 108 Off. Gaz. 796; *Ex parte Clausen*, 118 Off. Gaz. 838; *Ex parte Block*, 119 Off. Gaz. 963; *Ex parte Hess*, 126 Off. Gaz. 3041.



injunction.<sup>266</sup> In this section we will deal with the liability of the complainant upon the dissolution of the preliminary injunction, whether or not a bond has been exacted of the complainant.

As to the execution of such bonds, Mr. Justice Bradley has said:

“It is a settled rule of the court of chancery, in acting on applications for injunctions, to regard the comparative injury which would be sustained by the defendant, if an injunction were granted, and by the complainant, if it were refused. And if the legal right is doubtful, either in point of law or of fact, the court is always reluctant to take a course which may result in material injury to either party; for the damage arising from the act of the court itself is *damnum absque injuria*, for which there is no redress except a decree for the costs of the suit, or, in a proper case, an action for malicious prosecution. To remedy this difficulty, the court, in the exercise of its discretion, frequently resorts to the expedient of imposing terms and conditions upon the party at whose instance it proposes to act. The power to impose such conditions is founded upon and arises from the discretion which the court has in such cases, to grant or not to grant the injunction applied for. It is a power inherent in the court, as a court of equity, and has been exercised from time immemorial. The older authorities refer to numerous instances in which it has been exercised.”<sup>267</sup>

The liability where bond is given.

In the case from which we have just quoted, Mr. Justice Bradley says “where no bond or undertaking has been required, it is clear that the court has no power to award damages sustained by either party in conse-

266. *Ante*, p. 538.

267. *Russell v. Farley*, 105 U. S. 433, 26 L. Ed. 1062.

quence of the litigation, except by making such a decree in reference to the cost of the suit as may be equitable and just.”<sup>268</sup> In another case the same learned judge said:

“By the law of Louisiana damages may be recovered for suing out an injunction without just cause, independently of a bond. *Florance v. Nixon*, 3 La. 291. But this cannot be done in the United States Courts. Without a bond no damages can be recovered at all. Without a bond for the payment of damages or other obligation of like effect, a party against whom an injunction wrongfully issues can recover nothing but costs, unless he can make out a case of malicious prosecution. It is only by reason of the bond and upon the bond, that he can recover anything.”<sup>269</sup>

Judge Blodgett, however, has pointed out that the absence of a bond does not always preclude a recovery of damages by the defendant upon a dissolution of a preliminary injunction.

“The power of court of equity, on application for a preliminary injunction *pendente lite* to require from the complainant a bond to indemnify the defendant sought to be enjoined, as a condition on which such an injunction is granted, is too well established to be subject to question at this day. Probably the better authority is that if a preliminary injunction is granted after notice and hearing, without the requirement of a bond, the defendant is remediless, except in cases where the defendant is able to show that the complainant had no probable cause for the writ, and obtained it by imposition upon the court.”<sup>270</sup>

268. *Ibid.*

269. *Meyers v. Block*, 120 U. S. 206, 30 L. Ed. 642.

270. *Tobey Furniture Company v. Colby*, 35 Fed. Rep. 592. Citing

*Gorton v. Brown*, 27 Ill. 489, 81 Am. Dec. 245; *Sturgis v. Knapp*, 33 Vt. 486; *Cox v. Taylor's Adm's*, 10 B. Mon. (Ky.) 17. To the same effect see *Scheck v. Kelly*, 95 Fed.

The rule thus expressed relates to cases involving an order granting a preliminary injunction, without more. But liability to respond to damages in the event of the ultimate dissolution of the preliminary injunction may be imposed upon the complainant by the language of the court's order. Thus Judge Drummond has said, "The court orders the injunction, prescribes the terms upon which it shall be issued, and may require a bond, stipulation, or undertaking as a condition upon which it shall be issued or not according to its own view of the circumstances of the case."<sup>271</sup>

An illustrative order ran as follows: "It is ordered that the order for preliminary injunction, entered herein on the 17th instant, be, and the same is, hereby modified by adding the following, to-wit: It is further ordered that the complainant pay the defendant such resulting damages as it may sustain in case it be finally decided that said injunction ought not to have been granted."

Upon a final decree dissolving the injunction and dismissing the bill of complaint whereon it was issued for want of equity, in the case in which said order was made, Judge Kohlsaatt added the following clause to the order of dismissal; "said cause coming on to be heard upon the motion of defendant to cause an accounting to be had to ascertain what, if any, damages defendant has sustained by reason of the wrongful issuance of said injunction, it is ordered that said application for damages be referred to a master in chancery of this court to ascertain the same, and report to the court his finding in the premises."<sup>272</sup>

Rep. 941; *City of St. Louis v. St. Louis Gas Light Co.*, 82 Mo. 354; *National Phonograph Co. v. American Graphophone Co.*, 136 Fed. Rep. 231.

271. *Lea v. Deakin*, 13 Fed. Rep. 514.

272. *Mica Insulator Co. v. Commercial Mica Co.*, 157 Fed. Rep. 92, 96.

Where there is a bond.

Where a bond is given as a condition of granting a preliminary injunction, such a bond creates no liability upon the part of the surety for damages occasioned to a person who is a stranger to the suit, by the injunction.<sup>273</sup> When the injunction is dissolved, the damages will be assessed by the court in the same proceeding.<sup>274</sup> Judge Taft said of the procedure to assess damages upon the injunction bond, "in such a proceeding, at least when the amount of recovery is uncertain, the sureties must have notice and their day in court before the amount of damages is fixed against them."<sup>275</sup>

In the same case he held that where the jurisdictional amount was sufficient, the Federal Court had jurisdiction in an action for damages upon the bond "on the ground that the plaintiff is enforcing rights secured to him under the Constitution and the laws of the United States."<sup>276</sup>

The Federal courts have held uniformly that an injunction bond, in the absence of a specific covenant to that effect, is not liable for the payment of counsel fees of the successful defendant.<sup>277</sup> This rule is at variance with that of the State courts of many of the states; and for

273. *Hays v. Fidelity & Deposit Co.*, 112 Fed. Rep. 872, 50 C. C. A. 569.

274. *Deakin v. Stanton*, 3 Fed. Rep. 435; *Lea v. Deakin*, 13 Fed. Rep. 514; *Coosaw Mining Co. v. Farmers' Mining Co.*, 51 Fed. Rep. 107; *Lamb v. Ewing*, 54 Fed. Rep. 269, 4 C. C. A. 320; *West v. East Coast Cedar Co.*, 113 Fed. Rep. 742, 51 C. C. A. 416. The early rule was otherwise. *Bein v. Heath*, 12 How. 168, 13 L. Ed. 939. That the court has power to assess the damages, but may refuse to do so, and may leave the injured party

to his remedy at law, see *Russell v. Farley*, 105 U. S. 433, 26 L. Ed. 1060.

275. *Leslie v. Brown*, 90 Fed. Rep. 171, 174, 32 C. C. A. 556.

276. *Ibid.*

277. *Bein v. Heath*, 12 How. 168, 13 L. Ed. 939; *Oelrichs v. Spain*, 15 Wall. 211, 21 L. Ed. 43; *Browning v. Porter*, 12 Fed. Rep. 460; *The Alice*, 12 Fed. Rep. 502; *Jacobus v. Monongahela State Bank*, 35 Fed. Rep. 396; *Fidelity Ins. T. & S. D. Co. v. Roanoke Iron Co.*, 91 Fed. Rep. 21.

that reason cases are found in the books where the suit to enforce the obligation of an injunction bond given in a Federal court was brought in a State court, for the evident purpose of obtaining the benefit of a rule of damages which would enable the plaintiff to collect his counsel fees. Upon one of such cases being taken by writ of error to the Supreme Court of the United States from the Supreme Court of Kansas, Mr. Justice (now Chief Justice) White said:

“It is strenuously urged \* \* \* that although the rule against allowing attorneys’ fees in actions on injunction bonds was \* \* \* settled by this court adversely to the right to recover such fees, as the local law was to the contrary, the injunction bond given in the Federal court must be enforced, not by the law of the forum in which it was given, but according to the rule of the local law. This proposition again, however, but embodies the contention that the question of the allowance of attorneys’ fees involved no Federal question. \* \* \* For if it be true, and it undoubtedly is, that the giving of such a bond was an act done pursuant to an authority exercised under the Constitution and laws of the United States, it must follow that the bond so taken is to be interpreted with reference to the authority under which it was given, and the principles of jurisprudence controlling such authority, and not by the local law. \* \* \* Now it is at once conceded that the decision by a State court of a question of local or of general law involving no Federal element does not as a matter of course present a Federal question. But where, on the contrary, a Federal element is specially averred and essentially involved, the duty of this court to apply to such Federal question

its own conceptions of the general law we think is incontrovertible.”<sup>278</sup>

In view of the rule thus laid down, the successful defendant in the injunction proceeding cannot evade the Federal rule by bringing action upon the bond in the State court, and it would therefore be of no pertinence to here enumerate the decisions of the State courts which permit counsel fees to be awarded as part of the damages.

In advance of the liability against the bond becoming finally established, the surety cannot maintain a bill in equity in the nature of a bill *quia timet* to procure a decree against his principal upon the bond to indemnify the surety against apprehended danger of loss. This rule obtains even where there exists the usual indemnity agreement exacted by a surety company, “to indemnify and keep indemnified the said company from and against any and all loss, costs, charges, suits, damages, counsel fees, and expenses of whatever kind or nature which said company shall or may, for any cause at any time, sustain or incur, or be put to, for or by reason or in consequence of said company having entered into or executed said bond;” the common law rule being that “whenever a surety signs an obligation with a principal, the law raises an implied agreement to indemnify the surety against all loss and damage by reason of his suretyship.”<sup>279</sup>

§ 531. The comparative effect of laches on motions for preliminary injunction and on final hearing.

There seems to be a rather hopeless conflict between

278. *Tulloch v. Mulvane*, 184 U. S. 497, 512, 46 L. Ed. 657, 666. Followed in *Missouri, K. & T. R. Co. v. Elliott*, 184 U. S. 530, 46 L. Ed. 673.

279. *American Bonding & T. Co. v. Logansport & W. V. Gas Co.*, 95 Fed. Rep. 49.

the cases which hold long-continued laches to be an absolute bar to relief in equity, and those cases which hold that a degree of laches which will preclude the granting of a preliminary injunction will not be a bar to the granting of injunctive relief upon final hearing. Yet the confusion is more apparent than real.

Judge Sawyer said "this doctrine of laches, as I understand it, is, generally, applicable to preliminary injunction, only. When, upon a final hearing, a party, clearly, appears to be entitled to an injunction, unless he has been guilty of laches, I apprehend that, as a general rule, the injunction, as a part of his complete remedy, would not, ordinarily, be denied on the ground of laches alone. It is quite possible that a case may arise where laches, surrounded and attended by other qualifying circumstances, may render it inequitable to grant an injunction, as a part of the relief afforded at the final hearing." <sup>280</sup>

In another case the defense of laches was denied because the defendants had been defiant in their infringement, having been former licensees, and hence had not been misled by the inaction of the complainant.<sup>281</sup>

The distinguishing rule, as stated by Judge Wales, is that "knowledge of and long continued acquiescence by a complainant in an infringement may, in special cases, be fatal on a motion for a preliminary injunction, but will not, on a final hearing, prevent the court from granting such relief as may be just and equitable." <sup>282</sup>

This expression of the rule leaves little, if anything, to be desired. It is neither just or equitable to enjoin

280. *Brush Elec. Co. v. Electric Imp. Co.*, 45 Fed. Rep. 241.

281. *Kittle v. Hall*, 29 Fed. Rep. 508, 512.

282. *Taylor v. Sawyer Spindle*

*Co.*, 75 Fed. Rep. 301, 303, 22 C. C. A. 203; followed in *Empire Cream Separator Co. v. Sears, Roebuck & Co.*, 157 Fed. Rep. 238, 240 (C. C. A.).

a defendant who has been led into the building up of an infringing business by the neglect of the patent owner, with knowledge of the facts, to sue him, under the rule which we have elsewhere discussed.<sup>283</sup> Where the element of deceit, and the inactive waiting for profits to accrue, on the part of the patent owner, do not exist, mere delay may well justify the chancellor in denying preliminary relief, to deserve which the patent owner must be diligent in asserting his rights; although the delay in the latter case may clearly not be of such character, or such long duration, as to justify the refusal of injunctive relief on final hearing. So we see that there are two general kinds or degrees of laches. The first, where it will merely defeat an application for interim relief. The second, of such duration, and attended by such misleading or deceitful conduct toward the defendant as to debar the plaintiff from relief by injunction on final hearing. Beyond this rough division we may not go, for each case must be governed by its peculiar facts.

§ 532. The effect of the pendency of other litigation upon the defense of laches.

Equity never requires the doing of the useless or the impossible. Upon the advent of an invention whose value offers temptation to the infringer, infringements may spring up in all of the circuits, and to a number that would render the expense of simultaneous suits against all of the infringers impossible to any individual manufacturer or other patent owner. Hence the rule that if the patent owner is prompt in bringing a test case, and prompt in suing the other infringers, in rotation, if not simultaneously, he is not guilty of laches in the latest suit brought. The courts have frequently said that the patent owner is under no obligation to sue all of the in-

283. Ante, pp. 475, 552.



fringers of his patent at the same time.<sup>284</sup> "Other infringers cannot complain because only one test suit was brought."<sup>285</sup>

The fact that equity may prevent a multiplicity of suits is ample foundation for the principle which Judge Richards announced—"pending litigation involving the validity and construction of the patent was sufficient reason for not bringing other suits for infringement until the patent should be finally adjudicated."<sup>286</sup>

While, ordinarily, the laches of the agent is that of his principal, under peculiar circumstances the inaction or delay of the attorney in bringing an action may serve as a defense to the charge of laches. Thus the fact that an attorney had been employed to prosecute the charge of infringement for a contingent fee, delayed doing so for a considerable time, and died without bringing the suit, was considered by the Court of Appeals for the Ninth Circuit as meeting the defense of laches interposed to the suit brought later by other counsel.<sup>287</sup>

The natural result of the rule of this section is that the complainant will choose the forum where the conditions are most propitious for the sustaining of his patent. His right, under the Constitution and laws of the United States to elect the forum, has been judicially recognized.<sup>288</sup>

284. American Graphophone Co. v. National Graphophone Co., 90 Fed. Rep. 824; Timolat v. Franklin Boiler Works Co., 122 Fed. Rep. 69, 58 C. C. A. 405.

285. Edison Elec. Light Co. v. Mt. Morris Elec. Light Co., 57 Fed. Rep. 642, 645.

286. United States Mitis Co. v. Detroit Steel & Spring Co., 122 Fed. Rep. 863, 59 C. C. A. 589. Following Edison Elec. Light Co.

v. Sawyer, 53 Fed. Rep. 592, 3 C. C. A. 605; Taylor v. Sawyer Spindle Co., 75 Fed. Rep. 301, 22 C. C. A. 203; New York Filter Mfg. Co. v. Loomis-Manning Filter Co., 91 Fed. Rep. 421.

287. Los Alamitos Sugar Co. v. Carroll, 173 Fed. Rep. 280, 287, 97 C. C. A. 446.

288. Warren Bros. Co. v. City of Montgomery, 172 Fed. Rep. 414, 423.

§ 533. The pendency of litigation as an excuse for delay in applying for a reissue.

When the defectiveness or insufficiency of the original patent has been developed in the course of litigation, the pendency of that litigation prevents the bar of laches arising against a reissue application. But upon the final adjudication against the patent owner in the court of last resort, it was held that any delay is "at the complainant's peril. A just regard for the rights of the public demanded, if the patent was to be resuscitated in the form of a reissue, that it should be done immediately; and especially so when the reissue claims were to sweep under the monopoly devices not covered by the claims of the original."<sup>289</sup>

§ 534. Abatement of actions.

*a. By the plaintiff's assignment of the patent pending the suit.* The effect of such an assignment has been thus succinctly stated. "If a sole plaintiff, suing in his own right, assigns his whole interest to another, he is no longer able to prosecute the suit because he is without interest in the litigation. \* \* \* The suit is completely suspended and cannot be proceeded in till it is revived, and all orders and proceedings pending such amendment will be considered nugatory. After such an abatement, i. e., one caused by assignment of plaintiff's whole interest, the successor in interest, claiming by a title which may be litigated, may revive the suit by an original bill in the nature of a supplemental bill."<sup>290</sup> Thus the effect of such an assignment upon the pending suit in equity is distinguishable from the abatement of

289. Coxe, J., in Thomson-Houston Elec. Co. v. Western Elec. Co., 158 Fed. Rep. 813, 816, 86 C. C. A. 73.

290. Automatic Switch Co. v. Cutler-Hammer Mfg. Co., 147 Fed. Rep. 250, 251, 77 C. C. A. 176.

an action at law, "where a judgment *quod cassetur* is entered. It is merely an interruption to the suit, suspending its progress until the new parties are brought before the court, and if this is not done at a proper time the court will dismiss the suit."<sup>291</sup>

*b. By the defendant's assignment of his interest in the litigation pending the suit.* Where the defendant is not under preliminary injunction, and the infringement is continuing pending the suit, his assignment of his infringing business pending the suit is subject to the general rule, thus expressed by Mr. Chief Justice Waite. "It is well settled that an assignment by a defendant, of his interest in a litigation, does not necessarily defeat a suit. His assignee taking *pendente lite* is bound by what is done against him. The assignee may, at his own election, come in by an appropriate application, and make himself a party, so as to assume the burden of the litigation in his own name, or he may act in the name of his assignor."<sup>292</sup>

*c. By the expiration of the patent pending the suit.* When the patent expires pending the suit, so far as the possibility of injunctive relief against further making by the defendant is concerned, the suit is abated.<sup>293</sup> As to the further use and sale of infringing articles made by the defendant prior to the expiration of the patent, the right to enjoin such using and selling has been affirmed

291. *Ecaubert v. Appleton*, 67 Fed. Rep. 917, 924, quoting from Story, *Equity Pleading*, § 348. As to bills of revivor and their attendant practice, see *ante*, p. 522. That the assignee may be substituted as complainant although the patent has expired, see *Ross v. City of Ft. Wayne*, 63 Fed. Rep. 466, 11 C. C. A. 288; *George W. Jackson,*

*Inc. v. Friestedt Interlocking Channel Bar Co.*, 159 Fed. Rep. 496.

292. *Ex parte South & North Alabama R. Co.*, 95 U. S. (5 Otto), 221, 24 L. Ed. 355.

293. *New York Belting & Packing Co. v. Magowan*, 27 Fed. Rep. 111.

in some cases<sup>294</sup> and denied in others.<sup>295</sup> It is not apparent, however, why the successful complainant should be remitted to his action at law for damages, which is the effect of the refusal of the injunction against use and sale of the articles made prior to the expiration of the patent. Judge Wheeler's argument is as follows: "The grant to the patentee was of the exclusive right to make, use, and sell to others to be used, the invention during the term. The right to exclude others from making, using and selling was the essential thing, and really all that was granted. \* \* \* Any making for use during the term was taking from him what belonged to him. To permit any others to make such machines during the term, and hold them till the expiration, and then use them freely as if made after, would be to permit them to make off with so much of his (the patentee's) property that the law had granted to him."<sup>296</sup> But this reasoning was not intended to extend, and cannot be extended, to preparations to infringe, made in anticipation of the expiration of the patent. The separate elements may be made or collected for the purpose and with the intent of assembling them, or otherwise producing the article of the patent, and if that work of preparation falls short of the actual production of the completed thing of the patent, equity is powerless to intervene; for the reason, as Judge Wheeler has said, "that what is being done and so intended will never be an infringement. Till completed, these things would not infringe, and when completed the patent will not be in force to be infringed."<sup>297</sup>

294. *Reay v. Raynor*, 19 Fed. Rep. 308.

295. *Westinghouse v. Carpenter*, 43 Fed. Rep. 894.

296. *American Diamond Rock Boring Co. v. Rutland Marble Co.*, 2 Fed. Rep. 356.

297. *White v. Walbridge*, 46 Fed. Rep. 526.

*d. By the death of either party.* We have heretofore considered the effect of the death of a party upon the pending suit.<sup>298</sup>

*e. By the dissolution of an incorporated party to the suit.* The consolidation and merger of several corporations under an enabling act of the New York legislature (Laws N. Y. 1884, c. 367, § 6) have been held not to work the abatement of a patent suit pending in the name of one of the corporations at the time of the consolidation.<sup>299</sup> At common law a right of action for tort did not survive the dissolution of the corporation defendant; “for there is no pretense to say that a *scire facias* can be maintained and a judgment had thereon against a dead corporation any more than against a dead man.”<sup>300</sup> But under statutes providing that the dissolution of the corporation shall not impair any remedy against it for liabilities previously incurred, its dissolution will not work the abatement of a pending action for tort.<sup>301</sup>

*f. By the pendency of another suit.* The pendency of a suit in another jurisdiction between the same parties upon the same patent cannot work an abatement of a suit in equity for infringement. In an opinion in such a case, Judge Thomas G. Jones has said: “True, this may finally lead to conflicting judgments in the two courts as to the validity of this patent. Such results cannot be avoided under our present system, where no particular court has exclusive jurisdiction, and the validity of a patent may be tested in different courts of co-ordinate jurisdiction at the same time, and even by the same parties, when nothing has been decided in the litigation be-

298. *Ante*, pp. 522, 680.

299. *Edison Elec. Light Co. v. U. S. Elec. Lighting Co.*, 52 Fed. Rep. 300, 313, 3 C. C. A. 83.

300. Mr. Justice Story, in *Mumma v. Potomac Co.*, 8 Peters 281, 286, 8 L. Ed. 945, 948.

301. *Marstaller v. Mills*, 143 N. Y. 398.

tween them estopping either of them from setting up new evidence on points which may finally overthrow the patent. Comity cannot prevent such results; but neither of the courts so circumstanced ought to go any further than the necessities of the particular case in its own jurisdiction absolutely require. Neither should attempt to decide upon an infringement committed in the jurisdiction of the other, nor should either court require an accounting between the parties as to an infringement committed in the jurisdiction of the other.<sup>302</sup>

§ 535. Estoppel by implied license—the extension of the license to include other patents of the licensor, by implication.

Some of the adjudicated cases have dealt with this state of facts. In a suit for infringement of one patent, the defendant pleads a license from the plaintiff under another patent, so correlated to the one in suit that its use is necessary to the enjoyment of the license.

Judge (now Mr. Justice) Lurton has announced the resulting doctrine of license by implication as follows:

“That there may be circumstances under which the sale by a patentee of one patented article will carry with it the right to use another in cooperation with the first, although the thing be covered by a second patent. Thus, if the article sold be of such peculiar construction as that it is of no practical use unless it be used in combination with some subordinate part covered by another patent of the vendor, the right to use the latter in cooperation with the former might be implied from circumstances. It is a general principle of law that a grant necessarily carries with it that without which the thing granted cannot be enjoyed. The limitation upon this is that the

302. Warren Bros. Co. v. City of Montgomery, 172 Fed. Rep. 414, 423.

things which pass by implication only must be incident to the grant, and directly necessary to the enjoyment of the thing granted. The foundation of the maxim lies in the presumption that the grantor intended to make his grant enjoyable. This presumption has been employed in the construction of licenses granted by patentees, as well as in other branches of the law. Thus, in *Cutter Co. v. Sheldon*, 10 Blatchf. 1, Fed. Case 13,331, Woodruff, Circuit Judge, said:

‘If a party engaged exclusively in the construction of machines of various kinds for sale to others, were to receive a license to manufacture a patented machine, for a consideration presently paid to the patentee, a construction which would deny him all opportunity to make the privilege of any value, forbidding his sale of the machines when manufactured, should be very clearly imported by the license, or the court would hold that the parties meant that he should derive some benefit from the license, and not be left thereafter wholly dependent on the will of the patentee.’

“It is evident that the extent of an implied license must depend upon the peculiar facts of each case. The question in each case is whether or not the circumstances are such as to estop the vendor from asserting infringement. The cases of *Roosevelt v. Electric Co.*, 20 Fed. Rep. 724; *United Nickel Co. v. California Electrical Co.*, 25 Fed. Rep. 475, 479; *American Graphophone Co. v. Amet*, 74 Fed. Rep. 789,—are instances in which the court held that no license was implied under the facts. *Stonecutter Co. v. Shortsleeves*, 16 Blatchf. 381, Fed. Case 13,334, and *Illingsworth v. Spaulding*, 43 Fed. Rep. 831, are illustrations of the application of the presumption arising upon the particular facts of those cases. The

general principle is well stated by Judge Wallace in *Roosevelt v. Electric Co.*, cited above.”<sup>303</sup>

This doctrine has since been applied to a similar state of facts by the Court of Appeals of the Seventh Circuit.<sup>304</sup>

§ 536. Drafting the decree to exclude defendant's improvements.

It is obvious that so long as every new and useful improvement whose production involves invention is patentable, regardless of its infringement of a pre-existing patent, a defendant who has produced an attachment for, or improvement upon, the plaintiff's patented machine should not be enjoined from the manufacture, use or sale of his improvement or attachment. And this is so, whether or not his attachment or improvement is patented, or patentable if not patented. In a case where the defendant had infringed the plaintiff's patent for “a travelling contact for electric railways,” but was making and selling an attachment which was an addition to the patented device, Judge Tayler said:

“I see no reason why the injunction which ought to be allowed in this case, should not be so qualified as to permit the defendants to sell the portion of their trolley-base which, attached to the complainant's trolley-base, may make freer the lateral movement of the trolley-arm; and this, notwithstanding the fact that the addition of such a member to the complainant's device may exhibit a superiority, for the purpose designed, over that portion of the complainant's device which is designed to permit the trolley-pole to freely move in a lateral direction.

303. *Edison Elec. Light Co. v. Peninsular Light, Power & H. Co.*, 101 Fed. Rep. 831, 836, 43 C. C. A. 479; affirming *Edison Elec. Light Co. v. Peninsular Light, Power & H. Co.*, 95 Fed. Rep. 669.

304. *Thomson-Houston Elec. Co. v. Illinois Telephone Construction Co.*, 152 Fed. Rep. 631, 81 C. C. A. 473. Affirming *Thomson-Houston Elec. Co. v. Illinois Telephone Construction Co.*, 143 Fed. Rep. 534.



“Its use requires the use of complainant’s device; and the complainant is not therefore prejudiced, if the purchaser of its device obtains another device which he may think adds to the efficiency of the original purchase. One might as well say that the user of complainant’s trolley-base could not lubricate the vertical pivot in order to increase the freedom of movement upon it.”<sup>305</sup>

§ 537. Intervention in suits in equity.

It is a rare practice in equity cases to permit the intervention by persons, other than the original parties to the suit, whose rights may be affected by the ultimate disposition of the cause. Judge Pardee has said, “if their rights are to be affected they are necessary parties.”<sup>306</sup> But as against the objection of the original parties defendant, leave to intervene will ordinarily be denied. Judge Lurton has said “that a stranger to a suit will not be permitted, on his own application, and over the objection of the defendant, to become a defendant, is a well-established general rule, to which there are but few exceptions. \* \* \* In the exceptional cases a defendant can only be added to those named as such in the bill by consent of the complainant, or upon order of the court requiring the bill to be so amended on penalty of dismissal for want of proper parties.”<sup>307</sup> In the same case he held that the application for leave to intervene should be accompanied by a full copy of the proposed pleadings of the party seeking to intervene; but he permitted the petition for leave to intervene to stand as an answer.<sup>308</sup>

305. Thomson-Houston Elec. v. Holland, 143 Fed. Rep. 903, 907.

306. Carter v. City of New Orleans, 19 Fed. Rep. 659.

307. Toler v. East. Tenn., V. & G. R. Co., 67 Fed. Rep. 168, 170.

308. Ibid.

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Where the application for leave to intervene was filed in the Circuit Court of Appeals, the petitioner having declined an opportunity to intervene in the lower court, and the petition being based upon alleged collusion between the original parties, the court denied the petition after an examination of the record failed to find support for the charge of collusion, but gave the petitioner leave to file a brief upon the merits.<sup>309</sup>

309. Thomson-Houston Elec. Co.  
v. Western Elec. Co., 158 Fed. Rep.  
813, 86 C. C. A. 73.

# APPENDIX

# THE PATENT STATUTES

## ACT OF 1790, CHAPTER 7.

1 STATUTES AT LARGE, 109.

An Act to promote the progress of useful Arts.

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

affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and indorsed on the patent of the said Secretary at the time of granting the same.

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

SECTION 3. *And be it further enacted,* That upon the application of any person to the Secretary of State, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the Secretary to give such a copy, and to permit the

person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant.

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

SECTION 5. *And be it further enacted,* That upon oath or affirmation made before the judge of the district court where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously by, or upon false suggestion, and motion made to the said court, within one year after issuing the said patent, but not afterwards, it shall and may be lawful to and for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators, or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the

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

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

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

APPROVED April 10, 1790.

Repealed February 21, 1793. 1 Statutes at Large, Chap. 11, Section 12, p. 323.

### ACT OF 1793, CHAPTER 11.

1 STATUTES AT LARGE, 318.

An Act to promote the progress of useful Arts; and to repeal the act heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters-patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the alle-



gations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters-patent shall be delivered to the Attorney-General of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of State, who shall present the letters-patent, thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed; and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

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

SECTION 3. *And be it further enacted,* That every inventor, before he can receive a patent, shall swear or affirm, that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement

for which he solicits a patent, which oath or affirmation may be made before any person authorized to administer oaths, and shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings, or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description, signed by himself, and attested by two witnesses, shall be filed in the office of the Secretary of State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing, touching such patent right shall come in question. And such inventor shall, moreover, deliver a model of his machine, provided the Secretary shall deem such model to be necessary.

SECTION 4. *And be it further enacted,* That it shall be lawful for any inventor, his executor or administrator, to assign the title and interest in the said invention, at any time, and the assignee, having recorded the said assignment in the office of the Secretary of State, shall thereafter stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assigns, to any degree.

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

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

SECTION 7. *And be it further enacted,* That where any State, before its adoption of the present form of government, shall have granted an exclusive right to any in-

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vention, the party claiming that right shall not be capable of obtaining an exclusive right under this act, but on relinquishing his right under such particular State, and of such relinquishment, his obtaining an exclusive right under this act shall be sufficient evidence.

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

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

SECTION 10. *And be it further enacted,* That upon oath or affirmation being made before the judge of the district court where the patentee, his executors, administrators, or assigns, reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or

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

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

party obtaining the same, shall pay two dollars, of which payments an account shall be rendered, annually, to the treasury of the United States, and they shall also pass to the account of clerk-hire in the office of the Secretary of State.

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

APPROVED February 21, 1793.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

### Act OF 1794, CHAPTER 58.

1 STATUTES AT LARGE, 393.

An Act supplementary to the act "intituled" "An Act to promote the progress of Useful Arts."

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That all suits, actions, process and proceedings, heretofore had in any District Court of the United States, under an act passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An act

to promote the progress of useful arts," which may have been set aside, suspended or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said court, to the same situation, in which they may have been when they were so set aside, suspended, or abated; and that the parties to the said suits, actions, process or proceedings be, and are hereby, entitled to proceed in such cases, as if no such repeal of the act aforesaid had taken place: *Provided always*, That before any order or proceeding other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceedings as is used in other cases for compelling the appearance of a party.

APPROVED June 7, 1794.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

#### ACT OF 1800, CHAPTER 25.

2 STATUTES AT LARGE, 37.

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

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That all and singular the rights and privileges given, intended or provided to citizens of the

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

SECTION 2. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might, by virtue of this or the above-mentioned act, be granted to such person, and shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent, shall devolve on the legal representatives of such person in trust for the heirs at law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limi-



tations, and restrictions as the same was held, or might have been claimed or enjoyed by such person, in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation, provided in the third section of the before-mentioned act, shall be so varied as to be applicable to them.

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

SECTION 4. *And be it further enacted,* That the fifth section of the above-mentioned act, intituled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be and hereby is, repealed.

APPROVED April 17, 1800.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

## ACT OF 1819, CHAPTER 19.

3 STATUTES AT LARGE. 481.

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

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

APPROVED February 15, 1819.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

## ACT OF JULY 3, 1832, CHAPTER 162.

## 4 STATUTES AT LARGE, 559.

An Act concerning patents for useful inventions.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That it shall be the duty of the Secretary of State, annually, in the month of January, to report to Congress, and to publish in two of the newspapers printed in the city of Washington, a list of all the patents for discoveries, inventions, and improvements, which shall have expired within the year immediately preceding, with the names of the patentees, alphabetically arranged.

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

SECTION 3. *And be it further enacted,* That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of the act of Congress, entitled "An act to promote the progress

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

APPROVED July 3, 1832.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

## ACT OF JULY 13, 1832, CHAPTER 203.

4 STATUTES AT LARGE, 577.

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

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

APPROVED July 13, 1832.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

## ACT OF 1836, CHAPTER 357.

5 STATUTES AT LARGE, 117.

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

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be established and attached to the Department of State an office to be denominated the Patent Office; the chief officer of which shall be called the Commissioner of Patents, to be appointed by the President, by and with the advice and consent of the Senate, whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said office. And said Commissioner shall receive the same compensation as is allowed by law to the Commissioner of the Indian Department, and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage.

SECTION 2. *And be it further enacted,* That there shall be in said office an inferior officer, to be appointed by the said principal officer, with the approval of the Secretary of State, to receive an annual salary of seventeen hundred dollars, and to be called the Chief Clerk of the Patent Office; who in all cases during the necessary absence of the Commissioner, or when then said principal

office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers, machines, models, and all other things belonging to the said office, and shall perform the duties of Commissioner during such vacancy. And the said Commissioner may also, with like approval, appoint an examining clerk, at an annual salary of fifteen hundred dollars; two other clerks at twelve hundred dollars each, one of whom shall be a competent draughtsman; one other clerk at one thousand dollars; a machinist at twelve hundred and fifty dollars; and a messenger at seven hundred dollars. And said Commissioner, clerks, and every other person appointed and employed in said office, shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be granted.

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

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SECTION 4. *And be it further enacted,* That the said Commissioner shall cause a seal to be made and provided for the said office, with such device as the President of the United States shall approve; and copies of any records, books, papers, or drawings belonging to the said office, under the signature of the said Commissioner, or, when the office shall be vacant under the signature of the chief clerk, with the said seal affixed, shall be competent evidence in all cases in which the original records, books, papers, or drawings could be evidence. And any person making application therefor may have certified copies of the records, drawings, and other papers deposited in said office, on paying for the written copies the sum of ten cents for every page of one hundred words; and for copies of drawings the reasonable expense of making the same.

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



SECTION 6. *And be it further enacted,* That any person or persons, having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application, in writing, to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions; and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. He shall, furthermore, accompany the whole with a drawing or drawings, and written references, where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter; which descriptions and drawings, signed by the

inventor and attested by two witnesses, shall be filed in the Patent Office; and he shall moreover furnish a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. The applicant shall also make oath or affirmation that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths.

SECTION 7. *And be it further enacted,* That on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor, or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insuffi-

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cient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification, to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claims for a patent, with or without any alteration in his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the Commissioner, of the time

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and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application: *Provided however*, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

SECTION 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which

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

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

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

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

SECTION 12. *And be it further enacted,* That any citizen of the United States, or alien, who shall have been a resident of the United States one year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire fur-

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

SECTION 13. *And be it further enacted*, That whenever any patent which has heretofore been granted, or

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



all intents and purposes, as though it had been embraced in the original description and specification.

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

SECTION 15. *And be it further enacted,* That the defendant in any such action shall be permitted to plead the general issue, and to give this act and any special matter in evidence, of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, tending to prove that the description and specification filed by the plaintiff does not contain the whole truth relative to his invention or discovery, or that it contains more than is necessary to produce the described effect; which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new, or that it had been described in some public work anterior to the supposed discovery thereof by the

patentee, or had been in public use or on sale with the consent and allowance of the patentee before his application for a patent, or that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same; or that the patentee, if an alien at the time the patent was granted, had failed and neglected, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued; in either of which cases judgment shall be rendered for the defendant with costs. And whenever the defendant relies in his defense on the fact of a previous invention, knowledge, or use of the thing patented, he shall state, in his notice of special matter, the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same had been used: *Provided however*, That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery or any part thereof having been before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication. *And provided also*, That whenever the plaintiff shall fail to sustain his action on the ground that in his specification of claim is embraced more than that of which he was the first inventor, if it shall appear that the defendant had used or violated any part of the invention justly and truly specified and claimed as new, it shall be in the power of the court to adjudge and award as to costs, as may appear to be just and equitable.

SECTION 16. *And be it further enacted,* That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however,* That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

SECTION 17. *And be it further enacted,* That all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, by the circuit courts of the United States, or any

district court having the power and jurisdiction of a circuit court; which courts shall have power, upon a bill in equity filed by any party aggrieved, in any such case, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor as secured to him by any law of the United States, on such terms and conditions as said courts may deem reasonable: *Provided however,* That from all judgments and decrees from any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of circuit courts, and in all other cases in which the court shall deem it reasonable to allow the same.

SECTION 18. *And be it further enacted,* That whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and the Commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury, as in the case of an original application for a patent, cause to be published in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence

produced before them both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein: *Provided however,* That no extension of a patent shall be granted after the expiration of the term for which it was originally issued.

SECTION 19. *And be it further enacted,* That there shall be provided for the use of said office, a library of scientific works and periodical publications, both foreign and American, calculated to facilitate the discharge of

the duties hereby required of the chief officers therein, to be purchased under the direction of the Committee of the Library of Congress. And the sum of fifteen hundred dollars is hereby appropriated for that purpose, to be paid out of the patent fund.

SECTION 20. *And be it further enacted,* That it shall be the duty of the Commissioner to cause to be classified and arranged, in such rooms or galleries as may be provided for that purpose, in suitable cases, when necessary for their preservation, and in such manner as shall be conducive to a beneficial and favorable display thereof, the models and specimens of compositions and of fabrics and other manufactures and works of art, patented or unpatented, which have been, or shall hereafter be, deposited in said office. And said rooms or galleries shall be kept open during suitable hours for public inspection.

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

APPROVED July 4, 1836.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

## ACT OF 1837, CHAPTER 45.

5 STATUTES AT LARGE, 191.

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

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

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

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



SECTION 3. *And be it further enacted,* That whenever it shall appear to the Commissioner that any patent was destroyed by the burning of the Patent Office building on the aforesaid fifteenth day of December, or was otherwise lost prior thereto, it shall be his duty, on application therefor by the patentee or other person interested therein, to issue a new patent for the same invention or discovery, bearing the date of the original patent, with his certificate thereon that it was made and issued pursuant to the provisions of the third section of this act, and shall enter the same of record: *Provided however,* That before such patent shall be issued the applicant therefor shall deposit in the Patent Office a duplicate, as near as may be, of the original model, drawings, and description, with specification of the invention or discovery, verified by oath, as shall be required by the Commissioner; and such patent, and copies of such drawings and descriptions, duly certified, shall be admissible as evidence in any judicial court of the United States, and shall protect the rights of the patentee, his administrators, heirs, and assigns, to the extent only in which they would have been protected by the original patent and specification.

SECTION 4. *And be it further enacted,* That it shall be the duty of the Commissioner to procure a duplicate of such of the models, destroyed by fire on the aforesaid fifteenth day of December, as were most valuable and interesting, and whose preservation would be important to the public; and such as would be necessary to facilitate the just discharge of the duties imposed by law on the Commissioner in issuing patents, and to protect the rights of the public and of patentees in patented inventions and improvements: *Provided,* That a duplicate of such models may be obtained at a reasonable expense: *And provided also,* That the whole amount of expenditure

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for this purpose shall not exceed the sum of one hundred thousand dollars. And there shall be a temporary board of Commissioners, to be composed of the Commissioner of the Patent Office and two other persons to be appointed by the President, whose duty it shall be to consider and determine upon the best and most judicious mode of obtaining models of suitable construction; and also to consider and determine what models may be procured in pursuance of, and in accordance with, the provisions and limitations in this section contained. And said commissioners may make and establish all such regulations, terms, and conditions, not inconsistent with law, as in their opinion may be proper and necessary to carry the provisions of this section into effect, according to its true intent.

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

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

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

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

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

SECTION 7. *And be it further enacted,* That, whenever any patentee shall have, through inadvertence, accident, or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material or substantial part of the thing patented being truly and justly his own, any such patentee, his administrators, executors, and assigns, whether of the whole or of a sectional interest therein, may make disclaimer of such parts of the thing patented

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

SECTION 8. *And be it further enacted,* That, whenever application shall be made to the Commissioner for any addition of a newly discovered improvement to be made to an existing patent, or whenever a patent shall be returned for correction and reissue, the specification of claim annexed to every such patent shall be subject to revision and restriction, in the same manner as are original applications for patents; the Commissioner shall not add any such improvement to the patent in the one case, nor grant the reissue in the other case, until the applicant shall have entered a disclaimer, or altered his specification of claim in accordance with the decision of the Commissioner; and in all such cases, the applicant, if dissatisfied with such decision, shall have the same remedy, and be entitled to the benefit of the same privileges and proceedings as are provided by law in the case of original applications for patents.

SECTION 9. *And be it further enacted,* any thing in the fifteenth section of the act to which this is additional to

the contrary notwithstanding, That, whenever by mistake, accident, or inadvertence, and without any willful default or intent to defraud or mislead the public, any patentee shall have in his specification claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be deemed good and valid for so much of the invention or discovery as shall be truly and *bona fide* his own; *Provided*, It shall be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid. And every such patentee, his executors, administrators, and assigns, whether of the whole, or of a sectional interest therein, shall be entitled to maintain a suit at law or in equity on such patent for any infringement of such part of the invention or discovery as shall be *bona fide* his own as aforesaid, notwithstanding the specification may embrace more than he shall have any legal right to claim. But, in every such case in which a judgment or verdict shall be rendered for the plaintiff, he shall not be entitled to recover costs against the defendant, unless he shall have entered at the Patent Office, prior to the commencement of the suit, a disclaimer of all that part of the thing patented which was so claimed without right. *Provided however*, That no person bringing any such suit shall be entitled to the benefits of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer as aforesaid.

SECTION 10. *And be it further enacted*, That the Commissioner is hereby authorized and empowered to appoint agents, in not exceeding twenty of the principal cities or towns in the United States as may best accom-

modate the different sections of the country, for the purpose of receiving and forwarding to the Patent Office all such models, specimens of ingredients and manufactures, as shall be intended to be patented or deposited therein, the transportation of the same to be chargeable to the patent fund.

SECTION 11. *And be it further enacted,* That, instead of one examining clerk, as provided by the second section of the act to which this is additional, there shall be appointed, in manner therein provided, two examining clerks, each to receive an annual salary of fifteen hundred dollars; and also, an additional copying clerk, at an annual salary of eight hundred dollars. And the Commissioner is also authorized to employ, from time to time, as many temporary clerks as may be necessary to execute the copying and draughting required by the first section of this act, and to examine and compare the records with the originals, who shall receive not exceeding seven cents for every page of one hundred words, and for drawings and comparison of records with originals, such reasonable compensation as shall be agreed upon or prescribed by the Commissioner.

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

SECTION 13. *And be it further enacted,* That in all cases in which an oath is required by this act, or by the act to which this is additional, if the person of whom it

is required shall be conscientiously scrupulous of taking an oath, affirmation may be substituted therefor.

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

APPROVED March 3, 1837.

Repealed July 8, 1870. 16 Statutes at Large, Chap 230, Section 111, p. 216.

## ACT OF 1839, CHAPTER 88.

## 5 STATUTES AT LARGE, 353.

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

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

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

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

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



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

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

SECTION 7. *And be it further enacted,* That every person or corporation who has, or shall have, purchased or constructed and newly invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid, by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.

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

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

SECTION 11. *And be it further enacted,* That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition,

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

SECTION 12. *And be it further enacted*, That the Commissioner of Patents shall have power to make all such regulations, in respect to the taking of evidence to be used in contested cases before him, as may be just and reasonable. And so much of the act to which this is ad-

ditional, as provides for a board of examiners, is hereby repealed.

SECTION 13. *And be it further enacted*, That there be paid annually, out of the patent fund, to the said Chief Justice, in consideration of the duties herein imposed, the sum of one hundred dollars.

APPROVED March 3, 1839.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

### ACT OF 1842, CHAPTER 263.

5 STATUTES AT LARGE, 543.

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

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the Treasurer of the United States be, and he hereby is, authorized to pay back, out of the patent fund, any sum or sums of money, to any person who shall have paid the same into the Treasury, or to any receiver or depositary to the credit of the Treasurer, as for fees accruing at the Patent Office through mistake, and which are not provided to be paid by existing laws, certificate thereof being made to the said Treasurer by the Commissioner of Patents.

SECTION 2. *And be it further enacted*, That the third section of the act of March, eighteen hundred and thirty-seven, which authorizes the renewing of patents lost prior to the fifteenth of December, eighteen hundred and thir-

ty-six, is extended to patents granted prior to said fifteenth day of December, though they may have been lost subsequently: *Provided however*, The same shall not have been recorded anew under the provisions of said act.

SECTION 3. *And be it further enacted*, That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woolen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas-relief or composition in alto or basso relieve, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked, on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application in writing to the Commissioner of Patents expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent: *Provided*, That the fee in such cases, which by the now existing laws would be required of the particular

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applicant, shall be one half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section.

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

SECTION 5. *And be it further enacted,* That if any person or persons shall paint or print or mould, cast, carve, or engrave, or stamp, upon anything made, used, or sold, by him, for the sole making or selling which he hath not or shall not have obtained letters-patent, the name or any imitation of the name of any other person who hath or shall have obtained letters-patent for the sole making and vending of such thing, without consent of such patentee, or his assigns or legal representatives; or if any person, upon any such thing not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having the license or consent of such patentee, or his assigns, or legal representatives, shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise make or affix the words "patent," or the words "letters-patent," or the word "patentee," or any word or words of like kind, meaning, or import, with the view or intent of imitating or counterfeiting the stamp, mark or other device, of the patentee, or shall affix the same, or any word, stamp, or device,

of like import, on any unpatented article, for the purpose of deceiving the public, he, she, or they, so offending, shall be liable for such offence to a penalty of not less than one hundred dollars, with costs, to be recovered by action in any of the circuit courts of the United States, or in any of the district courts of the United States having the powers and jurisdiction of a circuit court; one half of which penalty, as recovered, shall be paid to the patent fund, and the other half to any person or persons who shall sue for the same.

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

APPROVED August 29, 1842.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

### ACT OF 1848, CHAPTER 47.

9 STATUTES AT LARGE, 231.

An Act to provide additional Examiners in the Patent Office, and for other Purposes.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be appointed, in the manner provided in the second section of the act entitled

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

SECTION 2. *And be it further enacted*, That hereafter the Commissioner of Patents shall require a fee of one dollar for recording any assignment, grant, or conveyance of the whole or any part of the interest in letters-patent, or power of attorney, or license to make or use the thing patented, when such instrument shall not ex



ceed three hundred words; the sum of two dollars when it shall exceed three hundred and shall not exceed one thousand words; and the sum of three dollars when it shall exceed one thousand words; which fees shall in all cases be paid in advance.

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

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

APPROVED May 27, 1848.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

#### ACT OF 1849, CHAPTER 108.

9 STATUTES AT LARGE, 395.

Section 2 of the Act entitled "An Act to establish the Home Department, and to provide for the Treasury Department an Assistant Secretary of the Treasury and a Commissioner of the Customs."

SECTION 2. *And be it further enacted,* That the Secretary of the Interior shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents, now exercised by the Secretary

of State; and the said Secretary of the Interior shall sign all requisitions for the advance or payment of money out of the Treasury on estimates or accounts, subject to the same adjustment or control now exercised on similar estimates or accounts by the First or Fifth Auditor and First Comptroller of the Treasury.

APPROVED March 3, 1849.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

### ACT OF 1852, CHAPTER 107.

10 STATUTES AT LARGE, 75.

An Act in addition to "An Act to Promote the Progress of the Useful Arts."

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

SECTION 2. *And be it further enacted,* That in case appeals shall be made to the said chief judge, or to either of the said assistant judges, the Commissioner of Patents shall pay to such chief judge or assistant judge the sum of twenty-five dollars, required to be paid by the ap-

pellant into the Patent Office by the eleventh section of said act, on said appeal.

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

APPROVED August 30, 1852.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

### ACT OF FEBRUARY 18, 1861, CHAPTER 37.

12 STATUTES AT LARGE, 130.

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

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

APPROVED February 18, 1861.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

## ACT OF MARCH 2, 1861, CHAPTER 88.

12 STATUTES AT LARGE, 246.

An Act in Addition to "An Act to promote the Progress of the useful Arts."

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any justice of the peace, or other officer authorized by law to take depositions to be used in the courts of the United States, or in the State courts of any State where such officer shall reside; and in any contested case pending in the Patent Office it shall be lawful for the clerk of any court of the United States for any district or Territory, and he is hereby required, upon the application of any party to such contested case, or the agent or attorney of such party, to issue subpoenas for any witnesses residing or being within the said district or Territory, commanding such witnesses to appear and testify before any justice of the peace, or other officer as aforesaid, residing within the said district or Territory, at any time and place in the subpoena to be stated; and if any witness, after being duly served with such subpoena, shall refuse or neglect to appear, or, after appearing, shall refuse to testify (not being privileged from giving testimony) such refusal or neglect being proved to the satisfaction of any judge of the court whose clerk shall have issued such subpoena, said judge may thereupon proceed to enforce obedience to the process, or to punish the disobedience in like manner as any court of the United States may do in case of disobedience to process of subpoena ad

testificandum issued by such court; and witnesses in such cases shall be allowed the same compensation as is allowed to witnesses attending the courts of the United States: *Provided*, That no witness shall be required to attend at any place more than forty miles from the place where the subpoena shall be served upon him to give a deposition under this law: *Provided also*, That no witness shall be deemed guilty of contempt for refusing to disclose any secret invention made or owned by him: *And provided further*, That no witness shall be deemed guilty of contempt for disobeying any subpoena directed to him by virtue of this act, unless his fees for going to, returning from, and one day's attendance at the place of examination, shall be paid or tendered to him at the time of the service of the subpoena.

SECTION 2. *And be it further enacted*, That for the purposes of securing greater uniformity of action in the grant and refusal of letters-patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three examiners in chief at an annual salary of three thousand dollars each, to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters-patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners-in-chief shall

be governed in their action by the rules to be prescribed by the Commissioner of Patents.

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

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

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

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

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

SECTION 8. *And be it further enacted,* That the Commissioner may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the parties filing such papers; and for gross misconduct he may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons of the Commissioner for such refusal shall be duly recorded, and be subject to the approval of the President of the United States.

SECTION 9. *And be it further enacted,* That no money paid as a fee, on any application for a patent after the passage of this act, shall be withdrawn or refunded, nor shall the fee paid on filing a caveat be considered as part of the sum required to be paid on filing a subsequent application for a patent for the same invention. That the three months' notice given to any caveator, in pursuance of the requirements of the twelfth section of the act of July fourth, eighteen hundred and thirty-six, shall be computed from the day on which such notice is depos-

ited in the post-office at Washington, with the regular time for the transmission of the same added thereto, which time shall be indorsed on the notice; and that so much of the thirteenth section of the act of Congress, approved July fourth, eighteen hundred and thirty-six, as authorizes the annexing to letters-patent of the description and specification of additional improvements is hereby repealed, and in all cases where additional improvements would now be admissible, independent patents must be applied for.

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

On filing each caveat, ten dollars.

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

On issuing each original patent, twenty dollars.

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

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

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

On filing each disclaimer, ten dollars.

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

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



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

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

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

SECTION 11. *And be it further enacted,* That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who, by his, her, or their own industry, genius, efforts, and expense may have invented or produced any new and original design, or a manufacture, whether of metal or other material or materials, and original design for a bust, statue, or bas-relief, or composition in alto or basso relievo, or any new and original impression or ornament or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell, and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application, in writing, to the Commissioner of Patents expressing such desire; and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent, for the term of three and one half years, or for the term of seven years, or for the term of fourteen years, as the said applicant

may elect in his application: *Provided*, That the fee to be paid in such application shall be for the term of three years and six months, ten dollars, for seven years, fifteen dollars, and for fourteen years, thirty dollars: *And provided*, That the patentees of designs under this act shall be entitled to the extension of their respective patents for the term of seven years, from the day on which said patent shall expire, upon the same terms and restrictions as are now provided for the extension of letters patent.

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

SECTION 13. *And be it further enacted*, That in all cases where an article is made or vendible by any person under the protection of letters-patent, it shall be the duty of such person to give sufficient notice to the public that said article is so patented, either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article patented, that may be impracticable, by enveloping one or more of the said articles, and affixing a label to the package, or otherwise attaching thereto a label on which the notice, with the date, is printed; on failure of which, in any suit for the infringement of letters-pat-

ent by the party failing so to mark the article the right to which is infringed upon, no damage shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued after such notice to make or vend the article patented. And the sixth section of the act entitled "An act in addition to an act to promote the progress of the useful arts," and so forth, approved the twenty-ninth day of August, eighteen hundred and forty-two, be, and the same is hereby, repealed.

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

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

SECTION 16. *And be it further enacted,* That all patents hereafter granted shall remain in force for the term

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of seventeen years from the date of issue; and all extension of such patents is hereby prohibited.

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

APPROVED March 2, 1861.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

### ACT OF 1862, CHAPTER 182.

12 STATUTES AT LARGE, 583.

Section 4 of an Act making supplemental appropriations for sundry civil expenses, &c.

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

APPROVED July 16, 1862.

## ACT OF 1863, CHAPTER 102.

12 STATUTES AT LARGE, 796.

An Act to amend an Act entitled "An Act to promote the Progress of the useful Arts."

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

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

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

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passage of this act, the said six months shall be reckoned from the date of such passage.

APPROVED March 3, 1863.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

### ACT OF 1864, CHAPTER 159.

13 STATUTES AT LARGE, 194.

An Act amendatory of an Act to amend an Act entitled "An Act to promote the Progress of the Useful Arts," approved March three, eighteen hundred and sixty-three.

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

APPROVED June 25, 1864.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

## ACT OF 1865, CHAPTER 112.

13 STATUTES AT LARGE, 533.

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

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That any persons having an interest in an invention, whether as inventor or assignee, for which a patent was ordered to issue upon the payment of the final fee, as provided in section three of an act approved March three, eighteen hundred and sixty-three, but who has failed to make payment of the final fee as provided in said act, shall have the right to make an application for a patent for his invention, the same as in the case of an original application, provided such application be made within two years after the date of the allowance of the original application: *Provided,* That nothing herein shall be so construed as to hold responsible in damages any persons who have manufactured or used any article or thing for which a patent aforesaid was ordered to issue. This act shall apply to all cases now in the Patent Office, and also to such as shall hereafter be filed. And all acts or parts of acts inconsistent with this act are hereby repealed.

APPROVED March 3, 1865.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

## ACT OF 1866.

14 STATUTES AT LARGE, 76.

An Act in Amendment of an Act to promote the Progress of the Useful Arts, and the Acts in Amendment of an Addition thereto.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That upon appealing for the first time from the decision of the primary examiner to the examiners-in-chief in the Patent Office, the appellant shall pay a fee of ten dollars into the Patent Office, to the credit of the patent fund: and no appeal from the primary examiner to the examiners-in-chief shall hereafter be allowed until the appellant shall pay said fee.

APPROVED June 27, 1866.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

## ACT OF 1870, CHAPTER 230.

16 STATUTES AT LARGE, 198.

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

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



things pertaining to patents shall be safely kept and preserved. [See Revised Statutes, Section 475.]

SECTION 2. *And be it further enacted*, That the officers and employees of said office shall continue to be: one commissioner of patents, one assistant commissioner, and three examiners-in-chief, to be appointed by the President, by and with the advice and consent of the Senate; one chief clerk, one examiner in charge of interferences, twenty-two principal examiners, twenty-two first assistant examiners, twenty-two second assistant examiners, one librarian, one machinist, five clerks of class four, six clerks of class three, fifty clerks of class two, forty-five clerks of class one, and one messenger and purchasing clerk, all of whom shall be appointed by the Secretary of the Interior, upon nomination of the Commissioner of Patents. [See Revised Statutes, Section 476.]

SECTION 3. *And be it further enacted*, That the Secretary of the Interior may also appoint, upon like nomination, such additional clerks of classes two and one, and of lower grades, copyists of drawings, female copyists, skilled laborers, laborers and watchmen, as may be from time to time appropriated for by Congress. [See Revised Statutes, Section 169.]

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

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

Of the assistant commissioner, three thousand dollars.

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

Of the chief clerk, two thousand five hundred dollars.

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

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

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

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

Of the librarian, one thousand eight hundred dollars.

Of the machinist, one thousand six hundred dollars.

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

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

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

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

Of the messenger and purchasing clerk, one thousand dollars.

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

Of the additional clerks, copyists of drawings, female copyists, and skilled laborers, such rates as may be fixed by the acts making appropriations for them. [See Revised Statutes, Sections 477, 440, and 167.]

SECTION 5. *And be it further enacted,* That all officers and employees of the Patent Office shall, before entering upon their duties, make oath or affirmation truly and faithfully to execute the trusts committed to them. [See Revised Statutes, Sections 1756 and 1757.]

SECTION 6. *And be it further enacted,* That the commissioner and chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of

five thousand dollars, conditioned for the faithful discharge of their duties, and that they will render to the proper officers of the treasury a true account of all money received by virtue of their office. [See Revised Statutes, Section 479.]

SECTION 7. *And be it further enacted*, That it shall be the duty of the commissioner, under the direction of the Secretary of the Interior, to superintend or perform all the duties respecting the granting and issuing of patents which herein are, or may hereafter be, by law directed to be done; and he shall have charge of all books, records, papers, models, machines, and other things belonging to said office. [See Revised Statutes, Section 481.]

SECTION 8. *And be it further enacted*, That the commissioner may send and receive by mail, free of postage, letters, printed matter, and packages relating to the business of his office, including Patent Office reports. [See 19 Statutes at Large, Chap. 103, Section 5, p. 335; and 20 Statutes at Large, Chap. 180, Section 29, p. 362.]

SECTION 9. *And be it further enacted*, That the commissioner shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents; an alphabetical list of the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public. [See Revised Statutes, Section 494.]

SECTION 10. *And be it further enacted,* That the examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and when required by the commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them. [See Revised Statutes, Section 482.]

SECTION 11. *And be it further enacted,* That in case of the death, resignation, absence, or sickness of the commissioner, his duties shall devolve upon the assistant commissioner until a successor shall be appointed, or such absence or sickness shall cease. [See Revised Statutes, Sections 177, 178, and 179.]

SECTION 12. *And be it further enacted,* That the commissioner shall cause a seal to be provided for said office, with such device as the President may approve, with which all records or papers issued from said office, to be used in evidence, shall be authenticated. [See Revised Statutes, Section 478.]

SECTION 13. *And be it further enacted,* That the commissioner shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in said office; and said rooms and galleries shall be kept open during suitable hours for public inspection. [See Revised Statutes, Section 484.]

SECTION 14. *And be it further enacted,* That the commissioner may restore to the respective applicants such

of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the treasury, as other patent moneys are directed to be paid. [See Revised Statutes, Section 485.]

SECTION 15. *And be it further enacted,* That there shall be purchased, for the use of said office, a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated by Congress for that purpose. [See Revised Statutes, Section 486.]

SECTION 16. *And be it further enacted,* That all officers and employees of the Patent Office shall be incapable, during the period for which they shall hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by said office. [See Revised Statutes, Section 480.]

SECTION 17. *And be it further enacted,* That for gross misconduct the commissioner may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior. [See Revised Statutes, Section 487.]

SECTION 18. *And be it further enacted,* That the commissioner may require all papers filed in the Patent Office, if not correctly, legibly and clearly written, to be printed at the cost of the party filing them. [See Revised Statutes, Section 488.]

SECTION 19. *And be it further enacted,* That the commissioner, subject to the approval of the Secretary of the Interior, may from time to time establish rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. [See Revised Statutes, Section 483.]

SECTION 20. *And be it further enacted,* That the commissioner may print or cause to be printed copies of the specifications of all letters patent and of the drawings of the same, and copies of the claims of current issues, and copies of such laws, decisions, rules, regulations, and circulars as may be necessary for the information of the public. [See Revised Statutes, Sections 489, 490, and 491.]

SECTION 21. *And be it further enacted,* That all patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the commissioner, and they shall be recorded, together with the specification, in said office, in books to be kept for that purpose. [See Revised Statutes, Section 4883.]

SECTION 22. *And be it further enacted,* That every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the said invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof; and a copy of said specifications and of the drawings shall be annexed to the patent and be a part thereof. [See Revised Statutes, Section 4884.]

SECTION 23. *And be it further enacted,* That every patent shall date as of a day not later than six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent; and if the final fee shall not be paid within that period, the patent shall be withheld. [See Revised Statutes, Section 4885.]

SECTION 24. *And be it further enacted,* That any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented, or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the duty required by law, and other due proceedings had, obtain a patent therefor. [See Revised Statutes, Section 4886.]

SECTION 25. *And be it further enacted,* That no person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country: *Provided,* The same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years. [See Revised Statutes, Section 4887.]

SECTION 26. *And be it further enacted,* That before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application there-

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for, in writing, to the commissioner, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery; and said specification and claim shall be signed by the inventor and attested by two witnesses. [See Revised Statutes, Section 4888.]

SECTION 27. *And be it further enacted,* That when the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of said drawings, to be furnished by the Patent Office, shall be attached to the patent as part of the specification. [See Revised Statutes, Section 4889.]

SECTION 28. *And be it further enacted,* That when the invention or discovery is of a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment. [See Revised Statutes, Section 4890.]

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



parts of his invention or discovery. [See Revised Statutes, Section 4891.]

SECTION 30. *And be it further enacted,* That the applicant shall make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. And said oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, *charge d' affaires*, consul, or commercial agent, holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be. [See Revised Statutes, Section 4892.]

SECTION 31. *And be it further enacted,* That on the filing of any such application and the payment of the duty required by law, the commissioner shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor. [See Revised Statutes, Section 4893.]

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

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the parties thereto, unless it be shown to the satisfaction of the commissioner that such delay was unavoidable. [See Revised Statutes, Section 4894.]

SECTION 33. *And be it further enacted,* That patents may be granted and issued or reissued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specifications sworn to by the inventor or discoverer; and also, if he be living, in case of an application for reissue. [See Revised Statutes, Section 4895.]

SECTION 34. *And be it further enacted,* That when any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application shall be made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them. [See Revised Statutes, Section 4896.]

SECTION 35. *And be it further enacted,* That any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who has failed to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application

for a patent for such invention or discovery the same as in the case of an original application: *Provided*, That the second application be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent, as aforesaid, was ordered to issue, prior to the issue thereof: *And provided further*, That when an application for a patent has been rejected or withdrawn, prior to the passage of this act, the applicant shall have six months from the date of such passage to renew his application, or to file a new one; and if he omit to do either, his application shall be held to have been abandoned. Upon the hearing of such renewed applications abandonment shall be considered as a question of fact. [See Revised Statutes, Section 4897.]

SECTION 36. *And be it further enacted*, That every patent or any interest therein shall be assignable in law, by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States; and said assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof. [See Revised Statutes, Section 4898.]

SECTION 37. *And be it further enacted*, That every person who may have purchased of the inventor, or with his knowledge and consent may have constructed any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or sold or used one so constructed, shall have the right to use, and vend to others to be used,

the specific thing so made or purchased, without liability therefor. [See Revised Statutes, Section 4899.]

SECTION 38. *And be it further enacted,* That it shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented, either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented. [See Revised Statutes, Section 4900.]

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

fense to a penalty of not less than one hundred dollars, with costs; one moiety of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed. [See Revised Statutes, Section 4901.]

SECTION 40. *And be it further enacted,* That any citizen of the United States, who shall have made any new invention or discovery, and shall desire further time to mature the same, may, on payment of the duty required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention; and such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application shall be made within the year by any other person for a patent with which such caveat would in any manner interfere, the commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person filing the caveat, who, if he would avail himself of his caveat, shall file his description, specification, drawings, and model within three months from the time of placing said notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto, which time shall be indorsed on the notice. And an alien shall have the privilege herein granted, if he shall have resided in the United States one year next preceding the filing of his caveat, and made oath of his intention to become a citizen. [See Revised Statutes, Section 4902.]

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SECTION 41. *And be it further enacted,* That whenever, on examination, any claim for a patent is rejected for any reason whatever, the commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant shall persist in his claim for a patent, with or without altering his specifications, the commissioner shall order a re-examination of the case. [See Revised Statutes, Section 4903.]

SECTION 42. *And be it further enacted,* That whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who shall be adjudged the prior inventor, unless the adverse party shall appeal from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe. [See Revised Statutes, Section 4904.]

SECTION 43. *And be it further enacted,* That the commissioner may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides. [See Revised Statutes, Section 4905.]

SECTION 44. *And be it further enacted,* That the clerk of any court of the United States, for any district or territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or his agent or attorney, issue [a] subpoena for any witness residing or being within said district or territory, commanding him to appear and testify before any officer in said district or territory authorized to take depositions and affidavits, at any time and place in the subpoena; and if any witness, after being duly served with such subpoena, shall neglect or refuse to appear, or after appearing shall refuse to testify, the judge of the court whose clerk issued the subpoena, may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience as in other like cases. [See Revised Statutes, Sections 4906 and 4908.]

SECTION 45. *And be it further enacted,* That every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States, but no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him, nor be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself. [See Revised Statutes, Sections 4906, 4907, and 4908.]

SECTION 46. *And be it further enacted,* That every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected, and every

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party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interference[s], in such case to the board of examiners-in-chief, having once paid the fee for such appeal provided by law. [See Revised Statutes, Section 4909.]

SECTION 47. *And be it further enacted,* That if such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the duty required by law, appeal to the commissioner in person. [See Revised Statutes, Section 4910.]

SECTION 48. *And be it further enacted,* That if such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc. [See Revised Statutes, Section 4911.]

SECTION 49. *And be it further enacted,* That when an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing. [See Revised Statutes, Section 4912.]

SECTION 50. *And be it further enacted,* That it shall be the duty of said court, on petition, to hear and determine such appeal, and to revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint, notifying the commissioner of the time and place of hearing; and the revision shall be confined to the points set forth in the reasons of appeal. And after hearing the case, the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Pat-



ent Office, and govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. [See Revised Statutes, Section 4914.]

SECTION 51. *And be it further enacted,* That on receiving notice of the time and place of hearing such appeal, the commissioner shall notify all parties who appear to be interested therein in such manner as the court may prescribe. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the commissioner shall furnish it with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the commissioner and the examiners may be examined under oath, in explanation of the principles of the machine or other thing for which a patent is demanded. [See Revised Statutes, Section 4913.]

SECTION 52. *And be it further enacted,* That whenever a patent on application is refused, for any reason whatever, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and

otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. [See Revised Statutes, Section 4915.]

SECTION 53. *And be it further enacted,* That whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such a patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or assignment of the whole or any undivided part of the original patent, to his executors, administrators, or assigns, for the unexpired part of the term of the original patent, the surrender of which shall take effect upon the issue of the amended patent; and the commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. And the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. And the patent so reissued, together with the corrected specification, shall have the effect and operation in law, on the trial of all actions for causes thereafter arising, as though the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall

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the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. [See Section 4916, R. S. U. S.]

SECTION 54. *And be it further enacted,* That whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the duty required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; said disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. [See Section 4917, R. S. U. S.]

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

United States, or any district court having the powers and jurisdiction of a circuit court, or by the Supreme Court of the District of Columbia, or of any territory; and the court shall have power, upon bill in equity filed by any party aggrieved, to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the *claimant* [complainant] shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction, and the court shall have the same powers to increase the same in its discretion that are given by this act to increase the damages found by verdicts in actions upon the case; but all actions shall be brought during the term for which the letters-patent shall be granted or extended, or within six years after the expiration thereof. [See Sections 629, and 4921, R. S. U. S.]

SECTION 56. *And be it further enacted*, That a writ of error or appeal to the Supreme Court of the United States shall lie from all judgments and decrees of any circuit court, or of any district court exercising the jurisdiction of a circuit court, or of the Supreme Court of the District of Columbia, or of any Territory, in any action, suit, controversy, or case, at law or in equity, touching patent rights, in the same manner and under the same circumstances as in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy. [See Section 699, R. S. U. S.]

SECTION 57. *And be it further enacted*, That written or printed copies of any records, books, papers, or draw-

ings belonging to the Patent Office, and of letters patent under the signature of the commissioner or acting commissioner, with the seal of office affixed, shall be competent evidence in all cases wherein the originals could be evidence, and any person making application therefor, and paying the fee required by law, shall have certified copies thereof. And copies of the specifications and drawings of foreign letters patent, certified in like manner, shall be prima facie evidence of the fact of the granting of such foreign letters patent, and of the date and contents thereof. [See Revised Statutes, Sections 892 and 893.]

SECTION 58. *And be it further enacted,* That whenever there shall be interfering patents, any person interested in any one of such interfering patents, or in the working of the invention claimed under either of such patents, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court having cognizance thereof, as hereinbefore provided, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the rights of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. [See Revised Statutes, Section 4918.]

SECTION 59. *And be it further enacted,* That damages for the infringement of any patent may be recovered by action on the case in any circuit court of the United States, or district court exercising the jurisdiction of a

circuit court, or in the Supreme Court of the District of Columbia, or of any Territory, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict shall be rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. [See Revised Statutes, Section 629, ¶ 9, and Section 4919.]

SECTION 60. *And be it further enacted*, That whenever, through inadvertence, accident, or mistake, and without any wil[l]ful default or intent to defraud or mislead the public, a patentee shall have (in his specification) claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer as aforesaid, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, provided it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the parts so claimed, without right as aforesaid, notwithstanding the specifications may embrace more than that of which the patentee was the original or first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit; nor shall he be entitled to the benefits of this section if he shall have unreasonably neglected or delayed to enter said disclaimer. [See Revised Statutes, Section 4922.]

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

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

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

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

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

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

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

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answer of the defendant, and with the like effect. [See Revised Statutes, Section 4920.]

SECTION 62. *And be it further enacted,* That whenever it shall appear that the patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. [See Revised Statutes, Section 4923.]

SECTION 63. *And be it further enacted,* That where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of his patent beyond the original term of its limitation, he shall make application therefor, in writing, to the commissioner, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of said invention or discovery. And said application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of said original term. [See Revised Statutes, Section 4924.]

SECTION 64. *And be it further enacted,* That upon the receipt of such application, and the payment of the duty required by law, the commissioner shall cause to be published in one newspaper in the city of Washington, and



in such other papers published in the section of the country most interested adversely to the extension of the patent as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. [See Revised Statutes, Section 4925.]

SECTION 65. *And be it further enacted,* That on the publication of such notice, the commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make to said commissioner a full report of the case, and particularly whether the invention or discovery was new and patentable when the original patent was granted. [See Revised Statutes, Section 4926.]

SECTION 66. *And be it further enacted,* That the commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence produced, both for and against the extension; and if it shall appear to his satisfaction that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery, a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the said commissioner shall make a certificate thereon, renewing and extending the said patent for the term of seven years from the expiration of the first term, which certificate shall be recorded in the Patent Office, and thereupon the said patent shall have the same effect in law as though it had been originally granted for twenty-one years. [See Revised Statutes, Section 4927.]

SECTION 67. *And be it further enacted*, That the benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented, to the extent of their interest therein. [See Revised Statutes, Section 4928.]

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

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

On issuing each original patent, twenty dollars.

On filing each caveat, ten dollars.

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

On filing each disclaimer, ten dollars.

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

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

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

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

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

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

For copies of drawings, the reasonable cost of making them. [See Revised Statutes, Section 4934.]

SECTION 69. *And be it further enacted*, That patent fees may be paid to the commissioner, or to the treasurer or any of the assistant treasurers of the United

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States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor. And all money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the treasury as received, without any deduction whatever; and all disbursements for said office shall be made by the disbursing clerk of the Interior Department. [See Revised Statutes, Section 496 and 4935.]

SECTION 70. *And be it further enacted,* That the Treasurer of the United States is authorized to pay back any sum or sums of money to any person who shall have paid the same into the treasury, or to any receiver or depositary, to the credit of the treasurer, as for fees accruing at the Patent Office through mistake, certificate thereof being made to said treasurer by the Commissioner of Patents. [See Revised Statutes, Section 4936.]

SECTION 71. *And be it further enacted,* That any person who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of wool[1]en, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the duty required by law, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor. [See Revised Statutes, Section 4929.]

SECTION 72. *And be it further enacted,* That the commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. [See Revised Statutes, Section 4930.]

SECTION 73. *And be it further enacted,* That patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. [See Revised Statutes, Section 4931.]

SECTION 74. *And be it further enacted,* That patentees of designs issued prior to March two, eight hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries issued prior to the second day of March, eighteen hundred and sixty-one. [See Revised Statutes, Section 4932.]

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

For three years and six months, ten dollars.

For seven years, fifteen dollars.

For fourteen years, thirty dollars.

For all other cases in which fees are required, the same rates as in cases of inventions or discoveries. [See Revised Statutes, Section 4934.]

SECTION 76. *And be it further enacted,* That all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries, not inconsistent with the provisions of this act, shall apply to patents for designs. [See Revised Statutes, Section 4933.]

[Sections 77 to 110, inclusive, apply to trade-marks and copyrights, and not to patents.]

SECTION 111. *And be it further enacted*, That the acts and parts of acts set forth in the schedule of acts cited, hereto annexed, are hereby repealed, without reviving any acts or parts of acts repealed by any of said acts, or by any clause or provisions therein: *Provided, however*, That the repeal hereby enacted shall not affect, impair, or take away any right existing under any of said laws; but all actions and causes of action, both in law or in equity, which have arisen under any of said laws, may be commenced and prosecuted, and if already commenced may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting that the remedial provisions of this act shall be applicable to all suits and proceedings hereafter commenced: *And provided also*, That all applications for patents pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage thereof: *And provided further*, That all offences which are defined and punishable under any of said acts, and all penalties and forfeitures created thereby and incurred before this act takes effect, may be prosecuted, sued for, and recovered, and such offences punished according to the provision of said acts, which are continued in force for such purpose.

APPROVED July 8, 1870.

Repealed June 22, 1874. Revised Statutes, Title LXXIV.

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**ACT OF MARCH 3, 1871.****16 STATUTES AT LARGE, 583.**

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

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That that part of section thirty-three of an act entitled "An act to revise, consolidate, and amend the statutes relating to patents and copyrights," approved July eighth, eighteen hundred and seventy, which requires that, in case of application by assignee or assignees for reissue of letters patent, the application shall be made and the specification sworn to by the inventor or discoverer, if living, shall not be construed to apply to patents issued and assigned prior to July eighth, eighteen hundred and seventy.

APPROVED March 3, 1871.

Repealed June 22, 1874. Revised Statutes, Title LXXIV.

**ACT OF MARCH 24, 1871.****17 STATUTES AT LARGE, 2.**

An Act to further regulate the publication of the Specifications and Drawings of the Patent Office.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That if, in the judgment of the joint committee on printing, the provisions of the joint resolution providing for publishing specifications and drawings of the

Patent Office, approved January eleventh, eighteen hundred and seventy-one, can be performed under the direction of the Commissioner of Patents more advantageously than in the manner provided in said joint resolution, it shall be so done, under such limitations and conditions as the joint committee on printing may from time to time prescribe.

SECTION 2. That the price of the printed copies of specifications and drawings of patents, when uncertified, shall be determined by the Commissioner of Patents, ten cents being hereby fixed as the minimum, and fifty cents as the maximum price of the same; certified copies to be sold at the price fixed by the patent act of eighteen hundred and seventy.

APPROVED March 24, 1871.

Repealed June 22, 1874. Revised Statutes, Title LXXIV.

## SECTIONS OF THE REVISED STATUTES OF THE UNITED STATES.

### RELATING TO PATENTS.

SECTION 440. There shall also be in the Department of the Interior:

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In the Patent Office:

One chief clerk, at a salary of two thousand five hundred dollars a year.

One examiner in charge of interferences, at a salary of two thousand five hundred dollars a year.

One examiner in charge of trade-marks, at a salary of two thousand five hundred dollars a year.

Twenty-four principal examiners, at a salary of two thousand five hundred dollars a year each.

Twenty-four first assistant examiners, at a salary of one thousand eight hundred dollars a year each.

Twenty-four second assistant examiners (two of whom may be women), at a salary of one thousand six hundred dollars a year each.

Twenty-four third assistant examiners, at a salary of one thousand four hundred dollars a year each.

One librarian, at a salary of two thousand dollars a year.

One machinist, at a salary of one thousand six hundred dollars a year.

Three skilled draughtsmen, at a salary of one thousand two hundred dollars a year each.

Thirty-five copyists of drawings, at a salary of one thousand dollars a year each.

One messenger and purchasing clerk, at a salary of one thousand dollars a year.

One skilled laborer, at a salary of one thousand two hundred dollars a year.

Eight attendants in the model-room, at a salary of one thousand dollars a year each.

Eight attendants in the model-room, at a salary of nine hundred dollars a year each. [See former Acts: Sections 2 and 3, 1870; Sections 4 and 7, 1861; Sections 1 and 3, 1848; Section 10, 1837; Section 2, 1836.]

SECTION 441. The Secretary of the Interior is charged with supervising all public business relating to \* \* \*

Fifth. Patents for inventions. [See former Acts; Section 1, Act of 1870; Section 2, Act of 1849.]

SECTION 475. There shall be in the Department of the Interior an office known as the Patent Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved. [See former Acts: Section 1, Act of 1870; Section 1, Act of 1836.]



SECTION 476. There shall be in the Patent Office a Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employees authorized by law for the Office shall be appointed by the Secretary of the Interior, upon the nomination of the Commissioner of Patents. [See former Acts: Section 2, Act of 1870; Section 2, Act of 1861; Section 1, Act of 1836.]

SECTION 477. The salaries of the officers mentioned in the preceding section shall be as follows:

The Commissioner of Patents, four thousand five hundred dollars a year.

The Assistant Commissioner of Patents, three thousand dollars a year.

Three examiners-in-chief, three thousand dollars a year each. [See former Acts: Section 4, 1870; Sections 2 and 4, Act of 1861; Section 11, Act of 1837; Section 1, Act of 1836.]

SECTION 478. The seal heretofore provided for the Patent Office shall be the seal of the Office, with which letters patent and papers issued from the Office shall be authenticated. [See former Acts: Section 12, Act of 1870; Section 4, Act of 1836.]

#### APPROPRIATION ACT OF MARCH 4, 1909.

Patent Office: For the Commissioner of Patents, five thousand dollars; first assistant commissioner, who shall perform such duties pertaining to the office of commissioner as may be assigned to him by the commissioner, four thousand five hundred dollars; assistant commissioner, who shall perform such duties pertaining to the

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office of commissioner as may be assigned to him by the commissioner, three thousand five hundred dollars; chief clerk, who shall be qualified to act as a principal examiner, three thousand dollars; two law examiners, at two thousand seven hundred and fifty dollars each; three examiners in chief, at three thousand five hundred dollars each; examiners of interferences, two thousand seven hundred dollars; examiner of trade-marks and designs, two thousand seven hundred dollars; examiner of classification, three thousand six hundred dollars; forty-two principal examiners, at two thousand seven hundred dollars each; fifty-eight first assistant examiners, at two thousand four hundred dollars each; sixty-eight second assistant examiners, at two thousand one hundred dollars each; seventy-eight third assistant examiners, at one thousand eight hundred dollars each; one hundred and ten fourth assistant examiners, at one thousand five hundred dollars each; financial clerk who shall give bonds in such amount as the Secretary of the Interior may determine, two thousand two hundred and fifty dollars; librarian, two thousand dollars; six chiefs of division, at two thousand dollars each; three assistant chiefs of division, at one thousand eight hundred dollars each; translator of languages, one thousand eight hundred dollars; nine clerks of class four; nine clerks of class three; seventeen clerks of class two; ninety-five clerks of class one; skilled laborer, one thousand two hundred dollars; three skilled draftsmen, at one thousand two hundred dollars each; four draftsmen, at one thousand dollars each; ninety clerks, at one thousand dollars each; messenger and property clerk, one thousand dollars; ninety copyists; eighty-five copyists, at seven hundred and twenty dollars each; four messengers; twenty-five assistant messengers; fourteen laborers, at six hundred dollars each; forty-two laborers, at four hundred and eighty dollars each; forty

messenger boys, at three hundred and sixty dollars each; in all, one million two hundred and thirty-nine thousand nine hundred and seventy dollars.

For purchase of professional and scientific books and expense of transporting publications of patents issued by the Patent Office to foreign governments, two thousand five hundred dollars.

For purchase of law books, five hundred dollars.

For producing copies of the weekly issue of patents, designs, and trade-marks; for the reproduction of copies of drawings and specifications of exhausted patents and other papers; one hundred and forty thousand dollars.

For investigating the question of the public use or sale of inventions for two years or more prior to filing applications for patents, and for expense attending defense of suits instituted against the Commissioner of Patents, two hundred and fifty dollars.

For the share of the United States in the expense of conducting the International Bureau at Berne, Switzerland, seven hundred and fifty dollars.

SECTION 479. The Commissioner of Patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices. [See former Act: Section 6, Act of 1870; Section 3, Act of 1836.]

SECTION 480. All officers and employees of the Patent Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or

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interest in any patent issued by the Office. [See former Act: Section 16, 1870.]

SECTION 481. The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office. [See former Act: Section 7, 1870; Section 1, 1836.]

SECTION 482. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for re-issues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them. [See former Act: Section 10, 1870; Section 2, 1861.]

SECTION 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. [See former Act: Section 19, 1870.]

SECTION 484. The Commissioner of Patents shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in the Patent Office; and the rooms and galleries shall be kept open during suitable hours for public inspection. [See former Act: Section 13, 1870; Section 20, 1836.]

SECTION 485. The Commissioner of Patents may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the Treasury, as other patent moneys are directed to be paid. [See former Acts: Section 14, 1870; Section 5, 1861.]

SECTION 486. There shall be purchased for the use of the Patent Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose. [See former Act: Section 15, 1870.]

SECTION 487. For gross misconduct the Commissioner of Patents may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior. [See former Act: Section 17, 1870.]

SECTION 488. The Commissioner of Patents may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them. [See former Acts: Section 18, 1870; Section 8, 1861.]

SECTION 489. The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public. [See former Act: Section 20, 1870.]

SECTION 490. The Commissioner of Patents is authorized to have printed, from time to time, for gratuitous

distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent hereafter issued, together with suitable indexes, one copy to be placed for free public inspection in each capitol of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or territorial capitols, and one in the Library of Congress, which copies shall be certified under the hand of the Commissioner and seal of the Patent Office, and shall not be taken from the depositories for any other purpose than to be used as evidence. [See Section 894, R. S. U. S.]

SECTION 491. The Commissioner of Patents is authorized to have printed such additional numbers of copies of specifications and drawings, certified as provided in the preceding section, at a price not to exceed the contract price for such drawings, for sale, as may be warranted by the actual demand for the same; and he is also authorized to furnish a complete set of such specifications and drawings to any public library which will pay for binding the same into volumes to correspond with those in the Patent Office, and for the transportation of the same, and which shall also provide for proper custody for the same, with convenient access for the public thereto, under such regulations as the Commissioner shall deem reasonable.

SECTION 492. The lithographing and engraving required by the two preceding sections shall be awarded to the lowest and best bidders for the interests of the Government, due regard being paid to the execution of the work, after due advertising by the Congressional Printer, under the direction of the Joint Committee on Printing; but the Joint Committee on Printing may em-

power the Congressional Printer to make immediate contracts for engraving, whenever, in their opinion, the exigencies of the public service will not justify waiting for advertisement and award; or if, in the judgment of the Joint Committee on Printing, the work can be performed under the direction of the Commissioner of Patents more advantageously than in the manner above prescribed, it shall be so done, under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe. [See Joint Resolution No. 5, January 11, 1871, 16 Statutes at Large, 590, and Section 1 of Patent Act of March 24, 1871.]

#### ACT OF MARCH 3, 1875.

SECTION 12. That it shall be the duty of the Commissioner of Patents to furnish, free of cost, one copy of the bound volumes of specifications and drawings of patents published by the Patent Office to each of the Executive Departments of the Government, upon the request of the head thereof.

#### ACT OF JANUARY 12, 1895.

28 STATUTES AT LARGE, 619.

The Commissioner of Patents, upon the requisition of the Secretary of the Interior, is authorized to continue the printing of the following:

First. The patents for inventions and designs issued by the Patent Office, including grants, specifications, and drawings, together with copies of the same, and of patents already issued, in such number as may be needed for the business of the Office.

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Second. The certificates of trade-marks and labels registered in the Patent Office, including descriptions and drawings, together with copies of the same, and of trade-marks and labels heretofore registered, in such numbers as may be needed for the business of the Office.

Third. The Official Gazette of the United States Patent Office in numbers sufficient to supply all who shall subscribe therefor at five dollars per annum; also to exchange for other scientific publications desirable for the use of the Patent Office; also to supply one copy to each Senator, Representative, and Delegate in Congress; also to supply one copy to eight such public libraries having over one thousand volumes, exclusive of Government publications, as shall be designated by each Senator, Representative, and Delegate in Congress, with one hundred additional copies, together with bimonthly and annual indexes for all the same; of the Official Gazette the "usual number" shall not be printed.

Fourth. The report of the Commissioner of Patents for the fiscal year, not exceeding five hundred in number, for distribution by him; the Annual Report of the Commissioner of Patents to Congress, without the list of patents, not exceeding one thousand five hundred in number for distribution by him; and of the Annual Report of the Commissioner of Patents to Congress, with the list of patents, five hundred copies for sale by him, if needed, and in addition thereto the "usual number" only shall be printed.

Fifth. Copies of the specifications and drawings of each patent issued, bound in monthly volumes, one copy for each of the Executive Departments of the Government, one copy to be placed for free public inspection in each capitol of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or Territorial capitols, and



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one in the library of Congress, which copies shall be certified under the hand of the Commissioner and seal of the Patent Office, and shall not be taken from the depositories for any other purpose than to be used as evidence; also one hundred additional copies of the same, for sale by him at a price to be fixed by the Secretary of the Interior. The "usual number" shall not be printed.

Sixth. Pamphlet copies of the rules of practice, pamphlet copies of the patent laws, and pamphlet copies of the laws and rules relating to trade-marks and labels, and circulars relating to the business of the Office, all in such numbers as may be needed for the business of the Office. The "usual number" shall not be printed.

Seventh. Annual volumes of the decisions of the Commissioner of Patents and of the United States courts in patent cases, not exceeding one thousand five hundred in number, of which the "usual number" shall be printed, and for this purpose a copy of each shall be transmitted to Congress promptly when prepared.

Eighth. Indexes to patents relating to electricity, and indexes to foreign patents, in such numbers as may be needed for the business of Office. The "usual number" shall not be printed.

All printing for the Patent Office making use of lithography or photolithography, together with the plates for the same, shall be contracted for and performed under the direction of the Commissioners of Patents, under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe, and all other printing for the Patent Office shall be done by the Public Printer under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe: *Provided*, That the entire work may be done at the Government Printing Office whenever in the judg-

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ment of the Joint Committee on Printing the same would be to the interest of the Government.

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SECTION 493. The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the Commissioner of Patents: *Provided*, That the maximum cost of a copy shall be ten cents.

SECTION 494. The Commissioner of Patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys, received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year; designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public. [See Sections 195, 196.]

SECTION 496. All disbursements for the Patent Office shall be made by the disbursing clerk of the Interior Department.

## ACT OF JULY 8, 1870.

16 STATUTES AT LARGE, 209.

SECTION 7. That in every case where the head of any Department of the Government shall request the Commissioner of Patents to expedite the consideration of an application for a patent it shall be the duty of such head of a Department to be represented before the Commissioner in order to prevent the improper issue of a patent.

SECTION 629. The circuit courts shall have original jurisdiction, as follows: \* \* \*

Ninth. Of all suits at law or in equity arising under the patent or copyright laws of the United States. [See former Acts: Section 55, 1870; Section 14, 1836; Section 1, 1819. Repealed by Section 289, The Judicial Code.]

## ACT OF MARCH 3, 1897.

SECTION 699. A writ of error may be allowed to review any final judgment at law, and an appeal shall be allowed from any final decree in equity hereinafter mentioned, without regard to the sum or value in dispute:

First. Any final judgment at law or final decree in equity of any circuit court, or of any district court acting as a circuit court, or of the Supreme Court of the District of Columbia, or of any Territory, in any case touching patent rights or copyrights. [See former Acts: Section 56, 1870; Section 1, February 18, 1861; Section 16, 1836; Section 1, 1819. Repealed by Section 289, The Judicial Code.]

SECTION 718. Whenever notice is given of a motion for an injunction out of a circuit or district court, the court or judge thereof may, if there appears to be danger or

irreparable injury from delay, grant an order restraining the act sought to be enjoined until the decision upon the motion; and such order may be granted with or without security, in the discretion of the court or judge. (Act of June 1, 1872, ch. 255, 17 Stat. at L. 197. Repealed and re-enacted as Section 263, The Judicial Code.)

SECTION 725. The said courts shall have power to impose and administer all necessary oaths, and to punish, by fine or imprisonment, at the discretion of the court, contempts of their authority: *Provided*, That such power to punish contempts shall not be construed to extend to any cases except the misbehavior of any person in their presence, or so near thereto as to obstruct the administration of justice, the misbehavior of any of the officers of said courts in their official transactions, and the disobedience or resistance by any such officer, or by any party, juror, witness, or other person, to any lawful writ, process, order, rule, decree, or command of the said courts. (Re-enacted as Section 268, The Judicial Code.)

SECTION 892. Written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent authenticated by the seal and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law, shall have certified copies thereof. [See former Acts: Section 57, 1870; Section 15, March 2, 1861; Section 2, 1837; Section 4, 1836; Sections 3, 6, 1790.]

SECTION 893. Copies of the specifications and drawings of foreign letters patent, certified as provided in the preceding section, shall be prima facie evidence of the fact of the granting of such letters patent, and of the

date and contents thereof. [See former Act: Section 57, 1870.]

SECTION 894. The printed copies of specifications and drawings of patents, which the Commissioner of Patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained.

SECTION 973. When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the Patent Office before the suit was brought. [See Section 4922, R. S. U. S.; and former Acts: Section 60, 1870; Section 9, 1837; Section 15, 1836.]

SECTION 1537. No patented article connected with marine engines shall hereafter be purchased or used in connection with any steam vessels of war until the same shall have been submitted to a competent board of naval engineers, and recommended by such board, in writing, for purchase and use.

SECTION 1673. No royalty shall be paid by the United States to any one of its officers or employees for the use of any patent for the system, or any part thereof, mentioned in the preceding section, nor for any such patent in which said officers or employees may be directly or indirectly interested.

SECTION 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose. [See former Acts: Section 21, Act of 1870; Section 5, Act of 1836; Section 1, Act of 1793; Section 1, Act of 1790.]

SECTION 4884. Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States, and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof. [See former Acts: Section 22, 1870; Section 16, 1861; Section 5, 1836; Section 1, 1793; Section 1, 1790.]

SECTION 4885. Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld.

SECTION 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention

or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor. [See former Acts: Section 24, 1870; Sections 6 and 7, 1836; Section 1, 1800; Section 1, 1793.]

### ACT OF MARCH 3, 1883.

#### CHAPTER 143, 22 STATUTES AT LARGE, 625.

The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes when such invention is used or to be used in the public service, without the payment of any fee: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be used by the Government or any of its officers or employees in prosecution of work for the Government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

SECTION 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and

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four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing. [As amended, Act March 3, 1903, c. 1019; compare former sections, Section 25, Act of 1870; Section 6, Act of 1839; Section 8, Act of 1836.]

**SECTION 4888.** Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable



any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim, the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses. [See former Acts: Section 26, 1870; Section 6, 1836; Section 1, 1793; Section 2, 1790.]

SECTION 4889. When the nature of the case admits of drawings, the applicant shall furnish one copy, signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office, and a copy of the drawing, to be furnished by the Patent Office, shall be attached to the patent as a part of the specification. [See former Acts: Section 27, 1870; Section 6, 1837; Section 6, 1836; Section 3, 1793.]

SECTION 4890. When the invention or discovery is of a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment. [See former Acts: Section 28, 1870; Section 6, 1836; Section 3, 1793.]

SECTION 4891. In all cases which admit of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery. [See former Acts: Section 29, 1870; Section 6, 1836; Section 3, 1793; Section 2, 1790.]

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SECTION 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or when the applicant resides in a foreign country, before any minister, *charge de'affaires*, consul, or commercial agent, holding commission under the Government of the United States, or before any notary public of the foreign country in which the applicant may be. [See former Acts: Section 30, 1870; Section 4, 1842; Section 6, 1836; Section 3, 1793.]

SECTION 4893. On the filing of any such application and the payment of fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor. [See former Acts: Section 31, 1870; Section 7, 1836; Section 1, 1790.]

SECTION 4894. All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable. [See former Acts: Section 32, 1870; Section 12, 1861.]

SECTION 4895. Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July, eighteen hundred and seventy. [See former Acts: Section 33, 1870; Section 6, 1837.]

SECTION 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted the right of applying for and obtaining the patent shall devolve on his legally appointed guardian, conservator, or representative in trust for his estate in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign

country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular official of the United States.

SECTION 4897. Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact. [See former Acts: Section 35, 1870; Section 1, 1865; Section 1, 1864.]

In the case of a renewal application under this section additional claims may be secured. *Bowers v. San Francisco Bridge Co.*, 69 Fed. Rep. 640. For many years it was the practice of the Patent Office to permit any number of renewal applications to be made, within the two years limit of this statute. This practice was changed to permit but one renewal, in 1894: *Ex parte Well*, 122 Off. Gaz. 352. In 1908 the ancient practice was restored and more than one renewal of a forfeited application is now permitted, provided it is made within the two years following the date of the original application. *In re Lambert*, 135 Off. Gaz. 1584; *Ex parte Lambert*, 135 Off. Gaz. 1581.

SECTION 4898. Every patent or any interest therein shall be assignable in law, by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof. [See former Acts: Section 36, 1870; Section 11, 1836; Section 4, 1793.]

SECTION 4899. Every person who purchases of the inventor or discoverer, or with his knowledge and consent constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. [See former Acts: Section 37, 1870; Section 7, 1839.]

SECTION 4900. It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article

so patented. [See former Acts: Section 38, 1870; Section 13, 1861; Section 6, 1842.]

SECTION 4901. Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs; one half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States, within whose jurisdiction such offense may have been committed. [See former Acts: Section 39, 1870; Section 5, 1824.]

SECTION 4902. [Repealed, June 25, 1910, 36 Statutes at Large, ch. 414.] Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the Patent Office a caveat setting forth the design thereof, and of his distinguishing characteristics, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and pre-

served in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen. [See former Acts: Section 40, 1870; Section 9, 1861; Section 12, 1836.]

SECTION 4903. Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case. [See former Acts: Section 41, 1870; Section 7, 1836.]

SECTION 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the

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applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe. [See former Acts: Section 42, 1870; Section 8, 1836; Section 9, 1793.]

SECTION 4905. The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides. [See former Acts: Section 43, 1870; Section 1, March 3, 1861; Section 12, 1839.]

SECTION 4906. The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him. [See former Acts: Section 44, 1870; Section 1, 1861.]

SECTION 4907. Every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed



to witnesses attending the courts of the United States. [See former Acts: Section 45, 1870; Section 1, 1861.]

SECTION 4908. Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself. [See former Acts: Sections 44 and 45, 1870; Section 1, 1861.]

SECTION 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal. [See former Acts: Section 46, 1870; Section 1, 1866.]

SECTION 4910. If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person. [See former Acts: Section 47, 1870; Section 2, 1861.]

SECTION 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the

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District of Columbia, sitting in banc. [See former Acts: Section 48, 1870; Section 1, 1852; Section 11, 1839.]

SECTION 4912. When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing. [See former Act: Section 49, 1870.]

SECTION 4913. The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded. [See former Acts: Section 51, 1870.]

SECTION 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But

no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. [See former Acts: Section 50, 1870.]

SECTION 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. [See former Acts: Section 52, 1870; Section 10, 1839.]

SECTION 4916. Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued

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to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. 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 arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. [See former Acts: Section 53, 1870; Sections 5 and 8, 1837; Section 13, 1836; Section 3, 1832.]

SECTION 4917. Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or

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any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. [See former Acts: Section 54, 1870; Section 7, 1837.]

SECTION 4918. Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. [See former Acts: Section 58, 1870; Section 16, 1836.]

SECTION 4919. Damages for the infringement of any patent may be recovered by action on the case, in the

name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. [See former Acts: Section 55, 1870; Section 14, 1836; Section 3, 1800; Section 5, 1793; Section 4, 1790.]

ACT OF JUNE 25, 1910.

36 STATUTES AT LARGE, ch. 423, p. 851.

[PUBLIC—No. 305.]

[H. R. 24649.]

An Act to provide additional protection for owners of patents of the United States, and for other purposes.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That whenever an invention described in and covered by a patent of the United States shall hereafter be used by the United States without license of the owner thereof or lawful right to use the same, such owner may recover reasonable compensation for such use by suit in the Court of Claims: *Provided, however,* That said Court of Claims shall not entertain a suit or reward compensation under the provisions of this Act where the claim for compensation is based on the use by the United States of any article heretofore owned, leased, used by, or in the possession of the United States: *Provided further,* That in any such suit the United States may avail itself of any and all defenses, general or special, which might be pleaded by a defendant in an action for in-

fringement, as set forth in Title Sixty of the Revised Statutes, or otherwise: *And provided further*, That the benefits of this Act shall not inure to any patentee, who, when he makes such claim is in the employment or service of the Government of the United States; or the assignee of any such patentee; nor shall this Act apply to any device discovered or invented by such employee during the time of his employment or service.

SECTION 4920. In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:

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

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

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

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

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

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and resi-

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dences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. [See former Acts: Section 61, 1870; Section 15, 1836; Section 6, 1793; Section 6, 1790.]

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

But in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action.

SECTION 4922. Whenever, through inadvertence, accident, or mistake, and without any willful default or in-



tent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. [See Sections 973, 4917.]

SECTION 4923. Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. [See former Acts: Section 62, Act of 1870; Section 15, Act of 1836.]

SECTION 4924. Where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one,

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shall desire an extension of this patent beyond the original term of its limitation, he shall make application therefor, in writing, to the Commissioner of Patents, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of the invention or discovery. Such application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of the original term. [See former Acts: Section 63, 1870; Section 1, 1848; Section 18, 1836; Section 2, July 3, 1832.]

SECTION 4925. Upon the receipt of such application, and the payment of the fees required by law, the Commissioner shall cause to be published in one newspaper in the city of Washington, and in such other papers published in the section of the country most interested adversely to the extension of the patent as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. [See former Acts: Section 64, 1870; Section 18, 1836.]

SECTION 4926. Upon the publication of the notice of an application for an extension, the Commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make the Commissioner a full report of the case, stating particularly whether the invention or discovery was new

and patentable when the original patent was granted. [See former Acts: Section 65, 1870; Section 1, 1848; Section 18, 1836.]

SECTION 4927. The Commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence produced, both for and against the extension; and if it shall appear to the satisfaction of the Commissioner that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the Commissioner shall make a certificate thereon, renewing and extending the patent for the term of seven years from the expiration of the first term. Such certificate shall be recorded in the Patent Office; and thereupon such patent shall have the same effect in law as though it had been originally granted for twenty-one years. [See former Acts: Section 66, 1870; Section 18, 1836.]

SECTION 4928. 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. [See former Acts: Section 67, 1870; Section 18, 1836.]

SECTION 4929. Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woollen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or

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otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor. [See former Acts: Section 71, 1870; Section 11, March 2, 1861; Section 3, 1842.]

SECTION 4930. The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. [See former Acts: Section 72, 1870.]

SECTION 4931. Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. [See prior Acts: Section 73, 1870; Section 11, 1861; Section 3, 1842.]

SECTION 4932. Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty-one. [See former Acts: Section 74, 1870; Section 11, March 2, 1861.]

SECTION 4933. All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this Title, shall apply to patents for designs. [See prior Act: Section 76, 1870.]

## ACT OF FEBRUARY 4, 1887, ch. 105.

## 24 STATUTES AT LARGE, 387.

*Be it enacted, etc.,* That hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied. Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of two hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars; and the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any circuit court of the United States having jurisdiction of the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.

SECTION 2. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same, might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement.

SECTION 4934. The following shall be the rates for patent fees:

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

On issuing each original patent, except in design cases, twenty dollars.

In design cases: For three years and six months, ten dollars; for seven years, fifteen dollars; for fourteen years, thirty dollars.

On filing each caveat, ten dollars. [Repealed June 25, 1910, 36 Statutes at Large, ch. 414.]

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

On filing each disclaimer, ten dollars.

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

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

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

For recording every assignment, power of attorney, or other paper, of three hundred words or under, one dollar; of over three hundred and under one thousand words, two dollars; and for each additional thousand words or fraction thereof, one dollar.

Certified copies of such drawings and specifications may be furnished by the Commissioner of Patents to persons applying therefor upon payment of the present rates for uncertified copies, and twenty-five cents additional for each certification.

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

SECTION 4935. Patent fees may be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the designated depositories, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever. [See prior Acts: Section 69, 1870; Section 14, 1837.]

SECTION 4936. The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or depository, to the credit of the Treasury, as for fees accruing at the Patent Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents. [See prior Acts: Section 69, 1870; Section 1, 1842.]

SECTION 5046. All property conveyed by the bankrupt in fraud of his creditors; all rights in equity, choses in action, patent rights, and copyrights; all debts due him, or any person for his use, and all liens and securities therefor; and all his rights of action for property or estate, real or personal, and for any cause of action which he had against any person arising from contract or from the unlawful taking or detention, or injury to the property of the bankrupt; and all his rights of redeeming such property or estate; together with the like right, title, power, and authority to sell, manage, dispose of, sue for, and recover or defend the same, as the bankrupt might have had if no assignment had been made, shall, in virtue of the adjudication of bankruptcy and the appointment of his assignee, but subject to the exceptions

stated in the preceding section, be at once vested is [in] such assignee.

SECTION 70. Title to Property. The trustee of the estate of a bankrupt, upon his appointment and qualification, and his successor or successors, if he shall have one or more, upon his or their appointment and qualification, shall in turn be vested by operation of law with the title of the bankrupt, as of the date he was adjudged a bankrupt, except in so far as it is to property which is exempt, to all (1) documents relating to his property; (2) interests in patents, patent rights, copyrights, and trademarks.

#### ACT OF FEBRUARY 13, 1911.

An Act to diminish the expense of proceedings on appeal and writ of error or of certiorari.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That in any cause or proceeding wherein the final judgment or decree is sought to be reviewed on appeal to, or by writ of error from, a United States circuit court of appeals, the appellant or plaintiff in error shall cause to be printed under such rules as the lower court shall prescribe, and shall file in the office of the clerk of such circuit court of appeals at least twenty days before the case is called for argument therein, at least twenty-five printed transcripts of the record of the lower court, and of such part or abstract of the proofs as the rules of such circuit court of appeals may require, and in such form as the Supreme Court of the United States shall by rule prescribe, one of which printed transcripts shall be certified under the hand of the clerk of the lower court and under the seal thereof, and shall furnish three



copies of such printed transcript to the adverse party at least twenty days before such argument: *Provided*, That either the court below or the circuit court of appeals may order any original document or other evidence to be sent up in addition to the printed copies of the record or in lieu of printed copies of a part thereof; and no written or typewritten transcript of the record shall be required.

SECTION 2. That in any cause or proceeding wherein the final judgment or decree is sought to be reviewed on appeal to or by writ of error or of certiorari from the Supreme Court of the United States, in which the record has been printed and used upon the hearing in the court below and which substantially conforms to the printed record in said Supreme Court, if there have been at the time of filing the record in the court below twenty-five copies of said printed record, in addition to those provided in the preceding section, lodged with the clerk of the court below, one copy thereof shall be used by the clerk of the court below in the preparation and as a part of the transcript of the record of the court below; and no fee shall be allowed the clerk of the court below in the preparation of the transcript for such part thereof as is included in said printed record so lodged with him. And the clerk of the court below in transmitting the transcript of record to the Supreme Court of the United States for review shall at the same time transmit the remaining uncertified copies of the printed record so lodged with him, which shall be used in the preparation and as a part of the printed record in the Supreme Court of the United States, and the clerk's fee for preparing the record for the printer, indexing the same, supervising the printing and binding and distributing the copies shall be at such rate per folio thereof, exclusive of the printed record so furnished by the clerk of the court

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below, as the Supreme Court of the United States may from time to time by rule prescribe; and no written or typewritten transcript of so much of the record as shall have been printed as herein provided shall be required.

Passed the Senate June 23 (calendar day, June 24), 1910.

ATTEST:

CHARLES G. BENNETT,  
Secretary.