

Nothing can be assigned for error which contradicts the record; nor can any appellant be allowed to assign for error the ruling of the court in respect to any defense not set up in his plea or answer. — *Bates v. Coe*, 98 U. S. 31; 25 L. Ed. 68.

The complainant has filed twenty assignments of error. It is hardly conceivable that the court below could have fallen into as many as twenty distinct different errors in passing upon the two questions at issue; and this court will not enter *seriatim* into an examination of these several assignments, but will treat the matter in a more compendious manner. — *Ashton v. Coale*, 52 Fed. 314; 3 C. C. A. 98.

Assignments of error ought to be strictly confined to the subject brought before the appellate court, whether on appeal or by writ of error. — *Game-well v. Municipal*, 61 Fed. 208; 9 C. C. A. 450.

Error is assignable upon an order or ruling, but not upon the opinion of a court or the reasons given for a ruling. — *Russell v. Kern*, 69 Fed. 94; 16 C. C. A. 154.

Caverly v. Deere, 66 Fed. 305.

Where counsel for an appellant or plaintiff in error files a brief and makes an oral argument, and does not allude in either to any of his assignments of error, he must be taken to have waived it. — *American v. Buckskin*, 72 Fed. 508; 18 C. C. A. 662.

The assignments of error are three in number, and are set forth in the statement which precedes this opinion. The first assignment is not distributive or severable as between the five claims. The proposition to which appellants commit themselves is that their construction is not an infringement of any one of the five claims. This court cannot sustain the assignment in form and effect as made without declaring that no one of the claims is infringed. So, also, as to the second assignment. The proposition therein put forward by appellants is that neither of the patents is valid. The court cannot sustain this assignment without holding that both are invalid. But two of the claims were infringed, and one of the patents, namely, that numbered 456,122, is valid. Assuming that the two assignments of error meet the technical rules of this court, — a matter not here decided, since a court of error may, of its own motion, reverse for an error not assigned, — this court must necessarily overrule said assignments. The situation here is plain enough without elaboration. — *Standard v. Crane*, 76 Fed. 767; 22 C. C. A. 549.

The assignment is predicated, not as it ought to have been, upon the ruling of the court, but upon the reason given for the decision. That, we have more than once declared, is improper and unavailing. — *Clark v. Deere*, 80 Fed. 534; 25 C. C. A. 619.

Caverly v. Deere, 66 Fed. 305; *Russell v. Kern*, 69 Fed. 94.

An assignment of error which is predicated upon the opinion of the court, or upon a reason given by the court for its ruling or decree, is not available. It is something done by the court, — a ruling, judgment, order or decree, — and not a reason therefor, which may be assigned as error. A sufficient assignment in this case would have been simply that the court erred in dismissing the bill. — *Evans v. Suess*, 83 Fed. 706; 28 C. C. A. 24.

Caverly v. Deere, 66 Fed. 305; *Russell v. Kern*, 69 Fed. 94; *Clark v. Deere*, 80 Fed. 534.

§ 112. Assignments of Error — Miscellaneous Rules.

The appellate court reversed the trial court holding that the claims were too broad, and, properly construed, the patent was not infringed. This defense was not raised by the assignment of errors. *Held*: The first assignment is that "the court erred in not dismissing the bill of complaint," and it is said to be too general. But if this be so, we think the error is plain, and that we may, in the exercise of our discretion, and ought to, notice it. This defense was distinctly raised by the answer, the issue is vital to the merits of the controversy, and the case cannot be rightly decided without advertng to it. — *Wessel v. United*, 139 Fed. 11; 71 C. C. A. 423.

C. C. A. Rules, 90 Fed. cxlvii; *Andrews v. National*, 77 Fed. 774; *National v. Spiro*, 78 Fed. 774.

The assignment of errors is to be filed in the court below before the court loses jurisdiction. It follows that, when these later assignments were filed, the case was no longer pending in the court below, and the filing them there was a futile act. — *Mast v. Superior*, 154 Fed. 45; 83 C. C. A. 157.

§ 113. Certification.

The circuit court, on division certified the single question of fact of infringement. *Held*: That it could not be entertained. — *Wilson v. Barnum*, 8 How. 258; 12 L. Ed. 1070.

It is only a difference on a special point of law which can be distinctly stated that may be certified to this court under sec. 652 R. S. — *California v. Molitor*, 113 U. S. 609; 28 L. Ed. 1106; 5 S. Ct. 618.

Wayman v. Southard, 10 Wheat. 20; *Denniston v. Stewart*, 18 How. 565; *Wilson v. Barnum*, 8 How. 258; *U. S. v. Briggs*, 5 How. 208; *U. S. v. Bailey*, 9 Pet. 257; *Adams v. Jones*, 12 Pet. 207; *Nesmith v. Sheldon*, 6 How. 41; *Webster v. Cooper*, 10 How. 54; *Daniels v. R. R.* 3 Wall. 250.

It was long ago settled under the statutes authorizing questions upon which two judges of the circuit court were divided in opinion to be certified to this court, that each question so certified must be a distinct point or proposition of law clearly stated, so that it could be definitely answered. — *Columbus v. Robbins*, 148 U. S. 266; 37 L. Ed. 445; 13 S. Ct. 594.

Perkins v. Hart, 24 U. S. 237; *Sadler v. Hoover*, 48 U. S. 646; *Jewell v. Knight*, 123 U. S. 426; *Fire Ins. Assn. v. Wickman*, 128 U. S. 426.

Whether the supreme court will review a decision of the circuit court of appeals solely on the grounds that another circuit has held otherwise, without division and certificate, quaery. — *Columbus v. Robbins*, 148 U. S. 266; 37 L. Ed. 445; 13 S. Ct. 594.

§ 114. Commissioner of Patents — Actions of.

In matters of this description, in which the action of the Commissioner is quasi judicial, the fact that no appeal is expressly given to the Secretary of the Interior is conclusive that none is to be implied. — *Butterworth v. Hoe*, 112 U. S. 50; 28 L. Ed. 656; 5 S. Ct. 25.

9 O. G. 403; 12 O. G. 475; 13 O. G. 771; 16 O. G. 220.

§ 115. Cross-Appeals.

When a complainant has a decree in his favor, but not to the extent prayed for in his bill, and the respondent appeals: if the complainant desires a more favorable decree, he must enter a cross appeal, that when the

decree comes before the appellate court he may be heard. For when the decree is affirmed or reversed by the appellate court, it becomes the decree of that court, and cannot be the subject of another appeal. — *Corning v. Troy*, 15 How. 451; 14 L. Ed. 768.

That a decree holding certain claims sued on invalid, and certain other claims sued on valid and infringed and ordering an injunction, is not a final decree, and is not appealable by complainant by cross-appeal, see *Ex parte National*, 201 U. S. 156; 26 S. Ct. 404.

On an interlocutory decree declaring certain claims void and others valid, the complainant is not entitled to a cross appeal or to the decrees holding certain claims void. — *Marden v. Campbell*, 67 Fed. 809; 15 C. C. A. 26.

Gamewell v. Municipal, 61 Fed. 208.

That decree allowed an injunction, and for that reason the defendants had a right to review it by appeal, and this court had jurisdiction to consider and determine upon that appeal what kind of a decree ought to be rendered. The complainant had no right to maintain a cross-appeal, because no injunction was granted against it, and the decree was not final. — *Minnesota v. Dowagiac*, 126 Fed. 746; 61 C. C. A. 352.

Both parties appealed from interlocutory decree, holding one claim valid and another void. *Held*: Inasmuch as the decree of the circuit court is not final, the only appeal which can be considered is from so much of such decree as grants an injunction. — *Kilmer v. Griswold*, 67 Fed. 1017; 15 C. C. A. 161.

§ 116. Decrees — Final — What Constitute.

As it is admitted that the court below has not yet acted upon the mandate of this court, and entered a final decree in pursuance thereof, there is no final decree, from which only an appeal can be taken. — *Corning v. Troy*, 15 How. 451; 14 L. Ed. 768.

The Palmyra 10 Wheat 502; Chace v. Vasquez, 11 Wheat 429.

In the Federal courts no appeal can, as a general rule, be taken, except from a final decree. — *Ex parte National*, 201 U. S. 156; 26 S. Ct. 404.

Forgay v. Conrad, 6 How. 201; *McLish v. Roff*, 141 U. S. 661.

Complainant *Brush Co.*, as co-complainant with licensee moved to be dismissed as a party. Motion denied. *Brush Co.*, appeals. *Held*: That the decision below on the question was a final decision in the sense of giving the right of appeal under the act. — *Brush v. Electric*, 51 Fed. 557; 2 C. C. A. 373.

2 Dan. Ch. 1192; *Williams v. Morgan*, 111 U. S. 689; *Forgay v. Conrad*, 6 How. 203; *Bronson v. Railroad*, 2 Black. 530; *Trust Co. v. Grant*, 135 U. S. 209; *Sharon v. Sharon*, 67 Cal. 195; *Terry v. Sharon*, 131 U. S. 46.

Although there may be an interlocutory decree declaring certain claims void and others valid, yet there is only one final decree. It would be contrary to all well-conceived notions to imagine two final decrees in a patent cause of this character. — *Marden v. Campbell*, 67 Fed. 809; 15 C. C. A. 26.

Whatever was before this court by virtue of that appeal, and was disposed of, has been finally done, and must be regarded as settled. The cir-

circuit court is bound by such decree as the law of the case, and must carry it into execution according to the mandate. The decree of this court upon any matter within its jurisdiction can neither be modified, reversed, enlarged, nor suspended by circuit court; nor can any other or less or greater relief be accorded than that prescribed by its decree and mandate. Any matter undecided and left open by the mandate the court below may hear and decide, and its decree in relation to such new matters can be examined here only upon a new appeal. That the decree and mandate of this court have precisely the same finality as was attached to the decree and mandates of the supreme court, before the establishment of the circuit courts of appeals, is too obvious for elaboration. — *Bissell v. Goshen*, 72 Fed. 545; 19 C. C. A. 25.

The injunction decree appealed from was not a mere preliminary injunction granted in the exercise of the discretion of the circuit court. The case had been fully prepared by both parties. It came on regularly to be heard on the merits and was so heard. The court was obliged to decide, and did decide that the complainant's patent was valid and infringed. Upon this basis the court awarded, as it was bound to do, a perpetual injunction and an accounting. Under the rule of the supreme court as to an appealable final decree, this was not one, although the merits had been determined and nothing remained to be done except to ascertain the damages. — *Bissell v. Goshen*, 72 Fed. 545; 19 C. C. A. 25.

Forgay v. Conrad, 6 How. 204; *Barnard v. Gibson*, 7 How. 656; *Humiston v. Stainthorp*, 2 Wall. 106; *Railroad v. Swasey*, 23 Wall. 405; *Bronson v. Railroad*, 2 Black 528; *Bostwick v. Brinkerhoff*, 106 U. S. 3; *Grant v. Ins. Co.* 106 U. S. 429; *Parsons v. Robinson*, 122 U. S. 112; *St. Louis v. Southern*, 108 U. S. 24; *Iron Co. v. Martin*, 132 U. S. 91; *McGourkey v. Railway*, 146 U. S. 536; *Elder v. McClaskey*, 70 Fed. 557.

A decree on the merits sustaining infringement (without injunction) is not a final decree for the purpose of an appeal. — *Lockwood v. Wickes*, 75 Fed. 118; 21 C. C. A. 257.

Perkins v. Tourniquet, 6 How. 206; *Barnard v. Gibson*, 7 How. 650; *Humiston v. Stainthorp*, 2 Wall. 106; *Crawford v. Points*, 13 How. 11; *Iron v. Martin*, 132 U. S. 91.

One portion of a given decree may be final, and for that reason reviewable on appeal, while the remainder may be interlocutory, and for that reason not appealable. — *Standard v. Crane*, 76 Fed. 767; 22 C. C. A. 549.

Forgay v. Conrad, 6 How. 202; *Iron Co. v. Meeker*, 109 U. S. 180; *McFarland v. Hall*, 17 Tex. 691; *Malone v. Marriott*, 64 Ala. 486; *Williamson v. Field*, 2 Barb. Ch. 281; *Dickerson v. Codwise*, 11 Paige, 189.

A decree finding title, infringement and awarding an injunction and accounting is not an interlocutory decree and is not appealable under sec. 7 but is a final decree and is appealable under sec. 6. — *Standard v. Crane*, 76 Fed. 767; 22 C. C. A. 549.

Disapproving,

Bissell v. Goshen, 72 Fed. 545; *Watch Co. v. Robbins*, 52 Fed. 337; s. c. 64 Fed. 384; *Richmond v. Atwood*, 52 Fed. 10; *Green v. Mills*, 69 Fed. 852.

That after a case has been to the master and determined, and the final decree corrected and determined on appeal, the appellate court will not entertain a second appeal on evidence insufficient to materially change the status of the case, see *Tuttle v. Clafflin*, 82 Fed. 744; 27 C. C. A. 255.

It is further contended, that as the decree finally disposes of the first claim of the patent, an appeal would lie independently of the statute. But as that part of the decree did not finally dispose of the whole case, which was retained for the purpose of an accounting upon the claims held valid, the right to appeal from the dismissal of the bill as to the first claim, would be suspended until the final decree. — *Western v. Williams-Abbott*, 108 Fed. 952; 48 C. C. A. 159.

Marden v. Printing Press, 67 Fed. 809.

As the case below passed off on demurrer, no testimony having been heard, we are at liberty to consider only the allegations of the bill and the specification and claim of the patent. We are at liberty, however, to examine the patent in the light of that common knowledge of facts and principles which is possessed by all persons of average intelligence. — *Mahler v. Animarium*, 111 Fed. 530; 49 C. C. A. 431.

Brown v. Piper, 91 U. S. 37; *Richards v. Elevator*, 158 U. S. 299; *Engraving v. Hoke*, 30 Fed. 444.

§ 117. Decrees — Interlocutory — Defined.

A decree sustaining a patent, awarding an injunction and ordering an accounting, is an interlocutory decree and is appealable under the act of 1891. — *Jones v. Munger*, 50 Fed. 785; 1 C. C. A. 668.

Iron Co. v. Martin, 132 U. S. 91; *Daniell Ch. Pr.* 5 ed. 986-1019; *Richmond v. Atwood*, 48 Fed. 910.

The "interlocutory order or decree" made appealable by amended section 7 must be one wherein the court grants, continues, refuses, dissolves, or refuses to dissolve an injunction. The state of the record or progress of the cause must be such, when said appealable "interlocutory order or decree" is entered, that a "final decree" upon the matter with which said "interlocutory order or decree" has to do may yet be made. The contrast suggested by the words "interlocutory order or decree" and "final decree" as used in the first paragraph of amended section 7, is between a decree which is preliminary to a hearing on the merits, and hence discretionary in the court, and one which follows a hearing on the merits, and is hence final, conclusive, and as of right in the prevailing party; between a decree which is meant to preserve the subject-matter of the litigation, or prevent irreparable injury, till a hearing on the merits can be had, and a decree which follows the hearing on the merits, and ultimately determines the rights of the litigants. The "interlocutory order or decree" made appealable by amended section 7 must be one which leaves the cause pending on the issues in the court of original jurisdiction. — *Standard v. Crane*, 76 Fed. 767; 22 C. C. A. 549.

§ 118. Decrees — Interlocutory — What Determined on Appeal.

Appeals from orders are not to be confounded with appeals from final decrees, and the rule stated (as to the force and effect to be given a prior adjudication) will not prevent our review of the adjudication itself, whenever it and the record upon which it was made, shall be presented upon appeal. The tendency of any different rule would be to produce confusion, and convert the review of the interlocutory order into a review of the final adjudication upon which it was founded. — *American v. National*, 51 Fed. 229; 2 C. C. A. 165.

The record before us is complete. Everything is here for our consideration which was before the court below. We must go to the full merits, as shown by the record, in order to determine whether the interlocutory decree

for a perpetual injunction is founded in error, and, if we determine the property right adversely to the complainant the injunction should be dissolved; and no sufficient reason has been suggested why the accounting, — to which the complainant is not entitled, and, which would be an evasion of a right, and therefore, inequitable and improper, under our view of the case — should proceed. — *Richmond v. Atwood*, 52 Fed. 10; 2 C. C. A. 596.

While an appellate court interferes reluctantly with discretionary injunctions, on an appeal from an interlocutory decree for a perpetual injunction and an accounting, upon a complete record the court will decide the appeal upon its merits without waiting for an accounting. — *Richmond v. Atwood*, 52 Fed. 10; 2 C. C. A. 596.

As to what the court will consider on appeal from an interlocutory order, see note in *Consolidated v. Pacific*, 53 Fed. 385; 3 C. C. A. 570.

The case came here on appeal from an interlocutory decree granting an injunction but was heard as well on the merits. The court had jurisdiction to review the case on its merits. — *Consolidated v. Pacific*, 58 Fed. 226; 7 C. C. A. 195.

Iron Works v. Smith, (no opinion filed.)

It is a rule of equitable convenience that when the whole record touching the decree so far as it supports the injunction comes up before the court of appeals, or can come there, so that the court has before it everything in this respect which the circuit court had or which the court of appeals would have on an appeal from a final decree, the court will go fully into the merits of the appeal. — *Marden v. Campbell*, 67 Fed. 809; 15 C. C. A. 26.

Richmond v. Atwood, 52 Fed. 10.

Inasmuch as the hearing of the merits of the bill, answer, and proofs, and the whole record is before us, we are able to dispose finally of the case in accordance with what is now the settled rule of practice. — *Crosby v. Ashton*, 94 Fed. 516; 36 C. C. A. 335.

The appeal being from an interlocutory decree, it was attempted to dispose of the issue on the ground that no recovery could be had because complainant had failed to mark its articles patented. *Held*: the decree below not having as yet become final, the appeal brings before this court for review only so much of the decree as awarded an injunction. — *Metallic v. Brown*, 104 Fed. 345; 43 C. C. A. 568.

Several issues of fact are raised by the pleadings, a consideration of which at this time would tend to embarrass the trial court in the consideration of the case on the final hearing, and this court, should the case be again brought here by appeal. The cause is not in condition to be heard as to these matters now, and it must be understood that what is said is upon the record as now before this court, and not as to the merits as they may be hereafter presented. — *American v. Phoenix*, 113 Fed. 629; 51 C. C. A. 339.

Loew v. Filter Co. 107 Fed. 950.

In addition to a defense of the novelty of the claims of the patent, the appellees contend that, inasmuch as this is only an appeal from an order allowing an injunction pendente lite, this court may not consider any other question than whether the court below has abused its legal discretion in allowing the injunction, all other defenses being postponed until a final hearing. (After holding the contrary, citing *Knoxville v. Africa*, 77 Fed. 501; *Mast v. Stover*, 177 U. S. 485; *Smith v. Vulcan*, 165 U. S. 518; *Bissell v. Goshen*, 72 Fed. 545; *Watch v. Robbins*, 52 Fed. 337; *Blount v. Societe*, 53 Fed. 98; *Duplex v. Campbell*, 69 Fed. 250 the court added): But it must be conceded that upon

such an appeal the case against the patent must be a very plain one before the court would be justified in holding it void for want of novelty upon its face, or in reaching the same result upon a contested question of anticipation arising upon prior patents and their exemplification by *ex parte* affidavits of patent experts. — *Co-operating v. Hallock*, 128 Fed. 596; 64 C. C. A. 104.

Milner v. Yesbera, 111 Fed. 386; *Higgins v. Scherer*, 100 Fed. 459.

§ 119. Decrees — Interlocutory — When Appealable.

The decree appealed from is one dissolving *pro tanto* the perpetual injunction heretofore in force, and is an appealable interlocutory order or decree, within the act of Feb. 18, 1895, which amends sec. 7 of Mar. 3, 1891, so as to allow appeals from interlocutory orders or decrees dissolving injunctions. — *Bissell v. Goshen*, 72 Fed. 545; 19 C. C. A. 25.

Note: Not appealable under later amendment to the statute.

§ 120. Decrees — Interlocutory — Miscellaneous Rules.

It is equally clear that congress intended, by allowing an appeal from an interlocutory decree, to allow an appeal from a perpetual injunction ordered, and allowed upon a final hearing of the merits, where the same decree refers the cause to a master for an accounting. — *Bissell v. Goshen*, 72 Fed. 545; 19 C. C. A. 25.

Richmond v. Atwood, 52 Fed. 10; *Dudley v. Munger*, 50 Fed. 785; *Marden v. Mfg. Co.* 67 Fed. 809; *Mfg. Co. v. Griswold*, 67 Fed. 1017; *American v. National*, 51 Fed. 229; *Curtis v. Wheel Co.* 58 Fed. 784; *Consolidated v. Accumulator*, 55 Fed. 485; *Blount v. Societe*, 53 Fed. 98; *Watch Co. v. Robbins*, 52 Fed. 337; *Industrial v. Electric*, 58 Fed. 732; *Consolidated v. Pacific*, 58 Fed. 226; *Andrews v. Pipe*, 61 Fed. 782.

We conclude that the question whether a complainant should be permitted, in a given case, to waive his right to an injunction and thereby postpone the right of appeal until the decree becomes in all respects final, is one which may be safely remitted to the discretion of the trial court. — *Lockwood v. Wicks*, 75 Fed. 118; 21 C. C. A. 257.

Following,

Richmond v. Atwood, 52 Fed. 10; *Jones v. Munger*, 50 Fed. 785.

The interlocutory decree held one of the claims of the patent valid and infringed, and the other claims invalid or not infringed, and the complainant appealed from so much thereof as related to the claims which were adjudged invalid or not infringed. Thereupon the respondent below, now the appellee, filed a motion to dismiss on the ground that the appeal was premature. The respondent below took an appeal from so much of the interlocutory decree as adjudged one of the claims valid and infringed. The motion to dismiss this appeal must be allowed on the authority of our decision in *Marden v. Campbell*, 67 Fed. 809; and also *Ex parte National Enameling*, 201 U. S. 156. — *Library v. Yawman*, 147 Fed. 245; 17 C. C. A. 387.

§ 121. Decrees — Stipulation.

A stipulation has been agreed upon between the parties that a decree might be entered in this case in conformity with and upon the filing of a decree in another suit between the same parties. *Held:* The court below having entered a decree conformable to that stipulation, the appellants cannot maintain an assignment of error. — *McCafferty v. Celluloid*, 104 Fed. 305; 43 C. C. A. 540.

Railroad v. Ketchum, 101 U. S. 289.

§ 122. Demurrer — Injunction.

Complainants, although they were prepared to go on with the motion they had made (for a preliminary injunction) were subjected on appeal to the same

consequences as if the preliminary hearing had been a final one. If complainants in every case must understand that a motion for preliminary injunction requires the same showing as on final hearing, very few motions of that sort would be made. We think the case comes within the exceptions pointed out in *Mast v. Stover*, 177 U. S. 485, and are impressed with the conviction that complainants have not had their day in court, and that it ought to be accorded them. — *Brill v. Peckham*, 189 U. S. 57; 47 L. Ed. 706; 23 S. Ct. 562.

§ 123. Dismissal — On Motion.

An appellant cannot as of right dismiss his own appeal. *U. S. v. Minn.* 18 How. 241; That ordinarily, on a dismissal on his own motion, the appellant is not entitled to an order expressed without prejudice, follows from what is said in the case cited at page 242, that usually the court will not allow such a dismissal if the appellant intends at some future time to bring another appeal. How very cautious the Supreme Court usually is to shut out presumptions of any qualification in connection with such orders appears from *U. S. v. Griffith*, 141 U. S. 212.

Where, after a hearing, a cause is disposed of by the court on appeal, for some reason not touching the merits, it is now well settled that the judgment should usually show that it is without prejudice. So, on his own motion to dismiss, an appellant may sometimes show inadvertence or mistake or some other special reason which may entitle him to equitable consideration and a special order. But we have no suggestion of any such exceptional matter here. We have no judicial knowledge of anything except what we have stated, and that there has been no hearing by us on the merits. Whether, under our expressions in *Gamewell Fire-Alarm Telegraph Co. v. Municipal Signal Co.* 61 Fed. 208 and in *Marden v. Mfg. Co.* 67 Fed. 809, the appellant is not, in any event, sure of all he desires to reserve, is for him to consider. As he moves to dismiss his appeal of his own volition, we have no occasion whatever to aid him, under the circumstances of the case, either by any special order, or by any expressions of opinion. — *Donallan v. Tamage Patent*, 79 Fed. 585; 24 C. C. A. 647.

§ 124. Dismissal — Without Prejudice.

The Supreme Court has shown a growing tendency to approve the practice of making it clear that a dismissal is without prejudice, or without a hearing on the merits, where there has been no such hearing. — *Greene v. United*, 124 Fed. 961; 60 C. C. A. 93.

Manifestly, whether the court below erred or did not err in entering a certain decree is a question to be presented upon review of such decree. It has nothing to do with a motion to dismiss appeal from such decree. The facts and circumstances which make the appeal effective or not all arise subsequent to the entry of the decree. — *Bradley v. Eccles*, 126 Fed. 945; 61 C. C. A. 669.

We are not able to see that the court below violated any rule of equity practice, or abused its legal discretion, in making the decree here complained of. No testimony had been taken in the case, and there had been no hearing or decree upon the merits. The hearing of the motion for a preliminary injunction upon opposing ex parte affidavits and the denial of the motion did not bar the dismissal of the bill by permission of the court in the exercise of its sound discretion. Nor was leave to dismiss precluded because the defendant was called on to answer the bill under oath, and did so. The appellant, we think, was deprived of no substantial right by the dismissal. We cannot agree that future litigation thus made possible amounted to legal prejudice. — *Penn v. Columbia*, 132 Fed. 808; 66 C. C. A. 127.

§ 125. Exceptions — Master's Report.

It is too late to raise exceptions here upon ruling of master on damages. — *Kinsman v. Parkhurst*, 59 U. S. 289; 15 L. Ed. 385.

Exceptions to a master's report raised for the first time in the Supreme Court will not be entertained. — *Topliff v. Topliff*, 145 U. S. 156; 36 L. Ed. 658; 12 S. Ct. 825.

McMicken v. Perin, 59 U. S. 507.

§ 126. Exceptions — Sufficiency.

An appeal lies only upon a bill of exceptions, certified, allowed and signed by the judge which constitutes a writ of error. — *Phoenix v. Lanier*, 95 U. S. 171; 24 L. Ed. 383.

Pomeroy v. Bk. 1 Wall. 592.

As no exception appears to have been taken thereto these findings must be accepted as conclusive. — *Kirk v. U. S.* 163 U. S. 49; 41 L. Ed. 66; 16 S. Ct. 911.

That exceptions under rule 11 must be definite, clear and specific, and not vague and general — see *Mast v. Superior*, 154 Fed. 45; 83 C. C. A. 157.

§ 127. Exceptions — Waiver.

When a party excepts to a ruling upon the trial but does not stand upon such exception, and elects to proceed, he thereby waives his exception. — *Campbell v. Haverhill*, 155 U. S. 610; 39 L. Ed. 280; 15 S. Ct. 217.

§ 128. Finality.

It seems to us that the opinions and decrees of this, as a court of appellate jurisdiction, are final and conclusive upon every point actually decided, and that it is the clear duty of the lower court to give effect to the decree here rendered. — *Bissell v. Goshen*, 72 Fed. 545; 19 C. C. A. 25.

Sibbald v. U. S. 12 Pet. 488; *Stewart v. Solomon*, 97 U. S. 361; *Metcalf v. City*, 68 Fed. 859; *Sanford, Petitioner*, 160 U. S. 247; 16 Sup. Ct. 291; *Southard v. Russell*, 16 How. 547; *Durant v. Essex*, 101 U. S. 555; *Kingsbury v. Buckner*, 134 U. S. 650; *Smelting v. Billings*, 150 U. S. 31; *Gaines v. Rugg*, 148 U. S. 228.

Whatever was before the court, and is disposed of, is considered as finally settled. The inferior court is bound by the decree as the law of the case. — *In re Gamewell*, 73 Fed. 908; 20 C. C. A. 111.

Sibbald v. U. S. 12 Pet. 488; *Gaines v. Rugg*, 148 U. S. 228; *In re Sanford*, 160 U. S. 247; *Southard v. Russell*, 16 How. 547.

§ 129. Findings.

The lower courts found that the invention was a broad one, and that the machine used by the Continental Company was an infringement. And these were questions of fact upon which, both of the courts concurring, their findings will not be disturbed unless clearly wrong. — *Continental v. Eastern*, 210 U. S. 405; 51 L. Ed. 922; 28 S. Ct. 748.

Deslions v. LaCompagnie, 210 U. S. 95.

An appeal in a case tried before a judge without a jury (under sec. 649 R. S.) taken upon the findings of fact, can present no other question on appeal. — *Klein v. Seattle*, 77 Fed. 200; 23 C. C. A. 114.

Trust Co. v. Wood, 60 Fed. 346; *Blanchard v. Bank*, 75 Fed. 249; *Grayson v. Lynch*, 163 U. S. 468.

Again, the court below has considered this question in the light of the state of the art, and of the conflicting testimony of the witnesses, and has decided that Seeley's combination was an invention. This conclusion is presumptively correct, and ought not to be reversed unless an obvious error has intervened in the application of the law, or some serious mistake has been made in the consideration of the facts by the circuit court. — *Kinloch v. Western*, 113 Fed. 659; 51 C. C. A. 369.

National v. Interchangeable, 106 Fed. 693; *Mann v. Bank*, 86 Fed. 51; *Tilghman v. Proctor*, 125 U. S. 136; *Kimberly v. Arms*, 129 U. S. 512; *Furrer v. Ferris*, 145 U. S. 132; *Warren v. Burt*, 58 Fed. 101; *Plow v. Carson*, 72 Fed. 387; *Trust Co. v. McClure*, 78 Fed. 209; *Exploration v. Adams*, 104 Fed. 404.

These findings of fact by the court below (that neither an express contract nor a presumption that such contract existed had been proved) must receive the respect and consideration to which such findings are always entitled in a reviewing court. They are prima facie conclusive, and nothing but a showing that the preponderance of evidence is clearly and unmistakably against them, would justify this court in reversing them. — *Pressed Steel v. Hansen*, 137 Fed. 403; 71 C. C. A. 207.

§ 130. Jurisdiction.

Neither can the allowance of the writ by the circuit court give jurisdiction, where the only question is the amount of costs to be taxed; and the amount allowed is less than \$2000. The discretionary power in this respect vested in the circuit court by the Act of July 4, 1836, sec. 17, is evidently confined to cases which involve the construction of the patent laws, and the claims and rights of the patentees under them. But the amount of costs which either party shall be entitled to recover is not regulated by these laws. The costs claimed are allowed or refused in controversies arising under the Patent Acts upon the same principle and by the same laws which govern the court in the taxation of costs in any other case that may come before it. The same laws, therefore, must be applied to them in relation to the writ of error, and must limit the jurisdiction of this court as in other cases. — *Sizer v. Many*, 16 How. 98; 14 L. Ed. 861.

The sum taxed being less than \$2000, no writ of error will lie under the Act of 1789. This Act gives no jurisdiction to this court over the judgment of a circuit court, when the judgment is for less than that sum. — *Sizer v. Many*, 16 How. 98; 14 L. Ed. 861.

A decree sustaining the validity of a patent, awarding injunction and an accounting is an interlocutory decree; and upon appeal from such decree the court will not pass upon the merits of the case as from a final decree. — *Columbus v. Robbins*, 52 Fed. 337; 3 C. C. A. 103.

(Overruled in *Bissell v. Goshen*, 72 Fed. 545.) See 148 U. S. 266.

Disapproving,

Richmond v. Atwood, 48 Fed. 910; *Jones v. Munger*, 50 Fed. 785; *Barnard v. Gibson*, 7 How. 650; *Humiston v. Stainthorp*, 2 Wall. 106; *Iron Co. v. Martin*, 132 U. S. 91; *Tourniquet v. Perkins*, 16 How. 84; *Beebe v. Russell*, 19 How. 283; *Craighead v. Wilson*, 18 How. 199; *Farrelly v. Woodfolk*, 19 How. 288; *Green v. Fisk*, 103 U. S. 518.

§ 131. Law Actions — What Considered on.

In a suit at law where evidence was taken and the question of infringement was determined, this court will not review the evidence as if it were a suit in equity. — *St. Paul v. Starling*, 140 U. S. 184; 35 L. Ed. 404; 11 S. Ct. 803.

Since the adoption of the seventh amendment to the Constitution, declaring that no fact tried by a jury shall be otherwise re-examined by any court of the United States than according to the rules of the common law, the Supreme Court has repeatedly affirmed the doctrine that upon writ of error the Federal courts are confined to the consideration of exceptions to the evidence and to the instructions given or refused to the jury, and that they have no concern with questions of fact, or the weight to be given to the evidence which was properly admitted. — *Singer v. Brill*, 54 Fed. 380; 4 C. C. A. 374.

Parsons v. Bedford, 3 Pet. 436; *Barreda v. Silsbee*, 21 How. 167; *Railroad v. Fraloff*, 100 U. S. 31; *Ins. Co. v. Ward*, 140 U. S. 91.

It is impossible for us to say that the jury disregarded the instructions. There is nothing in the bill of exceptions to show that they did. The presumption is, on the other hand, that they strictly observed it. — *Harper v. Wilgus*, 56 Fed. 587; 6 C. C. A. 45.

The only recognized exception to the statutory rule which in common law cases tried without a jury limits the review, on writ of error, to "rulings of the court in the progress of the trial" and to the question "of the sufficiency of the facts found to support the judgment," is that "a party may insist upon a finding in his favor on the ground that there is a total lack of evidence to support a contrary finding, or, if he have the burden of the issue, on the ground that the evidence in his favor is inadequate, unimpeached, and without conflict or uncertainty." But, to raise such a question as one of law, the exception or motion must be specific to that effect, distinguishing it from a question of the weight of evidence. — *Keene v. Barratt*, 100 Fed. 590; 40 C. C. A. 571.

Exposition v. Republic, 96 Fed. 687; *Martinton v. Fairbanks*, 112 U. S. 670.

Where the parties consent that the case be tried before a judge or referee, the only question presented by the writ of error is whether there is any error of law in the judgment upon the facts as found by the judge or referee. The court's findings upon questions of fact are not subject to review in the appellate court if there is any legal evidence upon which such findings could be made. — *American v. Bullivant*, 117 Fed. 255; 54 C. C. A. 287.

U. S. v. Dawson, 101 U. S. 569; *Boogher v. Insurance Co.* 103 U. S. 90; *Miles v. U. S.* 103 U. S. 304; *Paine v. Railroad*, 118 U. S. 152; *Stanley v. Board*, 121 U. S. 535; *Hathaway v. Bank*, 134 U. S. 494; *Rogers v. U. S.* 141 U. S. 548; 7 Enc. Pl. & Prac. 847-8; *Myers v. Brown*, 102 Fed. 250.

§ 132. Law Actions — Miscellaneous.

For a general statement as to requirements as to exceptions and as to briefs in the first circuit, see *National v. Leland*, 94 Fed. 502; 37 C. C. A. 372.

It is the rule that, if the bill of exceptions does not contain all of the evidence, the question whether a general verdict or finding of the lower court was supported by the evidence, will not be considered. — *Leslie v. Standard*, 98 Fed. 827; 39 C. C. A. 314.

It must always be presumed in such a case, that any defect in the evidence presented would be removed by a full statement, but, while every presumption must be indulged in favor of the judgment, it should be a reasonable presumption, not inconsistent with what is shown in the record; and when a finding has been directed in favor of the defendant in a case, and the bill of exceptions, though not purporting to contain all of the evidence, contains a statement of evidence in behalf of the plaintiff, sufficient

on every issue to have justified a verdict in his favor, the rule manifestly ought not to apply, especially if it be apparent that the action of the court was the result of a misapprehension of the bearing of the proof adduced. — *Leslie v. Standard*, 98 Fed. 827; 39 C. C. A. 314.

§ 133. Orders.

Orders relating to the conduct of a trial and to amendments adjusting the parties to a controversy are generally treated as orders made in the exercise of discretion, and not subject to exception and review. In an equity case, however, where the appeal brings up questions of law and of fact, the court of review may doubtless examine to see whether the case, as presented, is, either upon the law, the facts, or the pleadings, an inequitable case; and if, for any reason, it so appears, relief may and should be withheld. — *Consolidated v. West End*, 85 Fed. 662; 29 C. C. A. 386.

We cannot review the order of the court below refusing to stay the taxation of costs, or in fixing the amount of the bond to be given on appeal. The order is not reviewable, unless upon an appeal from the final decree. — *Crown v. Baltimore*, 136 Fed. 184; 69 C. C. A. 519.

Martin v. Hazard, 93 U. S. 302.

§ 134. Parties to.

The law gives the party aggrieved an appeal from a final decree of an inferior court. But it does not give the party who is not aggrieved an appeal from a decree in his favor, because the judge has given no reasons, or recited insufficient ones for a judgment admitted by the appellant to be correct. — *Corning v. Troy*, 15 How. 451; 14 L. Ed. 768.

All the parties against whom a joint judgment or decree is rendered, must unite in the writ of error or appeal, or it will be dismissed, unless there has been a summons and severance, or some like proceeding, or sufficient cause is shown for the non-joinder. — *Hedges v. Seibert*, 50 Fed. 643; 1 C. C. A. 594.

Masterson v. Herndon, 10 Wall. 416; *Feibelman v. Packard*, 108 U. S. 15; *Estis v. Trabue*, 128 U. S. 225.

As a patentee may be joined as a co-complainant against his consent originally, no good reason is perceived why he may not be so retained for the prosecution of the rights of his licensee, after judgment once rendered, and the cause remanded for further proceedings. The patentee may be content with a decree against him; but when his co-complainant is not, and has the right of appeal, the doctrine of summons and service may be invoked, and upon the refusal of the patentee to join in the appeal after being duly notified to do so, the appeal of his licensee may be allowed upon the entry of such refusal of record, the judgment remaining conclusive as to the party refusing. — *Excelsior v. City of Seattle*, 117 Fed. 140; 55 C. C. A. 156.

Masterson v. Herndon, 10 Wall. 416; *Fost. Fed. Prac. sec. 505*.

§ 135. Record — Encumbering.

The record contains embodied in the bill of exceptions, the whole of the testimony and evidence offered at the trial by each party in support of the issue. It is very voluminous, and as no exception was taken to its competency or sufficiency either generally or for a particular purpose, it is not properly before this court for consideration, and forms an expensive and unnecessary burden upon the record. This court has had occasion in many cases to express its regret on account of irregular proceedings of this nature. — *Pennock v. Dialogue*, 2 Pet. 1; 7 L. Ed. 327.

Where appellee needlessly encumbers record with some 50 immaterial patents, under Rule 10 half of the costs of printing will be assessed upon appellee. — *B. & S. Fastener v. Kraetzer*, 150 U. S. 111; 37 L. Ed. 1019; 14 S. Ct. 48.

We deem it proper to say that in view of the size which oftentimes in patent cases the zeal of counsel and the ingenuity of experts unduly swell the records and briefs, so called (in this case the record contained 2,200 pages and one of the briefs 484 pages), it is not to be expected that courts, and especially appellate ones, will follow the lead thus set and discuss every question raised. — *Goss v. Scott*, 110 Fed. 402; 49 C. C. A. 97.

§ 136. Record — Stipulated.

An appeal is good taken upon a judgment rendered upon an agreed statement of facts. — *Stimpson v. Railroad*, 10 How, 329; 13 L. Ed. 441.

3 Blackstone, 377; *Stephens Plead.* 92; *U. S. v. Eliason*, 16 Pet. 291.

As the parties to this suit have stipulated as to what the record is in this suit, and the clerk of the circuit court certifies the transcript, it must be accepted as sufficient for the purposes of this suit. — *Lake Shore v. National*, 110 U. S. 229; 28 L. Ed. 129; 4 S. Ct. 33.

The proper course of the clerk was for him to observe the agreement of counsel, and leave the parties to abide the consequences. The endeavor of counsel to eliminate matter which has been found to be superfluous and unnecessary to a review in the appellate court is one to be encouraged. — *Lamb v. Lamb*, 120 Fed. 267; 56 C. C. A. 247.

The jurisdiction of this court is appellate only. Its review in law or equity is limited to the record of matters which were before the trial court, and cannot be enlarged or affected by subsequent stipulations between the parties. — *Austin v. American*, 121 Fed. 76; 57 C. C. A. 330.

Maxwell Land-Grant Case, 122 U. S. 365; *Randolph v. Allen*, 73 Fed. 23; *Case v. Hall*, 94 Fed. 300.

§ 137. Record — Miscellaneous Rules.

The Peck patent, which is printed in the record, cannot be considered by the court, for the reason that it was not set up in the answer, and was first introduced as evidence in the court below in support of a motion for rehearing and to reopen the case, which was denied. — *Andrews v. Thum*, 67 Fed. 911; 15 C. C. A. 67.

Apart from any authority, it would seem that on principle the decision of this court upon a defective presentation of the case should not be conclusive of it in all respects. An amended bill is a continuation of the original bill, and forms a part of it. The original and amended bills constitute one pleading and one record. It is clear that at the time these parties were heard in this court upon the original bill the controversy between them was no longer presented by the original bill, but was contained in a record made up of the original bill and the amended and supplemental bills. So the dismissal of the original bill did not work a dismissal of the controversy. — *Berliner v. Gramophone*, 113 Fed. 750; 51 C. C. A. 440.

1 Dan. Ch. Pl. & Pr. 402, c. 6, sec. 7; *French v. Hay*, 22 Wall. 246; *Phosphate Co. v. Brown*, 74 Fed. 323; *Miller v. McIntyre*, 6 Pet. 62.

The court finds itself unable, upon the transcript from the court below, to determine with any degree of certainty the rights of the parties to this

litigation. Ordered that the decree of the court below be set aside, and the case remanded, with direction to remand the rules with leave to both parties to take such additional proofs as they may be advised. — *Standard v. Computing*, 145 Fed. 627; 76 C. C. A. 384.

§ 138. Rehearings.

The refusal of the circuit court to grant a rehearing is not open to consideration here. — *Boesch v. Gräff*, 133 U. S. 697; 33 L. Ed. 787; 10 S. Ct. 378.

Buffington v. Harvey, 95 U. S. 99; *Steines v. Franklin*, 81 U. S. 15; *Pittsburgh v. Heck*, 102 U. S. 20; *Kennen v. Gilmer*, 131 U. S. 22.

The petition was not filed within the 15 days limited by rule 16 of the circuit court, and therefore did not operate to extend the time within which the defendants below could appeal, under the circumstances found to exist by this court in *Andrews v. Thum*, 64 Fed. 149. — *Marden v. Campbell*, 67 Fed. 809; 15 C. C. A. 26.

On a motion for a rehearing the final decree is suspended and an appeal therefrom does not lie until such motion is decided. — *Andrews v. Thum*, 72 Fed. 290; 18 C. C. A. 566.

In the opinion announcing an allowance of a rehearing, the court describes the disclaimer as one by which the complainant "seeks to restrict the claims in controversy" so as to "avoid the effect of the anticipating devices referred to by the Court of Appeals." And then, after recognition of the rule that the Circuit Court has no power, upon the ground of newly discovered evidence, to reopen a question which has been finally decided by the Court of Appeals, without the permission of the appellate tribunal, the opinion proceeds thus: "But in the present case the complainant's patent, as it now stands, has never been before the Circuit Court of Appeals, and has therefore never been considered. It is in effect a new patent, and the subject of its validity or invalidity has never been decided by any tribunal." Do these considerations justify the action of the Circuit Court in granting a rehearing without leave of this court? The decisions of the Supreme Court require a negative answer. — *American v. Sample*, 136 Fed. 857; 70 C. C. A. 415.

Ex parte Sibbald, 12 Pet. 488; *Ex parte Dubuque*, 1 Wall. 69; *Stewart v. Solomon*, 97 U. S. 361; *In re Potts*, 166 U. S. 263.

§ 139. Remanding.

While the appellate court is not bound so to do, it may, in its discretion, and should, when equity so requires, make full direction as to the manner in which the case shall be disposed of below. — *Richmond v. Atwood*, 52 Fed. 10; 2 C. C. A. 596.

This court, however, has no power to remand except for the purpose of giving effect to some judgment of its own. — *Marden v. Campbell*, 67 Fed. 809; 15 C. C. A. 26.

Roemer v. Simon, 91 U. S. 149; *Smith v. Weeks*, 53 Fed. 758.

§ 140. Second Appeal.

A second appeal lies only when the court below, in carrying out the mandate of this court, is alleged to have committed an error. But on an appeal from the mandate, it is well settled, that nothing is before the court but the proceedings subsequent to the mandate. Whatever was formally before the court, and was disposed of by its decree, is considered as finally disposed of. — *Corning v. Troy*, 15 How. 451; 14 L. Ed. 768.

Himley v. Rose, 5 Cranch, 313; *Canter v. Ocean*, 1 Pet. 511; *The Santa Maria*, 10 Wheat. 431; *Rice v. Wheatley*, 9 Dana, 272.

It has been settled by the decisions of this court, that after a case has been brought here and decided, and a mandate issued to the court below, if a second writ of error is sued out it brings up for revision nothing but the proceedings subsequent to the mandate. None of the questions which were before the court on the first writ of error can be reheard or reexamined upon the second; and there is nothing now before the court but the taxation of costs. — *Sizer v. Many*, 16 How. 98; 14 L. Ed. 861.

7 Wheat. 58; 12 Pet. 488.

§ 141. Subject-Matter.

A point not taken in the court below cannot be made here. — *Klein v. Russell*, 86 U. S. 433; 22 L. Ed. 116.

No appeal lies from a mere decree respecting costs and expenses. — *Glendale v. Smith*, 100 U. S. 110; 25 L. Ed. 547.

Canter v. Ins. Co. 3 Pet. 307.

It is, of course, well understood that a court of equity is to decide on the law and fact, and that an appeal in equity is an appeal upon the law and fact involved in the cause. — *Richmond v. Atwood*, 52 Fed. 10; 2 C. C. A. 596.

LeGuen v. Gouveneur, 1 Johns. Cas. 500; *Adams Equity*, 375; *Briggs Petition*, 29 N. H. 553; *Blake v. Oxford*, 64 N. H. 302.

This court cannot now upon this assignment of error, enter into the consideration of the question whether or not the patent in suit was anticipated by the Gauthier patent and, therefore, was itself void. That inquiry involved a question of fact for the jury, and it was properly submitted to the jury. No exception was taken in the trial, either to the submission of the case to the jury, or to the charge of the court. On the writ of error to this court we are confined to the consideration of questions of law, — the rulings of the trial court upon questions of evidence, and the instructions given or referred to the jury. We have no concern with the weight to be given to evidence which has been properly admitted. — *Harper v. Wilgus*, 56 Fed. 587; 6 C. C. A. 45.

The objections made by the appellants, touching the form of the bill, whether supplemental or original, and those as to the sufficiency of the allegations of the bill, were not raised in the court below, and cannot be taken for the first time in this court. — *Herrick v. Giant Leveller*, 60 Fed. 80; 8 C. C. A. 475.

The only question open is as to whether the court erred in holding that the plea was sustained by the evidence. If it was not supported, it should have been overruled, and the defendant ordered to answer. — *Hartz v. Cleveland*, 95 Fed. 681; 37 C. C. A. 227.

Dalzell v. Mfg. Co. 149 U. S. 315; *Farley v. Kittson*, 120 U. S. 303.

§ 142. Supersedeas.

The circuit court had a discretion to grant or refuse a supersedeas and its discretion cannot be controlled by a mandamus. — *Re Haberman*, 147 U. S. 525; 37 L. Ed. 266; 13 S. Ct. 527.

Ex parte Hawkins, 147 U. S. 486.

When an appeal was allowed from the decree granting the perpetual injunction the circuit court, as it was authorized to do under sec. 7 of the court of appeals act, granted an appeal with supersedeas, on a bond con-

ditioned that the defendant should prosecute the said appeal to effect and pay all costs and damages if it failed to make said appeal good, "as well as all damages and profits resulting from its manufacture and sale of the infringing sweepers after the date of the said decree." This only operated to stay or suspend the injunction pending the appeal. It had no effect or operation as a license to defendant. The status of the defendant was simply that of persons engaged in infringing and not restrained by operation of the injunction. — *Bissell v. Goshen*, 72 Fed. 545; 19 C. C. A. 25.

§ 143. Supreme Court.

In order to invoke the exercise of our jurisdiction in the instruction of the circuit court of appeals as to the proper decision of questions or propositions of law arising in the classes of cases mentioned, it is necessary that such questions or propositions should be clearly and distinctly certified, and that the certificate should show that the instruction of this court as to their proper decision is desired. — *Columbus v. Robbins*, 148 U. S. 266; 37 L. Ed. 445; 13 S. Ct. 594.

An appeal to the Supreme Court does not lie in an action to compel the Commissioner to issue a patent, because it neither involves a question affecting a patent right nor a sum of \$5000. — *Durham v. Seymour*, 161 U. S. 235; 40 L. Ed. 682; 16 S. Ct. 452.

This court will not consider questions not presented to and passed upon by the lower court. — *U. S. v. Am. Bell Tel.* 167 U. S. 224; 42 L. Ed. 144; 17 S. Ct. 809.

Statement: The examiners-in-chief affirmed the decision of the primary examiner, "requiring a division of these claims for an art and for an independent machine used to perform the art;" and on appeal the Commissioner affirmed the examiners-in-chief in part only. Rehearing was denied and an appeal taken to the court of appeals D. C., which affirmed the decision of the Commissioner. An appeal and a writ of error were allowed, the court stating: "We are inclined to the view that this case is not appealable to the Supreme Court of the United States, but, as the question has never been directly decided, so far as we are advised, we shall grant the petition in order that the question of the right of appeal in such a case may be directly presented for the determination of the court of last resort." *Held*: The opinion or decision of the court, reviewing the Commissioner's decision, is not final, because it does not preclude any person interested from contesting the validity of the patent in court; and, if the decision of the Commissioner grants the patent, that is the end of the matter as between the government and the applicant; and if he refuses it, and the court of appeals sustains him, that is merely a qualified finality, for, as we have seen, the decision of that court may be challenged generally and a refusal of patent may be reviewed and contested by bill as provided. — *Frasch v. Moore*, 211 U. S. 1; L. Ed.; 29 S. Ct. 6.

Steinmetz v. Allen, 192 U. S. 543; *Butterworth v. U. S.* 112 U. S. 60; *Rousseau v. Brown*, 21 App. D. C. 73.

The rule of *Frasch v. Moore*, 211 U. S. 1, followed in *Johnson v. Mueser*, 212 U. S. 283; L. Ed.; 29 S. Ct. 390.

It is believed by this court that the practice of certification is intended to be availed of only when the certifying court is in doubt about the specific question or questions certified. — *Sigafus v. Porter*, 85 Fed. 689; 29 C. C. A. 391.

§ 144. Miscellaneous Rules.

Defenses mentioned in a brief but not raised upon the argument will not be considered here. — *Agawam v. Jordan*, 74 U. S. 583; 19 L. Ed. 177.

Where the record shows that complainant declared infringement for certain claim or claims and waived the others, only the claims declared upon will be considered on appeal. — *Doze v. Smith*, 69 Fed. 1002; 16 C. C. A. 581.

It appears that, where the validity of a patent is the main question in a co-pending suit, the court will, if possible so to do, leave such question to a full determination in such co-pending suit, see *Hunt v. Milwaukee*, 148 Fed. 220; 78 C. C. A. 116.

Upon this appeal the appellant only has appeared. Being, therefore, without the benefits accruing from a presentation of both sides of the case, we deem it advisable only to consider the particular grounds upon which the Circuit Court acted, and shall not consider ourselves precluded from examining anew other questions and reaching a different conclusion should another case be fully presented. — *Hartford v. Hollander*, 163 Fed. 948; C. C. A.

ARBITRATION.

Decision of Arbitrator — Force and | Effect § 145

§ 145. Decision of Arbitrator — Force and Effect.

Nothing is exhibited in the record to show that the arbitrator erred in the construction of the patent, and if he did not and his finding as to the character of the machine manufactured by the respondent is correct, it is settled law that his decision is correct. — *Reedy v. Scott*, 90 U. S. 352; 23 L. Ed. 109.

Gill v. Wells, 89 U. S. 1; *Gould v. Rees*, 15 Wall. 194; *Vance v. Campbell*, 1 Black. 428; *Prouty v. Ruggles*, 16 Pet. 341; *Carver v. Hyde*, 16 Pet. 514; *Brooks v. Fiske*, 15 How. 212; *Stimpson v. R. R.* 10 How. 329.

ART.

Statutory Provision § 146
Definition § 147

| Art and Process § 148
| See — Process § 813

§ 146. Statutory Provision.

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof * * *. — 4886, R. S.

§ 147. Definition.

No one has, and I think no one ever will, give a satisfactory definition of the word "art" as used in the Patent Statute. The Supreme Court has thus defined it by illustration:

In this art — or, what is the same thing under the patent law, this process, this way of transmitting speech — electricity, one of the forces of nature, is employed; but electricity, left to itself, will not do what is wanted. The art consists in so controlling the force as to make it accomplish the purpose. It had long been believed that if the vibrations of air caused by the voice in speaking could be reproduced at a distance by means of electricity, the speech itself would be reproduced and understood. How to do it was the question. Bell discovered that it could be done by gradually changing the intensity of a continuous electric current, so as to make it correspond exactly to the changes in the density of the air caused by the sound of the voice. This was his art. He then devised a way in which these changes of intensity could be made and speech actually transmitted. Thus his art was put in practical use. — *Telephone Cases*, 126 U. S. 1; 31 L. Ed. 863; 8 S. Ct. 778.

But the thing which Bell patented was a machine — a telephone. Is an "art," therefore, a "machine?" The process of making nitro-glycerine was a new and useful "art," and patentable; and the article itself, as a manufacture, was patentable. Aerial navigation is a new and useful art; but it is self-evident that no one will be granted a patent on the art of flying.

Many patents will be issued on machines used in the art. Nor does it help matters to say that it means the "mechanical arts," for so defined, in spite of the qualifications of novelty and utility imposed by the statute, it is still too broad; for it would include many things that are merely mechanical skill. We have all of us seen persons possessed of some remarkable mechanical art, such as turning an almost perfect sphere, or giving a tool a remarkably fine temper, or dyeing an article with remarkable exactness. These are mechanical arts — arts of individuals — but they are not, per se, patentable.

And yet, the use of the term in the statute has been a most desirable one, since its very vagueness has produced a resiliency in the otherwise hard-and-fast terms of the statute, and has enabled the Patent Office and the courts to reward those pioneers whose basic discoveries have often been too large, too simple, too generic to be limited to a specific machine or the specific steps of a process. It would not be far from the truth to say, that the term "art," as used in the statute, has opened the way for the courts to build up the doctrine of equivalents and establish that aristocracy among inventors known as "Pioneers."

§ 148. Art and Process.

We think that the method or art covered by the patent is patentable as a process, irrespective of the apparatus or instrumentality for carrying it out. — *New Process v. Maus*, 122 U. S. 413; 30 L. Ed. 1193; 7 S. Ct. 1304.

Corning v. Burden, 56 U. S. 252; *Cochrane v. Deener*, 94 U. S. 780; *Tilghman v. Proctor*, 102 U. S. 707.

The patent for the art does not necessarily involve a patent for the particular means employed for using it. Indeed, the mention of any means, in the specification or descriptive portion of the patent, is only necessary to show that the art can be used; for it is only useful arts — arts which may be used to advantage — that can be made the subject of a patent. The language of the statute is that "any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter" may obtain a patent therefor. Thus an art — a process — which is useful is as much the subject of a patent as a machine, manufacture or composition of matter. — *Telephone Cases*, 126 U. S. 1; 31 L. Ed. 863; 8 S. Ct. 778.

Corning v. Burden, 56 U. S. 252; *Cochrane v. Deener*, 94 U. S. 780; *Tilghman v. Proctor*, 102 U. S. 708; *New Process v. Maus*, 122 U. S. 413.

It is manifest that the subject-matter of the claims (a system for hotel and restaurant checks) is not a machine, manufacture or composition of matter. If within the language of the statute at all, it must be as a "new and useful art." One of the definitions given by Webster of the word "art" is as follows: "The employment of means to accomplish some desired end; the adaptation of things in the natural world to the uses of life; the application of knowledge or power to practical purposes." In the sense of the patent law, an art is not a mere abstraction. A system of transacting business disconnected from the means for carrying out the system is not, within the most liberal interpretation of the term, an art. Advice is not patentable. — *Hotel v. Lorraine*, 160 Fed. 467; 87 C. C. A. 451.

Fowler v. City of N. Y., 121 Fed. 747.

ASSIGNMENT.

Statutory Provisions § 149

Definition § 150

Action to Compel § 151 (*see* § 24)

Before Patent § 152

Conditions and Reservations § 153

Construction § 154

Copartnership § 155 (*see* § 270)

Corporation § 156 (*see* § 271)

Debtor and Creditor § 157
 Evidence § 158 (*see* § 388)
 Execution § 159
 Future Inventions
 Legality § 160
 Recording § 161
 What are Not § 162
 Miscellaneous Rules § 163
 Interests Assignable § 164
 License § 165 (*see* § 749)
 Notice
 Bona Fide Purchaser § 166
 Constructive § 167
 Parol § 168
 Part Interest § 169

Pendente Lite § 170
 Power of Attorney § 171
 Recording § 172 (*see* § 388)
 Reissue § 173 (*see* § 869)
 Specific Performance § 174
 Territorial § 175
 Miscellaneous Rulings § 176
See — Attorneys § 179; *Bankruptcy*
 § 182; *Employer and Employee* §§
 365-6; *Evidence* § 394; *Infringe-*
ment §§ 449-51, 509-13; *License*
 § 749; *Licensor and Licensee* § 765;
Mortgage § 778; *Royalties* § 897;
State Statutes § 920; *Title* § 925

§ 149. Statutory Provisions.

Sections 4895, 4897, 4898, 4899, 4934 and 5046 provide for the assignment and recording assignments of inventions and of letters patent.

§ 150. Definition.

The monopoly thus granted is one entire thing and cannot be divided into parts except as authorized by law.

The patentee or his assigns may, by instrument in writing, assign, grant and convey, either (1) the whole patent comprising the exclusive right to make, use and vend the invention throughout the U. S.; or, (2) an undivided part or share of that exclusive right; or, (3) the exclusive right under the patent within and throughout a specified part of the United States. (Rev. Stat. sec. 4898.) A transfer of either of these three kinds of interests is an assignment properly speaking, and vests in the assignee a title in so much of the patent itself, with a right to sue infringers; in the second case jointly with the assignor, in the first and third cases in the name of the assignee alone. Any assignment or transfer short of one of these, is a mere license, giving the licensee no title in the patent; and no right to sue at law in his own name for infringement. — *Waterman v. Mackenzie*, 138 U. S. 252; 34 L. Ed. 923; 11 S. Ct. 334.

R. S. sec. 4919; *Gayler v. Wilder*, 51 U. S. 477; *Moore v. Marsh*, 74 U. S. 515.

A grant, transfer, or conveyance of these exclusive rights throughout the United States, or a grant of an undivided part of these exclusive rights, or a grant of these exclusive rights throughout a specified part of the United States, is an assignment of an interest in the patent, by whatever name it may be called. A grant, transfer, or conveyance of any right or interest less than these is a license. — *Paulus v. Buck*, 129 Fed. 594; 64 C. C. A. 162.

Waterman v. Mackenzie, 138 U. S. 252; *Union v. Johnson*, 61 Fed. 940; *Pickhardt v. Packard*, 22 Fed. 530.

An assignment which is neither an undivided interest in the whole patent, nor of an exclusive right within a certain territory, is a mere license. — *Pope v. Gormully*, 144 U. S. 238; 36 L. Ed. 420; 12 S. Ct. 637.

Whether a transfer of a particular right or interest under a patent is an assignment or license does not depend upon the name by which it calls itself, but upon the legal effect of its provisions. — *Waterman v. Mackenzie*, 138 U. S. 252; 34 L. Ed. 923; 11 S. Ct. 334.

Wilson v. Rousseau, 45 U. S. 646; *Gayler v. Wilder*, 51 U. S. 477; *Mitchell v. Hawley*, 83 U. S. 544; *Hayward v. Andrews*, 106 U. S. 672; *Oliver v. Rumford*, 109 U. S. 75.

§ 151. Action to Compel.

Unquestionably, a contract for the purchase of any portion of a patent right may be good as between the parties as a license, and enforced as such in the courts of justice. — *Gayler v. Wilder*, 10 How. 477; 13 L. Ed. 504.

Where the invention belonged to the employer and the employee obtained the patent by fraud in his own name, an action to compel a surrender will lie. — *Appleton v. Bacon*, 67 U. S. 699; 17 L. Ed. 338.

The clause of the decree below, appointing a trustee to execute an assignment, if the patentee should not himself execute one as directed by the decree, was clearly within the chancery powers of the court as defined by the statute of Maryland. — *Ager v. Murray*, 105 U. S. 126; 26 L. Ed. 942.

As the patent upon plaintiff's own showing conferred no title or right upon the defendant, a court of equity will not order him to assign it to the plaintiff — not only because that would be to decree a conveyance of property in which the defendant has, and can confer, no title; but also because its only possible value or use to the plaintiff would be to enable him to impose upon the public by asserting rights under a void patent. — *Kennedy v. Hazelton*, 128 U. S. 667; 32 L. Ed. 576; 9 S. Ct. 202.

Post v. Marsh, L. R. 16 Ch. Div. 395; *Oldham v. James*, 14 Irish Ch. 81.

If it appears by the bill or otherwise, that the want of title (even if caused by the defendant's own act, as by his conveyance to a bona fide purchaser) was known to the plaintiff at the time of beginning the suit, the bill will not be retained for assessment of damages, but must be dismissed and the plaintiff left to his remedy at law. — *Kennedy v. Hazelton*, 128 U. S. 667; 32 L. Ed. 576; 9 S. Ct. 202.

Columbine v. Chichester, 2 Phil. 27; *Ferguson v. Wilson*, L. R. 2 Ch. 77; *Morse v. Elmendorf*, 11 Paige, 277; *Milkman v. Ordway*, 106 Mass. 232, 256.

The proceedings supplementary to execution, as authorized by the laws of New York, are a substitute for, and in all respects have the same force and effect as, an ordinary creditor's bill. The receiver, in such proceedings, becomes invested with the title to all the property — equitable as well as legal — belonging to the judgment debtor at the time of their institution; and the court has the power of a court of equity in such a suit to compel him to appropriate his property, including that out of the state (see *Fenner v. Sanborn*, 37 Barb. 610), and transfer it to the receiver towards the satisfaction of the judgment. In *Ager v. Murray*, 105 U. S. 126, it was decided that, notwithstanding a patent cannot be seized and sold on execution, it can be reached by a creditor's bill, and applied to satisfy a judgment against the owner, and a transfer by him be compelled for that purpose by the court. Although in the present case the court did not — as it might have done — compel Newton to make a written transfer to the receiver of his title to the patent, it is entirely clear that any equitable title which he may have had vested in the receiver, and passed by the sale to Vermilyea, and from Vermilyea to the defendant, by the assignment from Vermilyea. Newton never acquired anything but an equitable title to the patent, the right to compel a reformation of the agreement of March 6, 1889. He did not acquire the legal title, because, without an assignment such as the statute requires to effect the transfer of a patent interest, that title remained in the prior owner, the present defendant. *Gayler v. Wilder*, 10 How. 498. As that equitable title had, at the date of his assignment to Dooley, passed to the receiver, and the complainant's title is derived through that assign-

ment, she took nothing by the instrument. — *Newton v. Buck*, 77 Fed. 614; 23 C. C. A. 355.

Facts: Defendant was employed by complainant as engineer in charge of its plant to manufacture and to improve its product. He was paid from \$4000 to \$10,000 a year for his services. He made several improvements and assigned several patents thereon to complainant absolutely; in fact he made no claim to the title of any of his improvements until about the time he left the employ of the complainant, when he claimed as his own and refused to assign title to the six inventions in suit. There was no written agreement between the parties, and no parol agreement specifically agreeing to assign title was proved. *Held*: We do not think that the complainant here, in the absence of express contract to that effect, from the mere relation of employer and employee, in connection with the facts and circumstances disclosed in the record, is entitled, in equity and good conscience, to an assignment from the defendant of his whole right, title and property in the inventions in question. If entitled to anything, complainant is only entitled to a shop right or license that would enable it to use these inventions without paying a royalty therefor, a right which does not strip defendant of his entire property right in the product of his own inventive faculty. It is by distinguishing between claims for mere shop rights or license, and claims for the entire and exclusive property right in the inventions of the employee, that the cases cited are to be profitably read. This distinction has been observed in many cases, both federal and state. — *Pressed Steel v. Hansen*, 137 Fed. 403; 71 C. C. A. 207.

Opinion by Gray, C. J., Dallas, C. J. concurring; and Acheson, C. J. dissenting and holding that the facts bring the case within the rule in *Solomons v. U. S.*, 137 U. S. 342; *McAleer v. U. S.*, 150 U. S. 424; *Gill v. U. S.*, 160 U. S. 426.

Citg. and reviewing fully main authorities,

McClurg v. Kingsland, 1 How. 202; *Dalzell v. Dueber*, 149 U. S. 315; *Lane v. Locke*, 150 U. S. 193; *Bensley v. N. W. Horsenail Co.* 26 Fed. 250; *Hermann v. Hermann*, 29 Fed. 92; *Boston v. Allen*, 91 Fed. 248; *Joliet v. Dice*, 105 Ill. 649; *Fuller v. Bartlett*, 68 Wis. 73.

Note: This decision is conclusive, it seems to me, upon this point: Regardless of the *character* of the services rendered by the employee, in the absence of a written agreement or a parol agreement unmistakably proven by which the employee agreed to pass the title of his inventions to his employer, such employer will secure only a shop right or license; and that a sharp distinction must be drawn between the ordinary conditions of private employment and the special conditions of government employment, such as disclosed in the *Solomons*, *McAleer*, and *Gill* cases above cited by Acheson, J. dissenting.

§ 152. Before Patent.

The thing to be assigned is not the mere parchment on which the grant is written. It is the monopoly which the grant confers; the right of property which it creates. And when the party has acquired an inchoate right to it, and the power to make that right perfect and absolute at his pleasure, the assignment of his whole interest, whether executed before or after the patent is issued is equally within the provisions of the act of Congress. — *Gayler v. Wilder*, 10 How. 477; 13 L. Ed. 504.

It is well settled that a recorded assignment of a perfected invention, made before a patent has been issued, carries with it the patent when it is issued. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

Gayler v. Wilder, 10 How. 477.

While it is, perhaps, not necessary to decide whether in any case a sale of an invention which is never patented carries with it anything of value, we are of opinion that the rights growing out of an invention may be sold, and that in the present case the sale, with the right to use it in connection with the existing patent and its reissue or renewals, protects defendants from liability. — *Hammond v. Mason*, 92 U. S. 724; 23 L. Ed. 767.

Such an instrument, though executed before the patent is granted, transfers the legal title to the assignee. — *Hendrie v. Sayles*, 98 U. S. 546; 25 L. Ed. 176.

Gayler v. Wilder, 10 How. 477; *Rathbone v. Orr*, 5 McLean, 131; *Rich v. Lippincott*, 2 Fish. 1; *Herbert v. Adams*, 4 Mas. 15; *Dixon v. Moyer*, 4 Wash. 72.

An assignment of a patent is good if made before the patent is actually obtained and should not be treated as a sale of personal property that was not in existence. — *Brush v. California*, 52 Fed. 945; 3 C. C. A. 368.

Gayler v. Wilder, 10 How. 477; *Littlefield v. Perry*, 21 Wall. 205.

§ 153. Conditions and Reservations.

It would seem that conditions and reservations stated in the recorded assignments are sufficient to charge purchasers with notice as to such matters. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

The concluding provision, that the net profits arising from sales, royalties, or settlements, or other sources, are to be divided between the parties to the assignment so as to give the patentee one fourth thereof, does not in any respect, modify or limit the absolute transfer of title. It is a provision by which the consideration for the transfer is to be paid to the grantor out of the net profits made; it reserves to him no control over the patents or their use or disposal, or any power to interfere with the management of the business growing out of their ownership. The clause appointing the assignees attorneys of the grantor, with authority to use his name whenever they deem proper in such management, does not restrict in any way the power of the assignee after the transfer of the property. — *Rude v. Westcott*, 130 U. S. 152; 32 L. Ed. 888; 9 S. Ct. 463.

Tilghman v. Proctor, 125 U. S. 136.

An adequate assignment is not defeated by a subsequent conditional agreement, conditioning the assignment with specified requirements, where such conditions have been fulfilled. — *Boesch v. Gräff*, 133 U. S. 697; 33 L. Ed. 787; 10 S. Ct. 378.

An assignment of the entire patent, or of an undivided part thereof, or of the exclusive right under the patent for a limited territory may be either absolute or by way of mortgage and liable to be defeated by non performance of a condition subsequent, as clearly appears in the provision of the Statute, that "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." R. S. sec. 4898. — *Waterman v. Mackenzie*, 138 U. S. 252; 34 L. Ed. 923; 11 S. Ct. 334.

The title was conveyed to complainant subject only to certain conditions, and the assignor had no more right to it than a stranger so long as the conditions should remain unbroken. If the complainant should fail to keep his covenants, then the conditions would be broken, and the property would revert. Until this event happens the complainant has the right to protect

his interests by suing infringers of the patent. — *Platt v. Fire Extinguisher*, 59 Fed. 897; 8 C. C. A. 357.

Littlefield v. Perry, 21 Wall. 205.

§ 154. Construction.

When there is doubt as to the proper construction of an instrument, the intention of the parties is entitled to great consideration. But when its meaning is clear in the eye of the law, the error of the parties cannot control its effect. — *Railroad v. Trimble*, 77 U. S. 367; 19 L. Ed. 949.

The assignment transferred the patent together with alterations, improvements for the terms for which patents had theretofore been or might thereafter be granted. *Held*: to mean precisely what it said. — *Railroad v. Trimble*, 77 U. S. 367; 19 L. Ed. 949.

Gayler v. Wilder, 10 How. 477; distinguishing *Wilson v. Rousseau*, 4 How. 682.

An assignment of an interest in an invention secured by letters patent, is a contract, and, like all other contracts, is to be construed so as to carry out the intention of the parties to it. — *Nicholson v. Jenkins*, 81 U. S. 452; 20 L. Ed. 777.

Two contracts were made at the same time. The one, on its face assigning the patent but referring to the other agreement as part of the same contract, was recorded. The other was not. *Held*: for the purpose of ascertaining the intention of the parties in making their contract, the two instruments, executed as they were at the same time, and each referring to the other are to be construed together. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

The suggestion that "the test" of whether title passed by the assignment in question is "whether such paper could be recorded" under sec. 4898 has been attentively considered, but cannot be accepted. That section provides that "every patent * * * shall be assignable in law by an instrument in writing," and makes an assignment void for omission to record only "as against any subsequent purchaser or mortgagee," etc. In this instance we have a writing which, as was said by the learned judge below, is an assignment, in terms, "of all the property of the company executing it, * * * specifically including also 'the good will, patents, trademarks'" etc. Of course, the word "patents" included every patent which was assignable by the assignor (*Herring-Hall-Marvin v. Hall*, 208 U. S. 554); and with respect to the parties to this cause, it is immaterial whether the instrument was or was not eligible for record. — *Delaware v. Shelby*, 160 Fed. 928; 88 C. C. A. 110.

To preserve their joint property and prevent its practical destruction by co-owners, it is imperative that all should be permitted to simply vest the legal title in one without imposing any active duties on such holding trustee, and this shows that, while there are no express duties for the trustee to perform, it by no means follows the trust is a dry or inactive one. As holder of the legal title he can bring suit, enjoin infringers from destroying the patent, and the mere holding of the legal title in trust per se preserves the patent for the common good and prevents its destruction by each co-owner. We are of opinion that these views have actuated patent practitioners in thus vesting the legal titles to patents in trustees, and that a holding that such an instrument, contrary to its plain intent, executed itself and left the equitable owners as free to use and license as before would be most unfortunate in its unsettling effects. The intent and effect of this instrument we therefore hold was to vest and retain the legal title to this

patent in McDuffee, as trustee; but the equitable ownership thereof remained in his *cestuis que trustent*, and without their consent he could not convey such legal title, or any part thereof. — *McDuffee v. Hestonville*, 162 Fed. 36; 89 C. C. A. 76.

Duncan v. Jandow, 82 U. S. 165; *Flitercraft v. Com.* Title, 211 Pa. 119.

§ 155. Copartnership.

An assignment of a patent by one of two copartners to the other, for the use of the copartnership terminates with the copartnership. — *Denning v. Bray*, 61 Fed. 651; 10 C. C. A. 6.

We think the effect of the assignment was to transfer a one-half interest to the other partner, nothing appearing to show that the partners stood upon unequal terms. — *Canada v. Michigan*, 124 Fed. 486; 61 C. C. A. 194.

§ 156. Corporation.

Assignments of patents made by corporations need not be under seal. — *Gottfried v. Miller*, 104 U. S. 521; 26 L. Ed. 851.

Bank v. Patterson, 7 Cranch, 299; *Fleckner v. Bank*, 8 Wheat. 338; *Turnpike v. Hay*, 7 Mass. 102; *Dunn v. Rector*, 14 Johns, 118; *Kennedy v. Ins. Co.* 3 Har. & J. 367; *Stanley v. Hotel*, 13 Me. 51; *Fanning v. Gregorie*, 16 How. 524; *Mott v. Hicks*, 1 Cow. 513; *Bowen v. Morris*, 2 Taunt. 374; *Shelton v. Darling*, 2 Conn. 435; *Brockway v. Allen*, 17 Wend. 40.

The attachment of the stock of a stockholder in a corporation does not in any way prevent such corporation from executing an assignment of a patent. — *Gottfried v. Miller*, 104 U. S. 521; 26 L. Ed. 851.

It is alleged that the conveyance from the Firm Company to Firm was void by reason of the N. Y. statute which so declares to be certain transfers to its officers for the payment of any debts. We have been cited to no decision of the courts of that state holding that when the transfer has been made, and is unchallenged by the corporation, its receiver, its judgment creditors, or any stockholder, the transfer shall, at the instance of a stranger in interest and title, and against an innocent purchaser from the corporation's grantee, be adjudged absolutely void. In the absence of such construction, we are of the opinion that the title acquired by the complainant was, if, indeed, questionable, not void, but voidable, and, in the absence of any step to avoid it, must, for the purpose of this case, be deemed to vest the legal title to the patent in question in the complainant. — *Goss v. Scott*, 108 Fed. 253; 47 C. C. A. 302.

§ 157. Debtor and Creditor.

Under the copyright law, the sale on execution of a copper plate does not entitle the purchaser to produce and sell the copyrighted matter. But the copyright may be reached by a creditor's bill. — *Stephens v. Cady*, 14 How. 528; 14 L. Ed. 528.

See *Stevens v. Gladding*, 58 U. S. 447, to same effect.

It is within the general jurisdiction of a court of chancery to assist a judgment creditor to reach and apply to the payment of his debt any property of the judgment debtor, which by reason of its nature only, and not by reason of any positive rule exempting it from liability from debt, cannot be taken on execution at law; as in the case of trust property in which the judgment debtor has the entire beneficial interest, of shares of a corporation, or of choses in action. — *Ager v. Murray*, 105 U. S. 126; 26 L. Ed. 942.

McDermutt v. Strong, 4 Johns. Ch. 687; *Spader v. Davis*, 5 Johns. Ch. 280; *Hadden v. Spader*, 20 Johns. Ch. 554; *Edmeston v. Lyde*, 1 Paige, 637; *Wiggin v. Heywood*, 118 Mass. 514; *Sparhawk v. Cloon*, 125 Mass. 263; *Daniels v. Eldredge*, 125 Mass. 356; *Dake v. Rice*, 130 Mass. 410; *Stephens v. Cady*, 14 How. 528; *Stevens v. Gladding*, 17 How. 447.

A patent or copyright which vests the sole and exclusive right of making, using and vending the invention or of publishing and selling the book, in the person to whom it has been granted by the government, as against all persons not deriving title through him, is property, capable of being assigned by him at his pleasure, although his assignment, unless recorded in the proper office, is void against subsequent purchasers or mortgagees for a valuable consideration without notice. R. S. 4884, 4898, 4952, 4955. And the provisions of the patent and copyright Acts, securing a sole and exclusive right to the patentee, do not exonerate the right and property thereby acquired by him, of which he receives the profits, and has the absolute title and power of disposal, from liability to be subjected by suitable judicial proceedings to the payment of his debts. — *Ager v. Murray*, 105 U. S. 126; 26 L. Ed. 942.

There are decisions in the circuit courts that an assignee in insolvency, or a receiver, of all the property of a debtor, appointed under the laws of the state, does not, by virtue of the general assignment or apportionment merely, without any conveyance made by the debtor or specifically ordered by the court acquire a title in patent rights. But in *Ashcroft v. Walworth*, 1 Holmes, 152, Judge Shepley clearly intimated that the courts of the state might have compelled the debtor to execute such a conveyance. And the highest courts of New York and California have affirmed the power, upon a creditor's bill, to order the assignment and sale of a patent right for the payment of the patentee's judgment debts. — *Ager v. Murray*, 105 U. S. 126; 26 L. Ed. 942.

Gordon v. Anthony, 16 Blatchf. 234; *Gillett v. Bate*, 86 N. Y. 87; *Bank v. Robinson*, 57 Cal. 520.

The present license contained no words which show that it was intended to be assigned, and was purely a personal license. Consequently the receiver could not acquire it. — *Waterman v. Shipman*, 55 Fed. 982; 5 C. C. A. 371.

§ 158. Evidence.

The appellee produced a license in its possession, absolute on its face and without any limitation or condition. The burden of proof is upon the appellants to show that it was delivered as an escrow. — *Mellon v. D. L. & W.*, 154 U. S. 673; 26 L. Ed. 929; 14 S. Ct. 1194.

Certified copies of patent office records of instruments filed for record are not prima facie proof of either the execution or the genuineness of the original. The assignment of a patent is not a public document, but is merely a private writing. There is no statutory provision requiring it to be recorded in the patent office. Section 4898 R. S. permits this to be done for the protection of the assignee against a subsequent bona fide purchaser or mortgagee. The section does not make the recorded instrument evidence, does not require the assignment to be executed in the presence of any public officer, or to be acknowledged or authenticated in any way before recording, and does not provide or contemplate that it shall remain subsequently in the custody of the office. It devolves upon the patent office merely the clerical duty of recording any instrument which purports to be the assignment of a patent. We are aware of no principle which gives to such a record

the effect of primary evidence, or of prima facie proof of the execution or the genuineness of the original document. — *Mayor v. American*, 60 Fed. 1016; 9 C. C. A. 336.

Disapproving and reviewing in substance,

Brooks v. Jenkins, 3 McLean, 432; *Parker v. Haworth*, 4 McLean, 370; *Lee v. Blandy*, 1 Bond. 361; *Dederick v. Agricultural*, 26 Fed. 763; *National v. American*, 55 Fed. 488; *Approving Paine v. Trask*, 56 Fed. 233.

Section 4898 does not require that any instrument in the chain of title to a patent shall be recorded, but all such assignments may be recorded. The sense — the essential significance and intent — of this section is that the record or official copy of any assignment shall give to any person interested the prima facie assurance that an original assignment was made in terms as shown in the record, that such instrument was subscribed as shown, that it was delivered, that the signature thereto is the genuine signature of the assignor, and that such assignor had an assignable interest according to the purport of the instrument. The record of assignments in the patent office is a record "belonging to the patent office," within the literal terms of sec. 892. But, in the absence of that section, and on the general principles of evidence, a paper purporting to be a copy of a record in the patent office could be proven to be such copy by the sworn testimony of the person who made it, or of a person who had compared it with the original record in the patent office. The view here stated as to the prima facie probative force of a copy from the record of an assignment in the patent office has been substantially taken in many reported decisions. *Brooks v. Jenkins*, Fed. Cas. No. 1,953; *Parker v. Haworth*, Fed. Cas. No. 10,738; *Lee v. Blandy*, Fed. Cas. No. 8,182; *Dederick v. Agricultural Co.*, 26 Fed. 763; *National v. American*, 55 Fed. 488. The only question presented by the record is the prima facie probative force of the patent office record of an assignment. In *New v. American*, 60 Fed. 1016, the federal court of appeals at N. Y., following an obiter dictum by the federal court of appeals at Boston in *Paine v. Trask*, 56 Fed. 233, decided that under the sections above quoted from the Revised Statutes a certified copy from the records in the patent office would not prima facie prove the assignment without a further showing as to the execution of the original instrument. It is argued that the statute does not require an assignment to be recorded, that the original is not left in the custody of the patent office, and that no certificate of acknowledgment or proof of execution is required by the statute to be made in connection with such instrument. But the line of reasoning upon which the courts have developed the rule already stated does not involve any one of the conditions named. The statute makes it the duty of the commissioner of patents to record assignments that are genuine. He has no authority to record a spurious instrument. A spurious assignment recorded in the patent office would not be in law a record of that office. The record of an assignment is, in law, tantamount to a finding or certificate by the commissioner that the original is genuine. It matters not that the commissioner may act on the mere assumption that whatever paper of this kind is presented for record is genuine. He is a public officer, charged by law with the duty of recording only such as are genuine. The argument that a spurious assignment may be mistakenly put upon the record might be urged against the policy of the statute, but not against the obvious sense of it. Such an argument might also be urged against the ordinary statutes for recording deeds. This court cannot accede to the view announced in *N. Y. v. American*, supra. The rule as understood and acted upon prior to that decision, is considered by this court to be law. For 52 years (*Brooks v. Jenkins*, supra, was decided in 1844) that rule has prevailed. As pointed out by Judge Coxe in *National v. American*, supra, a holding that the patent office record of an assignment shall have no force as prima facie proof of

the original writing would often entail great and useless expense, if not an entire defeat of the rights of the complainant in a patent case. A spurious or counterfeit assignment put on record in the patent office would be easily and certainly detected by any person interested in the inquiry, especially in the case of any patent of real value. The possible gain from such a rascality would not be worth the risk. The complainant in a patent suit is ordinarily making actual use of the patent. What may be called his possession of the patent property is usually open and notorious. It is no hardship upon an infringer who, claiming no right in himself, proposes to dispute the showing of the patent office on the matter of title, to require from him such proof as may at least raise a fair presumption that the original of some assignment shown of record in the chain of title is spurious. — *Standard v. Crane*, 76 Fed. 767; 22 C. C. A. 549.

Woods dissenting.

§ 159. Execution.

Need not be under seal. — *Gottfried v. Miller*, 104 U. S. 521; 26 L. Ed. 851.

It is always open to show that an instrument produced in evidence, whether in an action at law or a suit in equity in support of a claim or defense, was never executed by the person whose signature it bears. — *Marsh v. Nichols*, 128 U. S. 605; 32 L. Ed. 538; 9 S. Ct. 168.

Section 5 of the act of Mar. 3, 1897 is a statute which was intended to declare the evidential effect to be given to acknowledgments before a notary, after a given date, without special reference, however, to the time when the acknowledgment was taken; and in the absence of any specific provision that it should apply only to acknowledgments taken subsequently to Jan. 1, 1898, we perceive no sufficient reason why it should be limited in its operation to acknowledgments so taken. — *Lanyon v. Brown*, 115 Fed. 150; 53 C. C. A. 354.

DeLaval v. Vermont, 109 Fed. 813.

Section 4898 of the Revised Statutes, as amended by Act March 3, 1897, simply provides a new method of proof. The evident intent of the act was to substitute proof of execution by acknowledgment, instead of by the production of the subscribing witness, if there were one, or proof of the handwriting of the assignor, if there were no subscribing witness. In *DeLaval v. Vermont*, 109 Fed. 813 it was held that assignments which were acknowledged before the passage of that act were admissible in evidence thereunder, and that the act referred "to the time," to use the language of the court, "when the acknowledgment is produced in evidence, rather than to the time when it was taken." The rule thus laid down was approved by the Circuit Court of Appeals for the Eighth Circuit in *Lanyon v. Brown*, 115 Fed. 150. — *Murray v. Continental*, 149 Fed. 989; 79 C. C. A. 499.

§ 160. Future Inventions — Legality.

An assignment including "with all the improvement which he hath made or shall make in the same" is a covenant which bound the inventor to convey his improvement. Though the assignment was not made until several years after it was patented the assignees were equitably entitled to it before. — *Troy v. Corning*, 14 How. 193; 14 L. Ed. 383.

An assignment of an unperfected invention, with all improvements upon it the inventor may make, is equivalent in equity to an assignment of the perfected results. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

An assignment of an invention and of future improvements to be made passes title to the improvements. — *Regan v. Pacific*, 49 Fed. 68; 1 C. C. A. 169.

Littlefield v. Perry, 21 Wall. 226.

An agreement to assign future inventions is valid. — *Regan v. Pacific*, 49 Fed. 68; 1 C. C. A. 169.

Curtis Sec. 160; Robinson Sec. 771.

The defense is set up that such contracts for an indefinite period, covering inventions to be afterwards made, are against public policy. On the other hand, whether based on agreements for employment or other valuable considerations, such contracts have been extensively made, and have never been doubted until of late. They are essential to the business of the contracting parties, and are not unjust. A person may purchase an invention, and pay therefor a very large sum, and proceed to make use of it. The inventor, according to a practice not uncommon, may subsequently overlap that invention by improvements which, though small, may be enough, in these days of sharp competition, to build up a successful hostile business. — *Reece v. Fenwick*, 140 Fed. 287; 72 C. C. A. 39.

Thibodeau v. Hildreth, 124 Fed. 892.

Parties may lawfully assign inventions not yet patented, and even future inventions, so far as such future inventions are tributary to the inventions assigned. — *American v. Pungs*, 141 Fed. 923; 73 C. C. A. 157.

§ 161. Future Inventions — Recording.

An agreement to "license, grant and convey" future inventions is not an assignment, is not recordable and gives the grantee only an equitable right subject to defeat by an assignment to a bona fide purchaser for value. — *Regan v. Pacific*, 49 Fed. 68; 1 C. C. A. 169.

That an assignment of a patent, together with any future improvements thereon, is recordable and operative as notice to subsequent assignees of patents for improvements, may be conceded. — *National v. New Columbus*, 129 Fed. 114; 63 C. C. A. 616.

Littlefield v. Perry, 21 Wall. 205; *Aspinwall v. Gill*, 32 Fed. 697.

The patentee had previously assigned an interest in his patent, and the patent had issued to him and his assignees. Subsequent to issue the patentee executed an assignment of a part interest in all future inventions. Held: Near having by his prior recorded assignments, which did not include improvements, conveyed to Reynolds the one undivided third in all existing patents, and there being no application pending for any patent, there was nothing upon which this document could operate which entitled it to registration as an assignment, grant or conveyance under sec. 4898 R. S. What we decide is that an instrument which was not intended to convey any present interest in any existing patent is not an "assignment, grant, or conveyance," within the meaning of the statute, and that its registration did not operate as constructive notice to the complainant. — *National v. New Columbus*, 129 Fed. 114; 63 C. C. A. 616.

Rob. Pat. secs. 411, 769, 785; *Wright v. Randel*, 8 Fed. 591; *Carpenter v. Dexter*, 8 Wall. 513; *Lynch v. Murphy*, 161 U. S. 247.

In actual fact, an assignment, had been spread upon the registry of the Patent Office, by which he had assigned to Reynolds a one-third interest

in all of his improvements and inventions in cash registers which he had been working on, and for which he contemplated filing applications. (There was no pending application at the time it was filed.) This assignment did not operate as a constructive notice, because it was not such a grant or conveyance as was entitled to registration. Neither did it request the commissioner to issue any particular patent to an assignee, and the commissioner therefore properly ignored it when he came to issue the patent. — *National v. New Columbus*, 129 Fed. 114; 63 C. C. A. 616.

Lynch v. Murphy, 161 U. S. 247; *Carpenter v. Dexter*, 8 Wall. 513; *Prentice v. Duluth*, 58 Fed. 437; Rob. Pat. sec. 785; *Wright v. Randel*, 8 Fed. 591; R. S. sec. 4895; Rob. Pat. secs. 411, 769, 785.

§ 162. Future Inventions — What are Not.

Complainant agreed to supply defendant with certain tackle blocks, and to assign patents for improvements, defendant agreeing to pay all expenses of patenting, dies, patterns, etc., and to pay complainant for all articles as ordered. Defendant lived up to the contract for a time and complainant assigned the patent upon the invention made during that period. Subsequently, when complainant had made further improvements and expended some \$8000 on dies and machinery, defendants refused to take the articles made. Later, defendants infringed the subsequent patented improvements of complainant and attempted to justify under implied license, growing out of said contract. *Held*: That the agreement was such as stated in the plea is highly improbable and the agreement made by the evidence still more so. The company was not bound to continue their agreement for a day, nor obliged to reimburse Hartz for cost of experiments or of plant essential in making his new devices. Such a contract is inconceivable and unconscionable. Even if clearly proven, it is not such a contract as a court of equity should specifically enforce. — *Hartz v. Cleveland*, 95 Fed. 681; 37 C. C. A. 227.

Dalzell v. Mfg. Co. 149 U. S. 315.

That when an employee agreed to assign inventions made while in the employ of defendant and to assign any future improvements on specific inventions already patented and assigned, such agreement covers improvement on said patents made after employment ceased, but not other improvements relating to defendant's business, see *Frick v. Geiser*, 100 Fed. 94; 40 C. C. A. 291.

That an assignment including along with pending applications, "inventions of like nature or similar thereto which I have already completed or which may hereafter be completed by me," cannot be construed to include inventions conceived after the assignment, see *Davis v. Tagliabue*, 159 Fed. 712; 86 C. C. A. 466.

§ 163. Future Inventions — Miscellaneous Rules.

The assignee of an agreement to assign future inventions takes it subject to all defenses against his assignor. — *Regan v. Pacific*, 49 Fed. 68; 1 C. C. A. 169.

An agreement existed by which the joint inventors agreed and did "bind themselves that in case they shall by invention or purchase become the owners of any invention or improvement upon carving machines they will transfer and assign a like exclusive right." Upon such title suit was brought. *Held*: While the terms of this agreement in reference to subsequent "invention in or improvement upon carving machines" are probably applicable

to the device shown in patent No. 447,796 (one of the patents in suit), and may be enforceable between the parties, as authorized in *Littlefield v. Perry*, 21 Wall. 205, it is plain that such agreement is executory only, and not an assignment, within the statute, so that no legal title is conferred. The subject-matter was not then in being, was incapable of sale and delivery, and, however binding the contract was upon the inventors to grant the right or title in their subsequent invention, it is not a legal assignment, and, at the utmost, confers upon the appellant a mere equity, with the legal title in the patentees. Suit by an assignee for infringement is authorized only when the assignment is complete within the statutory requirement. — *Milwaukee v. Brunswick-Balke*, 126 Fed. 171; 61 C. C. A. 175.

Rob. Pat. sec. 771; Curtis Pat. secs. 171-2; Regan v. Pacific, 49 Fed. 68; *Waterman v. Mackenzie*, 138 U. S. 252; *Pope v. Gormully*, 144 U. S. 248.

A contract for the assignment of future inventions existed. The bill asked for discovery of undisclosed inventions. The proofs gave no evidence whether such existed or what they were. *Held*: We are not justified in granting an order in the air for a discovery, involving parties in the hazards of ascertaining whether their proceedings may be in contempt or not. — *Reece v. Fenwick*, 140 Fed. 287; 72 C. C. A. 39.

Swift v. U. S. 196 U. S. 375.

Defendant having agreed to assign future inventions, was later discharged by complainant from its employ. Defendant then invented certain improvements and consulted officers of complainant with reference to getting them interested in complainant's proposed new business. Complainant's officers simply turned their backs on defendant without making any claim to the invention. *Held*: Inasmuch as defendant thereafterwards expended his time, efforts and money on the faith of the mutual understanding thus expressed by each party, equity cannot give the complainant relief with regard to any inventions on which defendant had expended his time, efforts and money with reference to developing and exploiting them, subsequently to the conversation referred to. — *Reece v. Fenwick*, 140 Fed. 287; 72 C. C. A. 39.

§ 164. Interests Assignable.

The monopoly granted to the patentee is for one entire thing; it is the exclusive right of making, using and vending to others to be used the improvement he has invented, and for which the patent is granted. The monopoly did not exist at common law, and the rights which may be exercised under it cannot be regulated by the rules of the common law. It is created by the act of Congress; and no rights can be acquired in it unless authorized by statute, and in the manner the statute provides. — *Gayler v. Wilder*, 10 How. 477; 13 L. Ed. 504.

Both assignees and grantees have an interest in the patent, but the terms are not synonymous, as used in the patent law. — *Moore v. Marsh*, 74 U. S. 515; 19 L. Ed. 37.

Potter v. Holland, 4 Blatchf. 157.

This power of assignment has been so construed by the courts as to confine it to the transfer of an entire patent, an undivided part thereof or the entire interest of the patentee or undivided part thereof within and throughout a certain specified portion of the United States. One holding such an assignment is an assignee within the meaning of the statute and may prosecute in the circuit court any action which may be necessary for the pro-

tection of his rights under the patent. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

That husband and wife may deal as strangers, see *Waterman v. Mackenzie*, 138 U. S. 252; 34 L. Ed. 923; 11 S. Ct. 334.

By the law of the State of New York where all the instruments were made and all the parties to them resided, husband and wife are authorized to make conveyances and contracts of and concerning personal property to and with each other in the same manner and to the same effect as if they were strangers. — *Waterman v. Mackenzie*, 138 U. S. 252; 34 L. Ed. 923; 11 S. Ct. 334.

Armitage v. Mace, 96 N. Y. 538; *Adams v. Adams*, 91 N. Y. 381.

This case really involves the question, which is one of considerable importance, whether a patentee can split up his patent into as many different parts as there are claims, and vest the legal title to those claims in as many different persons. This question has never before been squarely presented to this court, but in view of our prior adjudications, it presents no great difficulty. The leading case upon this subject is that of *Gayler v. Wilder*, 51 U. S. 477, and while that case involved a different question from the one in this case, the trend of the entire opinion is to the effect that the monopoly granted by law to the patentee is for one entire thing, and that in order to enable the assignee to sue, the assignment must convey to him the entire and unqualified monopoly which the patentee held, in the territory specified, and that any assignment short of that, is a mere license; for it was obviously not the intention of the legislature to permit several monopolies to be made out of one and divided among different persons within the same limits. — *Pope v. Gormully*, 144 U. S. 248; 36 L. Ed. 420; 12 S. Ct. 63.

The assignment ran to "J. B. Bartholomew, et al." It not appearing that any other interest had ever been asserted or claimed than that of Bartholomew, it was held that for the purpose of asserting title for the purpose of an infringement suit, the defendant having failed to show any adverse interest, that the expression "et al" was mere surplusage. — *Bliss v. Reed*, 106 Fed. 314; 45 C. C. A. 304.

It is urged that the use of the expression "may terminate this license" qualifies the language of the grant, and converts it into a mere license. We cannot concur in this view. It is a circumstance to be considered in the construction of the instrument as a whole, and in ascertaining whether there be provisions subsequent to the granting clause which are so repugnant to it that both cannot stand together. But the calling of an instrument which conveys the whole title of the grantor a license cannot qualify or limit the grant. — *Siehler v. Deere*, 113 Fed. 285; 51 C. C. A. 242.

Signal Co. v. Signal Co. 59 Fed. 20; *Newton v. Buck*, 72 Fed. 777.

§ 165. License.

A mere license to a party without having his assigns or equivalent words to them, showing that it is meant to be assignable, is only the grant of a personal power to the licensees, and is not transferrable to another. — *Troy v. Corning*, 14 How. 193; 14 L. Ed. 383.

Curt. Pat. 198; 2 Story. 525, 554.

An assignment of a right to use, make and sell for a limited time in a limited territory, in the absence of express words, is unassignable. — *Oliver v. Rumford*, 109 U. S. 75; 27 L. Ed. 862; 3 S. Ct. 61.

Iron v. Corning, 14 How. 193; *Gayler v. Wilder*, 10 How. 477.

The grant of an exclusive right under the patent within a certain district, which does not include the right to make, and the right to use, and the right to sell is not a grant of a title in the whole patent right within the district, and is therefore only a license. Such, for instance, is a grant of the "full and exclusive right to make and vend" within a certain district, reserving by the grantor the right to make within the district, to be sold outside of it. *Gayler v. Wilder*, 51 U. S. 477. So is a grant of "the exclusive right to make and use," but not to sell, patented machines within a certain district. *Mitchell v. Hawley*, 83 U. S. 544. So is an instrument granting "the sole right and privilege of manufacturing and selling" patented articles, and not expressly authorizing their use, because, though this might carry by implication the right to use the articles made under the patent by the licensee, it certainly would not authorize him to use such articles made by others. — *Waterman v. Mackenzie*, 138 U. S. 252; 34 L. Ed. 923; 11 S. Ct. 334.

Hayward v. Andrews, 106 U. S. 672; *Oliver v. Rumford*, 109 U. S. 75.

In equity as at law, when the transfer amounts to a license only, the title remains in the owner of the patent; and suit must be brought in his name, and never in the name of the licensee alone, unless that is necessary to prevent an absolute failure of justice, as when the patentee is the infringer and cannot sue himself. Any rights of licensee must be enforced through, or in the name of the owner of the patent, and perhaps, if necessary to protect the rights of all parties, joining the licensee with him as a plaintiff. — *Waterman v. Mackenzie*, 138 U. S. 252; 34 L. Ed. 923; 11 S. Ct. 334.

R. S. sec. 4921; *Littlefield v. Perry*, 88 U. S. 205; *Paper Bag Cases*, 105 U. S. 766, 771; *Birdsell v. Shaliol*, 112 U. S. 485; *Renard v. Levinstein*, 2 Hem. & M. 628.

An assignment or grant conveys (1) the whole patent, comprising the exclusive right to make, use and vend the invention throughout the United States; or (2) an undivided part or share of that exclusive right; or (3) the exclusive right under the patent within and throughout a specified part of the United States. "A transfer of either of these three kinds of interest is an assignment, properly speaking, and vests in the assignee, a title in so much of the patent itself, with a right to sue infringers; in the second case, jointly with the assignor; in the first and third cases, in the name of the assignee alone. Any assignment or transfer short of one of these is a mere license, giving the licensee no title in the patent, and no right to sue at law in his own name for infringement." *Waterman v. McKenzie*, 138 U. S. 252; *Gayler v. Wilder*, 10 How. 477; *Pope v. Gormully*, 144 U. S. 248. In the construction of this instrument, seeking to ascertain the intention of the parties to it, we must be governed by the familiar canons of interpretation. We must gather the intention from within the four corners of the instrument, giving the language employed its usual significance, and, if possible, reconcile discrepancies and avoid repugnancy, having regard also to the ancient rule that general words in one clause may be restricted by the particular words in a subsequent clause. — *Siehler v. Deere*, 113 Fed. 285; 51 C. C. A. 242.

Johnson v. Union, 59 Fed. 20; *Newton v. Buck*, 72 Fed. 777.

§ 166. Notice — Bona Fide Purchaser.

An assignee of a patent takes it subject to the legal consequences of the previous acts of the assignee. — *McClurg v. Kingsland*, 1 How. 202; 11 L. Ed. 102.

The owner of an equitable interest in a patent cannot set up such title against a bona fide purchaser of the legal title without notice of any prior outstanding equitable interest, and the title thus obtained is good as against

such equity in the hands of a subsequent purchaser even if they had notice.— *Faulkner v. Empire*, 67 Fed. 913; 15 C. C. A. 69.

A person taking title through an assignment indicating another interest takes at his risk, and is bound to make every inquiry to avoid the charge of notice. — *Mills v. Whitehurst*, 72 Fed. 496; 19 C. C. A. 130.

Chamberlain was Neer's attorney, and had charge of his application. He was asked to find out whether Neer would sell, and at what price. He bought the application from his client for himself, not disclosing to his client that he was buying for complainant, and then assigned the application to complainant at more than double the price he had paid. In the whole transaction he was acting in his own interest, and in such circumstances there is no presumption that he would disclose his information to his ostensible principal. — *National v. New Columbus*, 129 Fed. 114; 63 C. C. A. 616.

Thomson-Houston v. Capitol, 56 Fed. 849; *Pine v. Bailey*, 94 Fed. 258.

We are unable to hold, as against the defendant Tagliabue, a purchaser for value of the patents in question, that the verb "completed" should be given any other than its ordinary meaning. Assuming Tagliabue's actual knowledge of the assignment, he is not chargeable with notice that its language should receive an extraordinary interpretation. (The attempted interpretation being to make "completed or which may be hereafter completed by me" cover inventions made after the assignment was made). — *Davis v. Tagliabue*, 159 Fed. 712; 86 C. C. A. 466.

§ 167. Notice — Constructive.

Where the recorded agreement and assignment made reference to a second and unrecorded agreement and reservations and conditions therein contained, such record was sufficient to put bona fide purchasers on their inquiry as to the contents of the unrecorded agreement. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

It is well established that one who has reason to believe that another is offering property for sale, which he holds either as trustee or agent for a third person, cannot become a bona fide purchaser of the property for value by reliance on the statements of the suspected trustee or agent, either as to his authority, or as to his beneficial ownership of the thing sold. — *Mills v. Whitehurst*, 72 Fed. 496; 19 C. C. A. 130.

Trust Co. v. Boynton, 71 Fed. 797.

He is a voluntary purchaser, and having notice of a fact which casts doubt upon the validity of his title, the rights of innocent persons are not to be prejudiced through his negligence. — *Mills v. Whitehurst*, 72 Fed. 496; 19 C. C. A. 130.

Brush v. Ware, 15 Pet. 93, 112, 114; *Oliver v. Piatt*, 3 How. 333; *Cordova v. Hood*, 17 Wall. 1.

The defendants Weaver and Emminger were purchasers of the interest of Mrs. West for a valuable consideration after the alleged assignment to the partnership, and the oral unrecorded grant to the firm was void as against them and their licensee, the Buck Manufacturing Co., unless they had notice of its existence before they purchased from Mrs. West. — *Paulus v. Buck*, 129 Fed. 594; 64 C. C. A. 162.

Gates v. Fraser, 153 U. S. 332.

That where an assignee knew that other parties had been in some way interested in the development of a prior invention with the inventor and in the invention in question, or might have known such facts from the Patent Office records, such assignee is put upon his guard, see *National v. New Columbus*, 129 Fed. 114; 63 C. C. A. 616.

Cordova v. Hood, 17 Wall. 8; *Jonathan v. Whitehurst*, 72 Fed. 496.

§ 168. Parol.

An oral agreement for the sale and assignment of the right to obtain a patent for an invention is not within the statute of frauds, nor within section 4898 R. S. requiring assignments of patents to be in writing; and may be specifically enforced in equity upon sufficient proof thereof. — *Dalzell v. Dueber*, 149 U. S. 315; 37 L. Ed. 749; 13 S. Ct. 886.

Somerby v. Buntin, 118 Mass. 279; *Gould v. Banks*, 8 Wend. 562; *Burr v. De La Vergne*, 102 N. Y. 415; *Blakeney v. Goode*, 30 Ohio St. 350.

Complainant who had a series of patents and inventions, assigned to defendant those appertaining to his established business. The invention of the patent in suit was at that time unpatented but was in esse. Complainant claims that he reserved this invention (apparently mentally). *Held*: It would be difficult to conceive that intelligent men would omit from the calculation an element so essential to the success of the enterprise. To hold otherwise would be to credit the cunning of appellant a success, and to the committee that dealt with him a stupidity, that the care shown in all the other branches of the negotiation clearly discredit. — *Cook v. Sterling*, 150 Fed. 766; 80 C. C. A. 502.

An arrangement entered into, in contemplation of incorporation, and followed by incorporation, is binding upon the parties, when all the terms of the contract except the one in dispute have been fully and in good faith executed, and the disputed term fails of execution through the fraud, mistake, or inadvertence of the parties. To hold, in this respect, as we are asked to hold, would be to make all agreements preliminary to incorporation of no avail, notwithstanding the completion of the transaction by incorporation — a doctrine that in the present development of the law has no standing whatever. — *Cook v. Sterling*, 150 Fed. 766; 80 C. C. A. 502.

As a general rule, a parol contract reduced to writing, is to be held as fully expressed in the writing. But this does not exclude a court of equity from the inquiry whether, by fraud, mistake, or inadvertence, the writing fails to express the agreement; or (such fraud, mistake, or inadvertence appearing) from giving force to the oral agreement. — *Cook v. Sterling*, 150 Fed. 766; 80 C. C. A. 502.

§ 169. Part Interest.

If the owner assigns a part of his invention it must be an undivided portion of his entire interest under the patent, placing the assignee upon an equal footing with himself for the part assigned. Upon such an assignment, the patentee and his assignees become joint owners of the whole interest secured by the patent, according to the respective proportions which the assignment creates. — *Gayler v. Wilder*, 10 How. 477; 13 L. Ed. 504.

The assignment of a part interest of a patent pending suit does not defeat the action. — *Moore v. Marsh*, 74 U. S. 515; 19 L. Ed. 37.

Kilborn v. Rewes, 8 Gray, 415; *Eades v. Harris*, 1 Younge & C. 230.

How a patent monopoly may not be divided. — *Pope v. Gormully*, 144 U. S. 238; 36 L. Ed. 420; 12 S. Ct. 637.

§ 170. Pendente Lite.

The fact of the assignment of the Hofman patent *pendente lite*, and of all rights thereunder to any claims for, profits or damages, was not known to the circuit court. The defendant definitely learned of this assignment on Nov. 28, 1894, and thereafter, and before the argument upon the appeal, moved this court to remand the case to the circuit court with directions to dismiss the bill, but without prejudice to the rights of the assignee to apply for leave to file an original bill in the nature of a supplemental bill. This motion was properly denied. A peremptory dismissal of the bill, as will be seen hereafter, was not permissible; and furthermore, while Appleton and others were complainants, Ecaubert was seeking affirmative relief against them by his cross bill, and his right to relief, if any he had, could not be injuriously affected by the complainant's assignment. If the court should decree adversely to the validity of the Hofman patent, its assignees would be bound by the decree, because, irrespective of the question whether they had become the actual parties, they, being assignees were charged with notice of the suit, and bound by its results. Thus, where a plaintiff — who as owner of a patent, had brought suit for infringement and had assigned his interest in the patent *pendente lite* — asked the court to dismiss his bill, after an answer praying for affirmative relief, it was held that a possible right in the defendant to have a decree in his favor could not be defeated by such an assignment and by permission to dismiss the bill. — *Ecaubert v. Appleton*, 67 Fed. 917; 15 C. C. A. 73.

Electrical v. Brush, 44 Fed. 602.

If a sole plaintiff, suing in his own right, assigns the whole interest to another, he is no longer able to prosecute the suit because he is without interest in the litigation.

Nor would the fact that the assignment included collateral considerations, such as increase of consideration to be paid in the event of success of the litigation, or agreement to prosecute the action by the assignor, alter the condition of title. — *Automatic v. Cutler-Hammer*, 147 Fed. 250; 77 C. C. A. 176.

Ecaubert v. Appleton, 67 Fed. 917.

§ 171. Power of Attorney.

He undertook to give them an exclusive license, embracing the entire territory covered by the patent, and running for the full period of its life. We agree with the circuit court that this was a virtual, if not actual sale, and was therefore in excess of his authority (of working and developing the business of the said patent). What constitutes a sale of a patent, as an abstract question need not be discussed. It is sufficiently considered in *Nellis v. Mfg. Co.*, 13 Fed. 451; *Pickhardt v. Packard*, 22 Fed. 532; *Waterman v. MacKenzie*, 138 U. S. 252; 2 Rob. Pat. Sec. 763; Curt. Pat. pp. 241-243. — *Union v. Johnson*, 61 Fed. 940; 10 C. C. A. 176.

There can be no question that, under the power of attorney, the agent had full authority to assign the patent. But it is equally clear that his authority could be exercised only upon terms that should be first communicated to and accepted by his principal. The purported assignment, therefore, was clearly insufficient to transfer a title to the patent, not only because it was the act and deed of the agent, and not of the principal (*Marchesney v. Brown*, 29 Fed. 145, and cases there cited) but for the further

reason that the agent exercised a power not conferred upon him, in that he made a transfer of the patent without communicating the terms of the sale to his principal, or obtaining his approval thereof. — *Chauche v. Pare*, 75 Fed. 283; 21 C. C. A. 329.

Johnson v. Union, 59 Fed. 20; *Union v. Johnson*, 61 Fed. 940.

§ 172. Recording.

The record is intended for the benefit of the public. Bona fide purchasers look to it for their protection. The record of the grant alone, therefore, furnishes the strongest evidence of the intention of the parties. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

An agreement to "license, grant and convey" future inventions, is not an assignment of a patent, and is not recordable. — *Regan v. Pacific*, 49 Fed. 68; 1 C. C. A. 169.

§ 173. Reissue.

The words "to the full end of the term for which the said letters patent are or may be granted" embraced in an assignment carries both reissues and extensions of the patent. — *Nicholson v. Jenkins*, 81 U. S. 452; 20 L. Ed. 777.

R. R. v. Trimble, 10 Wall. 367.

Reissues are not patents for new inventions, but amendments of old patents. If a reissue is obtained with the consent of an assignee, it inures at once to his benefit; if without he has his election to accept or reject it. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

§ 174. Specific Performance.

A court of equity will not enforce an assignment from employee to employer upon a proved oral agreement which is unconscionable. — *Dalzell v. Dueber*, 149 U. S. 315; 37 L. Ed. 749; 13 S. Ct. 886.

Cathcart v. Robinson, 30 U. S. 264; *Mississippi v. Cromwell*, 91 U. S. 643; *Pope v. Gormully*, 144 U. S. 224.

A court of chancery will not decree specific performance, unless the agreement is "certain, fair, and just in all its parts." — *Dalzell v. Dueber*, 149 U. S. 315; 37 L. Ed. 749; 13 S. Ct. 886.

Buxton v. Lister, 3 Atk. 383; *Underwood v. Hitchcox*, 1 Ves. sec. 279; *Franks v. Martin*, 1 Eden, 309.

Uncertainty as to the meaning of a contract is fatal to a claim for its specific performance. — *Davis v. Tagliabue*, 159 Fed. 712; 86 C. C. A. 466.

§ 175. Territorial.

The holder of a territorial right, if exclusive although limited as to number of machines, holds such an interest as will enable him to sue for infringement in his own territory. — *Wilson v. Ronsseau*, 4 How. 646; 11 L. Ed. 1141.

The assignment of an exclusive right to make and use, and to vend to others machines within a given territory only, authorizes the assignee to vend elsewhere out of the said territory, the product of said machines. — *Simpson v. Wilson*, 4 How. 709; 11 L. Ed. 1169.

The patentee may assign his exclusive right within and throughout a specified part of the United States, and upon such an assignment, the

assignee may sue in his own name for an infringement of his rights. But in order to enable him to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee held in the territory specified — excluding the patentee himself as well as others. And any assignment short of this is a mere license. — *Gayler v. Wilder*, 10 How. 477; 13 L. Ed. 504.

§ 176. Miscellaneous Rulings.

An assignment made and recorded, based upon a definite consideration never paid, and which is treated as a nullity by the parties, is void. — *Railroad v. Trimble*, 77 U. S. 367; 19 L. Ed. 949.

See *Emerson v. Slater*, 22 How. 41.

An assignment made subsequent to a mortgage assignment duly recorded within the three months is subject to the mortgage, though not in terms so expressed. — *Waterman v. Mackenzie*, 138 U. S. 252; 34 L. Ed. 923; 11 S. Ct. 334.

When a patentee contracts for the use or sale of the patented article upon the payment of certain royalties, he cannot, as against such licensee, maintain a suit for infringement simply upon the ground that the licensee has failed to pay the agreed sum. — *Atkins v. Parke*, 61 Fed. 593; 10 C. C. A. 189.

Hartell v. Tilghman, 99 U. S. 547.

That where the evidence shows that the inventor agreed to assign his invention, and afterward refused so to do, he cannot recover for infringement, see *Schmitt v. Nelson*, 125 Fed. 754; 60 C. C. A. 522.

Acheson, J. dissenting (and I think most properly).

The assignment by the patentee who resided in England was made for the express purpose of enabling the assignee-trustee and his associates to exploit the invention, the assignee-trustee and his associates to license the use of the device, but not to sell or assign any part of the patent, and to pay the assignor one-third of all license fees. The successor of the assignee-trustee subsequently manufactured and sold the devices and did not account for all of the same, but did account in part, and the assignee accepted payments thereunder. *Held*:

We incline to agree with the court below that the correspondence between complainant and the patents company shows a sufficient acquiescence on the part of the complainant, in this mode of conducting business under the agreement, to estop him from now objecting thereto.

Sufficient evidence has been adduced, as to suppression of facts in regard to the amount of license fees collected and not accounted for, and undercharges in license fees due for devices made by defendants, accompanied by a refusal to make full disclosure of the books and accounts of said company, to clothe the complainant with a right to pursue defendants for redress in some form of action.

Equity and good conscience clearly require that these defendants, as trustees of these license fees, should be charged with the highest rate ever collected from outsiders for similar articles. — *Duff v. Gilliland*, 139 Fed. 16; 71 C. C. A. 428.

We are of the opinion that the short description in the title head is required for the purposes of Patent Office classification, that a conveyance by reference to the title head alone would be uncertain because applicable to any of the class, and that the name of the patentee and the serial number

afford a clear and definite description. There can be but one Maginn patent numbered 415,212. — *Maginn v. Standard*, 150 Fed. 139; 80 C. C. A. 15.

Note: This is good law very poorly stated. The "title head" includes name, number and short title. "Short title" is what the court meant. The use of the word "serial" is error; that word applies to the number of the application. What was meant was the patent number.

The assignment of the patent carried no such right. (The right to use the inventor's name and a certain mark in connection with it.) The name was not an essential part of the trademark, and, if the conveyance gave any right to use the name, it was only in connection with the particular representation of a shoe upon a cushion. — *Reed v. Frew*, 162 Fed. 887; 89 C. C. A. 577.

ATTORNEYS

Statutory Provision § 177		Statements on Argument — Not Evidence § 180
Actions Binding § 178 (<i>see</i> § 52)		Miscellaneous § 181
Assignment by — Notice § 179 (<i>see</i> § 149)		<i>See — Amendment</i> § 52

§ 177. Statutory Provision.

The only statutory provision as to attorneys or solicitors in the Patent Statute is sec. 487, which gives the Commissioner power to refuse recognition for gross misconduct. Under the powers given the Commissioner to establish regulations (sec. 483) some slight qualifications for practice before the Office have been provided; but, as elsewhere noted, these provisions are wholly inadequate.

§ 178. Acts Binding.

The court could not distinguish between the patentee and his counsel as to what occurred during the pendency of the application for the patent, and, as to the acceptance by the latter, the patentee must be regarded as bound by the acts of his counsel. — *Dobson v. Lees*, 137 U. S. 258; 34 L. Ed. 652; 11 S. Ct. 71.

That the negligence of an attorney in prosecuting an application is no excuse for defects which may exist in the patent, *see Lay v. Indianapolis*, 120 Fed. 831; 57 C. C. A. 313.

It will hardly be contended that the mistaken advice of a patent solicitor can override a statute of the United States. — *Eastman v. Mayor*, 134 Fed. 844; 69 C. C. A. 628.

§ 179. Assignment by — Notice.

Chamberlain was Neer's attorney, and had charge of his application. He was asked to find whether Neer would sell, and at what price. He bought the application from his client for himself, not disclosing to his client that he was buying for complainant, and then assigned the application to complainant at more than double the price he had paid. In the whole transaction he was acting in his own interest, and in such circumstances there is no presumption that he would disclose his information to his ostensible principal. — *National v. New Columbus*, 129 Fed. 114; 63 C. C. A. 616.

Thomson-Houston v. Capitol, 56 Fed. 849; *Pine v. Bailey*, 94 Fed. 258.

§ 180. Statements on Argument — Not Evidence.

That the mere argument of a solicitor found in the file-wrapper, in the absence of any amendment to conform thereto, cannot be held to limit or extend the claim, see *Boyer v. Keller*, 127 Fed. 130; 62 C. C. A. 244.

Aerne v. Carey, 96 Fed. 344; *Society v. Reh fuss*, 75 Fed. 657; *Daylight v. Marcus*, 110 Fed. 980.

§ 181. Miscellaneous.

The commissioner of patents has no right to make the former misconduct of an attorney or solicitor a ground for refusing him his rights upon proper demand. He cannot enforce an apology by withholding rights. Ill manners or bad manners do not work a forfeiture of men's civil rights. — *Boyden v. Burke*, 14 How. 575; 14 L. Ed. 548.

Right to amend. — *Eagleton v. West*, 111 U. S. 490; 28 L. Ed. 493; 4 S. Ct. 593.

Distinguished, *De La Vergne v. Featherstone*, 147 U. S. 209.

BANKRUPTCY.

Statutory Provision § 182

| Title to Patent § 183

§ 182. Statutory Provision.

Sec. 5046, R. S. provided for the vesting of the title to letters patent in the assignee in bankruptcy under the old act. The Act of July 1, 1898 (30 Stat. 565) in sec. 70, provides for the vesting of the title in the trustee of the bankrupt under the present act. It will be noted that the following rules were made with reference to conditions arising under the old act.

§ 183. Title to Patent.

If the existence of a patent had been concealed by the bankrupt, or the assignee had discovered it subsequently — after his discharge — and desired to take possession of it for the benefit of the estate, it is possible the bankruptcy court might reopen the case and vacate the discharge for that purpose. — *Sessions v. Romadka*, 145 U. S. 29; 36 L. Ed. 609; 12 S. Ct. 799.

Clark v. Clark, 58 U. S. 315.

While, under the provisions of the bankrupt law, the title to this patent passed undoubtedly to the assignee in bankruptcy, it passed subject to an election on his part not to accept it, if, in his opinion, it was worthless, or would have proved to be burdensome and unprofitable. And he was entitled to a reasonable time to elect whether he would accept it or not. — *Sessions v. Romadka*, 145 U. S. 29; 36 L. Ed. 609; 12 S. Ct. 799.

American v. Garrett, 110 U. S. 288; *Sparhawk v. Yerkes*, 142 U. S. 1; *Amory v. Lawrence*, 3 Cliff. 523.

CLAIMS (*see* § 249)

Statutory Provision § 184
Purpose of the Claim § 185
Ambiguity § 186
Combination § 187
Construction
Beneficial Use § 188
Broad and Narrow § 189

Comparison § 190
Dissecting § 191
Drawings § 192 (*see* § 362)
Duplication § 193
Equivalents § 194 (*see* § 373)
Expanding § 195
Functional § 196 (*see* § 426)

<p>Generic § 197 Improvement § 198 (see § 430) Limitation Broadening by Amendment § 199 (see § 52) Disclaimer § 200 (see § 339) By Applicant § 201 Elements of Claim § 202 Failure to Claim § 203 (see § 1) General Rules § 204 Improvement § 205 (see § 430) Narrow Improvement § 206 Patent Office Action Limiting § 207 Patent Office Action Not Limiting § 208 Patent Office Action — Protest § 209 Patent Office Action — Rule § 210 Specific Claims § 211 Specification and Drawings § 212 (see § 900) State of Art § 213 Words of Limitation § 214 (see § 936) Miscellaneous Rules § 215 Limitation to Avoid Anticipation § 216 Narrow § 217 Omitting Element § 218 Plain Intent and Meaning § 219 Reading in Elements § 220 Reference Characters § 221 Rules — General § 222</p>	<p>Specification § 223 (see § 900) State of Art § 224 Unclaimed Elements § 225 Undue Limitation by Patentee § 226 Unduly Broad § 227 Valeat quam Perent Rule § 228 Words and Phrases § 229 (see § 936) Miscellaneous Rulings § 230 Designs § 231 (see § 328) Elements (see § 249) Essential § 232 Redundant § 233 Reference Characters § 234 Terminology § 235 Excessive Duplication § 236 Effect of § 237 Foreclosing Improvement § 238 Expansion § 239 Failure to Claim § 240 Generic § 241 Novelty § 242 Process § 243 (see § 813) Purpose of § 244 Scope § 245 Specific § 246 Sufficiency § 247 Void § 248 See — <i>Divisional Patenting</i> § 348; <i>Double Patenting</i> § 356; <i>Equivalents</i> § 373; <i>Improvement</i> § 432; <i>Invention</i> §§ 603-12; <i>Process</i> §§ 814, 820; <i>Words and Phrases</i> § 936</p>
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§ 184. Statutory Provisions.

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. R. S. 4888.

§ 185. Purpose of the Claim.

Probably no better definition of the object and purpose of the claim is to be found than that given almost at the inception of patent decisions, in *Evans v. Eaton*, 7 Wheat. 356.

The specification has two objects: one is to make known the manner of construction so as to enable the artisans to make and use it, and thus to give the public the full benefit of the discovery after the expiration of the patent. The other is to put the public in possession of what the party claims as his invention, so as to ascertain if he claim anything that is in common use, or

is already known, and to guard against prejudice or injury from the use of an invention, which the party may otherwise innocently suppose not to be patented. It is therefore, for the purpose of warning an innocent purchaser, or other persons using a machine, of his infringement of the patent; and at the same time taking from the inventor the means for practicing upon the credulity, or the fears of other persons by pretending that his invention is for more than what it really is, or different from its ostensible objects.

§ 186. Ambiguity.

Without deciding that a repetition of substantially the same claim in different words will vitiate a patent, we hold that where a specification by ambiguity and needless multiplication of nebulous claims is calculated to deceive and mislead the public the patent is void. — *Carlton v. Bokee*, 84 U. S. 463; 21 L. Ed. 517.

There is here no sufficient foundation upon which to rest a claim which, if construed as broadly as the complainant insists it should be, practically makes all pay tribute who stir the mixture in question by machinery and by hand also, provided substantially the same movement can be produced. — *Marchand v. Emken*, 132 U. S. 195; 33 L. Ed. 332; 10 S. Ct. 65.

§ 187. Combination.

In case of a claim for a combination, where all the elements of the invention are old, and where the invention consists merely in the new combination of old elements or devices whereby a new and useful result is attained, such combination is sufficiently described if the elements or devices of which it is composed are all named and their mode of operation given, and the new and useful result to be accomplished pointed out, so that those skilled in the art and the public may know the extent and nature of the claims, and what the parts are which cooperate to produce the described new and useful result. — *Bates v. Coe*, 98 U. S. 31; 25 L. Ed. 68.

Curt. Pat. sec. 489; Seymour v. Osborne, 11 Wall. 542.

The claims of the patents sued on in this case are claims for combinations. In such claims, if the patentee specifies any element as entering into the combination either directly by the language of the claim or by such a reference to the descriptive part of the specification as carries such element into the claim, he makes such element material to the combination and the court cannot declare it to be immaterial. It is his province to make his own claim and his privilege to restrict it. If it be a claim to a combination, and be restricted to specified elements, all must be regarded as material, leaving open only the question, whether an omitted part is supplied by an equivalent device or instrumentality. — *Fay v. Cordesman*, 109 U. S. 408; 27 L. Ed. 979; 3 S. Ct. 236.

Water v. Desper, 101 U. S. 332; *Gage v. Herring*, 107 U. S. 640.

An attempt to incorporate into a claim for a combination a feature which had not been claimed in connection with the combination before, and thereby make a new combination will not be heard. — *Albany v. Worthington*, 79 Fed. 966; 25 C. C. A. 258.

§ 188. Construction — Beneficial Uses.

A patentee who is first to make an invention is entitled to his claim for all the uses and advantages which belong to it. — *Stow v. Chicago*, 104 U. S. 547; 26 L. Ed. 816.

Woodman v. Stimpson, 3 Fish. P. C. 98; *Tucker v. Spalding*, 80 U. S. 453; *Graham v. Mason*, 5 Fish. P. C. 1.

An inventor is entitled to a beneficial function of his invention, whether he knew all its beneficial uses or not. — *Goshen v. Bissell*, 72 Fed. 67; 19 C. C. A. 13.

McCormick v. Aultman, 69 Fed. 371; *Roberts v. Ryer*, 91 U. S. 150; *Brown v. D. C.* 130 U. S. 87-103; *Eames v. Andrews*, 122 U. S. 40; *Miller v. Mfg. Co.* 151 U. S. 201; *Stow v. Chicago*, 104 U. S. 550; *Tucker v. Spalding*, 13 Wall. 453; *Appleton v. Star*, 60 Fed. 411; *Western v. Sperry*, 58 Fed. 186; *Galt v. Parlin*, 60 Fed. 422; *Dixon v. Pfeifer*, 55 Fed. 390; *Thompson v. National*, 65 Fed. 427.

§ 189. Construction — Broad and Narrow.

It is possible, and perhaps probable, that the second claim might be construed as covering not only non-conducting material placed between the spiral layers, but such other means as might occur to the skilled mechanic as useful for that purpose, but it does not, it seems to us, necessarily follow that the inventor is bound to rely upon such scope as would probably result from construction. He may, for the purpose of describing the extent of his claims, not only state the general principles and requisite features of the invention in one claim, but the general principles and requisite features in another claim, supplementing this with a more particular description of the details involved in the contemplated structure. We do not consider the claims identical, and therefore, one or the other superfluous, but view the first claim as broader than the second in the respect which we have stated and not inconsistent therewith. — *Consolidated v. West End*, 85 Fed. 622; 29 C. C. A. 386.

Where there are several claims, if some of the claims are limited to details, those which remain are prima facie not to be fettered by insisting that they contain as necessary elements, the particulars which are specifically covered elsewhere. — *Bresnahan v. Tripp*, 102 Fed. 899; 43 C. C. A. 48.

§ 190. Construction — Comparison.

In our opinion, the special office of the second and third claims was to secure combinations containing the pivoted pitman and the pitman rod described in the specification and omitted from the first claim, and the fact these claims were added is a very persuasive argument that the additional elements they protect were not secured by the first claim. Any construction which would read into the first claim these additional elements, renders it useless and unmeaning, because it gives it the same effect as the claims which follow it, and in this way shows that neither the patentee nor the patent office contemplated such an interpretation. — *Mast v. Dempster*, 82 Fed. 327; 27 C. C. A. 191. But see 177 U. S. 485.

It is necessary where the complainant limited its suit, to one claim out of the many in the patent, to make sure that the claim in issue does not receive improper color or breadth from those not in issue. — *Eppler v. Campbell*, 86 Fed. 141; 29 C. C. A. 616.

The very fact that the other elements mentioned in the specification, while expressly embraced in the other claims, were not mentioned in the sixth claim, demonstrates an intention to cover by that claim any and all forms of disintegrators in the construction of which that cylinder should be used. — *Anderson v. Potts*, 108 Fed. 379; 47 C. C. A. 409.

Separate claims are not to be construed as identical unless fairly unavoidable. — *Lamson v. Hillman*, 123 Fed. 416; 59 C. C. A. 510.

United v. California, 25 Fed. 475; *Cohansey v. Wharton*, 28 Fed. 189; *Tondeur v. Stewart*, 28 Fed. 561; *Smead v. Union*, 44 Fed. 614; *National v. American*, 53 Fed. 367; *Felix v. Ledos*, 54 Fed. 163.

That a construction which would render two claims substantially identical should be avoided where possible, see *O'Rourke v. McMullen*, 160 Fed. 933.

Bresnahan v. Tripp, 102 Fed. 899; *Thomson-Houston v. Nassau*, 110 Fed. 647.

§ 191. Construction — Dissecting.

It is manifestly just to a patient and meritorious inventor that the court should be careful not to regard with too much importance the mere mechanical resemblance in the parts of the combination, or the combination as a whole, to the neglect of the result, and the success and efficiency with which the object aimed at is accomplished. — *Kalamazoo v. Duff*, 113 Fed. 264; 51 C. C. A. 221.

§ 192. Construction — Drawings.

When a drawing merely shows one special construction not pointed out and defined as to its value, and the device is broadly claimed, the drawing alone will not serve to limit the claim so as to save it from being void for broadness. — *Consolidated v. Metropolitan*, 60 Fed. 93; 8 C. C. A. 485.

DeLamater v. Heath, 58 Fed. 414.

We know of no principle of patent construction which, in such a case (the improvement being novel) would require the court to read into the claim the particular concrete form of improvement shown in the drawings and in the descriptions of such drawings. — *Consolidated v. Littaner*, 84 Fed. 164; 28 C. C. A. 133.

§ 193. Construction — Duplication.

While, according to strict rules of law, two distinct claims for the same substantial matter, differing only in nonessentials, cannot both be sustained, yet out of regard to the frailty of human methods of expression, and the variety of views among different legal judicial tribunals as to the construction of instruments of the character of letters patent, and conceding also, the difficulty of always correctly defining what one's invention really is, the practice has become settled to allow the same substantial invention to be stated in different ways, very much as the same cause of action, or the same offense intended to be covered by indictment, are permitted to be propounded in different counts, with a general verdict on all of them. — *Dececo v. Gilchrist*, 125 Fed. 293; 60 C. C. A. 207.

§ 194. Construction — Equivalents.

Though a claim is not entitled to the broad construction it would appear to imply, it still may be held to be infringed by a construction which comes within a limited construction of such claim. — *Lawther v. Hamilton*, 124 U. S. 1; 31 L. Ed. 325; 8 S. Ct. 342.

Among cases which run to the other extreme, where the range of equivalents is held to be very narrow are *Masten v. Hunt*, 51 Fed. 216; 55 Fed. 78; *Ball v. Ball*, 58 Fed. 818; *Ball v. Edgerton*, 96 Fed. 489; *Millard v. Chase*, 108 Fed. 399. In some of this class the nature of the invention prohibited anything except the narrowest range of equivalents, it being a practical rule

that the range is proportionate to the extent of the invention; but some are within the expressions of *Reece v. Globe*, 61 Fed. 958, to the effect that words and phrases which might have been omitted may be so introduced as to leave the courts no option except to regard them as limitations. — *U. S. Peg-Wood v. Sturtevant*, 125 Fed. 382; 60 C. C. A. 248.

Where two patents like those in question relate to improved mechanical arrangement, and where the structural and mechanical adaptations are so entirely different, and the modes of operation so entirely unlike, the situation does not admit of the doctrine of equivalents as a foundation for finding and holding infringement. Each should stand upon its merits, unaided by a liberal rule of judicial construction extending the claims beyond the mechanical arrangement described. — *Yawman v. Library*, 147 Fed. 246; 77 C. C. A. 388.

§195. Construction — Expanding.

It is well known that the terms of the claim in letters patent are carefully scrutinized in the Patent Office. Over this part of the specification the chief contest generally arises. It defines what the office, after a full examination of previous inventions and the state of the art, determines the applicant is entitled to. The courts therefore should be careful not to enlarge by construction the claim which the Patent Office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms. — *Burns v. Meyer*, 100 U. S. 671; 25 L. Ed. 738.

Court will not import elements that would operate to so enlarge its scope as to cover an invention not indicated upon its face. — *Wollensak v. Sargent*, 151 U. S. 221; 38 L. Ed. 137; 14 S. Ct. 291.

Day v. Fairhaven, 132 U. S. 98.

While this may be done (reading an old element into a claim) with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that, if we once begin to include elements not mentioned in the claim, in order to limit such claim, and avoid a defense of anticipation, we should never know when to stop. — *McCarty v. Lehigh*, 160 U. S. 110; 40 L. Ed. 358; 16 S. Ct. 240.

The patent was for an improvement in burglar-proof safes. There was no claim made upon the lock, but any suitable locking device was specified. Defendant applied the lock shown in the patent in suit to a jail cage. *Held*: In this case there was no claim for a lock or locking device, but for an improvement in safes; and it would unquestionably be extending the terms of the patent to afford protection against infringement in the use of a lock omitting the principal element mentioned in the specifications and claim. — *Gerard v. Diebold*, 54 Fed. 889; 4 C. C. A. 644.

Keystone v. Phoenix, 95 U. S. 274; *McClain v. Ortmyer*, 141 U. S. 419.

The enlargement of a claim to cover infringement beyond the scope of the application would render the patent void. — *Erie v. American*, 70 Fed. 58; 16 C. C. A. 632.

De La Vergne v. Valentine, 66 Fed. 771.

We do not entertain any doubt that there must be incorporated into these claims, by implication, means for maintaining the contact device and the conductor in their normal working relations. — *Thomson-Houston v. Union*, 86 Fed. 636; 30 C. C. A. 313.

The statute provides for a correction of defective patents by means of reissue, and we are of the opinion that a court of equity has no power, in a suit for infringement, to give existence on the theory of correcting a mistake, to a patent never issued in the mode provided by law, and adjudge damages for its infringement. — *Chuse v. Ide*, 89 Fed. 491; 32 C. C. A. 260.

That elements not clearly indicated as part of a combination cannot be read into the claims, see *Wilson v. McCormick*, 92 Fed. 167; 34 C. C. A. 280.

While the patent is notice of the claims which it contains and allows, it constitutes an estoppel of the patentee from claiming under that or any subsequent patent any combination or improvement there shown which he has not clearly pointed out and distinctly claimed as his discovery or invention when he received his patent. It is a complete and a legal notice to every one — notice on which every one has a right to rely — that he may freely use such improvements and combinations without claim or molestation from the patentee. It would constitute rank injustice to permit an inventor, after a combination or device that he did not distinctly claim in his patent had gone into general use, and years after his patent had been granted, to read that combination or device into one of the claims of his patent, and to recover for its infringement of every one who had used it upon the faith of his solemn declaration that he did not claim it. This would be the effect of a reversal of the decree below.— *M'Bride v. Kingman*, 97 Fed. 217; 38 C. C. A. 123.

Building v. Eustis, 65 Fed. 804; *Stirrat v. Mfg. Co.* 61 Fed. 980; *Adams v. Lindell*, 77 Fed. 432.

It is not within the rightful power of the courts to enlarge or restrict the scope of patents which by mistake, were issued in terms too narrow or too broad to cover the invention, however manifest the fact and extent of the mistake may have shown to have been. — *United States Repair v. Assyrian*, 100 Fed. 965; 41 C. C. A. 123.

The object of the claim in a patent is to publish to the world the precise nature of the invention which the patentee seeks to protect. He cannot demand that there shall be imported into it an element which is not there distinctly stated or necessarily implied. — *Santa Clara v. Prescott*, 102 Fed. 501; 42 C. C. A. 477.

In view of the fact that the invention was the hanging of the motor below the car, one end being centered upon the axle, and the other end being flexibly attached by springs to the truck frame, it cannot be subdivided, and claim four must be construed to include the flexible support of the off end of the motor from an independent structure which is the truck frame, or from the independently mounted body of the vehicle. — *Sprague v. Nassau*, 102 Fed. 761; 42 C. C. A. 612.

That reference to a subsequent patent to the same inventor may not be made for the purpose of expanding the claims of the patent in suit, see *Union v. Battle Creek*, 104 Fed. 337; 43 C. C. A. 560.

The courts will not, in the absence of an inclusive claim, go into the history of the art, to ascertain what was really discovered, and what might have been patented, had the patentee chosen. The patentee will be taken at his word, and protected only according to the terms in which he has himself demanded protection. — *Consolidated v. Seybold*, 105 Fed. 978; 45 C. C. A. 152.

The court is not at liberty by construction to expand a claim beyond the fair meaning of its terms. This claim is for a combination. Its terms are explicit and clear. It needs no interpretation. It speaks for itself. The court must take the claim as it finds it. — *Pittsburg v. Pittsburg*, 109 Fed. 644; 48 C. C. A. 580.

The claim does not contain any apt language which would suggest to a casual reader that the patentee intended to incorporate as one of the elements thereof the invention consisting of the supplemental chamber and a slotted partition wall, which are covered completely by the first claim; and in the absence of words which do clearly indicate such a purpose, we are not disposed to import into a claim a feature of construction already protected by another claim, merely for the purpose of sustaining the claim, and subjecting another to the charge of infringement. — *Metallic v. Brown*, 110 Fed. 665; 49 C. C. A. 147.

McCarty v. Railroad, 160 U. S. 110; *Stearns v. Russell*, 85 Fed. 218; *Wilson v. Machine Co.* 92 Fed. 167.

The most liberal rule of construction known to the patent law will not sanction such an interpretation of the specification and claims of a patent, or such an expansion of the invention (*viz.*, disregarding the specific feature repeatedly mentioned as the essence of the invention). Such a construction and enlargement of the claim are manifestly a contradiction of its specific terms, and an attempt to read into the patent a structure never contemplated by the patentee, and entirely outside of his invention. — *General v. Webster*, 113 Fed. 756; 51 C. C. A. 446.

If this tipping capacity had been pointed out, and even this indefinite direction given by the patentee as to the mode of securing the operation, the patent might possibly be saved. But neither the advantage of such a function, nor any hint that it is in any wise dependent upon the normal tension of the retaining wires, is to be found in the patent. How, then, is it possible for the public to obtain a knowledge of this new function? — *Goodyear v. Rubber*, 116 Fed. 363; 53 C. C. A. 583.

If, when thus examined, the specification answers the calls of the claim, there is no difficulty. But one may not read into a claim an element not contained in it when its meaning is once settled by construction. — *Canda v. Michigan*, 124 Fed. 486; 61 C. C. A. 194.

Stillwell-Bierce v. Eufaula, 117 Fed. 410; *Deering v. Winona*, 155 U. S. 286; *Goshen v. Bissell*, 72 Fed. 67; *Roberts v. Nail*, 53 Fed. 920; *Campbell v. Duplex*, 86 Fed. 315.

Neither can a feature of construction or an element covered by one claim be read into another in which it is not mentioned. — *Penfield v. Potts*, 126 Fed. 475; 61 C. C. A. 371.

Wilson v. McCormick, 92 Fed. 167; *Canda v. Michigan*, 124 Fed. 486.

We know of no authority for reading into a claim features which have been omitted, although shown in the specifications, and none which would justify us in suffering such enlargement of this claim for the purpose of increasing the damages justly recoverable for the infringement of the patented portions of the infringing machine. We may, beyond doubt, look to the specifications and drawings for the purpose of understanding the claims, or that we may see that the device is useful or operative, and sometimes for the purpose of limiting a claim to the particular device described, but we may not enlarge

a claim by including therein elements which are not claimed as such. — *Penfield v. Potts*, 126 Fed. 475; 61 C. C. A. 371.

McCarty v. Lehigh, 160 U. S. 110; *Stearns v. Russell*, 85 Fed. 218.

This is not a question of the construction of a patent or of the application of the doctrine of equivalents. It is a question whether the court will reconstruct the Whitley patent in order to cover a device in which the essence of the invention covered by the patent has been eliminated. — *Whitley v. Winsor*, 127 Fed. 338; 62 C. C. A. 220.

Under a well-settled rule, mere utility cannot serve to enlarge the scope of an invention which is limited to the structure disclosed in the patent — *Wilson v. Calculagraph*, 144 Fed. 91; 75 C. C. A. 249.

The rule is fundamental, in the construction of patents, that the claim in the patent is the measure of the invention. The specification may be referred to to explain any ambiguity in the claim, but it cannot be referred to for the purpose of expanding or changing the claim. — *National v. New England*, 151 Fed. 19; 80 C. C. A. 485.

Keystone v. Phoenix, 95 U. S. 274; *McClain v. Ortmyer*, 141 U. S. 419.

If we import the specifications into the claims it would seem that this characteristic of the vapor holder should go with it, as showing what vapor holder the patentee means by his claim. — *American v. Cleveland*, 158 Fed. 978; 86 C. C. A. 182.

§ 196. Construction — Functional.

We think it must be conceded that the movement of a machine irrespective of the mechanism which causes it cannot be patented. The claim must be restricted to the mechanism which causes the movement, subject, of course, to the rule of equivalents, which operates liberally in favor of the grantee where the patent is primary in nature, making a distinct advance in the progress of the art; and this patent, in our opinion, is of that character. When we examine the mechanism we find in the appellant's machine described in the patent a rocking or tilting device, and in the appellee's a lifting and dropping device. The appliances are essentially different. They do different things in distinct ways. The one rocks or tilts the mold plates, the other alternately lifts and drops them. Are we justified in holding that these two essentially distinct devices are equivalents, simply because the ultimate result is the same? We think not, for that would be construing the claim so as to cover the movement alone and not the mechanism producing it. It would be virtually giving a patent for the result, regardless of how reached. — *American v. Sexton*, 139 Fed. 564; 71 C. C. A. 548.

Burr v. Duryea, 1 Wall. 320; *Merrill v. Yeomans*, 94 U. S. 568; *Wessell v. United*, 139 Fed. 11.

§ 197. Construction — Generic.

If the patent be for a whole machine the party can maintain a title to it only by establishing that it is substantially new in its structure and mode of operation. — *Evans v. Eaton*, 7 Wheat. 356; 5 L. Ed. 472.

See s. c. 3 Wheat. 454.

Being satisfied that he was, in fact, the inventor of the general process described and bodied forth in the specification, how can we, by any fair rule of construction, circumscribe this claim in such a manner as that it shall only cover the process applied in the precise degree and the precise means or

machinery pointed out? Had the process been known and used before and not been Tilghman's invention, he could not then have claimed anything more than the particular apparatus described in his patent; but being the inventor of the process, as we are satisfied was the fact, he was entitled to claim it as he did. — *Tilghman v. Proctor*, 102 U. S. 707; 26 L. Ed. 279.

A patentee who is the first to make an invention is entitled to his claim for all the uses and advantages which belong to it. — *Stow v. Chicago*, 104 U. S. 547; 26 L. Ed. 816.

Woodman v. Stimson, 3 Fish. P. C. 98; *Tucker v. Spalding*, 80 U. S. 453; *Graham v. Mason*, 5 Fish. P. C. 1.

Unless the description is sufficiently clear and full to enable one skilled in the art to use the invention, the invention, though it be a pioneer cannot have a broad construction applied to its claims. — *Béné v. Jeantet*, 129 U. S. 683; 32 L. Ed. 803; 9 S. Ct. 428.

In view of the fact that the inventor was a pioneer in his art, and invented a principle which had gone into almost universal use in this country, we think he is entitled to a liberal construction of his claim, and that the infringing device, containing as it does all the elements of his combination should be held as an infringement, though there are superficial dissimilarities in their construction. — *Sessions v. Romadka*, 145 U. S. 29; 36 L. Ed. 609; 12 S. Ct. 799.

The Circuit Court of Appeals concurred with the Circuit Court that unless the patents sued on embodied a pioneer invention, the defendant's machine was so differentiated from either of the others that the charge of infringement could not be maintained. The Circuit Court held all complainant's patents to be only improvements on the prior art. The Circuit Court of Appeals held that the patent was entitled to be treated as embodying primary invention. We think that none of complainant's patents embodied primary invention, and we concur with both the courts below that, this being so, there was no infringement. — *Kokomo v. Kitselman*, 189 U. S. 8; 47 L. Ed. 689; 23 S. Ct. 521.

The patentee was a pioneer, in that he designed a new way to accomplish a desired result, but upon the same general idea which he had unsuccessfully tried to work out in his earlier patent. His later patent was the bridge and not a mere step, which carried from failure to success. It is not important now to determine the grade of its pioneership, and whether it may be classed in the list of those inventions which are of the highest rank; but it was an invention created to achieve great necessities and overcome great hindrances, and was one of wide breadth. A court would not be justified in adopting "a narrow or astute construction," which should minimize the character of the invention, leave its real scope open to trespassers and thus "be fatal to the grant." The claims of the patent do not contract the grant to narrower limits than those, which the invention as made by the patentee, literally covered; and the claims, therefore, are not limited to the precise mechanical means described in the specification. The rule which permits, and indeed compels, courts to give a wide range to the equivalents which a broad or pioneer patent can include, is thus expressed in *Miller v. Mfg. Co.* 151 U. S. 186. "If the invention is broad or primary in its character, the range of equivalents will be correspondingly broad, under the liberal construction which the courts give to such inventions." — *Westinghouse v. New York*, 63 Fed. 962; 11 C. C. A. 528.

On the whole case, we are satisfied that the Gorham binder was a primary or pioneer patent of the highest merit, that it attained a result wholly new in a new way, and that in the consideration of alleged infringements of it, the patentee is entitled to all the liberality of treatment accorded to that comparatively rare class of patents. — *McCormick v. Aultman*, 69 Fed. 371; 16 C. C. A. 259.

It is conspicuously one of those pioneer inventions which entitle the proprietor to a liberal protection from the courts in construing the claim. But there is a limit to the judicial liability in this direction. If an inventor is ambiguous or obscure, or halt or limp in his language of description, the courts will help him out, and so construe the claim as to give distinct identity to his device. If there be a doubt in the mind of the court or the jury on the issue of mechanical equivalency, the court will give and instruct the jury to give, the benefit of the doubt to the pioneer inventor. But where the inventor falls so far short in his description as to claim only the result which his machine accomplishes, and omits an explicit definition of the means by which he does it, as in the case at bar, the courts have another duty to perform, one which they owe to the public and to the worthy fraternity of inventors, and must decline to give him general rights where he is entitled only to special rights. — *Boyden v. Westinghouse*, 70 Fed. 816; 17 C. C. A. 430.

Limitations upon the claims by which the defendant seeks to avoid infringement proceed upon the initial fallacy, that in a generic process patent every phenomenon observed during operation and every minute detail described must be read into the claims and that the least departure from the claims as so construed avoids infringement. The position is not tenable. In a patent like Bradley's the claims should be as broad as the invention and, even if unnecessary and unreasonable limitations are incorporated in the claims, the court should interpret them liberally and not permit a defendant to escape who reaches the same result by analogous means, although he may employ additional elements and improve mechanical appliances. — *Electric v. Pittsburg*, 125 Fed. 926; 60 C. C. A. 636.

Ventilating Co. v. Fuller, 57 Fed. 626; *Tilghman v. Proctor*, 102 U. S. 707.

To use the language of counsel, the court ought "to refer back to the specifications, and read into the claims those elements which are therein specified as being the means by which such functions are performed." The claims of a patent should be construed, where they reasonably may be, to cover the entire invention of the patentee; and where a patent contains several claims, some of which are limited to details, the others are, *prima facie*, not to be restricted by insisting that they contain, as necessary elements, the particulars which are specifically covered elsewhere. — *Los Angeles v. Æolian*, 143 Fed. 880; 75 C. C. A. 88.

Risdon v. Trent, 92 Fed. 375; *Mast v. Dempster*, 82 Fed. 327; *Bresnahan v. Tripp*, 102 Fed. 899.

§ 198. Construction — Improvement.

Some inventions embrace only a part of a machine, and in such case the part or parts claimed must be specified and pointed out so that constructors, other inventors and the public may know how to make the invention, and what is withdrawn from general use. — *Seymour v. Osborne*, 78 U. S. 516; 20 L. Ed. 33.

Bailey was not the first to conceive the idea of the device in suit. The same thing had been done by other means. The claim must be confined to

the specific device described and claimed. — *Blake v. San Francisco*, 113 U. S. 679; 28 L. Ed. 1070; 5 S. Ct. 692.

Prouty v. Ruggles, 16 Pet. 336; *Rowell v. Lindsay*, 113 U. S. 97.

If his device contains a patentable invention, it is but one in a series of improvements all having the same general object and purpose; and that in construing the claims of his patent, they must be restricted to the precise form and arrangement of parts described in his specification, and to the purpose indicated therein. — *Bragg v. Fitch*, 121 U. S. 478; 30 L. Ed. 1008; 7 S. Ct. 978.

If the complainant's device constituted a patentable invention, it is clearly "one in a series of improvements, all having the same general object and purpose; and that, in construing the claims of his patent, they must be restricted to the precise form and arrangement of parts described in his specifications, and to the purpose indicated therein." — *Fox v. Perkins*, 52 Fed. 205; 3 C. C. A. 32.

Bragg v. Fitch, 121 U. S. 483; *Caster v. Spiegel*, 133 U. S. 360.

That an element in a prior patent to the same inventor cannot be imported into a claim of a later patent to make that claim cover a desired combination, see *Boston v. Woodward*, 82 Fed. 97; 27 C. C. A. 69.

If the patent alleged to be infringed had been of a primary character, or one embodying a distinct and substantial advance in the art to which it relates, we should probably be able to find the equivalents of the elements. — *Smith v. Ridgley*, 103 Fed. 875; 43 C. C. A. 365.

McCormick v. Aultman, 69 Fed. 371; *Bundy v. Detroit*, 94 Fed. 524.

The invention claimed being only for improvements in well-known processes, and in no sense one of a pioneer character, the patentee must be held to a strict construction of his claims. — *De Lamar v. De Lamar*, 117 Fed. 240; 54 C. C. A. 272.

Wright v. Yuengling, 155 U. S. 47; *Westinghouse v. Power-Brake*, 170 U. S. 562.

Limited to specific combination — see *Bibb v. Bowers*, 142 Fed. 137; 73 C. C. A. 355.

Singer v. Cramer, 192 U. S. 265.

It must be remembered that the patent sued on is in no sense a pioneer one, but a mere improvement. In such cases the patentee is limited to the precise devices and combinations shown and claimed in his patent. — *Cumming v. Baker*, 144 Fed. 395; 75 C. C. A. 373.

Boyd v. Janesville, 158 U. S. 260; *Brown v. Huntington*, 134 Fed. 735; *Rich v. Baldwin*, 133 Fed. 920; *King v. Bilhofer*, 127 Fed. 127; *Tabor v. Photograph*, 87 Fed. 871; *Ransome v. Hyatt*, 69 Fed. 148; *Ney v. Ney*, 69 Fed. 405; *Overweight v. Improved*, 94 Fed. 155.

§ 199. Construction — Limitation — Broadening by Amendment.

Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has, in the meantime, gone into public use. — *Chicago v. Sayles*, 97 U. S. 554; 24 L. Ed. 1053.

§ 200. Construction — Limitation — Disclaimer.

We are aware of no principle which will permit a patent to be defeated for want of novelty in respect to the subject-matter which has been eliminated from it by disclaimer. It is also urged that the effect of the disclaimer was to limit the method of the patent to the exact elements mentioned. If these elements only, instead of elements such as these named, had been mentioned, there would be much force in the argument. — *Schwarzwalder v. N. Y.* 66 Fed. 152; 13 C. C. A. 380.

It is material to observe that the invention claimed is the combination of certain described elements. This amounts to a disclaimer of anything new in the elements themselves. — *Wells v. Curtis*, 66 Fed. 318; 13 C. C. A. 494.

Corn Planter Pat. 23 Wall. 181; *Miller v. Brass Co.* 104 U. S. 350; *Rowell v. Linsay*, 113 U. S. 97.

If one particular branch of the art of working in wood — cabinet making, for example — had never used circular saws, because they were supposed to be impracticable or useless or not economical, although such saws were used in other branches of the art, it might be invention to introduce them in cabinet making; and the individual who showed that they were useful, practicable, and economical in that branch of the art might be entitled to a patent for a circular saw in combination with the other parts of an old machine. But his specification and claim would be expected to indicate just what it was he had invented and what he claimed. An individual who had invented some specific improvement in circular saws generally — something novel and useful and applicable to those tools in every branch of the wood-working art — might also obtain a patent, with a claim covering all circular saws, which would be good to restrain infringement of his particular improvement. But it would be a startling proposition that he could, 13 years afterwards, file a disclaimer of any combination containing circular saws so used (with his improvement or without) on the theory that no one had used them in that branch of the art before. We do not understand that the statutory provisions allowing a disclaimer to be filed can be thus availed of to change the invention claimed in a patent, and we are referred to no authorities which sustain complainant's contention. The object of a disclaimer is well expressed in *Chem. Wks. v. Lauer*, Fed. Cas. 12,135:

"It is designed to allow a patentee to recover on one claim of his patent, notwithstanding other claims in it are void for want of novelty. But it requires that the parts claimed without right, and the parts rightfully claimed, shall be definitely distinguishable, as a matter of fact, on the face of the claims; that is, to be definitely distinguished from each other in the claims." — *Albany v. Worthington*, 79 Fed. 966; 25 C. C. A. 258.

Whatever may have been the transactions between the applicant and the patent office, and whatever light may be thrown upon obscurities in the patent by the wrapper and contents, it is the patent as issued by which the patentee's right to a monopoly must be tested. When it expressly declares that there is some other process to which it does not apply, and in plain and unambiguous language gives the earmarks by which that other process is to be distinguished from the process of the patent, the public has the right to insist that the patentee shall abide by the disclaimer he has made and proclaimed. — *Jackson v. Birmingham*, 79 Fed. 801; 25 C. C. A. 196.

§ 201. Construction — Limitation — By Applicant.

Cases arise not unfrequently, where the actual invention described in the specification is larger than the claims of the patent; and in such cases it is undoubtedly true that the patentees in a suit for infringement must be

limited to what is specified in the claims annexed to the specification, but it is equally true that the claims of the patent, like other provisions in writing, must be reasonably construed, and in case of doubt or ambiguity it is proper in all cases to refer back to the descriptive portions of the specification to aid in solving the doubt or in ascertaining the true intent and meaning of the language employed in the claims; nor is it incorrect to say that due reference may be had to the specification, drawings and claims of a patent, in order to ascertain its true legal construction. In construing patents it is the province of the court to determine what the subject-matter is upon the whole face of the specification and the accompanying drawings. — *Bates v. Coe*, 98 U. S. 31; 25 L. Ed. 68.

Brooks v. Fisk, 15 How. 215; *Curt. Pat.* 4th Ed. sec. 222.

It is possible that the inventor was entitled to a broader claim than that to which he limited himself; but if he described and claimed only a part of his invention, he is presumed to have abandoned the residue to the public. — *Deering v. Winona*, 155 U. S. 286; 39 L. Ed. 153; 15 S. Ct. 118.

McClain v. Ortmayer, 141 U. S. 419.

The patentee having described in his specification and declared to be an essential part of his invention an element thereof and having made it a subject of his claims, is not now at liberty to say it is immaterial, or that a device which dispenses with it is an infringement, though it accomplish the same purpose in, perhaps, an equally effective manner. — *Wright v. Yuengling*, 155 U. S. 47; 39 L. Ed. 64; 15 S. Ct. 1.

Vance v. Campbell, 66 U. S. 427; *Union v. Desper*, 101 U. S. 332; *Gage v. Herring*, 107 U. S. 640; *Rees v. Gould*, 82 U. S. 187; *Brown v. Davis*, 116 U. S. 237.

It is insisted that the claims of the patent should have a liberal construction, and that the special devices described in the specification "are not necessary constituents of the claims." *Machine Co. v. Lancaster*, 129 U. S. 263. This just principle is one that is well recognized, but another principle is, at the present stage of the patent law, of equal force, which is that the construction of patents must be in conformity with the self-imposed limitations which are contained in the claims. — *Groth v. International*, 61 Fed. 284; 9 C. C. A. 507.

Following

McClain v. Ortmayer, 141 U. S. 419.

When a patentee has practically disclaimed other devices by stating in his specifications that they existed before his own was contrived, such other devices may fairly be considered to be part of the prior art, when he brings suit upon the patent issued to him upon the representation made in such specifications. — *Lyons v. Drucker*, 106 Fed. 416; 45 C. C. A. 368.

Where the patentee specifies a particular form as a means by which the effect of the invention is produced, or otherwise confines himself to a particular form of what he describes, he is limited thereby in his claim for infringement. — *Greene v. Buckley*, 135 Fed. 520; 68 C. C. A. 70.

Walker on Pat. sec. 363.

The patentee, having originally covered his real invention by the last of the original 10 claims, and having unwarrantably attempted by said other claims to cover a broader invention, secured a patent for certain other claims, limited to the definite construction shown and described in his application. In so doing he has committed himself to a definite interpretation and limitation of his claims. — *Greene v. Buckley*, 135 Fed. 520; 68 C. C. A. 70.

Since the patentee has deliberately chosen to make this parallelism a feature of these two claims, it is not for the court to strike it out. — *Whittemore v. Reinhardt*, 159 Fed. 707; 86 C. C. A. 461.

Where one claim of a patent specifically names two elements, and another claim specifically names these two elements and in addition thereto a third element, it must be presumed that the patentee intended to limit the claims to the elements enumerated. — *Marshall v. Pettingell-Andrews*, 164 Fed. 862; C. C. A.

§ 202. Construction — Limitation — Elements of Claim.

A claim must be limited to the elements claimed, or their equivalents. — *Gage v. Herring*, 107 U. S. 640; 27 L. Ed. 601; 2 S. Ct. 819.

Meter v. Desper, 101 U. S. 332; *Fames v. Godfrey*, 1 Wall. 78; *Murray v. Clayton*, L. R. 10 Ch. 675 note; *Clark v. Adie*, L. R. 10 Ch. 667.

Where the claims covered specifically cylinders with chambers or depressions, they cannot be construed to cover plain cylinders. — *Hendy v. Golden*, 127 U. S. 370; 32 L. Ed. 207; 8 S. Ct. 1275.

Fay v. Cordesman, 109 U. S. 408; *Sargent v. Hall*, 114 U. S. 63; *Shepard v. Carrigan*, 116 U. S. 593; *White v. Dunbar*, 119 U. S. 47; *Crawford v. Heysinger*, 123 U. S. 589.

Must be restricted and confined to the specific combination described and each element pointed out as an essential part thereof. — *Knapp v. Morss*, 150 U. S. 221; 37 L. Ed. 1059; 14 S. Ct. 81.

Duff v. Sterling, 107 U. S. 639; *Newton v. Furst*, 119 U. S. 373; *Bragg v. Fitch*, 121 U. S. 478; *Crawford v. Heysinger*, 123 U. S. 589; *Dreyfus v. Wiese*, 124 U. S. 32; also *Sargent v. Hall*, 114 U. S. 63; *Eddy v. Denis*, 95 U. S. 560; *McCormick v. Talcott*, 61 U. S. 402.

The patentee having described in his specification and declared to be an essential part of his invention an element thereof and having made it a subject of his claims, is not now at liberty to say it is immaterial, or that a device which dispenses with it is an infringement, though it accomplish the same purpose in, perhaps, an equally effective manner. — *Wright v. Yuengling*, 155 U. S. 47; 39 L. Ed. 64; 15 S. Ct. 1.

Vance v. Campbell, 66 U. S. 427; *Union v. Desper*, 101 U. S. 332; *Gage v. Herring*, 107 U. S. 640; *Rees v. Gould*, 82 U. S. 187; *Brown v. Davis*, 116 U. S. 237.

In insisting now that the defendant has incorporated this vital feature in its safety-valve, the complainant seems to place itself precisely within the animadversion of the Supreme Court in the case of *Western v. Ansonia*, 114 U. S. 447, where it says, "It has been held by this court that the scope of letters patent should be limited to the invention covered by the claim; and, though the claim may be illustrated, it cannot be enlarged by the language of other parts of the specification." — *Ashton v. Coale*, 52 Fed. 314; 3 C. C. A. 98.

The patentee has disclosed only one particular construction operating in a defined way, and this construction he has claimed. It is idle to speculate whether or not he might have made a broader claim. The court is powerless to relieve him from the consequences of self-imposed limitations. — *Lewis v. Pa.* 59 Fed. 129; 8 C. C. A. 41.

Keystone v. Phoenix, 95 U. S. 274; *Fay v. Cordesman*, 109 U. S. 408; *Rowell v. Lindsay*, 113 U. S. 97; *McClain v. Ortmyer*, 141 U. S. 419.

A patent grants no exclusive right except to what is distinctly covered by the claims. — *Thomasson v. Bumpass*, 78 Fed. 491; 24 C. C. A. 180.

Grant v. Walter, 148 U. S. 547; *Western v. Ansonia*, 114 U. S. 447; *Ashton v. Coale*, 52 Fed. 318; *McClain v. Ortmayer*, 141 U. S. 419.

The patent was for a narrow improvement. *Held*: He must be held to the combination which is described and claimed so explicitly. — *Hardison v. Brinkman*, 156 Fed. 962; 87 C. C. A. 8.

Keystone v. Phoenix, 95 U. S. 274.

When a claim is explicit, the courts cannot alter or enlarge it. — *Dey v. Syracuse*, 161 Fed. 111.

Keystone v. Phoenix, 95 U. S. 274.

A patent for described means or mechanism to accomplish a desired end must be limited to the particular means described in the specification or their clear mechanical equivalents, and does not embrace or cover any other mechanical structure which is substantially different in its construction or operation. — *Union v. Diamond*, 162 Fed. 148; 89 C. C. A. 172.

Eames v. Godfrey, 1 Wall. 78; *Boyd v. Janesville*, 158 U. S. 260; *Westinghouse v. Boyden*, 170 U. S. 537; *Bryce v. National*, 116 Fed. 186; *Jewell v. Jackson*, 140 Fed. 340.

§ 203. Construction — Limitation — Failure to Claim.

What is described in the specification of a patent and not claimed is presumed to have been old. — *Electric v. Boston*, 139 U. S. 481; 35 L. Ed. 250; 11 S. Ct. 586.

It is a settled principle of law, enacted by statute and announced by the courts that a patentee and his assignees have no right to the exclusive use of anything patented which the inventor has not distinctly claimed in his application for the patent. — *Ashton v. Coale*, 52 Fed. 314; 3 C. C. A. 98.

A description in a specification of details which the claim does not make elements of the combination, and which are not essential to it, simply points out one method of using it, and does not restrict the claim to these details. — *Brammer v. Schroeder*, 106 Fed. 918; 46 C. C. A. 41.

It may be that Farwell's invention would have entitled him to make a broader claim, but his patent makes no such broad claim. It is in this respect like the patent under consideration in *Keystone v. Phoenix*, 95 U. S. 274. — *Schreiber v. Adams*, 117 Fed. 830; 54 C. C. A. 128.

McClain v. Ortmayer, 141 U. S. 419; *Seabury v. Johnson*, 76 Fed. 456.

If in truth Harder understood the now stated objections, and was the first to conceive and embody a way of overcoming them, he carefully refrained from saying so. Now a patent is to be sustained not for what an inventor may have done in fact, but only for what he "particularly points out and distinctly claims" in his open letter. — *Harder v. United States*, 160 Fed. 463; 87 C. C. A. 447.

Fastener v. Kraetzer, 150 U. S. 116; *Indiana v. Crocker*, 103 Fed. 496; *Avery v. Case*, 148 Fed. 214.

§ 204. Construction — Limitation — General Rules.

It is clear that a party cannot entitle himself to a patent for more than his own invention; and if his patent includes things before known, or before

in use, as his invention, he is not entitled to recover, for his patent is broader than his invention. — *Evans v. Eaton*, 7 Wheat. 356; 5 L. Ed. 472.

See s. c. 3 Wheat. 454.

It is obvious that the inventor claims as his improvement, not the whole of the engine, nor the whole of the wheel, but both merely in the superior form which he particularly sets out. He therefore does not claim too much, which might be bad. — *Hogg v. Emerson*, 6 How. 437; 12 L. Ed. 505.

Hill v. Thompson, 2 March. 435; 4 Wash. C. C. 68; *Godson on Pat.* 189; *Kay v. Marshall*, 1 Mylne, 373; 1 Story R. 273; 2 Mas. 112; 4 B. & A. 541; *Boville v. Moon*, 2 March. 211.

It is true that the patent cannot be extended beyond the claim. That bounds the patentee's right. — *American v. Fiber Co.* 90 U. S. 566; 23 L. Ed. 31.

In making his claim the inventor is at liberty to choose his own form of expression, and while the courts may construe the same, in view of the specifications and the state of the art, they may not add to or detract from the claim. And it is equally true that, as the inventor is required to enumerate the elements of his claim, no one is an infringer of a combination claim unless he uses all the elements therein. — *Cimiotti v. American*, 198 U. S. 399; 49 L. Ed. 1100; 25 S. Ct. 697.

Shepard v. Carrigan, 116 U. S. 593; *Sutter v. Robinson*, 119 U. S. 530; *McClain v. Ortmyer*, 141 U. S. 419; *Wright v. Yuengling*, 155 U. S. 47; *Black Diamond v. Excelsior*, 156 U. S. 611; *Walk. Pat. sec.* 349.

It is the chief office of a claim to particularize and limit the monopoly of use which is secured to the inventor by the letters patent. Within the limits which are by the claim marked out and definitely established as the scope of the invention, no one can venture to intrude without becoming a trespasser upon the exclusive rights secured to the inventor. The very purpose of a claim is to establish the line of demarcation between a permissive and lawful use and the forbidden and unlawful use. In its scope, its operative power, its comprehensive effect, the public have no less interest than the inventor. In drafting a claim, the applicant for the grant of a monopoly is directly dealing with the rights of the public, and, in such cases, strictness rather than elasticity of construction must obtain. The language by which the comprehensive boundaries of a claim are to be made distinctive and clear lies wholly within the selection of the inventor. He alone may choose the words to describe and particularize his invention. When chosen and used, such words must be held to be binding upon him. — *Duff v. Forgie*, 59 Fed. 772; 8 C. C. A. 261.

The statute requires the inventor to particularly point out, and distinctly claim, the improvement or combination which he claims as his discovery. Rev. St. sec. 4888. The purpose of a claim in a patent is to notify the public of the extent of the monopoly secured to the inventor, and, while it is notice of his exclusive privileges, it is no less a notice, and a legal notice, upon which everyone has a right to rely, that he disclaims, and dedicates to the public, any combination or improvement, apparent on the face of his specification, not a mere evasion of his own, which he has not there pointed out and distinctly claimed as his discovery or invention. Every one has the right to use every machine, combination, device and improvement not claimed by the patentee, without molestation from him. It would work great injustice to permit a patentee, after a combination or device which he did not claim has gone into general use, and years after his patent was granted, to read

that combination or device into one of the claims of his patent, and to recover for its infringement of everyone who has used it on the faith of his solemn declaration that he did not claim it. — *Adams v. Lindell*, 77 Fed. 432; 23 C. C. A. 223.

Keystone v. Phoenix, 95 U. S. 274; *Miller v. Brass Co.* 104 U. S. 350; *Mahn v. Harwood*, 112 U. S. 354; *Wollensak v. Reiher*, 115 U. S. 96; *Parker v. Yale*, 123 U. S. 87; *Stirrat v. Mfg. Co.* 61 Fed. 980; *Building Co. v. Eustis*, 65 Fed. 804.

§ 205. Construction — Limitation — Improvement.

The invention being, then, in no sense a pioneer in the art, no unexpressed meaning can be read with the claim, and the patent must be limited to the specific device described therein. — *Evans v. Rood*, 99 Fed. 990; 40 C. C. A. 209.

§ 206. Construction — Limitation — Narrow Improvement.

In a narrow claim elements cannot be held essential as infringing which could not be claimed. — *Watson v. Cincinnati*, 132 U. S. 161; 33 L. Ed. 295; 10 S. Ct. 45.

Gage v. Herring, 107 U. S. 640; *Fay v. Cordesman*, 109 U. S. 408.

If there were any thing more in this than mechanical skill or the aggregation of familiar devices, each operating in the old way to produce an aggregated result, it was invention of such a limited character as to require a narrow construction. — *McCarty v. Lehigh*, 160 U. S. 110; 40 L. Ed. 358; 16 S. Ct. 240.

Penna. v. Locomotive, 110 U. S. 490.

That a claim covering such an improvement (minor) is not entitled to a broad construction is too obvious to require the citation of authorities. — *Dey v. Syracuse*, 161 Fed. 111; 88 C. C. A. 275.

Cimiotti v. Fur, 198 U. S. 399; *Kokomo v. Kitselman*, 189 U. S. 8.

§ 207. Construction — Limitation — Patent Office Action Limiting.

As patents are procured ex parte, the public is not bound by them, but the patentees are. If the office refuses to allow him all he asks, he has an appeal. But the courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office, or the appellate tribunal to which contested applications are referred. When the terms of a claim in a patent are clear and distinct, as they always should be, in a suit brought upon the patent, the patentee is bound by it. — *Keystone v. Phoenix*, 95 U. S. 274; 24 L. Ed. 344.

Merrill v. Yeomans, 94 U. S. 568.

In this case the description of appellee's invention is much broader than his claim. It seems quite clear, from the present form of appellee's specifications, and from the fact that his application for a patent was twice rejected, that he was compelled by the Patent Office to narrow his claim to its present limits before the commissioner would grant him a patent. In doing this he neglected to amend the descriptive part of his specifications. He cannot go beyond what he has claimed and insist that his patent covers something not claimed, merely because it is to be found in the descriptive part of the specifications. — *Lehigh v. Mellon*, 104 U. S. 112; 26 L. Ed. 639.

Burns v. Meyer, 100 U. S. 671; *Keystone v. Phoenix*, 95 U. S. 278.

In patents for combination of mechanism, limitations and provisos, imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor, and in favor of the public, and looked upon as in the nature of disclaimers. — *Sargent v. Hall*, 114 U. S. 63; 29 L. Ed. 67; 5 S. Ct. 1021.

Fay v. Cordesman, 109 U. S. 408; *Water Meter v. Desper*, 101 U. S. 332; *Gage v. Herring*, 107 U. S. 640.

If an applicant, in order to get his patent, accepts one with a narrower claim than that contained in his original application, he is bound by it. — *Shepard v. Carrigan*, 116 U. S. 593; 29 L. Ed. 723; 6 S. Ct. 493.

Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent. — *Shepard v. Carrigan*, 116 U. S. 593; 29 L. Ed. 723; 6 S. Ct. 493.

Leggett v. Avery, 101 U. S. 256; *Goodyear v. Davis*, 102 U. S. 222; *Fay v. Cordesman*, 109 U. S. 408; *Mahn v. Harwood*, 112 U. S. 354; *Cartridge v. Cartridge*, 112 U. S. 624; *Sargent v. Hall*, 114 U. S. 63.

Complainant is not at liberty now to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow as a condition of the grant. — *Sutter v. Robinson*, 119 U. S. 530; 30 L. Ed. 492; 7 S. Ct. 376.

Shepard v. Carrigan, 116 U. S. 593, and cases there cited.

This court has often held that when a patentee, on the rejection of his application, inserts in his specification, in consequence, limitations and restrictions for the purpose of obtaining his patent, he cannot, after he has obtained it, claim that it shall be construed as it would have been construed if such limitations were not contained in it. — *Roemer v. Peddie*, 132 U. S. 313; 33 L. Ed. 382; 10 S. Ct. 98.

Leggett v. Avery, 101 U. S. 256; *Goodyear v. Davis*, 102 U. S. 222; *Fay v. Cordesman*, 109 U. S. 408; *Mahn v. Harwood*, 112 U. S. 354; *Union v. U. S.* 112 U. S. 624; *Sargent v. Hall*, 114 U. S. 63; *Shepard v. Carrigan*, 116 U. S. 593; *White v. Dunbar*, 119 U. S. 47; *Sutter v. Robinson*, 119 U. S. 530; *Bragg v. Fitch*, 121 U. S. 478; *Snow v. Lake Shore*, 121 U. S. 617; *Crawford v. Heysinger*, 123 U. S. 589.

As the claim must be held to define what the Patent Office had determined to be the patentee's invention, it ought not to be enlarged beyond the prior interpretation of its terms. — *Day v. Fair Haven*, 132 U. S. 98; 33 L. Ed. 265; 10 S. Ct. 11.

When applicant has limited his claim by including specific elements in his combination under rejection by the Patent Office he is limited thereby to his specific elements. — *Phoenix v. Spiegel*, 133 U. S. 360; 33 L. Ed. 663; 10 S. Ct. 409.

Roemer v. Peddie, 132 U. S. 313 and cases there cited.

A claim admitted by the Patent Office and acquiesced in by the patentee should not be enlarged by construction beyond the fair interpretation of its terms. — *Haines v. McLaughlin*, 135 U. S. 584; 22 L. Ed. 241; 10 S. Ct. 876.

Where applicant has put in a claim in the Patent Office to cover more broadly his process, and afterwards struck it out on rejection, it is well

settled, by numerous cases in this court, that under such circumstances a patentee cannot successfully contend that his patent shall be construed as if it still contained the claims which were so rejected and withdrawn. — *Royer v. Coupe*, 146 U. S. 524; 36 L. Ed. 1073; 13 S. Ct. 166.

Roemer v. Peddie, 132 U. S. 313; *Phoenix v. Spiegel*, 133 U. S. 360; *Yale v. Berkshire*, 135 U. S. 342; *Dobson v. Lees*, 137 U. S. 258.

Must be read and interpreted with reference to the rejected claims and to the prior state of the art, and cannot be construed to cover either. — *Knapp v. Morss*, 150 U. S. 221; 37 L. Ed. 1059; 14 S. Ct. 81.

Shepard v. Carrigan, 116 U. S. 593; *Sutter v. Robinson*, 119 U. S. 530.

Applicant having withdrawn rejected claims and substituted narrower claims cannot insist on construction of a reissue claim to cover original claim. — *Corbin v. Eagle*, 150 U. S. 38; 37 L. Ed. 989; 14 S. Ct. 28.

Shepard v. Carrigan, 116 U. S. 593; *Roemer v. Peddie*, 132 U. S. 313; *Royer v. Coupe*, 146 U. S. 524.

Where applicant has amended on rejection by patent office he is estopped to claim the scope of original claim. — *Morgan v. Albany*, 152 U. S. 425; 38 L. Ed. 500; 14 S. Ct. 627.

Acquiescence in the rejection of a claim and restriction by amendment limits the construction of the claim to the device shown. — *Lehigh v. Kearney*, 158 U. S. 461; 39 L. Ed. 1055; 15 S. Ct. 871.

Knapp v. Morss, 150 U. S. 221.

His acquiescence in the rulings of the patent office indicates very clearly that he should be limited to the combination claimed, and that the case is not one calling for a liberal construction. — *McCarty v. Lehigh*, 160 U. S. 110; 40 L. Ed. 358; 16 S. Ct. 240.

The patentee had acquiesced in the rejection of his claim and could not claim the benefit thereof, or of an equivalent construction of the claims allowed. — *American v. Pennock*, 164 U. S. 26; 41 L. Ed. 337; 17 S. Ct. 1.

The record shows correspondence between solicitor and examiner, in which the solicitor admitted and amended the specification to state that certain functions in question were old, but not admitting their force in application to the case in question.

Held: We agree with the defendant that this correspondence and the specification as so amended should be construed as reading the auxiliary valve into the claim, and repelling the idea that this claim should be construed as one for a method or process. — *Westinghouse v. Boyden*, 170 U. S. 537; 42 L. Ed. 1136; 18 S. Ct. 707.

Note: This case decided 5 to 4. See dissenting opinion of Shiras: "The courts should be slow to permit this construction of a patent, actually granted and delivered, to be affected or controlled by alleged interlocutions between the officers in the Patent Office and the claimant. When we consider that often the employees in the Patent Office are inexperienced persons, and the mass of business is so vast, it can be readily seen how dangerous it would be to modify or invalidate a patent, clear and definite in its terms, resorting to such uncertain sources of information."

Whether the examiners were right or wrong in so holding (narrowly limiting the claim) we are not to inquire, as the claimant did not appeal, but amended his claim and accepted a grant thereof, thereby putting himself

within the range of the authorities which hold that if the claim to a combination be restricted to specified elements, all must be regarded as material, and the limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public, and looked upon as in the nature of disclaimers. — *Hubbell v. U. S.* 179 U. S. 77; 45 L. Ed. 95; 21 S. Ct. 24.

Union v. Desper, 101 U. S. 332; *Morgan v. Albany*, 152 U. S. 425.

In order to get his patent, he was compelled to accept one with a narrower claim than that contained in his original application; and it is well settled that the claim as allowed must be read and interpreted with reference to the rejected claim and the prior state of the art, and cannot be so construed as to cover either what was rejected by the Patent Office or disclosed by prior devices. — *Hubbell v. U. S.* 179 U. S. 77; 45 L. Ed. 95; 21 S. Ct. 24.

Leggett v. Avery, 101 U. S. 256; *Shepard v. Carrigan*, 116 U. S. 593; *Knapp v. Morss*, 150 U. S. 227.

In view of what passed in the Patent Office, and the state of the art, we cannot regard the Kitselman patent as a pioneer patent, but think its claims must be limited in their scope to the actual combination of essential parts as shown and cannot be construed to cover other combinations of elements of different construction and arrangement. — *Kokomo v. Kitselman*, 189 U. S. 8; 47 L. Ed. 689; 23 S. Ct. 521.

We are of opinion that the Patent Office, after twice refusing to allow the patent because of prior patents referred to, was led to take favorable action owing to the peculiar form of the described bearing, and that it was the purpose to limit the patent to the peculiar device. And this view is supported by the claim in question. It contains words of limitation. It is recited therein that the combination is to be "substantially as specified," that is, as described in the specifications and shown in the drawings. — *Singer v. Cramer*, 192 U. S. 265; 48 L. Ed. 437; 24 S. Ct. 291.

Westinghouse v. Boyden, 170 U. S. 537.

Where an inventor seeking a broad claim, which is rejected, in which rejection he acquiesces, substitutes therefor, a narrower claim, he cannot be heard to insist that the construction of the claim allowed shall cover that which has been previously rejected. — *Computing v. Automatic*, 204 U. S. 609; 51 L. Ed. 645; 27 S. Ct. 307.

Corbin v. Eagle, 150 U. S. 38; *Hubbell v. U. S.* 179 U. S. 77; *Leggett v. Avery*, 101 U. S. 256; *Shepard v. Carrigan* 116 U. S. 593; *Knapp v. Morss*, 150 U. S. 221.

Thereupon Carrington amended and limited his claims by withdrawing those first filed, and substituted the first claim that is now found in his patent; and, having adopted that course, the claim in dispute must receive a strict and narrow construction. — *Wright v. Standard*, 53 Fed. 819; 4 C. C. A. 28.

Roemer v. Peddler, 101 U. S. 313; *Sargent v. Safe & Lock Co.* 114 U. S. 63.

The history of his second application shows that he presented and abandoned claims so worded as to have the same meaning which it has been sought to put by construction upon the claims finally presented and allowed. It is insisted that the claim granted is broader than those rejected, and therefore, cannot be limited by them; but that is a begging of the question. It can be made broader only by construction, and the effect of the decisions on the subject, as we understand them, is that a claim cannot by construction

be enlarged to include the matter of claims in the rejection of which the patentee has acquiesced. — *Temple v. Goss*, 58 Fed. 196; 7 C. C. A. 174.

A claim is limited by an amendment made and acquiesced in on application. — *B. & S. Fastener v. B. G. Fastener*, 58 Fed. 818; 7 C. C. A. 498.

Union v. U. S. 112 U. S. 624; *Crawford v. Heysinger*, 123 U. S. 589; *Watson v. Railway*, 132 U. S. 161.

After withdrawing a specific claim for an element, in favor of a contestant, the patentee cannot set that element up. His patent, if valid, is for the combination minus that element, a device whose novelty consists in dispensing with that element. — *Shoemaker v. Merrow*, 61 Fed. 945; 10 C. C. A. 181.

Within these lines with which the patentee has himself circumscribed his patent in the process of application for the same it must be construed, and, as thus construed there is no infringement in a compound employing that which he specifically excluded. — *Dougherty v. Doyle*, 63 Fed. 475; 11 C. C. A. 298.

Although the patentee might have made the language of his claim more broad, he is bound by the terms of limitation which he adopted. — *Smith v. Macbeth*, 67 Fed. 137; 14 C. C. A. 241.

The rule is well settled that the patentee cannot, after the issuance of his patent, broaden his claims by dropping any element which he was compelled to include in order to secure the patent. — *Wheaton v. Norton*, 70 Fed. 833; 17 C. C. A. 447.

Fay v. Cordesman, 109 U. S. 408; *Sargent v. Lock Co.* 114 U. S. 63; *Shepard v. Carrigan*, 116 U. S. 593; *Leggett v. Avery*, 101 U. S. 256; *Vulcanite Co. v. Davis*, 102 U. S. 222; *Mahn v. Harwood*, 112 U. S. 354; *Howe v. National*, 134 U. S. 394; *White v. Dunbar*, 119 U. S. 47.

The claim of the patent must be restricted within the limitations imposed by the patent office and accepted by the applicant. — *Erie v. American*, 70 Fed. 58; 16 C. C. A. 632.

Eagleton v. Mfg. Co. 111 U. S. 490; *Machine v. Featherstone*, 147 U. S. 209; *Snow v. Railway*, 121 U. S. 617; *Crawford v. Heysinger*, 123 U. S. 589; *Consolidated v. McKeesport*, 40 Fed. 21.

In view of the limitations placed upon the claims by the patent office and acquiesced in, and in view of the specific language, we are of opinion the claim cannot be construed to cover an element of a different character. — *Troy v. Adams*, 73 Fed. 301; 19 C. C. A. 505.

That claim, however, was rejected, not because functional, but because it was "altogether too broad, if not functional"; and the authorities are familiar which forbid a construction of claims allowed which will make them equivalent to broader claims rejected. — *Brush v. Western*, 76 Fed. 761; 22 C. C. A. 543.

The patentee having acquiesced in the rejection of the claim in its original form, cannot now insist that the present claim should be construed as it might have been construed if the original claim had not been rejected and withdrawn. — *Olmsted v. Andrews* 77 Fed. 835; 23 C. C. A. 488.

Roemer v. Peddie, 132 U. S. 313; *Caster v. Spiegel*, 133 U. S. 360; *Yale v. Berkshire*, 135 U. S. 379; *Dobson v. Lees*, 137 U. S. 258; *Royer v. Coupe*, 146 U. S. 524; *Corbin v. Eagle*, 150 U. S. 38.

It is well settled that where the patent office rejects a claim covering a certain device on its merits, and such rejection is acquiesced in, and the patent issues, the applicant cannot afterwards be allowed a construction of the claims allowed wide enough to embrace the claim which was rejected. In *Morgan v. Albany*, 152 U. S. 425, Mr. Justice Brown, speaking for the supreme court, in considering the contention that a claim should have a certain construction, said:

“ But the patentee having once presented his claim in that form, and the patent office having rejected it, and he having acquiesced in such rejection, he is, under the repeated decisions of this court, now estopped to claim the benefit of his rejected claim, or such a construction of his present claim as would be equivalent thereto. *Leggett v. Avery*, 101 U. S. 256; *Shepard v. Carrigan*, 116 U. S. 593; *Crawford v. Heysinger*, 123 U. S. 589; *Union v. U. S.* 112 U. S. 624. It is true there were cases where the original claim was broader than the one allowed, but the principle is the same if the rejected claim be narrower.” — *Thomas v. Rucker*, 77 Fed. 420; 23 C. C. A. 211.

That limitations which an inventor places upon an invention in a proceeding in the patent office, to gain his point and get his claim, must stand against him, even if he won his claim by other means, see *Craig v. Michigan*, 81 Fed. 870; 26 C. C. A. 659.

Whatever the invention, and whatever the patentee ought to have been allowed to incorporate into this claim it is clear that under the circumstances of this case, the patentee bound himself and the court by the addition of these amendatory words. — *Eppler v. Campbell*, 86 Fed. 141; 29 C. C. A. 616.

Reece v. Globe, 61 Fed. 958.

For a curious way of stating the familiar rule, see *Truman v. Holmes*, 87 Fed. 742; 31 C. C. A. 215.

Roemer v. Peddie, 132 U. S. 313; *Morgan v. Albany*, 152 U. S. 425.

He cannot claim such a construction of his patent as would include what he was expressly required to abandon as a condition of the grant, even if it takes away a material part of his real invention. — *Kelly v. Clow*, 89 Fed. 297; 32 C. C. A. 205.

Morgan v. Albany, 152 U. S. 425.

An application for a patent which has been rejected, and which is subsequently amended to conform with the objections of the patent office, is strictly construed. — *Norton v. Jensen*, 90 Fed. 415; 33 C. C. A. 141.

Sargent v. Lock, 114 U. S. 63; *Meter Co. v. Desper*, 101 U. S. 332; *Gage v. Herring*, 107 U. S. 640; *Fay v. Cordesman*, 109 U. S. 408.

It is immaterial, we think, whether the patent office was right or wrong in rejecting complainant's original claims on the ground that the invention therein described was anticipated by the prior art. By amending his specification and claims the complainant admitted, in effect, that some limitations were necessary; and it is now too late to assert that he was entitled to his original claims, or that the claims as finally allowed are as broad as the original claims. — *Brill v. St. Louis*, 90 Fed. 666; 33 C. C. A. 213.

Sutter v. Robinson, 119 U. S. 530; *Shepard v. Carrigan*, 116 U. S. 593; *Erie v. American*, 70 Fed. 58.

The proceedings in the patent office, and the language of the specification and claim, place certain limitations upon the patent. The claim was rejected

on references and finally submitted in the form in which it appears. — *Lovell v. Johnson*, 91 Fed. 160; 33 C. C. A. 426.

In view of the prior state of the art and the proceedings had in the patent office, the claim of complainant's patent should be strictly construed against him and be restricted to the particular device described. — *Warren v. Casey*, 93 Fed. 963; 36 C. C. A. 29.

Mahn v. Harwood, 112 U. S. 354; *Sargent v. Lock*, 114 U. S. 63.

On that subject it is to be observed that the doctrines of equitable estoppel, or estoppel in pais, invoked in behalf of the appellee, are not involved or applicable. The estoppel, which arises in such cases is of the nature of estoppel by contract, and its scope in a particular case, like the meaning of a contract, is a matter of the interpretation and construction of the terms used according to their fair meaning. — *Magic v. Economy*, 97 Fed. 87; 38 C. C. A. 56.

Reece v. Globe, 61 Fed. 967.

As the applicant thereupon submitted his amended claims without change in the specifications, and accepted the patent upon the substituted claims, his acquiescence in the ruling forecloses any claim of invention in the rejected feature, through the well established doctrine of estoppel which then applies. — *Irwin v. Hasselman*, 97 Fed. 964; 38 C. C. A. 587.

Morgan v. Albany, 152 U. S. 425; *Richards v. Elevator*, 159 U. S. 477.

Having voluntarily abandoned the claim for method limited to the use of "a blast of heat" the patentee or his assignee may not insist that a broad claim containing no suggestion of such invention, shall nevertheless be subjected by construction to the same restriction. — *United States Repair v. Assyrian*, 100 Fed. 965; 41 C. C. A. 123.

Upon this and some further limitation, the patent was allowed. The patentee cannot now expand his claims to cover the ground he yielded in order to obtain the patent. What he conceded was accepted as one of the terms of the grant. — *Campbell v. Duplex*, 101 Fed. 282; 41 C. C. A. 351.

Roemer v. Peddie, 132 U. S. 313; *Royer v. Coupe*, 146 U. S. 524; *Thomas v. Rucker*, 77 Fed. 420.

The grant of the patent having been thus procured, certainly the complainant below was in no position to insist upon a construction of the allowed claim which would make it practically the equivalent of the rejected claim. — *Reineke v. Dixon-Woods*, 102 Fed. 349; 42 C. C. A. 388.

Morgan v. Albany, 152 U. S. 425.

In the proceedings on his original or forfeited application, he was required by the patent office to acknowledge the state of the art. This disposes of the contention that the device was a primary or pioneer invention. — *Walker v. Collins*, 102 Fed. 689; 42 C. C. A. 591.

The patentee himself acquiesced in a finding of the patent office that the existing state of the art negatived the patentability of the device of the patent in suit. The applicant struck out all of the before-quoted matter from his original specifications, and by so doing must be taken to have acquiescence in the action of the patent office. — *Newark v. Ryan*, 102 Fed. 693; 42 C. C. A. 594.

It is true that if a patentee acquiesces in the rejection of his claim on references cited in the patent office, and accepts a patent on an amended

claim, he is thereby estopped from maintaining that the amended claim covers the combinations shown in the references, and from claiming that it has the breadth of the claim that was rejected. — *National v. Interchangeable*, 106 Fed. 693; 45 C. C. A. 544.

Roemer v. Peddie, 132 U. S. 313; *Morgan v. Albany*, 152 U. S. 425; *Brill v. Car Co.* 90 Fed. 666; *Railroad Co. v. Kearney*, 158 U. S. 461; *Knapp v. Morss*, 150 U. S. 221; *Crawford v. Heysinger*, 123 U. S. 589.

One who acquiesces in the rejection of his claim because it is said to be anticipated by other patents or references is not thereby estopped from claiming and securing by an amended claim every known and useful improvement which he has invented that is not disclosed by those references. — *National v. Interchangeable*, 106 Fed. 693; 45 C. C. A. 644.

In this respect the case is altogether different from what it would have been if the invention had been of a fundamental character, and the inventor was sought to be deprived of substantial rights by reason of incidental action on the part of the examiners. — *Millard v. Chase*, 108 Fed. 399; 47 C. C. A. 429.

The patentee must be held to the results of the proceedings on his application, and be restricted thereby. — *Millard v. Chase*, 108 Fed. 399; 47 C. C. A. 429.

That a claim must be construed as limited by amendment and acquiescence in the Patent Office, see *Peifer v. Brown*, 112 Fed. 435; 50 C. C. A. 331.

Whatever doubt there might have been as to whether the claim was limited to the construction of its language by the specification, it was removed by the limitation which he put upon it by his explanation, the consequence of which was the allowance of his patent; and the claim must be read as limited in this respect in the same way as are the other claims. — *Dowagiac v. Superior*, 115 Fed. 886; 53 C. C. A. 36.

The correspondence between the attorneys for the patentee and the examiner's office, resulted in limitations of the first claim, which we are justified in calling enforced. The broader claims of the first application were abandoned, and the claims finally adopted cannot be construed as coextensive therewith. — *Carnegie v. Brislin*, 124 Fed. 213; 59 C. C. A. 651.

If he was in good faith, he desired the Patent Office to understand that his device was different from the reference. There is no doubt that the Patent Office so understood his representations. Under these circumstances, appellant will not be heard to assert that the Patent Office erred in rejecting his broad claims, or that we should give the claims allowed the meaning of those rejected. — *Ajax v. Pettibone*, 125 Fed. 748; 60 C. C. A. 516.

Roemer v. Peddie, 132 U. S. 313; *Phoenix v. Spiegel*, 133 U. S. 360.

In the light of what occurred in the Patent Office with reference to this patent, the inventor consented that his claim should have a literal, narrow construction. — *U. S. Peg-Wood v. Sturtevant*, 125 Fed. 382; 60 C. C. A. 248.

That conceded limitation of claims in the Patent Office is subsequently binding upon the patentee, see *Morgan v. Pennsylvania*, 126 Fed. 952; 62 C. C. A. 126.

The limitations thus imposed to secure the patent cannot now be disregarded. They constitute one of the terms of the grant. — *Hale v. World*, 127 Fed. 964; 62 C. C. A. 596.

Campbell v. Duplex, 101 Fed. 282; *Roemer v. Peddie*, 132 U. S. 313; *Royer v. Coupe*, 146 U. S. 524; *Thomas v. Rucker*, 77 Fed. 420.

Where a patentee acquiesces in a rejection of claims, and amends the same so as to be more specific, such claims must be read and interpreted with reference to the rejected claims and to the prior state of the art, and cannot be construed to cover either what was rejected by the Patent Office or disclosed by prior devices. — *Greene v. Buckley*, 135 Fed. 520; 68 C. C. A. 70.

Knapp v. Morss, 150 U. S. 221; *Roemer v. Peddie*, 132 U. S. 313; *Phoenix v. Spiegel*, 133 U. S. 360; *Singer v. Cramer*, 192 U. S. 265; *Reece v. Globe*, 61 Fed. 958; *Wood v. Deering*, 66 Fed. 547; *Ball v. Ball*, 58 Fed. 818.

It is quite unimportant that various claims in both applications were rejected, and the rejection acquiesced in by applicant, so long as the office finally granted the claim which is now in controversy. There is no question here of the construction of the claim, and no attempt to broaden it or to narrow it. — *Kinnear v. Wilson*, 142 Fed. 970; 74 C. C. A. 232.

It is questionable whether the applicant, instead of cancelling, might not have so amended the rejected claims as to differentiate them from the references cited, and still protect some of the broader elements of his invention. But however that may be, he acquiesced in the action of the Patent Office, and elected to substitute the present narrow claims in suit, and is now estopped to so expand them as to embrace the rejected subject matter. — *Van Epps v. United*, 143 Fed. 869; 75 C. C. A. 77.

The applicant acquiesced in the rejection, and amended his claim by adding the interlocking means. Thus it was conceded, and the complainant is precluded from asserting the contrary, that, except for the interlocking means, there was no novelty in the invention claimed. — *Ironclad v. Dairyman's*, 143 Fed. 512; 74 C. C. A. 372.

Examination discloses that he was compelled over and over again to amend and narrow his claims in order to avoid the prior art. The waiver and disclaimers of the file-wrapper were acquiesced in by the patentee in order to obtain his patent, and he is estopped from denying their force and effect. — *Williams v. Kemmerer*, 145 U. S. 928; 76 C. C. A. 466.

Hubbell v. U. S. 179 U. S. 77; *Shepard v. Carrigan*, 116 U. S. 593.

That where a claim is allowed only after strict limitation, such limitation cannot be disregarded in considering the question of infringement, see *United v. Greenman*, 146 Fed. 759; 77 C. C. A. 22.

That an applicant having added an element to his claim to make it allowable, as required by the Patent Office, and acquiescing in such limitation, is strictly limited to a construction containing such added element, see *Schweichler v. Levinson*, 147 Fed. 704; 78 C. C. A. 92.

After repeated amendments of the claims, to meet objections for conflict or want of invention, the claims in suit were allowed and the patent issued. The limitations thus imposed leave little, if any, scope for the claims beyond the several means which are specifically shown. — *Schock v. Olsen*, 147 Fed. 229; 77 C. C. A. 371.

The patentee repeatedly acquiesced in rejections of his application for a broad claim, and substituted therefor narrower claims, one after the other, upon each rejection, until his application was granted whereby water is delivered under pressure forwardly and laterly nearly parallel to the surface of the street. In such circumstances the owner of the patent will not be heard to insist that the narrower claim allowed shall cover the broader rejected claims. — *St. Louis v. American*, 156 Fed. 574; 84 C. C. A. 349.

Knapp v. Morss, 150 U. S. 221; *Corbin v. Eagle*, 150 U. S. 38; *Hubbell v. U. S.* 179 U. S. 77; *Computing v. Automatic*, 204 U. S. 609; *Greene v. Buckley*, 135 Fed. 520.

In the case of a meritorious invention a reasonable liberality in applying the doctrine of equivalents is not unusual, and patentees are not always held closely to the precise form stated in the claim when the same functions are found in a structure of a somewhat different form. But the history of this patent during its passage through the patent office precludes any construction of the claim which will eliminate the qualifying words "spirally wound." — *National v. Roebling's*, 158 Fed. 99; 85 C. C. A. 567.

Victor v. American, 151 Fed. 601.

The applicant had a long struggle in securing his patent, and was constrained to trim away, modify, and otherwise define his specifications and claims to meet the references made by the office, until they were brought within very narrow limits before his patent would be allowed. He must be deemed to have surrendered and disclaimed what he conceded, and to have imposed such definitions upon the language of the patent as he attributed to it in order to secure the grant. — *American v. Cleveland*, 158 Fed. 978; 86 C. C. A. 182.

Sargent v. Hall, 114 U. S. 63; *Thomas v. Rucker*, 77 Fed. 420; *Dowagiac v. Superior*, 115 Fed. 886; *Hale v. World*, 127 Fed. 964; *Muller v. Lodge*, 77 Fed. 621; *Warren v. Casey*, 93 Fed. 963; *Streit v. Kaiper*, 143 Fed. 981; *New York v. Ambler*, 103 Fed. 316.

§ 208. Construction — Limitation — Patent Office Action Not Limiting.

We do not mean to be understood as asserting that any correspondence between the applicant and the commissioner can be allowed to enlarge, diminish or vary the language of a patent afterwards issued. Undoubtedly a patent, like any other written instrument, is to be interpreted by its own terms. But when a patent bears on its face a particular construction, inasmuch as the specification and claim are in the words of the patentee, it is reasonable to hold that such a construction may be confirmed by what the patentee said when he was making his application. The understanding of a party to a contract has always been regarded as of some importance in its interpretation. — *Goodyear v. Davis*, 102 U. S. 222; 26 L. Ed. 149.

It is quite true, where the differences between the claim made and as allowed consist of mere changes of expression, having substantially the same meaning, such changes, made to meet the views of the examiner, ought not to be permitted to defeat a meritorious claimant. While not allowed to revive a rejected claim by a broad construction of the claim allowed, yet the patentee is entitled to a fair construction of the terms of his claim as actually granted. — *Hubbell v. U. S.* 179 U. S. 77; 45 L. Ed. 95; 21 S. Ct. 24.

The applicant amended his claim to comply with a requirement to put it in proper form. Such an amendment cannot be classed as a disclaimer. — *Hunt Bros. v. Cassidy*, 53 Fed. 257; 3 C. C. A. 525.

It may well be, in view of *Royer v. Coupe*, 146 U. S. 524; *Knapp v. Morss*, 150 U. S. 224; *Corbin v. Eagle*, 150 U. S. 40, and *Morgan v. Albany*, 152 U. S. 425, cited, that a patentee cannot be permitted to hold under his patent anything that he has clearly renounced and excluded from his inventions during the prosecution of his application. But surely it has never been held that mere changes in phraseology to suit the views of the examiner, and to distinguish the claims made from those contained in prior applications, to which reference has been made, can be held to defeat the patent, when granted. What is forbidden is the attempt, after a patent has been procured surrendering or disavowing substantial claims or devices, to recover such renounced and abandoned claims by demanding a broad construction of those allowed. — *Hillborn v. Hale*, 69 Fed. 958; 16 C. C. A. 569.

It is plain that, whatever were the views of the patent office, the matter stricken out was mere surplusage, and its omission was of no effect. — *Heap v. Greene*, 91 Fed. 792; 34 C. C. A. 86.

Winans v. Denmead, 15 How. 330; *Reece v. Globe*, 61 Fed. 958.

To be estopped by the action of the Patent Office, the patentee must be shown to have surrendered something which he now claims in order to obtain that which was allowed. — *Bundy v. Detroit*, 94 Fed. 524; 36 C. C. A. 375.

The effect of *Reece v. Globe*, as shown at the foot of page 969 of 61 Fed. and page 205 of 10 C. C. A., is to hold that such proceedings are of no effect when no direct issue of novelty or invention was involved, or when the amendments made by the applicant came in only incidentally, or in reference to an incidental matter. The case at bar, however, is clearly not excluded by the rule thus given. — *Coburn v. Chandler*, 97 Fed. 333; 38 C. C. A. 201.

So, the applicants never acquiesced in the examiner's action; the examiner did not require the amendment as a condition precedent to the allowance of claims narrower than originally made; and the appellate tribunal allowed the claims after examining the device in the spirit that giveth life. — *Regent v. Penn.* 121 Fed. 80; 57 C. C. A. 334.

That the subsequent allowance of a claim without the restriction imposed may remove such restriction, see *Kelley v. Diamond*, 123 Fed. 832; 59 C. C. A. 370.

That a claim formulated in the Patent Office for an interference will not be construed as limiting the invention, see *Reed v. Smith*, 123 Fed. 878; 59 C. C. A. 366.

It is a corollary to the general rule, that if the applicant successfully defends his position and secures the assent thereto of those in the office having charge of the application, and the patent issues notwithstanding the objection which had at one time been urged, the patent is not subject to diminution on that account. — *American v. Cleveland*, 158 Fed. 978; 86 C. C. A. 182.

That the file-wrapper contents of an abandoned application by the same person upon the same invention is not necessarily evidence of limitation of claims, see *Delaware v. Shelby*, 160 Fed. 928; 88 C. C. A. 110.

That rejection prior to amendment by the Patent Office does not argue for the invalidity of a claim subsequently amended and allowed as amended, see *Dunn v. Standard*, 163 Fed. 521; C. C. A.

§ 209. Construction—Limitation—Patent Office Action—Protest.

We now come to the novel question presented in this case. It is argued, and the circuit court held, that because the applicants after the rejection of

the claims, and after inserting the required limitations in the specifications, protested that the examiner was wrong in rejecting the claims, and advised him that they proposed to insist on a construction of claims as amended to cover the same ground as the rejected claims, the ruling of the patent office is not to be given the same effect as it would otherwise have. It seems to be contended that an applicant can qualify or minimize the effect of his acquiescence in the rejection of a claim by stating to the patent office that it is not an acquiescence, and that he expects to insist upon his right to cover the same ground as the rejected claim covered, under other and amended claims. We are clearly of opinion that he cannot thus destroy the effect of a patent office ruling. — *Thomas v. Rocker*, 77 Fed. 420; 23 C. C. A. 211.

§ 210. Construction — Limitation — Patent Office Action — Rule.

In order that the proceedings in the Patent Office should positively operate as a waiver or estoppel, they must relate to the pith and marrow of the alleged improvement, and be understandingly and deliberately assented to. — *U. S. Peg-Wood v. Sturtevant*, 125 Fed. 382; 60 C. C. A. 248.

Magic v. Economy, 97 Fed. 87; *Paxton v. Brinton*, 107 Fed. 137.

§ 211. Construction — Limitation — Specific Claims.

When a device designed merely for the improvement of a well-advanced art is described as having particular features of construction which are adapted to accomplish specific results or modes of operation, and the claim of the patent is for that device, the features so described are covered by the claim, and may not be rejected, or treated as of secondary importance, in order to extend the patent over other forms or features not described. — *Temple v. Goss*, 58 Fed. 196; 7 C. C. A. 174.

The claim of a specific combination or device in a patent is a renunciation of every claim to any other combinations or devices, for performing the same functions that are apparent from the face of the patent and are not colorable evasions of the combination or device claimed. — *Stirratt v. Excelsior*, 61 Fed. 980; 10 C. C. A. 216.

A combination for a specific invention is limited to the precise elements. — *Muller v. Lodge*, 77 Fed. 621; 23 C. C. A. 357.

Water Meter v. Desper, 101 U. S. 332; *Sargent v. Lock Co.* 114 U. S. 63; *Fay v. Cordesman*, 109 U. S. 408; *Hendy v. Iron*, 127 U. S. 371.

By force of the specification and drawings of the patent and the concluding terms of each of the claims, of which infringement is alleged, the invention is limited to certain peculiarities of construction and resulting functions described. — *Johnson v. Powers*, 85 Fed. 863; 29 C. C. A. 459.

But if the invention of this patent could be classified as a primary one, still the terms of claim 5 are so restricted that upon no sound principle of construction could it be held to cover the devices used by the defendants. — *Stokes v. Heller*, 101 Fed. 266; 41 C. C. A. 335.

Keystone v. Phoenix, 95 U. S. 274; *Railroad v. Mellon*, 104 U. S. 112; *McClain v. Ortmyer*, 141 U. S. 419; *Wright v. Yuengling*, 155 U. S. 47; *Lewis v. Steel Co.* 59 Fed. 129; *Duff v. Pump Co.* 107 U. S. 636; *Bragg v. Fitch*, 121 U. S. 478; *Knapp v. Morss*, 150 U. S. 221.

Having thus described his conveyor in his claim, he puts it forward as a constituent of his invention, and he could not now say that the kind of

frame he will employ is different. — *Moore v. Eggers*, 107 Fed. 491; 46 C. C. A. 425.

Keystone v. Phoenix, 95 U. S. 274; *Fay v. Cordesman*, 109 U. S. 408; *Brown v. Mfg. Co.*, 57 Fed. 731; *Mfg. Co. v. Randal*, 104 Fed. 355.

While the patent to Myers was issued more than a year in advance of the patent in suit, the application for it was filed 11 days after, so that they were for a time co-pending in the Patent Office. No interference was declared. That the existence of the Myers patent was recognized and its drawings cited during the pendency of the application of the patent in suit is conceded. The fact of the allowance, with the grant to Myers in view, and under the circumstances stated, is presumptive of an understanding that claim 1 was limited to the structure substantially as described — not in conflict with Myers' device — and of purpose to confer monopoly within such scope. The presumption thus arising would not overcome the grant for an invention which was broadly specified and broad in fact. — *Lowden v. Janesville*, 148 Fed. 686; 78 C. C. A. 548.

§ 212. Construction — Limitation — Specification and Drawings.

Claims must be limited to the means described in the specification. — *Hailes v. VanWormer*, 87 U. S. 353; 22 L. Ed. 247.

The plain and explicit language of the specification requires a construction of the claim which will enable the defendant to escape liability. There is nothing in the context to indicate that the patentee contemplated any alternative arrangement. — *Snow v. Railway*, 121 U. S. 617; 30 L. Ed. 1004; 7 S. Ct. 1343.

The description does not necessarily limit the claims. — *Continental v. Eastern*, 210 U. S. 405; 51 L. Ed. 922; 28 S. Ct. 748.

A mere reference in a claim to a letter on the drawing does not of itself limit the claim to the precise geometrical shape shown in the drawing, even though the description of the drawing in the specification refers to the part thus lettered by an adjective appropriate to the form shown in the drawing, unless that particular form is pointed out in the specification, or was known by the state of the art to be the particular improvement the inventor claimed. — *DeLamater v. Heath*, 58 Fed. 414; 7 C. C. A. 279.

Reed v. Chase, 25 Fed. 100.

As we have shown, the specification and drawings clearly contemplate the use of a track consisting of two small wires placed side by side, and this limitation enters into the claims by necessary implication. — *Lamson v. Godehard*, 59 Fed. 776; 8 C. C. A. 265.

Roller Mill v. Walker, 138 U. S. 124; *Caster Co. v. Spiegel*, 133 U. S. 360; *Bragg v. Fitch*, 121 U. S. 478; *Keystone v. Phoenix*, 95 U. S. 274; *Sharp v. Riessner*, 119 U. S. 631.

The claim should be read and construed in the light of the description of the invention and drawings attached, and of the state of the art to which the invention belongs, not to enlarge the claim, but to ascertain its true meaning and the actual invention asserted, and which the inventor desired to secure by letters patent. — *Card v. Colby*, 64 Fed. 594; 12 C. C. A. 319.

It would seem that the usual preliminary statement of the class and nature of the improvement, in the absence of any declaration of broad invention,

would be construed as limiting the claim within the class and to the means specified. — *Schuyler v. Electric*, 66 Fed. 313; 13 C. C. A. 491.

Words and phrases which might have been omitted, on the presumption that they relate to nonessentials, may be introduced in such direct and positive manner as to leave the courts no option except to regard them as effecting the objects and limitations of the instrument in question. — *Long v. Pope*, 75 Fed. 835; 21 C. C. A. 533.

Reece v. Globe, 61 Fed. 958.

The scope of letters patent must always be limited to the invention predicated in the claim, and this claim can never be enlarged by any language employed in other parts of the specification. — *Tiemann v. Kratz*, 85 Fed. 437; 29 C. C. A. 257.

Railroad v. Mellon, 104 U. S. 112.

General language in a claim which points to an element or device which is more fully described in the specification, is limited to such an element or device as is there described. — *Expanded v. Board*, 111 Fed. 395; 49 C. C. A. 406.

Smith v. Vulcanite, 93 U. S. 486; *Adams v. Lindell*, 77 Fed. 432; *Mitchell v. Tilghman*, 19 Wall. 287.

Note: The citations do not bear out so broad a statement. Unqualified, the statement clearly is not the law. Such is the law with a narrow, specific improvement; but with a generic invention, it is not.

§ 213. Construction — Limitation — State of Art.

Having reference to the state of the art at the date of the alleged invention and the claims of the patent, the patentee must be limited to the combination shown. — *Wollensak v. Reiher*, 115 U. S. 87; 29 L. Ed. 355; 5 S. Ct. 1132.

It is undoubtedly true that if the prior state of the art exhibits the combination of all these essential elements, except the peculiarly constructed hinge the patentees show, accomplishing substantially the same purpose which their improved construction brings about, then the claims of this patent must be restricted to the peculiar construction of the hinge. — *Griswold v. Harker*, 62 Fed. 389; 10 C. C. A. 435.

Stirratt v. Mfg. Co. 61 Fed. 980.

Manifestly neither of the patents is for a primary invention. In each instance patentability may be conceded. Nevertheless, these inventions, by reason of the state of the prior art, belong to that class in which the patentee is to be restricted to the specific form of improvement shown and described. — *Ryan v. Runyon*, 93 Fed. 970; 36 C. C. A. 36.

Railway v. Sayles, 97 U. S. 554; *Duff v. Pump Co.* 107 U. S. 636.

In view of the limitations imposed upon the claims by the prior state of the art, they ought not to receive a construction which will enable them to cover a combination in which the several devices are not substantially those described in the patent. It will not do to say that, because the patentee was the first to introduce locking devices into a motor in which the regulator and reverser were operated by different levers, he is entitled to a monopoly of all locking devices in such a motor that will co-ordinate the movements of the two levers so that neither will move except when the other is at a

predetermined position. Precisely that function had been previously performed by the locking devices used to co-ordinate levers, and, if the patentee had done no more than to introduce them into the levers of a motor, he would merely have made a change of location. He is entitled to the merit of being the first to conceive of the utility of interlocking the two levers of a motor controller of the type in which separate levers are employed, but his right to a patent must rest on the novelty of the means he has contrived to carry his idea into practical application. — *Thomson-Houston v. Lorain*, 107 Fed. 711; 46 C. C. A. 593.

Aron v. Railroad, 132 U. S. 84.

Where none of the prior inventors exhibits or suggests any co-operation of the elements upon the principle adopted by the patent in suit, or upon any principle adapted to serve the same purpose, the use of the old elements may limit, but cannot defeat the patent. — *Imperial v. Crown*, 139 Fed. 312; 71 C. C. A. 442.

Note: *Brawley, J.*, 4th Circ. writing the above. How such a prior device or the use of old elements "may limit" the patent does not appear. So much of this statement is distinctly untenable; for if it were the fact that prior use of the elements of an invention without ever producing the result attained by the patent could be postulated to limit the claim, such a thing as a generic invention or a primary improvement would be impossible.

In our judgment the reason of the case leads to the conclusion that between contracting parties, extraneous evidence is inadmissible if there is no ambiguity or uncertainty in the language of the description and claims, and that, if there is uncertainty, outside evidence is admissible only to make clear what the applicant meant to claim and the government to allow, and not for the purpose of showing, even in the slightest degree, that the applicant had no right to claim and that the government was improvident in allowing what was in fact claimed and allowed. — *Siemens-Halske v. Duncan*, 142 Fed. 157; 73 C. C. A. 375.

Trotman v. Wood, 16 C. B. (N. S.) 479; *Clark v. Adie*, L. R. 2 App. Cas. 423; *Chambers v. Chrichley*, 33 Beavan, 374; *Crossley v. Dixon*, 10 H. of L. Cas. 293; *United States v. Harvey*, 196 U. S. 310; *Faulks v. Kamp*, 3 Fed. 898; *Consolidated v. Guilder*, 9 Fed. 155; *Underwood v. Warren*, 21 Fed. 573; *Parker v. McKee*, 24 Fed. 808; *Pope v. Owsley*, 27 Fed. 100; *American v. Laraway*, 28 Fed. 141; *Adee v. Thomas*, 41 Fed. 342; *Woodward v. Boston*, 60 Fed. 283; *Babcock v. Clarkson*, 63 Fed. 607; *National v. Connecticut*, 73 Fed. 491; *Alvin v. Scharling*, 100 Fed. 87; *Standard v. Leslie*, 118 Fed. 557; *Frank v. Barnard*, 131 Fed. 269; *contra Noonan v. Chester*, 99 Fed. 90; *Smith v. Ridgley*, 103 Fed. 875.

§ 214. Construction — Limitation — Words of Limitation.

"Substantially as set forth" are words of limitation in a claim which limit the combination to the elements described. — *Pope v. Gormully*, 144 U. S. 248; 36 L. Ed. 423; 12 S. Ct. 641.

To prevent a broadening of the scope of the invention beyond its fair import in the light of the circumstances surrounding the issuance of the patent, the words of limitation contained in the claim must be given due effect, and, giving them such effect, the statement in the first claim of the elements entering into the combination must be construed to refer to elements in combination having substantially the form and constructed substantially as described in the specification and shown in the drawing. — *Singer v. Cramer*, 192 U. S. 265; 48 L. Ed. 437; 24 S. Ct. 291.

The words "substantially as described" are words of limitation and restriction in the claim of an improvement. — *Fox v. Perkins*, 52 Fed. 205; 3 C. C. A. 32.

Shepard v. Carrigan, 116 U. S. 598.

In view of the state of the art, the claim cannot be broadly construed, and it must be held to be fully limited by the words "substantially as described." — *Reece v. Globe*, 61 Fed. 958; 10 C. C. A. 194.

Railway v. National, 110 U. S. 229.

If therefore, the words "substantially as described," be omitted from the claim, and the preceding language be taken literally, nothing new would be embraced and the claim would consequently be invalid. — *Campbell v. Richardson*, 76 Fed. 976; 22 C. C. A. 669.

The words "substantially as set forth," with which this claim concludes, referred to the specification and make the description of the housings therein contained an essential part of the claim. "General language in a claim which points to an element or device more fully described in the specification, is limited to such an element or device as is there described." — *Brill v. St. Louis*, 90 Fed. 666; 33 C. C. A. 213.

Adams v. Lindell, 77 Fed. 432; *Mitchell v. Tilghman*, 19 Wall. 287; *Stirrat v. Mfg. Co.* 61 Fed. 980.

The second claim is narrow and is limited to the corrugations "substantially as set forth." The defendant's dies not having the same corrugations or the corrugations located in the same situation on the dies, do not infringe this claim. — *Simonds v. Hathorn*, 93 Fed. 958; 36 C. C. A. 24.

If the claim is to be read in connection with the specification, or any significance is to be attached to the words "substantially as described," it plainly must be limited to the coils of the patent. — *Webster v. General*, 115 Fed. 497; 53 C. C. A. 229.

Limited as above stated, appellant's structure does not infringe the specific organization covered by the first claim of the patent in suit. The words "substantially as set forth," with which the claim concludes, cannot here be ignored. — *Carnegie v. Brislin*, 124 Fed. 213; 59 C. C. A. 651.

He expressly declares that he does not intend to limit himself with regard to the different parts of his invention — a reservation sufficient, as it would seem to overcome the customary formula "substantially as described," at the end of the claim. — *Boyer v. Keller*, 127 Fed. 130; 62 C. C. A. 244.

That where the improvement is narrow the words "substantially as set forth" must be construed as words of limitation, see *Rose v. Dowden*, 157 Fed. 681; 85 C. C. A. 449.

Erie v. American, 70 Fed. 58.

§ 215. Construction — Limitation — Miscellaneous Rules.

Winans v. Denmead, 15 How. 330 construed with other cases and followed. — *Reece v. Globe*, 61 Fed. 958; 10 C. C. A. 194.

Miller v. Mfg. Co. 151 U. S. 186; *Mfg. Co. v. Adams*, 151 U. S. 139; *Snow v. Railway*, 121 U. S. 617; *Sargent v. Lock Co.* 114 U. S. 63; *Water Meter v. Desper*, 101 U. S. 332; *Fay v. Cordesman*, 109 U. S. 408; *Corn Planter Pat.* 23 Wall. 181; *Hoyt v. Horne*, 145 U. S. 302.

Doubtless a patentee is entitled to every use to which his invention is susceptible, whether such use be known or unknown to him (*Potts v. Craeger*, 155 U. S. 597) and if the patent applying the means used in the former art were in force it would doubtless be entitled to control the use of the device in the later art. Under the doctrine which gives to the patentee all the uses to which his invention is susceptible, whether known or unknown, it is difficult to see why the public should not be entitled to all the uses to which the means involved in devices covered by lapsed patents are susceptible, or why a patentee who employs the old means with improvements adapting the use to a new or analogous industry should not be limited to a monopoly of the combination or improved machine. To say that one who discovers that old means will do a new work without any change may thereby monopolize the old means as applied to such new work, would be carrying the discovery doctrine altogether too far. — *Wright v. Clinton*, 67 Fed. 790; 14 C. C. A. 646.

Brook v. Ashton, 27 Law. J. Q. B. 145; *Potts v. Craeger*, 155 U. S. 101; *Penna. v. Locomotive*, 110 U. S. 190; *Brown v. Piper*, 91 U. S. 37; *Roberts v. Ryer*, 91 U. S. 150; *Atlantic v. Brady*, 107 U. S. 192; *Tucker v. Spalding*, 13 Wall. 453; *Rob. Pat.* 259 n. 1; *Knapp v. Morss*, 150 U. S. 221; *Duff v. Pump*, 107 U. S. 636; *Newton v. Furst*, 119 U. S. 373; *Bragg v. Fitch*, 121 U. S. 478; *Dryfoos v. Wiese*, 124 U. S. 32.

Features described as preferable do not constitute a limitation of the claim. When the inventor says, "I recommend the following method," he does not thereby constitute such method a portion of his patent. His patent may be infringed, although the party does not follow his recommendation, but accomplishes the same end by another method. — *Krajewski v. Pharr*, 105 Fed. 514; 44 C. C. A. 572.

Sewall v. Jones, 91 U. S. 171.

In view of these circumstances (the narrowness of invention) and of the fact that the apparatus of the patent in suit is of doubtful utility, and does not appear ever to have been put upon the market, the claims can only be so interpreted as to cover details of construction. — *Huber v. Mott*, 125 Fed. 944; 60 C. C. A. 182.

§ 216. Construction — Limitation to Avoid Anticipation.

We ought to give a favorable construction so as to sustain the patent if it can be fairly done. — *Brown v. Guild*, 90 U. S. 181; 23 L. Ed. 161.

The patent in suit, in order that it may be held valid, must be construed in view of the disclaimer contained in that patent, and be limited to the particular devices shown in the specification. — *Ashcroft v. Boston*, 97 U. S. 189; 24 L. Ed. 982.

Where the complainant insists upon an extension of his claim he must submit also to the risk of anticipation. — *Sutter v. Robinson*, 119 U. S. 530; 30 L. Ed. 492; 7 S. Ct. 376.

A construction broad enough to cover infringement by equivalency may defeat the claim, because broadening the construction broadens the danger of anticipation. — *Pope v. Gormully*, 144 U. S. 238; 36 L. Ed. 420; 12 S. Ct. 637.

If complainant's claim should receive such construction as would cover defendant's machine, then it was clearly anticipated in the prior devices already referred to; that if valid under a narrow and restricted construction, which would limit the patent to the specific device described in the specifica-

tion, then it is not infringed by defendants. — *Fox v. Perkins*, 52 Fed. 205; 3 C. C. A. 32.

If the claims of the patent in suit were so constructed as to charge the defendant with infringement, the claims would be void for want of novelty; if construed so as to avoid anticipation, defendant does not infringe. — *Gates v. Fraser*, 55 Fed. 409; 5 C. C. A. 154.

To construe the claims of the patent so broadly as to cover appellant's device would render them worthless. — *Holman v. Jones*, 61 Fed. 105; 9 C. C. A. 385.

There is nothing new in the elements described. The only novelty is in the combination; and in this respect the device differs so little from others of an earlier date shown by the art, and intended for the same use, that the claims must be narrowly construed. We agree with the circuit court that the proofs do not exhibit anything sufficient to repel the ordinary presumption attending the grant of a patent. But this is only true, we think, when the claims are thus narrowly construed. — *Holman v. Jones*, 61 Fed. 105; 9 C. C. A. 385.

The invention being specific and limited, if the claims warranted a construction broad enough to cover the device of the appellee, we should have no hesitation in holding it void for want of novelty. — *Stirrat v. Excelsior*, 61 Fed. 980; 10 C. C. A. 216.

Atlantic v. Brady, 107 U. S. 192; *Vinton v. Hamilton*, 104 U. S. 485; *Slawson v. Railroad*, 107 U. S. 653; *King v. Gallun*, 109 U. S. 99; *Double Pointed v. Two Rivers*, 109 U. S. 117; *Estey v. Burdett*, 109 U. S. 633; *Bussey v. Mfg. Co.* 110 U. S. 131; *Phillips v. Detroit*, 111 U. S. 604; *Morris v. McMillin*, 112 U. S. 244; *Hollister v. Mfg. Co.* 113 U. S. 59; *Ellbert v. Gaslight Co.* 50 Fed. 205.

To imply as elements of a claim parts not named therein for the purpose of limiting its scope, so that it may be accorded novelty, is contrary to a well-settled rule of the patent law. — *Stearns v. Russell*, 85 Fed. 218; 29 C. C. A. 121.

McCarty v. Railroad, 160 U. S. 110.

These changes are of so slight a character, and the improvement by the new combination so debatable, that if any liberality in construction, or in the application of the doctrine of equivalents, be conceded for the purpose of including other improvers, along the same lines within the scope of this patent, it will have the necessary effect of rendering it void for anticipation. "That which infringes it, if later, anticipates it if earlier." — *St. Louis v. National*, 87 Fed. 885; 31 C. C. A. 265.

It is manifest that the inventions secured by the claims are of very narrow character, and that they cannot receive the broad construction which their language would authorize without affirming their invalidity for want of patentable novelty. — *Brill v. Pekham*, 108 Fed. 267; 47 C. C. A. 315.

Courts are reluctant to decree patents invalid when a decree can be based on infringement. — *Wilcox v. Sherborne*, 123 Fed. 875; 59 C. C. A. 363.

Note: This is lamentably true; and is one main respect in which the courts fail to do their duty by the public. If a patent is invalid and the court has jurisdiction thereof, it is the plain duty of the court as a servant of the Republic to destroy the illegal monopoly.

Even where a patent incidentally makes express reference to features other than the essential features, it has been held that the patent cannot be supported by such features alone, if the inventor does not rely upon them in describing the substance of his invention. Still less can a patent be supported

by features not referred to, claimed, or even suggested in the patent, and not a function of thing patented except when used in a special combination not claimed. — *Greene v. United*, 132 Fed. 973; 66 C. C. A. 43.

Waterman v. Lockwood, 125 Fed. 490.

§ 217. Construction — Narrow.

When the claim is confined to a particular article or fabric, it is tantamount to a declaration that nothing else was claimed. — *White v. Dunbar*, 119 U. S. 47; 30 L. Ed. 303; 7 S. Ct. 72.

The plaintiff's patent must be limited to the mechanism described and claimed by him, and cannot be extended so as to cover all mechanism for performing the function attained, nor to the process of operation described in his patent; and the defendant's mechanism, in each form of his machine cannot be regarded as merely an equivalent for the plaintiff's mechanism. — *Dryfoos v. Wiese*, 124 U. S. 32; 31 L. Ed. 362; 8 S. Ct. 354.

Yale v. Sargent, 117 U. S. 373.

Where, in a specific patent the claim is limited to the elements shown and claimed, the omission of an element thereof avoids infringement. — *Forn-crook v. Root*, 127 U. S. 176; 32 L. Ed. 97; 8 S. Ct. 1247.

Fay v. Cordesman, 109 U. S. 408; *Yale v. Sargent*, 117 U. S. 373; *Dryfoos v. Wiese*, 124 U. S. 32.

Where the patent in suit is not a pioneer patent the claims must be strictly construed. — *Clark v. Willimantic*, 140 U. S. 481; 35 L. Ed. 521; 11 S. Ct. 846.

Where it appears that the patent in suit is not a pioneer in the art, the claims will be construed strictly and narrowly to the device described. — *Gordon v. Warder*, 150 U. S. 47; 37 L. Ed. 992; 14 S. Ct. 32.

It clearly appears that complainant was not a pioneer in this department of machinery. Many inventors had preceded him and many patents had been issued. We think the case is one where, in view of the state of the art the patentee is entitled, at the most, only to the precise devices mentioned in the claims. — *Boyd v. Janesville*, 158 U. S. 260; 39 L. Ed. 973; 15 S. Ct. 837.

The claim of the patent, in view of the state of the art, covers a very narrow invention, if construed to cover the device of defendant it is void for want of novelty. — *Hammond v. Goodyear*, 58 Fed. 411; 7 C. C. A. 276.

This patent is a subordinate one, and must receive a narrow construction. It is not permissible to give to the terms of a patent of that class so wide a sweep as to include the various devices which may actuate the mechanism, and the range of its monopoly is a limited one. — *Westinghouse v. N. Y.*, 63 Fed. 962; 11 C. C. A. 528.

A claim for only the arrangement and combination of parts must be limited to a strict construction. — *Roemer v. Peddie*, 78 Fed. 117; 24 C. C. A. 39.

We find the first claim of the patent is for a specific combination of elementary parts. Upon well settled principles, this claim must be construed strictly, and the patentee held to the particular arrangement of parts described and specified. — *DeBeaumont v. Williames*, 80 Fed. 995; 26 C. C. A. 298.

Duff v. Pump Co. 107 U. S. 636; *Bragg v. Fitch*, 121 U. S. 478; *Snow v. Rail-way*, 121 U. S. 617; *Wright v. Yuengling*, 155 U. S. 47.

The facts that the claim is a narrow one, and that, after notice from patent office, Fay adhered to the special form of claim previously adopted; that the tool had not become generally commercial; and that the patentee unreasonably rested upon his supposed rights, — taken together, present a situation which forbids a liberal construction of the patentee's claims for the purpose of sustaining the contention of infringement. — *Starrett v. Stevens*, 100 Fed. 93; 40 C. C. A. 289.

It is true that Hamilton was the first inventor of a time-printing machine for directly measuring and recording intervals of time. It is also true that for this reason his patent should be liberally construed. But, at the same time, we know of no rule for construction which will permit the court to hold a machine to be an infringement of that patent which does not contain the original and vital elements of the invention, in a suit in which the claim of the patent relied upon expressly makes these elements a part of the combination covered by the claim. — *Wilson v. Calculagraph*, 144 Fed. 91; 75 C. C. A. 249.

§ 218. Construction — Omitting Element.

A patentee cannot claim the benefit of an element of his invention thus vaguely and indefinitely hinted at. It is clear that if the patentee intended to include the cooling of the wax or paraffine before compressing it upon the wire, he has failed to describe in his specification that element of his invention as required by the statute. Instead of describing the process he mentions a quality of the product, and asks the court to infer the process from the quality. Such a vague and inverted method of description is not a compliance with the statute. That part of the alleged invention is not even referred to in the most distant manner in the claim. It has been held by this court that, "the scope of letters patent should be limited to the invention covered by the claim; and, though the claim may be illustrated, it cannot be enlarged by the language in other parts of the description." — *Western v. Ansonia*, 114 U. S. 447; 29 L. Ed. 210; 5 S. Ct. 447.

R. R. v. Mellon, 104 U. S. 112.

The claim could hardly be construed to permit the omission of any of the described steps of the process, unless such omission had been recognized in the specification. — *U. S. Repair v. Standard*, 95 Fed. 137; 37 C. C. A. 28.

§ 219. Construction — Plain Intent and Meaning.

The courts of this country cannot always indulge the same latitude which is exercised by English judges in determining what parts of a machine are or are not material. Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, we cannot declare that any one of these elements is immaterial. The patentee makes them all material by the restricted form of his claim. We can only decide whether any part omitted by an alleged infringer is supplied by some other device or instrumentality which is its equivalent. — *Union v. Desper*, 101 U. S. 332; 25 L. Ed. 1024.

The meaning of letters patent, like other grants or written instruments, must be ascertained by the language employed, as applied to the subject matter. — *Krajewski v. Pharr*, 105 Fed. 514; 44 C. C. A. 572.

Robinson v. Sutter, 8 Fed. 828; *Adams v. Iron Co.* 26 Fed. 324; *Sayre v. Scott*, 55 Fed. 971.

Some allowance may well be made for an unlearned man, when we remember that in the recent case of *Westinghouse v. Boyden*, 170 U. S. 537, the Supreme Court itself required three hearings before it could determine the meaning and scope of the patent claims, and the record in this case shows that such learned experts as Gen. Spear and Mr. Walker differ radically as to what the claims of the original patent cover. — *Crown v. Aluminum*, 108 Fed. 845; 48 C. C. A. 72.

Such a restriction was not required by the prior act, in order to save the claim from being declared invalid, and, except for the purpose of saving a claim, its scope should not be restricted beyond the fair and ordinary meaning of the words. — *Ryder v. Schlichter*, 126 Fed. 487; 61 C. C. A. 469.

Winans v. Denmead, 56 U. S. 341; *Consolidated v. Columbian*, 79 Fed. 795; *Gaisman v. Gallert*, 105 Fed. 955.

These claims (the specific claims) are concerned with the particular structure described by the drawings and the specification, and to confine the fourth claim, which is drawn broadly, to such a structure, denies to the claim any effect whatever. This, we think, goes too far. It requires us to suppose that the inventor prepared a claim whose words do not mean what they say, and should be so modified as to make them a mere repetition of other claims, and that the Patent Office also knew that the words were to be read with limitations that are not stated, and nevertheless allowed the claim to stand. — *Ryder v. Schlichter*, 126 Fed. 487; 61 C. C. A. 469.

The meaning of the claim is plain. It does not require, and therefore is not open to, interpretation. It is so explicit that the courts cannot alter or enlarge it. — *Jones v. Davis*, 138 Fed. 62; 70 C. C. A. 558.

Keystone v. Phoenix, 95 U. S. 278.

The law requires the patentee to define in his claim precisely what his invention is. This Crosby has done, and the court has no power to disregard the plain terms of the claim and either change or enlarge it by a reference to the specification. — *Cincinnati v. American*, 143 Fed. 322; 74 C. C. A. 522.

Merrill v. Yeomans, 94 U. S. 568; *Keystone v. Phoenix*, 95 U. S. 274; *White v. Dunbar*, 119 U. S. 47; *McCarty v. Lehigh*, 160 U. S. 110; *Penfield v. Potts*, 126 Fed. 475.

Be this as it may, the Courts must take the claims of the patents as they find them, and are not permitted to reconstruct them by adding to or subtracting from their terminology. The Court is not concerned with the motives which induced the patent officials to require the patentee to accept the claim. It is enough that it is in the patent and that it is couched in language so plain and unambiguous as to leave no room for construction. The Courts must deal with the claims not as they might have been, but as they are. — *Ryan v. Metropolitan*, 144 Fed. 697; 75 C. C. A. 513.

We must construe the patent in the light of what it says, not what it might have said; we must hold the patentee to what he has put on paper, not what he may have had in his mind. It is enough that the patentee did not so word the claim and it is beyond the province of the court to rewrite it. — *Universal v. Sonn*, 154 Fed. 665; 83 C. C. A. 422.

Keystone v. Phoenix, 95 U. S. 274; *National v. Williams*, 44 Fed. 190.

The claims were limited by the word "detachable." Effort was made to show that this limitation should be disregarded. The court declined so to construe. — *Brookfield v. Elmer*, 154 Fed. 197; 83 C. C. A. 180.

§ 220. Construction — Reading in Elements.

It is true the elements of a combination not mentioned in a claim may sometimes be held included, in the light of other parts of the specification, which may be applicable, but here the claim is so broad that we are not justified in importing into it an element which would not operate to so enlarge its scope as to cover an invention in no manner indicated upon its face. — *Day v. Fair Haven*, 132 U. S. 98; 33 L. Ed. 265; 10 S. Ct. 11.

There is not an element in this combination which is not found in the wind-mill of the appellee, and it cannot be permitted to read other elements into this claim and then to defeat it, because it does not use the elements it interpolates. — *Mast v. Dempster*, 82 Fed. 327; 27 C. C. A. 191. But see 177 U. S. 485.

Clearly it is not allowable, by the importation of elements to give identity to claims which in terms are intelligibly different. — *Anderson v. Potts*, 108 Fed. 379; 47 C. C. A. 409.

McCarty v. Railroad, 160 U. S. 110.

The terms of the claim, read with the descriptive matter of the specification, would seem to require such a construction, but, inasmuch as the patent would be void for want of novelty if these constituents were omitted, this construction is imperative. — *Brickill v. Mayor*, 112 Fed. 65; 50 C. C. A. 1.

§ 221. Construction — Reference Characters.

Certainly neither of these cases establishes a hard and fast rule that where a patentee claims the combination of certain elements shown in his patent, describing them by reference letters shown in the drawings, he thereby deprives himself of the benefit of the liberal doctrine of equivalents applicable to pioneer patents, if otherwise he is entitled to its application. (Referring to *Weir v. Morden*, 125 U. S. 106; *Hendy v. Iron*, 127 U. S. 375.) — *McCormick v. Aultman*, 69 Fed. 371; 16 C. C. A. 259.

DeLamater v. Heath, 58 Fed. 414.

The use of letters in a claim to designate its elements does not prevent its liberal construction. — *Bonnette v. Koehler*, 82 Fed. 428; 27 C. C. A. 200.

McCormick v. Aultman, 69 Fed. 371; *Muller v. Tool Co.* 77 Fed. 621; *DeLamater v. Heath*, 58 Fed. 414.

The use of letters in describing a patented device has been the subject of consideration in a number of cases in the Supreme Court as well as in this court. Sometimes the letters have been held to limit the inventor to the very device thus designated; in other cases the mere use of letters has not been held to deprive the inventor of a liberal application of the doctrine of mechanical equivalents. An analysis of the cases will show that the conclusion reached depends upon the character of the improvement under consideration. If the invention is of a pioneer character, highly meritorious in conception and usefulness, the mere use of letters has been held not to limit the inventor to the exact form, of device shown, but he is entitled to a broader conception of his patent, in view of the advance which he has made in the art. However, if the field of invention is limited, and an improvement of a narrow character has been made, just sufficient to cross the line which divides mechanical improvement from patentable invention, the inventor will be allowed the specific description shown and no more. In other words, he will be held to have invented just what his claim shows to have been the specific subject matter of his improvement. Without stopping to analyze the cases,

we think the following citations establish the rules just stated. — *Ross-Moyer v. Randall*, 104 Fed. 355; 43 C. C. A. 578.

McCormick v. Aultman, 69 Fed. 371; *Weir v. Morden*, 125 U. S. 98; *Hendy v. Iron Works*, 127 U. S. 370; *Muller v. Tool Co.* 77 Fed. 621.

§ 223. Construction — Rules — General.

A patent should be generally construed in a favorable and beneficial sense for the best interests of the patentee. — *Hogg v. Emerson*, 6 How. 437; 12 L. Ed. 505.

Godson on Pat. 24; *Kingsley & P. on Pat.* 35; *Grant v. Raymond*, 6 Pet. 218; *Ames v. Howard*, 1 Summ. 482; *Weyeth v. Stone*, 1 Story, 273, 287; *Blanchard v. Sprague*, 2 Story, 164; *King v. Wheeler*, 2 Ban. & A. 345; *Wilson v. Rousseau*, 4 How. 708; *Russell v. Cowley*, 1 Compt. M. & B. 864, 876.

The term rule of construction in respect to patents and specifications, and the doings generally of inventors, is to apply to them plain and ordinary principles. — *Hogg v. Emerson*, 6 How. 437; 12 L. Ed. 505.

The reasonable presumption is that having a just right to cover and protect his whole invention, he intended to do so. — *Winans v. Denmead*, 15 How. 330; 14 L. Ed. 717.

Haworth v. Hardcastle, Web. P. C. 484.

A patent should be construed in a liberal spirit, to sustain the just claims of the inventor. This principle is not to be carried so far as to exclude what is in it, or to interpolate anything which it does not contain. But liberality rather than strictness, should prevail where the fate of the patent is involved, and the question to be decided is whether the inventor shall hold or lose the fruits of his genius and his labors. — *Rubber Co. v. Goodyear*, 76 U. S. 788; 19 L. Ed. 566.

Corning v. Burden, 15 How. 269; *Battin v. Taggart*, 17 How. 77.

It has always been held that a patent embraces nothing more than the improvement described and claimed as new, and that anyone who afterwards discovers a method of accomplishing the same object, substantially and essentially differing from the one described, has a right to use it and to vend it to others to be used. — *Mitchell v. Tilghman*, 86 U. S. 287; 22 L. Ed. 125.

O'Reilly v. Morse, 15 How. 119.

A literal construction is not to be adopted where it would be repugnant to the manifest sense and reason of the instrument. — *Brown v. Guild*, 90 U. S. 181; 23 L. Ed. 161.

The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. — *Howe v. National*, 134 U. S. 388; 33 L. Ed. 963; 10 S. Ct. 570.

White v. Dunbar, 119 U. S. 47.

If letters patent were to be treated by the courts in the critical and hostile spirit which a plea in abatement formerly encountered, the contention of the defendant would have technical importance; but courts do not construe letters patent for the purpose of their destruction. — *Electric v. Brush*, 52 Fed. 130; 2 C. C. A. 682.

The construction to be given to his patent must correspond with the extent of his invention. The actual invention, if in conformity with the language of the claims, should control in the construction of patents. A strict construction should not be resorted to if it becomes a limitation upon the actual invention, unless such construction is required by the claim, it being understood that the construction should not go beyond and enlarge the limitations of the claim. — *Smead v. Fuller*, 57 Fed. 626; 6 C. C. A. 481.

Merrill v. Yeomans, 94 U. S. 568; *Railroad v. Mellon*, 104 U. S. 117; *Railway v. Sayles*, 97 U. S. 554.

Unless a court is to recede from the rule of construction of claims which the modern decisions of the Supreme Court have endeavored to impress upon the patent law of this country, the claims are to be construed in accordance with what must be regarded as their obvious meaning. — *Groth v. International*, 61 Fed. 284; 9 C. C. A. 507.

The claim must be taken as defining precisely what the invention covered by the patent is, and, hence, the true question is, not what the patentee might have claimed, but what he has claimed. — *Durand v. Schulze*, 61 Fed. 819; 10 C. C. A. 97.

Theoretically, an inventor, in taking out a patent under the statutes of the United States, subtracts and adds nothing from or to his actual invention. The proceedings recognize his incipient ownership, and theoretically they constitute only a division of time, by which there is carved out of the entire estate a holding for a period of years for the inventor, and the fee is left for the public. Thus his patent is not at all akin to the King's grant, which must be expressed "ex speciali gratia, certa scientia, et mero motu regis," or be interpreted against the subject who receives it. Except for the provisions which, for public interests, require in a patent a description and claim, the same unrestricted rules of the common law would protect an inventor's statute right as are relied on to support a trademark or business good-will. Nevertheless, with reference to patents, the courts are necessarily subject to the restraints arising from the incorporation into them of the description and claim, which the statutes require. In interpreting these, however, the rule must be accepted that it is to be presumed the inventor did not intend to split up his invention. This is only an application of the ordinary rule of interpretation that transactions are to be construed in the light of all the circumstances and of the apparent purposes of the parties to them. Specifications and claims have not yet fallen into such settled forms as to enable the courts to construe them in any considerable part, with such certainty as they construe many words and phrases in formal instruments at the common law; but, on the whole the entire subject-matter must be taken together for effectuating the true purpose of the transaction, as contracts and wills, which are so frequently drawn formally, are usually construed. The ordinary rule that if by a literal construction an instrument would be rendered frivolous and ineffectual, and its apparent object frustrated, a different exposition will be applied if it can be supported by anything in it, requires that words which relate to what may be held nonessentials, however much multiplied, shall not be permitted unnecessarily to control the sense. For the most part such words are merely illustrative, or are used through inadvertence. On the other hand, it is true that words and phrases which might have been omitted on the presumption that they relate to nonessentials, may be introduced in such direct and positive manner as to leave the courts no option except to regard them as affecting the objects and limitations of the instrument in question. Especially may this be so when words which otherwise might be regarded as unimportant, are introduced by way of amendment. This is a

common rule, which perhaps has been illustrated more frequently with marine insurance policies than elsewhere. There is no doubt that if into an instrument which has been prepared and submitted additional words are subsequently introduced by mutual consent, greater effect may sometimes be attributed to such words than otherwise would be given them; for they then become the immediate language selected by the parties, and may be assumed to have been especially within their intention. The leading rule which we have given has been constantly restated by the text-writers and the courts as having full application to patents. They make use of such expressions as "ut res majis valeat quam pereat;" that "a patent should be construed in a liberal spirit, sustaining the just claims of the inventor;" that the titles by which patents are held "should not be overthrown upon doubts or objections capable of reasonable and just solution in favor of their validity;" that "in construing a patent the court will remember that the specification and claims are often unskillfully drawn;" and that "the claim shall be construed, if possible, to sustain the patentee's right to all that he has invented." It is true the general rules we have stated include the subordinate principle, which applies everywhere, that they are not to be carried "so far as to exclude what is in the patent, or to interpolate anything which it does not contain." It is impossible, however, to carry this to the extent of applying to patents as fully as it is applied to instruments in general, the maxim, "Enumeratio unius exclusio alterius." With the aid of the doctrine of equivalents, the courts are constantly engrafting on specifications and claims what they do not contain in the same sense in which the letter of ordinary instruments is required to contain matter on which the parties rely. To extend, in disregard of this fact, the rule against interpolations to any particular case, requires either that the patent relate to such mere matters of form or detail that interpretation by exclusion becomes just and reasonable, or that the specifications and claims be so phrased as in fact to contain a clearly intended exclusion, or the equivalent thereof. — *Reece v. Globe*, 61 Fed. 958; 10 C. C. A. 194.

These claims do not in themselves refer to the previous description of the parts of the machine mentioned in them, but they must be taken as in effect referring to the whole of the instrument in which they belong. — *Bundy v. Columbian*, 64 Fed. 851; 12 C. C. A. 442.

Westinghouse v. Air Brake Co. 2 Ban. & A. 55; Fed. Cas. 17,450; *Bruce v. Marder*, 10 Fed. 750.

The statute requires the inventor to particularly point out and distinctly claim the improvement or combination which he claims as his discovery. R. S. sec. 4888. When, under this statute, the inventor has made his claim, he has thereby disclaimed and dedicated to the public all other combinations and improvements apparent from his specifications and claims that are not mere evasions of the device, combinations or improvements he claims as his own. The purpose of a claim in a patent is to notify the public of the extent of the monopoly secured to the inventor, and, while it is notice of his exclusive privileges, it is no less an estoppel of the patentee to claim under that patent any combination or improvement he has not therein pointed out and distinctly claimed as his discovery or invention. The presumption is, and it is generally the fact, that any such unclaimed combination or improvement was not the invention or discovery of the patentee; that it was old and well-known; and that for that reason he did not intend to claim it. But whether he did intend to claim it or not is immaterial in an action for the infringement of a patent, where no claim for mistake or inadvertence in preparing the specifications or claims can be heard. The patent itself is a solemn declaration of the inventor that every improvement,

device and combination not claimed by him therein is not his invention or discovery, but is the property of the public. It is full and legal notice to every one; notice on which every one has the right to rely that he may freely use such improvements and combinations without claim or molestation from the patentee. The public generally does use them, and it would be rank injustice to permit a patentee, after a combination or device that he did not claim has gone into general use, and years after his patent was granted, to read that combination or device into one of the claims of his patent, and to recover for its infringement of every one who has used it on the faith of his solemn declaration that he did not claim it. — *Buffington's v. Eustis*, 65 Fed. 804; 13 C. C. A. 143.

Stirrat v. Mfg. Co. 61 Fed. 980; *Keystone v. Phoenix*, 95 U. S. 274; *Miller v. Brass Co.* 104 U. S. 350; *Mahn v. Harwood*, 112 U. S. 354; *Wollensak v. Reiher*, 15 U. S. 96; *Parker v. Yale*, 123 U. S. 87.

The invention secured by a patent is that which is secured to the patentee by the claim. The claim is a statutory requirement prescribed for the purpose of making a patentee define what his invention is so distinctly and exactly as to appraise other inventors, and the public, what is withdrawn from general use. The claim, however, is to be read in the light of the description contained in the specification, and its literal terms may be enlarged or narrowed accordingly, but not to an extent inconsistent with the meaning. Identity of language in the claims of two patents does not necessarily import that the invention patented by each is identical, nor does a difference in phraseology necessarily import that they are for different inventions. The test of identity is whether both, when properly construed in the light of the description define essentially the same thing. When the claims of both cover and control essentially the same subject-matter, both are for the same invention, and the later patent is void. — *Thomson-Houston v. Elmira*, 71 Fed. 396; 18 C. C. A. 145.

In the construction of a patent, it is not the personal intent or understanding of the patentee, but the actual facts regarding the invention, that was material. — *Thomson-Houston v. Western*, 72 Fed. 530; 19 C. C. A. 1.

It is the well known rule that patents, like other instruments, are to be construed by what appears on their face "in the light of all the circumstances and the apparent purposes of the parties to them." — *Long v. Pope*, 75 Fed. 835; 21 C. C. A. 533.

Reece v. Globe, 61 Fed. 958; *Wier v. Morden*, 125 U. S. 98.

That the claim is a statutory requirement and must be strictly construed, see *Boynton v. Morris*, 87 Fed. 225; 30 C. C. A. 617.

White v. Dunbar, 119 U. S. 47.

As the question of the construction of a patent concerns not only the parties in this case, but also the public, so that, as is well settled, we have a certain duty to take notice of matters bearing upon questions of the existence and extent of patentability, we would not be justified in ignoring what our own records show us on this point. — *Cushman v. Goddard*, 95 Fed. 664; 37 C. C. A. 221.

Among the primary rules for the construction of a contract are these: The court should put itself in the place of the parties at the time it is made, and should read its terms in the light of the facts and circumstances which then surrounded them. When the intention of the parties is manifest, it should control, regardless of inapt expressions and technical rules. In cases of

doubtful validity or of ambiguous terms, that construction should be adopted which sustains and vitalizes the agreement, rather than that which destroys or paralyzes it. Prior negotiations are merged in the contract, and, while they may be considered to interpret its purpose, they must not be permitted to contradict or modify its express meaning. — *National v. Interchangeable*, 106 Fed. 693; 45 C. C. A. 544.

If the original conception for which his patents were granted was not his; if the principle of the alleged invention, with all its undeveloped possibilities, is found in previous patents or rested in public knowledge, and he has done no more than extend the original thought by change only in form, proportion and degree; if he has carried forward another's conception by a new and more extended application of it; and if the essence of his patents is in doing substantially the same thing in substantially the same way, only providing such improvements and modifications as a mechanic conversant with the art could effect by skill and ingenuity — it would follow that he would be entitled only to patents upon his improvements, and would not be entitled to shut out others from the enjoyment of those improvements which the same or greater skill may have achieved. But if the entire scheme is radically different from the prior art, and if, in construction, operation, purpose and result, the invention set forth in the prior patent is not responsive in terms or substance to his construction, and the same or nonequivalent elements are not used in substantially the same way to produce the same result, and no mechanical skill working upon the prior patent could ever produce the same result that he accomplished, then it would follow that the inventive idea was different, and any modification or improvements worked out upon his idea must be tributary to it. — *Ideal v. Crown*, 131 Fed. 244; 65 C. C. A. 436.

The rules for the construction of contracts apply with equal force to the interpretation of patents. The great desideratum, here as there, is to ascertain and give effect to the intention of the parties to the contract when they made it. This intention must be ascertained from the entire agreement, and not from isolated parts of it, because it was not expressed by a part, but by the whole of the contract. When the terms of a patent are plain and the intention of the parties is manifest, the latter must prevail, and there is no room for construction. When its expressions are ambiguous and the validity of the patent or any claim in it is doubtful, that construction which sustains and vitalizes the patent or claim, rather than that which paralyzes or destroys them, must be preferred. — *Jewell v. Jackson*, 140 Fed. 340; 72 C. C. A. 304.

The question of the validity of the patent is to be determined by ascertaining what it describes and claims which had not been described in previous patents, and construing the claim so far as its language will permit so as to secure to the patentee that which was really new and patentable in view of the prior art. — *Ironclad v. Dairyman's*, 143 Fed. 512; 74 C. C. A. 372.

The claim should be as broad as the invention. A safe and conservative rule for the construction of such claims (primary improvements) is clearly stated by Judge Shipman in *Smead v. Fuller*, 57 Fed. 626. — *Wagner v. Wycoff*, 151 Fed. 585; 81 C. C. A. 129.

Machine Co. v. Murphy, 97 U. S. 120; *Tilghman v. Proctor*, 102 U. S. 707; *Eldred v. Kirkland*, 130 Fed. 342; *Reece v. Globe*, 61 Fed. 959.

The court may resort to strict and, it may even be, to harsh construction when the patentee has done nothing more than make a trivial improvement upon a well-known structure which produces no new result; but it should be

correspondingly liberal when convinced that the patentee's improvement is so radical as to put the old methods out of action. The courts have frequently held that one who takes an old machine and by a few, even inconsequential, changes compels it to perform a new function and do important work which no one ever dreamed it capable of performing, is entitled to rank as an inventor. — *O'Rourke v. McMullen*, 160 Fed. 933; 88 C. C. A. 115.

Hobbs v. Beach, 180 U. S. 383; *Magowan v. N. Y.* 141 U. S. 352, *Barbed Wire Case*, 143 U. S. 275; *Potts v. Creager*, 155 U. S. 597; *Loom Co. v. Higgins*, 105 U. S. 580.

§ 223. Construction — Specification.

The claim is not to be taken alone, but in connection with the specification and drawings; the whole instrument is to be construed together. But we are to look at the others only for the purpose of enabling us correctly to interpret the claim. — *Brooks v. Fisk*, 15 How. 212; 14 L. Ed. 665.

The claim should be construed in connection with the specification. — *Turrill v. Railroad*, 68 U. S. 491; 17 L. Ed. 668.

Such a reference is proper if it does not introduce confusion and uncertainty, and is often necessary for restraining the too great generality, or enlarging the literal narrowness of the claim. — *Brown v. Guild*, 90 U. S. 181; 23 L. Ed. 161.

The claim may be construed in connection with the specification, and if the claim contains words referring back to the specification it cannot properly be construed in any other way. — *Fuller v. Yentzer*, 94 U. S. 288; 24 L. Ed. 103.

Seymour v. Osborne, 11 Wall. 516.

The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it can not be enlarged by language used in other parts of the specification. — *Yale v. Greenleaf*, 117 U. S. 554; 29 L. Ed. 952; 6 S. Ct. 846.

Keystone v. Phoenix, 95 U. S. 274; *R. R. v. Mellon*, 104 U. S. 112.

Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification so as to make it include something more than, or something different from, what its words express. The context may undoubtedly be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. — *White v. Dunbar*, 119 U. S. 47; 30 L. Ed. 303; 7 S. Ct. 72.

Keystone v. Phoenix, 95 U. S. 274; *James v. Campbell*, 104 U. S. 356.

The plain and explicit language of the specification requires a construction of the claim which will enable the defendant to escape liability. There is nothing in the context to indicate that the patentee contemplated any alternative arrangement. — *Snow v. Railway*, 121 U. S. 617; 30 L. Ed. 1004; 7 S. Ct. 1343.

The invention, of course, must be described, and the mode of putting it to practical use, but the claims measure the invention. They may be explained

and illustrated by the description. They cannot be enlarged by it. — *Continental v. Eastern*, 210 U. S. 405; 51 L. Ed. 922; 28 S. Ct. 748.

Yale v. Greenleaf, 117 U. S. 554; *Snow v. Lake Shore*, 121 U. S. 617.

It is true that the claims must be construed according to the language of each, but specifications and designs may be referred to to limit or explain if not to enlarge. — *Jones v. Munger*, 49 Fed. 61; 1 C. C. A. 158.

Evans v. Kelly, 13 Fed. 903; *Turrill v. Railroad*, 1 Wall. 491; *Tompkins v. Gage*, 5 Blatchf. 268; *Vance v. Campbell*, 1 Black, 427.

It is always the duty of the courts to construe the patents by reference to the language of the claims and an examination of the specifications and drawings accompanying the same. — *Norton v. Jensen*, 49 Fed. 859; 1 C. C. A. 452.

Reference may be made to the specifications to supply in a claim what it is plain to every one skilled in the art is a necessary incident. — *Reece v. Globe*, 61 Fed. 958; 10 C. C. A. 194.

Seymour v. Osborne, 11 Wall. 516; *Day v. Railway*, 132 U. S. 98.

The claims of a patent limit the exclusive privileges of the patentee, and his specification may be referred to to explain and restrict, but never to expand them. General language in a claim which points to an element or device more fully described in the specification is limited to such an element or device as is there described. — *Adams v. Lindell*, 77 Fed. 432; 23 C. C. A. 223.

Mitchell v. Tilghman, 19 Wall. 287; *Stirrat v. Mfg. Co.* 61 Fed. 980.

The claims and the specifications are to be read together, not for the purpose of enlarging the invention stated in the claims, but "for the purpose of better understanding the meaning of the claims," the limit and extent of the invention, and the object of the inventor, and the construction, method, and process, as understood by him. — *American v. Howland*, 80 Fed. 395; 25 C. C. A. 500.

Howe v. National, 134 U. S. 383; *Vance v. Campbell*, Fed. Cas. 16,837; *Wilson v. Coon*, 6 Fed. 611; *Gottfried v. Brewing Co.* Fed. Cas. 5633; *Brass Co. v. Miller*, Fed. Cas. 17,254; *Seymour v. Osborne*, 11 Wall. 516; *Rob. Pat. sec. 750*; *Curt. Pat. sec. 225, 227*.

If, therefore, we apply the benignant rule of construction, — as we are required to do, — that the claims should be construed by the specifications, and that if, looking at both, the court is able to understand the meaning of the patentee in the language of his claims, and, as so understood, the combination is a practicable one, it will give effect to them according to the apparent purpose. *Ryan v. Goodwin*, Fed. Cas. 12,186; *Blanchard v. Sprague*, Fed. Cas. 1518; *Turrill v. Railroad*, 1 Wall. 491; *Klein v. Russell*, 19 Wall. 433; *Haworth v. Harcastle*, *Webst. Pat. Cas.* 480; *Blandy v. Griffith*, Fed. Cas. 1529; *Roller-Mill Co. v. Coombs*, 39 Fed. 25.

These are a few of the great number of cases in which the foregoing rule has been approved and applied. Of course, if the language of a claim, in the light of the specifications, does not show that the patentee has described a practicable combination, there is an end of it, and the claim is nugatory. — *Soehner v. Favorite Co.* 84 Fed. 182; 28 C. C. A. 317.

If interpretation of the claim were requisite, the specification might, of course, be resorted to for the purpose of arriving at a better understanding of its meaning, but this may not be done "for the purpose of changing it

and making it different from what it is." — *Boynton v. Morris*, 87 Fed. 225; 30 C. C. A. 617.

White v. Dunbar, 119 U. S. 47.

The patent when construed by a reference to the whole specification, including the description and the claims, fully accomplishes these several ends. If a claim, uncertain when considered apart from the description, can by reference to the latter be rendered so clear as to satisfy the requirement of the statute, that the inventor "shall particularly point out and distinctly claim" his invention, by parity of reasoning a doubtful point in the description, when considered apart from the claims, can by reference to the latter, when in themselves unambiguous, be rendered so clear as to satisfy the other requirement of the statute that the inventor shall fully and clearly set forth his invention in the description. That under such circumstances a description uncertain or indefinite when considered alone, but not inconsistent with the claims, may be rendered certain and sufficient to meet the requirements of the statute by reading the whole specification together has frequently been recognized and is, we think, a sound rule of law. — *Electric v. Carborundum*, 102 Fed. 618; 42 C. C. A. 537.

Battin v. Taggart, 17 How. 74; *Corn-Planter Pat.* 23 Wall. 181; *Carver v. Mfg. Co.* 2 Story, 430; *Howes v. Nutes*, 4 Cliff. 173; *Ryan v. Goodwin*, 3 Sumn. 514; *Myers v. Frame*, 8 Blatchf. 446; *Parker v. Stiles*, 5 McLean, 44; *Lowell v. Lewis*, 1 Mason, 182.

It is true that neither they nor the specification can be read to expand the claim; but the specification and the drawings must be read together, and given their obvious force and meaning, for the purpose of determining what devices are pointed out and described therein. — *Brammer v. Schroeder*, 106 Fed. 918; 46 C. C. A. 41.

We may go to the description to amplify a claim, but we can not, out of the mere descriptive portion of the patent, wholly create a claim. — *General v. Mallers*, 110 Fed. 529; 49 C. C. A. 138.

While it is the purpose of the statute to require the inventor to set forth the nature and extent of his patent, and it is not the province of the courts to add to or take from a claim that which is not embraced within its language, nevertheless we may look to the specifications for the purpose of construing the language used in the claim. If this language includes an element only described in general terms, we may look to the specifications to ascertain its meaning. — *Stillwell-Bierce v. Eufaula*, 117 Fed. 410; 54 C. C. A. 584.

Soehner v. Range Co. 84 Fed. 182; *Lake Shore v. National*, 110 U. S. 229; *Seymour v. Osborne*, 11 Wall. 516; *Corn Planter Pat.* 23 Wall. 181; *Fuller v. Yentzer*, 94 U. S. 288; *Hailes v. Van Wormer*, 20 Wall. 353; *Westinghouse v. Brake Co.* 170 U. S. 537.

While this court may resort to the language of the specification for the purpose of interpreting the claim, it cannot read into such claim elements not specifically covered thereby, especially where to do so would be to contradict the clear and definite statement in the specification. When the terms of the claim are clear and distinct, the patentee cannot claim anything beyond for the purpose of establishing infringement. — *Westinghouse v. N. Y.* 119 Fed. 874; 56 C. C. A. 404.

Keystone v. Phoenix, 95 U. S. 274; *Merrill v. Yeomans*, 94 U. S. 568; *McCarty v. Railroad*, 160 U. S. 110; *White v. Dunbar*, 119 U. S. 47.

Within certain limits the courts are inclined to adopt the mode of construction, of construing the claims by reference to the specification, when it

is necessary, as in the present case, to save the patent from the objection that the claims are too broad. — *Lamb v. Lamb*, 120 Fed. 267; 56 C. C. A. 247.

Rubber v. Goodyear, 9 Wall. 788; *McClain v. Ortmayer*, 141 U. S. 419; *Coupe v. Royer*, 155 U. S. 565; *Soehner v. Stove*, 84 Fed. 182.

The claims must stand or fall as made (*Keystone v. Phoenix*, 95 U. S. 274); but it is equally well settled that the claims for a patent are to be construed by reference to the specifications (of which the drawings form a part) and that such reference may be had, not for the purpose of expanding the claim, but for the purpose of defining it and limiting it to the description of the invention. — *Lamb v. Lamb*, 120 Fed. 267; 56 C. C. A. 247.

McClain v. Ortmayer, 141 U. S. 419; *Howe v. National*, 134 U. S. 288; *Coupe v. Royer*, 155 U. S. 565; *Tilghman v. Proctor*, 102 U. S. 729.

To sustain the validity of claims 1 and 2, it is necessary "to refer back to the specification; not, it is true, for a slavish adoption of the identical instrumentalities therein described, but for the understanding of the essential and substantial features of the means therein illustrated." — *Seiler v. Fuller*, 121 Fed. 85; 57 C. C. A. 339.

Westinghouse v. Boyden, 170 U. S. 537.

The claims of a patent must be read in the light of the specification. The specification may always be referred to to restrict, though not to expand, the claims. — *Anderson v. Collins*, 122 Fed. 451; 58 C. C. A. 669.

The claims cannot be broadened or made to include things not therein included, but to know what is included we may resort to the specification for the purpose of interpreting the claim. — *Canda v. Michigan*, 124 Fed. 486; 61 C. C. A. 194.

McCarty v. Lehigh, 160 U. S. 110; *White v. Dunbar*, 119 U. S. 47.

It is well settled that for such purpose, and especially when the claim refers to the specification for further description, it is proper to resort to the specification, if explanation is necessary. — *Canda v. Michigan*, 124 Fed. 486; 61 C. C. A. 194.

Soehner v. Favorite, 84 Fed. 182; *Stillwell-Bierce v. Eufaula*, 117 Fed. 410; *Klein v. Russell*, 19 Wall. 433; *Hailes v. Van Wormer*, 20 Wall. 353; *Lamb v. Lamb*, 120 Fed. 267.

Features of construction which the specification of a patent recommends or describes as preferable do not thereby become essential parts of the patent, or limitations of the claims. — *Smeeth v. Perkins*, 125 Fed. 285; 60 C. C. A. 199.

Sewall v. Jones, 91 U. S. 171; *Krajewski v. Pharr*, 105 Fed. 514; *Winans v. Denmead*, 15 How. 330; *Klein v. Russell*, 19 Wall. 433.

Reference may be made to the specification to explain but not to extend or limit the claim. The words "to operate substantially as described" mean "substantially as described in regard to the combination which is the subject of the claim." — *General v. International*, 126 Fed. 755; 61 C. C. A. 329.

Lake Shore v. Car Brake, 110 U. S. 229.

It is evident that the express terms of the claim do not limit the patentee to a particular device, and therefore the construction adopted by the court below practically rewrote the claim, and in effect expunged it from the patent; for to limit it to one form of structure described in the specification and

shown in the drawings necessarily introduced into the claim such modifications of the language used by the inventor as turned it into a substantial, and therefore a superfluous, equivalent of the claims preceding. — *Ryder v. Schlichter*, 126 Fed. 487; 61 C. C. A. 469.

The claims of a patent are to be fairly construed so as to cover, if possible, the invention, and thus save it, especially if it be a meritorious one. In approaching a patent, we are to look primarily at the thing which the inventor conceived and described in his patent, and the claims are to be interpreted with this particular thing ever before our eyes. In confining our attention too closely to the claims, we are apt to look at them as separate and independent entities, and to lose sight of the important consideration that the real invention is to be found in the specification and drawings, and that the language of the claims is to be construed in the light of what is there shown and described. — *Mossberg v. Nutter*, 135 Fed. 95; 68 C. C. A. 257.

If any doubt existed as to the meaning of the claim, or if it were susceptible to two interpretations, it would be both right and proper that reference should be made to the drawings and specifications, not for the purpose of changing or altering the claim, but to ascertain the true and proper interpretation. — *Robins v. American*, 145 Fed. 923; 76 C. C. A. 461.

McClain v. Ortmyer, 141 U. S. 419; *Klein v. Russell*, 19 Wall. 433; *McEwan v. McEwan*, 91 Fed. 787; *Stillwell-Bierce v. Eufaula*, 117 Fed. 410; *Electric v. Carborundum*, 102 Fed. 618; *Hogg v. Emerson*, 11 How. 587.

We are satisfied, not only that the scope of the patentee's invention was narrow in fact, but that such limitation was advisedly recognized in his specifications, and is conclusive against the broad interpretation now sought. — *Lowden v. Janesville*, 148 Fed. 686; 78 C. C. A. 548.

§ 224. Construction — State of Art.

The case is one where, in view of the state of the art, the invention must be restricted to the form shown and described by the patentee. He was not a pioneer. He merely devised a new form to accomplish these results. — *Duff v. Sterling*, 107 U. S. 636; 27 L. Ed. 517; 2 S. Ct. 487.

R. R. v. Sayles, 97 U. S. 554.

Where the state of the art shows prior devices limiting the scope of the invention, the claims must be strictly construed. — *Newton v. Furst*, 119 U. S. 373; 30 L. Ed. 442; 7 S. Ct. 369.

Letters patent, though not set up in the answer, may be received in evidence to show the state of the art and to aid in the construction of the plaintiff's claim, though not to invalidate the claim on the ground of want of novelty when properly construed. — *Grier v. Wilt*, 120 U. S. 412; 30 L. Ed. 712; 7 S. Ct. 718.

Vance v. Campbell, 66 U. S. 427; *Railroad v. Dubois*, 79 U. S. 47; *Brown v. Piper*, 91 U. S. 37; *Eachus v. Broomall*, 115 U. S. 429.

The extent of novelty which can be read into a claim must be limited by the state of the art. — *Consolidated v. Walker*, 138 U. S. 124; 34 L. Ed. 920; 11 S. Ct. 292.

Phoenix v. Spiegel, 133 U. S. 360.

The inventor is legally presumed to have all prior patents before him when he makes his invention. — *Duer v. Corbin*, 149 U. S. 216; 37 L. Ed. 707; 13 S. Ct. 850.

Devices, though not claimed to fully anticipate the patent in suit, are important in their bearing upon the construction of this patent and upon the alleged infringement of the defendants. — *Deering v. Winona*, 155 U. S. 286; 39 L. Ed. 153; 15 S. Ct. 118.

The line that the patentee drew in his patent between the old and new mechanism marks the extent of that portion of his invention now under consideration. — *Lalace v. Haberman*, 59 Fed. 143; 8 C. C. A. 53.

The claims must be construed in view of the state of the art, and unless it be a pioneer invention they are not entitled to the rule applicable to pioneer inventions. — *Lamson v. Godehard*, 59 Fed. 776; 8 C. C. A. 265.

Machine Co. v. Lancaster, 129 U. S. 263; *McCormick v. Talcott*, 20 How. 402; *Railway v. Sayles*, 97 U. S. 554.

The claims and specifications of every patent must be read and construed in the light of a full knowledge of the state of the art when the patent was issued. A patent to the original inventor of a machine which first performs a useful function protects him against all machines that perform the same function by equivalent mechanical devices, but a patent to one who has simply made a slight improvement on a device that performed the same function before as after the improvement, is protected only against those who use the very improvement he describes and claims, or mere colorable evasions of it. — *Stirratt v. Excelsior*, 61 Fed. 980; 10 C. C. A. 216.

McCormick v. Talcott, 20 How. 402.

The claims and specifications of every patent must be read and construed in the light of a knowledge of the state of the art when it was issued. — *Murphy v. Excelsior*, 76 Fed. 965; 22 C. C. A. 658.

A claim made necessarily complex and specific by reason of the prior art must be specifically construed. — *Volkman v. Dohnhoff*, 77 Fed. 978; 23 C. C. A. 599.

If the specifications and claims of the patent were to be given effect without regard to the history of the art or the proceedings in the patent office, it might be conceded that the defendant's device would come within the scope of complainant's monopoly. We must, however, use both aids in construing the patent. — *Thomas v. Rocker*, 77 Fed. 420; 23 C. C. A. 211.

If the patented pull-off and take-up are merely improvements upon old devices for doing the same work, or if the patentee has imposed a limitation on his invention by express words in the specification and claims, it is manifest that the court would not be warranted in giving that breadth of construction to the patent which would be given in a case where the inventor was the first to devise a pull-off and take-up mechanism, or had not expressly restricted his invention by the terms of the specification and claims. — *Goodyear v. Spaulding*, 110 Fed. 393; 49 C. C. A. 88.

We must charge the inventor with knowledge of all that preceded him in the art, for "it is a presumption of law that all mechanics interested in upholding or defeating a patent were fully acquainted with the state of the art when they took out their patent, or when they built their machine. Each

party may then be assumed to have borrowed from the other whatever was actually first invented and used by the other." — *Daylight v. American*, 142 Fed. 454; 73 C. C. A. 570.

Crompton v. Knowles, 7 Fed. 199; *Mast v. Stover*, 177 U. S. 493.

§ 225. Construction — Unclaimed Elements.

If the patentee by his specification, including the summary claim at its close, points out and distinguishes what he claims as his own invention, it is all that is required; the rest he impliedly, if he does not expressly, disclaims as old. — *Brown v. Guild*, 90 U. S. 181; 23 L. Ed. 161.

In testing the validity of this patent for the "sheets" (blank forms) the methods and forms of contract described and not claimed in it are to be considered as outstanding. — *U. S. Credit v. American*, 59 Fed. 139; 8 C. C. A. 49.

Underwood v. Gerber, 149 U. S. 224.

Of course the discovery is unimportant if the patent does not secure it. The claim for a method of glass manufacture, as we have seen, was disallowed. If the advantages of the discovery are not, therefore, embodied in a new function, the discovery is not secured. — *Benjamin v. Chambers*, 59 Fed. 151; 8 C. C. A. 61.

An unclaimed peculiarity of construction is rarely read into a claim, the life of which consists in minor improvements upon an old article, and in which the patentee has undertaken to point out minutely the distinctive features which differentiate his combination from that of pre-existing devices. — *Eagle v. Corbin*, 64 Fed. 789; 12 C. C. A. 418.

As it was the combination which was claimed, the tension device was to be deemed incorporated into the claims, notwithstanding it was not in terms included. — *Thomson-Houston v. Black River*, 135 Fed. 759; 68 C. C. A. 461.

Hartshorn v. Saginaw, 119 U. S. 678; *Consolidated v. Walker*, 138 U. S. 124.

Where the patentee in his specifications has limited himself to do what he states to be his primary invention, and to "the several combinations hereinafter described and claimed," and where the combination upon which the contention of infringement is based is neither described, claimed nor illustrated, it should not be read into the patent. — *Edison v. Crouse*, 152 Fed. 437; 81 C. C. A. 579.

§ 226. Construction — Undue Limitation by Patentee.

When a claim is explicit, the courts cannot alter or enlarge it. If the patentees have not claimed the whole of their invention, and the omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a reissue. They cannot expect the courts to wade through the history of the art and spell out what they might have claimed, but have not claimed. — *Keystone v. Phoenix*, 95 U. S. 274; 24 L. Ed. 344.

Merrill v. Yeomans, 94 U. S. 568.

The principle of construction which we think applicable to the plaintiff's patent is that such construction must be in conformity with the self imposed limitations which are contained in the claims. Such claims are the measure

of their right to relief. — *Coupe v. Royer*, 155 U. S. 565; 39 L. Ed. 263; 15 S. Ct. 199.

Keystone v. Phoenix, 95 U. S. 274; *Burns v. Meyer*, 100 U. S. 672; *McClain v. Ortmayer*, 141 U. S. 425.

That where a claim includes a specific element in a specifically limited form, where such limitation is not required by the general terms of the patent, or by the state of the prior art, the court may construe the claim, nevertheless, with a scope commensurate with the invention, see *Metallic v. Brown*, 104 Fed. 345; 43 C. C. A. 568.

McCormick v. Aultman, 69 Fed. 371; *Reece v. Globe*, 61 Fed. 958; *Electric v. LeRue*, 139 U. S. 601; *Devlin v. Paynter*, 64 Fed. 398.

That where the inventor has industriously set forth as essential to his invention a certain construction and in his claims limits it to "substantially as described," such element or construction must be imported into the claim whether specifically stated or not, see *Brill v. Peckham*, 108 Fed. 267; 47 C. C. A. 315.

It is an elementary rule that a patentee may claim the whole or a part of what he has invented. He is entitled to limit his claims to any extent that may seem desirable, but, having done so, his right to protection is so limited, since the claim actually made by the patentee is the measure of his right to relief. — *Lanyon v. Brown*, 129 Fed. 912; 64 C. C. A. 344.

McClain v. Ortmayer, 141 U. S. 419; *Keystone v. Phoenix*, 95 U. S. 274; *White v. Dunbar*, 119 U. S. 47.

The court is not permitted to reconstruct the claims of a patent, and the patentee is bound by the claims as he has written them. — *American v. Wagner*, 151 Fed. 576; 81 C. C. A. 120.

In view of the failure of the patentee specifically to point out, illustrate, or broadly claim such location, we cannot so read it into the patent so as to embrace defendant's construction. In fact, it may be said that the defendant's construction is founded on a discovery not disclosed in the patent in suit, namely, that the change which the patentee supposed could only be obtained by a location of the main or working circuit, might be obtained by a location in the generator circuit. In these circumstances the rule must be applied that, while a patentee is entitled to all the beneficial uses of his invention when the property or function is inherent in the invention or is described or claimed by him, yet that, where such change or function is neither described nor claimed, and especially where other changes are described and insisted on as essential and specifically claimed, it is significant proof that the change which had not been disclosed by him to the public is not his invention. — *Electric v. Gould*, 158 Fed. 610; 85 C. C. A. 432.

Fastener Co. v. Kraetzer, 150 U. S. 111; *Goodyear v. Rubber*, 116 Fed. 375; *Long v. Pope*, 75 Fed. 835; *Wells v. Curtis*, 66 Fed. 318; *Bates v. Force*, 149 Fed. 220.

If a patentee by his specification and claims industriously makes an unnecessary device an essential mechanical element of the combination he claims, he is thereby estopped from maintaining that a combination which omits it infringes. — *Brammer v. Witte*, 159 Fed. 526; 86 C. C. A. 207.

Cimiotti v. American, 198 U. S. 399.

§ 227. Construction — Unduly Broad.

Having thus enlarged his claims, the court should not be astute to restrict them by reading in the real invention which he has failed to include within their terms. — *Excelsior v. Morse-Keefer*, 101 Fed. 448; 41 C. C. A. 448.

Courts lean towards reading into the claims of a patent such limitations as will save the real invention as disclosed by the specification and the prior state of the art. But when the claims are drawn in broad and nebulous terms with the apparent purpose of enabling the patentee to monopolize an important industry, the courts should be slow in attempting to sustain their validity by narrowing them beyond the boundaries which are clearly warranted in the specification. — *National v. New England*, 151 Fed. 19; 80 C. C. A. 485.

§ 228. Construction — Valeat quam Pereat Rule.

Patents for inventions are not to be treated as mere monopolies, and, therefore, odious in the eyes of the law; but they are to receive a liberal construction, and under the fair application of the rule, *ut res magis valeat quam pereat*, are, if practicable to be so interpreted as to uphold and not destroy the right of the inventor. — *Turrill v. Railroad*, 68 U. S. 491; 17 L. Ed. 668.

Ryan v. Goodwin, 3 Sumn. 520.

In case of doubt when a claim is susceptible of two constructions the one will be adopted which will preserve to the patentee his actual invention; but if the language of the specification and claims show clearly what he desired to secure as a monopoly nothing can be held to be an infringement which does not fall within the terms the patentee has himself chosen to express his invention. — *McClain v. Ortmayer*, 141 U. S. 419; 35 L. Ed. 800; 12 S. Ct. 76.

Vance v. Campbell, 66 U. S. 427.

That interpretation which sustains and vitalizes the grant should be preferred to that which strikes down and paralyzes it. — *National v. Interchangeable*, 106 Fed. 693; 45 C. C. A. 544.

Reece v. Globe, 61 Fed. 958; *Consolidated v. Columbian*, 79 Fed. 795; *American v. Newton*, 82 Fed. 732; *McSherry v. Dowagiac*, 101 Fed. 716.

§ 229. Construction — Words and Phrases.

It is generally true, when a patentee describes a machine, and then claims it as described, that he is understood to intend to claim, and does by law actually cover, not only the precise forms he has described, but all other forms which embody his invention; it being a familiar rule, that to copy the principle or mode of operation described is an infringement, although the copy should be totally unlike the original in form or proportions. — *Winans v. Denmead*, 15 How. 330; 14 L. Ed. 717.

Words of such import, if not expressed in the claim, must be implied, else the patent in many cases would be invalid as covering a mere function, principle or result, which is obviously forbidden by the patent law, as it would close the door to all subsequent improvements. — *Mitchell v. Tilghman*, 86 U. S. 287; 22 L. Ed. 125.

Seymour v. Osborne, 11 Wall. 538; *Curt Pat. sec.* 242.

Objection is taken to the patent because it claims "the design for a carpet substantially as shown." We see no good objection to the form of the claim. It refers to the description as well as the drawing, in using the word "shown." — *Dobson v. Hartford*, 114 U. S. 439; 29 L. Ed. 177; 5 S. Ct. 945.

These words have been uniformly held by us to import into the claim the particulars of the specification. — *Westinghouse v. Boyden*, 170 U. S. 537; 42 L. Ed. 1136; 18 S. Ct. 707.

The words "substantially as set forth" do not justify reading into the claim qualifications expressed in the specification. — *Westinghouse v. Edison*, 63 Fed. 588; 11 C. C. A. 342.

It is said that the claims of the reissued patent are void because too broad. Unless the claims are to be restricted by construction, this criticism is a just one. The only adaptation capable of appropriation by the inventor is that which is shown in the specifications and drawings of his patent, and this is the necessary limiting effect of the words "substantially and for the purpose specified." In this way the court may sustain the validity of the claims, as it is its duty to do when possible. — *Columbus v. Robbins*, 64 Fed. 384; 12 C. C. A. 174.

Corn Planter Pat. 23 Wall. 181.

The phrase, "substantially as set forth," is technical and is equivalent to saying, "by the means described in the text of the inventor's application for letters patent, as illustrated by the drawings, diagrams, and models which accompany the application." These words limit the general terms of the specification which set out the function performed by the invention, and confine the inventor's rights to his own special means of performing the function. — *Boyden v. Westinghouse*, 70 Fed. 816; 17 C. C. A. 430.

The words in the claims "as herein described" and "as described" must be construed closely in a patent of narrow scope. — *Davis v. Parkman*, 71 Fed. 961; 18 C. C. A. 398.

Duff v. Pump Co. 107 U. S. 636; *Bragg v. Fitch*, 121 U. S. 478; *Knapp v. Morss*, 150 U. S. 221.

It is rare that the words, "substantially as described" aid the courts in construing patents, if they ever do. In view of the fact that the statutes require an inventor seeking a patent to give in his application a "written description" of his invention, the words in question are usually implied when not expressed. They cannot enlarge a patent for a narrow invention, and they cannot narrow a claim justly broad. — *Bresnahan v. Tripp*, 72 Fed. 920; 19 C. C. A. 237.

Machine v. Lancaster, 129 U. S. 263; *Rob. Pat.* 750; *Walker*, (3d ed.) 182.

That claim is dangerously near being a claim for a mode of operation, and, if saved, it is saved by the words "substantially as set forth" which serve to limit the claim to the described mechanism. — *Rousseau v. Peck*, 78 Fed. 113; 24 C. C. A. 7.

Seymour v. Osborne, 11 Wall. 516; *Curt Pat.* 4 ed. 281.

The "whereby" clause does not add anything to the claim. — *Frazer v. Gates*, 85 Fed. 441; 29 C. C. A. 261.

Birmingham v. Gates, 78 Fed. 350.

The claim has the usual conclusion "substantially as described," without these qualifying words, however, the claim is to receive a reasonable construction, regard being had to the nature of the described structure and the object to be attained. — *Thompson v. Second Avenue*, 93 Fed. 824; 35 C. C. A. 620.

If the claim is to be read in connection with the specification, or any significance is to be given to the words "substantially as described," it plainly must be limited to the coils of the patent. The proceedings in the Patent Office show that Eickemeyer attempted to claim the method of double

winding and abandoned it. — *General v. Webster*, 113 Fed. 756; 51 C. C. A. 446.

That in a specific or improvement patent, such terms as "means employed," "means for," or "means whereby" will be limited to the substantial means disclosed in the specification, see *Lowden v. Janesville*, 148 Fed. 686; 78 C. C. A. 548.

That where the claim contains the words "substantially as set forth," and elements not directly included in the claim but fully disclosed in the description as a part of the combination will be read into the claim, even if the claim is thereby limited, see *Boston v. Pennsylvania*, 164 Fed. 557; C. C. A.

§ 230. Construction — Miscellaneous Rulings.

The defect here is both in the specification and in the claim. The former does not distinguish the new parts from the old, nor is there anything in the specification by which they can be distinguished; and the latter, instead of claiming the old parts, should have excluded them, and claimed the new by which the old were adapted to the new use, producing the new result. — *Phillips v. Page*, 65 U. S. 164; 16 L. Ed. 639.

Inventions secured by letters patent sometimes, though rarely, embrace an entire machine, and in such cases it is sufficient if it appear that the claim is co-extensive with the invention. — *Seymour v. Osborne*, 78 U. S. 516; 20 L. Ed. 33.

The Whitney process described a system of re-heating car wheels which had been chilled upon the tread to a point a trifle below the fusing point. Its utility was attacked on the ground that reheating to such a point would destroy the chill. From the fact that the invention in practice had proved eminently useful, even by a wide modification of the degree of heat employed, the patent was held good upon the ground that the description was sufficiently exact to enable one skilled in the art to use the process. — *Mowry v. Whitney*, 81 U. S. 620; 20 L. Ed. 860.

Doubtful expressions may be subject to construction, but when the language employed is clear and unambiguous it must speak its own construction in the specification. — *Mitchell v. Tilghman*, 86 U. S. 287; 22 L. Ed. 125.

This duty is now cast upon the Patent Office. There his claim is, or is supposed to be, examined, scrutinized, limited and made to conform to what he is entitled to. — *Keystone v. Phoenix*, 95 U. S. 274; 24 L. Ed. 344.

Mere technicality of terms employed in the claims or specification does not render the patent void for ambiguity or indefiniteness. — *Loom Co. v. Higgins*, 105 U. S. 580; 26 L. Ed. 1177.

The first claim of the reissue, if construed so as to cover the defendant's structure, is void for want of novelty, being anticipated by the old structures referred to. — *Gosling v. Roberts*, 106 U. S. 39; 27 L. Ed. 61; 1 S. Ct. 26.

There is no suggestion that the combination of the second claim was not new; and, there being nothing shown in the state of the art which requires any such construction of the second claim as that contended for by the defendant, and it being fairly susceptible of the opposite construction, and the latter being one which is commensurate with the real invention embraced in the second claim and one which prevents the real substance of that invention from being bodily appropriated by an infringer, it is proper to give the claim such construction. — *Lake Shore v. National*, 110 U. S. 229; 28 L. Ed. 129; 4 S. Ct. 33.

Where certain elements of the invention are shown and described with reference to their function and mode of operation, the claim covering such elements must be construed as covering such elements limited to such function and mode of operation. — *Sharp v. Riessner*, 119 U. S. 631; 30 L. Ed. 507; 7 S. Ct. 417.

The doctrine which is applicable to a machine patent is of a kindred character with that applied in this country and in England to a patent for a process. — *Morley v. Lancaster*, 129 U. S. 263; 32 L. Ed. 715; 9 S. Ct. 299.

McCormick v. Talcott, 61 U. S. 402; *Chicago v. Sayles*, 97 U. S. 554; *Clough v. Barker*, 106 U. S. 166; *Duff v. Sterling*, 107 U. S. 636; *Consolidated v. Crosby*, 113 U. S. 157; and comparing, *Tilghman v. Proctor*, 102 U. S. 707; *Nelson v. Hartford*, 1 Web. P. C. 295; *O'Reilly v. Morse*, 56 U. S. 62, 115; *Curtis v. Platt* (note) L. R. 3 Ch. Div. 134; *Jupe v. Pratt*, 1 Web. 146; *Badische v. Leveinstein*, L. R. 24 Ch. Div. 156, 171; *Househill v. Nelson*, 1 Web. P. C. 685; *Proctor v. Bennis*, L. R. 36 Ch. Div. 740; *Clark v. Adie*, L. R. 2 App. Cas. 315, 320.

If the inventor had been the first to devise a contrivance of this description, it is possible that, under the cases of *Ives v. Hamilton*, 92 U. S. 426, and *Hoyt v. Horne*, 145 U. S. 302; a construction broad enough to include defendant's device might have been sustained. But in view, not only of the prior devices, but of the fact his invention was of doubtful utility and never went into practical use, the construction claimed would operate rather to the discouragement than the promotion of inventive talent. — *Deering v. Winona*, 155 U. S. 286; 39 L. Ed. 153; 15 S. Ct. 118.

Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or that the precise elements described in the patent as rendering it operative must be read into the claim. — *Deering v. Winona*, 155 U. S. 286; 39 L. Ed. 153; 15 S. Ct. 118.

Should this device (a device covering specific means for the alignment and adjustment of the rolls of a roller mill) be adjudged an infringement, we shall not know where to draw the line, provided the alleged infringing device accomplished the four results. — *Consolidated v. Barnard*, 156 U. S. 261; 39 L. Ed. 417; 15 S. Ct. 333.

He used the plural (filaments) omitting the phrases "of high resistance" and "made as described," used in the first claim, in order to be sure that he should not, as to this second claim, be confined by construction to any one variety of filament. — *Edison v. U. S.* 52 Fed. 300; 3 C. C. A. 83.

It is difficult to see why the circumstance that the patentee had no solicitor should lead to any peculiarly liberal construction of this patent, in view of the fact that the description of his invention is singularly clear, complete, intelligent and unambiguous; an agreeable contrast to many which come before this court where the inventor has been represented by solicitor. — *Gould v. Trojan*, 74 Fed. 794; 21 C. C. A. 97.

The position as to the patent in suit was peculiar, arising from the fact that the patentee, who resided abroad, and was ignorant of our language, was instructing his solicitor in the United States with reference to a very complicated machine; but, within the rules laid down by us in *Reece Buttonhole Mach. Co. v. Globe Buttonhole Machine Co.*, there is nothing which justifies us in holding that the inventor, either by implication of law or expressly, abandoned any part of his invention. We have therefore left only the question of infringement, to be determined in the light of the nature of

the invention, which, though limited in its scope in a certain sense, yet, on account of its importance is entitled to liberal protection. — *Heap v. Tremont*, 82 Fed. 449; 27 C. C. A. 316.

In construing this claim, we are permitted to omit the alternative words which we have stricken out, because, if they stood alone, they would narrow the claim within Brush's actual invention. — *Hatch v. Electric*, 100 Fed. 975; 41 C. C. A. 133.

A new rule will be established in patent law if claims for combinations of old elements are held not to cover those elements as they were known in the prior art because the patentee may have used inappropriate language in describing them. — *Cimiotti v. American*, 115 Fed. 498; 53 C. C. A. 230.

The object of the patent law is "to secure to inventors a monopoly of what they have actually invented or discovered," and it "ought not to be defeated by too strict construction" of the terms of the claims, which may be inartificially drawn. — *Austin v. American*, 121 Fed. 76; 57 C. C. A. 330.

Topliff v. Topliff, 145 U. S. 156; *Sewall v. Jones*, 91 U. S. 171.

§ 231. Designs.

A claim in a patent upon a machine for the means employed for producing a design, in connection with other claims upon the machine, is valid and is not a design claim within the meaning of the statute. — *Clark v. Bonsfield*, 77 U. S. 133; 19 L. Ed. 862.

In *Dobson v. Biglow*, 114 U. S. 439, the claim of the design patent was "the design of a carpet substantially as shown." Objection was taken to the form of the claim. But this court said it saw no good objection to the form, and that the claim referred to the description as well as the drawing, in using the word "shown." Undoubtedly the claim in this case covers the design as a whole and not any part of it as a part; and it is so to be tested as to the novelty and infringement. — *Dobson v. Dornan*, 118 U. S. 10; 30 L. Ed. 63; 6 S. Ct. 946.

§ 232. Elements — Essential.

A claim for a machine or for a combination of mechanical devices is not insufficient or invalid because it does not include mechanical devices for uniting and operating the elements of the machine or combination, which would readily suggest themselves to mechanics skilled in the art, or which are described in the specifications and drawings. — *Brammer v. Schroeder*, 106 Fed. 918; 46 C. C. A. 41.

Loom Co. v. Higgins, 105 U. S. 580; *Deering v. Harvester Works*, 155 U. S. 286.

The card's importance may be estimated by the fact that it is an element in nine out of the eleven claims. — *American v. Cimiotti*, 123 Fed. 869; 59 C. C. A. 357.

§ 233. Elements — Redundant.

This invention was for a method of lubrication. *Held*: If the crank shaft were left out the claims of this patent would not be so obnoxious to the criticism that they include in the combination specified any part of the engine which is not a part of the means employed to effect lubrication. The crank shaft is not essential because the necessary disc might be revolved by other means. — *Chuse v. Ide*, 89 Fed. 491; 32 C. C. A. 260.

Note: The entire spirit of this opinion by Judge Woods is to defeat the patent, and the conviction of the court that this should be done (and apparently it should) led to a hypercritical review of the claims. It is true, other means might have been used instead of the crank shaft, but without some means, the claims would have been open to criticism for want of operative-ness, as is apparent where the court, on page 494, essays to draw a claim to suit it.

§ 234. Elements — Reference Characters.

The apron referred to in the claims and indicated by the letter "A," in the drawings accompanying the patent, is an essential part of each claim, as well as the vital part of the patent itself. — *American v. Streat*, 83 Fed. 700; 28 C. C. A. 18.

Parry v. Hitchcock, 58 Fed. 402; *Weir v. Morden*, 125 U. S. 98; *Hendy v. Iron Works*, 127 U. S. 370; *Knapp v. Morss*, 150 U. S. 221.

A reference in a claim to a letter or figure used in the drawing and in the specification to describe a device or an element of a combination does not limit the claim to the specific form of that element there shown, unless that particular form was essential to, or embodied the principle of, the improvement claimed. — *National v. Interchangeable*, 106 Fed. 693; 45 C. C. A. 544.

Sprinkler v. Koehler, 82 Fed. 428; *McCormick v. Aultman*, 69 Fed. 371; *Muller v. Tool Co.*, 77 Fed. 621; *Delemater v. Heath*, 58 Fed. 414; *Reed v. Chase*, 25 Fed. 94; *Walk. Pat.* (3d Ed.) sec. 117a.

§ 235. Elements — Terminology.

In our opinion it cannot be construed as a claim for three elements (a valve, a water chamber, and water in such chamber). The apparatus is the same apparatus whether water is used in it or not. The method of use does not change it, and an inventor who employs a new process of using it, does not thereby invent a new apparatus. — *Consolidated v. Metropolitan*, 60 Fed. 93; 8 C. C. A. 485.

That a mathematical formula which is of the essence of an invention may be made a positive and essential element of a claim, see *Westinghouse v. Saranac*, 113 Fed. 884; 51 C. C. A. 514.

§ 236. Excessive — Duplication.

It would be a waste of time to dwell upon the verbal differences in these claims. The changes in phraseology import nothing of substance into their respective combinations. They describe the same things in different language, and the draftsman seems to have expended great ingenuity in cataloguing a group of synonyms. — *Thomson-Houston v. Hoosick*, 82 Fed. 461; 27 C. C. A. 419.

The rule of construction which usually obtains, whereby the several claims of a patent are to be differentiated so that effect may be given each, cannot be reasonably invoked in behalf of this patent, where so many of the claims are duplicated. — *Thomson-Houston v. Union*, 86 Fed. 636; 30 C. C. A. 313.

§ 237. Excessive — Effect of.

It is true, by the 9th sec. Act Mar. 3, 1837, ch. 45, it is provided, that the suit shall not be defeated when the patentee claims more than he has invented;

it must be, however, in a case where the part invented can be clearly distinguishable from that claimed but not invented.

(See the modification of this act, in view of this construction, in the amendment of 1870, sec. 4922 R. S.) — *Vance v. Campbell*, 66 U. S. 427; 17 L. Ed. 168.

§ 238. Excessive — Foreclosing Improvement.

In other words, having himself experimented only with three or four bodies out of a group of hundreds, he proposes to set himself in the pathway of future experimenters with any or all of the other bodies, and, as the result of each new experiment is disclosed, will fire away at it, calculating to "hit it if it is a deer, and miss it if it is a cow." That this is precisely what is contended for is manifest from the statement, prominently set forth in appellee's brief. — *Matheson v. Campbell*, 78 Fed. 910; 24 C. C. A. 284.

§ 239. Expansion.

One who has invented device with three elements necessary cannot claim two elements to forestall another who employs the two elements for the same position. — *National v. Hedden*, 148 U. S. 482; 37 L. Ed. 529; 13 S. Ct. 680.

Court will not import elements that would operate to so enlarge its scope as to cover an invention not indicated upon its face. — *Wollensak v. Sargent*, 151 U. S. 221; 38 L. Ed. 137; 14 S. Ct. 291.

Day v. Fairhaven, 132 U. S. 98.

If the claim of the patent is not limited to the construction and description of the original application which alone was supported by the required oath, it would seem to be invalid. — *De La Vergne v. Valentine*, 65 Fed. 765; 14 C. C. A. 77.

Eagleton v. West, 111 U. S. 490; *Machine v. Featherstone*, 147 U. S. 209.

§ 240. Failure to Claim.

The failure to claim either one of the elements separately raises a presumption that no one of them is novel. — *Richards v. Chase*, 159 U. S. 477; 40 L. Ed. 225; 16 S. Ct. 53.

A patentee who has claimed either more or less than was necessary, cannot, in a suit for infringement, be relieved from the consequences. — *Boynton v. Morris*, 87 Fed. 225; 30 C. C. A. 617.

McClain v. Ortmyer, 141 U. S. 419; *Durand v. Schulze*, 61 Fed. 819.

The requirement of the patent law that a patentee shall claim in his patent the exact invention is not only to enable the public to use it after the term of the patent has expired, but also for the purpose of enabling any one to determine what the invention is, which is protected by the patent, and what processes which are not protected by the patent may be used in the same manufacture. A person who discovers a new and useful invention does not obtain a monopoly under the patent laws unless he claims his invention in his patent. Even if he describes his invention in the specifications, and then claims as his invention something he has not invented, his patent is good for nothing. — *National v. New England*, 151 Fed. 19; 80 C. C. A. 485.

§ 241. Generic.

He (the inventor) may, for the purpose of describing the extent of his claims, not only state the general principles and requisite features of the

invention in one claim, but the general principles and requisite features in another claim, supplementing this with a more particular description of the details involved in the contemplated structure. We do not consider the claims, identical, and, therefore, one or the other superfluous, but view the first claim as broader than the second in the respect which we have stated, and not inconsistent therewith. — *Consolidated v. West End*, 85 Fed. 662; 29 C. C. A. 386.

If the Moore patent had preceded all other devices for performing the work for which it was intended, it might very well be that he could bring under tribute all who should enter his domain, and build within the wide four corners of his invention; or, if he had made a large advance in a new direction in an art not new, he would have been protected to the extent of the limits of his large invention. — *Moore v. Eggers*, 107 Fed. 491; 46 C. C. A. 425.

Morley v. Lancaster, 129 U. S. 263; *McCormick v. Aultman*, 69 Fed. 371; *Bundy v. Detroit*, 94 Fed. 524.

Inasmuch as there is no prior art limiting Bellis as the first to produce a machine capable of providing loops on a ribbed fabric adapted to be fleeced, we think his invention is entitled to be regarded as of such primary character as to embrace defendant's machine, which performs the same functions of looping and engaging a thread in the fabric by a combination of means covered by the terms of the claims in suit, and operating on the same principle, with the same resulting fleecing capacity. — *Scott v. Fisher*, 145 Fed. 915; 76 C. C. A. 447.

§ 242. Novelty.

The novelty in each case he describes clearly, as he should; and it is not necessary he should go farther. — *Hogg v. Emerson*, 6 How. 437; 12 L. Ed. 505.

1 Story R. 286; Web. on Pat. 86-n; *Macfarlane v. Price*, 1 Starkie, 199; *King v. Cutter*, 1 Starkie 354; 3 Cam & Payne, 611; 2 Mason, 112; *Kingsby & P. on Pat.* 61; *Godson on Pat.* 154; *Isaacs v. Cooper*, 4 Wash. 259.

We are asked to pronounce this process patentable, not because we can see wherein the novelty resides, or that the advantageousness of the process is due to such novelty, but because the product is, in some respects, different from anything going before. — *Cerealine v. Bates*, 101 Fed. 272; 41 C. C. A. 341.

§ 243. Process.

The patentee claimed the use of strong sulphuric acid in reducing rubber scrap, and pointed out that weak sulphuric acid had proven insufficient. *Held*: that the patent must be limited to the use of strong sulphuric acid. — *Chemical v. Raymond*, 71 Fed. 179; 18 C. C. A. 31.

§ 244. Purpose of.

Nothing is better settled in the patent law than that the patentee may claim the whole or any part of his invention, and that if he only describes and claims a part he is presumed to have abandoned the residue to the public. The claim is the measure of his right to relief, and while the specification may be referred to to limit the claim it can never be made available to

expand it. — *McClain v. Ortmyer*, 141 U. S. 419; 35 L. Ed. 800; 12 S. Ct. 76.

Keystone v. Phoenix, 95 U. S. 274; *Lehigh v. Mellon*, 104 U. S. 112; *Masury v. Anderson*, 11 Blatchf. 162; *Merrill v. Yeomans*, 94 U. S. 568; *Burns v. Meyer*, 100 U. S. 671; *Sutter v. Robinson*, 119 U. S. 530.

What is new must be covered by the claim. — *Grant v. Walter*, 148 U. S. 547; 37 L. Ed. 557; 13 S. Ct. 699.

James v. Campbell, 104 U. S. 356.

Formal claims necessary to ascertain scope of invention. — *Grant v. Walter*, 148 U. S. 547; 37 L. Ed. 557; 13 S. Ct. 699.

Merrill v. Yeomans, 94 U. S. 568; *Western Elec. Co. v. Ansonia*, 114 U. S. 447.

It is well known that patentees generally make a much broader statement of the novelty of their invention in the body of the specification than they limit themselves to in the claim, which latter is held to be the distinctive feature of a patent. By the act of congress of 1836, the applicant for a patent was, for the first time, required to "particularly specify and point out the part, improvement or combination which he claims as his own invention or discovery." — *Durand v. Schulge*, 61 Fed. 819; 10 C. C. A. 97.

Merrill v. Yeomans, 94 U. S. 568; *Keystone v. Phoenix*, 95 U. S. 278; *Mahn v. Harwood*, 112 U. S. 360; *Burns v. Meyer*, 100 U. S. 671; *White v. Dunbar*, 119 U. S. 51.

The claim is a statutory requirement prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. — *Westinghouse v. Edison*, 63 Fed. 588; 11 C. C. A. 342.

Quoting: *White v. Dunbar*, 119 U. S. 47.

Railroad v. Mellon, 104 U. S. 112; *Mfg. Co. v. Greenleaf*, 117 U. S. 554.

§ 245. Scope.

Whether the telegraph is regarded as an art or machine, the manner and process of making and using it must be set forth in exact terms. The patent embraces nothing more than the improvement described and claimed as new, and anyone who afterwards discovered a method of accomplishing the same object, substantially and essentially differing from the one described, has a right to use it. The specification of the patentee describes his invention or discovery, and the manner and process of constructing and using it; and his patent, like inventions in the other arts, covers nothing more. — *O'Reilly v. Morse*, 15 How. 62; 14 L. Ed. 601.

We cannot describe a machine which will perform a certain function, and then claim the function itself, and all other machines that may be invented to perform the same function. — *Corning v. Burden*, 15 How. 252; 14 L. Ed. 683.

Inventions sometimes embrace an entire machine, and in such cases it is sufficient if it appears that the claim is co-extensive with the patented improvement. Other inventions embrace one or more parts of a machine, and in such cases the part or parts claimed must be specified and pointed out, so that constructors, other inventors, and the public may know what the invention is and what is withdrawn from general use. — *Parks v. Booth*, 102 U. S. 96; 26 L. Ed. 54.

To hold that one who has discovered that a certain fibrous or textile material answered the required purpose, should obtain the right to exclude everybody from the whole domain of fibrous and textile materials, and thereby shut out any further efforts to discover a better specimen of that class than the patentee had employed, would be an unwarranted extension of his monopoly, and operate rather to discourage than to promote invention. — *Incandescent Lamp Patent*, 159 U. S. 465; 40 L. Ed. 221; 16 S. Ct. 75.

Undoubtedly, when an invention is meritorious, and of a primary character, as seems to be the case here, the patent should be liberally interpreted so as to secure to the patentee his real invention as he has disclosed it to the public by his specification; and, if it be for a process, he should be protected from the unauthorized practice of it by others, by whatsoever mode or forms of apparatus they may apply the process. The appellant's pretensions, however, far transcend the limits of these settled and just rules. Virtually the appellant claims all means, however differing in mode of action and principle from the process described in the patent. — *Celluloid v. Arlington*, 52 Fed. 740; 3 C. C. A. 269.

Tilghman v. Proctor, 102 U. S. 707; *Machine Co. v. Lancaster*, 129 U. S. 263; *Béné v. Jeantet*, 129 U. S. 683; *McClain v. Ortmyer*, 141 U. S. 419; *Corn Planter Pat.* 23 Wall. 218.

If a man describes in his specifications, a machine by which to get a certain result so that anyone skilled in the art can produce the machine and the result, he cannot be deprived of his exclusive right in the machine by a demonstration that his theory stated in the patent, of the causes producing the result is untrue. But a correct and certain knowledge of the principle by which the result is reached will often enable the patentee, or his solicitor, to cover, with general words, many different devices in which it may be applied. If he fails to use broad enough language to do so, then one of two things is true; either that he does not fully understand the true principle and the other devices are not part of his real invention, or else, knowing the principle, and its possible wider application, he has chosen to limit his claim for a monopoly to one particularly described device, and has abandoned the others to the public. Whichever horn of the dilemma he chooses, the court has no power to broaden the claims. — *Brown v. Stilwell*, 57 Fed. 731; 6 C. C. A. 528.

The scope of the claim must, on well-settled principles, be limited to the specific forms of construction shown and described by the patentee. — *Wells v. Curtis*, 66 Fed. 318; 13 C. C. A. 494.

Johnson v. Steel, 50 Fed. 90.

A patentee is not required to claim the entire machine in each claim. Each of the claims at issue is for a complete combination, and there was no necessity for expressing in terms the actuating devices. Any appropriate means for operating it will be understood. The omission of the actuating mechanism does not affect the validity of either one of the claims, which belong to that class where reference may be made to the specifications to supply in a claim what it is plain, to anyone skilled in the art, is a necessary incident. — *Taylor v. Sawyer*, 75 Fed. 301; 22 C. C. A. 203.

Reece v. Globe, 61 Fed. 970; *Deering v. Winona*, 155 U. S. 286.

If his invention is of a broad and meritorious character, such as to work a decided advance in the art, it will require something more than the use of reference letters in his claims to limit him to the exact form of device he has described. — *Muller v. Lodge*, 77 Fed. 621; 23 C. C. A. 357.

Pluralizing terms in the claim for the purpose of broadening it does not limit the claim so that a use in the singular is not an infringement of the plural. — *International v. Bennett*, 77 Fed. 313; 23 C. C. A. 179.

We are referred to no authority, and know of no principle, which will sustain the complainant's contention that he can thus, in the language of the circuit court, "speculate on the equivalents of his claimed invention, and thereby oblige the public to resort to experiments in order to determine the scope of the claims of his patent. — *Matheson v. Campbell*, 78 Fed. 910; 24 C. C. A. 284.

A patentee is bound by what his patent actually discloses and not by what he supposes his invention to be. — *Jackson v. Birmingham*, 79 Fed. 801; 25 C. C. A. 196.

The improvement was described in connection with a single thread machine; but the specification indicated its general adaptability. *Held*: The claims, therefore, in our opinion, cover the devices of the patent whether used in a double or in a single thread machine. — *Willcox v. Merrow*, 93 Fed. 206; 35 C. C. A. 269.

Deering v. Harvester, 155 U. S. 286.

A patentee is entitled to every function his device will perform, though he was ignorant of it when he procured his patent. But he secures no patent on the function, and a discovery of a new one in a patented device does not operate to broaden or enlarge the letter of his claim. — *Dunlap v. Willbrandt*, 151 Fed. 223; 80 C. C. A. 575.

§ 246. Specific.

The fact that the defendant was able, by a skillful contrivance, to dispense with one of the elements of plaintiff's claim, the plaintiff's patent not being generic, does not make the device an infringement. — *Derby v. Thompson*, 146 U. S. 476; 36 L. Ed. 1051; 13 S. Ct. 181.

If the first claim is valid, the second certainly is, because it is for the same combination, with limitations which include some additional minor improvements. — *Schenck v. Singer*, 77 Fed. 841; 23 C. C. A. 494.

A patentee may, however, describe all the devices in his machine or manufacture, and instead of claiming all or any particular portion of them in combination, may claim so much of the described mechanism as produces a particular described result. — *Parsons v. Seelye*, 100 Fed. 455; 40 C. C. A. 486.

Silsby v. Foote, 14 How. 218.

The terms of the claim are most specific, and it must be read with reference to the particular descriptions contained in the specifications and illustrated by the patent drawings. — *Reineke v. Dixon-Woods*, 102 Fed. 349; 42 C. C. A. 388.

Fay v. Cordesman, 109 U. S. 408; *Knapp v. Morss*, 150 U. S. 221.

§ 247. Sufficiency.

The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights. The genius of the inventor constantly making improvements in existing patents, a process which gives to the patent system its greatest value, should not be

restrained by vague and indefinite descriptions of claims in existing patents from the salutary and necessary right of improving on that which has already been invented. It seems to us that nothing can be more just and fair both to the patentee and to the public, than that the former should understand and correctly describe just what he has invented, and for what he claims a patent. — *Merrill v. Yeomans*, 94 U. S. 568; 24 L. Ed. 235.

But we are of opinion that the description and claim are sufficient. The purport of the description is, that what the photographic illustration represents as a whole is the invention. It is that which is claimed, when applied to carpeting. The design is a pattern to be worked into a carpet, and is within the statute. Claiming "the configuration of the design" is the same thing as claiming the design, or the figure or the pattern. It is better represented by the photographic illustration than it could be by any description, and a description would probably not be intelligible without the illustration. — *Dobson v. Dornan*, 118 U. S. 10; 30 L. Ed. 63; 6 S. Ct. 946.

See *Dobson v. Bigelow*, 114 U. S. 439.

In every patent the language of the claim, specification and grant, should be so clear, distinct and positive as to leave no question of what was asked and granted, nor should it require a careful, nice and labored investigation to ascertain whether one may not have trespassed upon the rights of the patentee. It is the duty of the inventor to use language sufficiently plain and explicit in his application to denote clearly what he asks for, and when he fails to do so, and the language of the grant follows that of the application, and is thereby misleading to the general public, he should gain no profit from such defective statement of that to which he considers he is entitled. — *Gerard v. Diebold*, 61 Fed. 209; 9 C. C. A. 451.

It is plainly unsound argument to say that, because the patentee does not expressly limit his patent to the device which he actually shows, therefore he is not entitled to the benefit of the invention involved in the use of one. — *McCormick v. Aultman*, 69 Fed. 371; 16 C. C. A. 259.

Where the invention is an improvement on a machine the claim need not include the main elements of the machine. — *Goshen v. Bissell*, 72 Fed. 67; 19 C. C. A. 13.

Here the result is obtained quite irrespective of the location of the upper ends of the brace-ropes. The state of the art does not require the novelty of the claims to be predicated of a particular location. — *Avery v. Case*, 148 Fed. 214; 78 C. C. A. 110.

Cazier v. Mackie-Lovejoy, 138 Fed. 654; *Machine Co. v. Murphy*, 97 U. S. 120; *Beach v. American*, 63 Fed. 597; *King v. Hubbard*, 97 Fed. 795; *Calculagraph v. Wilson*, 132 Fed. 20; *Benbow-Erammer v. Simpson*, 132 Fed. 614.

§ 248. Void.

One void claim does not vitiate a patent if made by mistake or inadvertence and without any wilful default or intent to defraud or mislead the public. — *Carlton v. Bokee*, 84 U. S. 463; 21 L. Ed. 517.

COMBINATIONS.

<p>General Statement § 249 See — <i>Aggregation</i> § 44; <i>Anticipation</i> §§ 67-69; <i>Claims</i> § 184; <i>Ele-</i></p>	}	<p><i>ments</i> § 232; <i>Improvement</i> § 433; <i>Infringement</i> §§ 464-73; <i>Invention</i> §§ 603-12.</p>
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§ 249. General Statement.

Combinations cannot be treated as constituting a single, unitary subject in the patent law. The Patent Statute does not use the term either as designating a patentable class of invention or as a condition of invention. But the term plays a large part in connection with *Infringement* §§ 466-473 and *Invention*, §§ 603-612 and also with the subjects of *Claims* § 187. It is sufficient to refer generally to those subjects, and to append what is regarded as one of the nearest approaches to a definition of patentable combination.

It must be considered that a new combination, if it produces new and useful results, is patentable, although all the constituents of the combination were well known and in common use before the combinations were made. But the result must be a product of the combination, and not a mere aggregate of several results, each the complete product of one of the combined elements. Combined results are not necessarily a novel result, nor are they an old result obtained in a new and useful manner. Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention. No one by bringing together several old devices without producing a new and useful result, the joint product of the elements of the combination and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices, either singly or in other combinations, or, even if a new and useful result is obtained, can prevent others from using some of the devices, omitting others, in combination. — *Hailes v. VanWormer*, 87 U. S. 353; 22 L. Ed. 247.

COMITY

General Statement and Definition § 250	Supreme Court and Circuit Court of Appeals § 255
Between Circuit Courts § 251	Weight of § 256
Between Circuit Court of Appeals and Circuit Court § 252	Miscellaneous § 257
Between Circuit Courts of Appeal § 253	See — <i>Adjudication</i> § 28; <i>Defenses</i> § 315; <i>Estoppel</i> § 381; <i>Injunction</i> § 535; <i>Interferences</i> § 580; <i>Res Judicata</i> § 893
Prior Adjudication § 254	

§ 250. General Statement and Definition.

If both court and counsel had kept before them more clearly the very plain and reasonable rule of the Supreme Court that "comity is not a rule of law, but one of practice, convenience and expediency," there would have been less confusion than appears from the following quotations, and vastly less than appears when we read the opinions of the circuit courts. In the nature of things there can be no enforced comity. The only approach to such a rule is that in *Kessler v. Eldred*, 206 U. S. 285, (see § 31); but the rule of that case is one of *res judicata* rather than of comity.

The question of comity arises, or is attempted to be raised, perhaps more frequently in connection with applications for injunctions *pendente lite* than in any other, but it will be found that the distinct tendency of the courts in all questions involving the exercise of the extraordinary powers of injunctive relief is to rely upon the exercise of a sound discretion in view of the record presented, and not to rest the exercise of such authority upon the event of another cause or the opinion of another court.

Comity is not a rule of law, but one of practice, convenience and expediency. It is something more than mere courtesy, which implies only deference to the opinion of others, since it has a substantial value in securing uniformity of decision, and discouraging repeated litigation of the same question.

But its obligation is not imperative. If it were, the indiscreet action of one court might become a precedent, increasing in weight with each successive adjudication, until the whole country was tied down to an unsound principle. Comity persuades; but it does not command. It declares, not how a case shall be decided, but how it may with propriety be decided. It recognizes the fact that the primary duty of every court is to dispose of cases according to the law and the facts; in a word, to decide them right. In doing so, the judge is bound to determine them according to his own conviction. It demands of no one that he shall abdicate his individual judgement, but only that deference shall be paid to the judgements of other co-ordinate tribunals. — *Mast v. Stover*, 177 U. S. 485; 44 L. Ed. 856; 20 S. Ct. 708.

A direct utterance (referring to *Stover v. Mast*, 89 Fed. 333, affirmed 177 U. S. 485) could not have made it more clear that no court is to be reviewed or reversed, without an enquiry into the merits, merely because it failed or refused to follow the decision of another court to which it was not directly subordinate. Not less than of the Supreme Court, is it the duty of this court, within the sphere of its jurisdiction, to decide questions presented according to its own judgment. The purpose of Congress in creating the circuit courts of appeals and in conferring upon them the extraordinary jurisdiction given them in appeals from interlocutory orders of injunction, would be to a large extent thwarted if the doctrine of comity, always factitious and sometimes pernicious, should be allowed in these courts to take the place of independent and conscientious judgment. The safeguard against the evil of diverted and discordant decisions in the different circuits is in the power given to the Supreme Court to require the certification of cases to that Court for review; and evidently a prompt and healthy exercise of that power is more likely to follow inconsistency of decision in the courts of appeals than a harmony of rulings brought about by considerations of deference to comity. — *Welsbach v. Cosmopolitan*, 104 Fed. 83; 43 C. C. A. 418.

§ 251. Between Circuit Courts.

The rule of practice for one member of a court to regard the prior decision of another, in cases of this kind, as to be followed until otherwise authoritatively adjudicated, seems to be justified in the orderly conduct of proceedings. — *Brill v. Peckham*, 189 U. S. 57; 47 L. Ed. 706; 23 S. Ct. 562.

A circuit court will give respect to a decision of another circuit upon the same patent and the same proofs; and will consider only new matters of defense presented. — *Wanamaker v. Enterprise*, 53 Fed. 791; 3 C. C. A. 672.

National v. American, 53 Fed. 367.

§ 252. Between Circuit Court of Appeals and Circuit Court.

The court below followed the decision of the court in Massachusetts (*National v. Boston*, 45 Fed. 481). The course pursued in this regard was in conformity with the rule, well established in this circuit, to follow, unless under extraordinary circumstances, a prior judgment of any other of the circuit courts of the United States, wherever the patent, the question and the evidence are the same in both suits. We do not question the propriety of this practice as it has heretofore prevailed; but it cannot be extended to this court. The decisions of the several circuit courts, whenever pertinent, will be attentively considered by this tribunal; but because they are subject to appeal, and for other manifest reasons, it is not admissible for a court of review to accord them controlling effect. — *National v. American*, 53 Fed. 367; 3 C. C. A. 559.

The practice of comity existing between circuit courts is not applicable to this court. — *Wanamaker v. Enterprise*, 53 Fed. 791; 3 C. C. A. 672.

National v. American, 53 Fed. 367.

Upon a final hearing upon the merits it would be different, for then considerations of comity might properly have weight with the court below, which we should not hesitate, as an appellate court, to disregard in finally settling the rights of the parties. — *Duplex v. Campbell*, 69 Fed. 250; 16 C. C. A. 220.

Questions on appeals of this character are ordinarily to be treated in this court from the standpoint from which they were viewed by the circuit court, and the decision on merits by a circuit court of another circuit, sustaining the patent, is therefore usually of controlling weight here, as it should be in the court below. — *Thomson-Houston v. Ohio*, 80 Fed. 712; 26 C. C. A. 107.

This court as an appellate tribunal is not in the least concluded by the decision in the New York case, nor do considerations of comity toward a circuit court with respect to its rulings have the same potency with a circuit court of appeals as they may properly have with a circuit court when confronted with the alternative of following or departing from the ruling of another circuit court. — *McNeely v. Williams*, 96 Fed. 978; 37 C. C. A. 641.

§ 253. Between Circuit Courts of Appeals.

Whether and how far in a case like this, in which a patent has been held invalid by the circuit court of appeals in another circuit, this court should be controlled by such judgement — *quaere*. — *Hammond v. Weld*, 72 Fed. 171; 18 C. C. A. 502.

It is not claimed that the judgment of the Circuit Court of Appeals for the Second Circuit is controlling in the sense that the question is *res adjudicata*, but the high respect we have for the ability, learning and experience of the judges of that court is a very persuasive reason for following it, when by so doing we may assist in securing that uniformity which is very desirable, thus avoiding confusion and preventing repeated litigation of the same question; but the parties before us have the right to our individual judgment, and considerations of convenience and expediency must give way to demands of duty, from which we cannot be absolved by the doctrine of comity. — *Imperial v. Crown*, 139 Fed. 312; 71 C. C. A. 442.

Mast v. Stover, 177 U. S. 488.

In accordance with our usual custom of yielding to decisions of the circuit courts of appeals of other circuits, we perceive no reason why we should not follow this one. Therefore the only question left for our investigation is that of anticipation, and we open that only so far as it appears that the alleged anticipations are shown to us which were not shown to the Circuit Court of Appeals for the Second Circuit. — *O'Brien v. Foster*, 159 Fed. 710; 86 C. C. A. 464.

§ 254. Prior Adjudication.

We appreciate the great importance in patent litigation of uniformity of rulings by courts of concurrent jurisdiction, and ordinarily, it is a commendable practice upon a question of the allowance of a preliminary injunction, to accept and follow the decisions of a circuit court of appeals of

another circuit sustaining and construing a patent. Such practice has always prevailed in this circuit. In the present case, however, the circumstances are so unusual that we are constrained to make an independent investigation as to the validity and scope of the first claim of this reissue. — *Horn v. Pelzer*, 91 Fed. 665; 34 C. C. A. 45.

American v. McKeesport, 57 Fed. 661; *Edison v. Phila.* 60 Fed. 397; *Crump v. Light Co.* 65 Fed. 551.

Note: But the District Judge dissents; and on what possible ground the court could have refused, at this stage of the litigation, to follow the decision of the Second Circuit, is absolutely impossible to understand.

Although the defendants in this case are not the same, or in privity with the defendants in other cases, we think, as a general rule, and especially in patent cases, we should follow the decisions of the circuit court of appeals, of another circuit upon final hearing with respect to the issues determined, if based upon substantially the same state of facts, unless it should clearly appear that there was manifest error. — *Beach v. Hobbs*, 92 Fed. 146; 34 C. C. A. 248.

§ 255. Supreme Court and Circuit Courts of Appeals.

Of course we are bound to give to this question of anticipation an independent consideration. At the same time, we feel ourselves bound to defer somewhat to the unanimity of opinion upon the part of so many learned and distinguished judges, whose lives have been largely devoted to the examination of patent causes. — *Hobbs v. Beach*, 180 U. S. 383; 45 L. Ed. 586; 21 S. Ct. 409.

§ 256. Weight of.

The obligation to follow the decisions of other courts in patent cases of course increases in proportion to the number of courts which have passed upon the question, and the concordance of opinion may have been so general as to become a controlling authority. So, too, if a prior adjudication has followed a final hearing upon pleadings and proofs, especially after a protracted litigation, greater weight should be given to it than if it were made upon a motion for a preliminary injunction. — *Mast Co. v. Stover Co.* 177 U. S. 485; 44 L. Ed. 856; 20 S. Ct. 708.

Macbeth v. Gillinder, 54 Fed. 169; *Electric v. Edison*, 61 Fed. 834; *Edison v. Beacon*, 54 Fed. 678; *Beach v. Hobbs*, 82 Fed. 916; *Newall v. Wilson*, 2 DeG. M. & G. 282.

Those adjudications, except the first, it is fair to assume, were governed by the well-known rule of comity by which one federal court follows the ruling of another, especially in patent cases, and are therefore not entitled to the weight of so many independent judgements. — *National v. Quick*, 74 Fed. 236; 20 C. C. A. 410.

That great deference should be paid to the circuit court of appeals of the third circuit is true, and we have conformed to that duty, but have not been able to accord with the result which that court reached. — *Hanifen v. Price*, 102 Fed. 509; 42 C. C. A. 434.

§ 257. Miscellaneous.

Comity, however, has no application to questions not considered by the prior art, or, in patent cases, to alleged anticipating devices which were not

laid before the court. — *Mast v. Stover*, 177 U. S. 485; 44 L. Ed. 856; 20 S. Ct. 708.

Prima facie, a decision founded upon one patent not in suit here, and another decision founded upon three patents collectively, one only of which is in suit here, the two decisions declaring that an invention used by a defendant who is not the defendant here, against a machine of that defendant differing widely in its structure from the one complained of here, cannot be treated as binding in the decision which this court may feel bound to render in the suit at bar. — *Boyden v. Westinghouse*, 70 Fed. 816; 17 C. C. A. 430.

A decent respect for the stability of judicial decision, and a proper regard for the security of property in patents, requires that we shall not reverse our original holding in respect of the same patent, unless convinced of a very palpable error in law or in fact. — *Penfield v. Potts*, 126 Fed. 475; 61 C. C. A. 371.

We have especially shown the propriety of following decisions of the Circuit Courts of Appeals with regard to decisions touching letters patent for inventions in *Beach v. Hobbs*, 92 Fed. 146; *Hatch v. Electric*, 100 Fed. 975. The Supreme Court laid down a like practical rule in *Hobbs v. Beach*, 180 U. S. 383. In the present case, however, while the Circuit Court might well have felt constrained to follow the result of the Circuit Court of Appeals for the Second Circuit, the body of prior judicial decisions is of such an inharmonious character that we may well make an independent investigation, based on the evidence before us. — *Westinghouse v. Stanley*, 133 Fed. 167; 68 C. C. A. 523.

The discussion in the opinion in the last case cannot be said to particularly bind the court, because it was carried out for the most part by simply making long extracts from the opinion passed down in the Circuit Court. This is a mere quotation from the opinion of the Circuit Court, and not an expression devised by the Supreme Court; and it is not to be assumed that where an appellate tribunal, as in this case, quotes long extracts, it is held to be bound by all the expressions contained in them. — *Westinghouse v. Stanley*, 138 Fed. 823; 71 C. C. A. 189.

No two cases are identical upon the facts. Differences can always be pointed out, but the question for the court to determine is are the differences of such a character as to induce the court to believe that if the facts in the second case had been present in the first case the same result would have been reached; in other words, are the cases the same in principle? — *Cortelyou v. Johnson*, 145 Fed. 933; 76 C. C. A. 455.

See *Cortelyou v. Carter*, 118 Fed. 1022; *Broderick v. Mayhew*, 131 Fed. 92, *affd.* 137 Fed. 596.

The fact that the court is now differently constituted is, of course, quite immaterial. If entitled to be considered at all upon a question of general significance, like that under consideration, it should operate as an additional reason for adhering to existing conditions. It is the court, not the individuals composing it, that declares the law; and it would be unseemly, to say the least, to review propositions previously established, even though as an original proposition we might have been led to a different conclusion. — *Cortelyou v. Johnson*, 145 Fed. 933; 76 C. C. A. 455.

Cimiotti v. Nearsal, 123 Fed. 479.

COMMISSIONER OF PATENTS.

Statutory Provision § 258
 General Statement § 259
 Actions § 260
 Decisions of § 261
 Duties § 262

Powers of § 263
See — Appeals § 114; Defenses § 308; Interferences § 580; Patent Office § 783; Reissue § 880; Res Judicata § 895

§ 258. Statutory Provisions.

Sections 476, 479, 481, 483, 484, 4883, 4893, 4905, 4910, and 4913, R. S. relate especially to the Commissioner. Of these only the following need be quoted:

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. — R. S. 481.

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. — R. S. 483.

§ 259. General Statement.

The duties of the Commissioner are, therefore, both executive and judicial. The records of the executive duties performed are to be found in the Annual Reports of the Commissioner, and the records of the judicial acts are to be found in the Patent Office Gazette and in the Commissioner's Decisions.

§ 260. Actions of.

The issuance of a patent is prima facie evidence of the regularity of proceedings had. — *Railroad v. Stimpson*, 14 Pet. 448; 10 L. Ed. 535.

It is to be presumed, until the contrary is made to appear, that the commissioner did his duty correctly in granting the reissued patent. — *Klein v. Russell*, 86 U. S. 433; 22 L. Ed. 116.

The action of the Commissioner in any case, within the limits of his authority, is not open to collateral impeachment. But a reissue for a different invention is an excession of authority contrary to law. — *Russell v. Dodge*, 93 U. S. 460; 23 L. Ed. 973.

Seymour v. Osborne, 11 Wall. 544; *Wicks v. Stevens*, 2 Woods, 312.

Yet both these matters (abandonment and public use) as well as the originality of the invention, upon which the Commissioner must pass, must be contested in suits brought for infringement of the patent. Such defenses are allowed by the statute. — *Woodbury v. Keith*, 101 U. S. 479; 25 L. Ed. 939.

§ 261. Decisions of.

No other tribunal is empowered to controvert the sufficiency of the proofs before the commissioner incident to the performance of his duties. — *Railroad v. Stimpson*, 14 Pet. 448; 10 L. Ed. 535.

Application for a patent is required to be made to the commissioner appointed under authority of law, and inasmuch as that officer is empowered to decide upon the merits of the application, his decision in granting the

patent is presumed to be correct. — *Agawam v. Jordan*, 74 U. S. 583; 19 L. Ed. 177.

Pitts v. Hall, 2 Blatchf. 229; *Union v. Matthieson*, 2 Fish. 600.

Inasmuch as that officer is empowered to decide upon the merits of the application, his decision in granting the patent is presumed to be correct. — *Mitchell v. Tilghman*, 86 U. S. 287; 22 L. Ed. 125.

Agawam v. Jordan, 7 Wall. 597.

The action of the commissioner of patents in granting a patent is not conclusive either as to novelty, utility or prior use. — *Reckendorfer v. Faber*, 92 U. S. 347; 23 L. Ed. 719.

Hotchkiss v. Greenwood, 11 How. 248; *Stimpson v. Woodman*, 10 Wall. 117; *Hailes v. Van Wormer*, 20 Wall. 353; *Rubber v. Howard*, 20 Wall. 498; *Smith v. Nichols*, 21 Wall. 115; *Hicks v. Kelsey*, 18 Wall. 670; *Seymour v. Osborne*, 11 Wall. 516.

In matters of this description, in which the action of the Commissioner is quasi judicial, the fact that no appeal is expressly given to the Secretary of the Interior is conclusive that none is to be implied. — *Butterworth v. Hoe*, 112 U. S. 50; 28 L. Ed. 656; 5 S. Ct. 25.

The decision of the Commissioner in favor of the applicant, upon the question whether the invention has been abandoned, is not conclusive, but may be contested and reviewed in a suit brought for the infringement of the patent. — *U. S. v. Whitney*, 118 U. S. 22; 30 L. Ed. 53; 6 S. Ct. 950.

Planing v. Keith, 101 U. S. 479.

§ 262. Duties.

Patents are public records of which all persons are bound to take notice. Upon proper application and the payment of fees the commissioner is obliged to furnish copies of such records. — *Boyden v. Burke*, 14 How. 575; 14 L. Ed. 548.

The relator had done all in his power to make his application effectual, and had a right to consider it properly before the commissioner. If the commissioner refused to take any action mandamus would lie; but having acted the remedy is by appeal. — *Holloway v. Whiteley*, 71 U. S. 522; 18 L. Ed. 335.

§ 263. Powers of.

Doubtless the several requirements of the statute may be regarded as conditions precedent to the right of the commissioner to grant the application, as they must appear on the face of the letters patent, and are always open to legal construction as to their sufficiency. — *Seymour v. Osborne*, 78 U. S. 516; 20 L. Ed. 33.

When patents were issued by the Secretary of State, it was held that the power to correct a mistake resided in that officer, irrespective of the statute. *Grant v. Raymond*, 6 Pet. 243. By the laws creating the office of Commissioner of Patents and transferring to the Secretary of the Interior the power previously exercised by the Secretary of State, it has devolved upon the Commissioner to superintend, execute and perform all acts respecting the granting and issuing of patents, subject to revision by the Secretary of the Interior. Original power was conferred upon him to grant reissue by permissive language. By the act of July 8, 1870 (16 Stat. 205,

c. 230) the permissive words were substituted by the mandatory words of the statute as it now exists. It is the effect of this legislation to delegate to the commissioner, subject to the interposition of the Secretary of the Interior, all those acts with respect to the issuing of patents which originally devolved upon the Secretary of State. — *Thomson-Houston v. Black River*, 135 Fed. 759; 68 C. C. A. 461.

COMPOSITION OF MATTER.

Statutory Provision § 264
 General Statement § 265
 General Rules § 266

See — Manufacture § 772; Process §§ 820-1; Product § 823

§ 264. Statutory Provision.

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter * * * — R. S. 4886.

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 composition, sufficient in quantity for the purpose of experiment. — R. S. 4890.

§ 265. General Statement.

The line of separation between a composition of matter and an article of Manufacture is not always distinct. It will be noted that a composition of matter may also be an article of manufacture, which may be patentable; but that, on the other hand, an article of manufacture, in order to be patentable, need not be composed of a novel combination of ingredients which would render it patentable as a composition of matter.

The subjects of composition of matter and *Manufacture* and *Process* are more or less closely related.

§ 266. General Rules.

In most compositions of matter, some small difference in the proportions must occasionally be required, since the ingredients proposed to be compounded must be in some degree superior or inferior to those most commonly used. — *Wood v. Underhill*, 5 How. 1; 12 L. Ed. 23.

When the specification of a mere composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly, it would be the duty of the court to declare the patent void. And the same rule would prevail when it was apparent that the proportions were stated ambiguously and vaguely. For in such cases it would be apparent on the face of the specification that no one could use the invention without first ascertaining by experiment the exact proportions. — *Wood v. Underhill*, 5 How. 1; 12 L. Ed. 23.

The character and purpose of the specification as compared with the English system. — *Hogg v. Emerson*, 6 How. 437; 12 L. Ed. 505.

Where a patent upon an article of manufacture does not claim the composition of matter, though it describes it, such omission is public dedication of the said composition. — *Underwood v. Gerber*, 149 U. S. 224; 37 L. Ed. 710; 13 S. Ct. 854.

Had the description and claims proceeded upon some designated treatment or process, we might have found a way to sustain their validity. But the

patent is ambitious beyond this. It seeks to exclude the use, by others, of pulverized silica in any proportion. It surveys a field that includes any silicate "having a frictional property and capable of being pulverized and compacted." To sustain this would be to hold that the use of pulverized silica in a billiard chalk, independently of the proportions employed, was a discovery properly embodied in appellant's patent. This the state of the art will not justify. — *Hoskins v. Matthes*, 108 Fed. 404; 47 C. C. A. 434.

CONGRESS.

Constitutional Powers § 267

| Plenary Powers § 268

§ 267. Constitutional Powers.

The Congress shall have power:

* * * * *

8. 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.

9. To constitute tribunals inferior to the Supreme Court. — Const. Art. I, Sec. VIII.

It will thus be seen that the power to create the patent monopoly resides in paragraph 8, while the power to maintain and protect that monopoly emanates from paragraph 9. In the exercise of its power Congress creates nothing that did not exist before. *Continental v. Eastern*, 210 U. S. 405. It would not have been enough to empower Congress to create a monopoly in derogation of the common-law; the power to punish for trespass and to restrain from infringement are vital necessities.

§ 268. Plenary Powers.

The powers of Congress are plenary. A patent may be granted by it wholly independently of the Patent Office and the statutes relating to the regular granting of patents. Such power has been exercised; but it would be only in the event of a most extraordinary state of facts that such power would be again asserted. It has not been asserted for years, and stern refusal has met every attempt to invoke these powers.

The power of Congress to legislate upon the subjects of patents is plenary by the terms of the Constitution, and as there are no restraints on its exercise, there can be no limitation of their rights to modify them at their pleasure, so they do not take away the rights of property in existing patents. — *McClurg v. Kingsland*, 1 How. 202; 11 L. Ed. 102.

CONTEMPT.

General Statement § 269

| See — *Injunction* §§ 536-8, 577

§ 269. General Statement.

Punishment for violation of a court order or decree occurs, in patent causes, well-nigh invariably in connection with injunctions, and most commonly with preliminary injunctions. In order that the entire appellate law on the subject may be studied together, all rulings relating to contempt are assembled under *Injunction — Appeals*, § 536, and *Injunction — Violation of*, § 577.

COPARTNERSHIP.

Miscellaneous Rulings § 270

See — *Assignment* § 155; *Joint In-*

| *ventions* § 704; *License* § 749; *Title* § 925

§ 270. Miscellaneous Rulings.

It is competent for two persons, joint owners of letters patent, whether valid or invalid, to enter into a copartnership for the manufacture and sale of the patented machines and to enter into an agreement not to manufacture independently thereunder, and such agreement is not in restraint of trade. — *Kinsman v. Parkhurst*, 59 U. S. 289; 15 L. Ed. 385.

A copartner holding no interest in the patent could not sue on the patent for such damages or any part of them. — *Yale v. Sargent*, 117 U. S. 536; 29 L. Ed. 954; 6 S. Ct. 934.

The plaintiff, as the owner of the patent, is entitled to recover the damages in this case. He may be accountable to his copartner for a part of them, but the copartner could not sue on the patent, for such damages or any part of them. — *Yale v. Sargent*, 117 U. S. 536; 29 L. Ed. 954; 6 S. Ct. 934.

Where partnership constructed a machine with knowledge and consent of inventor before application, an implied license arises in favor of the machine so constructed. — *Wade v. Metcalf*, 129 U. S. 202; 32 L. Ed. 661; 9 S. Ct. 271.

A license from one member to the firm for the use of the firm expires with the firm. — *Haffeke v. Clark*, 50 Fed. 531; 1 C. C. A. 570.

Oliver v. Chemical Co., 109 U. S. 75; *Nail Factory v. Corning*, 14 How. 193; *Gayler v. Wilder*, 10 How. 477.

The object of the agreement is expressly stated to be the creation and building up of a good business, which business was to be owned and shared equally and mutually by both. The learned judge who tried the case at circuit, construed this agreement as providing that whatever rights either might, by its terms, acquire in future inventions of the other, should be "qualified down to the requirements of the business" they were undertaking to build up, and that when the business ceased, each patent for an improvement should remain the property of the individual inventor, unqualified by any further interest of the other therein. — *Denning v. Bray*, 61 Fed. 651; 10 C. C. A. 6.

CORPORATIONS.

Miscellaneous Rulings § 271		§ 156; <i>Infringement</i> §§ 479-82; <i>Injunction</i> § 547
See — <i>Abatement</i> § 23; <i>Assignment</i>		

§ 271. Miscellaneous Rulings.

One corporation cooperating with another in the infliction of a wrong is directly responsible for the resulting damage. — *Railroad v. Winans*, 58 U. S. 31; 15 L. Ed. 27.

An implied license arising out of the employment and invention of an employee confers upon a corporation an unassignable right only and does not pass to a new corporation. — *Hapgood v. Hewitt*, 119 U. S. 226; 30 L. Ed. 369; 7 S. Ct. 193.

Troy v. Corning, 55 U. S. 193; *Oliver v. Rumford*, 109 U. S. 75.

The acquiescence of the former owners of the patent has in equity the same effect upon complainant's rights as its own subsequent neglect. — *Woodmansee v. Williams*, 68 Fed. 489; 15 C. C. A. 520.

Rob. Pat. 1194; *Spring v. Sewing*, Fed. Cas. 13,258; *McClurg v. Kingsland*, 1 How. 205.

A mere stockholder is not bound by the acts of a corporate body for which he labors as an employee. — *American v. Phoenix*, 113 Fed. 629; 51 C. C. A. 339.

Machine Co. v. Woodward, 82 Fed. 97.

COSTS.

Statutory Provisions § 272
 Appeals § 273 (*see* § 109)
 Disclaimer § 274 (*see* § 339)

Record § 275
 Taxation § 276
 Miscellaneous § 277

§ 272. Statutory Provisions.

Costs may be recovered by a plaintiff or complainant who succeeds in an action for infringement, under 4919 R. S. In like manner, a defendant succeeding in such an action is entitled to his costs under 4920 R. S.

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 (4917 R. S.), has been entered at the Patent Office before the suit was brought. 973 R. S.

* * * 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. * * * — 4922 R. S.

§ 273. Appeals.

An appeal involving costs will not be entertained here. — *Paper Bag Cases*, 105 U. S. 766; 26 L. Ed. 959.

When the plaintiffs fail in this court on both appeals, (one in which they had been successful below) they are to pay the costs of this court on both appeals. — *Yale v. Berkshire*, 135 U. S. 342; 34 L. Ed. 168; 10 S. Ct. 884.

This court has held in several cases that an appeal does not lie from a decree for costs; and if an appeal be taken from a decree upon the merits, and such decree be affirmed with respect to the merits, it will not be reversed upon the question of costs. — *DuBois v. Kirk*, 158 U. S. 58; 39 L. Ed. 895; 15 S. Ct. 729.

Glendale v. Smith, 100 U. S. 110; *Wood v. Weimer*, 104 U. S. 786; *Russell v. Farley*, 105 U. S. 433.

The apportionment of costs is generally for the master and the circuit court, and appeals, except in extraordinary cases will not be entertained. — *Davis v. Parkman*, 71 Fed. 961; 18 C. C. A. 398.

The patent having expired *pendente lite* and nominal damages having been awarded, an appeal cannot lie, as the only question is one of costs. — *Gamewell v. Municipal*, 77 Fed. 490; 23 C. C. A. 250.

That when a claim sued on proves invalid on appeal costs will be barred, see *Metallic v. Brown*, 110 Fed. 665; 49 C. C. A. 147.

Albany v. Felthousen, 20 Fed. 633; *Mann's v. Monarch*, 34 Fed. 130.

That if, on appeal, part of the claims sued on are sustained and part are not, the costs will be divided, see *Ide v. Trorlicht*, 115 Fed. 137; 53 C. C. A. 341.

Willcox v. Merrow, 93 Fed. 206; *Thomson-Houston v. Elmira*, 71 Fed. 396; *Albany v. Felthousen*, 20 Fed. 633.

Undoubtedly the statutory provision (as to disclaimer) applies to costs in the court below, but no case has been brought to our attention in which it was directly held that the statutory provision applies to costs on appeal. Our decree rectifies the error of the court in dismissing the bill, and remands the case with instructions to enter a decree in favor of the complainants, which should have been rendered. We think, then, that the appellants are rightfully entitled to costs in this court upon appeal, but not to costs below. — *Kahn v. Starrels*, 136 Fed. 597; 69 C. C. A. 371.

If the mandate of this court requires the trial court to enter a decree sustaining some parts of the patent and finding infringement, the statute will then have application and the patentee will not be allowed his costs because he had not entered his disclaimer before starting his suit and had put the defendant and the public to the disadvantage incident to his having asserted certain parts of his patent without right. We are not satisfied that either section (R. S. 973 and 4922) applies to a decree of this court where the decree of the court below is found erroneous, and that court is directed to enter a decree sustaining some of the claims of the patent in suit. If that court had rendered the proper decree, the patentee would not have been compelled to come here to obtain the measure of relief to which it is found he was entitled. It would be a harsh rule that would not allow him to recover the costs of his appeal from an erroneous decree so far as relief was denied upon the claim of his patents which were good because success had not attended the whole of his contention. — *Johnson v. Foos*, 141 Fed. 73; 72 C. C. A. 105.

§ 274. Disclaimer.

Failure to make necessary disclaimer before suit bars costs. — *Silsby v. Foote*, 61 U. S. 378; 15 L. Ed. 953.

The general issue of infringement was raised by the pleadings, and the answer, in general, set up necessity of disclaimer. The proofs were made on a single claim. Under such circumstances the complainant was not debarred costs under 973 and 4922 U. S. R. S. — *Gamewell v. Municipal*, 77 Fed. 490; 23 C. C. A. 250.

Fabries Co. v. Smith, 100 U. S. 110; *Paper Bag Cases*, 105 U. S. 766; *Mills v. Green*, 159 U. S. 651.

This claim being rejected as invalid, and no disclaimer having been filed before the suit was brought, under sec. 973 R. S. the complainant is not entitled to recover costs. — *Fairbanks v. Stickney*, 123 Fed. 79; 57 C. C. A. 209.

Metallic v. Brown, 110 Fed. 665.

§ 275. Record.

Where appellee has encumbered record with some 50 immaterial patents, under Rule 10 half of the costs of the printing will be assessed upon appellee. — *B. & S. Fastener v. Kraetzer*, 150 U. S. 111; 37 L. Ed. 1019; 14 S. Ct. 48.

There was so much irrelevant matter introduced into the case as to make it inequitable that the defendant should pay costs in this court, and he should not be compelled to pay the costs in the circuit court which were caused by this class of evidence. — *Ecaubert v. Appleton*, 67 Fed. 917; 15 C. C. A. 73.

That \$20.90 paid by appellant to the commissioner of patents for copies of patents for insertion in the printed record may be taxed as costs on appeal. This is allowed. It is part of the cost of printing the record, and therefore taxable here. — *Lee v. Penberthy*, 109 Fed. 964; 48 C. C. A. 760.

§ 276. Taxation.

The costs are, perhaps, never in fact, taxed, until after the judgement is rendered; and in many cases cannot be taxed until afterward and where this is the case the amount ascertained is usually, under the direction of the court, entered *nunc pro tunc* as a part of the original judgement. And this mode of proceeding is necessary for the purposes of justice, in order to afford the necessary time to examine and decide upon the several items of costs, to which the successful party is lawfully entitled. — *Sizer v. Many*, 16 How. 98; 14 L. Ed. 861.

Costs were properly allowed, but the court is of the opinion that the complainant was not entitled to an allowance for any expenses beyond the taxable costs. — *Parks v. Booth*, 102 U. S. 96; 26 L. Ed. 54.

§ 277. Miscellaneous.

In this case we sustain the action of the court below both as to the interlocutory and final decree, and, as costs in equity and admiralty cases are within the sound discretion of the court, we do not feel inclined to disturb this decree in awarding full costs to the plaintiff. — *DuBois v. Kirk*, 158 U. S. 58; 39 L. Ed. 895; 15 S. Ct. 729.

Canter v. American, 28 U. S. 307; *Harmony v. U. S.* 43 U. S. 110, 237; *Sapphire v. Napoleon*, 85 U. S. 51; *Kittridge v. Race*, 92 U. S. 116.

Distinguishing, *Dobson v. Hartford*, 114 U. S. 442; *Dobson v. Dornan*, 118 U. S. 10.

The co-complainant licensor would undoubtedly have the right to be protected from any costs that might be adjudged against it, or incurred in the management of the suit. The court, upon proper motion, would without doubt compel this protection. The usual practice is in such cases, to require a sufficient bond of indemnity. Under such conditions there would be an implied contract on the part of the licensor to permit the use of its name by the complainant. — *Brush v. California*, 52 Fed. 945; 3 C. C. A. 368.

It would seem that the death of one or two copartner defendants after the closing of the record and before decree, does not effect the costs as they are chargeable against the surviving partners. — *Hillborn v. Hale*, 69 Fed. 958; 16 C. C. A. 569.

The statute refers to depositions taken out of court under such notice or consent as will entitle them to be filed and read as evidence upon the hearing

of the case, and does not include evidence taken either in court or before a master upon a reference. — *Kissinger-Ison v. Bradford*, 123 Fed. 91; 59 C. C. A. 221.

Troy v. Corning, 7 Blatchf. 16; *In re Strauss v. Meyer*, 22 Fed. 467; *Spill v. Celluloid*, 28 Fed. 870; *Missouri v. Texas*, 48 Fed. 775; *Ferguson v. Dent*, 46 Fed. 88.

No costs will be recovered by either party in this court or in the court below; each party having succeeded only in part. — *Cleveland v. Detroit*, 131 Fed. 853; 68 C. C. A. 233.

Appellant urges upon our consideration an alleged error of the court in overruling his motion to tax against appellees the costs occasioned by their propounding alleged improper cross-examining questions to appellant's witnesses. The motion is based on the proposition that a cross-examiner in an equity suit may not go beyond the scope of the direct examination. Even on that basis the ruling was right, because the cross-examining questions were germane to the matters in issue, which had been opened up on direct examination. — *Parsons v. New Home*, 134 Fed. 394; 67 C. C. A. 392.

Inasmuch as complainant in the court below claimed infringement of all the claims except one, and on the taking of proofs expressly declined to state on which ones it relied, and now abandons all but four of said claims, no costs will be allowed in favor of complainant on this appeal. — *Cayuta v. Kennedy*, 135 Fed. 537; 68 C. C. A. 563.

That where officers of a corporation, acting merely as such officers, are joined as defendants and the bill as against them is dismissed by the appellate court, costs of both courts will go to them, see *Western v. North*, 135 Fed. 79; 67 C. C. A. 553.

The process patent was contested and the machine patents were held to be wanting in invention. The process patent being sustained, *Held*: In such circumstances we do not feel that the statute requires this court to deny the appellant his costs in this court. This is the view taken by the Third and Seventh Circuits. — *Johnson v. Foos*, 141 Fed. 73; 72 C. C. A. 105.

Kahn v. Starrels, 136 Fed. 597; *Ide v. Trorlicht*, 115 Fed. 137.

In equity cases this court directs the imposition of costs according to the circumstances, and apportions them or denies cost altogether by no iron-clad rule. Indeed, such a rule could not be well prepared, and would more often than otherwise lead to injustice. — *Johnson v. Foos*, 141 Fed. 73; 72 C. C. A. 105.

Northern v. Snyder, 77 Fed. 818.

Inasmuch as the defendant has been defeated on the issues contested, and escapes upon a defense not pleaded, the case will be reversed, with costs to the complainant in the court below and no costs to either party in this court. *Clancy v. Troy*, 157 Fed. 554; 85 C. C. A. 314.

DAMAGES.

(See § 825)

Statutory Provisions § 278

General Statement § 279

Actual § 280

Designs § 281 (see § 328)

In Equity § 282

Increasing § 283

Interest § 284

Law Actions § 285 (see § 733)

Master's Report § 286

Measure	Speculative § 295
Absence of License or Royalty Measure § 287	Miscellaneous § 296
Complainant's Loss § 288	Proof of § 297
Deductions and Mitigations § 289	Segregation § 298
Defendant's Gains § 290	Miscellaneous Rulings § 299
Full Damages § 291	<i>See — Designs § 336; Injunction §§ 556, 565; Marking "Patented" § 776; Profits § 825; Statute of Limitations § 291</i>
License Fee § 292	
Nominal § 293	
Royalty § 294 (<i>see § 897</i>)	

§ 278. Statutory Provisions.

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 costs. — R. S. 4919.

The several courts vested with jurisdiction of causes 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 entered 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. — R. S. 4921.

* * * 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. — R. S. 4900.

The Act Feb. 4, 1887, makes this special provision for damages for the infringement of design patents:

* * * 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.

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 profits made from the infringement.

The word "circuit," above, to be read *district*. Jud. Code, Sec. 291.

§ 279. General Statement.

The terms "damages" and "profits" are used with little discrimination in many instances, and the line of demarkation is often so indistinct that separation of the two is attended with difficulty. No attempt at an extended general statement upon the subject of damages, or that of profits will be attempted. This title, therefore, should be read in connection with "Profits," §§ 825-847.

The segregation rule established in the Mop Case (111 U. S. 120) and the long line of decisions growing out of it, which rendered recovery of substantial damages or profits practically impossible in most cases, has been brought to a pause, if not changed in its course, by the decision of *Westinghouse v. Wagner*, 225 U. S. 604 (§ 845). The Mop Case rule was, and is, sound as a rule of evidence which, like any minor rule of evidence, must conform and be subject to the basic principles of evidence. The error was in regarding it as a principle rather than a rule. The Supreme Court — not abrogating it as a useful rule — declared it subject to the broad principles of *onus probandi*; and thus it becomes possible to recover substantial damages and profits in that class of cases where segregation must be made.

§ 280. Actual.

Actual damages must be actually proved, and cannot be assumed as a legal inference from any facts which amount not to actual proof of the fact. — *Seymour v. McCormick*, 16 How. 480; 14 L. Ed. 1024.

When a plaintiff is allowed to recover only "actual damages," he is bound to furnish evidence by which the jury may assess them. If he rest his case, after merely proving an infringement of his patent, he may be entitled to nominal damages, but no more. He can not call a jury to guess out his case without evidence. Actual damages must be calculated, not imagined, and an arithmetical calculation cannot be made without certain data on which to make it. — *Mayor v. Ransom*, 64 U. S. 487; 16 L. Ed. 515.

Actual damages should be actually proved, and cannot be assumed as a legal inference from facts, which afford no data by which they can be calculated. — *Mayor v. Ransom*, 64 U. S. 487; 16 L. Ed. 515.

Seymour v. McCormick, 16 How. 485.

The measure of damages to be recovered, prescribed by the act of 1870, 16 Stat. at L. 207 is "the actual damages sustained by the plaintiff." — *Philip v. Nock*, 84 U. S. 460; 21 L. Ed. 679.

If the test of a royalty cannot be applied, he will be entitled to an amount which will compensate him for the injury to which he has been subjected by the piracy. — *Philip v. Nock*, 84 U. S. 460; 21 L. Ed. 679.

§ 281. Designs.

In absence of marking notice is necessary. — *Dunlap v. Schofield*, 152 U. S. 244; 38 L. Ed. 426; 14 S. Ct. 576.

The statute of 1887 was passed in consequence of the decision of the Supreme Court in *Dobson v. Carpet Co.* 114 U. S. 439. The manifest purpose of Congress was to enlarge the remedy against infringers of design patents, and to declare that the measure of profits recoverable on account of the infringement should be considered to be the total net profits upon the whole article. A construction which should limit a recovery above \$250.00 to the

amount which the complainant could clearly establish to be the value which the design had contributed to the infringing carpets would be at variance, not only with the apparent legislative intent but with the language of the statute. The rule which Congress declared for the computation of profits was the total profit from the manufacture or sale of the article to which the design was applied, as distinguished from the pre-existing rule of the profit which could be proved to be attributable to the design. — *Untermeyer v. Freund*, 58 Fed. 205; 7 C. C. A. 183.

The liability imposed by the act of Feb. 4, 1887, is a statutory penalty in the nature of damages, and not, as has been contended, a "profit liquidated." — *Monroe v. Anderson*, 58 Fed. 398; 7 C. C. A. 272.

§ 282. In Equity.

If the appellees had sustained an injury to their legal rights the courts of law were open to them for redress, and in those courts they might have claimed not compensation merely but vengeance for such injury as they could show they had sustained. — *Livingstone v. Woodworth*, 15 How. 546; 14 L. Ed. 809.

The rule in suits in equity of ascertaining by a reference to a master the profits which the defendant has made by the use of the plaintiff's invention, stands on a different principle. It is that of converting the infringer into a trustee for the patentee as regards the profits there made; and the adjudgment of these profits is subject to all the equitable considerations which are necessary to do complete justice between the parties, many of which would be appropriate in a trial by jury. With these corrective powers in the hands of a chancellor, the rule of assuming profits as the groundwork for estimating the compensation due from the infringer to the patentee has produced results calculated to suggest distrust to its universal application even in courts of equity. — *Packet Co. v. Sickles*, 86 U. S. 611; 22 L. Ed. 203.

Damages of a compensatory character may also be allowed in equity, in certain cases where the gains and profits made by the respondent are clearly not sufficient to compensate the complainant for the injury sustained. Gains and profits are still the proper measure of damage in equity. — *Birdsall v. Coolidge*, 93 U. S. 64; 23 L. Ed. 802.

Damages of a compensatory character may be allowed to a complainant in an equity suit, when it appears that the business of the infringer was so improvidently conducted that it did not yield any substantial profits. — *Marsh v. Seymour*, 97 U. S. 348; 24 L. Ed. 963.

R. S. Sec. 4921; *Birdsall v. Coolidge*, 93 U. S. 64.

By a uniform current of decisions of this court, beginning 30 years ago, the profits allowed in equity, for the injury that a patentee has sustained by the infringement of his patent, have been considered as a measure of unliquidated damages which, as a general rule, and in the absence of special circumstances, do not bear interest until after their amount has been judicially ascertained; and the provision introduced in the Patent Act of 1870, regulating the subject of profits and damages made no mention of interest, and has not been understood to affect the rule as previously announced. — *Tilghman v. Proctor*, 125 U. S. 136; 31 L. Ed. 664; 8 S. Ct. 894.

Silby v. Foote, 61 U. S. 378; *Mowry v. Whitney*, 81 U. S. 620; *Littlefield v. Perry*, 88 U. S. 205; R. S. 4921; *Parks v. Booth*, 102 U. S. 96; *Root v. Railway*, 105 U. S. 189; *R. R. v. Turrill*, 110 U. S. 301.

We have been in doubt as to the proper disposition of the case, — whether it should be sent to a master for rehearing, or whether this court should ascertain from the record the proper amount. *Mfg. Co. v. Cowling*, 105 U. S. 253. This case has now been in the courts for eighteen years. It survived two masters, and was before a master for more than nine years. The lapse of time undoubtedly arose from a variety of circumstances, and we are not aware that it is attributable to the counsel in the case; but the delays which are incident to an accounting are well known, and we hesitate exceedingly to compel an additional expenditure of time. The manufacture of plaits in any large amount has now ceased, and it is very likely that further testimony would result only in estimates not the result of experience. We have therefore concluded to ascertain from the record a more satisfactory amount of profits, and conclude that a reasonable allowance will be the sum of \$40,000. — *Tuttle v. Claffin*, 76 Fed. 227; 22 C. C. A. 138.

§ 283. Increasing.

Damages of a compensatory character may be allowed to a complainant in equity when it appears that the business of the infringer was so improvidently conducted that it did not yield any substantial profits, as in the case before the court. — *Root v. Ry.*, 105 U. S. 189; 26 L. Ed. 975.

Marsh v. Seymour, 97 U. S. 348.

Conduct of an infringer which will warrant. — *Topliff v. Topliff*, 145 U. S. 156; 36 L. Ed. 658; 12 S. Ct. 825.

Is a matter of discretion by court and will not be disturbed on appeal unless evidence clearly demands it. — *Topliff v. Topliff*, 145 U. S. 156; 36 L. Ed. 658; 12 S. Ct. 825.

They were perfectly indifferent to the claimed rights of anyone else, and purchased infringing goods from the Dayton Company a month after the issuance of a preliminary injunction against them, and nearly one and one-half months after the date of Judge Lacombe's opinion. While the master cautiously does not find a removal of their books and papers to evade the accounting, it appears that they did not exert themselves to produce them. They were passive instruments in the hands of the real defendants, and permitted all the difficulties which the master has detailed to be interposed. The doubling of the small amount of damages which the master was able to find, was a proper exercise of the power of the circuit court. — *National v. Elsas*, 86 Fed. 917; 30 C. C. A. 487.

This case is particularly free from unusual circumstances showing a wilful purpose to violate the rights of complainants, and we are not disposed to overrule the court below in refusing to exercise this punitive power. — *Kissinger-Ison v. Bradford*, 123 Fed. 91; 59 C. C. A. 221.

A suggestion was made with respect to our ascertaining from the master's report the amounts that should be adjudged on account of these additional infringements. We think the assessment should be made by the Circuit Court. — *Murray v. Orr*, 153 Fed. 369; 82 C. C. A. 445.

That damages recoverable in equity may not be increased (notwithstanding the plain statement of the statute) see *McSherry v. Dowagiac*, 160 Fed. 948; 59 C. C. A. 26.

In increasing the damages the court below was influenced by the fact that the defendant had reason to believe that it was infringing, "as it was called upon to indemnify at least one party with whom it was dealing and from whom it secured business by a reduction of price, thus knowingly taking business from a licensee of the complainants." It also appeared that the defendant destroyed all file proofs of the use by it of the infringing process prior to the commencement of the accounting, although this was not done maliciously or for the purpose of concealment. The account presented to the master was not a frank and full statement, and defendant's infringement was continued after the commencement of suit. If the question had been presented to this court in the first instance, it is not improbable that we should have decided to treble the damages. It was, however, in the discretion of the Circuit Court to do so and we hesitate to say that the discretion has been abused. — *Fox v. Knickerbocker*, 165 Fed. 442; C. C. A.

Topliff v. Topliff, 145 U. S. 156; *Day v. Woodworth*, 13 How. 363; *Weston v. Empire*, 155 Fed. 301; *Folding Box v. Elsas*, 81 Fed. 197, *affd.* 86 Fed. 917; *Lyon v. Donaldson*, 34 Fed. 789.

Since the statute permits only an increase of the damages found, and not of profits, it follows that the complainant's motion in that regard falls to the ground. — *Yesbera v. Hardesty*, 166 Fed. 120; C. C. A.

Note: This is clearly the rule in the Sixth Circuit. I have never been able to see the logic of this rule. The statute giving courts of equity jurisdiction provides: "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." (R. S. 4921). In the first place, "such damages" in an action at law may be measured by the jury in sundry ways — in terms of losses by defendant, gains of plaintiff, royalties, etc. In the second place, the distinction between "profits" and "damages" in equity is, as one observes from reading the cases, shadowy at least. Whether the award is in terms of profits or damages, it comes to dollars and cents — a penalty on the one hand, and a recoupment on the other. The rules and distinctions in damages and profits are means to a common end, rules for reaching justice; and the plain intent of congress in providing the means for increasing the award to a plaintiff or complainant was to enable the court, *in any case where the actual finding is palpably insufficient*, to do justice, not merely to inflict a penalty; and the recoupment feature is an equitable provision which a court of equity should be most willing to enforce.

§ 284. Interest.

Interest upon profits should not be allowed as part of the damages. — *Silsby v. Foote*, 61 U. S. 378; 15 L. Ed. 953.

In our opinion the defendant should not have been charged with interest before final decree. The profits which are recoverable against an infringer of a patent are in fact in compensation for the injury the patentee has sustained from the invasion of his right. They are the measure of his damages. Though called profits they are really damages, and unliquidated until the decree is made. — *Mowry v. Whitney*, 81 U. S. 620; 20 L. Ed. 860.

The circuit court, however, in rendering its final decree, added interest to the amount found by the master to be due upon the account for profits.

In *Mowry v. Whitney*, 14 Wall. 620 it was held that interest was not allowable in such cases except under peculiar circumstances. This case does not, in our opinion, justify such an allowance. It will be for the court to determine, upon the coming in of the new report, accompanied by other evidence, whether the conduct of the defendants has been such as to subject them to liability in this particular. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

The court in its former decision (94 U. S. 695) affirmed the decrees "with costs and interest until paid at the same rate per annum that similar decrees bear in the courts of the state of Illinois." By "similar" we did not mean decrees in patent suits, for of such suits state courts have no jurisdiction. It was right for the circuit court, when our mandate went down, to order the decree affirmed to be executed by the collection of the money found to be due, and interest, which, under the established rule in the state, will be six per cent. — *Railroad v. Turrill*, 101 U. S. 836; 25 L. Ed. 1009.

Interest on the profits decreed to the complainant should not have been allowed, as was decided by this court many years ago, the better opinion being that profits in such a case can be regarded in the light of unliquidated damages, which usually do not draw interest without a special order of the court. — *Parks v. Booth*, 102 U. S. 96; 26 L. Ed. 54.

Silsby v. Foote, 20 How. 378.

In a case arising in New York State the court awarded damages with interest until paid at the same rate per annum that decrees bear in the state of New York. — *Yale v. Sargent*, 117 U. S. 536; 29 L. Ed. 954; 6 S. Ct. 934.

Delay caused by the court, or not attributable to the plaintiff, in coming to a conclusion on the master's report, where the amount found by that report is confirmed, ought not to deprive the plaintiff of interest on the amount found by the master. Under such circumstances, the account ought to be considered as liquidated on the day when the master's report is filed. — *Consolidated v. Crosby*, 141 U. S. 441; 35 L. Ed. 809; 12 S. Ct. 49.

§ 285. Law Actions.

At law the jury can award only actual damages. — *Hogg v. Emerson*, 11 How. 587; 13 L. Ed. 824.

Lowell v. Lewis, 1 Mas. 182.

Profits are not the primary or true criterion of damages for infringement in an action at law. That rule applies eminently and mainly to cases in equity, and is based upon the idea that the infringer shall be converted into a trustee, as to those profits, for the owner of the patent which he infringes; a principle which it is very difficult to apply in a trial before a jury but quite appropriate on a reference to a master, who can examine defendant's books and papers, and examine him upon oath, as well as all his clerks and employees.

No doubt, in the absence of satisfactory evidence of either class in the form to which it is most appropriate, the other may be resorted to as one of the elements on which the damages or the compensation may be ascertained; but it cannot be admitted, as the prayer which was refused implies, that in an action at law the profits which the other party might have made is the primary

or controlling measure of damages. — *Burdell v. Denig*, 92 U. S. 716; 23 L. Ed. 764.

Packet v. Sickles, 19 Wall. 617.

We have repeatedly held that sales of licenses of machines, or of a royalty established, constitute the primary and true criterion of damages in the action at law. — *Burdell v. Denig*, 92 U. S. 716; 23 L. Ed. 764.

Where the suit is at law, the measure of damages remains unchanged, the rule still being that the verdict of the jury must be for the actual damages sustained, subject to the right of the court to enter judgement for any sum above the verdict not exceeding three times that amount, with costs. — *Birdsall v. Coolidge*, 93 U. S. 64; 23 L. Ed. 302.

There is a difference between the measure of recovery in equity and that applicable in an action at law. In equity the complainant is entitled to recover such gains and profits as have been made by the infringer from the unlawful use of the invention, and, since the act of July 8, 1870, in cases where the injury sustained by the infringement is plainly greater than the aggregate of what was made by the defendant, the complainant is entitled to recover the damages he has sustained, in addition to the profits received. At law the plaintiff is entitled to recover, as damages, compensation for the pecuniary loss he has suffered from the infringement, without regard to the question whether the defendant has gained or lost by his unlawful acts — the measure of recovery in such cases being not what the defendant has gained, but what plaintiff has lost. As the case in hand is one at law, it is not necessary to pursue the subject of the extent of the equitable remedy; but reference may be had to *Tilghman v. Proctor*, 125 U. S. 137, where the cases were elaborately considered and the rule above stated was declared to be established. — *Coupe v. Royer*, 155 U. S. 565; 39 L. Ed. 263; 15 S. Ct. 199.

That in the absence of any measure of damages at law, recovery cannot be measured in terms of the defendant's profits, see *Brown v. Lanyon*, 148 Fed. 838; 78 C. C. A. 528.

Reviewing history of the statute and citing:

Seymour v. McCormick, 16 How. 480; *Suffolk v. Hayden*, 70 U. S. 315; *Mowry v. Whitney*, 81 U. S. 620; *Philip v. Nock*, 84 U. S. 460; *Packet Co. v. Sickles*, 86 U. S. 611; *Burdell v. Denig*, 92 U. S. 716; *Tilghman v. Proctor*, 125 U. S. 136; *Coupe v. Royer*, 155 U. S. 565; *Belknap v. Schild*, 161 U. S. 10; *Houston v. Stern*, 74 Fed. 636; *Seattle v. McNamara*, 81 Fed. 863; *Boston v. Allen*, 91 Fed. 248; *Boyle v. Zacharie*, 6 Pet. 647; *Scott v. Neeley*, 140 U. S. 106; *Root v. Railway*, 105 U. S. 189.

The plaintiff offered to prove the utility and advantages of his patented device, that it had been appropriated and used by a number of other railroads, and that this use, being without his consent, prevented the establishment of a market value therefor. This offer the court rejected. It will thus be seen that *Suffolk Co. v. Hayden*, has been approvingly cited and considered as authority for the principle, therein enunciated, that, in the absence of license fee or royalty, other proof can in an action at law be resorted to, to show the damage done to the owner of the patent. The law thus announced in conclusion of the case before us, unless *Suffolk v. Hayden* was over-

ruled in *Coupe v. Royer*, 155 U. S. 567. Holding, then as we do, that *Suffolk v. Hayden* is unreversed and unqualified by *Coupe v. Royer*, it follows the court below erred. — *McCune v. Baltimore*, 154 Fed. 63; 83 C. C. A. 175.

Suffolk v. Hayden, 70 U. S. 318, *Birdsall v. Coolidge*, 93 U. S. 69; *Root v. Railway*, 105 U. S. 198; *Tilghman v. Proctor*, 125 U. S. 143; *Coupe v. Royer*, 155 U. S. 567.

The complaint (at law) concluded with a prayer or petition for judgment against the defendant in the sum of \$50,000. During the trial plaintiff sought to raise an issue respecting royalties, which was cut off by the court. Damages were assessed at \$1. Plaintiff then petitioned for an accounting of profits. *Held*: Relief can be administered in lawsuits only in accordance with the facts set out in the pleading, regardless of the prayer. As the profits are based upon the existence of established royalties, involving matters of accounting cognizable in equity, the bill should be framed accordingly, containing the essential averments authorizing an inquiry for the ascertainment of profits. There are no facts alleged in the petition as a basis for the ascertainment of profits. — *Portland v. Hermann*, 160 Fed. 91.

Brown v. Lanyon, 148 Fed. 838.

Note: It would seem as if this decision might fitly conclude the practice that has so curiously prevailed in the Ninth Circuit of bringing actions for infringement on the wrong side of the court.

§ 286. Master's Report.

The master acted in view of this evidence, and the court below concurred in his finding, except in some unimportant particulars. As no obvious error or mistake has been pointed out to us, their conclusions must be permitted to stand. — *Warren v. Keep*, 155 U. S. 265; 39 L. Ed. 144; 15 S. Ct. 83.

Tilghman v. Proctor, 125 U. S. 136.

The testimony on the reference was directed to both lines for recovery, namely profits on the one and damages on the other; and that the master followed this scheme, not for the purpose of duplicating the damages but because the complainant might be able to succeed on one line, even if he should fail on the other. The master's report shows that, though he was impressed that the proof was sufficient to make out a case for damages, he thought it expedient to report his conclusions upon the proof offered in support of the claim for profits, to the end that the court should have the data for a decree upon the adoption of either basis as the court should deem proper. We think the course pursued by the master was well advised, and conducive to a proper result. — *Mast v. Superior*, 154 Fed. 45; 83 C. C. A. 157.

The court abruptly departed from the orderly course of procedure. (The master found \$29,000 damages and the circuit judge arbitrarily reduced the amount to \$18,000.) The decree did not rest upon any finding of the master, notwithstanding the court overruled all exceptions to it. Nor is it supported by any evidence found in the record. It was for an arbitrary sum quite distinct from either of the results which the evidence had any tendency to prove, and the court was not at liberty to pronounce a decree at discretion. — *Mast v. Superior*, 154 Fed. 45; 83 C. C. A. 157.

N. Y. v. Ransom, 23 How. 487; *Philip v. Nock*, 17 Wall. 460.

§ 287. Measure — Absence of License or Royalty Measure.

This question of damage, under the rule given in the statute, is always attended with difficulty and embarrassment, both to the court and jury. There being no established patent or license fee in the case, in order to get at a fair measure of damages, or even an approximation to it, general evidence must necessarily be resorted to. And what evidence could be more appropriate and pertinent than that of the utility and advantage of the invention over the old modes or devices that had been used for working out similar results? With a knowledge of these benefits to the persons who have used the invention and the extent of the use by the infringer, a jury will be in possession of material and controlling facts that may enable them in the exercise of a sound judgment, to ascertain the damages, or, in other words, the loss to the patentee or owner, by the piracy instead of the purchase of the use of the invention. — *Suffolk v. Hayden*, 70 U. S. 315; 18 L. Ed. 76.

In cases where there is no established license fee in the case, or even an approximation to it, general evidence must necessarily be resorted to. — *Packet Co. v. Sickles*, 86 U. S. 611; 22 L. Ed. 203.

Suffolk v. Hayden, 3 Wall. 315.

In this case when the patentee granted no licenses and had no established license fee, but supplied the demand himself and was able to supply the demand, the master was unable to determine from the proofs what profits the defendant had made. He confined his award to the enforced reduction of price caused by the infringement. That this is a proper item of damages, if proved, is clear. — *Yale v. Sargent*, 117 U. S. 536; 29 L. Ed. 954; 6 S. Ct. 934.

McComb v. Brodie, 1 Woods, 153; *Philip v. Nock*, 17 Wall. 460.

This is an action at law for the damages sustained by the plaintiffs for the alleged infringement, and in such actions where there has been proved an established royalty or license fee, which has been customarily paid to the owner of the patent by those who desired to use it, such regular price for a license is its primary and true criterion of the plaintiff's damage; but in this case, there is no evidence of any license fee ever having been demanded or paid by anyone; and so, if you find in favor of the plaintiffs, you should consider the utility and advantage to the defendant of the use of the patented device, as compared to any other means of obtaining similar results which were open to the defendant to use; and you may consider the cost of using one as compared with the cost and savings to the defendant of using the other; and from these data, if proven to you, you should ascertain, in the exercise of a sound judgment, what would be a fair compensation to the plaintiffs for the damage which they have sustained by reason of the defendant having infringed, instead of having purchased the right to use, the invention. — *Brickill v. Mayor*, 60 Fed. 98; 8 C. C. A. 500.

Suffolk v. Hayden, 3 Wall. 320; *Sessions v. Romadka*, 145 U. S. 29.

If there had been an established royalty, the jury could have taken that sum as the measure of damages. In the absence of such royalty, and in the absence of proof of lost sales or injury by competition, the only measure of damages was such sum as, under all the circumstances, would have been a reasonable royalty for the defendant to have paid. This amount it was the province of the jury to determine. In so doing, they did not make a contract for the parties, but found a measure of damages. — *Hunt v. Cassidy*, 64 Fed. 585; 12 C. C. A. 316.

McKeever v. U. S. 14 Ct. Cl. 414; *Ross v. Railway*, 45 Fed. 371; *Royer v. Coupe*, 29 Fed. 371; *Cary v. Mfg. Co.* 37 Fed. 654.

That where there is no royalty basis, where the plaintiff can show no actual damage, and no market price can be established, the plaintiff, under *Coupe v. Royer*, 155 U. S. 565, can recover nominal damages only, see *Seattle v. McNamara*, 81 Fed. 863; 26 C. C. A. 652.

§ 288. Measure — Complainant's Loss.

Reduction of prices and consequent loss of profits, enforced by infringing competition, is a proper ground for award of damages. The only question is as to the character and sufficiency of the evidence in the particular case. — *Yale v. Sargent*, 117 U. S. 536; 29 L. Ed. 954; 6 S. Ct. 934.

Where the patentee grants no licenses, and has no established license fee, but supplied the demand himself, and was able to do so, an enforced reduction of price is a proper item of damages, if proven by satisfactory evidence. — *Boesch v. Gräff*, 133 U. S. 697; 33 L. Ed. 787; 10 S. Ct. 378.

Yale v. Sargent, 117 U. S. 536.

While the loss due to an infringing device reducing the market price of complainant's manufacture is a proper element of damages, the evidence must show that the reduction in price was due to the sale of the infringing devices and not to other causes. — *Boesch v. Gräff*, 133 U. S. 697; 33 L. Ed. 787; 10 S. Ct. 378.

Cornley v. Marckwold, 131 U. S. 159; *N. Y. v. Ransom*, 64 U. S. 487; *Rude v. Westcott*, 130 U. S. 152.

It is reasonable to conclude that, if the appellees had not deliberately and wantonly become infringers, and wrongfully trespassed on appellant's patent rights, they would have purchased from appellant the rods they used. Moreover, the law is that in cases of wanton infringement, every doubt is to be resolved against the infringer. These facts unite to afford substantial, not mere conjectural, grounds on which to base the conclusion, that the appellant, by appellees' wrongful act, lost the sale of these particular rods, and to that extent assuredly was damaged. The facts we have stated being in evidence, the master was fully justified in finding, as we do, and especially so in the absence of all counterproof by the appellees, that the appellant, by the appellees' wrongful impairment of his sales, was damaged to the extent of the difference between the cost price and the selling price established as between these parties, and interest from the date of the filing of the master's report. — *Rose v. Hirsch*, 94 Fed. 177; 36 C. C. A. 132.

Rubber Co. v. Goodyear, 9 Wall. 803; *Creamer v. Bowers*, 35 Fed. 209; *Covert v. Sargent*, 38 Fed. 237; *Tilghman v. Proctor*, 125 U. S. 161.

It is undoubted that the wrongdoer compelled the complainant to reduce its prices, but the complainant even then probably made a profit and it sold more machines on account of the reduced price. What, on the whole, it lost does not appear. It was within the power of the complainant to illustrate to what extent its whole profit fell off by reason of the competition. It did not do so, and the court is unable to know to what extent it was finally injured by the competition. Therefore, no damages growing out of this unlawful competition can be allowed. (Opinion of court below quoted and approved.) — *Force v. Sawyer-Boss*, 143 Fed. 894; 75 C. C. A. 102.

§ 289. Measure — Deductions and Mitigations.

The intent not to injure never exonerates from all damages, though it may mitigate them. — *Hogg v. Emerson*, 11 How. 587; 13 L. Ed. 824.

Whittemore v. Cutter, 1 Gall. 429; *Jones v. Pearce*, Web. P. C. 125; *Bryce v. Dorr*, 3 McLean, 583; *Lowell v. Lewis*, 1 Mas. 182.

Such general expenses as store rent, clerk hire, fuel, gas, portorage, etc. are to be deducted proportionally upon the profits of the attachment. — *Tremain v. Hitchcock*, 90 U. S. 518; 23 L. Ed. 97.

A receipt given after suit was commenced may be given in evidence to reduce damages without setting it up in the pleadings by amendment. — *Burdell v. Denig*, 92 U. S. 716; 23 L. Ed. 764.

The judge of the circuit court was of opinion that the facts in this case took it out of the general rule that the pecuniary advantage which the infringers derived from the unauthorized use of the patent is to be estimated upon the entire production of the infringers, because, in his opinion, the evidence showed that the defendants never would have resorted to the hand method, because it was so expensive as to be prohibitory, and because it was impossible to make marketable plaits by hand. There may be and probably will be, cases in which an inadvertent infringer of an old and unknown patent for the method of manufacturing an article which is made and sold by the million at a cheap rate, and which is expensively made by hand, like the article of paper bags, suggested by Judge Coxe, will have a persuasive equity against a decree for his entire profits, upon the ground that the owner of the patent suffered no damage, and that the paper-bag business was created by automatic machinery, and never would have existed if the bags must be made by hand. — *Tuttle v. Claflin*, 76 Fed. 227; 22 C. C. A. 138.

Before final hearing the courts referred the case back to "take proof as to the entire or partial abandonment by complainant of the disk furrow opener covered by the patent, and the substitution therefor of another and different type of device for the same purpose." The master reported that he was unable to discover how the later improvement should affect the consequences of the infringement from 1898 to 1902 and adhered to his former report. It is manifest that his conclusion upon the matter referred back to him was correct. — *Mast v. Superior*, 154 Fed. 45; 83 C. C. A. 157.

§ 290. Measure — Defendant's Gains.

It must be apparent to the most superficial observer of the immense variety of patents issued every day, that there cannot, in the nature of things, be any one rule of damages which will equally apply to all cases. The mode of ascertaining actual damages must necessarily depend upon the peculiar nature of the monopoly granted. A man who invents or discovers a new composition of matter such as vulcanized India rubber, or a valuable medicine, may find his profit to consist in a close monopoly, forbidding anyone to compete with him in the market, the patentee being himself able to supply the whole demand at his own price. If he should grant licenses to all who might desire to manufacture his composition, mutual competition might destroy the value of such license. This may be the case also where the patentee is the inventor of an entire new machine. If any person could use the invention or discovery by paying what a jury might suppose to be a fair value of a license, it is plain that competition would destroy the whole value of the monopoly. In such cases the profit of the infringer may be the only criterion of the actual damages of the patentee. — *Seymour v. McCormick*, 16 How. 480; 14 L. Ed. 1024.

It is only where, from the peculiar circumstances of the case, no other rule can be found, that the defendant's profits become the criterion of the plaintiff's loss. — *Seymour v. McCormick*, 16 How. 480; 14 L. Ed. 1024.

The master reported as damages the entire profits of defendant on car-wheels made under plaintiff's process. As it appeared that car-wheels could be made and sold at a profit without employing plaintiff's process it was held that the damages were the savings or gains due to said process over what the profits of defendant otherwise would have been. — *Mowry v. Whitney*, 81 U. S. 620; 20 L. Ed. 860.

The same principle, therefore, which gives to the complainants the aggregate profits of the entire manufacture would give the same profits to a patentee of the process of chilling, if there were one, and as there are many processes in the manufacture, for each of which it is conceivable there might be a patent and as every one of the processes is necessary to make a marketable wheel, an infringer might be mulcted in several times the profits he had made from the whole manufacture. We cannot assent to such a rule. The question to be determined in this case is: what advantage did the defendant derive from using the complainant's invention over what he had in using the processes then open to the public and adequate to enable him to obtain an equally beneficial result? The fruits of that advantage are his profits. — *Mowry v. Whitney*, 81 U. S. 620; 20 L. Ed. 860.

In arriving at their conclusion, the profit made by the defendant and that lost by the plaintiff, are among the elements which the jury may consider. — *Philip v. Nock*, 84 U. S. 460; 21 L. Ed. 679.

The decree (covering all gains and profits from selling articles containing the patented improvement) is as we think too broad. In *Mowry v. Whitney*, 14 Wall. 620, it was held "What advantage did the defendant derive from using the complainant's invention over what he had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result? The fruits of that advantage are his profits." For such profits he is compelled to account as damages. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

Profits actually realized are usually, in a case like this, the measure of unliquidated damage. Circumstances may, however, arise which would justify the addition of interest in order to give complete indemnity for losses sustained by wilful infringements. — *Littlefield v. Perry*, 88 U. S. 205; 22 L. Ed. 577.

Manifestly the complainants are not entitled to the savings or profits resulting from the defendant's own invention. — *Mason v. Graham*, 90 U. S. 261; 23 L. Ed. 86.

In cases where profits are the proper measure, it is the profits which the infringer makes, or ought to make, which govern, and not the profits which plaintiff can show that he might have made. — *Burdell v. Denig*, 92 U. S. 716; 23 L. Ed. 764.

Assuming that the use of the machine was not true economy. They had the choice of repairing them on the common anvil or on the complainant's machine. By selecting the latter, they saved a large part of what they must have expended in the use of the former. They gained, therefore, to the extent that they saved themselves from loss. — *Railroad v. Turrill*, 94 U. S. 695; 24 L. Ed. 238.

We think the weight of evidence leads to the conclusion that the number of feet mended on the infringing machines, the gain in mending compared with

the cost of mending on the common anvil, considering the saving of labor and fuel were such as justified the decrees that were made. — *Railroad v. Turrill*, 94 U. S. 695; 24 L. Ed. 238.

A limited locality required a particular kind of a pump to be used only in that locality for a special purpose. The market was not only limited to a particular locality but it was unusually limited in demand. A single manufacturer, possessing the facilities the appellant had could easily and with reasonable promptness fill every order that was made. There was no other pump that could successfully compete with that controlled by the patent. Under these circumstances it is easy to see that what had been the appellee's gain in this business must necessarily have been the appellant's loss and, consequently, the appellant's damages are to be measured by the appellee's profits derived from their business in that special and limited market. — *Goulds v. Cowing*, 105 U. S. 253; 26 L. Ed. 987.

The question to be determined is, what advantage did the defendant derive from using the complainant's invention over what he had in using other processes then open to the public and adequate to enable him to obtain an equally beneficial result. The fruits of that advantage are his profits. Quoting *Mowry v. Whitney*, 14 Wall. 620. — *Goulds v. Cowing*, 105 U. S. 253; 26 L. Ed. 987.

There was no market for pumps adapted to this particular use, except in the oil producing regions of Pennsylvania and Canada. The demand was limited as well as local. Less than a thousand pumps actually supplied all who wanted them. But for that particular use no other pump could at the time be sold. If the appellant kept the control of its monopoly under the patent, it alone had the advantage of the market. Unless the appellees got the improved pump, they could not become competitors in the field, and just to the extent they got into the field they drove the appellant out. Through their infringement they got the advantage of selling the pumps that had upon them the patented improvement. Without it no such sales would have been effected. The fruits of the advantage they gained by their infringement were, therefore, necessarily the profits they made on the entire sale. — *Goulds v. Cowing*, 105 U. S. 253; 26 L. Ed. 987.

It may be added that where no profits are shown to have accrued a court of equity cannot give a decree for profits by way of damages or as punishment for the infringement. — *Root v. Ry.*, 105 U. S. 189; 26 L. Ed. 975.

Livingston v. Woodworth, 15 How. 559.

No profits having been made by the defendant, in the absence of any evidence as to the value imparted by the patented design it was error to allow as damages upon the number of yards of goods made by the defendant the sum per yard which was the profit of the plaintiff in making and selling goods with the patented design. — *Dobson v. Dornan*, 118 U. S. 10; 30 L. Ed. 63; 6 S. Ct. 946.

Dobson v. Hartford, 114 U. S. 439.

Exception is taken to the form of the interlocutory decree, in that, while it awards a recovery for the profits and damages from the infringement of the design, it orders an account to be taken of the profits of the defendants from infringing upon the exclusive rights of the plaintiffs "by the manufacture, use and sale of carpeting bearing said patented design," and of the additional damages suffered by the plaintiffs "by reason of said infringements." We do not think the decree is open to the objection made. It is not like the

decree in *Littlefield v. Perry*, 88 U. S. 228. It directs an account of the profits from the infringement. The infringement could be committed only by making, using, and selling carpets containing the patented design; but the profits and damages to be accounted for are described as only those from the infringement. — *Dobson v. Dornan*, 118 U. S. 10; 30 L. Ed. 63; 6 S. Ct. 946.

Where defendant's entire profits were derived from the infringement his profits are plaintiff's damages. — *Hurlbut v. Schillinger*, 130 U. S. 456; 32 L. Ed. 1011; 9 S. Ct. 584.

Elizabeth v. Nicholson, 97 U. S. 126; *Root v. Railway*, 105 U. S. 189; *Callaghan v. Myers*, 128 U. S. 617; *Garretson v. Clark*, 111 U. S. 120.

This court has repeatedly held that in estimating damages in the absence of a royalty, it is proper to consider the savings of the defendant in the use of the patented device over what was known and in general use for the same purpose anterior to the date of the patent. — *Sessions v. Romadka*, 145 U. S. 29; 36 L. Ed. 609; 12 S. Ct. 799.

Mowry v. Whitney, 81 U. S. 620; *Cawood Pat.* 94 U. S. 695; *Tilghman v. Proctor*, 125 U. S. 136; *Williams v. Rome*, 18 Blatchf. 181.

If the infringing machine or device derived the entire commercial value from the patented feature or improvement, complainant would be entitled to defendant's entire profits. — *Mosher v. Joyce*, 51 Fed. 441; 2 C. C. A. 322.

Mfg. Co. v. Cowing, 105 U. S. 253; *Root v. Railway*, 105 U. S. 189; *Hurlbut v. Schillinger*, 130 U. S. 456; *Crosby v. Consolidated*, 141 U. S. 454.

Upon the foregoing facts, the question of the rule of law in regard to the method of ascertaining the profits was not a debatable one. If the defendants had made no addition to the Crosby and Kellogg invention, it being one of an original and primary character, they took it as it was, although they furnished their machine with mechanical equivalents which might produce better work than the corresponding devices for which they were substituted, and the complainants would be entitled to the pecuniary advantage which the infringers derived from their unauthorized use of the patent, the profit being in this case the difference between the expense of plaiting by the use of the patented device and the expense of doing the same thing by hand. — *Tuttle v. Claffin*, 76 Fed. 227; 22 C. C. A. 138.

Mowry v. Whitney, 14 Wall. 620; *Cawood Pat.* 94 U. S. 695; *Thomson v. Wooster*, 114 U. S. 104; *Sessions v. Romadka*, 145 U. S. 29.

When the infringer uses in his infringing machine the essential part of the patented machine, without which his infringing machine is worthless, it is not an adequate answer to the demand for the payment of his entire profits that his substituted equivalents improved the work of the corresponding elements of the infringed machine. — *Tuttle v. Claffin*, 76 Fed. 227; 22 C. C. A. 138.

§ 291. Measure — Full Damages.

It is the making and selling to be used, and not the selling or buying or making alone for which full damages are usually given. — *Hogg v. Emerson*, 11 How. 587; 13 L. Ed. 824.

10 Wheat. 350; *Curt. Pat.* 256 n. 3; 3 McLean. 427.

When the entire profit of a business or undertaking results from the use of the invention, the patentee will be entitled to recover the entire profits, if

he elects that remedy. And in such a case, the defendant will not be allowed to diminish the show of profits by putting in unconscionable claims for personal services or other inequitable deductions. — *Root v. Ry.*, 105 U. S. 189; 26 L. Ed. 975.

Rubber Co. v. Goodyear, 76 U. S. 788.

§ 292. Measure — License Fee.

When an inventor finds it profitable to exercise his monopoly by selling licenses to make or use his improvement, he has himself fixed the average of his actual damage, when his invention has been used without his license. If he claims anything above that amount he is bound to substantiate his claim by clear and distinct evidence. When he has himself established the market value of his improvement as separate and distinct from the other machinery with which it is connected, he can have no claim in justice or equity to make the profits of the whole machine the measure of his demand. — *Seymour v. McCormick*, 16 How. 480; 14 L. Ed. 1024.

The defendants in various forms prayed the court to instruct the jury that the measure of damages was the established rate for the license to use their invention, as ascertained by the sales made by plaintiffs of such license to others. If this was the true rule of estimating the damages, the bill of exceptions shows that a sufficient number of such licenses, and the prices at which they were granted, was in evidence to enable the jury to apply the principle to the case before them.

As we are of opinion that this was the sound rule, and that in refusing the prayers for instruction based on it, as well as in admitting evidence of the saving of fuel and its value as affecting the amount of the verdict, the court below was in error.

On that subject in the case of *Seymour v. McCormick*, 16 How. 480, this court on full consideration, and without dissent, laid down the proposition that in suits at law for infringement of patents, where the sale of licenses by the patentee had been sufficient to establish a price for such licenses, that price should be taken as his measure of damages against the infringer. The rule thus declared has remained the established criterion of damages in cases to which it was applicable ever since. *Sickles v. Borden*, 4 Blatchf. 14; *Suffolk v. Hayden*, 3 Wall. 315; *Livingstone v. Jones*, 3 Wall. Jr. 330.

Certainly any unnecessary relaxation of the rule we have laid down in cases at law, where the patentee has been in the habit of selling his invention or license to use it, so that a fair deduction can be made as to the value which he and those using it have established for it, does not commend itself to our judgement, nor is it encouraged by our experience.

If such be the proper rule in case of the infringer who uses the invention without license and against the consent of the owner, it should not be harsher against the party who uses it with consent of the owner, express or implied, but without any agreement as to the rate of compensation. In such case nothing can be more reasonable than that the price fixed by the patentee for the use of his invention, in his dealings with others, and submitted to by them before using it, should govern. — *Packet Co. v. Sickles*, 86 U. S. 611; 22 L. Ed. 203.

It is obvious that there cannot be any one rule of damages prescribed which will apply in all cases, even where it is conceded that the finding must be limited to actual damages. Frequent cases arise where proof of an established royalty furnishes a pretty safe guide both for the instructions of the court and the finding of the jury. Reported cases of undoubted authority may be referred to which support that proposition; and yet it is believed to

be good law that the rule cannot be applied without qualification, where the patented improvement has been used only to a limited extent and for a short time, that in such a case the jury should find less than the amount of the license fee; and it is admitted in several cases that the circumstances may be such that the finding should be larger than the royalty. — *Birdsall v. Coolidge*, 93 U. S. 64: 23 L. Ed. 802.

Seymour v. McCormick, 16 How. 490; *Livingston v. Woodworth*, 15 How. 560; *Dean v. Mason*, 20 How. 203; *Curtis Pat.* 459.

The inventor may indeed prohibit the use, or exact a license fee for it, and if such license fee has been generally paid, its amount may be taken as a criterion of damages to him when his rights are infringed. In the absence of such criterion, the damages must necessarily be nominal. — *Black v. Thorne*, 111 U. S. 122; 28 L. Ed. 372; 4 S. Ct. 326.

Established license fees are the best measure of damages that can be used. There may be damages beyond this, such as the expense and trouble the plaintiff has been put to by the defendant, and any special inconvenience he has suffered from the wrongful acts of the defendant; but these are more properly the subject of allowance by the court under the authority given to it to increase the damages. — *Clark v. Wooster*, 119 U. S. 322; 30 L. Ed. 392; 7 S. Ct. 217.

In an action at law for the infringement of a patent, the plaintiff can recover a verdict for only the actual damages which he has sustained; and the amount of such royalties or license fees as he has been accustomed to receive from third persons for the use of the invention, with interest thereon from the time when they should have been paid by the defendants, is generally, though not always, taken as the measure of his damages; but the court may, whenever the circumstances of the case appear to require it, inflict vindictive or punitive damages by rendering judgement for not more than thrice the amount of the verdict. — *Tilghman v. Proctor*, 125 U. S. 136; 31 L. Ed. 664; 8 S. Ct. 894.

Seymour v. McCormick, 57 U. S. 480; *N. Y. v. Ransom*, 64 U. S. 487; *Suffolk v. Hayden*, 70 U. S. 315; *Philip v. Nock*, 84 U. S. 460; *Packet Co. v. Sickles*, 86 U. S. 611; *Burdell v. Denig*, 92 U. S. 716.

It is clear that the payment of any sum in settlement of a claim for an alleged infringement cannot be taken as a standard to measure the value of the improvements patented, in determining the damages sustained by the owners of the patent in other cases of infringement. Many considerations other than the value of the improvements may induce the payment in such cases. The avoidance of the risk and expense of litigation will always be a potential motive for settlement. It is undoubtedly true that when there has been such a number of sales by a patentee of licenses to make, use and sell his patents, as to establish a regular price for a license that price may be taken as a measure of damages against infringers. That rule was established in *Seymour v. McCormick*, 57 U. S. 480; *N. Y. v. Ransom*, 64 U. S. 487; *Packet v. Sickles*, 86 U. S. 611; *Birdsall v. Coolidge*, 93 U. S. 64; *Root v. Railway*, 105 U. S. 189. Sales of licenses made at periods years apart, will not establish any rule on the subject and determine the value of the patent. Like sales of ordinary goods, they must be common, that is, of frequent occurrence, to establish such a market price for the article that it may be assumed to express, with reference to all similar articles, their salable value at the place designated. In order that a royalty may be accepted as a measure of damages against an infringer, who is a stranger to the license establishing it, it must be paid or secured before the infringement complained of; it must

be paid by such a number of persons as to indicate a general acquiescence in its reasonableness by those who have occasion to use the invention; and it must be uniform at the places where the licenses are issued. — *Rude v. Westcott*, 130 U. S. 152; 32 L. Ed. 888; 9 S. Ct. 463.

A license fee, when established and agreed to by the public, is only a measure of estimating the market value of a patented machine or device of which the patentee has been deprived by infringement. — *Hunt v. Cassidy*, 53 Fed. 257; 3 C. C. A. 525.

Seymour v. McCormick, 16 How. 480; *Packet Co. v. Sickles*, 19 Wall. 617; *Rude v. Westcott*, 130 U. S. 152.

The proof of a license fee for two improvements is not competent to show the damages sustained by an infringement of one of these improvements. And suit having been brought on only one patent and no proof having been offered to apportion or segregate the profits due to each, nominal damages only can be recovered. — *Hunt v. Cassidy*, 53 Fed. 257; 3 C. C. A. 525.

Philip v. Nock, 17 Wall. 460; *Seymour v. McCormick*, 16 How. 480.

It appears from the evidence that at the time of infringement, there was an established license fee for the use of the apparatus such as that employed by the defendant, and that it amounted on the proper basis of computation, to \$687.50. This sum with interest is the measure of damages which the complainants are entitled to recover. — *McNeely v. Williames*, 96 Fed. 978; 37 C. C. A. 641.

The proof of damages consisted of licenses granted to a large proportion of the leading manufacturers on which royalties substantially uniform were agreed to be paid, and it was upon the basis of such royalties that the master reckoned the damages. These licenses were made after this suit was begun and while it was pending contemporaneously with the running of these licenses and the pending of this suit, the defendant was continuing the infringement. The licenses recited the pending of the litigation over the patent, and stipulated that, if it should be adjudged invalid, the royalties should cease or be remitted. The licensees were all substantial parties. In the present case, so far as we can see there is no room for suspecting collusion. Nor can we perceive any reason why the evidence in such a case should be hedged about with suspicions and artificial limitations not felt or imposed in dealing with business transactions generally. — *Mast v. Superior*, 154 Fed. 45; 83 C. C. A. 157.

§ 293. Measure — Nominal.

It does not always follow that because a party may have made an improvement in a machine and obtained a patent for it, another using the improvement and infringing upon the patentee's rights will be mulcted in more than nominal damages for the infringement. If other methods in common use produce the same results, with equal facility and cost, the use of the patented invention cannot add to the gains of the infringer, or impair the just rewards of the inventor. — *Black v. Thorne*, 111 U. S. 122; 28 L. Ed. 372; 4 S. Ct. 326.

Where plaintiff claims profits of defendant where infringement does not cover entire machine only nominal damages can be had in absence of segregation. — *Keystone v. Adams*, 151 U. S. 139; 38 L. Ed. 103; 14 S. Ct. 295.

The court below charged the jury as follows: "Your verdict in this case can be only for the damages which he (the plaintiff) has sustained by the

alleged use of his patent by the defendant during the six years prior to the date of his writ. There being no evidence that the patent was of any value to him during this time or that the use of it by the defendant during the 6 years was any injury to him, or that he paid anything for the patent, you can find only nominal damages, if any, in this case." Under these circumstances, the court should have expressly directed the jury that it should not return a verdict for more than nominal damages. — *Boston v. Allen*, 91 Fed. 248; 33 C. C. A. 485.

Suffolk v. Hayden, 3 Wall. 315; *Coupe v. Royer*, 155 U. S. 565 (overruling *Suffolk v. Hayden*); *Black v. Thorn*, 111 U. S. 122; *Seattle v. McNamara*, 81 Fed. 863.

§ 294. Measure — Royalty.

Where the plaintiff has sought his profit in the form of a royalty paid by his licensees, and there are no peculiar circumstances in the case, the amount to be recovered will be regulated by that standard. — *Philip v. Nock*, 84 U. S. 460; 21 L. Ed. 679.

Evidence of an established royalty will undoubtedly furnish the true measure of damages in an action at law when the wilful acts consist in making and selling the patented improvement, or in the extensive and protracted use of the same, without palliation or excuse; but when the use is a limited one and for a brief period it is error to apply the rule arbitrarily and without any qualification. — *Birdsall v. Coolidge*, 93 U. S. 64; 23 L. Ed. 802.

Packet v. Sickles, 19 Wall. 617; *Burdell v. Denig*, 92 U. S. 716; *Suffolk v. Hayden*, 3 Wall. 320.

Where damages cannot be assessed upon the basis of a royalty, nor on that of lost sales, nor on that of hurtful competition, the proper method of assessing them is to ascertain what would have been a reasonable royalty. — *Hunt v. Cassidy*, 64 Fed. 585; 3 C. C. A. 525.

Quoting Rob. Pat. Sec. 563.

(The application of the rule in this case seems to me wholly beyond the rule. The only direct testimony of the royalty value was the opinion of the plaintiff. If this is not allowing a plaintiff to assess his own damages under cover of another name, then it would be hard to tell what would be.)

In the instant case, although three sales were sworn to, the price in only two is given, and one of these was a sale made before the reissue of the patent. All were more than ten years before the infringement alleged in this case, and, during these ten years, although the appliance was on the market not a single sale or license fee is shown. It cannot be seriously contended that the sales referred to establish the market value of the patent. From this state of the case, it is clear that the court erred in refusing to charge the jury to find nominal damages only. — *Houston v. Stern*, 74 Fed. 636; 20 C. C. A. 636.

Coupe v. Royer, 155 U. S. 565; *Rude v. Westcott*, 130 U. S. 152.

§ 295. Measure — Speculative.

In the present case, the master found that the plaintiffs' profit on their carpets was a certain percentage, and assumed or presumed that the defendants' carpets, which were far inferior in quality as well as in market value, displaced those of plaintiffs to the extent of the sales by the defendants, and held that the entire profit which the plaintiffs would have received, at such percentage, from the sale of an equal quantity of their own carpets of the same pattern, was the proper measure of their damages. The defendants' carpets were so inferior in quality that they sold them at a much less price

than the plaintiffs got for their carpets, and even at those prices the defendants made no profits. Under these circumstances there can be no presumption that the plaintiffs would have sold their better quality of carpets in place of the defendants' poorer quality, if the latter had not existed, or that the pattern would have induced the purchasers from the defendants to give to the plaintiffs the higher price. On the contrary, the presumption is at least equal that the cheaper price, and not the pattern, sold the defendants' carpets. There was no satisfactory testimony that those who bought the cheap carpets from the defendants would have bought the higher priced goods from the plaintiffs, or that the design added anything to the defendants' price or promoted their sale of the particular carpets; and none to show what part of the defendants' price was to be attributed to the design. — *Dobson v. Dornan*, 118 U. S. 10; 30 L. Ed. 63; 6 S. Ct. 946.

Opinions not founded on knowledge are of no value. Conclusions from such opinions are at best mere guesses. By the decision rendered a settled rule of law was violated, that actual, not speculative damages must be shown, and by clear and definite proof, to warrant a recovery for the infringement of a patent. As was said long ago by this court; actual damages must be calculated, not imagined; and an arithmetical calculation cannot be made without certain data on which to make it. — *Rude v. Westcott*, 130 U. S. 152; 32 L. Ed. 888; 9 S. Ct. 463.

N. Y. v. Ransom, 64 U. S. 487.

In view of this record, it might be possible to make some vague guess, as many of the witnesses have, as to how much faster some one appliance would work than another, under favorable circumstances; but there seems to be absolutely no proof which would warrant the court in finding that by the use of the infringing nets, defendant saved any specific number of hours out of the time it would have taken to do the work with one or other of the cargo-hoisting appliances available to defendant. The testimony falls far short of the reliable and tangible proof which is required to establish profits. — *Hohorst v. Hamburg-American*, 91 Fed. 655; 34 C. C. A. 39.

The parties agreed upon a guess as to the number of machines made and sold and on this guess the amount of damages was estimated. If the Supreme Court had not found plenty of reasons for reversing this decision upon other grounds (192 U. S. 265) there is little question but that it would have been reversed on the question of damages. — *Singer v. Cramer*, 109 Fed. 652; 48 C. C. A. 588. Reversed, 192 U. S. 265.

Counsel for the defendant says, "the law requires that the two things to be compared must be adequate to produce an equally beneficial result." This proposition seems to have been borrowed from cases where the circumstances were such as to make such a comparison possible. It has no application to a case like this. There was no such thing to compare with and the rule above stated, to be applicable to such a case as this, must be modified to suit the different circumstances. — *Mast v. Superior*, 154 Fed. 45; 83 C. C. A. 157.

Suffolk v. Hayden, 3 Wall. 315; *Cawood Pat.* 94 U. S. 695; *Sessions v. Romadka*, 145 U. S. 29.

§ 296. Measure — Miscellaneous.

These sales (of the attachment alone) furnish a much better measure of profits than a ratable proportion on the entire machine. It may fairly be presumed from them that the profits on the sale of the machine, with the improvement attached, were increased by the infringing device quite as much as was the profit on the improvement sold separately. It does not

appear at what profit, if any, the machines could have been sold without the improvement. — *Mason v. Graham*, 90 U. S. 261; 23 L. Ed. 86.

As the infringement of a combination is in the use of the combination and not its elements, so profits or damages for such infringement depend upon the combination and not the elements. — *Elizabeth v. American*, 97 U. S. 126; 24 L. Ed. 1000.

For history of doctrine of damages, see *Root v. Ry.*, 105 U. S. 189; 26 L. Ed. 975.

If made by such infringement they can hardly be set up against the complainant to reduce the amount of profits made by the defendants. At all events, since the defendants chose to make their own folded strips in their own factory, instead of going outside to purchase them, or have them made by others, they cannot justly complain of their being accountable for the profits realized in using the complainant's machine for that purpose. — *Thompson v. Wooster*, 114 U. S. 104; 29 L. Ed. 105; 5 S. Ct. 788.

§ 297. Proof of.

The plaintiffs have furnished no data to estimate actual damage, and therefore, in no aspect of the case can they recover more than nominal damages. — *Mayor v. Ransom*, 64 U. S. 487; 16 L. Ed. 515.

The plaintiff must show his damages by evidence. They must not be left to conjecture by the jury. They must be proved, and not guessed at. — *Philip v. Nock*, 84 U. S. 460; 21 L. Ed. 679.

No license fee charged by complainant is shown. The burden of proof rests upon him. Damages must be proved; they are not to be presumed. — *Robertson v. Blake*, 94 U. S. 728; 24 L. Ed. 245.

Having failed to prove by reliable and tangible evidence that the entire value of the infringing device as a marketable article, was properly and legally attributable to his patented feature, the court cannot indulge in conjecture or speculation in order to give him the entire profits made by the defendants. — *Mosher v. Joyce*, 51 Fed. 441; 2 C. C. A. 322.

The burden of proof of damages is upon the plaintiff. — *Hunt v. Cassidy*, 53 Fed. 257; 3 C. C. A. 525.

Garretson v. Clark, 111 U. S. 120; *Blake v. Robertson*, 94 U. S. 728.

The defendant below insisted that the damages recoverable must be actual, and that proof as to sales to other parties or of an established license fee as royalty, was inadmissible. The trial judge overruled the objection, and, we think, rightly, admitted evidence of sales made and license fees collected. — *Houston v. Stern*, 74 Fed. 636; 20 C. C. A. 636.

§ 298. Segregation.

If the measure of damages be the same whether a patent be for an entire machine, or for some improvement in some part of it, then it follows that each one who has patented an improvement in any portion of a machine may recover the whole profits arising from the skill, labor, material and capital employed in making the whole machine, and the unfortunate mechanic may be compelled to pay treble his whole profits to each of a dozen or more several inventors of some small improvement in the machine he has built.

By this doctrine even the smallest part is made equal to the whole, and "actual damages" to the plaintiff may be converted into an unlimited series of penalties on the defendant. — *Seymour v. McCormick*, 16 How. 480; 14 L. Ed. 1024.

One who invents some improvement in the machinery of a mill could not claim that the profits of the whole mill should be the measure of damages for the use of his improvement. And when the profit of the patentee consists neither in the exclusive use of the thing invented or discovered nor in the monopoly of making it for others to use, it is evident that the rule could not apply. — *Seymour v. McCormick*, 16 How. 480; 14 L. Ed. 1024.

It is true of a process invented as an improvement in a manufacture, as it is of an improvement in a machine, that an infringer is not liable to the extent of his entire profits in the manufacture. — *Mowry v. Whitney*, 81 U. S. 620; 20 L. Ed. 860.

Jones v. Morehead, 1 Wall. 155; *Seymour v. McCormick*, 16 How. 480.

Where the infringement is confined to a part of the thing sold, the recovery must be limited accordingly. It cannot be as if the entire thing were covered by the patent; or, where that is the case, as if the infringement were as large as the monopoly. — *Philip v. Nock*, 84 U. S. 460; 21 L. Ed. 679.

Where segregation is necessary and is not made, only nominal damages will be allowed. — *Robertson v. Blake*, 94 U. S. 728; 24 L. Ed. 245.

It does not necessarily follow from this rule (the rule in *Mowry v. Whitney*) that where the patent is for one of the constituent parts and not for the whole machine, the profits are to be confined to what can be made by the manufacture and sale of the patented part separately. If, without improvement, a machine adapted to the same uses can be made, which will be valuable in the market and salable, then as was further said in *Mowry v. Whitney*, the inquiry is, "what was the advantage in cost, in skill required, in convenience of operation or marketability" gained by the use of the patented improvement. If the improvement is required to adapt the machine to a particular use, and there is no other way open to the public of supplying the demand for that use, then it is clear the infringer has by his infringement secured the advantage of a market he would not otherwise have had, and that the fruits of his advantage are the entire profits he has made in that market. Such, we think, is the case. — *Goulds v. Cowing*, 105 U. S. 253; 26 L. Ed. 987.

It is incumbent upon the complainant to separate the profits arising from the saving to defendant by using the patented device from other savings or profits. — *Black v. Thorne*, 111 U. S. 122; 28 L. Ed. 372; 4 S. Ct. 326.

It is provided by sec. 4921 of the R. S. that, in a suit in equity for the infringement of a patent, the plaintiff may, on a decree in his favor, recover the damages he has sustained, in addition to the profits to be accounted for by the defendant, such damages to be assessed by the court, or under its direction, and with the same power to increase the damages, in the discretion of the court, as in the case of verdicts; and the damages intended are "the actual damages sustained" in the language of sec. 4919. *Root v. R. Co.* 105 U. S. 189. By sec. 4933 all these provisions apply to patents for designs.

This court has, in a series of decisions, laid down rules as to what are to be regarded as "profits to be accounted for by the defendant," and what as "actual damages" in suits for the infringement of patents; and no rule has

been sanctioned which will allow, in the case of a patent for a design for ornamental figures created in the weaving of a carpet, or imprinted on it, the entire profit from the manufacture and sale of the carpet, as profits or damages, including all the profits from carding, spinning and weaving, thus regarding the entire profits as due to the figure or pattern, unless it is shown by reliable evidence that the entire profit is due to the figure or pattern. It is matter of common knowledge that there is an infinite variety of patterns in carpets, and that, between two carpets of equal cost to make and equal merit as to durability of fabric and fastness of color, each with a pattern pleasing to the taste, one having a design free to be used and the other a design protected by a patent, the latter may or may not command in the market a price larger than the former. If it does, then the increased price may be fairly attributed to the design, and there is a solid basis of evidence for profits or damages. But, short of this, under the rules established by this court, there is no such basis. The same principle is applicable as in patents for inventions. The burden is upon the plaintiff, and if he fails to give the necessary evidence, but resorts, instead, to inference and conjecture and speculation, he must fail for want of proof. There is another suggestion of great force. The carpet with the infringing design may be made on an infringing loom, and various infringing processes or mechanisms for carding, spinning and dyeing may be used in making it, and if the entire profit in making and selling it is necessarily to be attributed to the pattern, so it may as well, on principle, be attributed to each of the other infringements, and a defendant might be called on to respond many times over for the same amount. There is but one safe rule — to require the actual damages or profits to be established by trustworthy legal proof. — *Dobson v. Hartford*, 114 U. S. 439; 29 L. Ed. 177; 5 S. Ct. 945.

Livingston v. Woodworth, 15 How. 546; *Seymour v. McCormick*, 16 How. 480; *Mayor v. Ransom*, 23 How. 487; *Mowry v. Whitney*, 14 Wall. 620; *Philip v. Nock*, 17 Wall. 460; *Littlefield v. Perry*, 21 Wall. 205; *Birdsall v. Coolidge*, 93 U. S. 64; *Cawood Pat.* 94 U. S. 695; *Blake v. Robertson*, 94 U. S. 728; *Garretson v. Clark*, 111 U. S. 120; *Black v. Thorne*, 111 U. S. 122. *Distinguishing Mfg. Co. v. Cowing*, 105 U. S. 253.

The plaintiff must show what profit or damages are attributable to the use of the infringing design. — *Dobson v. Dornan*, 118 U. S. 10; 30 L. Ed. 63; 6 S. Ct. 946.

Dobson v. Hartford, 114 U. S. 439.

Where patent covers only a part or an improvement upon a general machine profits must be segregated. — *McCreary v. Pennsylvania*, 141 U. S. 459; 35 L. Ed. 817; 12 S. Ct. 40.

Seymour v. McCormick, 57 U. S. 480; *Mowry v. Whitney*, 81 U. S. 620; *Littlefield v. Perry*, 88 U. S. 205; *Elizabeth v. Nicholson*, 97 U. S. 126; *Garretson v. Clark*, 111 U. S. 120.

Necessary to the recovery of more than nominal damages. — *Keystone v. Adams*, 151 U. S. 139; 38 L. Ed. 103; 14 S. Ct. 295.

Garretson v. Clark, 111 U. S. 120.

The rule requiring that profits arising from the patented features must be separated from those arising from the unpatented features has little application in a case where every feature is patented. — *Warren v. Keep*, 155 U. S. 265; 39 L. Ed. 144; 15 S. Ct. 83.

It is, no doubt, well settled that where a patent is for a particular part of an existing machine, it is not sufficient to ascertain the profits on the whole

machine, but it must be shown what portion of the profits is due to the particular invention secured by the patent in suit. But it is equally true that, when the patented invention is for a new article of manufacture, which is sold separately, the patentee is entitled to damages arising from the manufacture and sale of the entire article. — *Warren v. Keep*, 155 U. S. 265; 39 L. Ed. 144; 15 S. Ct. 83.

Robertson v. Blake, 94 U. S. 728; *Dobson v. Hartford*, 114 U. S. 439; *Goulds v. Cowing*, 105 U. S. 258; *Hurlbut v. Schillinger*, 130 U. S. 456; *Crosby v. Consolidated*, 141 U. S. 441.

Rule of *Garretson v. Clark* cited and applied. — *Mosher v. Joyce*, 51 Fed. 441; 2 C. C. A. 322.

Dobson v. Carpet Co. 114 U. S. 444.

The authorities are full upon the point that a party cannot recover on damages the profits to be derived from the manufacture of the whole of a machine, when only a portion of the same contains a patented feature. — *Hunt v. Cassidy*, 53 Fed. 257; 3 C. C. A. 525.

Garretson v. Clark, 111 U. S. 120; *Dobson v. Carpet Co.* 114 U. S. 440; *Philip v. Neck*, 17 Wall. 460.

It would be impossible in the case of a patent such as this to introduce testimony to separate the value of the patented from the unpatented parts. The plaintiffs' invention practically introduced a new cart, — a cart for which a demand at once arose. There is no evidence that at any time carts were constructed after the manner of the plaintiff's but with the patented feature omitted. There would be no demand for such a cart. It was impossible, therefore, to compare the value of the patented cart with a cart which did not contain the invention. There was in the case the admission of the defendants that they had constructed 150 carts in 1893. The testimony of the plaintiffs was that, by reason of the competition of infringers, the price of their cart, which was originally \$35, had been reduced to \$22.50. The measure of their damages was their entire loss. — *Holmes v. Truman*, 67 Fed. 542; 14 C. C. A. 517.

Fitch v. Bragg, 16 Fed. 243; *Mfg. Co. v. Sargent*, 117 U. S. 536.

The defendants insist, however, that they made additions which materially benefited the machines, and increased their effective power. If this is true, although they took the whole of the vital and effective part of the invention, but superadded and annexed an improvement which contributed to the saving which they obtained, they have a right to an apportionment, the burden being upon them to show that a portion of the profits was the result of the improvement which they annexed. — *Tuttle v. Claffin*, 76 Fed. 227; 22 C. C. A. 138.

Elizabeth v. Pavement, 97 U. S. 126; *Crosby v. Consolidated*, 141 U. S. 441.

The general rule is clear that in an accounting of profits derived from the infringement of a patent the plaintiff has the burden of proof, and the infringer is chargeable only with the actual gains and advantages derived from the use of the invention. — *Elgin v. Nichols*, 105 Fed. 780; 45 C. C. A. 49.

Garretson v. Clark, 111 U. S. 120; *Dobson v. Carpet Co.*, 114 U. S. 439; *City v. American*, 97 U. S. 126.

But it does not follow that, because the only part of the machine sold covered by this claim is the barred cylinder, the patentees' recovery of

profits is to be confined to what can be made by making and sale of this cylinder only. — *Penfield v. Potts*, 126 Fed. 475; 61 C. C. A. 371.

Garretson v. Clark, 111 U. S. 120; *Reed v. Lawrence*, 29 Fed. 915; *Mosher v. Joyce*, 51 Fed. 441, *Manufacturing Co. v. Cowing*, 105 U. S. 253; *Crosby v. Consolidated*, 141 U. S. 454.

Here is the rock on which many patent causes have been stranded at the end of their course, for, though it can sometimes be done, it is generally next to impossible to distinguish the profits due to one rather than another of the characteristics of the article sold, or manufactured to be sold. The price is single, and it would rarely happen that either the buyer or the seller would contemplate the price as made up of components grounded on such a distinction. The facts are similar to those which in other cases would condemn the guilty party to suffer the consequences of his mingling indistinguishably the property of an innocent party with his own or that of another. Counsel for defendant has argued this question upon the theory that the rule laid down in the case of *Elizabeth v. Pavement Co.* was an exception to that stated in *Garretson v. Clark*, and seems to suppose that, in every case where some element or elements of a combination found in a former patent is found also in the infringing article, the burden is cast upon the plaintiff to prove either that it did not affect the selling price of the article, or, if it did, to show what part of the price was due to his own invention. But such a rule would be inconsistent with the decision in *Elizabeth v. Pavement Co.* We think the two cases above mentioned are not inconsistent; but that they are easily reconciled upon the assumption that the rule of the first case is applicable to the question of the burden of proof of showing the presence of the extraneous element and the probability that it has affected the price, and that the rule of the second case relates to the burden of proof after these facts are established. Thus in the later case of *Keystone v. Adams*, 151 U. S. 145, in summing up the conclusions reached thereon, one was stated to be, "that when the infringed device was a portion only of defendant's machine, which embraced inventions covered by patents other than that for the infringement of which the suit was brought, in the absence of proof to show how much of that profit was due to such other patents, and how much was a manufacturer's profit, the complainant is entitled to nominal damages only," from which it seems that the conditions stated must have been made to appear before the rule stated could be applied. — *Canda v. Michigan*, 152 Fed. 178; 81 C. C. A. 420.

That the conduct of the infringer may require a modification of this rule see *Mast v. Superior*, 154 Fed. 45; 83 C. C. A. 157.

It is contended that the master should have made some apportionment in his estimate of profits to other features of merit in the devices sold by the defendant. No doubt if the defendant could have satisfied the master that there were some other special features of merit not common to grain drills, which contributed to the profits, it would have been his duty to make an apportionment, and award to the Peckham patent only such part of the profits as the proof would justify; but there was no factor brought forward which was entitled to share in the profits the master was inquiring about. The burden was on the defendant to prove that there existed such a factor. — *Mast v. Superior*, 154 Fed. 45; 83 C. C. A. 157.

Canda v. Michigan, 152 Fed. 178; *Elizabeth v. Pavement Co.* 97 U. S. 126; *Sayer v. Scott*, 55 Fed. 971; *Tuttle v. Claffin*, 76 Fed. 227.

Note: Many of the leading cases on this subject will be found under *Profits* — *Segregation*.

§ 299. Miscellaneous Rulings.

The transfer of title to patent in suit *pendente lite* does not affect the right to past damages. — *Dean v. Mason*, 61 U. S. 198; 15 L. Ed. 876.

Counsel fees cannot be included in the verdict. — *Philip v. Nock*, 84 U. S. 460; 21 L. Ed. 679.

When a suit in equity has been brought and prosecuted in the name of the patentee alone, with the licensee's consent and concurrence, to final judgment, from which, if for too small a sum, an appeal might have been taken in the name of the patentee, we should hesitate to say that the licensee, merely because he was not a formal plaintiff in that suit, could bring a new suit to recover damages against the same defendant for the same infringement. — *Birdsall v. Shaliol*, 112 U. S. 485; 28 L. Ed. 768; 5 S. Ct. 244.

Proof of what other manufacturers have realized not a measure of damages. — *Keystone v. Adams*, 151 U. S. 139; 38 L. Ed. 103; 14 S. Ct. 295.

The fact that a competing article could be made and sold at an equal profit does not affect the damages. — *Warren v. Keep*, 155 U. S. 265; 39 L. Ed. 144; 15 S. Ct. 83.

It has been often repeated that a patentee has three distinctive rights, — the right to make, the right to sell, and the right to use his patented articles, — and that whoever invades any one of these rights is an infringer, and liable for damages. — *Philadelphia v. Edison*, 65 Fed. 551; 13 C. C. A. 40.

Since *Birdsall v. Shaliol*, 112 U. S. 485, the law has been settled that the recovery of damages from a defendant, for manufacturing and selling, will not prevent the recovery of other substantial damages from the defendant's vendees; for their profits upon reselling the patented articles. — *Philadelphia v. Edison*, 65 Fed. 551; 13 C. C. A. 40.

Kelley v. Mfg. Co. 44 Fed. 19; *Tuttle v. Matthews*, 28 Fed. 98.

The second patent is only for an attachment, which doubtless may be usefully employed, especially in power mills, but if left off or removed no equivalent in its place is imperative. There can, therefore, be no good reason for supposing that the profits derived from the manufacture and sale of the mills in which that device was employed were all due to its use. — *Elgin v. Nichols*, 105 Fed. 780; 45 C. C. A. 49.

Neither is there any doubt, since the Act July 8, 1870, R. S. 4921, but that, where the injury resulting from an infringement shall be greater than the gains and profits made by the infringer, the patentee, in addition to the profits to be accounted for, is entitled to recover the damages he has sustained. — *Kisinger-Ison v. Bradford*, 123 Fed. 91; 59 C. C. A. 221.

Root v. Railway, 105 U. S. 189; *Coupe v. Royer*, 155 U. S. 565.

DEATH OF APPLICANT.

Miscellaneous Rulings § 300 (*see* § 38)

§ 300. Miscellaneous Rulings.

Power of attorney — right to amend, *see* *Eagleton v. West*, 111 U. S. 490; 28 L. Ed. 493; 4 S. Ct. 593.

Distinguished, *De La Vergne v. Featherstone*, 147 U. S. 209.

Executor or administrator, powers of defined in *De La Vergne v. Featherstone*, 147 U. S. 209; 37 L. Ed. 138; 13 S. Ct. 283.

Amendment after death of applicant made within the scope of the original application without new oath or new power of attorney does not void patent. — *De La Vergne v. Featherstone*, 147 U. S. 209; 37 L. Ed. 138; 13 S. Ct. 283.

Distinguishing, *Eagleton v. West*, 111 U. S. 490.

Does not void patent issued subsequent to his death for which he made application. — *De La Vergne v. Featherstone*, 147 U. S. 209; 37 L. Ed. 138; 13 S. Ct. 283.

DECREES.

General Statement § 301
Appellate Power Over § 302
Classes § 303
Interlocutory § 304

Miscellaneous § 305
See — *Adjudication* § 24; *Appeals*
§§ 116-21; *Injunction* § 533

§ 301. General Statement.

Since this work deals with pleading, practice and procedure only with reference to matters peculiar to patent causes, such topics and titles as the above will be found fragmentary and unsatisfactory as determining any question arising thereunder. It is always presumed that the practitioner has at hand the standard authorities on pleading, practice and procedure, and that what is here given on such subjects is limited to the special rulings in patent causes.

§ 302. Appellate Power Over.

The general rule that a court of review may, whether the adjudication appealed from be interlocutory or final, direct the court of original jurisdiction to enter whatever decree ought to have been entered in the first instance, as in *LeGuen v. Gouverneur*, 1 Johns, Cas. 436; *Richmond v. Atwood*, 52 Fed. 10; *Bissell v. Goshen*, 72 Fed. 545; and *Green v. Mills*, 69 Fed. 852, the opinion in the last named case being by Chief Justice Fuller, — need not be dwelt on. — *Standard v. Crane*, 76 Fed. 767; 22 C. C. A. 549.

An appellate tribunal cannot change the nature of a decree; it cannot make an interlocutory decree final. — *Standard v. Crane*, 76 Fed. 767; 22 C. C. A. 549.

Disapproving, *Bissell v. Goshen*, 72 Fed. 545.

§ 303. Classes.

The single division of decrees into two classes, and two only, interlocutory and final, has been generally accepted by lawyers and judges in this country and England. — *Richmond v. Atwood*, 52 Fed. 10; 2 C. C. A. 596.

“Decrees are of two kinds, interlocutory and final. An interlocutory decree is properly a decree pronounced for the purpose of ascertaining matter of law or fact preparatory to a final decree.” — *Richmond v. Atwood*, 52 Fed. 10; 2 C. C. A. 596.

A preliminary injunction had been granted and no appeal taken. Claim 1 was held invalid at circuit on proofs taken. On motion to dismiss cross-

appeal, *Held*: Here defendants present a complete record. They do not attack merely the injunction respecting the second patent, and that on the ground that it was temporary and improvidently granted; but they contend that, as to the five claims of the two patents held valid, the ultimate merits of the questions of validity and infringement are in their favor. If we were not authorized now to consider and decide the merits with respect to claim 1 of the first patent, which was included in the pleadings and proofs and held invalid, the result would be that the Circuit Court would proceed with the accounting on a basis that does not accord with our views of the ultimate merits, and a new accounting would have to be taken after a subsequent appeal to this court. Motion overruled. — *Chicago v. Miller*, 133 Fed. 541; 66 C. C. A. 517.

§ 304. Interlocutory.

Decree finding certain claims invalid, certain claims valid and infringed, and ordering an injunction.

The decree entered by the circuit court was interlocutory, and not final. — *Ex parte National*, 201 U. S. 156; 26 S. Ct. 404.

Barnard v. Gibson, 7 How. 650; *Humiston v. Stainthorp*, 2 Wall. 106; *Esty v. Burdette*, 109 U. S. 633; *McGourky v. Toledo*, 146 U. S. 536; *Hohorst v. Hamburg-American*, 148 U. S. 262; *Smith v. Vulcan*, 165 U. S. 518.

It will be observed, from an examination of the cases in the Supreme Court of the United States, that a decree in patent cases, declaring the patent in question valid, and that it has been infringed, and for an injunction and an accounting, has uniformly been referred to as an interlocutory decree. — *Richmond v. Atwood*, 52 Fed. 10; 2 C. C. A. 596.

Barnard v. Gibson, 7 How. 650; *Forgay v. Conrad*, 6 How. 201; *Humiston v. Stainthorp*, 2 Wall. 106; *Railroad v. Soutter*, 2 Wall. 510; *Beebe v. Russell*, 19 How. 283; *Iron Co. v. Martin*, 132 U. S. 91.

The Supreme Court has held a decree in a patent case, declaring the patent valid and infringed, and for an injunction and accounting, interlocutory. — *Richmond v. Atwood*, 52 Fed. 10; 2 C. C. A. 596.

Barnard v. Gibson, 7 How. 650, *Forgay v. Conrad*, 6 How. 201; *Humiston v. Stainthorp*, 2 Wall. 106; *Railroad v. Soutter*, 2 Wall. 510; *Beebe v. Russell*, 19 How. 283; *Iron Co. v. Martin*, 132 U. S. 91.

§ 305. Miscellaneous.

A decree by consent for injunction and accounting does not preclude defendant from objection or exception to proceedings subsequent to the decree. — *Livingston v. Woodworth*, 15 How. 546; 14 L. Ed. 809.

The bill we have seen was taken pro confesso, and a decree pro confesso was regularly entered. The defendants are concluded by that decree, so far at least as it is supported by the allegations of the bill, taking the same to be true. Being carefully based on these allegations, and not extending beyond them, it cannot now be questioned by the defendants unless it is shown to be erroneous by other statements contained in the bill itself. A confession of facts properly pleaded dispenses with proof of those facts, and is as effective for the purposes of the suit as if the facts were proved; and a decree pro confesso regards the statements of the bill as confessed. — *Thompson v. Wooster*, 114 U. S. 104; 29 L. Ed. 105; 5 S. Ct. 788.

Keller. Proced. Rom. § 69; *Hawkins v. Crook*, 2 P. Wons. 556; *Davis v. Davis*, 2 Atk. 21; *Williams v. Corwin*, Hopk. Ch. 471; 1 Smith Ch. Pr. 153; 1 Dan. Ch. Pr. 696; *Ogilvie v. Hearne*, 13 Ves. 463; *Geary v. Sheridan*, 8 Ves. 192; *Rose v. Woodruff*, 4 Johns. Ch. 547.

The patent in suit contains 18 claims, and the prayers of the bill relate to the patent as a whole. The decree below directed that an injunction issue "according to the prayer of the bill" although only claims 2 and 13 were in issue. It has been many times urged that the public has an incidental interest in patent litigation, which throws a duty on the court to notice certain matters of its own motion. This is one of them; and in a patent cause, a decree should not go which is broader than the findings of the court. Heretofore we have been content merely to correct the decree below, but, as the duty of drawing out a proper decree rests on the solicitor for the complainant, we will hereafter endeavor to protect the court by a proper adjustment of costs. As the appellant assigned no error on this account, he is not entitled to costs in this behalf. — *Shute v. Morley*, 64 Fed. 368; 12 C. C. A. 356.

When the decree is drawn broader than the findings the complainant can have no costs on appeal. — *Blair v. Eastman*, 64 Fed. 491; 12 C. C. A. 603. Following *Shute v. Morley*, 64 Fed. 368.

In connection with the caution which we have heretofore given parties with reference to the proper limiting of decrees and decretal orders, we said in *Shute v. Machine Co.* 64 Fed. 368, that, when the caution was not thereafter regarded, we should endeavor to protect ourselves by a proper adjustment of the costs. — *Hatch v. Electric*, 100 Fed. 975; 41 C. C. A. 133.

When a decree is "affirmed with respect to the merits, it will not be reversed upon the question of costs." — *Sproull v. Pratt & Whitney*, 108 Fed. 963; 48 C. C. A. 167.

DuBois v. Kirk, 158 U. S. 58.

That other defendant has rights. If Bouchat had permitted a decree pro confesso to have been entered against him, and this corporation, which was the original defendant, had answered, and had set up an available defense, such defense would inure to the benefit of both defendants. — *American v. Phoenix*, 113 Fed. 629; 51 C. C. A. 339.

Frow v. De LaVega, 15 Wall. 552; *Andres v. Lee*, 21 N. C. 319; *Bates*, Fed. Eq. Pro. sec. 327.

In the preparation of his record, the appellant, although not an attorney, acted as his own counsel. In dismissing the bill for want of equity, but without prejudice, the court below evinced a recognition of the failure of the appellant to properly conduct his case, and therefore dismissed the bill without prejudice to the appellant. — *Robinson v. Chicago*, 118 Fed. 438; 55 C. C. A. 254.

The fact that the decree did not become final until after the interlocutory decree in this case does not affect it as a bar when presented before the final decree. — *Penfield v. Potts*, 126 Fed. 475; 61 C. C. A. 371.

Bradley v. Eagle, 57 Fed. 980.

No appeal has been taken by the complainant below from the part of the decree holding claim 2 valid, and we must assume that the validity of this broad claim is acquiesced in. — *Press v. Westinghouse*, 135 Fed. 767; 68 C. C. A. 469.

That a final decree may be amended after entry and after the term of such entry, under certain conditions, see *Maginn v. Standard*, 150 Fed. 139; 80 C. C. A. 15.

DEFENSES.

Statutory Provisions § 306

General Statement § 307

General

Invalidity—Acts of Commissioner § 308

Invalidity -- Defective Grant or Specification § 309 (see § 900)

Invalidity — Reissue § 310 (see § 869)

License or Purchase § 311

Non-Infringement § 312 (see § 445)

Non-Patentability § 313

Non-Utility § 314

Res Judicata § 315

Statutory

Abandonment § 316 (see § 1)

Fraud or Misrepresentation in Specification § 317 (see § 900)

Fraud or Unfairness as Against

another Inventor § 318

Non-Inventorship § 319

Prior patent or Publication § 320 (see § 58)

Prior Public Use or Sale § 321 (see §§ 58, 849)

Miscellaneous § 322

See — Adjudication §§ 31, 33; Anticipation § 58; Demurrer § 323;

Double Patenting § 356; Estoppel § 381; Foreign Patent § 419; Infringement §§ 483-4; Judicial Notice § 705; Jurisdiction § 713; Laches § 726; License § 749; Marking

"Patented" § 776; Oath § 779; Pleading and Practice § 788; Public Use § 849; Reissue § 869; Res Judicata § 893; Statute of Limitations § 921; Title § 925

§ 306. Statutory Provisions.

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 more than two years prior to his application for a patent therefor; 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 the 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 answer of the defendant, and with like effect. — R. S. 4920.

§ 307. General Statement.

The classification of defenses in patent causes, as made by the text-book writers, is chiefly a matter of convenience in treatment of the subject. It is unnecessary for present purposes to do more than to make these two general divisions: statutory defenses specially mentioned in the above classes, and the general defenses available under the general issue.

The subject of statutory notice will be found under the title of *Pleading*.

§ 308. General — Invalidity — Acts of Commissioner.

It was not intended then, and is not now, to question the conclusiveness, in suits for infringement of patents, of the decisions of the Commissioner on questions of fact necessary to be decided before issuing such patents, except as the statute gives specific defenses in that regard. But the statutory defenses are not the only defenses which may be made against a patent. When it is evident that the Commissioner, under a misconception of the law, has exceeded his authority in granting or reissuing a patent, there is no sound principle to prevent a party sued for its infringement, from availing himself of the illegality, independently of any statutory permission so to do. — *Mahn v. Harwood*, 112 U. S. 354; 28 L. Ed. 665; 5 S. Ct. 174.

Stoddard v. Chambers, 2 How. 318; *Easton v. Salisbury*, 21 How. 426; *Richert v. Felps*, 6 Wall. 160; *Meador v. Norton*, 1 Wall. 442; *Best v. Polk*, 18 Wall. 112; *Morton v. Nebraska*, 21 Wall. 660; *Newhall v. Sanger*, 92 U. S. 761; *R. R. v. U. S.* 92 U. S. 733; *Sherman v. Brick*, 93 U. S. 209.

So far as we know, this is the first time the practical construction of the statute now called in question has been challenged, and much disturbance of things supposed to rest on solid foundations would ensue if such an objection should be sustained. Whether the practice, if promptly challenged by the government in a direct proceeding to recall a patent would be sanctioned, we have not now to consider. We think the patents ought not to be held void for irregularity, if it be such, at the instance of a private party in a collateral proceeding. — *Western v. North*, 135 Fed. 79; 67 C. C. A. 553.

“Where it is evident that the commissioner, under misconception of the law, has exceeded his authority in granting or reissuing a patent, there is no sound principle to prevent a party sued for its infringement from availing himself of the illegality, independently of any statutory permission so to do.” — *Weston v. Empire*, 136 Fed. 599; 69 C. C. A. 329.

Mahn v. Harwood, 112 U. S. 354; *Planing Machine v. Keith*, 101 U. S. 479.

§ 309. General — Invalidity — Defective Grant or Specification.

A claim is false, though not fraudulent, when founded upon an honest mistake; and, as it must have failed whenever called into question and the facts were made known, it is void. — *Hartshorn v. Saginaw*, 119 U. S. 664; 30 L. Ed. 539; 7 S. Ct. 421.

We think it may be affirmed as a rule resting upon the fundamental principles of patent law that, where the essence of the invention is the location, form, size, or any other characteristic of the means employed, the patent must distinctly specify the peculiarities in which his invention is to be found. — *American Lava v. Steward*, 155 Fed. 731; 84 C. C. A. 157.

Store Co. v. Store Co. 150 Fed. 141; *Bullock v. Gen. Elec.* 149 Fed. 409.

Note: This rule is undoubtedly sound, but this is a dangerous case. See same pat. sustained 128 Fed. 599.

§ 310. General — Invalidity — Reissue.

If the defendant means, by the very vague answer to the bill, to set up and to rely on a fraud by which the commissioner was misled and deceived and induced to reissue the patent, and that the plaintiff or its assignors were the guilty parties, that question cannot be raised in this collateral proceeding, and can only be considered in some direct suit to impeach and set aside the patent. — *Eureka v. Bailey*, 78 U. S. 488; 20 L. Ed. 209.

Rubber v. Goodyear, 9 Wall. 788.

In this very matter of reissued patents it has also been frequently decided that it is a good defense in a suit on such a patent to show that the Commissioner exceeded his authority in granting it. Such a defense is established by showing that the rescinded patent is for a different invention from that described in the original; inasmuch as the statute declares that it must be for the same invention. — *Mahn v. Harwood*, 112 U. S. 354; 28 L. Ed. 665; 5 S. Ct. 174.

Burr v. Duryee, 1 Wall. 531; *Gill v. Wells*, 22 Wall. 1; *Collar v. Van Deusen*, 23 Wall. 530; *Wood Paper Pat.* 23 Wall. 566; *Leggett v. Avery*, 101 U. S. 259; *James v. Campbell*, 104 U. S. 368.

§ 311. General — License or Purchase.

The defendant cannot justify his act by proving license under other patents. — *Blanchard v. Putnam*, 75 U. S. 420; 19 L. Ed. 433.

Curt. Pat. 350, 353; *Carver v. Mfg. Co.* 2 Story, 432.

Defendants were innocent infringers. When they discovered the fact they purchased a legal title to the patent for this territory. *Held*: That such purchase converted their act into a legal right, and was equivalent to an original lawful purchase or manufacture of the machine. — *Eunson v. Dodge*, 85 U. S. 414; 21 L. Ed. 766.

That part of the defendant's affidavit which asserts that a certain named patentee has served the defendant with notice of a claim for damages for infringement of letters patent by the defendant's use of the machinery and appliances furnished to it by the plaintiff, and that by such use the defendant is also liable to another patentee, affords no ground of defense to this action. A purchaser of property who has had the full use and enjoyment of the same, and is in the undisturbed possession thereof in the absence of fraud, cannot withhold the purchase price because a third person claims to have a superior title thereto, or an adverse right therein, and threatens to bring suit to enforce the same, or because of an alleged liability on the part of a purchaser to a patentee for an infringement of letters patent by reason of the use of the priority. — *Consumers v. Danville*, 50 Fed. 778; 1 C. C. A. 663.

Wanzer v. Truly, 17 How. 584; *Krumbhaar v. Birch*, 83 Pa. St. 426; *Geist v. Stier*, 134 Pa. St. 216.

To permit any undisclosed improvements controlled by either party to be set up for the purpose of limiting the rights of the other under the contract at bar, and especially for diminishing the apparent extent or validity of its patents, would effect an unjust evasion of the stipulated terms. — *B. & S. Fastener v. B. G. Fastener*, 58 Fed. 818; 7 C. C. A. 498.

While, under the contract, the state of the art could not be shown to defeat the validity of the patents under the contract, it could be shown to determine the scope of the claims, the character of the invention and the applicability of the rule of equivalents. — *B. & S. Fastener v. B. G. Fastener*, 58 Fed. 818; 7 C. C. A. 498.

Complainant proved infringement by the production of an exhibit made according to the terms of the patent, and proved that the same had been made by defendant. Defendants denied infringement in their answer and alleged invalidity of the patent. After the case was ready for final hearing, defendants having taken no proofs, defendant moved to amend their answer and set up a license. This license ran from complainant to one Bry, who was an importer and dealer, and provided a royalty and also provided that but one royalty should be paid on such goods. Defendant claimed this license a bar

to recovery. *Held:* We are not able to read the complainant's license to Bry as giving any sanction to the manufacture by the defendants of the patented fabric. The defendants are neither parties nor privies to that instrument. That they themselves are not bound by any of its provisions is too plain for argument. The licensee thereunder is Jean Bry, and as to him it is non-assignable personal license. There is no contractual relation whatever between the complainant and the defendants; hence no accounting on that basis is enforceable by the complainant against the defendants. If, then, the Bry license is, as claimed, a defense to a bill for infringement, the complainant is remediless as against the defendants in respect to their transactions with Bry. Upon the defendants' theory, by their own simple election to resort to Bry's license they acquired, as against the owner of the patent, a right to manufacture without liability to account to him. But, if Bry's license is thus available to the defendants, it is equally available to every other unlicensed manufacturer in the country. A construction of a license which leads to such results is not to be lightly adopted. — *Hanifen v. Lupton*, 101 Fed. 462; 41 C. C. A. 462.

§ 312. General — Non-Infringement.

Courts did not, perhaps, at first distinguish clearly between a defense which would authorize a verdict and judgement in favor of the defendant in a particular action, leaving the plaintiff free to use his patent, and to bring other suits for its infringement; and one which, if successful, would require the Court to enter a judgement not only for the defendant in the particular case, but one which declares the patent to be void. This distinction is now well settled. — *Grant v. Raymond*, 6 Pet. 218; 8 L. Ed. 376.

There is no inconsistency in the two allegations. The first is a direct, positive denial of infringement; the second, that the acts of the defendant charged as infringing the patent had been done by it since 1891. It does not concede that these acts infringed the patent, but asserts, in legal effect, that if, as the complainant claims, they do so infringe it, then the performance of these acts dated from a period six years prior to the patent, sustaining the defense of a public use, and so establishing want of novelty. — *Robinson v. American*, 135 Fed. 693; 68 C. C. A. 331.

The infringement was conceded in the Circuit Court by the counsel for defendant, and such fact was recited in the opinion of the circuit judge. This understanding was adhered to in the preparation of printed briefs on both sides. Appellee having submitted the case on briefs in this court, counsel for appellant on the oral argument called attention to an alleged distinguishing feature of the defendant's structure which he claimed relieved it from infringement. Even if his proposition were sound from a mechanical standpoint, we should hesitate to entertain the same at this time in view of the history of the case, which shows that this defense has been expressly and deliberately waived by counsel. — *Railway v. Munroe*, 147 Fed. 241; 77 C. C. A. 383.

The answer denied infringement. A supplemental answer alleged use under a patent to defendant, which patent, on its face was an infringement of the patent sued on. *Held:* This pleading, of course, presented no defense to the suit. Its sole effect was to annul the denial of infringement contained in the answer and to relieve plaintiff of the necessity of proving it. It had this effect because it is apparent from an inspection of said patent that the apparatus described in it and to which it related is an infringement of plaintiff's two patents sustained and held to be infringed, and it is alleged that the apparatus in use by defendant is of that character. This left the second

defense of the original answer as the only defense to the suit. — *Buser v. Novelty*, 151 Fed. 478; 81 C. C. A. 16.

Defendant avers that it ceased the sale of said grain drill long prior to the beginning of the present action. Answers in equity must be full, unequivocal, and responsive to the bill. The indefinite, evasive averments of the answer in this case signally fail to respond to the requirements of that rule and well justify us in treating them as negative pregnant admitting the truth of the definite averments of the bill which are not fully answered. — *Deere v. Dowagiac*, 153 Fed. 177; 82 C. C. A. 351.

§ 313. General — Non-Patentability.

We do not attach much significance to the act, which was intended to create an easy system of pleading. Proof that there is no invention strikes at the root of the whole claim. The patent is based on an affirmative act of which this is the direct negative. It needed no statute to aid or justify this defense. It is provable when it exists under any general denial, like the fact of not guilty or non-assumpsit in cases where guilt or a promise is first to be established. — *Reckendorfer v. Faber*, 92 U. S. 347; 23 L. Ed. 719.

A valid defense not given by the statute often arises where the question is, whether the thing patented amounts to a patentable invention. This being a question of law, the courts are not bound by the decision of the Commissioner, although he must necessarily pass upon it. — *Mahn v. Harwood*, 112 U. S. 354; 28 L. Ed. 665; 5 S. Ct. 174.

Brown v. Piper, 91 U. S. 38; *Glue Co. v. Upton*, 97 U. S. 3; *Dunbar v. Myers*, 94 U. S. 187; *Atlantic v. Brady*, 107 U. S. 199; *Slawson v. R. R.* 107 U. S. 652; *King v. Gallun*, 109 U. S. 101.

This defense is one which may be availed of without setting it up in an answer. — *Hendy v. Golden*, 127 U. S. 370; 32 L. Ed. 207; 8 S. Ct. 1275.

Dunbar v. Myers, 94 U. S. 187; *Slawson v. Grand*, 107 U. S. 649; *Mahn v. Harwood*, 112 U. S. 354.

Want of patentability is a defense, though not set up in an answer or plea. — *May v. Juneau*, 137 U. S. 408; 34 L. Ed. 729; 11 S. Ct. 102.

Brown v. Piper, 91 U. S. 37; *Dunbar v. Myers*, 94 U. S. 187; *Slawson v. Grand*, 107 U. S. 649; *Hendy v. Golden*, 127 U. S. 370.

Although want of novelty is not pleaded, the patent may be declared void for want of novelty. — *Richards v. Chase*, 158 U. S. 299; 39 L. Ed. 991; 15 S. Ct. 831.

Dunbar v. Myers, 94 U. S. 187; *Slawson v. Grand*, 107 U. S. 649; *Brown v. Piper*, 91 U. S. 37.

§ 314. General — Non-Utility.

The burden is upon the defendant to prove want of utility. He must either show that it is theoretically impossible for such a device to operate, or demonstrate by clear proof that a person skilled in the art to which the invention pertains has endeavored in good faith to make the patent work, and has been unable to do so; and it follows that such evidence is overthrown if it is demonstrated by practical experiments of credible persons that they have succeeded in producing by the patent process the results claimed by the patent. — *Crown v. Aluminum*, 108 Fed. 845; 48 C. C. A. 72.

The proposition that the invention is without utility is sufficiently answered

by the fact that defendants persistently use it. — *Rumford v. New York*, 134 Fed. 385; 67 C. C. A. 367.

The appellee company, failing to use any of the older forms of clamping jaws, and seizing upon appellant's success, is hardly in a position to question the utility of the novel feature. — *Cazier v. Mackie-Lovejoy*, 138 Fed. 654; 71 C. C. A. 104.

It is asserted by the defendant that the complainant never made fasteners under the patent. If this be true it is wholly immaterial to the present controversy. Where it is asserted that a patented device is inoperative and lacks utility, evidence that it has never been put to use is persuasive, but in a case like the present, where the fact that the device is useful and operative can be seen at a glance, such evidence is negligible. The complainant had a right to use the patent in any way it saw fit. — *U. S. Fastener v. Bradley*, 149 Fed. 222; 79 C. C. A. 180.

§ 315. General — Res Judicata.

This court described the rule in *Aspden v. Nixon*, 4 How. 476, in such cases to be, that a judgement or decree, set up as a bar by plea, or relied on as evidence by way of estoppel, must have been made by a court of competent jurisdiction upon the same subject matter, between the same parties for the same purpose. — *Packet Co. v. Sickles*, 65 U. S. 333; 16 L. Ed. 650.

In the absence of a plea other than res adjudicata based upon an interference and in the absence of any proof other than the record, the prima facie of the patent in suit will entitle a decree. — *Garratt v. Siebert*, 98 U. S. 75; 25 L. Ed. 84.

Without respect to pleading, wherever a former recovery is properly in evidence — as here it was by agreement of the parties — full effect should be given to it, so far as it bears upon the issue presented. The issue here being novelty of invention, and that fact having been determined by the prior adjudication, the former decree becomes conclusive evidence of the validity of the patent as between the parties affected by such prior adjudication. — *Bradley v. Eagle*, 58 Fed. 721; 7 C. C. A. 442.

§ 316. Statutory — Abandonment.

It must, then, be open to every person, charged with an infringement, to show in his defense that the patentee had abandoned his invention before he obtained his patent. — *Woodbury v. Keith*, 101 U. S. 479; 25 L. Ed. 939.

The defense of abandonment was not pleaded, and the appellant had no opportunity to meet it by evidence. It was discovered by the court below at the final hearing, and it rested on the statement in the patent which we have quoted, and that alone. The mere statement was insufficient to support it. — *Mast v. Dempster*, 82 Fed. 327; 27 C. C. A. 191. But see 177 U. S. 485.

§ 317. Statutory — Fraud or Misrepresentation in Specification.

Since that time (the Act 1832) it has been definitely settled that neither reissued nor extended patents can be abrogated by an infringer in a suit against him for infringement, upon the ground that the letters patent were procured by fraud in prosecuting the application for the same before the commissioner. — *Seymour v. Osborne*, 78 U. S. 516; 20 L. Ed. 33.

Rubber v. Goodyear, 9 Wall. 797; *Stimpson v. R. R.* 4 How. 404; *R. R. v. Stimpson*, 14 Pet. 458.

The defendants when sued for an infringement, were not at liberty to set up as a defense that the patent had been fraudulently obtained, no fraud appearing on its face. — *Railroad v. DuBois*, 79 U. S. 47; 20 L. Ed. 265.

Rubber v. Goodyear, 9 Wall. 788.

Whether under the present act the defense of defective specification implies fraudulent intent, the court said:

There is plausibility in this argument, and if it were necessary to the decision of this case, it might give us some embarrassment. — *Loom Co. v. Higgins*, 105 U. S. 580; 26 L. Ed. 1177.

The right given to the infringer to make this defense is a right given to him personally, and to him alone, and the effect of a successful defense of this character by one infringer is simply to establish the fact that, as between him and the patentee, no right of action exists for the reasons set up in such defense. But the patentee is not prevented by any such decision from suing a hundred other infringers if so many there be, and putting each of them to an expensive defense, — in which they all, or some of them, may be defeated and compelled to pay, because they are not in possession of the evidence on which the other infringer succeeded. On the other hand, the suit of the Government, if successful, declares the patent void, sets it aside as of no force, vacates it or recalls it, and puts an end to all suits which the patentee can bring against anybody. — *United States v. Am. Bell*, 128 U. S. 315; 32 L. Ed. 450; 9 S. Ct. 90.

§ 318. Statutory — Fraud or Unfairness as Against Another Inventor.

The charge that the original patentee in this case fraudulently and surreptitiously obtained the patent for that which he well knew was invented by another, unaccompanied by the further allegation that the alleged first inventor was at the time using reasonable diligence in adapting and perfecting the invention is not sufficient to defeat the patent, and constitutes no defense to the charge of infringement. — *Agawam v. Jordan*, 74 U. S. 583; 19 L. Ed. 177.

Reed v. Cutter, 1 Story, 599.

§ 319. Statutory — Non-Inventorship.

Viewed in any light the proposition amounts to the charge that the invention was made by the person therein mentioned, and not by the assignor of the complainant, and the burden to prove it is on the respondents, not only because they make the charges, but because the presumption arising from the letters patent is the other way. — *Agawam v. Jordan*, 74 U. S. 583; 19 L. Ed. 177.

§ 320. Statutory — Prior Patent or Publication.

The defense of anticipation by a prior patent must be raised by the statutory notice. — *Blanchard v. Putnam*, 75 U. S. 420; 19 L. Ed. 433.

Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of a prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement in such full, clear and exact terms as to enable any person skilled