

upon, on said date, the clerks of said courts shall deliver to the clerks of the district courts of the United States for their respective districts all the journals, dockets, books, files, records, and other books and papers of or belonging to or in any manner connected with said circuit courts. \* \* \*

#### **Circuit Courts — Transfer of Powers and Duties.**

Sec. 291. Whenever, in any law not embraced within this Act, any reference is made to, or any power or duty is conferred or imposed upon, the circuit courts, such reference shall, upon the taking effect of this Act, be deemed and held to refer to, and to confer such power and impose such duty upon, the district courts.

#### **Circuit Courts of Appeals — Circuits — Constitution.**

Sec. 116. There shall be nine judicial circuits of the United States, constituted as follows:

\* \* \* \* \*

Sec. 117. There shall be in each circuit a circuit court of appeals, which shall consist of three judges, of whom two shall constitute a quorum, and which shall be a court of record, with appellate jurisdiction, as hereinafter limited and established.

#### **Circuit Courts of Appeals — Certification to Supreme Court.**

Sec. 239. In any case within its appellate jurisdiction, as defined in section 128, the circuit court of appeals at any time may certify to the Supreme Court of the United States any questions or propositions of law concerning which it desires the instruction of that court for its proper decision; and thereupon the Supreme Court may either give its instruction on the questions and propositions certified to it, which shall be binding upon the circuit court of appeals in such case, or it may require that the whole record and cause be sent up to it for its consideration, and thereupon shall decide the whole matter in controversy in the same manner as if it had been brought there for review by writ of error or appeal.

#### **Circuit Courts of Appeals — Certiorari to.**

(See Supreme Court, Sec. 240, Jud. Code).

#### **Circuit Courts of Appeals — Injunctions — Interlocutory Decrees.**

Sec. 129. Where upon a hearing in equity in a district court, or by a judge thereof in vacation, an injunction shall be granted, continued, refused, or dissolved by an interlocutory order or decree, or an application to dissolve an injunction shall be refused, or an interlocutory order or decree shall be made appointing a receiver, an appeal may be taken from such interlocutory order or decree granting, continuing, refusing, dissolving, or refusing to dissolve, an injunction, or appointing a receiver, to the circuit court of appeals, notwithstanding an appeal in such case might, upon final decree under the statutes regulating the same, be taken directly to the Supreme

Court: Provided, That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed unless otherwise ordered by that court, or the appellate court, or a judge thereof, during the pendency of such appeal: Provided, however, That the court below may, in its discretion, require as a condition of the appeal an additional bond.

**Circuit Courts of Appeals — Jurisdiction.** Sec. 128. The circuit courts of appeals shall exercise appellate jurisdiction to review by appeal or writ of error final decisions in the district courts, including the United States district court for Hawaii, in all cases other than those in which appeals and writs of error may be taken direct to the Supreme Court, as provided in section 238, unless otherwise provided by law; and, except as provided in sections 239 and 240, the judgments and decrees of the circuit courts of appeals shall be final in all cases in which the jurisdiction is dependent entirely upon the opposite parties to the suit or controversy being aliens and citizens of the United States, or citizens of different States; also in all cases arising under the patent laws, under the copyright laws, under the revenue laws, and under the criminal laws, and in admiralty cases.

**Construction — Arrangement and Classification.**

Sec. 295. The arrangement and classification of the several sections of this Act have been made for the purpose of a more convenient and orderly arrangement of the same, and therefore no inference or presumption of a legislative construction is to be drawn by reason of the chapter under which any particular section is placed.

**Construction — Continuation of Previous Acts.**

Sec. 294. The provisions of this Act, so far as they are substantially the same as existing statutes, shall be construed as continuations thereof, and not as new enactments, and there shall be no implication of a change of intent by reason of a change of words in such statute, unless such change of intent shall be clearly manifest.

**Construction — Definition.**

Sec. 293. The provisions of sections one to five, both inclusive, of the Revised Statutes, shall apply to and govern the construction of the provisions of this Act. The words "this title," wherever they occur herein, shall be construed to mean this Act.

**Courts — Always Open as Courts of Equity.**

Sec. 9. The district courts, as courts of admiralty and as courts of equity, shall be deemed always open for the purpose of filing any pleading, of issuing and returning mesne and final process, and of making and directing all interlocutory motions, orders, rules, and other proceedings preparatory to the hearing, upon their merits, of all causes pending therein. Any district judge may, upon reason-



able notice to the parties, make, direct, and award, at chambers or in the clerk's office, and in vacation as well as in term, all such process, commissions, orders, rules, and other proceedings, whenever the same are not grantable of course, according to the rules and practice of the court.

#### **Courts — Special Terms.**

Sec. 11. A special term of any district court may be held at the same place where any regular term is held, or at such other place in the district as the nature of the business may require, and at such time and upon such notice as may be ordered by the district judge. Any business may be transacted at such special term which might be transacted at a regular term.

#### **Court of Appeals, D. C. — Appeals from.**

(See Appeals, Sec. 250, Jud. Code).

#### **Court of Appeals, D. C. — Certification to Supreme Court.**

Sec. 251. \* \* \* It shall also be competent for said court of appeals, in any case in which its judgment or decree is made final under the section last preceding, at any time to certify to the Supreme Court of the United States any questions or propositions of law concerning which it desires the instruction of that court for their proper decision; and thereupon the Supreme Court may either give its instruction on the questions and propositions certified to it, which shall be binding upon said court of appeals in such case, or it may require that the whole record and cause be sent up to it for its consideration, and thereupon shall decide the whole matter in controversy in the same manner as if it had been brought there for review by writ of error or appeal.

#### **Court of Appeals, D. C. — Certiorari to.**

(See Supreme Court, Sec. 251, Jud. Code).

#### **Decrees — Interlocutory — Appeals.**

(See Circuit Courts of Appeals, Sec. 129, Jud. Code).

#### **Equity — Jurisdiction — Adequate Remedy at Law.**

(See Jurisdiction, Sec. 267, Jud. Code).

#### **Injunction — Appeals.**

(See Circuit Courts of Appeals, Sec. 129, Jud. Code)

#### **Injunction — Circuit Judge.**

(See Injunction, Sec. 264, Jud. Code).

#### **Injunction — In what Case Judge May Grant.**

Sec. 264. Writs of injunction may be granted by any justice of the Supreme Court in cases where they might be granted by the

Supreme Court; and by any judge of a district court in cases where they might be granted by such court. But no justice of the Supreme Court shall hear or allow any application for an injunction or restraining order in any cause pending in the circuit to which he is allotted, elsewhere than within such circuit, or at such place outside of the same as the parties may stipulate in writing, except when it can not be heard by the district judge of the district. In case of the absence from the district of the district judge, or of his disability, any circuit judge of the circuit in which the district is situated may grant an injunction or restraining order in any case pending in the district court, where the same might be granted by the district judge.

**Injunction — Supreme Court Justices.**

(See Injunction, *supra*, Sec. 264, Jud. Code).

**Injunction — Temporary Restraining Order.**

Sec. 263. Whenever notice is given of a motion for an injunction out of a district court, the court or a judge thereof may, if there appears to be danger of irreparable injury from delay, grant an order restraining the act sought to be enjoined until the decision upon the motion; and such order may be granted with or without security, in the discretion of the court or judge.

**Jurisdiction — Circuit Court of Appeals.**

(See Circuit Court of Appeals, Sec. 128, Jud. Code).

**Jurisdiction — District Courts.**

Sec. 24. The district courts shall have original jurisdiction as follows:

\* \* \* \* \*

Seventh. Of all suits at law or in equity arising under the patent, the copyright, and the trade-mark laws.

**Jurisdiction — Equity — Adequate Remedy at Law.**

Sec. 267. Suits in equity shall not be sustained in any court of the United States in any case where a plain, adequate, and complete remedy may be had at law.

**Jurisdiction — Exclusive of State Courts.**

Sec. 256. The jurisdiction vested in the courts of the United States in the cases and proceedings hereinafter mentioned, shall be exclusive of the courts of the several states:

\* \* \* \* \*

Second. Of all suits for penalties and forfeitures incurred under the laws of the United States.

\* \* \* \* \*

Fifth. Of all cases arising under the patent-right, or copyright laws of the United States.



**Jurisdiction — Residence or Place of Business — Patent Causes.**

Sec. 48. In suits brought for the infringement of letters patent the district courts of the United States shall have jurisdiction, in law or in equity, in the district of which the defendant is an inhabitant, or in any district in which the defendant, whether a person, partnership, or corporation, shall have committed acts of infringement and have a regular and established place of business. If such suit is brought in a district of which the defendant is not an inhabitant, but in which such defendant has a regular and established place of business, service of process, summons, or subpoena upon the defendant may be made by service upon the agent or agents engaged in conducting such business in the district in which suit is brought.

**Jurisdiction — Several Defendants — Diversity of Residence.**

Sec. 50. When there are several defendants in any suit at law or in equity, and one or more of them are neither inhabitants of nor found within the district in which the suit is brought, and do not voluntarily appear, the court may entertain jurisdiction, and proceed to the trial and adjudication of the suit between the parties who are properly before it; but the judgment or decree rendered therein shall not conclude or prejudice other parties not regularly served with process nor voluntarily appearing to answer; and non-joinder of parties who are not inhabitants of nor found within the district, as aforesaid, shall not constitute matter of abatement or objection to the suit.

**Repeal and Superseding Provisions.**

Sec. 297, among other things, repeals or effects supersedence of sections and acts heretofore embodied in the so-called patent laws:

629, R. S., repealed.

Act Mar. 3, 1897, sub 629, superseded by Sec. 48.

699, R. S., repealed.

711, R. S., repealed, see Sec. 256.

Act Mar. 3, 1891, secs. 2 and 4, sub 711, superseded by Secs. 116 and 117.

Act Feb. 19, 1897, sec. 6, sub 711, superseded by Secs. 239 and 240.

Act Feb. 9, 1893, secs. 6 and 8, sub 4915, repealed by Sec. 250.

**Revision of Previous Acts — Supersedence.**

Sec. 292. Wherever, in any law not contained within this Act, a reference is made to any law revised or embraced herein, such reference, upon the taking effect hereof, shall be construed to refer to the section of this Act into which has been carried or revised the provision of law to which reference is so made.

**Supreme Court — Certification of Questions to.**

(See Circuit Court of Appeals, Sec. 239, Jud. Code).

**Supreme Court — Certiorari to Circuit Courts of Appeals.**

Sec. 240. In any case, civil or criminal, in which the judgment or decree of the circuit court of appeals is made final by the provisions of this Title, it shall be competent for the Supreme Court to require, by certiorari or otherwise, upon the petition of any party thereto, any such case to be certified to the Supreme Court for its review and determination, with the same power and authority in the case as if it had been carried by appeal or writ of error to the Supreme Court.

**Supreme Court — Certiorari to Court of Appeals, D. C.**

Sec. 251. In any case in which the judgment or decree of said court of appeals is made final by the section last preceding, it shall be competent for the Supreme Court of the United States to require, by certiorari or otherwise, any such case to be certified to it for its review and determination, with the same power and authority in the case as if it had been carried by writ of error or appeal to said Supreme Court.

\* \* \* \* \*

**Title — Designation.**

Sec. 296. This Act may be designated and cited as "The Judicial Code."

**JURISDICTION.****Circuit Courts — Law and Equity.**

(See Jud. Code, Sec. 24).

**Court of Claims.**

(See Government, Act June 25, 1910).

**Designs — Infringement.**

\* \* \* 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.

SEC. 2. That nothing in this act contained shall prevent, lessen, impeach or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same, might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement. — R. S. 4933 and Act Feb. 4, 1887.

**Patent Causes.**

(See Jud. Code, Sec. 256).

**Place and Person.**

(See Jud. Code, Sec. 48).



## JURY TRIAL

**Equity Cases — Questions of Fact.**

SEC. 2. The said courts (U. S. Circuit Courts) when sitting in equity for the trial of patent causes, may empanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises as may, from time to time, be made by the Supreme Court, and submit to them such questions of fact arising in such case as such circuit court shall deem expedient.

And the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with such findings. — R. S. 4921.

## LACHES

**Application — Abandonment.**

(See Invention, R. S. 4886).

**Application — Prosecution.**

(See Application, R. S. 4894).

**Claims too Broad — Failure to File Disclaimer.**

\* \* \* But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. — R. S. 4922.

**Reissue.**

(See Reissue, R. S. 4916).

## LAW ACTIONS

**Damages.**

(See Damages, R. S. 4919).

## LETTERS PATENT

**General Provision — Contents.**

Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof. — R. S. 4884.

*Patented articles subject to State police laws.* — Patterson v. Kentucky, 97 U. S., 501. Webber v. Va., 103 U. S., 344.

*Patents are property.* — Densmore v. Scofield, 102 U. S., 375.  
*Government has no right to use patented inventions without compensation.*  
 — James v. Campbell, 104 U. S., 356.

**General Provision — Date.**

Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period, the patent shall be withheld. — R. S. 4885, Amended May 23, 1908.

**General Provision — Grant Issuance Attestation.**

All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office in books to be kept for that purpose. — R. S. 4883.

*Omission of signature of the Secretary.* — *Marsh v. Nichols Co.*, 128 U. S., 605.

**Actions to Compel Issue — Actions in Equity.**

(See Actions — Equity, R. S. 4915).

**Assignment Before Issue.**

Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July, eighteen hundred and seventy. — R. S. 4895.

*Assignee of patent before issue.* — *Hendrie v. Sayles*, 98 U. S., 546.

**Assignment — Execution and Recording.**

(See Assignment — By Instrument in Writing, R. S. 4898).

**Authentication — Seal of Patent Office.**

The seal heretofore provided for the Patent Office shall be the seal of the Office, with which letters patent and papers issued from the Office shall be authenticated. — R. S. 478.

**Certified Copies — How Obtained.**

\* \* \* Any person making application therefor, and paying the fee required by law, shall have certified copies thereof. — R. S. 892.

**Designs.**

(See Designs, R. S. 4929).

**Drawings — Part of Specification.**

(See Letters Patent — Contents, R. S. 4884).



**Duration of Grant.**

Every patent shall contain \* \* \* a grant to the patentee, his heirs or assigns, for the term of seventeen years. \* \* \* — R. S. 4884.

**Duration — Limitation by Foreign Patent.**

(See Foreign Patent — Effect on U. S. Application, R. S. 4887).

**For what Granted.**

(See Inventions — Classes of, R. S. 4886).

**Foreign Use — No Bar to Grant — When.**

(See Anticipation — Prior Foreign Invention, R. S. 4923).

**Grant to Representatives of Deceased or Insane Inventor.**

(See Executor, R. S. 4896).

**Granted to Assignee.**

(See Assignment — Before Issue, R. S. 4895).

**Interest in — Patent Office Employees.**

(See Employees — Patent Office, R. S. 480).

**Issuance — Signature, Seal and Record.**

All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office in books to be kept for that purpose. — R. S. 4883.

**Recording of — In Patent Office.**

(See Letters Patent — Issuance, R. S. 4883).

**Sealing.**

The seal heretofore provided for the Patent Office shall be the seal of the Office, with which letters patent and papers issued from the Office shall be authenticated. — R. S. 478.

**Scope of Grant — Territory Included.**

Every patent shall contain \* \* \* a grant to the patentee, his heirs and assigns \* \* \* throughout the United States and Territories thereof. \* \* \* — R. S. 4884.

**Short Title.**

(See Letters Patent — Contents, R. S. 4884).

**LITHOGRAPHING AND ENGRAVING**

The lithographing and engraving required by the two preceding sections shall be awarded to the lowest and best bidders for the

interests of the Government, due regard being paid to the execution of the work, after due advertising by the Congressional Printer under the direction of the Joint Committee on Printing; but the Joint Committee on Printing may empower the Congressional Printer to make immediate contracts for engraving whenever, in their opinion, the exigencies of the public service will not justify waiting for advertisement and award; or if, in the judgment of the Joint Committee on Printing, the work can be performed under the direction of the Commissioner of Patents more advantageously than in the manner above prescribed, it shall be so done, under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe. — R. S. 492.

## LICENSE

### Assignment.

(See Assignment, R. S. 4898).

### Implied — Arising Before Application.

Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application of the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. — R. S. 4899.

## LIMITATIONS

### Statute of.

\* \* \* But in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action. — R. S. 4921.

## MACHINE

### Patentability of.

(See Invention, R. S. 4886).

## MANUFACTURE

### Patentability of.

(See Invention, R. S. 4886).

## MARINE SERVICE

### Adoption of Patented Articles — How Recommended.

No patented article connected with marine engines shall hereafter be purchased or used in connection with any steam vessels of war until the same shall have been submitted to a competent



board of naval engineers, and recommended by such board, in writing, for purchase and use. — R. S. 1537.

## MARKING ARTICLES PATENTED

### Necessity and Manner — Result of Not Marking.

It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented. — R. S. 4900.

*Sufficiency of notice.* — Sessions v. Schofield, 152 U. S., 244; Beach v. Romadka, 145 U. S., 29; Dunlap v. Inman Co., 71 F. R., 420.

### Penalty for False Marking.

Every person who, in any manner, marks upon anything made, used or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor, without the consent of such patentee, or his assigns or legal representatives; or,

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee" or the words "letters patent" or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or,

Who, in any manner, marks upon or affixes to any unpatented article the word "patent" or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed. — R. S. 4901.

## MODELS

### Arrangement and Exhibition of — Public Inspection.

The Commissioner of Patents shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be de-

posited in the Patent Office; and the rooms and galleries shall be kept open during suitable hours for public inspection. — R. S. 484.

**Designs — Dispensed with — When.**

The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. — R. S. 4930.

**Disposition of — Rejected Applications.**

The Commissioner of Patents may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the Treasury, as other patent moneys are directed to be paid. — R. S. 485.

**Reissue — Amendment.**

(See Reissue).

**When Requisite.**

In all cases which admit of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery. — R. S. 4891.

**NOTICE OF ALLOWANCE**

(See R. S. 4885).

**NOVELTY**

**Designs — Prior Patent, Publication, or Use.**

(See Designs — Patentability of, R. S. 4929).

**Prior Foreign Invention — When Not Anticipation.**

(See Anticipation — Prior Foreign Invention, R. S. 4923).

**Prior Use — Prior Publication.**

Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country *before his invention or discovery thereof*, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, *or more than two years prior to his application*, and not in public use or on sale *in this country* for more than two years prior to his application \* \* \* may \* \* \* obtain a patent therefor. — R. S. 4886.

*Note:* Amendments of Mar. 3, 1897, in italics.

**Required — Novelty and Utility.**

Any person who has invented or discovered any new and useful \* \* \* — R. S. 4886.



## OATH

**General Provisions.**

The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, *judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States.*— R. S. 4892.

*Note:* The italics indicate the change made by amendment of Mar. 3, 1903.

<p><i>Not necessary to recite that oath has been taken.</i>— Seymour v. Osborne, 11 Wall., 516.</p>	<p><i>Oath must be made by the inventor.</i>— Kennedy v. Hazelton, 128 U. S., 667-673.</p>
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**Executor, Administrator or Committee.**

(See Executor, R. S. 4896).

**Requirement of — Assigned Invention.**

Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July, 1870. — R. S. 4895.

## OFFICIAL GAZETTE

**Publication of — Authority for.**

The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues. \* \* \* — R. S. 489.

## PAPERS AND DOCUMENTS

**Legibility — Printing.**

The Commissioner of Patents may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them. — R. S. 488.

## PATENT OFFICE

**General Provisions.**

The Secretary of the Interior is charged with the supervision of public business relating to the following subjects:

\* \* \* \* \*

Fifth. Patents for inventions. — R. S. 441.

*Jurisdiction of the Secretary on appeal from Commissioner.* — Butterworth v. *Hoc*, 112 U. S., 50-60.

There shall be in the Department of the Interior an office known as the Patent Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved. — R. S. 475.

**Classifications.**

The Commissioner of Patents shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs which have been or shall be deposited in the Patent Office; and the rooms and galleries shall be kept open during suitable hours for public inspection. — R. S. 484.

**Disbursements — Disbursing Clerk.**

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

**Documents, etc. — Preservation of.**

There shall be in the Department of the Interior an office known as the Patent Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved. — R. S. 475.

**Employees — Number and Salaries.**

(For list of minor employees, salaries, etc., see R. S. 440 and amendments thereto, and also the several appropriation acts of Congress).

**Library — Purchase of Books.**

There shall be purchased for the use of the Patent Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose.

For purchase of professional and scientific books and expenses of transporting publications of patents issued by the Patent Office to foreign governments, two thousand five hundred dollars. — R. S. 486 and Act Feb. 3, 1905.



**Officials — Appointment of.**

There shall be in the Patent Office a Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employes authorized by law for the office shall be appointed by the Secretary of the Interior, upon the nomination of the Commissioner of Patents. — R. S. 476.

**Publications — Law and Decisions.**

The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public. — R. S. 489.

**Seal of — Authentication by.**

The seal heretofore provided for the Patent Office shall be the seal of the Office, with which letters patent and papers issued from the Office shall be authenticated. — R. S. 478.

**Secretary of the Interior — Charged with Supervising.**

The Secretary of the Interior is charged with the supervision of public business relating to the following subjects:

\* \* \* \* \*

Fifth. Patents for inventions. — R. S. 441.

**PRIORITY****Between Applicants — Applicant and Patentee.**

(See Interferences, R. S. 4904).

**Interfering Patents.**

(See Interfering Patents, R. S. 4918).

**PROCESS****Patentability of.**

(See Invention, R. S. 4886).

**PROFITS****General Provision.**

The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its

direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

But in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action. — R. S. 4921.

*Articles imported from abroad.* — *Measure of damages.* — Boesch v. Graff, 133 U. S., 697.

*Compensatory damages.* — Birdsall v. Coolidge, 93 U. S., 64.

*Court will not interfere to enjoin a pending suit at law, much less the bringing of one in the future.* — Hapgood v. Hewitt, 119 U. S., 226.

*Decree against all defendants.* — Hohorst v. Hamburg Am., 148 U. S., 262.

*Effect of laches on right to preliminary injunction.* — Keyes v. Eureka, 158 U. S., 150; Russell v. Kern, 69 F. R., 94.

*Effect of expiration of patent before final decree.* — Beedle v. Bennett, 122 U. S., 71; Clark v. Wooster, 119 U. S., 322.

*Infringement by equivalents.* — Seymour v. Osborne, 11 Wall., 516. Gould v. Rees, 15 Wall., 187. Cawood Patent, 94 U. S., 695.

*Infringer's liability.* — Mowry v. Whitney, 14 Wall., 620. Philp v. Nock, 17 Wall., 460. Packet Co. v. Sickles, 19 Wall., 611. Littlefield v. Perry, 21 Wall., 205; Mason v. Graham, 23 Wall., 261; Tremolo Patent, 23 Wall., 518; Burdell v. Denig, 92 U. S., 716. Mevs v. Conover, 11 O. G., 1111. Elizabeth v. Pavement, 97 U. S., 126. Marsh v. Seymour, 97 U. S., 348; Goulds v. Cowing, 105 U. S., 253; Crosby v. Safety Valve, 141 U. S., 441; McCreary v. Canal Co., 141 U. S., 459; Sessions v. Romadka, 145 U. S., 29; Consumer v. Am. Co., 50 F. R., 778.

*Liabilities of parties, maker, user, and seller.* — Birdsell v. Shaliol, 112 U. S., 485.

*Measure of damages.* — Garretson v. Clark, 111 U. S., 120; Black v. Thorne, 111 U. S., 122; Rude v. Westcott, 130 U. S., 152. Hurlbut v. Schillinger, 130 U. S., 456; Cornely v. Marckwald, 131 U. S., 159; Thomson v. Wooster, 114 U. S., 104; Clark v. Wooster, 119 U. S., 322; Seabury v. Am Ende, 152 U. S., 561; Warren v. Keep, 155 U. S., 265; Belknap v. Schild, 16 S. C. Reporter, 443; Holmes v. Truman, 67 F. R., 542; Hunt v. Cassidy, 53 F. R., 257; Sayre v. Scott, 55 F. R., 971; Keystone v. Adams, 151 U. S., 139; Coupe v. Royer, 155 U. S., 565; Tilghman v. Proctor, 125 U. S., 136; Tuttle v. Clafin, 76 F. R., 227; Mosher v. Joyce, 51 F. R., 441.

*Measure of damages, interest on damages.* — *Death of patentee during suit.* — Railroad v. Turrill, 110 U. S., 301.

*Not necessary to show recovery at law to warrant jurisdiction in equity for injunction.* — McCoy v. Nelson, 121 U. S., 484.

*Jurisdiction.* — Heaton Co. v. Eureka Co., 78 O. G., 171.

*Perpetual injunction granted.* — Safety Valve v. Steam Co., 113 U. S., 157.

*Violation of preliminary injunction.* — Warden v. Searles, 121 U. S., 14.

*Injunction.* — Am. v. National Co., 51 F. R., 229.

SEC. 2. That said courts [U. S. district courts], when sitting in equity for the trial of patent causes, may impanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises as may, from time to time, be made by the Supreme Court, and submit to them such questions of fact arising in such cause as such circuit court shall deem expedient.

And the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with such findings. — Act Feb. 16, 1875.



**PRINTING****Papers Filed.**

The Commissioner of Patents may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them. — R. S. 488.

**PUBLICATION****Claims, Laws, Decisions.**

The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public. — R. S. 489.

**Specifications and Drawings.**

The Commissioner of Patents is authorized to have printed, from time to time, for gratuitous distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent hereafter issued, together with suitable indexes, one copy to be placed for free public inspection in each capitol of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or Territorial capitols, and one in the Library of Congress, which copies shall be certified under the hand of the Commissioner and seal of the Patent Office, and shall not be taken from the depositories for any other purpose than to be used as evidence. [See § 894.] — R. S. 490.

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

**PUBLIC USE****Prior.**

(See Novelty — Prior Use, R. S. 4886).

**Prior Foreign Use — When Not a Bar.**

(See Anticipation — Prior Foreign Invention, R. S. 4923).

**PURCHASER****Article Made Before Application — License.**

(See Infringement — Article made before Application, R. S. 4899).

**QUESTION OF FACT**

**In Equity — Trial by Jury.**

(See Actions — Equity, R. S. 4921).

**RECORDS AND DOCUMENTS**

**Certified Copies — How Obtained.**

\* \* \* Any person making application therefor and paying the fee required by law, shall have certified copies thereof. — R. S. 892.

**Evidence — Patent Office Records.**

(See Evidence, R. S. 892).

**REDUCTION TO PRACTICE**

**General Requirements.**

(See R. S. 4886 and 4888).

**REISSUE**

**General Provision.**

Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. — R. S. 4916.



*Reissue must be for original invention.*

— Seymour v. Osborne, 11 Wall., 516. Littlefield v. Perry, 21 Wall., 205; Gill v. Wells, 22 Wall., 1; Union v. Van Dusen, 23 Wall., 530; Russell v. Dodge, 93 U. S., 460; Marsh v. Seymour, 97 U. S., 348; Powder v. Powder, 98 U. S., 126; Ball v. Langles, 102 U. S., 128; Garneau v. Dozier, 102 U. S., 230; James v. Campbell, 104 U. S., 356; Heald v. Rice, 104 U. S., 737; Johnston v. R. R., 105 U. S., 539; Wing v. Anthony, 106 U. S., 142. Gage v. Herring, 107 U. S., 640; McMurray v. Malloy, 111 U. S., 97-109; Cochrane v. Badische, 111 U. S., 203; Eachus v. Broomall, 115 U. S., 429; Worden v. Searls, 121 U. S., 14; Pattee v. Kingman, 129 U. S., 294; Flower v. Detroit, 127 U. S., 563; Farmers v. Challenge, 128 U. S., 506; Dunham v. Dennison, 154 U. S., 103; Olin v. Timkin, 155 U. S., 141; Lehigh v. Kearney, 158 U. S., 461; Pat. Clothing v. Glover, 141 U. S., 560; Freeman v. Asmus, 145 U. S., 226; Huber v. Nelson, 148 U. S., 270; Leggett v. Oil Co., 149 U. S., 287; Corbin v. Eagle, 150 U. S., 38; American v. Johnston, 52 F. R., 229.

*Can not proceed on original patent if reissue is void.* — Eby v. King, 158 U. S., 366.

*Defective specification, inoperative patent; mistake, laches, new matter, reinstatement of claims.* — Yale v. Berkshire, 135 U. S., 342.

*Disclaimer to new matter in reissue considered.* — Hurlbut v. Schillinger, 130 U. S., 456.

*Enlarged claim must be sought within two years.* — Topliff v. Topliff, 145 U. S., 156; Wollensak v. Reiher, 115 U. S., 96.

*Intervening rights.* — Lumber v. Rodgers, 112 U. S., 659; Clements v. Excavating, 109 U. S., 641-650; Turner v. Stamping, 111 U. S., 319; White v. Dunbar, 110 U. S., 47; Cornell v. Weidner, 127 U. S., 261; Brown v. Davis, 116 U. S., 237; Mahn v. Harwood, 112 U. S., 354; Ives v. Sargent, 119 U. S., 652; Newton v. Furst, 119 U. S., 373.

*Inadvertence or mistake.* — Coon v. Wilson, 113 U. S., 268; Yale v. James, 125 U. S., 447.

*Insufficient specification, accident or mistake, enlargement of claims.* — Earnes v. Andrews, 122 U. S., 40; Matthews v. Iron Clad, 124 U. S., 347.

*Matter purposely erased in original.* — Leggett v. Avery, 101 U. S., 256; Goodyear v. Davis, 102 U. S., 222; Cartridge v. Cartridge, 112 U. S., 624; Beecher v. Atwater, 114 U. S., 523; Crawford v. Heysinger, 123 U. S., 589; Dobson v. Lees, 137 U. S., 258.

*Question of fact settled by Commissioner.* — Seymour v. Osborne, 11 Wall., 516; Corn Planter Patent, 23 Wall., 181.

*Reissue for abandoned invention.* — Mfg. Co. v. Corbin, 103 U. S., 786.

*"The same invention" defined.* — Parker v. Yale, 123 U. S., 87-104.

*Unreasonable delay.* — Miller v. Brass Co., 104 U. S., 350; Matthews v. Mach. Co., 105 U. S., 54; Bantz v. Frantz, 105 U. S., 160; Johnson v. R. R. Co., 105 U. S., 539; Thomson v. Wooster, 114 U. S., 104-120; Gardner v. Herz, 118 U. S., 180; Hartshorn v. Saginaw, 119 U. S., 664; Gas Light v. Boston, 139 U. S., 481; Leggett v. Oil Co., 149 U. S., 287; Wollensak v. Sargent, 151 U. S., 221.

**Applications for — By Whom Made.**

(Must be made by inventor, R. S. 4888, 4896).

**Assignee — May be Granted to.**

(See Assignment Before Issue, R. S. 4895).

**Oath — By Inventor if Living.**

(See Oath, R. S. 4888, 4896).

**REJECTION****Application — Notice to Applicant.**

(See Application — Examination, R. S. 4903).

**RENEWAL****Forfeited Application.**

(See Application — Renewal of, R. S. 4897).

**RULES AND REGULATIONS****Patent Office — Establishment of.**

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.

**RULES****Taking Testimony — Commissioner to Establish.**

(See Evidence — Required by Patent Office, R. S. 4905).

**SECRETARY OF THE INTERIOR****Supervision of Patents — Charged with.**

The Secretary of the Interior is charged with the supervision of public business relating to the following subjects:

\* \* \* \* \*

Fifth. Patents for inventions. — R. S. 441.

**SPECIFICATIONS****Requirements Regarding — Specifications and Claims.**

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.

**Signing and Witnessing.**

(See Specifications, supra).

**SPECIMENS****May be Required.**

(See Compositions of Matter, R. S. 4890).

**SUBPOENAS****Witnesses.**

See Witnesses, R. S. 4906).



## UNPATENTED INVENTIONS

**Right of Purchaser or Maker to Use.**

Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. — R. S. 4899.

*Previously purchased machine can be no infringement during extension. — Paper Bag Mach. Cases, 105 U. S., 766.*

*What persons have the right to use. — Wade v. Metcalf, 129 U. S., 202. Dable v. Flint, 137 U. S., 41.*

## UTILITY

**Necessity of to Grant.**

\* \* \* And if \* \* \* it shall appear \* \* \* that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor. — R. S. 4893.

Any person who has invented or discovered any new and useful \* \* \* — R. S. 4886.

## WITNESSES

**Contempt — Evidence before Department.**

Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself. — R. S. 4908.

**Evidence before Department — Privileged Matter.**

\* \* \* But no witness shall be deemed guilty of contempt \* \* \* for refusing to disclose any secret invention or discovery made or owned by himself. — R. S. 4908.

**Fees — Evidence before Department.**

Every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending courts of the United States. — R. S. 4907.

**Subpoenas — Evidence before Department.**

The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any con-

tested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him. — R. S. 4906.



## APPENDIX

Covering cases reported since first edition, down to and including 225 U. S. and 194 Fed.

The section numbering is identical with the original, main chapter.

### ABANDONMENT.

#### § 2. General Rules.

The law provides that if the invention covered by a patent was in public use or on sale earlier than two years before the date of the application, the patent is invalid. The law is based upon the proposition that if an inventor permits the public to use the invention for more than two years, during which period he takes no steps to secure the monopoly for himself, he is presumed to have abandoned it. In other words, he cannot secure a patent and levy tribute upon or enjoin a use which he has constructively sanctioned for a period of two years. — *Corrington v. Westinghouse*, 178 Fed. 711; 103 C. C. A. 479.

The defense of constructive abandonment through prior sale first appeared in the patent act of 1836, which provided that a defendant might defend by showing that the thing patented "had been in public use or on sale with the consent and allowance of the patentee before his application for a patent." This provision was modified by the patent act of 1839, which provided that purchases and sales prior to the application for the patent should not invalidate it except on proof "that such purchase, sale or prior use had been for more than two years prior to the application." The consolidated patent act of 1870 (§§ 4920, 4886) provided that a defendant might show by way of defense that the patented device "had been in public use or on sale in this country for more than two years before his application for a patent." And this language has not been changed by the amendments of 1897 and 1903. — *National v. American*, 178 Fed. 79; 101 C. C. A. 569.

There is a distinction between abandonment of an invention and abandonment of an application. Abandonment of the invention was not pleaded. Abandonment of an invention being a question of intent, appellant, if it had pleaded the defense, would have had the burden of proving clearly that Schmertz and his successors in interest had such an intent. — *Western Glass v. Schmertz*, 185 Fed. 788; 109 C. C. A. 1.

*Western Elec. v. Sperry*, 58 Fed. 186; *International v. Kellogg*, 171 Fed. 651.

The invention was completed and used in 1897. Application for patent was not made until Feb. 10, 1900. The alleged anticipating device was made in the fall of 1898, and application filed Feb. 6, 1899. *Held*: Thus, if the above-mentioned device and use of Hill were anticipated in date by Reginer (patentee of patent in suit), they became public property through Hill's independent disclosure and dedication, pending such conduct of Reginer indicative of abandonment, and we believe any (assumed) invention therein on the part of Reginer must be treated as abandoned and unpatentable,

under the settled policy of the patent law. — *Handy Things v. Tucker*, 188 Fed. 68; 110 C. C. A. 138.

*Kendall v. Winsor*, 21 How. 322.

It is the general rule that abandonment of an invention is not to be presumed, but must be clearly proven. — *Sly v. Russell*, 189 Fed. 61; 110 C. C. A. 625.

*Ide v. Trorlicht*, 115 Fed. 137.

#### § 4. Amendment.

That when, by amendment, an applicant omits a feature of his invention as originally disclosed, it will be presumed that he considered it inoperative or worthless and abandoned, see — *Western Glass v. Schmertz*, 185 Fed. 788; 109 C. C. A. 1.

*Stoner v. Todd*, L. R. Ch. Div. 60, 46 L. J. Ch. 33.

#### § 5. Application — Abandonment and Renewal.

One application for a patent may be a continuation of a prior application for the same thing under certain circumstances. — *Model Bottling Mach. v. Anheuser-Busch*, 190 Fed. 573; 111 C. C. A. 389.

*Hayes-Young v. St. Louis*, 137 Fed. 80.

#### § 9. Division of Application.

Among the numerous cases cited we find none where it has been held that when a patent has been issued to a party for all he claimed in his application, the party may subsequently make a new application for a new patent upon omitted matters, and that such new application was a continuation of the first or original application, without surrendering the first patent and obtaining a reissue for the unexpired term of the first patent, as provided in § 4916. — *Model Bottling Mach. v. Anheuser-Busch*, 190 Fed. 573; 111 C. C. A. 389.

That division of an application or separate application upon a process and an apparatus does not work abandonment, one by the other, even though one or the other may have been abandoned, see — *Acme Acetylene v. Commercial*, 192 Fed. 321; 112 C. C. A. 573.

*Leeds v. Victor*, 213 U. S. 301.

While he abandoned his first application and substituted therefor a second, he did not abandon his invention. This substitution was proper procedure. We also find the substance of the second application had been embodied in the first. In that respect we have the action of the Patent Office, which, with full knowledge of the previous application, allowed such substitution and based its grant of the patent on the basis of the substantial identity of the two applications. The presumption that arises in such case must, as in a reissue, "only by showing from a comparison of the original specification with that of the reissue that the former does not substantially describe what is described and claimed in the latter." — *Clark Blade v. Gillette*, 194 Fed. 421; 114 C. C. A. 383.

*Godfrey v. Eames*, 1 Wall. 324; *Corrington v. Westinghouse*, 173 Fed. 76; *Smith v. Goodyear*, 93 U. S. 499.

#### § 10. Experimental Use.

In so far as the patentee exercised invention therein, it was completely formulated and disclosed in the machine of 1898 (application filed in 1903),



and it is immaterial that its operation was unsatisfactory to him, inducing frequent experiments to improve the combination. His undoubted election to use the invention, independently and commercially, over four years before application for a patent, followed by at least two years of such use in the first machine, constitutes an abandonment thereof to the public. — *Star v. Crescent*, 179 Fed. 856; 103 C. C. A. 342.

*Smith v. Sprague*, 123 U. S. 249; *Eastman v. Mayor*, 134 Fed. 844.

### § 11. Evidence of.

The burden was upon appellant to prove very clearly that the patentee meant to donate his invention to the public. — *International v. Kellogg*, 171 Fed. 651; 96 C. C. A. 395.

*Ide v. Trorlicht*, 115 Fed. 144.

### § 18. Public Use.

Manufacturing and delivering a machine upon an advance order indicate just as much an intention to abandon the invention as delivering it when completed upon an order then obtained. We think it would be altogether too technical and wholly out of accord with the purpose of the patent laws to hold that the manufacture and delivery of the machine upon an order obtained in advance amounted to anything different. In our opinion the disposition by an inventor for a pecuniary consideration of the article invented amounts to a "sale" within the meaning of the patent act, whether such disposition be made in accordance with a contract to manufacture such article or to sell it after manufacture. — *National v. American*, 178 Fed. 79; 101 C. C. A. 569.

## ACTIONS.

### § 25. To Compel Issue of Patent.

That an action brought under § 4915 R. S. asking for a decree upon a question of reissue and also upon an interference is multifarious, see — *Gould v. Gould*, 187 Fed. 273; 109 C. C. A. 615.

This case seems to establish the following:

1. That an action to compel issue is an original proceeding and is in no sense an appeal from the Department or from the Court of Appeals, D. C.

2. That the complainant may carry his date of invention back of that of the Patent Office proceeding and that in evidence before the Court of Appeals, D. C.

3. That to overcome the decision of the Patent Office as affirmed by the Court of Appeals, D. C. the complainant must introduce evidence which will overcome the presumption of finality of the decision of that court, and more. — *Greenwood v. Doyer*, 194 Fed. 91; 114 C. C. A. 169.

*Morgan v. Daniels*, 153 U. S. 120; *In re Hein*, 160 U. S. 432; *Maxwell Land Grant Case*, 121 U. S. 325; *United States v. Am. Bell Tel.* 167 U. S. 224; *Westinghouse v. Stanley*, 133 Fed. 167; *Brooks v. Sachs*, 81 Fed. 403.

### § 26. Cancellation of Patent.

Congress named certain permissible defenses, of which fraud and collusion in following the application to issuance is not one. Therefore a patent procured by fraud and collusion or by illegal procedure can be attacked only by the government. — *Western Glass v. Schmertz*, 185 Fed. 788; 109 C. C. A. 1.

*Gandy v. Marble*, 122 U. S. 432; *Mowry v. Whitney*, 14 Wall. 439; *Mahn v. Harwood*, 112 U. S. 354; *Ry. Register v. North Hudson*, 23 Fed. 593; *U. S. v. Am. Bell Tel.* 128 U. S. 315; *id.* 159 U. S. 555; *id.* 167 U. S. 224.

## ADJUDICATION.

## § 30. Patent Office Decisions.

In the interference proceedings, the respective rights of McBerty and Fowler to the issuance of a patent, were examined in succession by the Examiner of Interferences, the Board of Examiners in Chief, the Commissioner of Patents, and the Court of Appeals for the District of Columbia; and in each tribunal judgment of priority of invention was in favor of McBerty. To overcome these judgments, the proof must be clear and convincing — by evidence which shall strongly outweigh that of the respondent below, as put by Judge Putnam. — *Western Elec. v. Fowler*, 177 Fed. 224; 101 C. C. A. 394.

*Brooks v. Sachs*, 81 Fed. 403; *Morgan v. Daniels*, 153 U. S. 120; *United States v. Bell Tel.* 167 U. S. 224.

## § 31. Prior — Conclusiveness.

If the first Peckham company were privy to the decree declaring the patent void, there would be great force in the argument that that decree established, as against the plaintiff, the right of the Peckham Mfg. Co. to make and sell the patented article, and that the right ought to be recognized in a suit against its customer, defended by it. *Brill v. Washington*, 215 U. S. 527; 54 L. Ed. 311; 30 S. Ct. 177.

*Kessler v. Eldred*, 206 U. S. 285.

We are met at the outset with a decree of the Circuit Court for the Northern District holding in a contested case where the same claim was made, that this identical patent was valid. This decree being between other parties, does not constitute *res adjudicata*. We are not constrained to follow it upon any principle of *stare decisis*. Still we think an orderly administration of justice in patent causes requires, as a general rule, that when a patent, after a full hearing, has been declared by the Circuit Court to be valid and such decree has been affirmed by this court, we should follow the decision in a subsequent case involving the validity of the same patent, and not presenting any essentially different evidence, notwithstanding the claim of validity was not urged upon this court upon the prior appeal. — *Crier v. Innes*, 170 Fed. 324; 95 C. C. A. 508.

That where a patent has been finally held void, both the combination and the elements of the combination become public property; and a person exercising his right to their use may restrain the owner of the invalidated patent from threatening or harassing his customers, see — *Rubber Tire v. Goodyear*, 183 Fed. 978; 106 C. C. A. 318.

*Kessler v. Eldred*, 206 U. S. 285; *Young and Foerster*, 37 Fed. 203; *Morgan v. Albany*, 152 U. S. 425; distinguishing *Aspden v. Nixon*, 4 How. 467; *Birdsell v. Shaliol*, 112 U. S. 485.

That where a party had practically intervened and made himself a party to the defense so that estoppel would apply, and the patent was defeated, such party may restrain the owner of the defeated patent from bringing suits against his customers, see — *Marshall v. Bryant*, 185 Fed. 499; 107 C. C. A. 599.

*Columb v. Webster*, 84 Fed. 592; *United States v. California*, 192 U. S. 355; *Kessler v. Eldred*, 206 U. S. 285; distinguishing *Russell v. Place*, 94 U. S. 606.

For a partial ruling in applying *Kessler v. Eldred*, 206 U. S. 285, and certification of a doubtful question thereunder to the Supreme Court, see — *Hurd v. Seim*, 191 Fed. 832; 112 C. C. A. 346.



### § 37. *Stare Decisis.*

That the Supreme Court will not reverse findings of fact after concurrent decisions of the lower courts, see — *Rumford v. Hygienic*, 215 U. S. 156; 54 L. Ed. 137; 30 S. Ct. 45.

The case being here on substantially the same state of facts as in the former appeal, all questions of law determined on the first appeal become law of the case for courts and parties on the second. — *Penn v. Conroy*, 185 Fed. 511; 107 C. C. A. 611.

*Columbia v. Duff*, 184 Fed. 876.

This court would not depart from its former ruling on the patent in suit without satisfactory evidence of other facts which ought to induce a different conclusion in respect to the validity of the patent. — *Interurban v. Westinghouse*, 186 Fed. 166; 108 C. C. A. 298.

## ANTICIPATION.

### § 59. *General Rules.*

The only conclusion we have been able to reach is that we are not "satisfied beyond a reasonable doubt" that the alleged anticipating device was perfected and in use prior to the date of application. Inasmuch as the burden of thus satisfying the court rests upon the defendant, the defense of prior use is not made out. — *Moyer v. Metal Stamping*, 178 Fed. 830; 102 C. C. A. 504.

In determining the question of patentable novelty, there can be no hard and fast rule. Each case must be decided upon its own facts. — *Union Carbide v. Am. Carbide*, 181 Fed. 104; 104 C. C. A. 522.

### § 61. *Abandoned Device or Experiment — Non-Anticipating.*

That where a device disclosed in a preliminary specification is abandoned and omitted from the final specification, it will be presumed to have been inoperative and merely experimental, see — *Western Glass v. Schmertz*, 185 Fed. 788; 109 C. C. A. 1.

*Stoner v. Todd*, L. R. Ch. Div. 60, 46 L. J. Ch. 33.

### § 62. *Abandoned Device or Experiment — Application.*

An application for a patent pending in the office is not such a printed publication as the statute contemplates, and, indeed, is not a publication at all. — *Interurban v. Westinghouse*, 186 Fed. 166; 108 C. C. A. 298.

### § 63. *Analogousness — Art.*

Still we appreciate the substantial difference between the problem of propelling a boat and the motor vehicle problem and are not inclined to hold that this use constituted an anticipation, although it may properly be considered in determining the question of invention. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

That a machine for punching paper is not in an art analogous to that of punching steel beams, see — *Conley v. King Bridge*, 187 Fed. 137; 109 C. C. A. 412.

### § 64. *Analogousness — Use.*

It does not follow as a rule of law, that because the Gauthier sprinkler was used in sprinkling trees, and delivered the fluid in the form of mist, the

Wilgus sprinkler, which was used to sprinkle lawns, and delivered the water in drips, was not anticipated by the prior invention. — *Wilgus v. Germain*, 72 Fed. 773; 19 C. C. A. 188.

*Tucker v. Spalding*, 13 Wall. 453; *Smith v. Nichols*, 21 Wall. 112; *Machine Co. v. Murphy*, 97 U. S. 125; *Machine Co. v. Keith*, 101 U. S. 479.

### § 65. Anticipating an Anticipation — Burden of Proof.

The burden was on complainant to do so by satisfactory and convincing proof. She did not produce the inventor himself, who was the best witness on the issue. On the contrary, we are asked to believe the oral testimony of witnesses somewhat contradictory in itself, given many years after the event and unsupported by physical exhibits or other substantial or imperishable monument. Such testimony is not sufficient. — *Torry v. Hancock*, 184 Fed. 61; 107 C. C. A. 79.

*Clark v. Willimantic*, 140 U. S. 481; *Rogers v. Fitch*, 81 Fed. 403; *Eastern v. Continental*, 142 Fed. 479; *Kraatz v. Tiemen*, 79 Fed. 322.

That to anticipate an anticipation the burden is upon him asserting it to show prior conception and diligence in reduction to practice, see — *Sheffield v. D'Arcey*, 194 Fed. 686; — C. C. A. —.

*Barbed Wire Pat.* 143 U. S. 275; *Columbus v. Standard*, 148 Fed. 622; *Christie v. Seybold*, 55 Fed. 69; *Automatic v. Pneumatic*, 166 Fed. 288.

### § 68. Combining Old Elements — Different Patents.

It is no defense to a claim of an infringement that one or more elements of a patented combination, or one or more elements of a patented improvement, may be found in one old patent or publication, and others in another, and still others in a third. It is indispensable that all of them, or their mechanical equivalents, be found in the same description or machine, where they do the same work by substantially the same means. — *Owens v. Twin City*, 168 Fed. 259; 93 C. C. A. 561.

*Imhacuser v. Buerk*, 101 U. S. 647; *Bates v. Coe*, 98 U. S. 31; *Latta v. Shawk*, Fed. Cas. 8116; *Machine v. Pearce*, Fed. Cas. 4132; *Mfg. Co. v. Steiger*, 17 Fed. 250; *National v. American*, 53 Fed. 367; *Rhodes v. Lincoln*, 64 Fed. 218; *Packard v. Lacing*, 70 Fed. 66.

Defendants have ransacked patent offices in America and Europe. Piecing together excerpts and elements from this wide search, they have built up a formidable speculative argument to show how simple and easy was the step taken. This is a form of argumentation familiar in patent litigation. The patent law, however, has its proper place in the realm of actual industrial life, and not in the limboes of parchment casuistry. — *Naylor v. Alsop*, 168 Fed. 911; 94 C. C. A. 315.

If we assume the first seven features here mentioned are to be found in prior patents — that is, one feature in one patent and another feature in another patent, or substantially this — it would not in any way affect the validity of the combination covered by claim 3 of the Houghton patent. Under a familiar and well-settled rule the patentability of combination claims cannot be overthrown in this way. — *Whitin v. Houghton*, 178 Fed. 278; 101 C. C. A. 344.

It is urged that it did not involve inventive genius to make such changes in the apparatus of the above (cited prior) patents as to adapt them to the transmission of carriers under a vacuum system such as that of the patent in suit — that such alterations were within the competency of any one skilled in the art. Doubtless had the apparatus in question been seen and examined



by those skilled in the art, as disclosed by the above patents, and they had been asked to make such changes, they might have done so. But this circumstance fails to overcome the presumption of validity arising from the granting of the patent, coupled with the nature of the change necessary to be made to convert pressure despatch into vacuum despatch systems. — *Am. Pneumatic v. Snyder*, 180 Fed. 712; 104 C. C. A. 78.

These claims are for new combinations of old devices. They are of course not anticipated by the fact that a part of the old devices may be found in one and another part of them in a prior patent. The claim for such a combination is no more anticipated than it is infringed by a combination which lacks any one of its mechanical elements. Dissenting opinion of Judge Sanborn in — *Electric Protection v. American*, 184 Fed. 916; 107 C. C. A. 38.

#### § 71. Evidence of — Burden of Proof.

Prior use, in order to show anticipation of a patent, must be "proven by evidence so cogent as to leave no reasonable doubt in the mind of the court." *Mueller v. Glauber*, 184 Fed. 609; 106 C. C. A. 613.

*Deering v. Winona*, 155 U. S. 286; *Barbed Wire Patent*, 143 U. S. 275.

#### § 72. Evidence of — Device or Exhibit.

In *Writing Mach. v. Wagner*, 151 Fed. 576, we held that a model filed in the Patent Office, which is a full operative embodiment of the patented mechanism, may be considered upon the question of invention arising upon a subsequent patent. But we have never gone to the extent of holding that an unpleaded patent issued after the patent in suit may defeat the latter because the specification states that the application was filed prior to the application of the patent in suit. Assuming, that the specification and drawings may be considered, we think they are entitled to little weight unless supplemented by proof showing their condition at the time of filing and that no material changes have been made in either. We have nothing but the printed date on the specification that his device was made before Hobart's and nothing but inference to show that the specification and drawings were those originally filed. It would be a dangerous rule to establish that a patent granted in 1904 may be destroyed by the disclosures of a patent granted in 1905, the latter not being pleaded and no word of proof being offered as to what changes were made during the two years it remained in the Patent Office, inaccessible to the public. — *Roth v. Harris*, 168 Fed. 279; 93 C. C. A. 581.

#### § 74. Evidence of — Parol.

The oral testimony of many witnesses, if unsupported by any evidence consisting of documents or things, must be very reasonable or very strong to establish the defense of prior use. — *Parker v. Stebler*, 177 Fed. 210; 101 C. C. A. 380.

*Barbed Wire Pat.* 143 U. S. 275; *Deering v. Winona*, 155 U. S. 286; *Cantrell v. Wallick*, 117 U. S. 689; *Knickerbocker v. Rogers*, 61 Fed. 297; *Pratt v. Sencenbaugh*, 64 Fed. 779; *Wickes v. Lockwood*, 65 Fed. 610; *Singer v. Schenck*, 68 Fed. 191; *Emerson v. Van Nort*, 116 Fed. 974; *Pettibone v. Penn. Steel*, 133 Fed. 730.

It is true that prior use must be established beyond a reasonable doubt, but testimony must be weighed in a patent cause as in other cases, and the court is not permitted to reject arbitrarily the testimony of respectable witnesses because of mistakes and differences in nonessentials. — *Corrington v. Westinghouse*, 178 Fed. 711; 103 C. C. A. 479.

The testimony as to these alleged transactions in 1897 is entirely founded on the unaided memories of witnesses testifying 10 years after the event, and is not sufficient under well recognized rules to make out the alleged anticipation. — *Schwab v. Apstein*, 178 Fed. 91; 101 C. C. A. 455.

In order to defeat a patent by evidence of prior public use more than two years before the application for a patent is made by another, the proof must be very clear and definite, and as a general proposition it has been held that mere oral evidence, depending on the memory of the witness or witnesses, without the production of any visible sign or contemporary memoranda certainly fixing and defining the character of the alleged anticipating structure, will not be regarded as sufficient. Still it has been held that the rule is not inflexible, and upon the testimony of witnesses who are shown to be familiar with the thing or matter described, if it is so definite and specific in detail as to induce the court to feel that it is treading on safe ground, the fact may be established without the production of any tangible exhibit. — *Interurban v. Westinghouse*, 186 Fed. 166; 108 C. C. A. 298.

*Am. Roll-Paper v. Weston*, 59 Fed. 149.

The existence and use of an unpatented anticipating device prior to the invention patented may be established by oral testimony only by clear and satisfactory evidence, sufficient to prove the facts beyond a reasonable doubt. — *DeLaval v. Iowa*, 194 Fed. 423; 114 C. C. A. 385.

*Barbed Wire Pat.* 143 U. S. 275; *Mast v. Dempster*, 82 Fed. 327; *National v. Interchangeable*, 106 Fed. 693; *Am. Bank Protection v. Electric*, 181 Fed. 350.

#### § 77. Evidence of — Miscellaneous Holdings.

That a prior blueprint of a construction which is not proved to have been constructed or reduced to practice is not admissible to prove anticipation, see — *Morgan Engineering v. Alliance*, 176 Fed. 100; 100 C. C. A. 30.

It is a significant fact that, although he was the inventor of other devices and was at that time applying for patents thereon, he never filed an application for a patent on his truck, but, on the other hand, discarded his own invention and used appellee's. — *Parker v. Stebler*, 177 Fed. 210; 101 C. C. A. 380.

#### § 78. Experiment.

It is also quite clear that Wochler published a mere result of a laboratory experiment which was put to no practical use. Crystalline carbide, on the other hand, has been a great commercial success, and has furnished the foundation for important industries. — *Union Carbide v. Am. Carbide*, 181 Fed. 104; 104 C. C. A. 522.

#### § 87. Inoperative Device.

When the question is whether a prior system described and diagrammatically illustrated is practically operative, any doubt which arises should be resolved in favor of the working plan and against the paper plan. — *Hall v. General*, 169 Fed. 290; 94 C. C. A. 580.

A patent cannot be invalidated by a structure which can only be altered into an anticipation by the use of inventive skill. — *Waterbury v. Aston*, 183 Fed. 120; 105 C. C. A. 410.



The Crosby invention undoubtedly anticipates and describes the whole theory of the Pettit patent; but it does not appear ever to have been put to use, and there is no evidence that any machine was ever constructed under it. It is one thing to invent the theory of a machine. It is quite another thing to invent a successfully operating machine. In any view, the Pettit machine being the first successful machine to accomplish a new result, the claims of the patent are clearly entitled to a broad and liberal construction, and to the benefit of the doctrine of equivalents. — *Kings County v. U. S. Consolidated*, 182 Fed. 59; 104 C. C. A. 499.

*Deering v. Winona*, 155 U. S. 286.

It seems unnecessary to spend time in support of the proposition that a method of making a new and useful fabric is not anticipated by testimony that prior to the invention of this fabric a machine was in existence which, by a few changes in adjustment, was capable of producing the fabric had some one known enough to make them. Few patents could survive such a test as this. — *General Knit Fabric v. Steber*, 194 Fed. 99; 114 C. C. A. 177.

### § 88. Knowledge.

Whether he knew it in fact or not, he is conclusively presumed to have been entirely familiar with all the prior art as disclosed either by patents or prior devices; and the originality of his accomplishment must be determined in the light of this presumption. — *Torrey v. Hancock*, 184 Fed. 61; 107 C. C. A. 79.

*Voigtmann v. Weis*, 148 Fed. 848.

### § 91. Old Elements or Device — Requiring Adaptation.

It is not enough to constitute anticipation that the devices relied upon might, by a process of modification, reorganization, or combination with each other, be made to accomplish the function performed by the device of the patent sued on. — *Los Alamitos v. Carroll*, 173 Fed. 280; 97 C. C. A. 446.

*Western Elec. v. Home Tel.* 85 Fed. 649; *Dederick v. Cassell*, 9 Fed. 506; *Pattee v. Moline*, 9 Fed. 821; *Fuller v. Yentzer*, 94 U. S. 288; *Topliff v. Topliff*, 145 U. S. 156; *Rob. Pat.* § 282; *Walk. Pat.* § 62.

The situation is the oft-recurring one, where none of the prior devices anticipates the patent, but where, taking one element here and another there, all the elements of the patented combination may be found in the prior art, and where, by recasting prior structures in the light of the patented structure, something like it may be produced. \* \* \* The unified results and capabilities of the McKanna oiler are not mere aggregations of separate old devices having separate old results, but come from an integral, mechanically-true combination. — *Lavigne v. McKanna*, 194 Fed. 112; 114 C. C. A. 190.

### § 95. Prior Art — Sufficient.

That a statement in a patent that it is adapted to other uses than that specifically shown in the patent opens the door to examination of other arts suggested, see — *Safety Car Heating v. Consolidated*, 174 Fed. 658; 98 C. C. A. 412.

### § 97. Prior Patent — Insufficient.

That question is more wisely determined by the lesson of experience than by conjecture after the event. The record is full of proof of attempts to bring forth improved devices to serve the use, and yet in the 10 years between the

alleged anticipating patent and the patent in suit the eye of the mechanic never saw in the description of the prior patent, and his skill never reproduced from it, the simple, inexpensive, and effective device of the patent in suit. — *Wayne v. Benbow-Brammer*, 168 Fed. 271; 93 C. C. A. 573.

It is enough that a patent which was respected by competitors for 13 years and which covers a system which has been in successful operation during its entire life cannot be invalidated by the ambiguous language of a patent which has added nothing of value to the art. In such circumstances, unusually clear and perspicuous language is necessary. Success cannot be anticipated by failure. When the problem of aerial navigation is finally solved by the construction of a secure dirigible air-ship, it is safe to predict that the inventor's patent will not be invalidated by a prior structure, no matter how perfect it may be, which was never known to fly. — *Hall v. General*, 169 Fed. 290; 94 C. C. A. 580.

That a patent alleged to anticipate must not be vague, confused, indeterminate, must be reduced to practical form, and must be more than the naked assertion that a certain result can be accomplished, see — *American v. Leeds*, 170 Fed. 327; 95 C. C. A. 511.

*Standard v. Peters*, 77 Fed. 630; *Hanifen v. Godshalk*, 84 Fed. 649; *Coffin v. Ogden*, 18 Wall. 120; *Badische v. Kalle*, 104 Fed. 802.

That the fact that a prior patent may show the mechanical arrangement of the patent in suit, but not designed or used for the purpose of the patent, does not necessarily amount to anticipation, see — *Gray Tel. v. Baird*, 174 Fed. 417; 98 C. C. A. 353.

*Brill v. Third Ave.* 103 Fed. 289; *Canda v. Michigan*, 124 Fed. 486.

That a patent not a part of the prior art at the time of the filing of the application of the patent in suit cannot be availed of as an anticipation, see — *Gray Tel. v. Baird*, 174 Fed. 417.

*Bates v. Coe*, 98 U. S. 31; *Anderson v. Collins*, 122 Fed. 451; *Eck v. Kutz*, 132 Fed. 758; *Walk. Pat. § 70*; *Rob. Pat. § 331, n. 332, 334*; *Barnes v. Sprinkler*, 60 Fed. 605.

### § 98. Prior Patent — Sufficient.

It is obvious that the invention disclosed by Hilker's first patent is as important in determining questions of anticipation and patentable invention as if the invention and patent were those of a third person. — *Hilker v. U. S. Mop.* 191 Fed. 613; 112 C. C. A. 176.

*James v. Campbell*, 104 U. S. 356.

### § 100. Process — Machine.

But it is said that these patents were machine patents, and, being such, are impertinent as evidence of anticipation. A full and complete answer to this is that, though these patents were each for an apparatus, they fully disclosed the process, and upon the issue of the patents such process was published. — *Model Bottling Mach. v. Anheuser-Busch*, 190 Fed. 573; 111 C. C. A. 389.

### § 101. Process — Process Rule.

"You cannot apply the doctrine of mechanical equivalents to a chemical patent." (Quoted from 24 Pat. Des. & T. M. Cas. 365 in) — *Naylor v. Alsop*, 168 Fed. 911; 94 C. C. A. 315.



It is sufficient if in general aspects the two processes are the same and the difference in minor matters is only such as would suggest themselves to a person possessing ordinary skill in the art. — *Model Bottling Mach. v. Anheuser-Busch*, 190 Fed. 573; 109 C. C. A. 389.

### § 102. Process — Miscellaneous.

When it is sought to ascertain the state of the art by means of prior patents, nothing can be used except what is disclosed on the face of those patents. Such patents cannot be reconstructed in the light of the invention in suit, and then used as a part of the prior art. — *Naylor v. Alsop*, 168 Fed. 911; 94 C. C. A. 315.

An expert cannot take a process patent, which has never been applied industrially, and work the process in his laboratory, and discover therefrom something which is not disclosed on the face of the patent, and then transfer that experience back to the time of the patent and make it a part of the prior art. The trifling experiments of the laboratory shown by defendant's experts in this case, are not entitled to weight as against the teaching of this practical experience. — *Naylor v. Alsop*, 168 Fed. 911; 94 C. C. A. 315.

### § 103. Public Use — Sufficient.

The testimony as to the use by the defendant long prior to the date of the invention of the patent in suit was correctly admitted by the court below, on the ground that it was not the introduction of evidence as to prior use affecting the validity of the patent, but evidence tending to show the rightful use by defendant of the alleged infringing device, on the ground that it had used it long prior to the application for the patent. — *Baltimore & O. v. McCune*, 174 Fed. 991; 98 C. C. A. 561.

This use was not an abandoned experiment but an attempt to induce the railway company to equip the cars with the Brayton engine. The perfected structure was capable of practical use, although there was much room for improvement. It was not embryonic or inchoate. The combination of the engine, the drive, and the carriage was used in public, and thereafter it required the use of the imitative, and not of the inventive, faculties to claim, without modification, the same combination. The use of the engine in one vehicle pointed directly to its use in another vehicle. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

## APPEALS.

### § 111. Assignments of Error — Sufficiency.

There are but two assignments of error. The first alleges error in entering the order adjudging Grove guilty of contempt, and the second alleges error in the refusal of the court to deny the order. These assignments, though not sufficiently specific to conform to the best practice, are sufficient, we think, to justify our inspection of the record to ascertain whether there be in it any apparent error. — *In re Grove*, 180 Fed. 62; 103 C. C. A. 416.

### § 117. Decrees — Interlocutory — Defined.

No point is better settled in this court, than that an appeal may be prosecuted only from a final decree. The cases are numerous where appeals have been dismissed, because the decree of the Circuit Court was not final. . . . The decree in the case under consideration is not final, within the decisions of this court. The injunction prayed for was made perpetual, but there was a reference to a master to ascertain the damages by reason of the infringe-

ment; the bill was not dismissed, nor was there a decree for costs. — *Barnard v. Gibson*, 7 How. 650; 12 L. Ed. 857.

Distinguishing *Forgay v. Conrad*, 6 How. 201.

As to the individual defendants, the rule is that, where defendants are jointly sued with others, and the bill is dismissed as to some but is retained as to others for a final decree and accounting, the decree is not final and no appeal lies from the part dismissing the bill as to some of the defendants so jointly charged. — *Electric Protection v. American*, 184 Fed. 916; 107 C. C. A. 238.

*Hohorst v. Hamburg American*, 148 U. S. 262; *Stanley v. Roberts*, 59 Fed. 836.

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

That the question of infringement may be considered and determined upon an appeal from an interlocutory decree, see — *Highland v. Schmertz*, 178 Fed. 944; 102 C. C. A. 316.

*Smith v. Vulcan*, 165 U. S. 518; *Mast v. Stover*, 177 U. S. 485; distinguishing *Ex parte National*, 201 U. S. 156.

As the patent was sustained by the Circuit Court in the *Waring Case* and as the present record contains only the bill and affidavits used on the motion for the preliminary injunction, it is manifest that the validity of the patent is not now in issue and that the question of infringement is alone presented. — *Ferry-Hallock v. Herman*, 178 Fed. 550; 101 C. C. A. 230.

*Consolidated v. Diamond*, 157 Fed. 677.

When in such a suit (on different patents) the bill is sustained as to some of the patents but dismissed as to others by an interlocutory decree, no appeal lies from that part of the decree which dismisses the bill as to some of the patents until after the final decree. — *Electric Protection v. American*, 184 Fed. 916; 107 C. C. A. 238.

*Ex parte Enameling*, 201 U. S. 156.

### § 125. Exceptions — Master's Report.

As the transcript does not contain any of the evidence before the master, except as the same may be quoted in the master's report, his findings of fact, unless inconsistent with the evidence, as quoted by him, must be taken as conclusive. — *Maimen v. Union Special Mach. Co.* 187 Fed. 123; 109 C. C. A. 41.

### § 128. Finality.

Such being the construction of the contract by this court, it follows that the charge of the court below on the retrial was error, for it overlooked the scope of this court's former decision. The construction of this contract was a question which this court was required to pass upon when the case was here before. That question it decided. — *Columbia v. Duff*, 184 Fed. 876; 107 C. C. A. 200.

*Nat. Surety v. Kansas*, 182 Fed. 54; *Roberts v. Cooper*, 20 How. 467.

That the decision of the Court of Appeals, D. C. is not final upon the question of novelty, see — *Model Bottling Mach. v. Anheuser-Busch*, 190 Fed. 573; 111 C. C. A. 389.

*Butterworth v. Hoe*, 112 U. S. 50; *U. S. v. Duell*, 172 U. S. 576.



**§ 129. Findings.**

These concurring findings (of the master and the circuit court) are presumptively correct and must be permitted to stand, unless some obvious error has intervened in the application of the law, or some serious and important mistake has been made in the consideration of the evidence. — *Brown v. Lanyon*, 179 Fed. 309; 102 C. C. A. 497.

*Moffat v. Blake*, 145 Fed. 40; *Houck v. Christy*, 152 Fed. 612.

The testimony of the witnesses upon this issue is conflicting, and under a familiar rule the finding of the chancellor must prevail unless the defendant has succeeded in showing from the record that he has made a mistake in his deduction of this fact from the evidence. — *Century Electric v. Westinghouse*, 191 Fed. 350; 112 C. C. A. 8.

*Kimberly v. Arms*, 129 U. S. 512; *Tilghman v. Proctor*, 125 U. S. 136; *Furrer v. Ferris*, 145 U. S. 132; *Coder v. Arts*, 152 Fed. 943; *State of Iowa v. Carr*, 191 Fed. 257; *Brammer v. Schroeder*, 106 Fed. 918; *Anderson v. Collins*, 122 Fed. 451.

The question of infringement being one of fact, we might be justified in following, in the absence of manifest error, the finding of the court below. — *Krupp v. Midvale*, 191 Fed. 588; 112 C. C. A. 194.

*Continental v. Eastern*, 210 U. S. 405.

When the chancellor has considered conflicting evidence, and made his finding and decree thereon, they must be taken to be presumptively right; and unless an obvious error has intervened in the application of the law, or some serious mistake has been made in the construction of the evidence, they must be permitted to stand. — *DeLaval v. Iowa*, 194 Fed. 423; 114 C. C. A. 385.

*Tilghman v. Proctor*, 125 U. S. 136; *Kimberly v. Arms*, 129 U. S. 512; *Evans v. State Bank*, 141 U. S. 107; *Furrer v. Ferris*, 145 U. S. 132; *Warren v. Burt*, 58 Fed. 101; *Paxson v. Brown*, 61 Fed. 874; *Stuart v. Hayden*, 72 Fed. 402; *Coder v. Arts*, 152 Fed. 943.

When questions of fact are disposed of by the trier of the facts in an equity suit, his decision may be reviewed on appeal. When disposed of by the verdict of a jury, properly instructed, its decision on those points are not reviewable by the appellate court. — *Transit Development Co. v. Cheatham*, 194 Fed. 963; 114 C. C. A. 599.

*Heide v. Panoulias*, 188 Fed. 915.

**§ 131. Law Actions — What Considered On.**

That although the defendant failed to except to the refusal of the court to grant a motion for dismissal non obstante verdicto, the question will be considered on appeal, see — *Baltimore & O. v. McCune*, 174 Fed. 991; 98 C. C. A. 561.

Defendant's counsel now asks that he be allowed to reargue on this point, (a defense not raised on the trial) and to contend that the "court may take judicial notice that the patent is invalid for the reason stated." This should not be done. Plaintiff has had no opportunity to litigate that point, nor to put in evidence which might have avoided it. — *Heide v. Panoulias*, 188 Fed. 914; 110 C. C. A. 656.

Ordinarily the presence or absence of "invention" and "infringement" are questions of fact. When disposed of by the trier of the facts in an equity

suit, his decision may be reviewed on appeal. When disposed of by the verdict of a jury, properly instructed, its decisions on those points are not reviewable on appeal. — *Heide v. Panoulas*, 188 Fed. 914; 110 C. C. A. 656.

*Singer v. Cramer*, 192 U. S. 275; *Heald v. Rice*, 104 U. S. 737; *Bischoff v. Wethered*, 76 U. S. 812; *Keyes v. Grant*, 118 U. S. 25; *Royer v. Schultz*, 135 U. S. 319.

### § 133. Orders.

This appeal must be dismissed, because an order overruling a demurrer, and giving the defendant leave to answer, is not a final decision. — *Adriance v. National*, 101 Fed. 1005; 41 C. C. A. 675.

That an order dismissing a bill as to one party is not appealable until after final decree, see — *Gen. Electric v. Allis-Chalmers*, 194 Fed. 413; 114 C. C. A. 375.

*Hohorst v. Hamburg*, 148 U. S. 262; *Ex parte National*, 201 U. S. 158.

That where an injunction order has been vacated and a new order entered for the evident purpose of enabling the parties to appeal piecemeal as to matters involved in the accounting, the order will be reversed with direction to reinstate the original order of injunction on application, see — *Metzger v. Berlin*, 194 Fed. 426; 114 C. C. A. 388.

### § 136. Record — Stipulated.

While we have in the present case no bill of exceptions, we have a record made up by agreement of the parties. The agreement of counsel was not merely that the papers mentioned in their stipulation should be printed in the record, but that it should "constitute the record." This case differs in this respect from *Continental v. Murray*, 162 Fed. 873. — *In re Grove*, 180 Fed. 62; 103 C. C. A. 416.

The file wrappers of the patent in suit and of the Aston application were not printed in the record, but by stipulation between the parties the printing thereof was waived and the same were returned as exhibits. This was done without the consent of the court, and we are under no obligation to receive them. — *Waterbury v. Aston*, 183 Fed. 120; 105 C. C. A. 410.

### § 137. Record — Miscellaneous Rules.

A writ of error addresses itself to any defect apparent on the face of the record, provided the defect be pointed out in the assignment of errors, but the evidence taken in the case is no part of the record, unless, by some method known to the law, it is imported into the record. — *In re Grove*, 180 Fed. 62; 103 C. C. A. 416.

*Suydam v. Williamson*, 20 How. 427; *Storm v. U. S.*, 94 U. S. 76; *Insurance Co. v. Piaggio*, 16 Wall. 378.

That the records in other appeals taken by the defendant contain the necessary facts, and that these may be used in support of the appeal under consideration is without sanction, see — *Frank v. Bernard*, 185 Fed. 810; 108 C. C. A. 42.

The motion is, in effect, for a direction to the court of claims to certify the evidence to this court, and not its conclusions from the evidence. This is clearly in contravention of the rule of this court which requires the record on appeal from the court of claims to contain a finding by the court "of the facts in the case established by the evidence in the nature of a special verdict,



but not the evidence establishing it." — *United States v. Société Anonyme &c.* 224 U. S. 309; 56 L. Ed. 224; 32 S. Ct. 479.

§ 141. **Subject-Matter.**

As the ground of complaint insisted on in this court was not included in the grounds of complaint mentioned in the bill of complaint, and does not seem to have been presented to or argued before the Circuit Court, it should not be considered here. — *New Jersey Patent v. Schaefer*, 178 Fed. 276; 101 C. C. A. 540.

§ 143. **Supreme Court.**

In *Frasch v. Moore*, 211 U. S. 1, it was held that decisions in the court of appeals of the District of Columbia in appeals from the Commissioner of Patents under § 9 of the act Feb. 9, 1893, were interlocutory, and not final, and not reviewable by this court under § 8 of that act. Under § 4914 no opinion or decision of the court of appeals on appeal from the Commissioner precludes "any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question;" and by § 4915 a remedy by bill in equity is given where a patent is refused; and we regard these provisions as applicable in trademark cases under § 9 of the act Feb. 20, 1905. — *Atkins v. Moore*, 212 U. S. 285; 53 L. Ed. 514; 29 S. Ct. 390.

§ 144. **Miscellaneous Rules.**

It has been held by the supreme court that the omission to give a bond for costs at the time the appeal is taken does not necessarily avoid the appeal, and that the appellant may be allowed to file the bond afterwards, within a reasonable time. — *Schenck v. Diamond*, 73 Fed. 22; 19 C. C. A. 352.

While in some jurisdictions it has been held that a mere promise or agreement not to prosecute an appeal will not divest an appellate court of its jurisdiction, the contrary has been held in other jurisdictions; and it seems to be universally held that, where such an agreement is made upon a valid and legal consideration, either before or after trial, it will be enforced in an appellate court, and the appeal, if taken, will be dismissed. — *U. S. Consolidated v. Chaddock*, 173 Fed. 577; 97 C. C. A. 527.

*Sanders v. White*, 22 Ga. 103; *Fahs v. Darling*, 82 Ill. 142; *Runnion v. Ramsay*, 93 N. C. 410; *Townsend v. Masterson*, 15 N. Y. 587; *Cole v. Thayer*, 25 Mich. 212; *Oliver v. Blair*, 5 Pac. 917; *Saling v. Ger. Sav. Bk.* 8 N. Y. Supp. 469; *Commonwealth v. Johnson*, 6 Pa. 136; *Wheeler v. Floral*, 10 Nev. 200; *Hill v. Hermans*, 59 N. Y. 396; *Mackey v. Daniel*, 59 Md. 484; *Emerick v. Armstrong*, 1 Ohio. 513; *Johnson v. Halley*, 27 S. W. 750.

As to *this* court, when an order is "affirmed on the opinion of the court below," it approves the reasoning, adopts the findings and concurs in the conclusions of the court below. When, itself writing nothing, making no record of its findings as a court of appeals, it merely announces, "Order affirmed," it is to be understood that for some reason it prefers not to adopt the opinion of the court below, either that it has reached the conclusion by a totally different process of reasoning, or that, while in the main approving the opinion, there is something in it which the appellate court does not wish to approve. — *Victor Talking Mach. v. Hoschke*, 188 Fed. 326; 110 C. C. A. 304.



## ASSIGNMENT.

## § 151. Action to Compel.

Complainant, the owner of basic patents, entered into verbal agreements with defendants to promote a nation-wide industry and entered into a written agreement giving licenses for a specific territory. Much money and effort were put into the enterprise by both parties, but the basic patents proved ineffective. Defendants invented improvements, but refused to assign to complainant. Action brought to compel assignment of improvements patented and unpatented. *Held*: Before any case can be said to be made out, requiring appellants to assign their inventions, it must be shown that consciously, and knowing the effect of what they were doing, they expressly agreed to make the assignment. Persons are not to be deprived of their inventions merely because to retain them, under the circumstances, may appear unconscionable. The circumstances must include a contemplated assignment as their conscious act and deed. But such conscious act and deed is sufficiently shown, it seems to us, when it is made to appear that consciously, and knowing the effect of what they were doing, they became parties to a lawful undertaking that, to carry out the undertaking as an entirety, expressly involved, on their part, such an assignment. In other words, title will not be taken, by the courts, from the inventor, and given to another, upon a state of facts that does not involve proof that the inventor, consciously and knowing the effect of what he was doing, contemplated that the title should go to the other; the rule being to protect the inventor against everything except his conscious agreement. But it was not intended that he should thereby be circumscribed in what he consciously wished to do with his future inventions. The rule was to save him from advantage being taken of him by others. \* \* \* There existed, then, between these parties, as we view it, a relationship that made them, appellee as well as appellants, agents to a common enterprise — agents by agreement — the principal being the common enterprise itself; a relationship that, faithfully carried out by appellants, required them to put in the name of the appellee, but for the common enterprise, whatever they might invent in that line; and that, faithfully carried out by appellee, required that he extend (the appellants fulfilling their obligations) the scope of the common enterprise to include the whole of the United States — the specific option contracts being the mode employed. In what respect has this relationship failed: That appellants stand in a trustee relationship with respect to these inventions, to this common enterprise, we think is clear. That appellee stands, in relation to this common enterprise, as a trustee also, we think is clear. This clothes the court with power to enter a decree of some kind. It is the form of decree that remains to be determined. \* \* \* The fairest and most equitable thing, as it seems to us, is to deal with this common enterprise as we would with a dissolved partnership, giving to each of the separating parties, as nearly as possible, his interest in the assets that have grown out of the common enterprise. — *Nat. Wire Bound Box v. Healy*, 189 Fed. 49; 110 C. C. A. 613.

Marshall had, however, in violation of his contract, previously assigned patent 725,349 to the New Marshall Engine Co., which took with notice of the prior transfer. This company, therefore, held the legal title as trustee for the complainant. Under the circumstances the state court had jurisdiction to pass on the question of ownership, and to enter a decree requiring \* \* \* assignment in due form to the complainant. This jurisdiction was based on general principles of equity jurisprudence, and did not present a case arising under the patent law. It is, however, urged that the state court was ousted of jurisdiction to enter a decree for specific performance, because the bill went farther, and prayed that the defendants \* \* \* be enjoined.



\* \* \* The injunction was asked for only as an incident to a finding that the title was vested in the complainant. — *New Marshall Engine Co. v. Marshall*, 223 U. S. 473; 56 L. Ed. 513; 32 S. Ct. 238.

*Brown v. Shannon*, 20 How. 56; *Wilson v. Sanford*, 10 How. 99.

That where an inventor assigns the invention of one application to one party and thereafter assigns the invention of another application to another party which second application matures into a patent containing claims covering what was really the property of the purchaser of the first application, so long as the second application contains claims distinct from the first, an action to compel assignment by the owner of the second patent will not lie, see — *Gould Storage Battery v. Electric Storage Battery*, 192 Fed. 28; 112 C. C. A. 416.

#### § 157. Debtor and Creditor.

That a sheriff selling under execution, a trustee in bankruptcy, or a receiver under a creditor's bill can convey no title beyond that held by the debtor; and while he may be able to sell the physical object of the patent, such sale may convey no right to use, see — *Henry v. Dick*, 224 U. S. 1; 56 L. Ed. 645; 32 S. Ct. 364.

*Sawin v. Guild*, 1 Gall. 485; *Wilder v. Kent*, 15 Fed. 217; *Porter v. National*, 17 Fed. 536.

#### § 158. Evidence.

That where the search for a lost assignment has been thorough, it is not necessary that the complainant search the country over on mere conjecture in order to make a certified copy admissible, see — *Wayne v. Benbow-Brammer*, 168 Fed. 271; 93 C. C. A. 573.

#### § 160. Future Inventions — Legality.

That where parties embark upon a common enterprise under agreements which are general and comprehensive, a condition may exist which will create an equitable trust wherein both patented inventions and future inventions will be held trust property for the benefit of all the parties, after the manner of concluding a copartnership, see — *Nat. Wire Bound Box v. Healy*, 189 Fed. 49; 110 C. C. A. 613.

*Note:* This is believed to be a novel question and a leading case upon the question of future inventions and the powers of a court of equity in dealing with the titles to patents. See excerpt from this decision under § 151, and compare with cases referred to by the court: *Pressed Steel v. Hanson*, 137 Fed. 403; *American v. Wilson*, 198 Mass. 182; *Dalzell v. Dueber*, 149 U. S. 315; *Deane v. Hodge*, 35 Minn. 146; *Belcher v. Whittemore*, 134 Mass. 330; *Burr v. DeLaVergne*, 102 N. Y. 415; *Hapgood v. Hewitt*, 119 U. S. 226; *Solomons v. U. S.*, 137 U. S. 342.

#### § 164. Interests Assignable.

The defendant's patent cannot be split up; it must be transferred in its entirety (i. e., the claims cannot be split up). — *Gould Storage Battery v. Electric Storage Battery*, 192 Fed. 28; 112 C. C. A. 416.

#### § 168. Parol.

The general understanding and agreement between the parties was one thing; it fixed their relations to each other. The particular written agreements was another and different thing; they were only the *modus vivendi*

of carrying out the general understanding as business conditions and opportunity developed. There is no ground, therefore, for applying the rule of law that verbal conversations are merged in a subsequent written agreement; for these subsequent written agreements were not accepted or acted upon by the parties as a written embodiment of the verbal agreement. — *Nat. Wire Bound Box v. Healy*, 189 Fed. 49; 110 C. C. A. 613.

#### § 174. Specific Performance.

That where the assignment was made subject to a royalty and a provision that the assignee should use reasonable diligence in putting the apparatus to practical use, and the assignee failed to use any reasonable diligence whatever, the assignor is entitled to an accounting and a reassignment, see — *Neenan v. Otis Elevator*, 194 Fed. 414; 114 C. C. A. 376.

#### § 175. Territorial.

For a history of the law relating to the right to use, as distinguished from the right to make, including territorial rights, see — *Daimler v. Conklin*, 170 Fed. 70; 95 C. C. A. 346.

### CLAIMS.

#### § 186. Ambiguity.

A claim for a combination which embraces an element only in case it is made capable of being employed in the combination and without disclosing means of adapting it, discloses nothing definite. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

#### § 188. Construction — Beneficial Uses.

A patentee who has sufficiently described and distinctly claimed his invention is entitled to every use to which his device can be applied, whether he perceived or was aware of all of such uses at the time he claimed and secured his patent or not. — *Acme v. Meredith*, 183 Fed. 124; 105 C. C. A. 414.

*Stow v. Chicago*, 100 U. S. 547; *Roberts v. Ryer*, 91 U. S. 150; *Miller v. Eagle*, 151 U. S. 186; *National v. Interchangeable*, 106 Fed. 693.

#### § 189. Construction — Broad and Narrow.

Where a patent contains a general claim for a combination of certain mechanical elements and a specific claim for a combination of a specified form, combination, or construction of one of those elements with other elements of the general claim, the legal presumption is that the two claims secure different combinations, and the general claim is not limited to the specific form, composition, or construction claimed in the specific claim, but protects the element and its mechanical equivalents, though in form, composition, or construction differing from that of the specific claim. — *Owens v. Twin City*, 168 Fed. 259; 93 C. C. A. 561.

Progress in the inventive arts cannot be impeded by giving to a patent for an intricate mechanical combination a construction that will deny to anyone his right to make and use a combination essentially different from the patented combination, even though features of the new combination may have been suggested by the patented combination. — *Ohl v. Falstrom*, 175 Fed. 67; 99 C. C. A. 89.

There is nothing in the prior art that compels the restriction of the broad element of claim 1. Under such conditions, following our previous decision,



we give effect to all parts of the patent by enforcing a construction that makes both generic and specific claims effective. — *Freeman Co. v. General Electric*, 191 Fed. 168; 111 C. C. A. 646.

Following *Ryder v. Schlichter*, 126 Fed. 487.

### § 191. Construction — Dissecting.

It would indeed be arbitrary, as said by claimant, to read into the claim the specific metal of which those shells are composed "for no other purpose than to render it (the claim) worthless." — *United States v. Société Anonyme &c.*, 224 U. S. 309; 56 L. Ed. 224; 32 S. Ct. 479.

### § 193. Construction — Duplication.

It is true ordinarily that the employment of different words in separate claims indicates a purpose to secure distinct inventions; indeed, the rule is that "each claim of a patent covers a complete invention, and is, in substance, an independent patent." — *Twentieth Century v. Taplin*, 181 Fed. 96; 104 C. C. A. 156.

*Celluloid v. Zylonite*, 27 Fed. 291; *United Nickel v. California*, 25 Fed. 475; *Leeds v. Victor*, 213 U. S. 301.

### § 194. Construction — Equivalents.

It is, of course, clear that an inventor is not limited to the particular structure illustrated in his patent as the best form known to him provided his claim is broad enough to cover other or equivalent forms. If the claim in the present case could have been sustained as covering a combination of any hydrocarbon engine of the compression type with the other elements, the description in the specification of the modified Brayton engine would have been considered as a statement of the inventor's idea of the best form; but he would not have been confined to it, and the Otto improved engine would unquestionably have infringed. But we are unable to sustain the claim as so construed and could only hold it valid as being limited to a combination in which a Brayton modified or reorganized engine should be a member. The patent as so construed necessarily permits only a very limited range of equivalent forms. Being confined to an engine element of a particular class or type, an engine of another class seems almost barred by the interpretation itself. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

*Note:* This passage states the course of reasoning in the *Selden Automobile Case* perhaps as well as any single passage. In a nutshell, the Circuit Court held that Selden invented a motor car driven by a gas-engine of the compression type. In a nutshell, the Circuit Court of Appeals held that Selden invented a motor car driven by a particular species of gas-engine. If, as a matter of fact, the prior art showed that a motor car had been driven by the explosive force of a hydrocarbon, the Circuit Court was wrong and the Circuit Court of Appeals was wrong in holding the patent valid but limited. If the prior art did not so show, then the Circuit Court was right and the Circuit Court of Appeals was wrong. Selden's patent is for a generic invention, or nothing.

The evidence is not before me; but it seems to me self-evident that, if all that Selden did was merely to employ a Brayton engine in a combination that was old (as the appellate court holds), it is too plain for argument that he invented nothing — or at least nothing more than certain improvements upon the Brayton engine, which, possibly, might be patentable as an improvement in gas-engines. Suppose that, after a direct current motor had been employed to propel a street-car, when the alternating current motor



was invented, someone had patented and claimed the combination of a car, trolley connections, and an alternating current motor. Clearly such would be mere substitution. But this is precisely what the logic of the appellate court comes to. They say a vehicle had been driven by a gas-engine before Selden's time, and, therefore, his claim must be limited to a particular species of gas-engine.

Again, the Selden patent as a *genus* may be tolerated; it is doubtfully operable; it is commercially a monstrosity. As a *genus* — as the thing which pointed the way to a new field of industry — it may be viewed with patience. As a *species* — showing how to make a specific application of a known mechanical means — it is an utter absurdity. Either Selden was at the foundation of the automobile art and is entitled to the honors of a pioneer, regardless of his procrastination and failure to make any substantial addition to the art in any specific sense; or else he and his assigns have foisted upon the public, after years of cold-storage in the Patent Office and after years of utter lack of progress, a *species*, born out of time and out of joint. The Circuit Court may have been wrong on the facts; it may be that a gas-engine driven-vehicle was old in the art; such would seem to be the fact. The Circuit Court of Appeals may have been right on these facts; but its facts and its logic, as it seems to me, are sorely mismated.

The liberal construction allowed to pioneer inventions cannot be invoked in behalf of a patentee whose claim was limited to save it from anticipation by previous patents so as to broaden the claim and practically make it cover what was rejected in the Patent Office. — *Cotto-Waxo v. Perolin*, 185 Fed. 267; 107 C. C. A. 373.

*Royer v. Coupe*, 146 U. S. 524; *Phoenix v. Spiegel*, 133 U. S. 360.

### § 195. Construction — Expanding.

It would be grossly unfair to compel the builder of a practical working machine to pay tribute to one who added nothing of substantial value to the art, simply because the language of his claims is broad enough to include the successful structure. Claims should cover what the patentee has invented and not what he imagines he has invented. — *Lovell v. Seybold*, 169 Fed. 288; 94 C. C. A. 578.

To give the claim a broader application would be to depart from its own language as well as to wholly ignore the extracts from the specification which we have quoted. We cannot accede to the proposition that the patentee can, under any doctrine of equivalents, change or add to the circuit connections of the patent so as to make the apparatus work in a different way or under different conditions. — *Herzog v. N. Y. Telephone*, 176 Fed. 349; 99 C. C. A. 623.

We cannot, by construction, enlarge a claim of a patent beyond the fair meaning of its language. If a patentee discloses in his specification an invention not sufficiently covered by the claims of his patent, he may, if the limited character of the claim is the result of inadvertence, accident, or mistake, surrender his patent and apply for a reissue, with a claim or claims sufficiently definite and exact to cover the whole of his invention. If he fails to do that, the part of his invention outside the claims belongs to the public. — *Nu Bone v. Spirella*, 183 Fed. 984; 106 C. C. A. 324.

The specification may not be read into a claim for the purpose of changing it, or to escape anticipation, or establish infringement. — *Mueller v. Glauber*, 134 Fed. 609; 106 C. C. A. 613.

*Westinghouse v. Boyden*, 170 U. S. 537; *Gen. Sub-Construction v. Netcher*, 167 Fed. 549.



**§ 196. Construction — Functional.**

Whether a claim that is functional may be patentable where the specification discloses the means, see — *Arnold v. Tyden*, 193 Fed. 410; 113 C. C. A. 344.

*Paper Bag Case*, 210 U. S. 405.

**§ 199. Construction — Limitation — Broadening by Amendment.**

We have, then, a situation where a patent application made in the early stages of the electrical art to electric car service was promptly and properly rejected, and where the rightfulness of that rejection remained unchallenged some seven years, and, indeed, appears now unchallengeable if the disclosures then made constitute the sole ground for the patent. During this interim there was a rapid and general advance in the railway art, and when therefore a patentee, seven years after his original application and enlightened by such intervening years of progress, seeks not to prosecute his original application, but to amend the same, and on the basis of such amendment to make claims of a different character from those originally made, it becomes the duty of a court to zealously and jealously scrutinize such belated application, for to such a situation is applicable the principle laid down in *Railway v. Sayles*, 97 U. S. 563, and *Corbin v. Eagle*, 150 U. S. 43. — *Hestonville v. McDuffee*, 185 Fed. 798; 109 C. C. A. 606.

**§ 201. Construction — Limitation — By Applicant.**

Where an applicant for a patent materially modifies a claim in accordance with a requirement of the Patent Office, it will not be construed as it would have been if it had not been thus modified. And this is so though such modification was made under protest, accompanied by notice that applicant would insist that the modification would be construed away after the grant of the patent; and such is the law even though the decision of the Patent Office was erroneous. — *Johnson v. Western*, 178 Fed. 819; 102 C. C. A. 267.

*Phoenix v. Spiegel*, 133 U. S. 360; *Thomas v. Roker*, 77 Fed. 431; *Macbeth v. Gillinder*, 54 Fed. 170; *Lapham-Dodge v. Severin*, 40 Fed. 763; *Keystone v. Phoenix*, 95 U. S. 274; *Computing v. Automatic*, 204 U. S. 609; *Brill v. St. Louis*, 90 Fed. 666; *Westinghouse v. Boyden*, 170 U. S. 537.

That a statement made by the patentee subsequent to the granting of the patent as to the scope of the claims is not evidence of limitation, see — *Bossert v. Pratt*, 179 Fed. 385; 103 C. C. A. 45.

**§ 202. Construction — Limitation — Elements of Claim.**

In patents for a combination (combinations?), 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. — *Electric Protection v. American*, 184 Fed. 916; 107 C. C. A. 238.

*Fay v. Cordesman*, 109 U. S. 408.

*Note:* This case, in my opinion, illustrates the misapprehension and misapplication of this rule. Judge Sanborn, in his dissenting opinion, has noted this fact.

**§ 203. Construction — Limitation — Failure to Claim.**

A great idea may be embodied in a patent, and yet the patentee take nothing of value by it. That which he takes is that which he describes and claims. His discovery may be of importance, but he may limit it by his claim, and his claim may proceed in the wrong direction. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

That although an invention may disclose novelty in the process of producing the manufacture, the claim being for the article cannot be sustained on the ground of the novelty of the process, see — *Ashley v. Tatum*, 189 Fed. 357; 111 C. C. A. 279.

A patentee who limits his claims to the precise construction shown and described, even though not obliged to do so, cannot hold as an infringer one who uses a different construction. — *Morse Chain v. Link Belt*, 189 Fed. 584; 110 C. C. A. 564.

**§ 204. Construction — Limitation — General Rules.**

It is of the essence of the rule whereby the inventor is estopped from claiming to the full of his invention as disclosed by his specifications and claims in consequence of his concessions to meet the requirements of the Patent Office and so obtain his patent, that the requirements which were conceded by him should concern the matter upon which the estoppel is raised. The estoppel must rest upon a definite basis. If the examiner discloses his objection, we can see what it is, and know the consequence of a concession to it. If he does not do this, and contents himself with a reference, we look to the matter referred to, to ascertain his meaning. Either in the one way or the other the examiner must point out what his objection means. If his objection is not put upon the ground whereon the patentee is alleged to be estopped, it is obvious that the concession made to meet it would be a concession only of an entirely irrelevant matter. — *Vrooman v. Penhollow*, 179 Fed. 296; 102 C. C. A. 484.

*Hillborn v. Hale*, 69 Fed. 958; *Owens v. Twin City*, 168 Fed. 259.

It does not necessarily follow from the fact that the claim describes a specific form of construction, that the inventor shall be limited to that form. All depends upon his expressed intention, and the scope of the actual invention when it was made. If his improvement is but a narrow one, or if he has used language such as clearly to show his intention to limit his invention to a particular form described, then he is held to the language of his claim, and limited to the specific form. But if his is a pioneer invention, or one of such merit as to be entitled to a liberal construction, the claims will not thus be limited, even if couched in specific language, unless the inventor has also shown his positive intention to relinquish to the public all other forms in which his invention might be embodied. — *Kings County v. U. S. Consolidated*, 182 Fed. 59; 104 C. C. A. 499.

*Winans v. Denmead*, 15 How. 330; *Western v. La Rue*, 139 U. S. 601; *Hoyt v. Horne*, 145 U. S. 302; *Sessions v. Romadka*, 145 U. S. 29; *McCormick v. Aultman*, 69 Fed. 371.

**§ 205. Construction — Limitation — Improvement.**

We cannot assent that the patent is a "basic or pioneer patent and entitled to be construed accordingly," but rather a patent for a combination of elements already in use; and, this being true, the patent is not entitled to a broad and liberal construction, but, on the contrary, the range of in-



fringing equivalents must be restricted to those which perform the same functions in the same way. — *St. Louis v. Sanitary*, 178 Fed. 923; 103 C. C. A. 565.

*Sargent v. Lock Co.*, 114 U. S. 63; *Shepard v. Carrigan*, 116 U. S. 593; *Carter v. Hanes*, 70 Fed. 859.

*Note:* The "range of infringing equivalents," stated by the court, is a peculiar statement. When we come to refine equivalents to "infringing" and non-infringing, we are getting to a rather fine point.

That where the prior art shows that the claim is merely an improvement, there is no room for construction, see — *Jackson v. D'Arcey*, 181 Fed. 340; 104 C. C. A. 170.

*Keystone v. Phoenix*, 95 U. S. 274; *Burns v. Meyer*, 100 U. S. 671; *Duff v. Sterling*, 107 U. S. 636; *Wells v. Curtis*, 66 Fed. 318; *Ludington v. Leonard*, 119 Fed. 937.

#### § 206. Construction — Limitation — Narrow Improvement.

Were we dealing with a broad, generic invention, these differences might be considered negligible, but they cannot be ignored when considering claims which are limited to the structures described and are not entitled to a wide range of equivalents. — *Corrington v. Westinghouse*, 178 Fed. 711; 103 C. C. A. 479.

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

That where an applicant makes the form of construction a condition to obtain a claim he is limited to that exact form, see — *Campbell v. Am. Shipbuilding*, 179 Fed. 498; 103 C. C. A. 122.

*Werner v. King*, 96 U. S. 218; *Safety Oiler v. Scovill*, 110 Fed. 203; *Brill v. St. Louis*, 90 Fed. 666; *Am. Stove v. Cleveland*, 158 Fed. 978; *Morgan v. Albany*, 152 U. S. 425; *Am. Graphophone v. Universal*, 151 Fed. 595; *Roemer v. Peddie*, 132 U. S. 313; *Shepard v. Carrigan*, 116 U. S. 593.

That where an applicant has acquiesced in the narrowing of a claim to avoid anticipation, he cannot afterwards broaden it by construction to cover infringement, see — *Underwood v. Typewriter*, 180 Fed. 726; 104 C. C. A. 92.

It is hard to perceive any difference in principle between acceptance of a limitation made in the Patent Office through change of a single claim, and acceptance of a limitation imposed upon that claim through denial of other claims of the same application. Of course it would generally be more difficult definitely to work out an estoppel in the latter case than in the former; and it must be conceded that estoppel will not lie in either of the cases suggested, unless the elements are definitely traceable to the inventor through his acquiescence in adverse action taken in the Patent Office. — *Twentieth Century v. Taplin*, 181 Fed. 96; 104 C. C. A. 156.

*Vrooman v. Penhollow*, 179 Fed. 296; *Bundy v. Detroit*, 94 Fed. 524; *U. S. Repair v. Assyrian*, 183 U. S. 591; *id.* 100 Fed. 965.

If claim 1 had itself been changed so as definitely to limit its scope to the swinging bail, acquiescence therein on the part of the inventor would manifestly have estopped him from using any other device than the bail to support or operate the dumping portion of his grate, no matter whether any-

thing in the prior art requires such a limitation or not. — *Twentieth Century v. Taplin*, 181 Fed. 96; 104 C. C. A. 156.

*Campbell v. Am. Shipbuilding*, 179 Fed. 498; *Brown v. Stilwell*, 57 Fed. 731; *Corbin v. Eagle*, 150 U. S. 38; *Royer v. Coupe*, 146 U. S. 524; *Hubbell v. U. S.* 179 U. S. 77.

A claim narrowed to meet rulings of the Patent Office does not resume its expansiveness when the patent is secured. — *Am. Disappearing Bed v. Arnaelsteen*, 182 Fed. 324; 105 C. C. A. 40.

It is settled by the repeated decisions of the Supreme Court and of this court that, when an inventor seeking a patent for a broad claim acquiesces in a rejection of the same by the Patent Office and substitutes therefor a narrower one, he will not be heard to insist that the construction of the claim allowed shall include that which has been rejected; also, that a claim as allowed under such circumstances must be construed with reference to the rejected claims and the prior state of the art, and will not be so interpreted as to cover either what was rejected by the Patent Office or disclosed by prior devices. — *Boss v. Thomas*, 182 Fed. 811; 105 C. C. A. 243.

*Corbin v. Eagle*, 150 U. S. 38; *Computing v. Automatic*, 204 U. S. 609; *National v. Interchangeable*, 106 Fed. 693; *St. Louis v. American*, 156 Fed. 574.

It is not necessary to enquire whether the inventor was entitled to broader claims than he has received. The fact that he acquiesced in the ruling of the examiner and accepted the limited claims here in issue estops him from now claiming what he formally abandoned. — *Winchester v. Peters*, 184 Fed. 333; 106 C. C. A. 363.

Where a patentee on the rejection of his application inserts 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 and restrictions were not contained in it. — *Cotto-Waxo v. Perolin*, 185 Fed. 267; 107 C. C. A. 373.

*Corbin v. Eagle*, 150 U. S. 40; *Roemer v. Peddie*, 132 U. S. 313; *Electric v. Boston*, 139 U. S. 481; *Sutter v. Robinson*, 119 U. S. 530.

The rule is well settled that where an applicant for a patent acquiesces in the rejection of the claims presented, and amends the same or substitutes others to meet the objections of the Patent Office, he must be deemed to have surrendered and disclaimed what he thus conceded, and is bound by the limitation so imposed. — *Sly v. Russell*, 189 Fed. 61; 110 C. C. A. 625.

*Shepard v. Carrigan*, 116 U. S. 593; *Roemer v. Peddie*, 132 U. S. 313; *Morgan v. Albany*, 152 U. S. 425; *American v. Cleveland*, 158 Fed. 978; *Campbell v. American*, 179 Fed. 498; *Twentieth Century v. Taplin*, 181 Fed. 96.

*Note:* The rule thus stated is rather too broad, and is properly qualified by the court in the same paragraph.

Claim 11, as originally drawn, omitted the limiting phrase \* \* \*. That phrase was inserted by amendment to distinguish it from French patent No. 157,852, on which it had been rejected. As the element here referred to has the same limiting phrase in each of the four claims, and as that phrase was inserted in claim 11 to obtain it, it follows that the limitation cannot be read out of the claim, or, indeed, out of claims 8, 9, or 10, in order to hold the defendants as infringers. — *Tabor Co. v. Mumford Co.* 191 Fed. 166; 111 C. C. A. 644.



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

If a patentee acquiesces in the rejection of his claim on references, he may be estopped to maintain that an amended claim covers the combinations shown in those references, or that it has the breadth of the rejected claim, but he is not estopped from claiming and securing by the amended claim every improvement and combination which he has invented and which was not disclosed by those references. — *Owens v. Twin City*, 168 Fed. 259; 93 C. C. A. 561.

*National v. Interchangeable*, 106 Fed. 693.

While the rejection on the reference and the subsequent amendment may estop the complainant from claiming the improvements shown in the reference, they do not estop it from claiming and securing every improvement and combination which the patentee invented that was not disclosed by the reference. — *Wayne v. Benbow-Brammer*, 168 Fed. 271; 93 C. C. A. 573.

*National v. Interchangeable*, 106 Fed. 693; *Owens v. Twin City*, 168 Fed. 259.

The inventor is required by the statute to point out the best mode in which he has contemplated the application of the principle of his invention. But this does not preclude him from claiming any other mode which embodies his principle. \* \* \* His drawings show such a form. He could have no objection to claiming his invention in that form, and accordingly accepted the suggestion of the examiner. The examiner saw that this was the inventor's preferred form, and recommended that the claim of his invention be in that form. We see nothing in these circumstances which would work a limitation any more than if he had originally so described his cutting roller. \* \* \* We do not doubt that where the thing described in a claim has been declared by the inventor to be the only one, or has treated it as the only one appropriate to represent his invention, or the character of the associated elements is such as necessarily to require that particular form, in all such cases the patentee will be bound by his description. But where there are no such considerations, and there is simply and only a description of one form of a thing which would perform the same office in other forms, the court will apply the general rule above stated and accord him his monopoly in all equivalent forms. — *Vrooman v. Penhollow*, 179 Fed. 296; 102 C. C. A. 484.

*Werner v. King*, 96 U. S. 218.

While acquiescence in the rejection of claims on references in the Patent Office and the acceptance of a patent on amended claims estops the patentee from maintaining that the amended claims secure to him a monopoly of the use of the devices shown in the references, that is the limit of the estoppel. He is not estopped thereby from securing by amended claims every novel and useful device, composition, and process that he has discovered or invented that is not disclosed by these references. Dissenting opinion of Judge Sanborn in — *Cotto-Waxo v. Perolin*, 185 Fed. 267; 107 C. C. A. 373.

*National v. Interchangeable*, 106 Fed. 693.

Of course, the acquiescence in the rejection of a combination of elements in general terms is not an abandonment of a combination of the same elements limited to specific construction and location, for in the specific construction and location may reside invention. — *Moneyweight v. Toledo*, 187 Fed. 826; 109 C. C. A. 585.



A patentee who, in order to avoid a rejection of his application, inserts limitations in his claims, is estopped from contending that the patent as issued should be construed as if such limitations had not been made. But, as a general rule, the interpretation to be placed upon the claims and specification of a patent is to be determined from the language of the grant, and the proceedings in the Patent Office are quite immaterial. Such is the situation in the present case. Original claims were rejected in the Patent Office. Thereupon the applicants, instead of limiting their claims, substituted broader ones which were accepted. Presumably the examiner changed his mind. But whatever the explanation of his position, nothing whatever is shown to work an estoppel against the patentees. Instead of surrendering something which they now claim to obtain that which was allowed, they claimed something more and got it. — *Westinghouse v. Condit*, 194 Fed. 427; 114 C. C. A. 389.

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

Though such modification was made under protest, accompanied by notice that the applicant would insist that the modification would be construed away after the grant of the patent, and such is the law even though the decision of the Patent Office was erroneous. — *Johnson v. Western*, 178 Fed. 819; 102 C. C. A. 267.

*Phoenix v. Spiegel*, 133 U. S. 360; *Thomas v. Rucker*, 77 Fed. 431; *Macbeth v. Gillinder*, 54 Fed. 170; *Lapham-Dodge v. Severin*, 40 Fed. 763.

**§ 212. Construction — Limitation — Specification and Drawings.**

That where the claims use broader language as to the action or function of the invention than the specification, the specification must govern, see — *Zinn v. Auto Strop*, 175 Fed. 78; 99 C. C. A. 100.

Can the patentee rightfully include in his claims something that does not emerge from the description? Can a patentee describe something to the world in his letters patent that means just that thing or its equivalents and nothing else, and having claimed that, claim in addition something not thus described and not its equivalents? We think not. The description is required to set forth the invention in such full, clear, concise and exact terms as to enable any person, skilled in the art to which it appertains, or with which it is most nearly connected, to make and use the same; and the claim is to enable the public to know the bounds and scope of the invention "thus described;" but "any claim which is broader than the described invention is void; even where the invention is valuable, and could have supported a valuable claim." — *Walk. Pat. (4th Ed.)*, § 177, citg. *Edison v. American*, 114 Fed. 934.

There is nothing in *Winans v. Denmead*, 15 How. 330, or the *Paper Bag Case*, 210 U. S. 405, nor in any of the rules of law cited ("that the claims of every patent should be construed, if possible, to cover and protect the actual invention made by the patentee, and should not be restricted to the particular form of device disclosed in his patent, if other forms may embody it," or that "the patentee's claim is the measure of his invention," or that "where the claims of a patent are clear and unambiguous, there is no room for construction") that contravenes what has just been said; for what is said in both of these cases, and in all of the rules, is based on the fact that the inventive concept is disclosed in the description, whatever may have been the mechanical form that such concept subsequently took. Certainly it was not intended by these cases or these rules that an inventive concept,



that is separate and apart from the one embodied in the description, should become a part of the patent simply by being included in the claims. — *State Bank v. Hillmans*, 180 Fed. 732; 104 C. C. A. 98.

*Note:* This is believed to be a wholesome clearing-up of much loose statement, usually under shield of "beneficial uses." See §§ 188, 598.

The description in a specification or drawings of details which are not, and are not claimed as, essential elements of a combination, is the mere pointing out of the better method of using the invention. Dissenting opinion of Judge Sanborn in — *Electric Protection v. American*, 184 Fed. 916; 107 C. C. A. 238.

*Boston v. Allen*, 91 Fed. 248; *National v. Interchangeable*, 106 Fed. 693; *Owens v. Twin City*, 168 Fed. 259; *Continental v. Eastern*, 210 U. S. 405.

Claims cannot be broadened by construction beyond what is reasonably necessary to accomplish the stated primary object of the patent. — *American Stoker v. Underfeed*, 188 Fed. 314; 110 C. C. A. 292.

The specification which forms a part of the same application as the claims must be read and interpreted with them, not for the purpose of limiting, or of contracting, or expanding, the latter, but for the purpose of ascertaining from the entire agreement, of which each is a part, the actual intention of the parties, and that intention when ascertained should prevail over the dry words and inapt expressions of the contract evidenced by the patent, its specification and claims. — *Century Electric v. Westinghouse*, 191 Fed. 350; 112 C. C. A. 8.

*Seymour v. Osborne*, 11 Wall. 516; *National v. Interchangeable*, 106 Fed. 693; *Jewell v. Jackson*, 140 Fed. 344; *Louden v. Janesville*, 148 Fed. 686; *Electric Machine v. Morris*, 156 Fed. 972; *Lewis v. Premium*, 163 Fed. 950; *Fullerton v. Anderson-Barngrover*, 166 Fed. 443.

### § 213. Construction — Limitation — State of Art.

A claim in a patent as allowed must be read and interpreted with reference to the claims that have been rejected and to 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. — *Cotto-Waxo v. Perolin*, 185 Fed. 267; 107 C. C. A. 373.

*Hubbell v. U. S.* 179 U. S. 77; *Computing v. Automatic*, 204 U. S. 609.

### § 214. Construction — Limitation — Words of Limitation.

In construing claims, whether or not the phrase "substantially as described" is repeated in each one, the first, and generally the best source of information is the specifications. — *Am. Specialty v. New England*, 176 Fed. 557; 100 C. C. A. 193.

We think that undue significance was attached by the court below to the phrase "substantially as described." The complainants certainly are not by any descriptive language in the claims of either of them restricted to the precise form or forms of closure mechanism set forth in the patent description. Nor does the description state directly or indirectly that the patentees were to be confined to such particular form or forms of closure mechanism. — *Am. Pneumatic v. Snyder*, 180 Fed. 712; 104 C. C. A. 78.

That where the claim employed the term "means" in a general way, and on rejection and reference to prior patent that term was restricted to

a specific and designated means, the claim is so limited, see — *Twentieth Century v. Taplin*, 181 Fed. 96; 104 C. C. A. 156.

**§ 220. Construction — Reading in Elements.**

That where an element obviously essential to a combination and obviously implied is omitted, it may be read into the claim, see — *Herman v. Youngstown*, 191 Fed. 579; 112 C. C. A. 185.

**§ 222. Construction — Rules — General.**

The rules applicable to the construction of these claims are: (1) That we cannot read into a claim for a combination an element not mentioned in it, although it may appear in the specifications; (2) That if the claim includes an element in general terms, and refers to the specification to identify it, we may read that element into the claim; (3) That where the applicant for a patent in one claim makes no mention of an element, and in another includes it, the presumption is that he omitted it in the first on purpose; (4) That a patentee may include in or omit from his claims so much of the matter of the specifications of his invention as he pleases; but he is bound to state distinctly what part of it he intends to claim as his own. — *Duncan v. Cincinnati*, 171 Fed. 656; 96 C. C. A. 400.

In construing the claim in controversy, we must remember that it is to be interpreted in the light of the description and drawings having regard to the difficulties to be overcome and the end to be attained. — *Simplex Railway v. Pressed Steel*, 189 Fed. 70; 110 C. C. A. 634.

**§ 223. Construction — Specification.**

The description in a specification or drawing of a form, or a composition, or construction, of a mechanical element, when that form, composition, or construction is not, and is not claimed to be essential to the combination or improvement claimed, is the mere pointing out of the best mode in which the patentee contemplated applying the principle of his invention under § 4888, and does not deprive him of protection for mechanical equivalents or indicate that he intended to give up all other modes of application. — *Owens v. Twin City*, 168 Fed. 259; 93 C. C. A. 561.

*Continental v. Eastern*, 210 U. S. 405; *National v. Interchangeable*, 106 Fed. 693; *Boston v. Allen*, 91 Fed. 248.

That the claim must be construed in the light of the specification, see — *Washer Co. v. Cramer*, 169 Fed. 629; 95 C. C. A. 157.

While the law permits us to read the specification into a claim upon reference thereto in the latter, it would be an abuse of such liberality to first alter the specification and then read it, thus altered, into the claim. — *Duner v. Grand Rapids*, 171 Fed. 863; 96 C. C. A. 531.

The discussion of the claims of a patent is not to be confined to a mere logomachy, which could be set at rest at once by a reference to the specifications and drawings. — *Fowler v. National*, 172 Fed. 661; 97 C. C. A. 187.

**§ 228. Construction — Valeat quam Pereat Rule.**

That the court cannot, in order to save a claim, limit it beyond the plain and undeniable content, see — *Empire v. Channon*, 168 Fed. 705; 94 C. C. A. 211.



A construction resulting in the abandonment by the applicant of the very feature for which the invention was in large part designed should not be adopted unless such abandonment is clearly shown. — *Sly v. Russell*, 189 Fed. 61; 110 C. C. A. 625.

**§ 229. Construction — Words and Phrases.**

The introductory phrase is not an element of the combination, and does not necessarily limit the claim. — *Sly v. Russell*, 189 Fed. 61; 110 C. C. A. 625.

*Ex parte Casler*, 90 O. G. 446.

**§ 241. Generic.**

Undoubtedly a patent upon a combination may be broader than a patent upon any or all of its elements. — *Columbia v. Duerr*, 184 Fed. 893 (note, p. 910); 107 C. C. A. 215.

*Note:* This statement is open to serious question.

**§ 246. Specific.**

That a claim drawn specific to another claim with an added element may be valid, see — *Herman v. Youngstown*, 191 Fed. 579; 112 C. C. A. 185.

**§ 247. Sufficiency.**

Claim 2 is not invalid because it is not for an operative device, for, if such were the law, patentability must have been denied to Elias Howe for "the grooved and eye-pointed needle," which constituted his seventh claim. — *Clark Blade v. Gillette*, 194 Fed. 421; 114 C. C. A. 383.

*Howe v. Williams*, Fed. Cas. 6778; *Deering v. Winona*, 155 U. S. 286.

**§ 248. Void.**

Claims are independent inventions. One may be infringed, others not, and the redress of the patentee is limited to the injury he suffers, not by the abstract rights which may have been granted to him in other claims. One claim may be valid, all the rest invalid — invalid for the want of some essential patentable attribute. But what is good remains and is unaffected by its illegal associates. In such cases the patent does not stand or fall as a unity. — *Leeds v. Victor*, 213 U. S. 301; 53 L. Ed. 805; 00 S. Ct. 000.

COMITY.

**§ 250. General Statement and Definition.**

In passing on the other foreign patents, the circuit court considered that the prior adjudications fortified the presumption of the validity of the patent in suit, and established its scope, and that the new matter introduced did not repel the presumption or limit the extent of the patent. That the lower courts properly regarded the prior adjudications as a ground of preliminary injunction is established by the cases cited *Walk. Pat. §§ 665 et sq.*, *Rob. Pat. §§ 117 et sq.* And in that aspect the question must be considered, and, so considering it, we may pass the defenses of anticipation, whether complete or partial, and the defense of infringement. — *Leeds v. Victor*, 213 U. S. 301; 53 L. Ed. 805; 29 S. Ct. 495.

*Note:* It is believed that this decision should turn the tendency of the courts in certain circuits from their present disregard of prior adjudication to a more wholesome respect for decisions in other circuits.

**§ 251. Between Circuit Courts.**

When the same question subsequently comes before another judge at circuit on substantially the same evidence, it is to be expected that he will follow Judge Townsend's findings and conclusion. But if the evidence is materially different, so that he feels convinced that upon the new record Judge Townsend would have decided differently, we do not understand that he is so constrained. — *Victor v. Hoschke*, 188 Fed. 326; 110 C. C. A. 304.

**§ 253. Between Circuit Courts of Appeals.**

That upon substantially the same record, the decision of one circuit court of appeals should be given great weight by another circuit court of appeals, see — *Westinghouse v. Condit*, 167 Fed. 546; 93 C. C. A. 224.

The importance of securing uniformity in the law as administered in the several circuits in patent causes is so great that a decision of a court of co-ordinate jurisdiction should be followed by this court in every case where the question presented can fairly be regarded as doubtful. — *Gormley & Jeffry v. U. S. Agency*, 177 Fed. 691; 101 C. C. A. 479.

*Pratt v. Wright*, 65 Fed. 99; *Enterprise v. Deisler*, 46 Fed. 855.

The Circuit Court for the Northern District of Ohio, and the Circuit Court of Appeals for the Sixth Circuit having held the first claim of the patent here in suit is invalid, we think that an orderly administration of the patent law demands that we should follow these decisions unless clearly persuaded that they are erroneous. — *Lorain v. White*, 184 Fed. 326; 106 C. C. A. 356.

Our high respect for the learning of those courts gives to their judgment in any case a strong persuasive force, and the desirability of uniformity of decisions of courts exercising co-ordinate jurisdiction in patent cases is so great as to strongly incline us as a matter of comity to acquiesce; but there is no rule of law requiring such acquiescence. Moreover, there is evidence strongly tending to show that that (the prior) suit was collusive; not designed for a trial of the second claim of the patent upon its merits, but to secure vantage ground for future injunctive relief. In view of these things we are abundantly absolved, in any view of the rule of comity, from following the decision in the *Sanders Case*. — *Torrey v. Hancock*, 184 Fed. 61; 107 C. C. A. 79.

*Mast v. Stover*, 177 U. S. 485.

Although the parties are entitled to the independent judgment of this court, nevertheless the orderly administration of justice requires that, where a question has been decided after careful and exhaustive examination by the court of appeals of one circuit, another court of co-ordinate jurisdiction should not reach a different conclusion unless persuaded that the first decision is clearly wrong. Especially is this true in patent causes, for otherwise, under our present system, a party may be punished for an act which on the other side of a dividing line is perfectly lawful and proper. — *Calculagraph v. Automatic*, 187 Fed. 276; 109 C. C. A. 618.

The rule of comity for the Second Circuit, as stated by Judge Coxe, quoted and approved in — *Warren Bros. v. City of N. Y.* 187 Fed. 831; 109 C. C. A. 591.

*Box Co. v. Paper Co.* 51 Fed. 229; *Doig v. Morgan*, 91 Fed. 1001; *New York Filter v. Niagara*, 80 Fed. 924; *Consolidated Rubber Tire v. Diamond*, 157 Fed. 677; distinguishing *Mast v. Stover*, 177 U. S. 488.



Five judges have decided that the invention of the original is not the same as that of the reissue. \* \* \* In these circumstances we should be very sure of our position before running counter to such a weight of authority. — *Morse Chain v. Link-Belt*, 189 Fed. 584; 110 C. C. A. 564.

## CORPORATIONS.

### § 271. Miscellaneous Rulings.

That in the absence of proof of personal acts, officers of corporations are not personally liable for infringement by a corporation, see — *Johns-Pratt v. Sachs*, 175 Fed. 70; 99 C. C. A. 92.

The two corporations evidently preserve their separate organizations; but the control of the Bullock Company's business is exercised by the Allis-Chalmers Company, which has taken over all that is valuable in this business and made it a department of its own. The substance of the matter is that the Allis-Chalmers Company is the unquestioned master, whose orders are obeyed, and we think that under such circumstances a court of equity will look behind the corporate screen and determine where the real and responsible power lies. — *Westinghouse v. Allis-Chalmers*, 176 Fed. 362; 100 C. C. A. 408.

## COSTS.

### § 273. Appeals.

That an objection to an item taxed by the appellate court should be raised by application for retaxation in that court, and cannot be raised for the first time in the court below, see — *Fidelity v. Expanded*, 183 Fed. 568; 106 C. C. A. 114.

There seems to be no reasonable doubt that sec. 1 of rule 13 requires that the bond on appeal or writ of error shall cover the costs of both the upper and lower courts, except in cases where, from the nature and character of the suit, they are otherwise secured. — *Fidelity v. Expanded*, 183 Fed. 568; 106 C. C. A. 114.

*Kountze v. Omaha*, 107 U. S. 378; *Dexter v. Sayward*, 73 Fed. 237; *The Joseph B. Thomas*, 158 Fed. 559.

The cost of the supersedeas bond was a necessary part of the expenses of appeal, caused by the erroneous decision of the court below. Although the bond was allowed as a favor and not a matter of right, it was necessary to protect the appellant's interests pending the appeal. As it has not been customary to tax the premiums on supersedeas or appeal bonds in the Circuit Court of Appeals, the action of the clerk is affirmed, but the appellant should be allowed to tax these premiums in the Circuit Court. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

That the costs which the clerk is entitled to charge for supervising the appeal record as fixed by statute is indivisible, and that the full amount is to be charged even when the supervision involves merely preparing an index, see — *Colt's Co. v. N. Y. Sporting Goods Co.* 186 Fed. 625; 108 C. C. A. 489.

Following *Bean v. Patterson*, 110 U. S. 401.

### § 274. Disclaimer.

There being no disclaimer the decree will be without costs. And this applies as well to the costs in this court as in the court below. This relief

is merely negative, however. It denies costs, but it does not give them; and we see no occasion to direct that the defendants shall recover any costs here, or any further portion of their costs below than was there allowed them. — *Novelty v. Brookfield*, 172 Fed. 221; 97 C. C. A. 25.

That where complainant succeeds on appeal as to certain claims and is required to disclaim as to others, he may recover costs on appeal, but neither party will recover costs in the court below, see — *Cummer v. Atlas*, 193 Fed. 993; 113 C. C. A. 611.

*Yale v. Sargent*, 117 U. S. 536.

### § 277. Miscellaneous.

Where a suit is brought upon several claims of one or more patents, and the complainant succeeds in obtaining relief upon some of the claims but fails to recover upon others, an equitable division of the costs proportioned to the expense of litigating the respective claims should be made. — *Owens v. Twin City*, 168 Fed. 259; 93 C. C. A. 561.

*Ide v. Trorlicht*, 115 Fed. 137; *Willcox v. Merrow*, 93 Fed. 206; *Thomson-Houston v. Elmira*, 71 Fed. 886; *Johnson v. Foos*, 141 Fed. 73.

As the defendant succeeds as to the Whitmore patent, he was entitled to costs to which he would be entitled had there been a separate suit against him on that patent. — *Roth v. Harris*, 168 Fed. 279; 93 C. C. A. 581.

The complainant has established that he has a valid patent which has been infringed. On account of the unusual circumstances of the case, he is not entitled to any of the relief prayed for. We think it equitable that he should have one-half costs of this court, and that neither party should recover in the Circuit Court. — *Crier v. Innes*, 170 Fed. 324; 95 C. C. A. 508.

The words "cost" and "costs" do not always mean the same thing. The word "cost" and the phrase "taxable costs" generally have quite different meanings. "Cost" may be considered as synonymous with "expense." "Taxable costs" are allowances made to the successful party to reimburse him for his disbursements made in prosecuting or defending a suit. But to the unsuccessful party they are of the same nature as the damages awarded against him. He pays them because they are an incident to the judgment, not because they are any part of the expenses of his own defense. — *Hygienic v. Provident*, 176 Fed. 525; 100 C. C. A. 121.

That where two corporations entered into an agreement for mutual defense against suits for infringement, "the cost and expense of such defenses to be equally borne by the parties hereto," such agreement cannot be construed as an agreement of indemnity, so that one of the parties being mulcted with costs can recover pro rata such costs from the other party, see — *Hygienic v. Provident*, 176 Fed. 525; 100 C. C. A. 121.

In view of the fact that the complainant recovered only nominal damages, the trial court ordered it to pay all costs attending the accounting, including the hearing on the exceptions to the master's report. We think this was right. — *Dowagiac v. Minnesota*, 183 Fed. 314; 105 C. C. A. 526.

*Kirby v. Armstrong*, 5 Fed. 801; *Ingersoll v. Musgrove*, Fed. Cas. 7040; *Robbins v. Illinois*, 78 Fed. 124; *Kansas City v. Devol*, 127 Fed. 363.



It is apparently true that in some rare cases where there were several wrongdoers, some of whom had participated in doing the wrong only in a trivial or almost wholly unrelated manner, the court has exercised its discretion in their favor and cast the heavier burden of costs to which all are liable upon the more guilty parties. But such cases are exceptions to the general rule upon very special circumstances. — *Vrooman v. Penhollow*, 186 Fed. 495; 108 C. C. A. 502.

That the fact that a demurrant fails on one or more grounds set out in the demurrer, so long as he succeeds upon one ground, does not bar costs, see — *Gold v. Gold*, 187 Fed. 273; 109 C. C. A. 615.

## DAMAGES.

### § 283. Increasing.

That the Circuit Court of Appeals for the Second Circuit will not follow the course in *Fox v. Knickerbocker*, 165 Fed. 442, see — *Brown v. Drohen*, 175 Fed. 576; 99 C. C. A. 192.

### § 288. Measure — Complainant's Loss.

That losses based upon diverted sales must not be speculative, see — *Nat. Metal v. Bredin*, 186 Fed. 490; 108 C. C. A. 468.

The proofs show that the complainant's profit on the strips manufactured and sold by them was 1½ cents per foot. It is fair to assume that this agent would have purchased the 71,634 feet from complainants if the defendant's infringing strip had not been offered to him. — *Nat. Metal v. Bredin*, 186 Fed. 490; 108 C. C. A. 468.

Assignment is to a refusal to charge that: "Inasmuch as plaintiff has not proven that it would have received any order for its switching devices from either of the defendants, it cannot recover." We think this request was unsound. It would require plaintiff specifically to prove what in the nature of things can only be established by inference. When a person buys and installs an infringing device, it is assumed he does so because he finds it desirable or necessary to do so; and the natural inference would be that, if he had not got the infringing device from the infringing manufacturer, he would have got the equivalent device of the patent from some one licensed to make it, or if no one is so licensed, and the owner of the patent himself manufactures, then from such owner. — *Transit Development Co. v. Cheat-ham*, 194 Fed. 963; 114 C. C. A. 599.

### § 289. Measure — Deductions and Mitigations.

That the complainant may have been a party to an unlawful trust or combination, which raised the prices of the articles made and sold is not a ground for mitigating or refusing damages, see — *Novelty v. Brookfield*, 170 Fed. 946; 95 C. C. A. 516.

*St. Louis v. Terre Haute*, 145 U. S. 393.

### § 292. Measure — License Fee.

The master found that the evidence failed to establish a uniform license fee for the machines when used both night and day, as but a single instance of a license for such work was shown. This proposition is not seriously disputed, but the complainant contends that there was an established license fee for day work, and as the defendant used the machines night and day, he should not complain if required to pay the fee charged for day work.

This contention certainly seems plausible, but we hesitate to adopt it in the absence of proof. Are we permitted to infer that a license fee for a machine working night and day must, under all conditions, exceed, or at least equal, a license fee for a machine working by day only? We cannot think that the affirmative of this proposition is entirely free from doubt.

Lacombe, J. dissenting: I cannot concur in the proposition that we may assume, without proof, that a patentee who has an established license fee for the use of his machine for day work only, would be likely to allow its use for day and night work both at any less rate. — *Brown v. Drohen*, 175 Fed. 576; 99 C. C. A. 192.

*Note:* It is difficult to follow the reasoning of Judge Coxe in this case, and it would seem that the dissent of Judge Lacombe is justified.

This conclusion (for nominal damages) was reached upon the theory that unless a uniform rate of license fee, or at least a uniform rate for the particular period during which the defendant's infringement began, can be shown, nothing at all can be recovered. We do not agree with this conclusion. The patent had a career of vicissitudes. Sometimes it was held valid, sometimes void. In consequence the owner could not always get the same license fee. \* \* \* Upon such a state of facts we are of the opinion that the infringer should be held to have damaged the owner to the extent of what such infringer would have had to pay for a license at the lowest rate for which licenses had been issued, had he not infringed but conceded the validity of the patent at the outset. An owner may not announce some fixed rate, and then constantly depart from it for one reason or another, and at the same time insist that an infringer shall pay this rate, which the owner finds it impossible to collect from all others who use his improvement. It would be reasonable to assume that, had the infringer put the owner to an election either to abate from his announced rate or to undertake an infringement suit, such owner would have been willing to accept a rate as low as he had already accepted from others who possibly had put him to a like election in their cases. But it is a very different thing to hold that where there is a lowest limit below which the owner has never gone, preferring to bring suit rather than accept so little, an infringer may appropriate the invention feeling assured that, because all licensees have not paid exactly the same rate, he will never have to pay anything. Such a rule seems to us to be most inequitable, and the one indicated above is certainly fair to both sides. \* \* \* We find nothing in the frequent statement that an "established rate" cannot be proved except by showing uniformity, to preclude the adoption of the rule above indicated. — *Am. Sulphite Pulp Co. v. De Grasse*, 193 Fed. 653; 113 C. C. A. 521.

*Seymour v. McCormick*, 57 U. S. 480; *Packet Co. v. Sickles*, 86 U. S. 611; *Rude v. Westcott*, 130 U. S. 152.

*Note:* Is this rule "certainly fair to both sides?" The reversal of the court below was clearly proper, but should an infringer be entitled to dictate the terms of a license or the amount all pay for infringement? If an infringer is a tortfeasor, why should he have a privilege, established by law, to drive a better bargain by committing a tort than he would have been able to make had he acted lawfully?

### § 299. Miscellaneous Rulings.

It is said that the glass company was a non-exclusive licensee by sufferance, and that the damages which it suffered must be recovered, if at all, by the owner prosecuting in its behalf. This, no doubt, is the law. *Bird-*



sell *v.* Shaliol, 112 U. S. 485. But it does not necessarily dispose of the case. Neither is it ruled by *Yale v. Sargent*, 117 U. S. 552, where the owner of the patent was allowed to recover damages to a partnership of which he was a member. Nor is *Tilghman v. Proctor*, 125 U. S. 136, applicable, there being no proof there that any one beside the plaintiff had an interest, legal or equitable, in the patent, and the question being not as to the plaintiff's damages, but the defendant's profits, which the plaintiff was held entitled to recover, no matter to whom they were eventually to go. The bill proceeds in the interest and for the benefit of the owner of the patent alone, and it is not at this stage to be transformed into something else. It is only where the licensee, exclusive or nonexclusive, is in fact, in whole or in part, the beneficial party, that anything can be claimed by way of damages on his account. — *Brookfield v. Novelty*, 170 Fed. 960; 96 C. C. A. 127.

The bill charged that the defendant maliciously and for the purpose of delaying the issue of complainant's patent caused an interfering application to be filed, and by delays and repeated appeals delayed the issue of the patent for some three years, and sought damages therefor. *Held*: The case, if any case can be made upon the facts detailed, is one in the nature of trespass on the case for injury and damage to the plaintiff in error, growing out of the postponement of its coming into enjoyment of his grant, due to the alleged malicious conduct of the defendant in error. But to support such an action, if such an action exists at law, it is essential that plaintiff in error should have suffered some specific damage due to the postponement, and that such damage should be specially set forth in the complaint. — *Avery v. Case*, 174 Fed. 147; 98 C. C. A. 181.

## DEFENSES.

### § 322. Miscellaneous.

The validity of a patent is not affected by nonuser. But it may be said to have a bearing upon its construction. — *Westinghouse v. Toledo*, 172 Fed. 371; 97 C. C. A. 69.

*Continental v. Eastern*, 210 U. S. 405; *Bradford v. Belknap*, 105 Fed. 63.

If the defendant's answer had set up as the sole defense no notice other than that contained in the bill of complaint, and that immediately upon the commencement of the suit it had dismantled the machine it had been using, the contention might, perhaps, be good. — *Morton Trust v. Standard*, 177 Fed. 931; 101 C. C. A. 211.

*Note*: It is thought special emphasis should be put upon the word "perhaps."

## DEMURRER.

### § 323. Dismissing Bill on.

Courts are slow to sustain demurrers on the ground that the letters patent are void on their face, as showing no patentable invention. They, however, recognize the duty imposed upon them, where it is clear that the device of the patent in suit does lack patentable invention, to so declare, and to dispose of the case on demurrer, and thus put an end to useless and expensive litigation. — *Victor v. Hawthorne*, 178 Fed. 455; 101 C. C. A. 439.

Rule and authorities stated in — *Boldt v. Nevison*, 194 Fed. 871; 114 C. C. A. 617.

**§ 324. Judicial Notice.**

Of course, every bill is written against the background of common knowledge; and in that view a demurrer may be said to invite the chancellor to take judicial notice of the background. But if a bill, in and by its own averments, states a prima facie case, that case cannot properly be overthrown by the chancellor merely on the ground that he judicially knows of facts that would support an answer. His judicial knowledge must go farther, and be so broad and all-embracing that he can properly hold that no facts exist that would tend to controvert the supposed answer and support a replication and the bill. This is so because, if such facts exist, the complainant is entitled to a hearing where he can present and argue the facts, and such a hearing cannot be had on demurrer to the bill. — *Lange v. McGuin*, 177 Fed. 219; 101 C. C. A. 389.

See foot-note to this case with list of authorities.

**§ 325. Patentability and Novelty.**

It is true that, in a case where there is doubt whether the patent involves invention or utility, the power of the court to pass upon its validity in advance of proofs which might be adduced to sustain it should be exercised with caution. What was said (in *Richards v. Chase*, 158 U. S. 299) is applicable with greater force in a case in which the pure question of law is presented whether the invention is or is not within the class of those which the law makes patentable. In such a case no light can come from testimony. — *Am. Disappearing Bed v. Arnaelsteen*, 182 Fed. 324; 105 C. C. A. 40.

There seems to be sufficient doubt about the question of patentability to call for a disposition of the case similar to that made in *Beer v. Walbridge*, 100 Fed. 465, *National v. Stolts*, 174 Fed. 413, and *Lyons v. Drucker*, 106 Fed. 416, where we reversed decisions sustaining demurrers. In patent causes, moreover, there is always the chance that evidence as to conditions prior and subsequent to the patentee's publication of his improved device may be introduced which induce the reversal even of a very strong impression formed merely from a perusal of the patent itself in the light of common knowledge. Such instances are within the experience of this court. See *Schenck v. Singer*, 77 Fed. 841; *Brunswick-Balke-Collender v. Thum*, 111 Fed. 904. — *Stilwell v. McPherson*, 183 Fed. 586; 106 C. C. A. 354.

**§ 327. Miscellaneous.**

The records in the former litigations are not before us and cannot be introduced upon the issue presented by the bill and demurrer. The demurrer admits what the bill alleges, but the bill does not allege that the original patent was held invalid because of lack of patentability. The courts may, of course, in considering a demurrer, take judicial notice of matters within the common knowledge of the people, but we have grave doubt whether we are justified in considering the testimony and exhibits produced before us at an argument which took place two years ago. The evidence of the witness who testified to a prior use in the suit on the original patent may be decisive of this case also, but his testimony is not before us and it would, we think, be establishing a dangerous precedent were we in aid of a demurrer to resort to testimony not in the record. — *National v. Stolts*, 174 Fed. 413; 98 C. C. A. 617.

**DESIGNS.****§ 331. Infringement.**

Design patents are to make that, which otherwise is useful, ornamental as well. Many designs, while differing in detail, may present to the ordinary



observer the same appearance. "Sameness of appearance" is "identity of design." But the object in a design patent is not to identify the article as an article of trade, but to ornament it so as to make it pleasing to the eye, the true rule being, What is the aesthetic effect? And does the alleged infringing device produce upon the eye of the ordinary observer the same aesthetic effect? The "sameness of appearance" is the sameness of aesthetic effect upon the eye. — *Bolte v. Knight*, 180 Fed. 414; 103 C. C. A. 558.

*Smith v. Whitman*, 148 U. S. 680; *Jennings v. Kibbe*, 10 Fed. 669.

That while the absence of a description accompanying the drawing in a design patent does not render the patent void, it limits the construction to the precise showing of the drawing, and the court cannot hold any element shown to be nonessential, see — *Ashley v. Tatum*, 186 Fed. 339; 108 C. C. A. 539.

*Dobson v. Dornan*, 118 U. S. 10; *Ex parte Mygatt*, 117 O. G. 538; *Ex parte Freeman*, 109 O. G. 1339; *Ex parte Mygatt*, 121 O. G. 1676; *Tompkins v. N. Y.* 159 Fed. 133.

### § 332. Invention.

We think it distinctly the better view that the patentee, while availing himself of parts old in the art, so united them in his design as to produce a completed whole having a new and pleasing effect distinct from the effect of the separate parts — that he obtained a new result, and consequently a valid patent. — *Crier v. Innes*, 170 Fed. 324; 95 C. C. A. 508.

### § 334. Novelty.

In order to sustain a patent, whether for mechanical construction or for design, it must appear that there was exercise of the inventive faculties. A mere change in construction which shows no originality and adds no beauty to existing structures is not sufficient to sustain a patent for a design. — *Mygatt v. Schaffer-Flaum*, 191 Fed. 836; 112 C. C. A. 350.

### § 335. Patentability.

A monument is manufactured, and in our opinion is a "manufacture," and not a species of architecture. — *Crier v. Innes*, 170 Fed. 324; 95 C. C. A. 508.

That under § 4929 as amended a design must be "ornamental" and that the term "useful" is omitted; and for a most instructive discussion of the patentability of designs, see — *Phoenix Knitting Wks. v. Hygienic*, 194 Fed. 696; — C. C. A. —.

Familiar rule and cases cited in — *Boldt v. Nevison*, 194 Fed. 871; 114 C. C. A. 617.

## DISCLAIMER.

### § 340. Delay.

That where, upon the affirmance of a decree dismissing a bill, the complainant files a disclaimer and asks amendment of the mandate to permit the filing of a supplemental bill in the nature of a bill of review, such motion is made in season, see — *Fellows v. Borden's*, 187 Fed. 1095; 109 C. C. A. 535.

### § 341. Effect of.

The effect of the disclaimer was not to broaden the claim, but to limit it to the construction, described and shown. Until this disclaimer was allowed it was possible to contend for a construction broad enough to include a structure described in the language disclaimed. That this was a proper case for a disclaimer and that the language disclaimed is no longer a part of the specification are propositions which are sustained by the authorities. \* \* \* The statement eliminated by the disclaimer was unnecessary and was not advisedly inserted, but there is nothing of which to predicate a fraudulent intent. — *Simplex Railway v. Pressed Steel*, 189 Fed. 70; 110 C. C. A. 634.

*Dunbar v. Meyers*, 94 U. S. 187; *Accumulator v. Julien*, 38 Fed. 117, and cases cited; *Carnegie v. Cambria*, 185 U. S. 403.

### § 342. Failure to File.

The decree must be affirmed as to claim 2; but there being no disclaimer as to the others, it will be without costs. And this applies as well to the costs in this court as in the court below. — *Novelty v. Brookfield*, 172 Fed. 221; 97 C. C. A. 25.

That failure to file a disclaimer which may bar costs in no wise bars the right to an accounting, see — *Novelty v. Brookfield*, 172 Fed. 221; 97 C. C. A. 25.

### § 344. Purpose and Effect of.

The old and inequitable rule of the Second Circuit that a complainant succeeding on one claim and another claim sued on being held bad must disclaim the latter before decree, is, by this decision affirmatively revoked, the court saying: Such an interpretation of the section seems unreasonable, and the so-called "rule of practice" in the Second Circuit will no longer be followed. — *Page v. Dow*, 168 Fed. 703; 94 C. C. A. 209.

Revg. the rule applied in *Myers v. Frame*, Fed. Cas. 9991; *Burdett v. Estey*, Fed. Cas. 2145; *Christman v. Rumsey*, Fed. Cas. 2704; *Schillinger v. Gunther*, Fed. Cas. 12,458; *Atwater v. Beecher*, 8 Fed. 610; *Tyler v. Galloway*, 12 Fed. 567; *Brainard v. Cramme*, 12 Fed. 621; *Matthews v. Spagenberg*, 19 Fed. 823; *Hake v. Brown*, 37 Fed. 783; *Union v. Waterbury*, 39 Fed. 389; *Electric v. Julien*, 38 Fed. 117; *Steam Gauge v. Kennedy*, 41 Fed. 38; *Brush v. Electric*, 47 Fed. 48; *Ballard v. McCluskey*, 58 Fed. 880.

That where certain claims sued on are held void on appeal and certain claims are sustained, the appellate court may compel complainant to make disclaimer upon the claims held void before entering decree upon the others, see — *Morgan Engineering v. Alliance*, 176 Fed. 100; 109 C. C. A. 30.

*Morgan v. Alliance*, 176 Fed. 100, followed in — *Herman v. Youngstown*, 191 Fed. 579; 112 C. C. A. 185.

Under the practice pointed out in *Morgan v. Alliance*, 176 Fed. 100, and *Herman v. Youngstown*, 191 Fed. 579; the complainant should have 30 days after the mandate is filed in the court below within which to file a certified copy of a disclaimer as to claims 7, 8, 9, and 10, and, in the absence of such disclaimer, the bill should be dismissed. — *Cummer v. Atlas*, 193 Fed. 993; 113 C. C. A. 611.



## DISCOVERY.

## § 347. General Statement and Definition.

The prior art had no teaching on the subject, and Byerley discovered it, not by any process of reasoning or building upon former methods, but accidentally and without design. Byerley on one occasion and from mere curiosity carried the distilling process beyond the usual point, and to his surprise found it resulted in an unlooked-for and unknown chemical action and product, namely, the artificial asphalt of his second claim. — *Byerley v. Sun*, 184 Fed. 455; 106 C. C. A. 537.

## DIVISIONAL PATENTING.

## § 348. Statute and General Rule.

One who makes several patentable inventions that result in a new and useful machine or process, or both, may have as many separate valid patents as he makes patentable inventions. — *Century Electric v. Westinghouse*, 191 Fed. 350; 112 C. C. A. 8.

*Rob. Pat.* § 465; *Expanded v. Bradford*, 214 U. S. 366; *Badische v. Klipstein*, 125 Fed. 543; *Westinghouse v. Dayton*, 106 Fed. 724; *Westinghouse v. Electric Appliance*, 142 Fed. 545.

## § 349. Co-Pending Applications.

Where each of several applications which subsequently ripen into patents to the same inventor describes the same machine and process and the inventions claimed in all the applications, but no one of the applications claims any invention claimed in any of the others and they are all pending at the same time, the respective dates when the applications were filed are immaterial, and the applications and patents cannot be used to anticipate or avoid each other. — *Century Electric v. Westinghouse*, 191 Fed. 350; 112 C. C. A. 8.

*Ide v. Trorlicht*, 115 Fed. 137; *Walk. Pat.* § 180; *Suffolk v. Hayden*, 3 Wall. 315; *Westinghouse v. Dayton*, 106 Fed. 724; *Graham v. McCormick*, 11 Fed. 859; *Graham v. Manufacturing Co.* 11 Fed. 138.

## § 351. Distinguished from Double Patenting.

That one application for a patent may be a continuation of a prior application for the same thing under certain circumstances is unquestioned. — *Model Bottling Mach. v. Anheuser-Busch*, 190 Fed. 573; 111 C. C. A. 389. *Hayes-Young v. St. Louis*, 137 Fed. 80.

## § 354. Identity.

A patent for an invention does not avoid a later patent for an improvement thereon nor does a patent for an improvement avoid a later patent for the invention on which the improvement is made. The sum of the whole matter is that while an earlier patent avoids a later patent to the same patentee for the invention claimed and secured by the former, it does not invalidate a later patent to him for a distinct, different and separable invention whether generic or specific, whether an original machine or process, or both, or an improvement thereon which is not actually claimed or secured by the earlier patent. — *Century Electric v. Westinghouse*, 191 Fed. 350; 112 C. C. A. 8.

*Thomson-Houston v. Ohio*, 80 Fed. 712; *Thomson-Houston v. Elmira*, 71 Fed. 396; *Electrical Accumulator v. Brush*, 52 Fed. 130.

## DOUBLE PATENTING.

## § 358. Extending the Monopoly.

That an attempt to secure by subsequent patent application claims upon combinations fully disclosed but not claimed in the prior patent — which claims might have been made part of the original patent or secured in it by a reissue, is double patenting and the latter patent void, see — *Union Typewriter v. Smith*, 181 Fed. 966; 104 C. C. A. 430.

That where an invention is patented with specific claims, the issuance of a subsequent patent with generic claims would be double patenting and extend the monopoly, see — *Gold v. Gold*, 187 Fed. 273; 109 C. C. A. 615.

An inventor may not sustain a subsequent patent for an invention actually claimed and secured in a former patent. Nor may he sustain a subsequent patent for an essential element of an invention secured by a former patent without which that invention would not have been patentable. — *Century Electric v. Westinghouse*, 191 Fed. 350; 112 C. C. A. 8.

*Miller v. Eagle*, 151 U. S. 186; *Mosler v. Mosler*, 127 U. S. 355; *Otis v. Portland*, 127 Fed. 557; *Western Electric v. Williams-Abbott*, 108 Fed. 952; *Thomson-Houston v. Hoosick*, 82 Fed. 461; *Palmer v. Lozier*, 90 Fed. 732; *Industrial v. Wilcox*, 112 Fed. 535.

## DRAWINGS.

## § 363. General Statement and General Rules.

The rule is, of course, appreciated that while the drawings of a patent serve to make plain doubtful or ambiguous statements in the written description, they cannot go further and supply the entire absence of the written description required by the statute. A strict application of this rule would probably prevent us from considering what the drawings show concerning the gearing ratio or the working of the cylinders — these subjects not being mentioned in the description. But in view of the stated objects of the patent and in view of the fact that changes in the Brayton structure referred to in the description tend to increase speed capabilities, we have thought that the rule should not be strictly applied in this case and that some weight should be given to what the drawings disclose in that direction, as supplementing the written description and not altogether as supplying its absence. — *Columbia v. Duerr*, 184 Fed. 893 (note, p. 907); 107 C. C. A. 215.

## EMPLOYER AND EMPLOYEE.

## § 365. Contract — Future Inventions:

The law is settled that, in the absence of an express contract or agreement, the relation of employer and employee, under whatever circumstances, short of specific employment to make an invention, does not invest the employer with the entire property right in an invention of the employee. — *Johnson v. Western*, 178 Fed. 819; 102 C. C. A. 267.

*Pressed Steel v. Hanson*, 137 Fed. 403; *Hapgood v. Hewitt*, 11 Fed. 422; *affd.* 119 U. S. 226.

## § 366. License — Implied.

(1) It was one of the duties of the plaintiff's employment to improve the defendant's machinery. (2) The plaintiff used the property of the defendant and the assistance of its other employes in developing and putting into practical form his invention. (3) The defendant also paid the expenses of taking out the patent. (4) The defendant also paid for the machines which were installed in the defendant's factory under the direction of the plaintiff.



(5) In addition to these material facts the salary of plaintiff was raised from \$1800 to \$5000 per annum, and the plaintiff also had quite a large interest in the profits of the business. Upon this state of facts, the defendant, under well settled rules governing this class of cases, clearly had at least a shop right or implied license to use these particular machines without compensation. \* \* \* In the absence of an express agreement on the part of the defendant to pay for the use of these machines, the court below properly directed a verdict for the defendant. — *Wilson v. Am. Circular Loom*, 187 Fed. 840; 109 C. C. A. 600.

*Solomons v. U. S.* 137 U. S. 342; *Gill v. U. S.* 160 U. S. 426; *McClurg v. Kingsland*, 1 How. 202; *Barry v. Crane*, 22 Fed. 396; *Withington v. Kinney*, 68 Fed. 500; *Am. Tube Wks. v. Bridgewater*, 26 Fed. 334; *Magoun v. New England*, Fed. Cas. 8960; *Blauvelt v. Interior*, 80 Fed. 906; *Barber v. National*, 129 Fed. 370; *Fuller Bartlett*, 68 Wisc. 73.

## EQUITY.

### § 371. Jurisdiction.

Defendant held a patent and threatened to bring suit for infringement against complainant, but failed and refused so to do. Complainant brought suit to perpetuate testimony, alleging such proof sufficient to establish the invalidity of the patent and danger of such testimony being lost. *Held*: The jurisdiction of courts of equity to entertain bills for the perpetuation of testimony is undoubted. It is by original bill (under the second clause of § 886 R. S.), and exists where the complainant has an interest which he cannot make the subject of judicial inquiry and the testimony in support of such interest may be lost before such inquiry is made. — *Westinghouse v. Electric*, 170 Fed. 430; 95 C. C. A. 600.

*Buddicum v. Kirk*, 3 Cranch, 295; *Booker v. Booker*, 20 Ga. 780; *Dan. Ch.* 1573; *Angell v. Angell*, 1 Eng. Ch. Rep. 89; *Ellice v. Roupell*, 32 Beav. 303; *May v. Armstrong*, 26 Ky. 261; *Hall v. Stout*, 4 Del. Ch. 272; 9 Am. & Eng. Enc. 312; *Story Eq. Pl.* § 303; *Fost. Fed. Pr.* § 279; *Richter v. Union*, 115 U. S. 55; *Green v. Compagnia*, 82 Fed. 494; *N. Y. v. N. Y.* 9 Fed. 578.

That a bill setting forth no special equities, but pleading two patents, one in vigor and one expired, is bad, see — *Sheridan v. Law*, 172 Fed. 223; 97 C. C. A. 27.

*Root v. Railway*, 105 U. S. 189; *Consolidated v. Ashton*, 26 Fed. 319; distinguishing *McDonald v. Miller*, 84 Fed. 344.

Equity, in seeking justice between man and man, not obtainable at law, does not stop precisely where the cases already decided have stopped. The chancellor has now, as had the chancellor in the past, the power and duty to apply old principles to new cases involving new relationships. \* \* \* There existed, then, between these parties, as we view it, a relationship that made them, appellee as well as appellants, agents to a common enterprise — agents by agreement — the principal being the common enterprise itself; a relationship that, faithfully carried out by appellants, required that they put in the name of the appellee, but for the common enterprise, whatever they might invent in that line; and that, faithfully carried out by appellee, required that he extend (the appellants fulfilling their obligations) the scope of the common enterprise to include the whole of the United States — the specific option contracts being the mode employed. In what respect has this relationship failed? That appellants stand in a trustee relationship with respect to these inventions, to this common enterprise, we think is clear. That appellee stands, in relation to this common enterprise, as trustee also, we think is clear. This clothes the court with power

to enter a decree of some kind. It is the form of the decree that remains to be determined. — *Nat. Wire Bound Box v. Healy*, 189 Fed. 49; 110 C. C. A. 613.

The owner of a patent cannot recover, in a suit against a manufacturer of an infringing article which he sells to retailers, the full relief to which he is entitled in suits against the retailers, and a decree for an injunction and damages against a manufacturer is no bar to suits against those who purchase from the manufacturer and use or sell to others. — *Kryptok v. Stead*, 190 Fed. 767; 111 C. C. A. 495.

*Birdsell v. Shaliol*, 112 U. S. 485.

That in an action by an assignor for an accounting and a re-assignment there is no adequate remedy at law, and equity will take jurisdiction, see — *Neenan v. Otis Elevator*, 194 Fed. 414; 114 C. C. A. 376.

## EQUIVALENTS.

### § 373. General Statement and Definitions.

To be substantially equivalent means, they must perform the same office by a similar organization and mode of operation. — *Chicago Grain Door v. National*, 173 Fed. 918; 97 C. C. A. 324.

### § 374. Combinations.

The elements of the combination are things and not names. In this as in other patents for combinations, we think that the unity of the combination will not be affected by the substitution of elements which, however they may be classified or designated, perform the same function in substantially the same way, while it will be destroyed by the substitution of elements which do not perform the same office in substantially the same manner. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

The doctrine of mechanical equivalents is governed by the same rules and has the same application when the infringement of a patent for a combination is in question as when the issue is over the infringement of a patent for any other invention. Dissenting opinion of Judge Sanborn in — *Electric Protection v. American*, 184 Fed. 916; 107 C. C. A. 238.

*Imhauser v. Buerk*, 101 U. S. 647; *Griswold v. Harker*, 62 Fed. 389; *Fay v. Cordesman*, 109 U. S. 408; *Union v. Desper*, 101 U. S. 332.

### § 376. Improvements.

Where a patent depends for its novelty over the prior art upon a single limited feature of construction, the claims cannot be expanded by any doctrine of equivalents, to cover a device which lacks the essential feature. — *Lieberman v. Ruwell*, 170 Fed. 590; 95 C. C. A. 134.

*Wagner v. Wycoff*, 151 Fed. 585.

That the broad rule of equivalents applicable to pioneer patents, as stated in *Morley v. Lancaster*, 129 U. S. 263, does not apply to an improvement patent, see — *National v. Ralston*, 172 Fed. 293; 97 C. C. A. 91.

That an invention which is merely an improvement may partake of the nature of a pioneer invention sufficiently to give it some range of equivalency, see — *Am. Pneumatic v. Snyder*, 180 Fed. 712; 104 C. C. A. 78.

*Paper Bag Case*, 210 U. S. 405.



Since the invention is a secondary improvement marking only a small step in the art, and with comparatively small meritoriousness in the improvement, the range of equivalents is correspondingly narrow and the doctrine of equivalents should be less liberally applied in its favor. — *Jackson v. D'Arcey*, 181 Fed. 340; 104 C. C. A. 170.

*Miller v. Eagle*, 151 U. S. 86; *Bundy v. Detroit*, 94 Fed. 525; *King v. Hubbard*, 97 Fed. 795; *Taber v. Meriden*, 105 Fed. 83.

Considering the prior art, we cannot believe that the patent is entitled to a broad construction; on the contrary, in view of the earlier uses made of the condenser, we think the patent can be accorded only a narrow construction. — *Kellogg v. Dean*, 182 Fed. 991; 105 C. C. A. 545.

*National v. Buckeye*, 171 Fed. 847.

When an invention is a primary one, and the inventor a pioneer in the art to which it relates, he is justly entitled to a wide range of equivalents; but when it is for a slight improvement upon prior efforts which have met with more or less success, its range of equivalents should be correspondingly limited; and when the patent is for described means or mechanism to accomplish a specified improvement, it will be limited to the particular means described in the specification, or their clear mechanical equivalents. — *Electric Protection v. American*, 184 Fed. 916; 107 C. C. A. 238.

*Union v. Diamond*, 162 Fed. 148; *Boyd v. Janesville*, 158 U. S. 260; *Knapp v. Morss*, 150 U. S. 221; *National v. Interchangeable*, 106 Fed. 693.

### § 378. Range of.

The main contention of the defendant is that if a patentee in describing one feature of his invention, as, for example, a stop, says that it may consist of two forms, and in his claim he describes only one form, his claim is thereby limited to that form, and cannot be construed to cover the other form as an equivalent. In support of this proposition the defendant cites § 4888 R. S., and a long list of cases, from which it is sufficient to refer to the language of the Supreme Court in *Miller v. Brass Co.* 104 U. S. 350, 352. While the rule laid down in *Miller v. Brass Co.* and many other cases cited by the defendant has long been recognized, we do not think it has any application to the case at bar. This is not a case where the patentee, having failed to include in his claim a feature of his invention described in his specification, is seeking to have that feature read into his claim; but it is a case where the claim includes one form of the feature described in the specification, and where the only question is whether the claim does not also cover, under the doctrine of equivalents, the equivalent form described in the specification. — *Whitin v. Houghton*, 178 Fed. 444; 101 C. C. A. 344.

This question of breadth of equivalents again depends upon the extent of the advance which the inventor has made in the art. — *Sly v. Russell*, 189 Fed. 61; 110 C. C. A. 625.

*Penfield v. Chambers*, 92 Fed. 630; *Bundy v. Detroit*, 94 Fed. 524; *McSherry v. Dowagiac*, 101 Fed. 716; *Winans v. Denmead*, 15 How. 330; *Metallic v. Brown*, 104 Fed. 345; *Vrooman v. Penhollow*, 179 Fed. 296.

### § 379. Identity.

It is, of course, true that for one thing to be the equivalent of another it must perform the function of that other, and the function must be performed in substantially the same way by the alleged equivalent as by the thing of which it is alleged to be the equivalent. But it is not necessary that this



function be performed in identically the same way, or to the same extent. — *Sly v. Russell*, 189 Fed. 61; 110 C. C. A. 625.

## ESTOPPEL.

### § 381. Corporations.

That an estoppel arising out of the assignment of the patent in suit against the assignor who subsequently assigns another patent to and becomes the employee of a corporation does not extend to include such corporation, see — *Babcock v. Toledo*, 170 Fed. 81; 95 C. C. A. 363.

*Babcock v. Clarkson*, 63 Fed. 607; *Hail v. Conder*, 2 C. B. (N. S.) 22; *Noonan v. Chester*, 99 Fed. 90; *Boston v. Woodward*, 82 Fed. 97; *American v. Phoenix*, 113 Fed. 629; distinguishing *Daniel v. Miller*, 81 Fed. 1000; *Time Tel. v. Himmer*, 19 Fed. 322; *Continental v. Pendergast*, 126 Fed. 381; *Woodward v. Boston*, 60 Fed. 283; *Noonan v. Chester*, supra; *Lamb v. Lamb*, 120 Fed. 267.

The defendant Sachs is the patentee. He assigned the patent to complainant and subsequently organized the Sachs Company, of which he is a large stockholder and the moving spirit. If the prior state of the art were such that his assertions of novelty were fallacious, there would be no real invention disclosed, his claims would be unwarranted, and his patent void. But in a suit for infringement brought by the person to whom the patentee sold his patent at its face value, against him and the company he has created and controls, an inquiry into the prior art for such purpose is not to be undertaken. — *Johns-Pratt v. Sachs*, 175 Fed. 70; 99 C. C. A. 92.

Nor is such estoppel of Parkinson (who effected the sale of the patent) to be evaded by his organizing the Furnace Company and operating through it. It and his associates interested in said corporation were in privity with him and are equally estopped. — *Johnson v. Western*, 178 Fed. 819; 102 C. C. A. 267.

*Force v. Sawyer-Boss*, 111 Fed. 902; *Siemens-Halske v. Duncan*, 142 Fed. 157; *Mellor v. Carroll*, 141 Fed. 992; *N. Y. Phonograph v. National*, 163 Fed. 534; *Mathews v. Lister*, 154 Fed. 490; *Nat. Recording v. International*, 158 Fed. 824; *Continental Wire v. Pendergast*, 126 Fed. 381; *Woodward v. Boston*, 60 Fed. 622.

### § 384. Licensor or Former Owner.

Parkinson participated with Johnson in the sale of the patent to Burns for complainant, and Parkinson received one-eighth of the consideration therefor. He, and all in privity with him, are estopped from now alleging the invalidity of the patent. The estoppel against the assignor is not based simply upon the covenants expressed and implied in his conveyance. It rests upon the broad and equitable doctrine that one who receives and retains a portion of the fruits of a sale of a patent which he has assisted in making to another is estopped from claiming that such patent is invalid and worthless. This principle applies to Parkinson as well as Johnson. The equitable garment fits each alike and they must each wear it. — *Johnson v. Western*, 178 Fed. 819; 102 C. C. A. 267.

*Daniel v. Miller*, 81 Fed. 1000; *Force v. Sawyer-Boss*, 111 Fed. 902; *Time Tel. v. Himmer*, 19 Fed. 322; *Siemens-Halske v. Duncan*, 142 Fed. 157.

*Facts:* The president of defendant company had been a stockholder and officer of complainant company and gone into other business. Defendant company's predecessor sought and engaged him to reorganize and manage its business, which he did by financing the defendant company, taking for cash a considerable block of stock. Previously, complainant company had sued defendant company's predecessor on this same patent and the patent



was held invalid (*Globe-Wernicke v. Macey*, 119 Fed. 696). On this suit complainant claims estoppel against the present company defendant to question the validity of complainant's patent issued to the president of defendant, formerly assignee-patentee to complainant and officer of complainant. Defendant sets up the former suit against its predecessor as *res judicata*, and complainant contends that defendant is estopped from raising such defense in bar. *Held*: No estoppel and *res judicata*. — *Macey v. Globe-Wernicke*, 180 Fed. 401; 103 C. C. A. 547.

*Boston v. Woodward*, 82 Fed. 97; *Regent v. Penn*, 121 Fed. 80; *Babcock v. Toledo*, 170 Fed. 81; *Belknap v. Schild*, 161 U. S. 10.

The court ruled that Christopherson (an inventor-assignor) by his assignment was to be regarded as representing that the patent was what it purported to be, was valid in accordance with its terms, that it was to be fairly construed, and that the prior art could not be invoked to limit its terms. This is the length to which the rule may be properly carried. It has never been held to estop an assignor from thereafter employing his genius in a new field of the same art, nor to deny him the fruits of such effort. It does not preclude him from denying infringement, nor of invoking the prior art for the purpose of showing that no infringement in fact exists. — *Leather Grille v. Christopherson*, 182 Fed. 817; 105 C. C. A. 249.

*Siemens-Halske v. Duncan*, 142 Fed. 157; *Noonan v. Chester*, 99 Fed. 90.

### § 385. Owner of Patent or Licensee.

Hibbard, the licensor to the old company, brought suit against the new company for infringement, claiming that the assignment did not pass to the new company from the old company, which contention was upheld. *Held*: If the suit were against the old company for further royalties, that company would be estopped from contending that the devices stamped and put forth by it as the patented devices were not in truth within the patents. But as to the new company, Hibbard cannot both deny the relation of licensor and licensee and also claim the benefit of the estoppel that would arise from the relationship. — *Niagara v. Hibbard*, 179 Fed. 844; 103 C. C. A. 330.

*Sproull v. Pratt*, 97 Fed. 807; *Piaget v. Headley*, 108 Fed. 870.

The defendant was a licensee under the patent in suit for the life of the patent, had paid royalties in full and was bound to pay royalties in the future if the patent was held valid. In a suit against a third party this defendant, by permission of the court, filed a brief in that case attacking the validity of the patent. *Held*: These royalties were large; the monopoly itself, if upheld, was extremely valuable; and the question whether the monopoly had been judicially determined, was, therefore, a matter of deep consequence to appellee (the licensee). Why may not the appellee, without violation of its contract, or violation of any ethical duty it owes to appellant, contribute toward clarifying the vision of the Court by which this judicial determination is to be made both right and final? We see nothing in the conduct of appellee that is a renunciation, repudiation or forfeiture of its contract; on the contrary we see simply a precaution upon its part that the judgment of the Court, upon which its additional obligations and its additional advantages alike depend, shall be as free from error as a full discussion of the record before the Court can make the judgment, that is to follow, free from error. — *Comptograph v. Burroughs*, 183 Fed. 321; 105 C. C. A. 533.

*Note*: In my opinion, this is not only bad law and bad ethics, but it is an utter misinterpretation of the authorities cited. Such a rule opens wide the



door for a licensee to entirely avoid the rule of estoppel by coming in behind a third party, furnishing the sinews of war, and defeating a patent whenever it is to the interest of the licensee so to do. The "clarifying the vision of the Court" is too screamingly specious for argument.

### § 386. Privity.

The president of the defendant companies testified "we have undertaken to assist in bearing the burdens of this defense, and have contributed to the defense financially and otherwise;" but it was not shown that, as between the present and former defendants, either company had the right to intermeddle in any way in the conduct of the case. The companies would have been glad to see the patent declared void, and were willing to pay something to that end. That was all, and that did not make them privies. — *Rumford v. Hygienic*, 125 U. S. 156; 54 L. Ed. 137; 30 S. Ct. 45.

*Litchfield v. Goodnow's*, 123 U. S. 549.

This action is brought against a copartnership consisting of three members. The two members of the firm who took part, respectively, in the two prior actions are not shown to have acted for or represented the firm or their copartners in so doing, or to have had other interest in such litigation than such as belonged to them in their attitude of stockholders in the respective corporations defendant therein. The parties, therefore, are not the same, and the judgments do not estop the present defendants. — *Wilgus v. Germain*, 72 Fed. 773; 19 C. C. A. 188.

In order that one not a party may be precluded by a former adjudication, he must have been privy to the former proceedings, or connected therewith in such a way that he had the right to control the litigation, or at least the right to appear by counsel and make motions and offer evidence and examine witnesses. To prove that one was a witness in a cause, and took a leading part in the defense thereof, without further information concerning the nature of his connection therewith, is not equivalent to proof that he had or assumed the right to control the proceedings, or to adduce or cross-examine witnesses, or to appeal from the judgment; and there is no such privity between a private corporation and its stockholders that a judgment obtained against the one is *res judicata* as to the other. — *Wilgus v. Germain*, 72 Fed. 773; 19 C. C. A. 188.

*Miller v. Tobacco Co.* 7 Fed. 92; *Robbins v. Chicago*, 4 Wall. 657; *Litchfield v. Goodnow's*, 123 U. S. 549; *Hawkins v. Glenn*, 131 U. S. 329; *Schrader v. Bank*, 133 U. S. 67; *Glenn v. Liggett*, 135 U. S. 533; *Hawes v. Petroleum*, 101 Mass. 385.

That although a party may have paid the attorney in the former suit, and paid part or all of the costs, so long as it does not appear that he had control of the litigation, he is not bound by it, see — *General v. Morgan-Gardner*, 168 Fed. 52; 93 C. C. A. 474.

### § 387. Miscellaneous.

The patentee, in prosecuting his application, distinguished his application from a prior patent to him. Having purchased a still earlier application of another inventor, he incorporated such broader claims therein. It was sought to extend the estoppel to such earlier case. *Held*: This would carry the doctrine of estoppel or abandonment by reason of conceding the soundness of departmental criticisms far beyond any recorded decision, and we cannot assent to any such extension. — *Armstrong v. Belding*, 174 Fed. 410; 98 C. C. A. 361.



Defendant acknowledged infringement and agreed not to infringe further, and afterwards put out a somewhat different device which it contended was not an infringement. As to the claimed estoppel, *held*: While defendant may not dispute the validity of the patent, nor such a construction of its claims as will cover kettles of the type it first made, it may show if it can, that those of the later type are not within the patent; and in considering this question the court may look into the prior art and construe the specifications in the light of the file wrapper, in order to determine whether the new style of kettle also infringes the patent. — *Am. Specialty v. New England*, 176 Fed. 557; 100 C. C. A. 193.

The defendants have adopted this construction and obtained whatever advantage in it there may be, and they cannot dispute its patentable utility. — *Cummer v. Atlas*, 193 Fed. 993; 113 C. C. A. 611.

*Diamond Rubber Tire v. Consolidated*, 220 U. S. 428.

## EVIDENCE.

### § 389. Anticipation — Prior Art.

Proof was taken by the complainant, but none by the respondents, although by their answer they had specified by name and place 60 prior uses, and in addition cited 70 patents as anticipations. In the absence of proof on the respondents' part, the case is therefore before us as if on demurrer. — *Greenwald v. Enochs*, 183 Fed. 583; 106 C. C. A. 351.

### § 390. Anticipation — Prior Patent or Publication.

The patent was not pleaded in the answer, and cannot be used as an anticipation. It may be considered as showing the prior art. — *Roth v. Harris*, 168 Fed. 279; 93 C. C. A. 581.

The record discloses attempts to demonstrate their actual identity (the chemical constituency of the patent in suit and the prior patent), but these are not produced in such shape as to avail the appellant. Courts place little weight on *ex parte* demonstrations in any case, but especially is this true with regard to experiments in chemicals. — *Kuehmsted v. Farbenfabriken*, 179 Fed. 701; 103 C. C. A. 243.

### § 391. Anticipation — Prior Use.

It is well settled that the defense of prior use must be established by evidence which proves it beyond a reasonable doubt. — *Parker v. Stebler*, 177 Fed. 210; 101 C. C. A. 380.

*Turrill v. Railroad*, 1 Wall. 491.

### § 395. Depositions.

That where the answers to interrogatories in a deposition are not responsive and the interrogator has had opportunity to secure correction, such evidence may be admitted, see — *Varley v. Ostheimer*, 186 Fed. 171; 108 C. C. A. 303.

### § 398. Expert.

We should regret to be compelled to decide a case by the acceptance or rejection of a theoretic explanation upon which it still is possible that authorities in science disagree. — *Steward v. American*, 215 U. S. 161; 54 L. Ed. 139; 30 S. Ct. 46.

It is only where the court requires the explanation of technical terms or the language of any particular art to enable it to understand a specification that the evidence of those expert in the art is pertinent. The province of such expert testimony is to remove uncertainty where the terms used are obscure, and is not to create uncertainty where the language is plain. — *Krupp v. Midvale*, 191 Fed. 588; 112 C. C. A. 194.

#### § 400. Invention — Fact of.

To find any substantial validity in these claims, we must determine whether invention was involved in such adaptation. Such a question is essentially one of fact. — *Herman v. Youngstown*, 191 Fed. 579; 112 C. C. A. 185.

*National Tube v. Aikin*, 163 Fed. 254; *Electric v. Westinghouse*, 171 Fed. 83; *Morgan v. Alliance*, 176 Fed. 100.

#### § 403. Law Actions — Facts — For Court.

That the question of range of equivalents in a given case is a question of law to be determined by the court and given to the jury as instruction, see — *Holt v. Best*, 172 Fed. 409; 97 C. C. A. 107.

#### § 404. Law Actions — Facts — For Jury.

Where the determination of the question of invention was left with the jury, we think it clear that nothing tending to show the true state of the art at the date of the claimed invention should be excluded from their consideration. — *Holt v. Best*, 172 Fed. 409; 97 C. C. A. 107.

*Rob. Pat. § 1020*; *Aron v. Manhattan*, 132 U. S. 84; *Penn. Ry. v. Truck Co.* 110 U. S. 490; *Benbow-Brammer v. Richmond*, 159 Fed. 161.

Upon conflicting proof it is a question for the jury to pass upon whether a patented invention is of a primary character and the patent a "pioneer patent." — *Transit Development Co. v. Cheatham*, 194 Fed. 963; 114 C. C. A. 599.

*Royer v. Schultz*, 135 U. S. 319.

That questions of invention and of infringement, in the presence of conflicting proofs, are for the jury, see — *Transit Development Co. v. Cheatham*, 194 Fed. 963; 114 C. C. A. 599.

*Heide v. Panoulis*, 188 Fed. 915; *Bischoff v. Wethered*, 76 U. S. 812.

### EXPERIMENT.

#### § 414. Experimental Use.

The use was not an abandoned experiment but an abandoned attempt to induce the railway company to equip the cars with the Brayton engine. The perfected structure was capable of practical use, although there was much room for improvement. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

### FOREIGN PATENT.

#### § 420. General Rulings.

In ascertaining the true scope and meaning of an invention, the importance of looking at the claims is recognized in England. And the necessity for doing so in this country is found in the established rule. And it would seem that the rule in this behalf prevailing in this country should be applied to a foreign patent as well as to a domestic patent, where the court is called



upon to determine the effect of the duration of the grant of the former upon that of the latter. — *Acme Acetylene v. Commercial*, 192 Fed. 321; 112 C. C. A. 573.

*Presto Gear v. Orme*, 18 R. P. C. 17; *Fulton Pat.* 98; *Keystone v. Phoenix*, 95 U. S. 274; *Railroad v. Mellon*, 104 U. S. 112; *Leeds v. Victor*, 213 U. S. 301.

#### § 421. Expiration of.

The passage (A patent cannot be exempt from the operation of the law by adding some new improvements to the invention; and cannot be construed as running partly from one date and partly from another, *Siemen v. Sellers*, 123 U. S. 276) must be construed by what precedes it. It was said there was no essential difference between the patents. "They described the same functions in all essential particulars," is the language used. "The principal invention," therefore, was "the same in both," and the improvements, which it was asserted the American patent contained, did not destroy its essence or its identity with the English patent; necessarily, therefore, did not save it "from the operation of the law." And the court meant no more than that. It was not said that a patentable improvement could not be made which could be secured by a patent which would endure beyond the expiration of a prior foreign patent for that which was improved. Such a ruling would contravene the right given by the statute. § 4886 provides that "any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, \* \* \* may \* \* \* obtain a patent therefor." The improvement would be the invention and would endure for the period given to it by law. Besides, a patent may embrace more than one invention. A process and an apparatus by which it is performed are distinct things. They may be found in one patent; they may be made the subject of different patents. So may other dependent and related inventions. If patented separately, a foreign patent for either would not affect the other. Why should such effect follow if they are embraced in the same patent? — *Leeds v. Victor*, 213 U. S. 301; 53 L. Ed. 805; 29 S. Ct. 495.

*Steinmetz v. Allen*, 192 U. S. 543; distinguishing *Siemens v. Sellers*, 123 U. S. 276; *Western v. Citizens*, 106 Fed. 215; *Sawyer v. Carpenter*, 133 Fed. 238; *affd.* 143 Fed. 976; *Thomson-Houston v. McLean*, 153 Fed. 883.

A French patent for the same invention was previously issued and two additions were applied for prior to the filing of the U. S. application. Normally, under § 4887, as then applicable, the U. S. patent would have expired with the original French patent, which, under the French law, carried the additions with it. The French patent and its additions were held void by the French courts, thus wiping out the French grant. While Judge Gray held that the voidance of the French patent by the courts relieved the U. S. patent from its operation, and while Judge Buffington dissented in a separate opinion, holding that the U. S. patent was limited from the day of its granting by the existence of the French patent then valid on its face, Judge Archbald concurred in the result reached by Judge Gray, but upon the ground that the treaty of Brussels took the U. S. patent out from under the operation of § 4887, *holding*: The article must be regarded as self-executing. A contrary opinion was given by the Attorney General as to the treaty of 1883. 19 Op. Atty. Gen. 275. And this was followed by the Patent Office. *Ex parte Zwack*, 76 O. G. 1855; *Butterworth v. Boral*, 97 O. G. 1596. It was accepted also by the Court of Appeals, D. C. *Parker v. Appert*, 75 O. G. 1201; *Rousseau v. Brown*, 104 O. G. 1120. In *United v. Duplessis*, 155 Fed. 842, also, it was held by the Court of Appeals for the First Circuit, that, although article 4 bis on its face was self-executing, it was controlled by implication by the passage by Congress of act Mar. 3, 1903, to give effect



to it. Taking treaty and acts of Congress together, therefore, the case stands this way: By § 4887 a domestic patent for the same invention previously patented abroad was made dependent upon the term of such foreign patent, by which it was limited. The act of Mar. 3, 1897, removed this restriction, but provided (§ 8) that it should not apply to patents granted prior to Jan. 1, 1898, nor to applications filed before that on which patents were subsequently granted. This prevented the patent in suit, for the time, from having the benefit of this legislation. Then the additional act of Brussels of 1900 was ratified, by which, according to art. 4 bis, there was a complete unfettering of foreign and domestic patents for the same invention; and this by express terms was made to apply to existing patents. Such was the state of the law and such the position of the patent in suit when the act of Mar. 3, 1903, came into existence. As just stated, this could not undo what had already been done, nor put back the patent into its former dependent condition. Having become entitled to the full term of 17 years according to patents generally, it could not thereafter be again restricted. Nor did the act of 1903 undertake to do so. It simply re-enacted § 4887 as amended by the act of 1897, leaving out the limitation which time and treaty had doubly disposed of, and introducing certain provisions in conformity with the treaty. — *Hennebique v. Myers*, 172 Fed. 869; 97 C. C. A. 289.

*Note:* It will thus be seen that the Third and First Circuits are at variance upon the construction of the legislation as to this treaty, and that this case presents two unsettled questions to be passed upon by the Supreme Court.

A French patent for the same invention was previously issued and two additions were applied for prior to the filing of the U. S. application. Normally, under § 4887 as then applicable, the U. S. patent would have expired with the original French patent, which, under the French law, carried the additions with it. The French patent and its additions were held absolutely void by the French courts, thus wiping out the foreign grant. *Held:* The words "foreign patent" and "patented in a foreign country," in § 4887, must be taken to connote matters of substance, and not of mere form, and the French patent and the addition thereto, though regular in form, conferred no such privilege or monopoly as would bring them within the purview of the section referred to. They conveyed to the patentee no substantial rights, and secured to him no valuable monopoly. *Hennebique v. Myers*, 172 Fed. 869; 97 C. C. A. 289.

*Note:* This opinion of Judge Gray is rigorously dissented to by Judge Buffington in a separate opinion, and is concurred in as to results by Judge Archbald in a separate opinion, but on wholly different grounds, viz. that by the treaty of Brussels, art. 4 bis, the U. S. patent was relieved from the operation of § 4887 as it stood at the time the U. S. patent was applied for, and thus disagreeing with and refusing to follow the First Circuit in *United v. Duplessis*, 155 Fed. 842. It would seem that two questions are here raised and left in dispute which must be passed upon by the Supreme Court.

Clearly, the patent granted and so limited in this country must be for an invention previously patented in a foreign country, and they must in essential features be the same. — *Acme Acetylene v. Commercial*, 192 Fed. 321; 112 C. C. A. 573.

*Leeds v. Victor*, 213 U. S. 301; *Siemens v. Sellers*, 123 U. S. 276; *Westinghouse v. Stanley*, 138 Fed. 823.



### § 422. Lapse of.

That the lapse or forfeiture of a foreign patent by reason of failure such as failure to extend does not affect the domestic patent for the same invention, see — *Leeds v. Victor*, 213 U. S. 301; 53 L. Ed. 805; 29 S. Ct. 495.

*Pohl v. Anchor*, 134 U. S. 381.

## FUNCTION.

### § 426. Patentability.

It is undoubtedly true, and all the cases agree, that the mere function or effect of the operation of a machine cannot be the subject of a lawful patent. — *Expanded v. Bradford*, 214 U. S. 366; 53 L. Ed. 1034; 29 S. Ct. 652.

## GOVERNMENT.

### § 428. Statutory Provisions.

By act of June 25, 1910, the following provision was made as “additional protection for owners of patents:”

That whenever an invention described in and covered by a patent of the United States shall hereafter be used by the United States without license of the owner thereof or lawful right to use the same, such owner may recover reasonable compensation for such use by suit in the court of claims: Provided, however, That said court of claims shall not entertain a suit or award compensation under the provisions of this act where the claim for compensation is based on the use by the United States of any article heretofore owned, leased, used by, or in the possession of, the United States: Provided, further, That in any such suit the United States may avail itself of any and all defenses, general or special, which may be pleaded by a defendant in an action for infringement, as set forth in title sixty of the Revised Statutes or otherwise: And provided further, That the benefits of this act shall not inure to any patentee who, when he makes such claim, is in the employment or service of the government of the United States; or the assignee of any such patentee; nor shall this act apply to any device discovered or invented by such employee during the time of his employment or service.

## IMPROVEMENT.

### § 430. Statute Authority and General Statement.

Invention, in the nature of improvements, is the double mental act of discerning, in existing machines, or processes or articles, some deficiency, and pointing out the means of overcoming it. — *General Electric v. Sangamo*, 174 Fed. 246; 98 C. C. A. 154.

*Note:* This clear-cut definition ought to induce the Patent Office to correct its loose and improper use of the term “improvement.”

### § 434. General Rule.

*Singer's* invention may not be a great or a pioneer one. That invention and the prior art present one of those cases in which several inventors produce by different processes different compositions which collect dust with varying degrees of operative success. Under such circumstances, each inventor is entitled to his own method and composition so long as they differ from those of his competitors, and do not include theirs. Dissenting opinion of Judge Sanborn in — *Cotto-Waxo v. Perolin*, 185 Fed. 267; 107 C. C. A. 373.

*Railway v. Sayles*, 97 U. S. 554; *McCormick v. Talcott*, 29 How. 402.

### § 435. Generic.

Whether an invention be a pioneer, or, being of small importance, is ranked at the foot of the line, the rule is that each shall be judged on its own merits; that is to say, according to the advance it has made in novelty and utility beyond the former art. And in its own peculiar field it is not upon this record to be denied that this invention was the first, and for that reason and because it has proved useful to the public, should be dealt with as one standing at the head of its line and entitled to be protected accordingly. — *Vrooman v. Penhollow*, 179 Fed. 296; 102 C. C. A. 484.

*McSherry v. Dowagiac*, 101 Fed. 716; *Penfield v. Chambers*, 92 Fed. 639; *Paper Bag Case*, 210 U. S. 405.

### § 440. Patentability.

And it (the law) recognizes degrees of change, dividing inventions into primary and secondary, and as they are, one or the other, gives a proportionate dominion to its patent grant. In other words, the invention may be broadly new, subjecting all that comes after it to tribute; it may be the successor, in a sense, of all that went before, a step only in the march of improvement, and limited, therefore, to its precise form and elements, as the patent in suit is conceded to be. In its narrow and humble form it may not excite our wonder as may the broader or pretentious form, but it has as firm a right to protection. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

*Chicago v. Sayles*, 97 U. S. 554.

### § 441. Scope — Limitations.

Where an art is crowded and so old that no pioneer patent exists therein, and many inventors have conceived and made machines, combinations and improvements in it which accomplish the desideratum with varying degrees of success, each is entitled to his own machine or combination or improvement, so long as it differs from those of his competitors and does not include theirs. — *Wayne v. Benbow-Brammer*, 168 Fed. 271; 93 C. C. A. 573.

*Railway v. Sayles*, 97 U. S. 554; *McCormick v. Talcott*, 20 How. 402; *Stirrat v. Excelsior*, 61 Fed. 980; *National v. Interchangeable*, 106 Fed. 693.

When each of two inventors improves upon the former art, each in his own distinct and separate way, they shall each be credited with his own improvement. — *Duncan v. Cincinnati*, 171 Fed. 656; 96 C. C. A. 400.

Once, therefore, that an automatic cut-off was made use of in either of these earlier devices, it was conclusive upon the novelty of the idea upon everyone coming after; and the only thing open to later inventors was the particular means that might be adopted for the accomplishment of this purpose. — *Elliott v. Youngstown*, 181 Fed. 345; 104 C. C. A. 175.

## INFRINGEMENT.

### § 452. Avoidance — Adding Elements or Functions.

That mere addition of an element to avoid a combination with no change of function does not avoid infringement, see — *Western Telephone v. Swedish-American*, 194 Fed. 104; 114 C. C. A. 182.

### § 456. Avoidance — Omitting Element.

If any essential element of the combination is omitted from an alleged infringing device without substituting therefor its clear mechanical equiva-



lent, the charge of infringement is not sustained. — *Acme v. Meredith*, 183 Fed. 124; 105 C. C. A. 420.

*Fay v. Cordesman*, 109 U. S. 408; *Boyd v. Janesville*, 158 U. S. 260; *Cimiotti v. American*, 198 U. S. 399; *Eames v. Godfrey*, 1 Wall. 78; *Rowell v. Linsay*, 113 U. S. 97; *Union v. Diamond*, 162 Fed. 148.

If the defendants do not use the modified Brayton engine and do use the modified Otto engine, they escape infringement unless the latter is an equivalent of the former. It is well settled that to establish infringement of a combination, the use of every element of the combination must be shown. — *Columbia v. Duerr*, 184 Fed. 893 (note, p. 910); 107 C. C. A. 215.

The use of any two of these parts only, or of two combined with a third, which is substantially different in form or in the manner of its arrangement with the others, is, therefore, not the thing patented. It is not the same combination if it substantially differs from it in any of its parts. — *Electric Protection v. American*, 184 Fed. 916; 107 C. C. A. 238.

*Eames v. Godfrey*, 1 Wall. 78.

It is settled that a claim for a combination is not infringed if any one of the elements is omitted without substitution of an equivalent. — *Union Paper Bag v. Advance*, 194 Fed. 126; 114 C. C. A. 204.

Citing old and familiar cases.

#### § 457. Avoidance — Transposition of Parts.

Assuming that the defendant makes the asserted transposition, which is by no means clear on the proof, we are satisfied that infringement is not thus avoided. — *General Electric v. Hill-Wright*, 174 Fed. 996; 98 C. C. A. 566.

#### § 458. Avoidance — Miscellaneous Conditions.

Appellant complains because after the decision in the former case respondent deliberately set about devising, with the aid of patent experts, a machine which would produce the Bates fence, without infringing the Bates patent. It is sufficient to answer that complaint in the language of Mr. Justice Grier in *Burr v. Duryee*, 1 Wall. 531: "Every man has a right to evade a patent, provided he does not invade the rights of the patentee." — *Am. Steel & Wire v. New Jersey*, 194 Fed. 117; 114 C. C. A. 195.

#### § 459. Change of Form — Colorable.

Mere changes of the form of a device do not avoid infringement, where the principle of the invention is taken, unless the form modified is the distinguishing characteristic of the invention. — *Wayne v. Benbow-Brammer*, 168 Fed. 271; 93 C. C. A. 573.

*National v. Interchangeable*, 106 Fed. 693; *Columbus v. Robbins*, 64 Fed. 384.

Mere changes of form or composition of a device or of some of the mechanical elements of a combination will not avoid infringement, where the principle or mode of operation of the patented improvement or combination is adopted, unless the form or composition is the distinguishing characteristic of the invention. — *Owens v. Twin City*, 168 Fed. 259; 93 C. C. A. 561.

*Columbus v. Robbins*, 64 Fed. 384; *New Departure v. Bevin*, 64 Fed. 859; *Machine v. Murphy*, 97 Fed. 125; *Winans v. Denmead*, 15 How. 342; *Rob. Pat. § 141*; *Blandy v. Griffith*, Fed. Cas. 1529; *Bonnette v. Koehler*, 82 Fed. 431; *National v. Interchangeable*, 106 Fed. 693.

Mere changes of the form of some of the mechanical elements of a combination secured by patent will not avoid infringement, where the principle of the patented invention is adopted, unless the form of the elements changed is the distinguishing characteristic of the invention. Dissenting opinion of Sanborn, J. in — *Electric Protection v. American*, 184 Fed. 916; 107 C. C. A. 238.

*Watch Co. v. Robbins*, 64 Fed. 384; *New Departure v. Bevin*, 64 Fed. 859; *Kinloch v. Western*, 113 Fed. 652; *Lourie v. Lenhart*, 130 Fed. 122.

#### § 460. Change of Form — Location.

It is evident, therefore, that the respondent has availed itself of the substance of Conley's device by a mere shifting of parts, which in the shifted position still exert the identical functions of the device Conley first contributed to the art. It follows, therefore, the respondent must be held to infringe. — *Conley v. King Bridge*, 187 Fed. 137; 109 C. C. A. 412.

#### § 461. Change of Form — Modification.

Infringement is not avoided by the fact that one of the integral elements is separated into two or more distinct parts, so long as the function and operation remain substantially the same. — *Kings County v. U. S. Consolidated*, 182 Fed. 59; 104 C. C. A. 499.

*Kalamazoo v. Duff*, 113 Fed. 264; *Bundy v. Detroit*, 94 Fed. 524; *Brammer v. Witte*, 159 Fed. 726.

#### § 462. Change of Form — Number of Parts.

The first element of the claim is a frame, and any one who uses it in combination with the other elements is an infringer, whether the frame is composed of one piece or fifty. — *Waterbury v. Aston*, 183 Fed. 120; 105 C. C. A. 410.

#### § 468. Combination — Equivalents.

We have seen De Bange describe what he conceived to be the best form of his invention, and contemplated that it could be represented in other forms and proportions. This, however, was unnecessary, for the law would secure him against imitation by other forms and proportions. — *United States v. Société Anonyme &c.* 224 U. S. 309; 56 L. Ed. 224; 32 S. Ct. 479.

*Winans v. Denmead*, 15 How. 330; *Hotchkiss v. Greenwood*, 11 How. 248; *Western Electric v. LaRue*, 139 U. S. 601.

The use of the tang in question in place of the lower central gripper does not amount to the substitution of a mechanical equivalent; for that would be to treat the paper made into diamond folds by the machine as an element of the patent. — *Union Paper Bag v. Advance*, 194 Fed. 126; 114 C. C. A. 204.

*Morgan v. Albany*, 152 U. S. 425; *Am. Tobacco v. Streat*, 83 Fed. 700.

#### § 469. Combinations — Identity.

A patent for a mechanical combination is not infringed except by a device containing all the elements of that combination. The elements of the infringing device must be the very elements of the patented combination or clear mechanical equivalents thereof. — *Ohl v. Falstrom*, 175 Fed. 67; 99 C. C. A. 89.

A combination claim is never infringed, except by the use of that which embodies every element of the combination or its equivalent. — *Morton Trust v. Standard*, 177 Fed. 931; 101 C. C. A. 211.



#### § 474. Contributory — Furnishing Material.

The case (*Morgan v. Albany*, 152 U. S. 425) has no principle or reasoning applicable to the case at bar. The disc is not a mere concomitant to the stylus; it coacts with the stylus to produce a result. To confound its active cooperation with the mere passivity of the paper in the mechanism described in the *Morgan Envelope Company* is not only to confound essential distinctions made by the patent laws, but essential distinctions between entirely different things. Besides, the lower courts found that the discs were not perishable. Can petitioner find justification under the right of repair and replacement? The sales of petitioner, as found by the courts below, and as established by the evidence, were not to furnish new records identical with those originally offered by the *Victor Company*, but, to use the language of Judge Lacombe, "more frequently in order to increase the repertory of tunes than as substitute for worn-out records." The right of substitution or "resupply" of an element depends upon the same test. The license granted to a purchaser of a patented combination is to preserve its fitness for use so far as it may be affected by wear or breakage. Beyond this there is no license. — *Leeds v. Victor*, 213 U. S. 325; 53 L. Ed. 816; 29 S. Ct. 503.

*Wilson v. Simpson*, 9 How. 109; *Chaffee v. Boston*, 22 How. 217.

#### § 476. Contributory — Making Elements.

A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or noncomposite instrument. Whoever uses it without permission is an infringer of it. Whoever contributes to such use is an infringer of it. It may be well here to get rid of a misleading consideration. It can make no difference as to the infringement or noninfringement of a combination that one of its elements or all of its elements are unpatented. — *Leeds v. Victor*, 213 U. S. 325; 53 L. Ed. 816; 29 S. Ct. 503.

That building a machine which embodies a part of and is essential to the carrying out of a process is infringement, see — *Naylor v. Alsop*, 168 Fed. 911; 94 C. C. A. 315.

That furnishing material to be used in connection with an infringing device — such as refilling acetylene gas tanks which are patented — is contributory infringement, see — *Acme Acetylene v. Commercial*, 192 Fed. 321; 112 C. C. A. 573.

*Leeds v. Victor*, 213 U. S. 325; *Commercial Acetylene v. Autolux*, 181 Fed. 387; *Edison v. Peninsular*, 101 Fed. 831; *Aeolian v. Juelg*, 155 Fed. 119; *Heaton v. Eureka*, 77 Fed. 288; *Rupp v. Elliott*, 131 Fed. 730; *Kalem v. Harper*, 222 U. S. 55.

#### § 477. Contributory — Rules.

"Contributory infringement," says Judge Townsend in *Thomson-Houston v. Kelsey*, "has been well defined as the intentional aiding of one person by another in the unlawful making, or selling or using of the patented invention." \* \* \* There must be an intent and purpose that the article sold will be so used. Such a presumption arises when the article so sold is only adapted to an infringing use. It may also be inferred where its most conspicuous use is one which will co-operate in an infringement when such sale to such user is invoked by advertisement. — *Henry v. Dick*, 224 U. S. 1; 56 L. Ed. 645; 32 S. Ct. 364.

*Thomson-Houston v. Kelsey*, 72 Fed. 1016; *Wallace v. Holmes*, 29 Fed. Cas. 79; *Risdon v. Trent*, 92 Fed. 375; *Thomson-Houston v. Ohio*, 80 Fed. 721;

*Am. Graphophone v. Hawthorne*, 92 Fed. 516; *Rupp v. Elliott*, 131 Fed. 730; *Kalem v. Harper*, 222 U. S. 55.

#### § 481. Corporations — Officers of.

This court absolutely and entirely rejects the not uncommon view that the fiction of distinct corporate existence can be made to serve as a shield against the consequences of individual wrongdoing. Upon the presentation of a case showing active participation by an officer of a corporation in the infringement of a patent, we have been, and shall be, not slow to disregard the corporate device and enforce personal responsibility. — *Weston v. Empire*, 177 Fed. 1006; 100 C. C. A. 670.

That the question of the non-liability of an officer of a corporation, in the absence of evidence, cannot be raised for the first time on appeal, see — *Vrooman v. Penhollow*, 179 Fed. 296; 102 C. C. A. 331.

#### § 485. Division or Union of Parts or Elements.

A mere splitting up of the parts of a patented structure, the functions remaining the same, does not avoid infringement. — *Nu Bone v. Spirella*, 183 Fed. 984; 106 C. C. A. 321.

#### § 487. Evidence of — Acts of Defendant.

That where the defendant conceded the validity of the patent, agreed to discontinue infringement and was released from liability for its past acts, the mere fact that the defendant continued to show the infringing article in its advertisements thereafter — there being no other proof of infringement subsequent to such release — is insufficient to warrant a preliminary injunction, see — *Am. Specialty v. New England*, 176 Fed. 557; 100 C. C. A. 193.

That the motives or conduct of a defendant when acting within his rights cannot be construed as evidence of infringement, see — *Twentieth Century v. Taplin*, 181 Fed. 96; 104 C. C. A. 156.

Bauer solved the problem; his simple changes have produced strength where formerly there was weakness and stability where there was infirmity. No better proof of this is needed than the tenacity with which the defendant has insisted upon using the patented structure. — *Simplex Railway v. Pressed Steel*, 189 Fed. 70; 110 C. C. A. 634.

#### § 488. Evidence of — Burden.

Infringement is not only a question of fact, but it is a tort or wrong, the burden of establishing which, as in all torts, clearly rests on those who charge such wrong. The absence of actual proof is not met by the presence of expert speculations, no matter how voluminous. — *Krupp v. Midvale*, 191 Fed. 588; 112 C. C. A. 194.

#### § 489. Evidence of — Expert.

The absence of actual proof is not met by the presence of expert speculations, no matter how voluminous. — *Krupp v. Midvale*, 191 Fed. 588; 112 C. C. A. 194.

#### § 490. Evidence of — Function.

Complainant's and defendant's grates each perform the same functions. While it is necessary to constitute infringement that each should perform



the same function, performance of the same function does not alone constitute infringement. — *Johnson v. Western*, 178 Fed. 819; 102 C. C. A. 267.

*Eames v. Godfrey*, 1 Wall. 78; *Burr v. Duryee*, 1 Wall. 531; *Westinghouse v. Boyden*, 170 U. S. 568.

That identity of function or result is not evidence of infringement where the means or methods employed differ, see — *Kellogg v. Dean*, 182 Fed. 991; 105 C. C. A. 545.

That while the difference between simultaneous or continuous operation and successive or intermittent operation may not be proof of noninfringement, it argues therefor, see — *Am. Steel & Wire v. New Jersey*, 194 Fed. 117; 114 C. C. A. 195.

#### § 491. Evidence of — Identity.

The mere fact that the defendant's device may be within the letter of the claim sued on is not conclusive proof of infringement. This is shown in the opinion of Judge Cross in the court below (171 Fed. 666). — *Gen. Electric v. Allis-Chalmers*, 178 Fed. 273; 101 C. C. A. 537.

Patentable difference does not of itself tend to negative infringement. It may just as well be based upon infringement plus improvement; and improvement may lie in addition, simplification, or variance. — *Herman v. Youngstown*, 191 Fed. 579; 112 C. C. A. 185.

#### § 494. Evidence of — Sufficiency.

*It would seem* that where there is both a method and machine patent and the method is clearly patentable and the machine patent is doubtful, the doubt should be resolved in favor of the defendant on the ground that complainant has adequate relief under the other patent. — *General Knit Fabric v. Steber*, 194 Fed. 99; 114 C. C. A. 177.

#### § 495. Evidence of — Utility — Use by Defendant.

The patent itself was evidence of the utility of claim 4 and the defendant was estopped from denying that it was of value. — *Westinghouse v. Wagner*, 225 U. S. 604; 56 L. Ed. —; 32 S. Ct. 691.

*Lehnbeuter v. Holthaus*, 105 U. S. 94.

#### § 496. Evidence of — Miscellaneous Holdings.

The last item of proof in the case is a blue-print of the machine which the defendant is now using. There is not a line of testimony explaining the exhibit. It is a complicated drawing, and it would be highly presumptuous in us to say it shows infringement. — *Morton Trust v. Standard*, 177 Fed. 931; 101 C. C. A. 211.

The fact that the formulae are identical cuts little figure. A chemical formula is simply the symbolical expression of the composition or constitution of a substance. — *Kuehmsted v. Farbenfabriken*, 179 Fed. 701; 103 C. C. A. 243.

#### § 497. Generic Patent.

It is a general rule that there is a presumption that a process or apparatus of a later patent does not infringe the process or apparatus of an earlier patent relating to the same subject. There is also a general rule that there is a presumption that a process or apparatus of a later patent does not infringe

the process or apparatus of an earlier patent between which the Commissioner of Patents has decided that there was no interference. But there is an exception to this rule that where a patentee has made a primary invention of a new and useful process or apparatus which accomplishes a result never before produced by such a process or machine, the presumption that a process or apparatus of a later patent on the same subject is for a subordinate improvement or modification of the primary invention and hence subject to an infringement of the earlier patent which secures it, is at least as strong as the presumptions of the general rules, because there are many more patents for subordinate improvements and modifications of primary inventions than there are for such inventions, and hence more probability that a given process or apparatus is of the former than that it is of the latter class. — *Century Electric v. Westinghouse*, 191 Fed. 350; 112 C. C. A. 8.

*Ries v. Barth*, 136 Fed. 850; *Boyd v. Janesville*, 158 U. S. 260; *Consolidated v. Crosby*, 113 U. S. 157; *Morley v. Lancaster*, 129 U. S. 263; *National v. Interchangeable*, 106 Fed. 693; *Crown v. Aluminum*, 108 Fed. 845.

### § 498. By Government.

The text of this statute (Act June 25, 1910, see App. § 428) leaves no room to doubt that it was adopted in contemplation of the contingency of the assertion by a patentee that rights secured to him by a patent had been invaded for the benefit of the United States by one of its officers; that is, that such officer, under the conditions stated, had infringed a patent. The enactment of the statute, we think, grew out of the operation of the prior statute law concerning the right to sue the United States for the act of an officer in infringing a patent, as interpreted by repeated decisions of this court. — *Crozier v. Krupp*, 224 U. S. 290; 56 L. Ed. 771; 32 S. Ct. 488.

*United States v. Palmer*, 128 U. S. 262; *Schillinger v. U. S.* 155 U. S. 163; *United States v. Berdan*, 156 U. S. 552; *Russel v. U. S.* 182 U. S. 516; *Harley v. U. S.* 198 U. S. 229.

### § 500. Identity — Means Employed.

It does not necessarily follow that, because the separate elements unaffected by their special adaptations might be found in both patents, the combinations are therefore the same. — *Duncan v. Cincinnati*, 171 Fed. 656; 96 C. C. A. 400.

*Westinghouse v. Boyden*, 170 Fed. 537.

It is no defense to a charge of infringement of a process, a machine or a combination clearly described and claimed in a patent that it, or some part of it, was misnamed therein, or that the infringer had called it by a name different from that applied to it by the patentee. Patents protect new and useful processes, machines and combinations, whatever their names, when they are clearly described and claimed in the specification. — *Century Electric v. Westinghouse*, 191 Fed. 350; 112 C. C. A. 8.

### § 503. Identity — Tests of.

To sustain the charge of infringement the infringing device must be substantially identical with the one alleged to be infringed in (1) the result attained; (2) the means of attaining that result; and (3) the manner in which its different parts operate and co-operate to produce the result. If the devices are substantially different in either of these respects the charge of infringement is not sustained. — *Electric Protection v. American*, 184 Fed. 916; 107 C. C. A. 238.

*Machine Co. v. Murphy*, 97 U. S. 120; *Eames v. Godfrey*, 1 Wall. 78; *National v. Interchangeable*, 106 Fed. 693; *Adams v. Lindell*, 77 Fed. 432.



### § 505. Importation and Exportation.

The use of articles covered by a United States patent within the United States can no more be controlled by foreign law than the sale can. The sale by a German patentee of a patented article may take it out of the monopoly of the German patent, but how can it take it out of the monopoly of the American patentee who has not sold? — *Daimler v. Conklin*, 170 Fed. 70; 95 C. C. A. 346.

*Featherstone v. Ormonde*, 53 Fed. 110.

### § 506. Improvement — By an Improvement.

The mechanism of defendant differs in some respects from that of the patent. It is made under a later patent issued to defendant, but that circumstance does not necessarily negative infringement. The later patent expressly states that it relates to improvements in stitch-forming mechanism such as is illustrated in the patent in suit. It not infrequently happens that some improvement of an older device exhibits patentable novelty, but cannot be put in practice without infringement of the original device, which it has improved. — *Acme-Keystone v. Dearborn*, 185 Fed. 503; 107 C. C. A. 603.

### § 507. Improvement — Of an Improvement.

That in determining whether there is infringement of an improvement the scope of the prior patent must be determined, see — *Herman v. Youngstown*, 191 Fed. 579; 112 C. C. A. 185.

### § 508. Intent.

The infringement of a patented combination is complete when the component parts of the combination are made or sold, fitted to be put together and intended to be put together. The infringement in this case was clearly a direct infringement. The facts do not show a partial infringement in aid of a complete infringement. He sold both parts of the combination in a condition ready to be put together to make a completed structure. His offense contained all the elements of a direct infringement. — *Kreplik v. Couch Patents*, 190 Fed. 565; 111 C. C. A. 381.

*Goodyear v. Jackson*, 112 Fed. 148; *Bullock v. Westinghouse*, 129 Fed. 105.

### § 510. License — By Licensee.

That a patentee may effectually restrict the time, place or manner of using a patented machine, so that a prohibited use will constitute an infringement of the patent, is fully conceded. \* \* \* The books abound in cases upholding the right of a patentee owner of a machine to license another to use it subject to any qualification in respect of time, place, manner or purpose of use which the licensee agrees to accept. Any use in excess of the license would obviously be an infringing use and the license would be no defense. — *Henry v. Dick*, 224 U. S. 1; 56 L. Ed. 645; 32 S. Ct. 364.

*Note:* This is final authority; see long list of cases cited by Justice Lurton in foot-note.

Complainant and defendant entered into a cross-license agreement permitting each to "operate" under the patents of the other. Defendant took from a third party in trade goods made by said party in infringement of the patents of complainant and resold them as its goods. *Held:* The order is sought to be sustained on the ground that selling these records was a violation of the agreement. Conceding, without admitting, this to be so, the act

would not be a contempt, but a breach of contract, to be remedied in an action at law. — *Am. Graphophone v. Victor*, 183 Fed. 580; 106 C. C. A. 348.

*Washburn v. Southern*, 37 Fed. 428.

#### § 519. Process — Tests of.

The real test of infringement is not identity of product which is not patented, but identity of patented process in producing an unpatented product. — *Krupp v. Midvale*, 191 Fed. 588; 112 C. C. A. 194.

#### § 520. Process — Miscellaneous.

The patentee is entitled to the protection of his process against its use by such a subsequently invented machine, and also to protection of his apparatus against its infringement by its mechanical equivalents. — *Century Electric v. Westinghouse*, 191 Fed. 350; 112 C. C. A. 8.

#### § 528. Tests — Interchangeability.

The mechanism of the two hammers is not interchangeable, and noninterchangeability is an important test in determining the question of infringement. — *Boyer v. Cleveland*, 185 Fed. 808; 108 C. C. A. 40.

*Miller v. Eagle*, 151 U. S. 186.

#### § 531. Tests — Miscellaneous.

Infringement is to be judged by the state of the art when it takes place, and not by something which has come in since. — *Novelty v. Brookfield*, 170 Fed. 946; 95 C. C. A. 516.

### INJUNCTION.

#### § 535. Appeals — Comity.

Judge Coxe states the principles which should control when application for a preliminary injunction is subsequently made and resisted on ex parte affidavits, as follows: "There can be no doubt that the doctrine of comity not only, but the orderly administration of justice, requires that the Circuit Court should adopt and follow the decisions of the Circuit Courts of Appeals in other circuits than their own, rendered upon facts substantially identical. Any other rule would lead to confusion and injustice. Of course in such circumstances the defendant in patent causes may introduce new evidence of anticipation and may show that the facts on which infringement is based are essentially different from those in the adjudicated case. Such proof must carry conviction with it." Appellant's brief bitterly attacks this statement, but we understand it to be an accurate presentation of the law and find nothing in *Mast v. Stover*, 177 U. S. 488, which calls for a different conclusion. The practice indicated by Judge Coxe has been uniformly followed in this circuit. — *Warren Bros. v. City of N. Y.* 187 Fed. 831; 109 C. C. A. 591.

*Box Co. v. Paper Co.* 51 Fed. 229; *Doig v. Morgan*, 91 Fed. 1001; *N. Y. Filter v. Niagara*, 80 Fed. 924; *Consolidated Rubber Tire v. Diamond*, 157 Fed. 677.

#### § 536. Appeals — Contempt, General.

Writ of error will lie only when the fine is clearly punitive, and in vindication of the authority of the court, as in the case where the fine is made payable in whole or in part to the United States. — *Heller v. National*, 168 Fed. 249; 93 C. C. A. 551.

*In re Christensen*, 194 U. S. 458.



A contempt case like the present one, where the fine imposed is payable to the United States, and where the party adjudged to be in contempt is not a party to the cause in which the contempt occurs, is in its nature a criminal and not a civil proceeding. The judgment is final. For these reasons it is reviewable on a writ of error. — *In re Grove*, 180 Fed. 62; 103 C. C. A. 416.

**§ 538. Appeals — Contempt — Reverse of Rule in Debs Case.**

The matter sought to be reviewed is an order adjudging Henry S. Grove (president of defendant) guilty of contempt for having refused to produce before the examiner, in response to a subpoena duces tecum. The penalty imposed was a fine of \$1 payable to the United States. The case is therefore one in which the fine was punitive and in vindication of the authority of the court, and not compensatory to the complainants in the principal case. It follows that the order of the circuit court is reviewable on a writ of error. — *In re Grove*, 180 Fed. 62; 103 C. C. A. 416.

*Bessette v. Conkey*, 194 U. S. 324; *id.*, 133 Fed. 163; *In re Christensen*, 194 U. S. 458.

**§ 539. Appeals — Decision on Merits.**

Familiar rule and familiar citations in — *Sheffield v. D'Arcy*, 194 Fed. 686; — C. C. A. —.

**§ 540. Appeals — Dismissing Bill.**

It is now well settled by the supreme court that the court, in passing upon an appeal of this character (appeal from order granting an injunction), may consider and decide the case on the merits. — *Berliuer v. Seaman*, 110 Fed. 30; 49 C. C. A. 99.

*Smith v. Iron Works*, 165 U. S. 518.

**§ 543. Appeals — Sound Discretion.**

That the refusal of the trial court to permit the complainant to adduce evidence to show the amount of his damage by reason of the violation of injunction by defendant is a matter of discretion and not appealable, see — *Cazier v. Mackie-Lovejoy*, 168 Fed. 701; 94 C. C. A. 215.

That where the primary question is that of discretion exercised by the court below, the appellate court will not go further into the case, see — *Grushlaw v. Phoenix*, 183 Fed. 222; 105 C. C. A. 484.

The general rule is that unless it explicitly appears that the court has proceeded upon an erroneous hypothesis of pertinent fact or law, or has improvidently exercised its legal discretion, the order will not be disturbed. — *Acme Acetylene v. Commercial*, 192 Fed. 321; 112 C. C. A. 573.

*Interurban v. Westinghouse*, 186 Fed. 166; *Shelbyville v. Glover*, 184 Fed. 234.

**§ 544. Appeals — What Considered on.**

The granting or refusing of a preliminary injunction ordinarily rests in the sound discretion of the trial court, and the review thereof by an appellate court is limited to the inquiry whether there was abuse of discretion in granting the writ. — *Kings County v. U. S. Consolidated*, 182 Fed. 59; 104 C. C. A. 499.

*Blount v. Société*, 53 Fed. 98; *Jensen v. Norton*, 64 Fed. 662; *Southern v. Earl*, 82 Fed. 690.

The general rule is that the (injunction) order will not be disturbed unless it clearly appears that the court below has exercised the discretion, which it admittedly has, upon a wholly wrong comprehension of the facts or law of the case. — *Interurban v. Westinghouse*, 186 Fed. 166; 108 C. C. A. 298.

*Thomson-Houston v. Ohio*, 80 Fed. 712; *Loew v. German-American*, 107 Fed. 949; *Proctor v. Globe*, 92 Fed. 357; *Paris v. Hill*, 102 Fed. 148.

We may say with respect to the present case that this rule (sound discretion) requires us to pass upon any question of law, the determination of which was necessarily involved in the granting of the order. — *Acme Acetylene v. Commercial*, 192 Fed. 321; 112 C. C. A. 573.

*Bissell v. Goshen*, 72 Fed. 545.

#### § 545. Appeals — Miscellaneous Rulings.

We cannot agree with the proposition of counsel that once this court had declared the validity and infringement of the letters patent, and remanded the case for further proceedings not inconsistent with its opinion, the right of an injunction followed as a matter of course, and that the circuit court was without discretion in the premises. No ruling to that effect has been cited, and, instead of there being no authority to the contrary, there are many cases at circuit in which such discretion has been exercised. — *In re Chicago Sugar Ref.* 87 Fed. 750; 31 C. C. A. 221.

#### § 546. Bond.

That although a patent may have been sustained on appeal in another circuit, where the injunction would work hardship and the defendant is entirely responsible, a bond may be required in lieu, see — *Westinghouse v. Burton*, 77 Fed. 301; 23 C. C. A. 174.

That where an injunction is granted conditioned upon complainant giving a bond in a sum specified, in the event of failure of complainant to succeed, the damages which defendant can recover cannot exceed the amount of the bond, see — *Cimiotti v. American*, 168 Fed. 529; 93 C. C. A. 546.

That where the patent has but a short time to run, and the granting of a preliminary injunction would work serious consequences with the defendant, the injunction may be suspended pending appeal with proper bond, see — *Interurban v. Westinghouse*, 186 Fed. 166; 108 C. C. A. 298.

#### § 548. Discontinuance or Non-Use.

The fact that a defendant has ceased to infringe and promised not to infringe in the future does not necessarily prevent an injunction issuing against him. Indeed, under such conditions, an injunction would ordinarily issue. But still an injunction is only granted to prevent threatened injury. If it is clear that no injury is threatened, it should not issue. — *Crier v. Innes*, 170 Fed. 324; 95 C. C. A. 508.

The appellant for two or three months at a period of about one year before the bill was filed, made and sold some of these sockets; they then discontinued the use of that form and adopted the later numbered styles. It does not appear that the appellee was notified of the discontinuance of the infringing style or had any knowledge that it had been discontinued. We cannot say that it had no reason for apprehending that its use would be discontinued, or would not be renewed. In these circumstances, the appellee was entitled to file its bill for an injunction. — *Yost v. Perkins*, 179 Fed. 511; 103 C. C. A. 116.



**§ 549. Discretion of Court.**

The grant of a preliminary injunction rests in the discretion of the trial court, not in its arbitrary, whimsical will, but in its sound judicial discretion, informed and guided by the established principles, rules, and practice of equity jurisprudence; and where the court has not departed from them, its injunctive orders may not be reversed without clear proof of an abuse of its discretion. — *Kryptok v. Stead*, 190 Fed. 767; 111 C. C. A. 495.

**§ 552. General Rules for Refusing.**

Injunction is not the appropriate remedy to procure relief for past injuries, and is to be used only in the prevention of further injury when further injury is actually threatened. — *Kennicott v. Bain*, 185 Fed. 520; 107 C. C. A. 626.

High, Inj. § 23; *Gen. Electric v. New England*, 123 Fed. 310; *Odell v. Stout*, 22 Fed. 159.

**§ 554. Grounds for Granting — Acquiescence.**

The patent in suit has never been adjudicated, and it is, of course, the general rule that a preliminary injunction will not be issued upon an unadjudicated patent. But exceptions to this rule exist in cases where the validity of the patent has been admitted and acquiesced in. — *Standard Typewriter v. Standard*, 181 Fed. 500; 104 C. C. A. 248.

That where a patent has been upheld in a prior suit and the defendant there and others took out licenses under the patent, such acquiescence is persuasive, see — *Grushlaw v. Phoenix*, 183 Fed. 222; 105 C. C. A. 484.

**§ 555. Grounds for Granting — Conduct of Defendant.**

For a case specifying a number of acts, any one of which should entitle complainant to an injunction, see — *Standard Typewriter v. Standard*, 181 Fed. 500; 104 C. C. A. 248.

**§ 559. Grounds for Granting — Nature of Act.**

Appellant takes the position that a well-grounded apprehension of infringement may, in a proper case, alone suffice to support a bill quia timet for an injunction, without any established breach; that the patent being valid, the fact of a breach has ordinarily been held sufficient to justify an injunction because of a well-grounded apprehension of a repetition of the infringement. From this position, as a proposition of law, we do not dissent. — *Kennicott v. Bain*, 185 Fed. 520; 107 C. C. A. 626.

*Woolworth v. Stone*, Fed. Cas. 18,021; *Facer v. Midvale*, 38 Fed. 231; *Celluloid v. Arlington*, 34 Fed. 324; *Brookfield v. Elmer*, 132 Fed. 312; *Sawyer v. Turner*, 55 Fed. 979; *Kane v. Candy Co.* 44 Fed. 287; *Matthews v. National*, 71 Fed. 518; *Cayuta v. Kennedy*, 127 Fed. 355; *Potter v. Crowell*, Fed. Cas. 11, 323; *N. Y. Filter v. Chemical*, 93 Fed. 827; *Winchester v. American*, 54 Fed. 703; *Gen. Electric v. New England*, 128 Fed. 738.

**§ 561. Grounds for Granting — Prior Adjudication.**

In passing on the other foreign patents, the circuit court considered that the prior adjudications fortified the presumption of validity of the patent in suit, and established its scope, and that the new matter introduced did not repel the presumption or limit the extent of the patent. That the lower courts properly regarded the prior adjudications as a ground of preliminary injunction is established by the cases cited *Walk. Pat. §§ 665 et seq.*, and *Rob. Pat. §§ 117 et seq.* And in that aspect the question must be considered, and, so considering it, we may pass the defenses of anticipation, whether

complete or partial, and the defense of infringement. — *Leeds v. Victor*, 213 U. S. 301; 53 L. Ed. 805; 29 S. Ct. 495.

*Note:* This ruling should put a stop to the tendency in certain circuits, especially the seventh, to disregard prior adjudications, especially those of other circuits.

When there has been a prior adjudication sustaining the patent and the infringement thereof is the same or in another circuit, where the validity of the patent has been contested upon full proofs, the circuit court should, upon a motion for preliminary injunction, sustain the patent, and leave the determination of the question of its validity to be determined upon the final hearing. This rule is even more emphatic when the former decision was made by the federal court in the same circuit. — *Interurban v. Westinghouse*, 186 Fed. 166; 108 C. C. A. 298.

*Duplex v. Campbell*, 69 Fed. 250.

That where a patent has been sustained upon full proofs in a prior suit, the trial court should, on motion for a preliminary injunction, sustain the patent and leave the proofs to final hearing, see — *Acme Acetylene v. Commercial*, 192 Fed. 321; 112 C. C. A. 573.

*Interurban v. Westinghouse*, 186 Fed. 166; *Leeds v. Victor*, 213 U. S. 302; *Commercial Acetylene v. Acme*, 188 Fed. 89.

#### § 562. Grounds for Granting — Sufficiency — General.

To entitle the complainant to a preliminary injunction in a suit for the infringement of a patent prior to a trial on the merits, he must show three things: a clear title to the patent; its presumptive validity; threatened infringement by the defendant. — *Kings County v. U. S. Consolidated*, 182 Fed. 59; 104 C. C. A. 499.

*Edison v. Beacon*, 54 Fed. 679; *Norton v. Can Co.* 57 Fed. 929.

#### § 564. Grounds for Refusing — Conflicting Proofs.

The contention is that, the Grant patent having been declared invalid by the circuit court of appeals for the sixth circuit and by the circuit court for the district of Indiana in the seventh circuit, the rubber company should not have been enjoined from the handling or sale of tires manufactured in the sixth and seventh circuits, and cites *Kessler v. Eldred*, 206 U. S. 285. The court of appeals practically reserved the question. It modified the decree of the circuit court so far as it prevented the handling, using, or selling tires and rims authorized by any judicial decree, recognizing, as it said, the applicability of *Kessler v. Eldred*. But it further said: "Whether it should be given a broader interpretation is a question upon which we express no opinion, deeming it more prudent to wait until the facts are fully developed." \* \* \* We concur in these remarks. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

There is a sharp conflict of evidence, numerous affiants testifying. All their statements are ex parte affidavits made without any opportunity to test their probative force by cross-examination. Under such circumstances, it seems to us, irrespective of any of the other questions in the case, that infringement was not so clearly established as to justify a preliminary injunction. — *Wright v. Herring-Curtiss*, 180 Fed. 110; 103 C. C. A. 31.

*Westinghouse v. Montgomery*, 139 Fed. 868; *Hall v. General*, 153 Fed. 907.



**§ 566. Grounds for Refusing — Infringement not Clear.**

The most favorable view for the complainant is that the question of infringement is involved in doubt, and a preliminary injunction should not be granted in a doubtful case. — *Ferry-Hallock v. Herman*, 178 Fed. 550; 101 C. C. A. 230.

That where infringement is in doubt, injunction should be refused pendente lite, see — *Wright v. Paulhan*, 180 Fed. 112; 103 C. C. A. 32.

*Wright v. Herring-Curtiss*, 180 Fed. 110.

**§ 574. Non-User.**

Doubtless, in the present case, the complainant was entitled to an injunction restraining further infringement. It was entitled to that relief whether it made use of the patent or not. — *Lorain v. N. Y. Switch*, 184 Fed. 301; 106 C. C. A. 443.

*Paper Bag Case*, 210 U. S. 405.

It is sufficient to sustain the decree of the court below, that, as a matter of fact, appellee did, in good faith, cease the use of the infringing device, and that appellant had full opportunity to make itself acquainted with this fact before it filed its bill. — *Kennicott v. Bain*, 185 Fed. 520; 107 C. C. A. 626.

**§ 576. Powers and Scope.**

Where a court of equity has jurisdiction of appellants, it may enjoin them by decree in personam from doing any acts at places beyond the jurisdiction of the court, as well as within it. — *Rubber Tire v. Goodyear*, 183 Fed. 978; 106 C. C. A. 318.

**§ 577. Violation of — Contempt.**

It is true that the corporation is not expressly named as defendant, but it could not have had more direct and explicit notice of the injunction if it had been so named. It was cited by an order of the Circuit Court to appear and show cause why it should not be punished for contempt in violating the injunction and was given full opportunity to purge itself. In organizing the corporation Bernard was the moving spirit. That it was organized for the purpose of escaping the consequences of the infringement of the patent which Bernard had sold and assigned to the complainants, is too plain for controversy. A person who, with full knowledge of its provisions, has violated an injunction may be punished for contempt, although not a party to it. — *Bernard v. Frank*, 179 Fed. 516; 101 C. C. A. 459.

*In re Lennon*, 166 U. S. 548; *In re Debs*, 158 U. S. 564; *Bessette v. Conkey*, 194 U. S. 324.

That it is not contempt for a party to refuse to produce and exhibit records which he is under injunction from a department of the government to keep secret and which the head of such department has advised him not to disclose, see — *In re Grove*, 180 Fed. 62; 103 C. C. A. 416.

The injunction against which the offense was committed was an injunction against "directly or indirectly" infringing the patent. The learned judge who sat in the Circuit Court adjudged that the defendant violated the injunction. We find this judgment free from error, whether the defendant is held to be guilty of a direct or a merely contributory infringement. — *Kreplik v. Couch Patents*, 190 Fed. 565; 111 C. C. A. 381.

The courts of the United States recognize that the process of contempt has two distinct aspects — one criminal, to punish for disobedience; and the other remedial and civil to enforce a decree of the court, and to compensate private persons. \* \* \* The two aspects of contempt proceedings have often been before the Circuit Court in this circuit, where it has been clearly recognized that in an equity case a fine for contempt imposed for the use of the petitioner is not a punitive fine, but merely indemnity to the petitioner for the loss occasioned to him by the offensive acts of the defendant. \* \* \* The Circuit Court made its two awards, its compensatory award and its punitive award, in one proceeding. In doing so it followed the practice of the courts in this circuit and in other circuits \* \* \* in patent cases the practice has been to combine the two under a proper proceeding, and to order punishment, if it is thought proper, and to indemnify the plaintiff if it is thought proper, or to do both if justice requires. \* \* \* In the *Gompers Case* the court has nowhere said that this practice of the several circuits in patent causes is improper or illegal. Under the principles announced in that case, it must, of course, appear in a case in equity that, before imposing a sentence for criminal contempt, the court distinctly gave the defendant his day in court and allowed him a full and fair hearing upon a criminal charge. \* \* \* The Supreme Court further said that, where a court is proceeding in vindication of its authority, this element dominates the proceeding, and is reviewable by the Circuit Court of Appeals on writ of error. It is clear, then, that in a proceeding where both the remedial and punitive elements are brought before the court, the criminal element must control. — *Kreplik v. Couch Patents*, 190 Fed. 565; 111 C. C. A. 381.

*Re Christensen*, 194 U. S. 458; *Bessette v. Conkey*, 194 U. S. 324; *Gompers v. Bucks*, 221 U. S. 418; *Hendryx v. Fitzpatrick*, 19 Fed. 810; *Re Chiles*, 22 Wall. 157; *Anderson v. Dunn*, 6 Wheat. 204.

#### § 578. Violation of — Miscellaneous Rules.

When the validity of a patent has been established, and the defending party decreed to be an infringer on account of certain specific devices brought before the court, the infringing party may not, by mere colorable changes, avoid the effect of the decree as an adjudication between the parties; and the offending party may be reached either by separate suit or by a supplemental bill. — *Cazier v. Mackie-Lovejoy*, 168 Fed. 701; 94 C. C. A. 215.

*Murray v. Orr*, 153 Fed. 369.

#### § 579. Miscellaneous Injunction Decisions.

*Cruikshank* (one of the partners) died before the commencement of the suit, and the defendant *Marr* is his administrator. An injunction cannot run against the former, nor against the latter as administrator on account of his intestate's infringing act. — *Crier v. Innes*, 170 Fed. 324; 95 C. C. A. 508.

That the fact that there are other suits pending upon the same patent in other circuits against other infringers is not a ground for refusing injunction, see — *Interurban v. Westinghouse*, 186 Fed. 166; 108 C. C. A. 298.

That an injunction should be refused if its granting will cause greater injury than its refusal, see — *Kryptok v. Stead*, 190 Fed. 767; 111 C. C. A. 767.

*Russell v. Farley*, 105 U. S. 433; *Shubert v. Woodward*, 167 Fed. 47; *Blount v. Société*, 53 Fed. 98.

That a defendant manufacturer may not restrain a complainant from bringing suits against its customers or dealers merely because such course



may cause expense and loss to the original defendant or to such other persons sued, see — *Kryptok v. Stead*, 190 Fed. 767; 111 C. C. A. 767.

*Acetylene v. Avery*, 152 Fed. 642.

## INTERFERENCES.

### § 584. Conclusiveness.

It was so decided in the interference proceedings, which, while not conclusive upon us, it is or the defendants to overcome. — *Novelty v. Brookfield*, 170 Fed. 946; 95 C. C. A. 516.

*Morgan v. Daniels*, 153 U. S. 120.

That an interference adjudication is conclusive in a subsequent suit between the same parties only upon the issues there determined, and upon those issues only in the absence of further and persuading proofs, see — *Elliott v. Youngstown*, 181 Fed. 345; 104 C. C. A. 175.

That an interference adjudication is presumed to be conclusive against the defeated party and his privies until such presumption is overcome, see — *Hillard v. Remington*, 186 Fed. 334; 108 C. C. A. 534.

*Morgan v. Daniels*, 153 U. S. 120.

That an interference or the failure to declare an interference has small evidential weight, see — *Herman v. Youngstown*, 191 Fed. 579; 112 C. C. A. 185.

### § 585. Miscellaneous.

The patentee, after succeeding in interference, appropriated the claims of the defeated party. *Held*: True, the fact that Cox (the patentee) may have mistakenly regarded these things as not new, and therefore not the subject of a patent, would not have prevented him from correcting his mistake if done in apt time, by amending his application and broadening his claims. But this must be done by a showing in his application that the conception was his, and that it was new and novel; and this he did not do. His application, either before or after the new claims were inserted, discloses no conception of the deficiency to which the interfering patent was directed, antedating it. — *General Electric v. Sangamo*, 174 Fed. 246; 98 C. C. A. 154.

The result of the interference was adverse to Marder; but the result does not establish the proposition as against the rest of the world that the patentees had perfected their invention prior to September 12, 1904. — *Dey v. Bundy*, 178 Fed. 812; 102 C. C. A. 260.

## INVENTION.

### § 591. Adaptation — Arrangement or Grouping.

That mere arrangement of a part, such as giving a certain inclination to the moldboard or disk of a plow, is not invention, see — *Torrey v. Hancock*, 184 Fed. 61; 107 C. C. A. 79.

*Eddy v. Dennis*, 95 U. S. 560.

### § 594. Aggregation — Co-action Wanting.

The patent concerns metallic or pressed steel cars provided with double hopper-bottoms. In the device as a whole there was no interchange of mechanical function between the several parts, and no new result from their

contiguity. Each maintained its independent function, which, whether in isolation or companionship, remained the same. There being absence of new functional co-operation, and the position and relation of the several parts being wholly structural, we cannot regard the construction as inventive in character. — *Am. Car & Foundry v. Morton Trust*, 175 Fed. 568; 99 C. C. A. 190.

The mere bringing together of old parts and allowing each to work out its own old effect, without producing some new machine or product, is not invention. It is necessary always to determine whether the conception of a combination of old parts results from the intuition of the inventor as distinguished from the skill of the mechanic. — *Warner v. Stewart*, 185 Fed. 507; 107 C. C. A. 607.

*Reckendorfer v. Faber*, 92 U. S. 347.

That a tool embracing means for performing a plurality of functions, lacking co-action, though convenient and useful, is not patentable, see — *Irvington v. Utica Drop Forge*, 191 Fed. 169; 111 C. C. A. 647.

### § 596. Aggregation — Not Invention.

The specifications of the patent acknowledge "that scorching devices and burning tools are separately old." If the patent consists in simply bringing together into one tool these two things, it is not invention. It is mere aggregation. — *Tyssowski v. Thayer*, 174 Fed. 43; 98 C. C. A. 29.

Mere simultaneous treatment of two objects by the same process previously applied to one is not invention. — *Krupp v. Midvale*, 191 Fed. 588; 112 C. C. A. 194.

### § 597. Aggregation — Old Elements, Old Result.

To sustain a patent with a combination of old elements, it is well settled that a new result must be obtained, which is due to the joint and co-operating action of all the old elements. Either this must be accomplished, or a new machine of distinct character and function must be constructed. If several old devices are so put together to produce even a better machine or instrument than was formerly in use, but each of the old devices does what it had formerly done in the machine or instrument from which it was borrowed, and in the old way, without uniting with other old devices to perform any joint function, it seems that the combination is not patentable. — *Anton v. Grier*, 185 Fed. 796; 108 C. C. A. 173.

*Brinkerhoff v. Aloe*, 146 U. S. 515; *Pickering v. McCullough*, 104 U. S. 310; *Reckendorfer v. Faber*, 92 U. S. 347; *Hailes v. Van Wormer*, 87 U. S. 353; *Specialty v. Fenton*, 174 U. S. 492.

### § 598. Beneficial Uses and Scope of.

We should be slow to infer such ignorance. \* \* \* When a person produces a useful instrument, to say that he did not know what he was about is at least confusing. To take from him the advantage of it upon nice speculation as to whether it was an ignorant guess or confident knowledge and adaptation might do him great injustice. His success is his title to consideration. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

Even if the patentee at the time of making his application did not know of this advantage, or knowing failed distinctly to express it, he, in view of



what he did state and show, is entitled to have his invention considered with reference to it. — *Morgan Engineering v. Alliance*, 176 Fed. 100; 100 C. C. A. 130.

*Goshen v. Bissell*, 72 Fed. 67; *Dowagiac v. Superior*, 115 Fed. 886; *Stilwell-Bierce v. Eufaula*, 117 Fed. 410.

It is possible that in Forster's device the water, to some extent, impinges upon the inside of the "tubular body," though he does not suggest it. But he would be entitled to the benefit of that feature, if in fact it existed. — *Forest City v. Barnard*, 176 Fed. 561; 100 C. C. A. 197.

*Goshen v. Bissell*, 72 Fed. 67; *Goodyear v. Rubber*, 116 Fed. 363; *Stilwell-Bierce v. Eufaula*, 117 Fed. 410; *Eames v. Worcester*, 123 Fed. 67.

A patentee who has plainly described and claimed his machine or combination has the right to every use to which his device can be applied, and to every way in which it can be utilized to perform its function, whether he was aware of these uses or methods of use when he claimed or secured his monopoly or not. — *Warren Webster v. Dunham*, 181 Fed. 836; 104 C. C. A. 346.

*National v. Interchangeable*, 106 Fed. 693; *Roberts v. Ryer*, 91 U. S. 150; *Miller v. Mfg. Co.* 151 U. S. 186; *Goshen v. Bissell*, 72 Fed. 67; *Stearns v. Russell*, 85 Fed. 218; *Mfg. Co. v. Neal*, 90 Fed. 725; *Tire Co. v. Lozier*, 90 Fed. 732.

It is objected that the advantage of avoiding side tones is not mentioned in the specification. This is true. But this omission was not fatal if the advantage was necessarily achieved through the invention. — *Kellogg v. Dean*, 182 Fed. 991; 105 C. C. A. 545.

*Goshen v. Bissell*, 72 Fed. 67; *Dowagiac v. Superior*, 115 Fed. 886; *Stilwell-Bierce v. Eufaula*, 117 Fed. 410; *Morgan v. Alliance*, 176 Fed. 100.

### § 599. Carrying Forward.

The rule of *Smith v. Nichols*, 21 Wall. 112, quoted and applied in — *Neureuther v. Mineral Point*, 179 Fed. 850; 103 C. C. A. 336.

*Smith v. Nichols*, supra; *Wilce v. Bush*, 134 Fed. 389.

In *Smith v. Nichols*, 21 Wall. 119, it was held that a mere carrying forward of an original conception patented, a new and more extended application of it, involving no change of form, proportion, or degree, the substitution of equivalents doing the same thing as did the original invention by substantially the same means with better effects, is not such invention as will sustain a patent. — *Yost v. Perkins*, 179 Fed. 511; 103 C. C. A. 116.

*Roberts v. Ryer*, 91 U. S. 150; *Phillips v. Detroit*, 111 U. S. 604; *Burt v. Ivory*, 133 U. S. 349; *Ansonia v. Electrical*, 144 U. S. 19; *Lovell v. Cary*, 147 U. S. 623.

### § 601. Change of Form — Mere Change.

If it were shown to be true that a machine with knives set at a particular angle had distinct advantages over a machine with knives set at any other angle, the discovery and embodiment of the fact in a working machine ought, we suppose, to be deemed patentable. But nothing of the kind is shown here. It follows that there is no patentability in that particular, even if it be conceded that the drawings of the patent are to be regarded as working plans, showing the particular angle stated, — a proposition which, in view of the fact that the specification is silent on the subject, is not deemed tenable. — *Caverly v. Deere*, 66 Fed. 305; 13 C. C. A. 452.

Any changes made were in degree, proportion, or symmetry. The plow of his patent did the same thing in the same way, and by substantially the same means as before, and although it produced better results it did not rise to the dignity of invention. — *Torrey v. Hancock*, 184 Fed. 61; 107 C. C. A. 79.

*Smith v. Nichols*, 21 Wall. 112; *Belding v. Corn Planter*, 152 U. S. 100.

### § 602. Change of Form — When Patentable.

But the law has other tests of invention than subtle conjectures of what might have been and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change, even as demonstration. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

The structure on which invention is predicated is unquestionably new, there being a readjustment of materials, by which new and highly useful results are brought about. — *Edison v. Novelty*, 167 Fed. 977; 93 C. C. A. 381.

*Raincar v. Western*, 159 Fed. 431.

### § 603. Combinations — Co-Action of Elements.

When the complete machine of the patent is used, the crushing and separating elements do, in our opinion, co-operate to produce a new, final and unitary result, to wit, the complete separation of the cinder from the iron and the ejection of the former from the mill and the leaving of the latter therein. This constitutes invention. — *Sly v. Russell*, 189 Fed. 61; 110 C. C. A. 625.

*Nat. Cash Register v. American*, 53 Fed. 367; *Walk. Pat. § 33*.

An aggregation is the mere assembling of separate elements without changing their respective functions or accomplishing any result other than the added result of those functions. In order to be patentable a combination of elements must in their co-relation produce a different force, or effect, or result, from the sum of that which is produced by their separate parts. It is not necessary that each element in performing its own function shall also modify the function performed by the others. It is generally sufficient if there be such coaction that a result is produced which is new, and the result is new if it is substantially a better result than that which has been accomplished by the other combinations. — *Pelton v. Doble*, 190 Fed. 760; 111 C. C. A. 488.

*Reckendorfer v. Faber*, 92 U. S. 347; *Hailes v. VanWormer*, 20 Wall. 353; *Loom Co. v. Higgins*, 105 U. S. 580.

### § 604. Combinations — Entirety.

A combination is a union of elements, which may be partly old and partly new, or wholly old or wholly new. But whether new or old, the combination is a means — an invention — distinct from them. They, if new, may be inventions and the proper subject of patents, or they may be covered by claims in the same patent with the combination. — *Leeds v. Victor*, 213 U. S. 301; 53 L. Ed. 805; 29 S. Ct. 495.

The novelty as well as the virtue of the invention depends upon the machine as a whole. — *Novelty v. Brookfield*, 170 Fed. 946; 95 C. C. A. 516.

*Brookfield v. Novelty*, 154 Fed. 197.



The test is whether there is a new unitary result, to the production of which the different elements coact. — *Novelty v. Brookfield*, 170 Fed. 946; 95 C. C. A. 516.

*Bliss v. Reed*, 106 Fed. 314; *National v. Aiken*, 163 Fed. 264.

It is sufficient to sustain the claim to hold that the combination embraced a novel element. The claim is held to be valid as covering a combination in a road locomotive of the different elements with a liquid hydrocarbon compression engine of the Brayton type. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

A number of the elements of this combination are undoubtedly old, but, by reason of its compact unitary structure and easy accessibility for purposes of inspection and repair, and other advantages, it has achieved a result which entitled it to be characterized as an advance in the art. — *Allis-Chalmers v. Westinghouse*, 184 Fed. 722; 107 C. C. A. 541.

The fact that there is novelty in one of the elements does not justify a claim to a combination of the elements unless there is co-action between them to produce a new result, and a combination is not unpatentable merely because the result might have been accomplished by other combinations. — *Pelton v. Doble*, 190 Fed. 760; 111 C. C. A. 488.

#### § 608. Combinations — Old Elements, New Results.

It is perfectly well settled that a new combination of elements, old in themselves, but which produce a new and useful result, entitles the inventor to the protection of a patent. — *Expanded v. Bradford*, 214 U. S. 366; 53 L. Ed. 1034; 29 S. Ct. 652.

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

A combination of old elements which accomplishes a new and beneficial result, or attains an old result in a more facile, economical, or efficient way, may be protected by patent as securely as a new machine or composition of matter. — Dissenting opinion of Judge Sanborn in — *Electric Protection v. American*, 184 Fed. 916; 107 C. C. A. 238.

*Seymour v. Osborne*, 11 Wall. 516; *Gould v. Rees*, 15 Wall. 187; *Thomson v. Bank*, 53 Fed. 250.

While the desirability of insulating the inside of a socket was recognized, while the use of insulating material retained in place by its yielding nature in other portions of a socket was common, and while it was known to the bottle-stopping art that a yielding lining material could be sprung into the interior of a stopper and there retained, yet the existence of these elements in severalty suggested to no one their combined use to fill a recognized want in electric lighting. — *Freeman Co. v. General Electric*, 191 Fed. 168; 111 C. C. A. 646.

#### § 614. Definition of.

In the eyes of the patent law, the real device in this case is not the skill of the dressmaker in making the skirt after she is once told how, but in the original thought that discovered and originated the device without being told. — *Greenwald v. Enochs*, 183 Fed. 583; 106 C. C. A. 351.

#### § 615. Dividing or Uniting Parts.

Being obvious and self evident, the remedy employed of cutting the horn in two sections, was equally obvious and self evident, and to claim a patent

monopoly therefor is a misuse of the patent laws which are to foster invention alone. The device of the patent in suit, to overcome the inconvenience of handling and packing a one-piece horn, no more involves invention than cutting a length of stove-pipe into two sections and providing for their being united and fitted together, by slightly crimping the end of one section, that it may enter and be pressed into the end of the other. — *Victor v. Hawthorne*, 178 Fed. 455; 101 C. C. A. 439.

The general rule stated and followed in — *Gould v. Cincinnati*, 194 Fed. 680; — C. C. A. —.

*Standard v. Caster*, 113 Fed. 162; *National v. Aiken*, 163 Fed. 254; *Herman v. Youngstown*, 191 Fed. 579.

Familiar rule followed and familiar cases cited in — *Sheffield v. D'Arcy*, 194 Fed. 686; — C. C. A. —.

### § 616. Double or Analogous Use — Analogous Use Non-Patentable.

That the adaptation of a device for printing pictures to making blue-prints is mere double use, see — *Elliott v. Youngstown*, 181 Fed. 345; 104 C. C. A. 175.

But conceding that the complainant is entitled to all the uses and advantages which may arise from the slot, whether he conceived the idea of all of them or not (*Roberts v. Ryer*, 91 U. S. 150), the fact still remains that the only feature of his device not found in the prior art is the slot or slidable connection of the braces. \* \* \* His application of the slot or slidable connection (known in an art clearly analogous) did not involve patentable invention. — *Stevens v. Rodgers*, 186 Fed. 631; 108 C. C. A. 495.

*Smyth v. Sheridan*, 149 Fed. 208.

### § 620. Evidence of — Acquiescence.

That acquiescence by the public and purchase of the patent or license under it by manufacturers may be evidence of invention, but of slight weight in view of other facts, see — *Elliott v. Youngstown*, 181 Fed. 345; 104 C. C. A. 175.

### § 622. Evidence of — Commercial Success.

The unsuccessful experiments on the part of those not only skilled in the art, but under the sharp spur of competition, the success and usefulness of the device and its speedy general adoption, furnish persuasive evidence of invention. — *Electric v. Westinghouse*, 171 Fed. 83; 96 C. C. A. 187.

*Keystone v. Adams*, 151 U. S. 139; *Potts v. Creager*, 155 U. S. 597; *Hobbs v. Beach*, 180 U. S. 383; *Star v. General*, 111 Fed. 398; *Kalamazoo v. Duff*, 113 Fed. 264; *Dowagiac v. Superior*, 115 Fed. 886.

Peller has produced a device the value of which has been demonstrated not only by its popularity in the trade but by the persistent contest in the patent office for the honor of being its inventor. — *Waterbury v. Aston*, 183 Fed. 120; 105 C. C. A. 410.

*Topliff v. Topliff*, 145 U. S. 156.

### § 623. Evidence of — Commercial Success — When Not.

It may be admitted that the commercial utility of a patented device is sometimes persuasive evidence of invention. But it is not conclusive. — *Victor v. Hawthorne*, 178 Fed. 455; 101 C. C. A. 439.



The rule is that general public acceptance and use of the patented device is only a fact to be considered with all the other facts in the case on the issue of patentable novelty, and is most appropriately resorted to in cases where the issue is in grave doubt. — *Torrey v. Hancock*, 184 Fed. 61; 107 C. C. A. 79.

*Smith v. Goodyear*, 93 U. S. 486.

#### § 624. Evidence of — Efficiency.

If the combination of elements described in the patent in suit furnishes a machine that bends pipes and tubes in a more rapid, economical, efficient, or advantageous way than any of the machines of the prior art, it is an important fact in solving the question of the validity of the patent. — *Morton Trust v. Standard*, 177 Fed. 931; 101 C. C. A. 211.

#### § 625. Evidence of — Extensive Litigation.

The utility of a device may be attested by the litigation over it, as litigation "shows and measures the existence of the public demand for its use." — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

*Eames v. Andrews*, 122 U. S. 40.

For 10 years now solicitors and courts have been searching the records and the law to decide attacks upon the validity of this patent, and no court has ever held that the Palmer patent anticipated or rendered it void. These facts are too persuasive and compelling to permit us to hold that there was no invention. — *Wayne v. Benbow-Brammer*, 168 Fed. 271; 93 C. C. A. 573.

The protracted and stubbornly contested interference is wholly inconsistent with defendant's present contention that the patent is void for lack of patentability. Men do not struggle for years to secure a valueless thing. — *Roth v. Harris*, 168 Fed. 279; 93 C. C. A. 581.

Peller has produced a device the value of which has been demonstrated not only by its popularity in the trade, but by the persistent contest in the patent office for the honor of being its inventor. — *Waterbury v. Aston*, 183 Fed. 120; 105 C. C. A. 410.

#### § 626. Evidence of — Extensive Use.

We can understand that some advertising was necessary to bring it into notice, and give it a certain use, but the extensive use which it attained, and more certainly the exclusive use which it attained, could only have been the result of its essential excellence, indeed its pronounced superiority over all other forms. Here, again, in our discussion, a comparison is suggested between it and other tires, and the inquiry occurs why capital has selected to invest in and advertise, and not one of the tires of the prior art, if it be not better than they? But the effect of advertising is mere speculation; to the utility and use of an article the law assigns a definite presumption of its character, as we have seen, and which we are impelled by the facts of this record to follow. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

But the law has other tests of invention than subtle conjectures of what might have been and yet were not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as

demonstration. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

*Note:* This case, next to the *Barbed Wire Case*, illustrates a condition where the question of doubtful novelty has been overcome solely by utility of an extreme nature. It cannot be said that this case sets any new rule in this respect, but it certainly serves to put a period to the expression of certain judges to the effect that utility in the absence of novelty which they have predetermined, is not evidence of invention.

#### § 627. Evidence of — Extensive Use — When Not.

General use alone does not show invention. — *De Long v. Francis*, 168 Fed. 900; 94 C. C. A. 240.

#### § 628. Evidence of — Obvious Demand.

Manufacturers of these supplies were constantly seeking, through skilled engineers, economies in material and form of unitary transformers which were thus obtained by Kurda's combination, and we believe it to be fairly attributable to invention, rather than an obvious expedient of the engineer; that without great advance in the art his new combination is entitled to protection within its narrow scope. — *Gen. Electric v. Winona*, 183 Fed. 418; 105 C. C. A. 652.

#### § 629. Evidence of — Patent Prima Facie.

The records of the Patent Office disclose only the fact that a patent was issued to Wilgus upon an application in which he stated that he was aware of the Gauthier patent, and called attention to the features which distinguished his invention. The issuance of the patent, under these circumstances, created only a prima facie presumption that the invention of the patentee was not anticipated by the prior invention. — *Wilgus v. Germain*, 72 Fed. 773; 19 C. C. A. 188.

*Corning v. Burden*, 15 How. 265; *Miller v. Mfg. Co.* 151 U. S. 208; *Boyd v. Tool Co.* 158 U. S. 260; *Pavement Co. v. Elizabeth*, Fed. Cas. 312; *Ransome v. Hyatt*, 69 Fed. 148.

The presumption of validity arising from the grant is of no avail where the prior art excludes all reasonable presumption of novelty or the exercise of inventive genius. — *Trethaway v. Bertels*, 180 Fed. 730; 104 C. C. A. 96.

#### § 631. Evidence of — Prior Failures.

It is often difficult to determine whether a given improvement is a mere mechanical advance, or the result of the exercise of the creative faculty amounting to a meritorious invention. The fact that the invention seems simple after it is made does not determine the question; if this were the rule, many of the most beneficial patents would be stricken down. It may be safely said that if those skilled in the mechanical arts are working in a given field, and have failed, after repeated efforts, to discover a certain new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor. — *Expanded v. Bradford*, 214 U. S. 366; 53 L. Ed. 1034; 29 S. Ct. 652.

That the fact that skilled inventors had labored long to attain the result is evidence that the end was inobvious and involved invention, see — *Edison v. Novelty*, 167 Fed. 977; 93 C. C. A. 387.



It affirms rather than lessens the achievement that the different parts were brought together from the scrap heap, to which they had been consigned. — *Novelty v. Brookfield*, 170 Fed. 946; 95 C. C. A. 516.

That the fact that a device was well known in other arts, and that no one had previously contemplated its use in the art in question is evidence of invention, see — *Am. Laundry Mach. v. Troy*, 174 Fed. 415; 98 C. C. A. 612.

But the fact that the electrical world, with the knowledge of the use of both rotary converter and auxiliary exciter, during the several years the difficulty existed, made no such combination as Lamme's, is highly suggestive that it required more than mere engineering advance of the electrical art. — *Westinghouse v. Allis-Chalmers*, 176 Fed. 362; 100 C. C. A. 408.

While it may not always be helpful in determining whether a given act or result involves the exercise of constructive faculty rather than mechanical skill to resort either to the fact that the matter in dispute had been allowed to lie dormant for years in the face of needed solution, or to the approval accorded to such solution by men of scientific knowledge and practical experience immediately upon becoming aware of it, yet it is not always easy or advisable to repel the influence of such facts. — *Morgan Engineering v. Alliance*, 176 Fed. 100; 100 C. C. A. 30.

The fact that so many persons caught the idea (four applications being made about the same time) goes rather to prove that it was simple and obvious, and not that it required inventive genius to conceive. It is not like the case where the art is waiting for the device, and inventors striving unsuccessfully to produce it, under which circumstances invention may well be held to appear. — *Elliott v. Youngstown*, 181 Fed. 345; 104 C. C. A. 175.

Dean was the first to get the voice currents into the receiver by direct and continuous path, and at the same time to practically exclude the energizing current. He did this by placing an old device in a new location, and so, through combination with other elements old in themselves, secured a new result. We are therefore of opinion that Dean made an improvement of such merit as to entitle it to the rank of patentable invention. It is true there was left to him but a "short step," but if this step was within the skill of the art, why was it not taken in the long struggle that we have but outlined? — *Kellogg v. Dean*, 182 Fed. 991; 105 C. C. A. 545.

*Morgan v. Alliance*, 176 Fed. 100.

Moreover, it must not be overlooked that the improvement was made in a long-developed art, in which there was meagre sphere for invention. Where a field is barren, a marked improvement in product evidences corresponding originality in making such improvement. — *Greenwald v. Enochs*, 183 Fed. 583; 106 C. C. A. 351.

### § 632. Evidence of — Simplicity.

The fact that the invention is simple and that at the present time it seems as if it might have been obvious to the workers in this art, does not militate against its validity. Many of the most useful inventions depend equally upon simple changes. — *General Electric v. Hill-Wright*, 174 Fed. 996; 98 C. C. A. 566.

### § 633. Evidence of — Turning Failure into Success.

Hoffmann has produced a medicine indisputably beneficial to mankind — something new in a useful art, such as our patent policy was intended to promote. Kraut and his contemporaries, on the other hand, had produced only, at best, a chemical compound in an impure state. And it makes no difference, so far as patentability is concerned, that the medicine thus produced is lifted out of a mass that contained, chemically, the compound; for, though the difference between Hoffmann and Kraut be one of purification only — strictly marking the line, however, where the one is therapeutically available and the others were therapeutically unavailable — patentability would follow. In the one case the mass is made to yield something to the useful arts; in the other case what is yielded is chiefly interesting as a fact in chemical learning. — *Kuchmsted v. Farbenfabriken*, 179 Fed. 701; 103 C. C. A. 243.

*Merrill v. Youmans*, 94 U. S. 569; *Badische v. Kalle*, 104 Fed. 802; *Badische v. Klipstein*, 125 Fed. 543.

In addition to the presumption which arises from the issuance of the patent, there are to be taken into consideration, as sustaining the patent, the further fact that, when his invention was made, there was want in the art for such a device, that in the prior art there were well recognized and admitted defects, and that the appellee's device eliminated those defects and went into general and successful use. — *Kitchen v. Levison*, 188 Fed. 658; 110 C. C. A. 424.

### § 634. Evidence of — Use by Defendant.

It is conceded that the invention is a narrow one, — a step beyond the prior art, — built upon it, it may be, and only an improvement upon it. Its legal evasion may be the easier, and hence we see the strength of the concession to its advance beyond the prior art and of its novelty and utility by the runner company's imitation of it. The prior art was open to the rubber company. That "art was crowded," it says, "with numerous prototypes and predecessors" of the Grant tire, and they, it is insisted, possessed all of the qualities which the dreams of experts attributed to the Grant tire. And yet the rubber company uses the Grant tire. It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation, as others have done. And yet the narrowness of the claims seemed to make legal evasion easy. Why, then, was there not evasion by a variation of the details of the patented arrangement? Business interests urged to it as much as to infringement. We can find no answer except that given by the tire company: "The patented organization must be the one that is essential. Its use in the precise form described and shown in the patent must be inevitably necessary." — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

*Chicago v. Sayles*, 97 U. S. 554.

When a defendant persists in using such an improvement in preference to prior devices which he insists are equally efficacious, he tacitly concedes its superiority. It is difficult to reconcile his persistent use, even though it involves him in an infringement suit, with the contention that other devices which he is free to use are equally good. — *Rajak v. Crossman*, 188 Fed. 73; 110 C. C. A. 143.

The defendants are not in a position to deny that the Scott patent discloses both novelty and invention in view of the fact that the defendant Steber, in March, 1910, received a patent for a knitted fabric which contains all the prominent features of the complainant's fabric, and differs only in details



which do not alter its usefulness or its appearance. In other words, one who receives a patent for the Steber fabric in 1910 is hardly in a position to deny patentability to the Scott fabric of 1908. — *General Knit Fabric v. Steber*, 194 Fed. 99; 114 C. C. A. 177.

### § 635. Evidence of — Utility — When Evidence.

We think the invention may be said to be useful within the meaning of the statute, and, that being true, the rule is that the court would not be justified in declaring the patent void. — *St. Louis v. Sanitary*, 178 Fed. 923; 103 C. C. A. 565.

*Seymour v. Osborne*, 11 Wall. 516; *Wilbur v. Beecher*, Fed. Cas. 17,634; *Lehnbeuter v. Holthaus*, 105 U. S. 94; *Gibbs v. Hoefner*, 19 Fed. 323.

*Note:* This clearly is not an exact statement of the law.

*Facts:* The claim was for crystalline  $\text{CaC}_2$  in aggregated masses. Amorphous carbide was old, but was not of practical commercial value. *Held:* that the difference of character of the products and the difference in utility constituted novelty. — *Union Carbide v. Am. Carbide*, 181 Fed. 104; 104 C. C. A. 522.

In view of the presumption arising from the grant, the further fact that the prior art fails to disclose any device showing the same combination, the further fact that its utility is such that it has come into demand, together with the rule of law which requires that doubt be solved in favor of the validity of the patent, it is our opinion that the patent discloses patentable novelty, though of a low order. — *Mueller v. Glauber*, 184 Fed. 609; 106 C. C. A. 613.

For an instance of saving a patent from falling within ordinary mechanical skill upon very narrow grounds of patentable utility, see — *General Electric v. Hartman*, 187 Fed. 131; 109 C. C. A. 49.

### § 636. Evidence of — Utility — When Not.

Utility alone is not enough to establish invention. *Jacobs v. Almond*, 177 Fed. 935; 101 C. C. A. 215.

In doubtful cases the fact that a patented article has gone into extensive or general use is evidence of its utility; but that is by no means conclusive of its patentability. When there is no invention, the extent of the use is a matter of no importance. — *Boss v. Thomas*, 182 Fed. 811; 105 C. C. A. 243.

*McClain v. Ortmyer*, 141 U. S. 419; *Adams v. Bellaire*, 141 U. S. 539; *Duer v. Corbin*, 149 U. S. 216.

The considerations of prior demand, unsuccessful attempts to supply the demand, utility, and public favor, are evidence of invention, and in an otherwise doubtful case might turn the scale in favor of its existence. But neither or all of these considerations, regardless of all others, necessarily prove invention, the existence of which is always ultimately a question of fact, to be determined upon a consideration of all applicable facts and conditions. — *Gould v. Cincinnati*, 194 Fed. 680; — C. C. A. —.

Familiar rule and authorities stated in — *Boldt v. Nevison*, 194 Fed. 871; 114 C. C. A. 617.

### § 637. Evidence of — Want of Invention.

That while the fact that a patent has never gone into general use cannot defeat a patent, it may be considered in construing the patent, see — *National v. Buckeye*, 171 Fed. 847; 96 C. C. A. 515.

*Bradford v. Belknap*, 105 Fed. 63; *Crown v. Aluminum*, 108 Fed. 845.

It would seem that, in a case of doubtful novelty, the fact that a feature relied upon in the patent as important possessed little utility and was displaced by a different construction, such fact is pertinent upon the question of novelty, see — *Hayward v. Ellis*, 187 Fed. 128; 109 C. C. A. 46.

### § 646. Improvement — Non-Patentable.

While the policy of our law is to encourage inventions, we should in this age of rapid and marvelous improvements in mechanical appliances, when dealing with patents, be careful to distinguish between those improvements which do and those which do not involve real inventive genius. The mechanical art should not be burdened with patents for those improvements which involve only the skill of the mechanic. — *Standard Machine v. Rambo*, 188 Fed. 323; 110 C. C. A. 301.

### § 649. Manufacture.

*Facts:* The claim was for crystalline  $\text{CaC}_2$  in aggregated masses. Amorphous carbide was old, but was not of practical commercial value. *Held:* that the difference in character of the products and the difference in utility constituted novelty. — *Union Carbide v. Am. Carbide*, 181 Fed. 104; 104 C. C. A. 522.

### § 652. Mechanical Skill — Adaptation.

That mere change of construction, such as the extension of a lug, turning it in an opposite direction or attaching by means of a screw instead of a rivet, does not rise to the dignity of invention, see — *Boss v. Thomas*, 182 Fed. 811; 105 C. C. A. 243.

*Richards v. Chase*, 158 U. S. 299; *Mast v. Stover*, 177 U. S. 485; *Ross v. Dowden*, 157 Fed. 681.

### § 653. Mechanical Skill — Aggregation.

A mere improvement in the method of doing the work does not necessarily lie within the boundaries of patentable invention. — *Winston v. Croton Falls*, 194 Fed. 123; 114 C. C. A. 201.

*Dodge v. N. Y. C.* 150 Fed. 738; *Dunbar v. Eastern*, 81 Fed. 201; *Fowler v. City of N. Y.* 121 Fed. 747; *Richards v. Chase*, 158 U. S. 299.

### § 654. Mechanical Skill — Carrying Forward.

That improvements, though useful, which would occur to those familiar with the electrical art, are not patentable invention, see — *General Electric v. Winona*, 188 Fed. 77; 110 C. C. A. 147.

### § 655. Mechanical Skill — Change of Form.

That they discharge into an air current going on one direction, instead of in another, or that they admit only part instead of all the gases, is not a new result, nor does it involve novel co-action so as to support a claim whose only novelty lies therein. — *Cummer v. Atlas*, 193 Fed. 993; 113 C. C. A. 611.

*Electric v. Perkins*, 179 Fed. 511; *Nat. Tube v. Aikin*, 163 Fed. 260.



**§ 656. Mechanical Skill — Definition and Distinction from Invention.**

Many things which seemed indicative of invention in earlier times have lapsed into the domain of the skill and prevision of the artisan, and the test of invention in the mechanical arts has risen to a higher plane as the eye, the hand, the intelligence of the workman have been educated to higher issues. The fruits of the progress thus made belong to the general public, and the danger is that too many of the utilities of life may be covered by the ever-increasing flood of patents, too many of which may have little or no right to a monopoly. — *Duncan v. Cincinnati*, 171 Fed. 656; 96 C. C. A. 400.

The question is whether the improvement is the result of mere mechanical skill or involves the higher quality of invention. This question might be answered differently by persons of equal intelligence. — *Bossert v. Pratt*, 179 Fed. 385; 103 C. C. A. 45.

*Western v. LaRue*, 139 U. S. 601; *Potts v. Creager*, 155 U. S. 597; *Hobbs v. Beach*, 180 U. S. 383; *O'Rourke v. McMullen*, 160 Fed. 936.

**§ 657. Mechanical Skill — Degree of Knowledge and Skill.**

Mechanical skill is not converted into invention because it is applied to a structure showing the highest degree of inventive genius. If the problem be to construct a key for a lock, it can make no difference whether the lock is attached to a typewriter or an ice box. — *Hillard v. Remington*, 186 Fed. 334; 108 C. C. A. 534.

**§ 658. Mechanical Skill — Dividing or Uniting Parts.**

There was no invention in making two parts or two pieces of the integral member employed by the earlier patent. — *Chicago Grain Door v. National*, 173 Fed. 918; 97 C. C. A. 324.

*Bundy v. Detroit*, 94 Fed. 524; *D'Arcy v. Staples*, 161 Fed. 733, and cases cited at page 742.

To divide the handle midway of the collar would not have constituted invention. — *Hilker v. U. S. Mop*, 191 Fed. 613; 112 C. C. A. 176.

*Standard v. Caster*, 113 Fed. 162.

**§ 660. Mechanical Skill — Increased Efficiency.**

That a mere difference in speed or skill is not patentable, see — *Highland v. Schmertz*, 178 Fed. 944; 102 C. C. A. 316.

**§ 665. Mechanical Skill — Strengthening or Increasing.**

For a case which comes perilously near holding that strengthening and arranging and adapting parts may involve invention, see — *Morgan Engineering v. Alliance*, 176 Fed. 100; 100 C. C. A. 30.

**§ 666. Mechanical Skill — Miscellaneous Decisions.**

That merely securing two rows of articles by a single line of stitching instead of two lines is not invention, see — *De Long v. Francis*, 168 Fed. 900; 94 C. C. A. 240.

That it does not involve invention to put the operating key of a line lock on a typewriter in a more convenient place, employing well-known mechanisms, see — *Hillard v. Remington*, 186 Fed. 334; 108 C. C. A. 534.

*Mann's v. Monarch*, 34 Fed. 130; *Aron v. R. R.* 132 U. S. 84; *Stephenson v. Brooklyn*, 114 U. S. 149.

### § 667. Novelty — Definitions and Distinctions.

Nor does it detract from its merit that it is the result of experiment and not the instant and perfect product of inventive power. A patentee may be baldly empirical, seeing nothing beyond his experiments and the result; yet if he has added a new and valuable article to the world's utilities, he is entitled to the rank and protection of an inventor. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

Aside from those contentions and the ability by which they are supported, we might point out what it does as a demonstration of its difference from all that preceded it, attribute or force, — something which is the law of its organization and function, and raises it above a mere aggregation of elements to a patentable combination. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

### § 668. Novelty — Evidence of.

It appears from the record that neither Wightman nor the Potter patent was cited to the examiner in the Patent Office and were overlooked by him. This circumstance affects the presumption in favor of the validity of the patent from its issuance. — *Westinghouse v. Toledo*, 172 Fed. 371; 97 C. C. A. 69.

*Cleveland v. Kauffman*, 126 Fed. 658; *American v. Sample*, 130 Fed. 145.

*Note:* It is to be noted that of the two authorities cited in support of this rule the first is a reversed case; and that the second is not a case which would warrant drawing a general rule. Such a rule would be, to say the least, dangerous; for as a matter of fact the file wrapper discloses, *not all of the patents which an examiner may have examined*, but *only* those he may have considered pertinent. Before such a conclusion could be justified it would be necessary to establish by evidence the fact that the examiner had overlooked the patents in question.

### § 671. Old Device, New Use — General Rules.

But the application of an old device or combination to a new use is not in itself an invention, or capable of protection by a patent. If the relation between the two uses is remote, and the old device or combination produced a new result by virtue of its application, that application may constitute invention. Where a machine or a combination is discovered in a remote art, where it is used to perform a different function, and where it was not designed and was not apparently suitable to accomplish the thing desired, the application of it with proper mechanical adaptation to a new use is often the result of the exercise of the inventive faculty. But the thought that an existing machine or combination discovered in the same art or one nearly analogous to it, designed and suitable to perform a similar function, may be used or adopted to accomplish the desideratum, is not the product of inventive genius, but the result of the application of the skill of the mechanic to the subject under consideration. It is only when the new use is so recondite and remote from that to which the old device and combination has been applied, or for which it was conceived, that its application would not occur to the mind of the ordinary mechanic skilled in the art, seeking to devise means to perform the desired function, with the old machine or combination before him, that its conception may rise to the dignity of invention. — *Warren Webster v. Dunham*, 181 Fed. 836; 104 C. C. A. 346.

*Potts v. Creager*, 155 U. S. 597; *Hobbs v. Beach*, 180 U. S. 383; *Adams v. Lindell*, 77 Fed. 432; *National v. Interchangeable*, 106 Fed. 693.



*Note:* This statement of a most profound mind is open to one serious criticism. Suppose that the invention was not made "with the old machine or combination before him;" does it follow that if re-invented independently, the rule does not apply? Clearly not; the law assumes that the inventor has before him the prior art and all its analogies. This clause is, therefore, superfluous, and, possibly, misleading.

### § 672. Old Device, New Use — Non-Patentable.

That the use of a device for mixing concrete which had been used for mixing tea does not involve invention, see — *Ransome v. United Concrete*, 177 Fed. 413; 101 C. C. A. 217.

*Potts v. Creager*, 155 U. S. 597; *Mast v. Stover*, 177 U. S. 485.

That where a wood lining had been previously used as a lining for pumps, it did not involve invention to employ that lining for pipes for dredgers for carrying sand and gravel, see — *Lewis v. Semple*, 177 Fed. 407; 101 C. C. A. 411.

Even if the Brayton engine had been used only for stationary purposes, it is by no means certain that its mere selection for incorporation in a motor vehicle without adaptation would have involved invention. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

*Faure's Appeal*, 52 O. G. 754; *Shaw v. Worthington*, 77 Fed. 992.

The true test is whether Cadman produced a new result or an improved method of producing an old result. Clearly he did not. At the most he applied an old and well-known combination of elements, each one performing its original function, to a new use. Such was not invention. — *Warner v. Stewart*, 185 Fed. 507; 107 C. C. A. 607.

*Webster v. Dunham*, 181 Fed. 836.

That the art of pasteurizing beer is analogous to that of curing fish, see — *Model Bottling Mach. v. Anheuser-Busch*, 190 Fed. 573; 111 C. C. A. 389.

*Brown v. Piper*, 91 U. S. 37; *Crescent v. Gottfried*, 128 U. S. 158; *Aron v. Manhattan*, 132 U. S. 84; *Thomson-Houston v. Rahway*, 95 Fed. 660; *Burns v. Mills*, 143 Fed. 325; *Am. Brake Shoe v. Railway*, 143 Fed. 540.

It does not involve invention to apply an old process or machine or idea to a similar or analogous subject, with no change in the manner of application and no substantially different result. — *Myers v. Fairbanks*, 194 Fed. 971; 114 C. C. A. 516.

*Blake v. San Francisco*, 113 U. S. 679.

### § 673. Old Device, New Use — Patentable.

Such an application of an old machine or device found in an analogous art, to a new use is invention and is patentable where its applicability would not be perceived by a person of ordinary mechanical skill, where it would not perform the same function requisite for the new use without substantial modification, and where it was not designed by its maker, or adapted, or actually used, to perform such functions. — *Wayne v. Benbow-Brammer*, 168 Fed. 271; 93 C. C. A. 573.

*Topliff v. Topliff*, 145 U. S. 156; *Potts v. Creager*, 155 U. S. 597; *Hobbs v. Beach*, 180 U. S. 383.

Unless the uses are so analogous that the application of the old device to the use of the new would occur to a person of ordinary mechanical skill,

inventive faculty may be involved in such new application. — *Electric v. Westinghouse*, 171 Fed. 83; 96 C. C. A. 187.

*Potts v. Creager*, 155 U. S. 597.

#### § 674. Old Elements, New Result.

The elements of a combination may be all old. In making a combination the inventor has the whole field of mechanics to draw from. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

*Leeds v. Victor*, 123 U. S. 318.

#### § 675. Old Elements, Old Result.

There could have been no invention in bringing these old elements into a new combination, where each would perform the same service as they did in the earlier art. — *Yost v. Perkins*, 179 Fed. 511; 103 C. C. A. 116.

*Burt v. Ivory*, 133 U. S. 349; *Florsheim v. Schilling*, 137 U. S. 77; *Burnham v. Union*, 110 Fed. 765; *Overweight v. Vogt*, 102 Fed. 957; *Campbell v. Duplex*, 101 Fed. 282.

Familiar rule and familiar cases cited in — *Sheffield v. D'Arcey*, 194 Fed. 686; — C. C. A. —.

#### § 676. Old Process, New Use — Non-Patentable.

That the discovery of new possibilities of an old process or apparatus producing better but analogous results is not patentable, see — *Carmichael v. Jackson*, 192 Fed. 937; 113 C. C. A. 327.

#### § 679. Patentability — Definition.

Patents may be obtained for any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, or any new, original, and ornamental design for any article of manufacture. Aside from these specific classes of patentable inventions, no invention or improvement is patentable, however useful and novel it may be. While many devices and many novel combinations of materials used in the construction of houses are within the protection of the patent laws, it has never been held, so far as we are advised, that any particular form of construction of a room in a house, or of a recess in a room, is patentable, whether considered by itself or taken in combination with any conceivable use to which it may be put. — *Am. Disappearing Bed v. Arnaelsteen*, 182 Fed. 324; 105 C. C. A. 40.

*Jacobs v. Baker*, 7 Wall. 295; *Fond du Lac v. May*, 137 U. S. 395; *Milligan v. Upton*, Fed. Cas. 9607; distinguishing *Crier v. Innes*, 170 Fed. 324.

#### § 680. Patentability — Patentable Difference.

The presumption is that two patents do not cover the same invention, and the burden is heavily on him who asserts to the contrary. It would require cogent proof to convince the court that the Patent Office would, within a month, issue two patents for the same invention to the same inventor. — *Gould Storage Battery v. Electric Storage Battery*, 192 Fed. 28; 112 C. C. A. 416.

#### § 682. Patentability — Mental Conception.

The invention must of necessity, if it be such, consist in the device of the patent, and not in the conception of the principle to be utilized. — *Gray Tel. v. Baird*, 174 Fed. 417; 98 C. C. A. 353.

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



### § 684. Patentability — Miscellaneous Rules.

*Semble* that a mere architectural expedient is not patentable, see — *Tayntor v. Goetchius*, 183 Fed. 130; 105 C. C. A. 420.

### § 690. Result or Function.

When we are dealing with electricity, an invisible, intangible agency, and in itself of different kinds, and when we know that in its different phases it may effect, or be affected by, metals and appliances in different ways and with wholly different results, we must guard against being misled by the mere superficial resemblances of the appliances and machines used in connection with it; for from an electrical standpoint the real significance of such appliances lies, not in their material, external appearance, but in their working effect under the influence of diverse electrical factors. — *Westinghouse v. Allis-Chalmers*, 176 Fed. 362; 100 C. C. A. 408.

### § 691. Scientific Principles and Laws.

And how can it take from his merit that he may not know all of the forces which he has brought into operation? It is certainly not necessary that he understand or be able to state the scientific principles underlying his invention, and it is immaterial whether he can stand a successful examination as to the speculative ideas involved. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 Fed. 527; 31 S. Ct. 444.

*Andrews v. Cross*, 8 Fed. 269; *Eames v. Andrews*, 122 U. S. 40; *St. Louis v. Quinby*, Fed. Cas. 12,240; *Pfeifer v. Dixon*, 55 Fed. 390; *Cleveland v. Detroit*, 131 Fed. 853; *Van Epps v. United*, 143 Fed. 869; *Westmoreland v. Hogan*, 167 Fed. 327.

True, Parsons had no patent on the law of the structure as such. But he was the first to see the advantage of such a structure and to construct accordingly. And what he has done and patented cannot be trespassed upon with impunity simply because the law of the structure necessarily turns what, in pretense of appearance, may be called a tight fitting device, into a loose fitting device. — *Excelsior Supply v. Weed Chain*, 192 Fed. 35; 113 C. C. A. 1.

### § 692. Simplicity — Does not Negative Invention.

Its simplicity should not blind us as to its character. Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and, "in the light of the accomplished result," it is often a matter of wonder how they so long "eluded the search of the discoverer and set at defiance the speculations of inventive genius." — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

*Pearl v. Ocean*, Fed. Cas. 10,876.

### § 693. Simplicity — Ex post facto Judgment.

Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

The invention of Peller, like the rubber button in *Frost v. Cohn*, 112 Fed. 1009, and 119 Fed. 505, and the collar button in *Krementz v. Cottle*, 148 U. S. 556, was one of those fortunate discoveries which seem obvious after it has been made. — *Waterbury v. Aston*, 183 Fed. 120; 105 C. C. A. 410.

After a thing of this kind is accomplished, the point of view makes it seem a simple contrivance, but in dealing with the question of invention, the essential view is from the state of the art existing at the time the necessary problem was sought to be solved. — *General Electric v. Hartman*, 187 Fed. 131; 109 C. C. A. 49.

#### § 696. Substitution — New Material — Non-Patentable.

It is a matter of common knowledge that the use of the screw, the nut and bolt, and the rivet as means of uniting or attaching together two or more pieces or parts of material, were well known, and the mechanical equivalents of each other. — *Boss v. Thomas*, 182 Fed. 811; 105 C. C. A. 243.

*Peters v. Hansen*, 129 U. S. 541.

#### § 697. Substitution — New Material — Patentable.

Practical inventions of great merit are often based upon comparatively simple changes in form or material. And in this connection it should be borne in mind that the various prior attempts in more complicated structures to use metal in place of wood, as exhibited in some seven or eight patents, had proved failures, and that the Houghton device was the first successful attempt to remedy the defects in the old wooden finger-head. — *Whitin v. Houghton*, 178 Fed. 444; 101 C. C. A. 344.

For quotations from authorities holding change of material patentable, see — *Frost v. Samstag*, 180 Fed. 739; 105 C. C. A. 37.

*Frost v. Cohn*, 119 Fed. 505; *Hicks v. Kelsey*, 18 Wall. 670; *Union v. Selchow*, 112 Fed. 1006.

#### § 698. Systems and Arrangements.

That a system, such as a block-signaling system, may be patentable when there is interaction and one unit modifies or controls the action of an adjacent unit, see — *Hall v. General*, 169 Fed. 290; 94 C. C. A. 580.

The patent covered a mileage book in which the units were in terms of currency instead of miles. *Held*: Unquestionably, the idea embodied in this ticket is a happy one. Possibly it has followed naturally, and without the employment of inventive thought, the wider use of interchangeable tickets. Possibly the wider use of interchangeable tickets has followed the embodiment of this idea. Which is cause and which is effect, we have no means of determining. \* \* \* All that we know is, that it was not used before appellee's patent, and that it has been followed by the widest use. This, it seems to us, implies that the conception of this ticket, at least, helped to bring about the idea of a wide interchangeable use. — *Rand, McNally v. Exchange*, 187 Fed. 984; 110 C. C. A. 322.

*Note*: To this holding Judge Carpenter dissents with a substantial review of the authorities. While one is not able to judge a holding of this kind, without the record and exhibits in view, the logic and the law would seem to be with Judge Carpenter.

But where "Arrangement" or "Adjustment" makes operative and practicable what was before inoperative and impracticable, and is not itself so obvious that its utilization is not of higher merit than the mechanic's skill,



"Arrangement" or "Adjustment" may be the basis of invention. — *Excelsior Supply v. Weed Chain*, 192 Fed. 35; 113 C. C. A. 1.

### § 701. Transposition of Parts.

In a broad way it may be said that Dean simply reversed the position of White's sealed chamber, but neither the White patent nor anything else in the prior art would have told the mechanic why the changes ought to be made. — *International v. Kellogg*, 171 Fed. 651; 96 C. C. A. 395.

That merely to make one part stationary and another moving when the reverse condition had obtained is not invention, see — *Duner v. Grand Rapids*, 171 Fed. 863; 96 C. C. A. 531.

*Campbell v. Duplex*, 101 Fed. 282; *Sargent v. Larned*, Fed. Cas. 12,364; *Abbott v. Bonn*, 51 Fed. 223; *Machine Co. v. Murphy*, 97 U. S. 120.

There would be no patentability in a mere reversal of functions, accomplishing the same result by making the blade rigid and the guard adjustable. — *Zinn v. Auto Strop*, 175 Fed. 78; 99 C. C. A. 100.

### § 702. Utility.

An improvement which reduces, in any degree, the chances of derailment and collision, and thus safeguards life and property, is entitled to greater consideration than one which deals only with economics. — *Hall v. General*, 169 Fed. 290; 94 C. C. A. 580.

Utility alone cannot support a patent monopoly. — *Trethaway v. Bertels*, 180 Fed. 730; 104 C. C. A. 96.

Mere useful and economic administrative methods, however valuable, while they may and usually are incident to invention, do not themselves constitute invention. — *Krupp v. Midvale*, 191 Fed. 588; 112 C. C. A. 194.

## JOINT INVENTIONS.

### § 704. General Statement and Rules.

The patent was for a combination, and while the evidence would justify a conclusion that one of the Vroomans only first perceived the crude form of the elements, and saw that by their adaptation they might be made to accomplish a useful result, yet it only shows that one of the inventors, looking through a glass darkly, saw something of the elements which were finally composed and adapted to their places for their proper work. It would constantly be happening in the case of joint inventions that the illuminating idea was seen by one before it was seen by the other. But between that and the issuing of the patent there is, in many instances, a long stretch of time devoted to experiments and the consideration of the form or forms in which it may be best used. The law contemplates this and gives time for it. — *Vrooman v. Penhollow*, 179 Fed. 296; 102 C. C. A. 484.

## JURISDICTION.

### § 714. Contracts.

That the license agreement (attached to the machine) constitutes a contract not to use the machine in a prohibited manner, is plain. The defendants might be sued upon the broken contract, or for its enforcement or for the forfeiture of the license, is likewise plain. But if by the use of the machine in a prohibited way Miss Skou infringed the patent, then she is also liable to an action under the patent law for infringement. Now that is pri-

marily what the bill alleged, and this suit is one brought to restrain the defendants as aiders and abettors to her proposed infringing use. That the patentee may waive the tort and sue upon the broken contract, or in assumpsit, is elementary. But if the patentee elect to waive the tort and sue upon the covenants or for a breach of contract, the suit would not be one dependent upon or arising out of the patent law, and a Federal court would have no jurisdiction unless diversity of citizenship existed. — *Henry v. Dick*, 224 U. S. 1; 56 L. Ed. 645; 32 S. Ct. 364.

Rob. Pat. §§ 1225, 1250 & n.; *Steam Cutter v. Sheldon*, 15 Fed. 608; *Pope v. Owsley*, 27 Fed. 100; *Button Fastener Cases*, 77 Fed. 288, 291; *Wilson v. Sanford*, 10 How. 99; *Magie Ruffle v. Elm City*, Fed. Cas. 8949; *Goodyear v. Union*, Fed. Cas. 5586; *Goodyear v. Congress*, Fed. Cas. 5565.

That where the gravamen of the bill arises out of contractual relations and a minor charge of infringement is imperfectly pleaded, such minor allegations will not give jurisdiction under the patent statute, see — *Reliable v. Stahl*, 105 Fed. 663; 44 C. C. A. 657.

The bill was for infringement and there was a subsisting contract of license, the bill not alleging that the contract had been rescinded, but alleging that defendants had forfeited the contract by denying the validity of the patent. *Held*: Are there existing contracts between these parties? Has the conduct of the respondents been such as to preclude them from availing themselves of the license granted by said contracts? Does the law give the complainant a right to ignore the contracts and enforce the monopoly of its patent? Stripped of all verbiage and extraneous matter, the question to which this case would ultimately come is one of contract rights. — *Am. Graphophone v. Victor*, 188 Fed. 428; 110 C. C. A. 308.

Following *Wilson v. Sanford*, 10 How. 99; *Hartell v. Tilghman*, 99 U. S. 547; distinguishing *White v. Rankin*, 144 U. S. 635; citg. *McMullen v. Bowers*, 102 Fed. 494; *American Co. v. Jones*, 122 Fed. 803; *White v. Lee*, 3 Fed. 222; *Adams v. Meyrose*, 7 Fed. 208; *Standard Co. v. National*, 95 Fed. 291.

The Federal courts have exclusive jurisdiction of all cases arising under the patent laws, but not of all questions in which a patent may be the subject-matter of the controversy. For courts of a state may try questions of title, and may construe and enforce contracts relating to patents. — *New Marshall Engine v. Marshall*, 223 U. S. 473; 56 L. Ed. 513; 32 S. Ct. 238.

*Wade v. Lawder*, 165 U. S. 627.

### § 715. Court of Claims.

That where the Government, with the consent of the owner of a patent, and without denial or contest of the validity of the patent, uses the invention, a contract by implication arises which is justiceable in the Court of Claims, see — *Crozier v. Krupp*, 224 U. S. 290; 56 L. Ed. 771; 32 S. Ct. 488.

### § 717. Equity — Expiration of Patent Pendente Lite.

The bill was filed the 15th, subpoena served the 17th, and the patent expired the next day, the 18th. The bill was demurred to as without equity, because complainant had a plain, adequate and complete remedy at law, and because the bill was filed so shortly before the expiration of the patent that no motion for an injunction could have been regularly noticed. It is manifest that complainant in an action at law could recover nominal damages only. He could not prove loss of license fees, because he had no established license fee; nor could he show lost sales, because he was not in fact selling at all; nor could he show reduction in prices through competition,



because there was no competition; nor that his market was destroyed by the infringer, because he was not undertaking to establish a market. The patentee's remedy at law would seem to be inadequate, if because of his failure to establish a license fee, or to endeavor to market his invention, he had lost the right to recover more than nominal damages, while under a suit in equity there could be recovered the actual profits, possibly large, which the defendant made by his unlawful piracy of plaintiff's invention. The case stated in the bill seems to bring it within the category set forth in *Root v. Railway*. — *Tompkins v. International*, 183 Fed. 773; 106 C. C. A. 529.

*Root v. Railway*, 105 U. S. 189; *Clark v. Wooster*, 119 U. S. 322; *Miller v. Schwarner*, 130 Fed. 561; *Am. Cable v. Chicago*, 41 Fed. 522; *Bragg v. Hartford*, 56 Fed. 292; *Davis v. Smith*, 19 Fed. 823; *Diamond v. Seus*, 159 Fed. 497; *Suffolk v. Hayden*, 70 U. S. 315; *Coupe v. Royer*, 155 U. S. 565; refusing to concur in *McCune v. Baltimore*, 154 Fed. 63.

### § 718. Equity — Rule.

The remedy which the complainant seeks may often determine whether the suit is one arising under the patent law and cognizable only in a court of the United States, or one upon a contract between the patentee and his assigns or licensees, and, therefore, cognizable only in a state court, unless there be diversity of citizenship. Thus, a bill to enforce a contract concerning the title to a patent, or an interest therein, or to declare a forfeiture of an assignment of an interest in a patent, or even a license to make, sell or use the patented thing or an action to recover damages for a breach of contract relating to a patent or a license thereunder, would not, because of the character of remedy or relief sought, be a suit cognizable in a United States court, although the facts stated might have justified a suit for infringement in a United States court, if the complainant had elected that remedy. To sustain the contention that a breach of the implied agreement not to use the machine in question except in a particular way might have supported a suit to forfeit the license, or an action for damages upon the broken contract, counsel have cited and commented at great length upon the cases of *Wilson v. Sanford*, 10 How. 99; *Dale v. Hyatt*, 125 U. S. 46; *Albright v. Teas*, 106 U. S. 613; *Hartell v. Tilghman*, 99 U. S. 547; *Pratt v. Paris*, 168 U. S. 255; *Keeler v. Standard*, 157 U. S. 659, and *Bement v. National*, 186 U. S. 70; but an examination of these cases will disclose that while in some of them a suit for infringement might have been brought, the complainants had in fact brought suits to set aside or enforce contracts relating to patents, or licenses under patents. They were, therefore, not "patent cases," but cases determinable upon principles of general law. \* \* \* The test of jurisdiction is this: Does the complainant "set up some right, title or interest under the patent laws of the United States, or make it appear that some right or privilege will be defeated by one construction, or sustained by another, of those laws?" — *Henry v. Dick*, 224 U. S. 1; 56 L. Ed. 645; 32 S. Ct. 364.

Quoting *Excelsior v. Pacific*, 185 U. S. 282; citg. *Pratt v. Paris*, 168 U. S. 255; *White v. Rankin*, 144 U. S. 628.

### § 721. Infringement.

Obviously, a suit for infringement, which must turn upon the scope of the monopoly or privilege secured to a patentee, presents a case arising under the patent law. — *Henry v. Dick*, 224 U. S. 1; 56 L. Ed. 645; 32 S. Ct. 364.

### § 722. Licensor and Licensee.

Whether a patentee may lawfully impose such restrictions (restrictions to use the machine only with supplies sold by the patentee), and whether

their violation constitutes an infringement, are obviously questions arising under the patent law. — *Henry v. Dick*, 224 U. S. 1; 56 L. Ed. 645; 32 S. Ct. 364.

*Littlefield v. Perry*, 21 Wall. 205.

Were the court to assume supervision of this continuous contract now, and enforce its performance by its injunction, it must continue this supervision, and see to it during the whole existence of the contract that both parties fulfill their mutual obligations. This has been repeatedly declared to be outside of the functions of a court of equity. — *Berliner v. Seaman*, 110 Fed. 30; 49 C. C. A. 99.

*Strang v. Railroad*, 101 Fed. 511; *Marble v. Ripley*, 10 Wall. 339; *Texas & P. v. Marshall*, 136 U. S. 405; *Ross v. Railway*, Fed. Cas. 12,181.

### § 723. Residence.

That an assignment of a cause of action merely to give jurisdiction is ineffective, see — *Consolidated v. Ferguson*, 183 Fed. 756; 106 C. C. A. 330.

### § 724. State Court.

That an action to rescind a contract respecting a patent is not a Federal question, see — *Wade v. Lawder*, 165 U. S. 624; 41 L. Ed. 851; 17 S. Ct. 425.

## LACHES.

### § 727. Application.

If during Dean's suspension of activities, McCormick had either patented the device or brought it into public use without a patent, the public would have been indebted to McCormick for benefits conferred, and Dean might well be held estopped by his delay from claiming the public grant; but in our judgment neither reason nor authority sanctions an estoppel against the first and true inventor unless the later comer has cut in between and made the public his debtor by being the first to get to the patent office or the market. *International v. Kellogg*, 171 Fed. 657; 96 C. C. A. 395.

*Kendall v. Winsor*, 21 How. 328; *Consolidated v. Wright*, 94 U. S. 92; *Savary v. Lauth*, Fed. Cas. 12,389; *White v. Allen*, Fed. Cas. 17,535; *Universal v. Comptograph*, 146 Fed. 984.

It is urged that we should regard unfavorably the patent on account of this delay in the Patent Office, should seek to avoid giving it a broad construction, and should permit the alleged abuse of the law to weigh against the standing of the complainants in a court of equity. But the patentee acted wholly within his rights. He merely took advantage of the delays which the law permitted him. He followed strictly the statutes and rules of procedure, and the courts cannot exact a greater measure of diligence from him. When the patent was granted under the authority of the law, it became entitled to the construction accorded to any other patent. If the statutes and rules permit unnecessary delays, they should be changed; but we reject the view that this court owes a duty to relieve against their operation. This patent, even if it be useful only for tribute, must be viewed without prejudice and with absolute judicial impartiality. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

### § 728. Bringing Suit.

The proofs show that the complainant waited for 12 years before bringing this action, and is guilty of such laches as will preclude a recovery for profits



and damages. — *Safety Car Heating v. Consolidated*, 174 Fed. 658; 98 C. C. A. 412.

## LAW ACTIONS.

### § 735. Findings.

Where the jury has decided the questions of invention and infringement in one way, and no error is found in the conduct of the trial, it is not for us to set aside their verdict merely because, if the same questions were submitted to us as triers of the facts upon the same record, we might have reached a different conclusion. — *Heide v. Panoulas*, 188 Fed. 914; 110 C. C. A. 656.

*Tucker v. Spalding*, 13 Wall. 455.

## LETTERS PATENT.

### § 741. Contract Theory.

The judge of the Circuit Court was of opinion that inventors should be held strictly to the wording of their claims because patents are monopolies given out of the sovereign's generosity and given *ex parte*. We, however, think that patents are grants made in consideration of discoveries which "promote the progress of science and useful arts" (Const. art. 1, § 8), and that they are to be construed liberally so as to effect their real intent. — *Bossert v. Pratt*, 179 Fed. 385; 103 C. C. A. 45.

*Grant v. Raymond*, 6 Pet. 240; *Blanchard v. Sprague*, Fed. Cas. 1517.

A patent is a contract made by the acceptance by the government of the offer which the patentee by his application makes to disclose his invention, in consideration that the United States will secure to him the exclusive use and sale of it for 17 years. The offer embodied in the application becomes the specification of his patent, if his offer is accepted, and with his claims evidences the terms of the agreement. — *Century Electric v. Westinghouse*, 191 Fed. 350; 112 C. C. A. 8.

An American patent is a written contract between an inventor and the government. The contract consists of mutual, interrelated considerations moving from each party to the other for such contract. The consideration given on the part of the inventor to the government is the disclosure of his invention in such plain and full terms that anyone skilled in the art to which it appertains may practise it. The consideration on the part of the government given to the patentee for such disclosure is a monopoly for 17 years of the invention disclosed to the extent of the claims allowed in the patent. — *Krupp v. Midvale*, 191 Fed. 588; 112 C. C. A. 194.

### § 744. Monopoly.

The manufacturing company had the right to select its customers, and to sell and to refuse to sell to whomsoever it chose, and the provision making the Creamery Company its sole sales agent was a usual and reasonable method of providing for the disposition of its product. The effect of this contract, if, indeed, it had any effect, upon interstate or international commerce was only incidental and indirect. — *Virtue v. Creamery*, 179 Fed. 115; 102 C. C. A. 413.

*Union Pacific v. U. S.* 173 Fed. 737; *Whitwell v. Continental*, 125 Fed. 454; *Cincinnati v. Bay*, 200 U. S. 179.

The mere fact that the Creamery Company was a party to an unlawful combination would not deprive it of the right to sue and recover damages

against an infringer of patents owned by it, or to bring suit if it believed the patents were being infringed. — *Virtue v. Creamery*, 179 Fed. 115; 102 C. C. A. 413.

*Strait v. National*, 51 Fed. 819.

Monopoly in production and use being the legitimate purpose of the grant, the sole test of right thereto is the validity and scope of the patent. — *Gen. Electric v. Winona*, 183 Fed. 418; 105 C. C. A. 652.

*Note:* In connection with this decision attention is called to the circuit court decision in *United States v. Standard Sanitary Co.* 191 Fed. 172.

### § 745. Nature of Grant.

A patent is not the grant of a right to make or use or sell. It does not, directly or indirectly, imply any such right. It grants only the right to exclude others. The supposition that a right to make is created by the patent grant is obviously inconsistent with the established distinctions between generic and specific patents, and with the well-known fact that a very considerable portion of the patents granted are in a field covered by a former relatively generic or basic patent, and are tributary to such earlier patent, and cannot be practised unless by license thereunder. — *Herman v. Youngstown*, 191 Fed. 579; 112 C. C. A. 185.

## LICENSE.

### § 755. Forfeiture.

The license contained a forfeiture clause, operative on failure of licensee to pay royalties, or render accounts, after notice from licensor. The licensor gave such notice in writing terminating the license. The licensee paid all accrued royalties. Complainant brought this suit for infringement, and defendant filed a cross-bill for a decree holding the license to be in force and effect. The cross-bill was stricken out, and the bill of complainant dismissed for want of equity. *Held:* We think that the defendant asking affirmative relief followed the better practice in filing the cross-bill. It seems to us that payment of the royalty in licenses is, so far as the licensor is concerned, the main object of the contract, and that a court of equity ought to relieve against the forfeiture if payment with interest will fully compensate him, and this whether the provision as to forfeiture is self executing or at the option of the licensor or in a mode prescribed, as in this case, by giving notice in writing. The complainant contends that, the parties having agreed upon their respective rights in a precise manner, the court would be making a new contract for them if it relieved against the cancellation of the license (on the authority of *White v. Lee*, 3 Fed. 222; *Hammacher v. Wilson*, 26 Fed. 239; *Platt v. Fire Extinguisher*, 59 Fed. 897). We can go with these authorities so far as to hold that, when the contract provides the manner in which the licensor may forfeit the license, he need not apply for assistance to any court, but not to say that in such a case a court of equity is without power to relieve against the forfeiture at the instance of the licensee. Royalties having been paid in full at the time the bill was filed, though with a little delay, and the licensee being ready, willing, and able to pay punctually thereafter, the licensor was not injured, and we think the court properly dismissed the bill. — *Foster v. Taylor*, 184 Fed. 71; 106 C. C. A. 467.

*Giles v. Austin*, 62 N. Y. 486; *Horton v. N. Y. Central*, 12 Abb. N. C. 30; *Atkins v. Chilson*, 11 Mete. 112; *Klein v. Ins. Co.* 104 U. S. 88; *N. Y. Life v. Statham*, 93 U. S. 24; distinguishing *Wilson v. Sanford*, 10 How. 99; *Hartell v. Tilghman*, 99 U. S. 547; *White v. Lee*, *supra*; *Hammacher v. Wilson*, *supra*; *Platt v. Fire Extinguisher*, *supra*.



That where the license agreement did not contain definite terms of forfeiture, *held*: In the absence of any such provision, mere delay in payment, though long continued, would, of course, give a right to sue for royalties but would not ipso facto operate to annul the contract. — *Rowland v. Biesecker*, 185 Fed. 515; 107 C. C. A. 615.

That a licensee holding a non assignable license to make and sell may organize a corporation which he controls and have that corporation manufacture the articles for him exclusively, he accounting personally to the licensor, without forfeiture of his license, see — *Foster v. Taylor*, 191 Fed. 1003; 111 C. C. A. 667.

### § 758. Non-Assignable.

The inventor assigned patents to the West Virginia company with the restriction, among others, that it should not assign the contract without the inventor's consent. By bill of sale the company conveyed all its contracts, good will and property to the Ohio company, its successor without the consent of the inventor. *Held*: The Ohio company was not the successor (or heir) of the West Virginia company. Hibbard's contract, being personal, could not pass to the Ohio company save by assignment, and the assignment could not be effective without Hibbard's consent. — *Niagara v. Hibbard*, 179 Fed. 844; 103 C. C. A. 330.

*Dillingham v. Snow*, 5 Mass. 554; *Overseers v. Sears*, 39 Mass. 122; *Hapgood v. Hewitt*, 119 U. S. 226; *Boston v. Potter*, 123 Mass. 28; *Bowers v. Lake Superior*, 149 Fed. 983.

### § 759. Parol.

The license was oral, it is true; but that is no objection to its validity. — *St. Louis v. Sanitary*, 178 Fed. 923; 103 C. C. A. 565.

*Sharpley v. Moseley*, 75 Fed. 595; *Gayler v. Wilder*, 10 How. 477.

### § 760. Royalties.

The licensee gave a sub license, receiving \$20,000 lump sum for the first 800,000 articles, regardless of the validity of the patent and regardless of whether the sub-licensee took that number or not; and a further royalty of one cent each on all articles over 800,000. The licensee contended that the \$20,000 was a bonus to him, for which he did not have to account to his licensor. *Held*: We cannot assent to this construction. It is immaterial when the banks were made, or whether the whole number are ever made. Royalties freeing them from the patent have been paid once for all, under an agreement not to make reclamation for any part of them, should the patent be held invalid. To the extent of the 800,000 his licensors are entitled to look to Brigham for the royalties he agreed to pay to them at the stipulated rate of one cent each. — *Reizenstein v. Koopman*, 178 Fed. 546; 101 C. C. A. 462.

That where a licensee consigned a shipment of goods and the same were destroyed by fire in transit and the licensee collected insurance on the goods, the licensor was entitled to regular royalties on the same — the insurance company being regarded as a purchaser, see — *Reizenstein v. Koopman*, 178 Fed. 546; 101 C. C. A. 462.

### § 761. Scope of.

That when defendants agreed to pay plaintiff \$500 upon demonstration of his invention and the further sum of \$2500 from sales under the patent, and plaintiff failed to obtain a patent and one of the defendants subsequently

obtained a patent on the device, *held*: Treating the action as in tort, which was the theory on which it was tried, to recover damages for the wrongful appropriation by the defendants of plaintiff's invention, the measure of damages is obviously the value of the invention. But the proof showed that no clutch was manufactured or sold between the date of the patent to Forman and the trial. The evidence is that the invention was commercially a failure. What the defendants had agreed they would pay the plaintiff upon a contingency which never happened, viz., \$2000 out of the first profits earned, is no evidence of the actual value of the invention. — *Childs v. LeBrocq*, 178 Fed. 719; 102 C. C. A. 211.

A limited license conveys only the rights defined therein, and if the licensee makes any other or different use, either as to time or place, than that authorized by the license, he becomes an infringer, and his limited license is no justification. — *St. Louis v. Sanitary*, 178 Fed. 923; 103 C. C. A. 565.

*Heaton v. Eureka*, 77 Fed. 288.

#### § 762. Termination of.

The license provided: "This agreement to extend 5 years from date with privilege of 10 years, or terminate at any time if by mutual consent of both parties." *Held*: Defendant's privilege of continuing for 10 years was one which he could exercise *ex parte*. The case differs materially from *Seal v. Bookkeeper*, 130 Fed. 449, relied on by complainant, where it was provided that the second party might renew for an extended period "by mailing first party written notice of his intention so to do." — *Rowland v. Biesecker*, 185 Fed. 515; 107 C. C. A. 615.

#### § 764. Miscellaneous.

Neither does the fact that the license was granted after the application was filed, but before the issuance of the letters patent, render it invalid. — *St. Louis v. Sanitary*, 178 Fed. 923; 103 C. C. A. 565.

*Brush v. California*, 59 Fed. 945.

### MACHINE AND PROCESS.

#### § 770. General Rules.

A process and an apparatus by which it is performed are distinct things. They may be found in one patent; they may be made the subject of different patents. — *Leeds v. Victor*, 213 U. S. 301; 53 L. Ed. 805; 29 S. Ct. 495.

That the fact that the patented process cannot be used without the patented apparatus, or the apparatus without the process, does not make them the same invention and not separately patentable, and that as the statute makes no such distinction, the courts may not, see — *Century Electric v. Westinghouse*, 191 Fed. 350; 112 C. C. A. 8.

*Armour v. United States*, 153 Fed. 1.

### MANUFACTURE.

#### § 774. Novelty.

A new article of commerce is not necessarily a new article patentable as such. But patentable novelty in a case like the present may be founded upon superior efficiency; upon superior durability, including the ability to retain a permanent form when exposed to the atmosphere; upon a lesser tendency to breakage and loss; upon purity, and, in connection with other things, upon comparative cheapness. So, as supplementing other considerations, commercial success may properly be compared with mere laboratory



experiments. — *Union Carbide v. Am. Carbide*, 181 Fed. 104; 104 C. C. A. 522.

### MARKING "PATENTED."

#### § 777. Rulings under the Statute.

The design was used upon a belt and upon a hatband. To all the belts he made and sold he affixed the notice "Lichtenstein Pennant Belt, Pat. Jan. 15, 1907." To the hatbands, however, which he made, placed on women's sailor hats and sold with the hats, he affixed no notice; but upon the lining in the inside of the hats he printed the notice, "Lichtenstein Pennant Sailor, Pat. Jan. 15, 1907." We do not think it can be fairly said that the label inside on the lining of the hat was affixed to the band, or that the hat was a package within which one or more bands were enclosed. Inasmuch as complainant admits that no labels other than these were affixed to anything, he has failed to make sufficient proof of notice to entitle him to recover damages, profits, or statutory penalty. — *Lichtenstein v. Phipps*, 168 Fed. 578; 93 C. C. A. 483.

*Note:* This case is believed to be the climax of this sort of hair-splitting that has been indulged in of late in the misinterpretation of the statute. While we must bow to the dictates of this court, we sincerely hope it will not be long before the Supreme Court puts a stop to this line of decisions, and reverses a goodly number of them.

The testimony is unpersuasive that all the monuments sold were marked. Indeed, the evidence with respect to several — the Coon monument, for example — is convincing that they were not marked. The complainant has failed to establish a case in which damages can be recovered. — *Crier v. Innes*, 170 Fed. 324; 95 C. C. A. 508.

*Note:* This is carrying the rule as to marking a step beyond what has ever before been held. Not only must the complainant have marked *every* article sold, but the *burden of proof* is apparently upon him to establish that fact. While this is a holding with reference to a penalty in a design case, with the present tendency of this court on this subject, the next step may be to extend this rule generally to all cases.

The opinion of Judge Brown covers the following points in *qui tam* actions under § 4921, R. S.:

1. That the statute does not prescribe a distinct penalty for each individual article marked, but merely a penalty for the offense of marking, and that, therefore, where the marking is all done on the same day and at the same time, so that it is practically a single, continuous act, but one offense is committed and only a single penalty is recoverable, though more than one article may have been marked. *Hotchkiss v. Cupples*, 53 Fed. 1018; *Hoyt v. Computing*, 96 Fed. 250; *Taft v. Stephens*, 38 Fed. 28.

2. As the penalty is not measured by the extent of publication of the false statement, the statute must be read as making the fraudulent purpose or intent to deceive the public the gravamen of the offense, and the marking as the overt act whereby the intent is made manifest. *U. S. Condensed v. Smith*, 101 N. Y. Supp. 129.

3. That a plaintiff, in order to recover more than a single penalty, must go further than to prove the marking of a number of unpatented articles. The proof must be sufficiently specific as to the time and circumstances to show a number of distinct offenses, and to negative the possibility that the marking of the different articles was in the course of a single and continuous act.



4. Though a single violation of the statute may be proved by general evidence that the article was falsely marked within the period of the statute of limitations, yet concerning the article of the character in question in this suit there can arise no presumption that each act of marking was so separated from the others as to constitute a distinct offense.

5. In order to prove distinct offenses, however, it was not essential that the plaintiff should be able to prove the specific date of marking. It was sufficient if the evidence showed such divergence of time and circumstances as to make one act of marking separable and distinct from the other acts of marking.

6. The commission of a single offense could be proved by evidence that the marking was done within the period of limitations. The ruling that the plaintiff was bound to prove some specific date of marking, and could not recover without doing so, was error.

7. That where the evidence is sufficient to raise the question of commission of an act of marking, it should be submitted to the jury.

8. The purpose to deceive the public is an essential element of the offense, and the burden is upon the plaintiff to establish this purpose, as well as the fact that the article is unpatented. The statute does not extend to one who has an honest, though mistaken, belief that upon a proper construction of the patent, it covers the article which he marks. The question of guilt does not depend upon such close or exact construction of the patent as is usual upon bills for infringement where the issue is as to the extent of the patentee's right under letters patent.

9. Where the article marked is obviously very remote from the patent referred to in justification of the marking, this difference alone may be sufficient to show an intention to deceive; but where the difference is slight, and the question of the breadth of the invention or of the claims is so close as to permit of an honest difference of opinion, then it may become necessary for the plaintiff to adduce testimony additional to the fact that the article is unpatented, in order to show guilty knowledge as distinguished from erroneous opinion.

10. Though the article was without the terms of the patent, the question of the defendant's good faith in assuming it to be within the patent was a question of fact for the jury.

11. The defendant contends that this offense is one that cannot be committed by a corporation; but we are of opinion that this objection is without merit. *N. Y. Central v. U. S.* 212 U. S. 481; *United States v. Union*, 215 U. S. 50.

12. An officer of a defendant corporation may not refuse to testify on the ground that he is privileged. *Hale v. Henkel*, 201 U. S. 43. — *London v. Dunbar*, 179 Fed. 506; 103 C. C. A. 130.

That where complainant alleged "that it has applied the said improvements to practical use, and has always stood ready and now stands ready to supply any and all demands of the public for said improvement," etc., and upon giving supplemental proofs before the master asserts that it never gave notice required by § 4900 because one of the patented articles had been in existence, in order to avoid the force and effect of that section; *held*: We think such a contention cannot be sustained. What right of recovery of profits or damages the complainant might have had, if in its bill it had substituted for the allegations above quoted allegations showing that it had locked up its patent and had not used it, we need not consider. It is sufficient for us at present to say that the defendant was not called on by the bill to defend against the complainant's present contention. — *Lorain v. N. Y. Switch*, 184 Fed. 301; 106 C. C. A. 443.



## OATH.

**§ 779. Statutory Requirements and General Rule.**

That it is not perjury under § 5392, R. S. for an applicant to swear that he is the sole inventor when in fact he is a joint inventor, see — *Patterson v. U. S.* 181 Fed. 970; 104 C. C. A. 434.

**§ 780. Supplemental Oath.**

He made no claim for a process and disclosed no invention of a device. This being so, the amendment required an oath that Dolan might have found it difficult to make, and for want of it the patent is void. — *Steward v. American*, 215 U. S. 161; 54 L. Ed. 139; 30 S. Ct. 46.

R. S. § 4892; *Chicago v. Sayles*, 97 U. S. 554; *Eagleton v. West*, 111 U. S. 490; *Kennedy v. Hazleton*, 128 U. S. 667; *De La Vergne v. Featherstone*, 147 U. S. 209.

That where a claim is added by amendment without supplemental oath, if the claim is narrower than the invention previously claimed and the subject-matter is shown, it is not invalid for want of oath, see — *General v. Morgan-Gardner*, 168 Fed. 52; 93 C. C. A. 474.

## PATENT OFFICE.

**§ 787. Miscellaneous.**

For an instance of the inadequacy and superficiality of some Patent Office actions, see — *Am. Specialty v. New England*, 176 Fed. 557; 100 C. C. A. 193.

## PLEADING AND PRACTICE.

**§ 790. Bill of Review.**

That where, upon the affirmance of a decree dismissing a bill, the complainant files a disclaimer and asks amendment of the mandate to permit the filing of a supplemental bill in the nature of a bill of review, such motion is made in season, see — *Fellows v. Borden's*, 187 Fed. 1005; 109 C. C. A. 535.

**§ 794. Multifariousness.**

That where judgment has been had against several defendants for infringement and execution returned unsatisfied, in a suit brought to reach the property of one of the defendants — the liability of the several defendants not being identical — the bill is not multifarious as joining different causes and conditions, see — *Hobbs v. Gooding*, 176 Fed. 259; 100 C. C. A. 83.

**§ 795. Notice.**

That where a substantial defense of anticipation, not pleaded, was developed upon cross-examination of complainant's witnesses, and no objection to want of statutory notice was made, such objection cannot be raised for the first time on the appeal; and to allow further evidence to be taken after decision in the Circuit Court of Appeals would introduce a novel practice, and one which should not be encouraged. — *Dey v. Bundy*, 178 Fed. 812; 102 C. C. A. 269.

Objection is made to certain testimony of anticipation and prior use because notice was not given of it in the answer. It was admissible to show the

state of the art, to show what was old, to distinguish what is new, and to aid the court in the construction of the patent. — *Stevens v. Rodgers*, 186 Fed. 631; 108 C. C. A. 495.

*Dunbar v. Myers*, 94 U. S. 187; *May v. Juneau*, 137 U. S. 408.

### § 803. Sufficiency.

We do not intend to approve the action of the complainant in withholding the prior application until after the defendant's proofs had been taken and the introduction of rebutting testimony had commenced. It would seem that defendant is entitled to know by allegations in the bill when the application for patent was filed and prepare his defense accordingly. — *Corrington v. Westinghouse*, 178 Fed. 711; 103 C. C. A. 479.

That where the answer to a bill on several patents was a general denial of infringement, and the proofs showed two separate causes of action, so that the bill might have been treated as multifarious, the answer cannot be treated as a denial of one cause and an admission of the other, see — *Perry v. Chicago*, 178 Fed. 449; 101 C. C. A. 433.

### § 804. Suit on Plurality of Patents.

The only difference in the two patents consists in the fact that the invention of the patent of 1901 improved one of the elements of the combination of the earlier patent. The infringement was of both patents, in the same machine, and by the same parties. We think there could be no valid objection to the joinder of the patents in one suit, and that it was warranted by the precedents. — *Vrooman v. Penhollow*, 179 Fed. 296; 102 C. C. A. 484.

Walk. Pat. § 417, and cases cited.

### § 805. Supplemental Bills.

That while leave to file a supplemental bill is discretionary with the court, in a case where the officers of a defendant corporation have dissipated the assets of the company to avoid paying damages, the proper course is by a creditor's bill, see — *Brookfield v. Novelty*, 170 Fed. 960; 96 C. C. A. 127.

10 Cyc. 665; *Jackson v. Ludeling*, 21 Wall. 616; *Weston v. Empire*, 166 Fed. 869.

### § 806. Title.

That where it appears that a party apparently holding a legal interest should have been made a party complainant, the court will permit amendment to bring in such party, see — *Snead v. Scheble*, 175 Fed. 570; 99 C. C. A. 578.

*Clark v. Wooster*, 119 U. S. 322; *Busch v. Jones*, 184 U. S. 598; *Carnegie v. Colorado*, 165 Fed. 195.

That where the record shows a legal part interest in the patent outstanding in a corporation assignee, although such corporation may never have actually assumed title and although such corporation may have been closed out by a receiver, in the absence of positive record showing that the entire title has been reinvested in complainant, such corporation will be presumed to be in existence and must be made a party, see — *Snead v. Scheble*, 175 Fed. 570; 99 C. C. A. 578.

*Railroad v. Trimble*, 10 Wall. 367.



### § 807. Miscellaneous Rules of Practice and Pleading.

The Circuit Court was right in striking out the file-wrapper and contents and the prior patents as amendments to the bill, it still being improper to plead evidence. — *Lange v. McGuin*, 177 Fed. 219; 101 C. C. A. 389.

That a statement in pleading which might be construed as an admission of a fact is not to be so interpreted and held when the context of the pleading is to the contrary and the other party has not been misled thereby, see — *American Stoker v. Underfeed*, 188 Fed. 314; 110 C. C. A. 292.

## PRIORITY.

### § 812. Miscellaneous Holdings.

If the two applications disclose substantially the same subject-matter, in the absence of any other evidence of the date of invention, the date of the first application would be prima facie taken as the date of the first invention. — *Electric v. Westinghouse*, 171 Fed. 83; 96 C. C. A. 187.

*Drewson v. Hartje*, 131 Fed. 734.

In view of the action of the patentee in requesting the suppression of the earlier application it is contended by the defendant that it cannot be used to enable the patentee to avail himself of an earlier application date than that stated in the patent. Though the question is not free from doubt, we have concluded that the reasoning of the judge of the circuit court in this regard is sustained by the weight of authority and we therefore accept May 16, 1903 (the date of filing of the first and abandoned application), as the filing date of the application. In so deciding we do not intend to approve the action of the complainant in withholding the prior application until after the defendant's proofs had been taken and the introduction of rebutting testimony had commenced. — *Corrington v. Westinghouse*, 178 Fed. 711; 103 C. C. A. 479.

*Victor v. Am. Graphophone*, 145 Fed. 350; *Tooth Crown v. Richmond*, 30 Fed. 775.

## PROCESS.

### § 817. Mechanical.

It is undoubtedly true, and all the cases agree, that the mere function or effect of the operation of a machine cannot be the subject-matter of a lawful patent. But it does not follow that a method of doing a thing, so clearly indicated that those skilled in the art can avail themselves of mechanism to carry it into operation, is not the subject-matter of a valid patent. The contrary has been declared in decisions of this court. We therefore reach the conclusion that an invention or discovery of a process or method involving mechanical operations, and producing a new and useful result, may be within the protection of the Federal statute, and entitle the inventor to a patent for a discovery. — *Expanded v. Bradford*, 214 U. S. 366; 53 L. Ed. 1034; 29 S. Ct. 652.

*Cochrane v. Deener*, 94 U. S. 780; *Tilghman v. Proctor*, 102 U. S. 707; *Eastern v. Standard*, 30 Fed. 63; *Union v. Waterbury*, 39 Fed. 389; *Travers v. American*, 64 Fed. 771; *Carnegie v. Cambria*, 185 U. S. 403; *Telephone Cases*, 126 U. S. 1; *Leeds v. Victor*, 213 U. S. 301; distinguishing *Westinghouse v. Boyden*, 170 U. S. 537; *Wicke v. Ostrum*, 103 U. S. 461.

*Note:* While this case merely distinguishes the process from such as that in the *Westinghouse* case, it is the entering wedge for the reversal of the bad law of that case.

That a mechanical process, such as making wire glass, is patentable, see — *Western Glass v. Schmertz*, 185 Fed. 788; 109 C. C. A. 1.

*Expanded v. Bradford*, 214 U. S. 366; *Streator v. Wire Glass*, 97 Fed. 950.

### § 819. Patentability.

The word "process" is not used in the statute. The inventor of a new and useful art is distinctly entitled to the benefit of the statute as well as he who invents a machine, manufacture, or composition of matter. The word "process" has been brought into the decisions because it is supposedly an equivalent form of expression, or included in the statutory designation of a new and useful art. — *Expanded v. Bradford*, 214 U. S. 366; 53 L. Ed. 1034; 29 S. Ct. 652.

That where the steps of the process produce a chemical change, the process is patentable, see — *Byerley v. Sun*, 184 Fed. 455; 106 C. C. A. 455.

## PROFITS.

### § 830. Deductions — Manufacturer's Profits.

We are clear that the complainants are entitled to recover from the defendant what are termed "manufacturer's profits;" that is, profits which the defendant company made in the manufacture and sale of weather strips embodying complainant's patent. — *Nat. Metal v. Bredin*, 186 Fed. 490; 108 C. C. A. 468.

### § 836. Master in Chancery.

In view of this well settled rule, we think the court below would not have been warranted in setting aside the finding of fact to which we have referred, and that therefore this court, of course, should not do so. — *Cimiotti v. American*, 168 Fed. 529; 93 C. C. A. 546.

In the absence of manifest error, it is not the province of this court to disturb the findings of a master reached upon conflicting testimony, which findings have been examined and adopted by the Circuit Court. — *Brown v. Drohen*, 175 Fed. 576; 99 C. C. A. 192.

His conclusion was reviewed on exceptions by the learned trial judge. Both of them found against the contention. There being no obvious error of law or serious mistake of fact, their findings will be accepted as true. — *Dowagiac v. Minnesota*, 183 Fed. 314; 105 C. C. A. 526.

*Moline v. Carson*, 72. Fed. 387; *Brown v. Lanyon*, 179 Fed. 309.

### § 837. Measure of — Actual Gains.

The portion of the profit paid out in dividends during the accounting period and the sums paid for legal and expert services in the litigation over the patent were added together, and from the sum was deducted the deficit existing at the end of the accounting period. Assuming that the company paid no exorbitant salaries, and that it did not in any other manner unfairly dispose of its earnings, we think the method was as fair a one as could have been adopted. — *Nat. Metal v. Bredin*, 186 Fed. 490; 108 C. C. A. 468.

A manufacturer who devises a machine that he honestly believes he has a right to use \* \* \* is not to be mulcted in punitive damages. Equity is satisfied if he accounts for all the pecuniary benefits he derived from the use of the infringing machine. If there were no other way of obtaining the result, he might rightly be held for all the profits he made from the output of his



establishment. But if, as here, other machines for doing the same work, though less effectively, were available at the date of the patent, the whole advantage would lie in the increase of efficiency. \* \* \* If, however, he should adopt a machine that finally was adjudged to be an infringement, all that he would actually gain by the infringement would be the excess of effectiveness of the machine over the later, available, competitive machines. (That is, machines available later than the date of the infringed patent.) — *Columbia Wire v. Kokomo*, 194 Fed. 108; 114 C. C. A. 186.

*Note:* This evidently extends the well-known rule of the cases cited in the foot-note, page 109, to include all machines which are available at the time the infringement occurred. Would this include machines subsequently patented to others? This opens a serious question.

### § 838. Measure of — Entire Profits.

No doubt the saving or advantage to the defendants is the true measure. *Cawood Pat.* 94 U. S. 695. But this may well be taken as represented by the difference between profitable and unprofitable commercial manufacture. More accurately, it would be the difference between the cost of insulators as made by the machine of the patent and the cost as made by those open to the defendants. But for all practical purposes, the two under the evidence are the same. If salable articles, in other words, could not be made at the ruling prices by the old methods, without a loss, while with the machine of the patent there would be a profit, the profit so made has certainly been saved or gained from the invention. — *Novelty v. Brookfield*, 170 Fed. 946; 95 C. C. A. 516.

When the entire profit of a business results from the use of the patented invention, the patentee will be entitled to recover the entire profits if he elects that remedy. — *Nat. Metal v. Bredin*, 186 Fed. 490; 108 C. C. A. 468.

*Crosby v. Safety Valve*, 141 U. S. 452; *Wales v. Waterbury*, 101 Fed. 126; *Orr v. Murray*, 163 Fed. 54; *Elizabeth v. Pavement Co.* 97 U. S. 126.

Complainant made sewing machines containing the combinations of an expired patent and a valid, living patent. Defendant bought up old machines of complainant's make containing the combination of the expired patent, rebuilt the machines and added the combination of the living patent. The master reported entire profits of defendant upon the ground that the salability of the machines was due to the presence of the valid combination. Affirming the decree it was *held*: The general rule relied upon by the appellant in regard to the recovery of profits in infringement cases is that quoted from *Westinghouse v. N. Y. Air Brake Co.* 140 Fed. 545-9 (quoting). But, in stating this rule, the court called attention to circumstances which may except a case from its application, as where the "profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine, as a marketable article, is properly and legally attributable thereto" (i. e., to the patented feature). There are many cases in which this rule is affirmed, and there is no controversy as to its propriety. The only questions that arise are as to its applicability to the peculiar circumstances of a given case. — *Maimin v. Union Special Mach. Co.* 187 Fed. 123; 109 C. C. A. 41.

*Goulds v. Cowing*, 105 U. S. 253.

### § 840. Measure of — Savings by Use.

It is not as though they were being charged for infringing sales of the machine, where the profits recoverable would properly be confined to those realized from the features which constituted the patentable advance on the

prior art. *Force v. Sawyer*, 143 Fed. 894. The infringement here is in the use of the patented machine, and response must be made in consequence for the saving effected, not from any particular part, but from the whole. — *Novelty v. Brookfield*, 170 Fed. 946; 95 C. C. A. 516.

Instead of making money in carrying out his contract with the government, he lost money, and the decree against him is sustained upon the theory that but for the use of the infringing machines, he would have lost more money. — *Brown v. Drohen*, 175 Fed. 576; 99 C. C. A. 192.

The comparison between the cost of doing the work by hand labor and by the patented machine was correctly adopted as the proper standard by which to measure the defendant's profits. As there were no machines existing prior to the date of the inventions covered by the complainant's patents, which could do the work, hand labor was the only available standard of comparison. If the defendant had not used infringing machines he would have been compelled to use hand labor. — *Brown v. Drohen*, 175 Fed. 576; 99 C. C. A. 192.

#### § 841. Measure of — Trustee ex Maleficio Rule.

For the full and final delimitation of the rule of trustee ex maleficio, see extended excerpt from *Westinghouse v. Wagner*, 225 U. S. 604; 56 L. Ed. —; 32 S. Ct. 691; under § 845.

The infringement in this case was deliberate, with every means taken to avoid being responsible for it, and if there are any uncertainties in the situation, it is for the defendants, and not the complainants, to clear them up. — *Novelty v. Brookfield*, 170 Fed. 946; 95 C. C. A. 516.

*Rose v. Hirsh*, 94 Fed. 177; *Regina v. Otto*, 114 Fed. 508.

#### § 843. Segregation — Burden of Proof.

The general rule in patent cases, like all others, is that a complainant is entitled to recover damages for the loss he has sustained by reason of the wrongful acts of the infringer, and the burden is on him to show how much it is. — *Dowagiac v. Minnesota*, 183 Fed. 314; 105 C. C. A. 526.

*Garretson v. Clark*, 111 U. S. 120.

If the Ottofy device as limited had any special value when used as but a small part of a large completed structure, the complainant as owner of the patent should have introduced evidence of the profits realized by the infringer and ascribable to the particular device in question, so that they could be ascertained and stated by the master. — *Am. Street Flushing Mach. v. St. Louis*, 192 Fed. 121; 112 C. C. A. 582.

*Westinghouse v. Wagner*, 173 Fed. 361; *Brown v. Lanyon*, 179 Fed. 309; *Dowagiac v. Plow Co.* 183 Fed. 314.

#### § 845. Segregation — General Rules.

*The final rule of the Supreme Court.*

After more than a quarter of a century of misconstruction of the statute and academic refinement and sophistry centering about the old Mop Case, the Supreme Court in reversing *Westinghouse v. Wagner*, 175 Fed. 361, and following the masterly dissenting opinion of Judge Sanborn, has put on sound foundations the rules of segregation and trustee ex maleficio. So important and far-reaching is this decision, it is excerpted liberally.

The writ was issued in view of the holding that, though the master found that the defendant had made a profit of \$132,000 from the sale of infringing



transformers, the plaintiff could yet only recover one dollar because it failed to separate the profits made by its patent from those made by the defendant's addition.

1. The question as to who has the burden of proof, in cases like this, is one of great practical importance and constantly arises in patent causes. There has been much controversy on the subject and a conflict in the decisions. \* \* \* It will be sufficient for the present purposes to say that —

(a) Where the infringer has sold or used a patented article, the plaintiff is entitled to recover all of the profits.

(b) Where a patent, though using old elements, gives the entire value to the combination, the plaintiff is entitled to recover all the profits. (*Hurlbat v. Shillinger*, 130 U. S. 472.)

(c) Where profits are made by the use of an article patented as an entirety, the infringer is liable for all the profits — “unless he can show — and the burden is on him to show — that a portion of them is the result of some other thing used by him.” (*Elizabeth v. Paving Co.* 97 U. S. 127.)

(d) But there are many cases in which the plaintiff's patent is only a part of the machine and creates only a part of the profits. His invention may have been used in combination with valuable improvements made, or other patents appropriated by the infringer, and each may have jointly, but unequally, contributed to the profits. In such case, if plaintiff's patent only created a part of the profits, he is only entitled to recover that part of the net gains. He must, therefore, “give evidence tending to separate or apportion the defendant's profits and the patentee's damages between the patented feature and the unpatented features, and such evidence must be reliable and tangible, and not conjectural or speculative; or he must show, by equally reliable and satisfactory evidence, that the profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine, as a marketable article, is properly and legally attributable to the patented feature.” (*Garretson v. Clark*, 111 U. S. 121.)

The real controversy arises in applying this principle to those cases where it is impossible to separate the single profit into its component parts.

In considering the question presented by the record here, it is to be borne in mind that Congress has legislated (R. S. 4921) with a view of affording the patentee ample redress against the infringer. It not only makes the latter liable for damages — sometimes threefold damages — but for all profits derived from the use or sale of plaintiff's invention. The rule as to the burden of proof has, however, been so applied that this statutory right has been often nullified by those infringers who had ingenuity enough to smother the patent with improvements belonging to themselves or to third persons. In such cases the greater the wrong the greater the immunity; the greater the number of improvements the greater the difficulty of separating the profits. And if that difficulty could only be converted into an impossibility the defendant retained all of the gains, because the injured patentee could not separate what the guilty infringer had made impossible of separation. Manifestly such consequences demonstrate that either the rule or its application is wrong. The rule is sound, for it but announces the general proposition that the plaintiff must prove its case and carry the burden imposed by law upon every person seeking to recover money or property from another. But the principle must not be pressed so far as to override others equally important in the administration of justice. \* \* \*

The plaintiff proved its patent and that it had been infringed. \* \* \* But no matter how great its presumptive or actual value, it did not follow that the defendant had made a profit by the sale of the infringing transformers. And so, having sued for profits, the Westinghouse Company was under the burden of showing they had been made. This it did to the satisfaction of the master. The defendant then had the right either to disprove the plain-



tiff's case or to offer evidence in mitigation, or both. Accordingly it submitted evidence tending to show that the spaces added by the defendants were non-infringing and valuable improvements which had contributed to the making of the profits. In reply the Westinghouse Company insisted that claim 4 was an entirety. \* \* \* For that reason the plaintiff contended that it had shown that all the gains were "legally attributable to the patented feature." (*Garretson v. Clark*, 111 U. S. 121; *Elizabeth v. Pavement Co.* 97 U. S. 127; *Crosby v. Safety Valve*, 141 U. S. 454; *Keystone v. Adams*, 151 U. S. 144.) This view was sustained by the master. But if it be assumed as was found to be the fact by the court, that the spaces were non-infringing and valuable improvements, it may then have prima facie appeared that these changes had contributed to the profits. If so, the burden of apportionment was then logically on the plaintiff, since it was only entitled to recover such part of the commingled profits as was attributable to the use of its invention.

3. Lindley, L. J., said in *Siddell v. Vickers*, 9 Rep. Pat. Cas. 162, that there "was no form of account more difficult to work out than an account of profits." But that is no reason why the plaintiff should be denied its rights. The problem here, though different, was in many respects analogous to that presented in those cases where it was necessary to separate interstate from intrastate earnings made by a railroad. \* \* \* The courts, "while recognizing the impossibility of reaching a conclusion that is mathematically exact," have, in addition to the other evidence bearing on the question, received "the testimony of experts as to the relative cost of doing a local and through business." (*Chicago v. Tompkins*, 176 U. S. 178.) The converse is true. What is permissible in an effort to separate costs may also be done in a patent case where it is necessary to separate profits (*Root v. Railway*, 105 U. S. 198. See also *Rubber Co. v. Goodyear*, 9 Wall. 802). \* \* \*

4. Having, by books and other data, proved to the satisfaction of the master the existence of profits, the plaintiff had carried the burden imposed by law, and established every element necessary to entitle it to a decree, except one. As to that, the act of the defendant had made it not merely difficult but impossible to carry the burden of apportionment. But plaintiff offered evidence tending to establish a legal equivalent. It had proved the existence of a fact which, whether treated as a rule of evidence or as a matter of substantive law, would entitle it to a decree for all the profits. The method was different from that mentioned in the second branch of the rule in the *Garretson Case*, but the plaintiff had now presented proof to demonstrate its right to the whole of the fund because of the fact that the defendant had inextricably commingled and confused the parts composing it. This result would not be in conflict with the principle which in the first instance imposed the burden of proof on the plaintiff, but merely gave legal effect to a new fact which as a matter of law entitled the patentee to a particular judgment. It presented a case where the court was called on to determine the liability of a trustee ex maleficio, who had confused his own gains with those which belonged to the plaintiff. One party or the other must suffer. The inseparable profit must be given to the patentee or infringer. The loss had to fall on the innocent or the guilty. In such an alternative the law places the loss on the wrongdoer.

5. It is said, however, that the rule does not apply in patent cases. Why it should be limited does not appear. It is admitted that an injunction may be granted against selling infringing devices, even though the result will be to prevent the defendant from using valuable appliances confused with the patented device. And Lord Eldon treated this conceded right to enjoin as an application of the rule relating to the confusion of goods. He therefore restrained the publication of a book, a large portion of which was original, because copyright matter was incorporated therein. \* \* \* (*Mawman v.*



Tegg, 2 Russ. 390.) This case was cited and approved in *Callaghan v. Myers*, 128 U. S. 658, where the infringer who had blended his own with copyright matter, in a volume which sold for a profit, was made to "abide the consequences on the same principle that he who has wrongfully produced a confusion of goods must alone suffer." \* \* \* In both, as in patent cases, the infringer was a "trustee for the plaintiff in respect of profits." (*Root v. Railway*, 105 U. S. 214.) And the liability is not lessened because the confusion is due to a wrongful appropriation by a trustee de son tort instead of carelessness of a trustee lawfully appointed.

6. \* \* \* This conclusion is said to be in conflict with the *Garretson* and other decisions which, it is claimed, justify the conclusion that the defendant is entitled to retain all of the profits even where the patentee is unable to make an apportionment. (*Warren v. Keep*, 155 U. S. 265.) An analysis of the facts of those cases will show that they do not sustain so extreme a doctrine. For they deal with instances where the plaintiff apparently relied on the theory that the burden was on the defendant, and for that, or other reasons, made no attempt whatever to separate the profits. None of the cases cited discuss the rights of the patentee who has exhausted all available means of apportionment, who has resorted to the books and employees of the defendant, and by them, or expert testimony, proved that it was impossible to make a separation of the profits. This distinction, between difficulty and impossibility, is involved in the ruling \* \* \* in *Brennan v. Dowagiac*, 162 Fed. 476, where the *Garretson* Case was distinguished. \* \* \*

It may be argued that, in its last analysis, this is but another way of saying that the burden of proof is on the defendant. And no doubt such, in the end, will be the practical result in many cases. But such burden is not imposed by law; nor is it so shifted until after the plaintiff has proved the existence of profits attributable to his invention and demonstrated that they are impossible of accurate or approximate apportionment. If then the burden of separation is cast on the defendant, it is one which justly should be borne by him, as he wrought the confusion. — *Westinghouse v. Wagner*, 225 U. S. 604; 56 L. Ed. —; 32 S. Ct. 691.

These authorities make it clear, we think, that an apportionment of profits between the patented and unpatented parts of the drill was indispensably necessary. The invention did not inhere in the entire machine as an entirety, but was only an improvement in a single element of an otherwise well-known device. — *Dowagiac v. Minnesota*, 183 Fed. 314; 105 C. C. A. 526.

*Garretson v. Clark*, 111 U. S. 120; *Tilghman v. Proctor*, 125 U. S. 136; *McCready v. Pennsylvania*, 141 U. S. 459; *Crosby v. Supply*, 141 U. S. 441; *Sessions v. Romadka*, 145 U. S. 29; *Keystone v. Adams*, 151 U. S. 139; *Westinghouse v. Wagner*, 173 Fed. 361; *Brown v. Lanyon*, 179 Fed. 309.

### § 846. Segregation — Miscellaneous Rules.

That where the main efficiency of the machine depends entirely upon the patent in suit, and where subsequent minor patented improvements have been added which contribute in some measure to the machine, segregation is not necessary, see — *Novelty v. Brookfield*, 170 Fed. 946; 95 C. C. A. 516.

That where the patented article consisted of three elements, only one of the elements being covered by the patent, the profits should be limited to the patented element, see — *Nat. Metal v. Bredin*, 186 Fed. 490; 108 C. C. A. 468.

### § 847. Miscellaneous Rules Concerning Profits.

Even if James Bredin's claim as licensee could have been properly joined with the claim of the owners of the patent, it was not so joined, and the award to the complainants jointly of profits arising, not from the manufacture and sale of the strips, which did belong to the complainants, but from the installation of the strips, which belonged exclusively to the licensee, was to extend the decree quite beyond the scope of the pleadings. — *Nat. Metal v. Bredin*, 186 Fed. 490; 108 C. C. A. 468.

*Brookfield v. Novelty*, 170 Fed. 960.

## PUBLIC USE.

### § 851. Experiment.

He did not sell or lease his completed device; he did not permit others to use it; he did not use it himself. He did, to the knowledge of others, couple it to a telephone line to see whether it would do what he hoped. He lost nothing by such a use. — *International v. Kellogg*, 171 Fed. 651; 96 C. C. A. 395.

*Elizabeth v. Pavement*, 97 U. S. 126.

### § 856. Single Use.

The fact that there was only a single sale of a single machine does not save the patent. One sale before the two years' period will invalidate a patent as well as many. — *National v. American*, 178 Fed. 79; 101 C. C. A. 569.

*Smith v. Sprague*, 123 U. S. 249; *Consolidated v. Wright*, 94 U. S. 92; *Covert v. Covert*, 106 Fed. 183; *Henry v. Frankestown*, 2 Fed. 78.

## REDUCTION TO PRACTICE.

### § 861. Diligence.

The question is not which of the two, Boothroyd or Tillinghast, ran the faster in giving to the world a material and practical exhibit of his conception. It is simply whether Tillinghast, the first to conceive the improvement, was reasonably diligent in putting into a practical and useful form the idea which he expressed to others in July, 1890. If he was, his patent is valid notwithstanding the later conception of Boothroyd was given to the world before Tillinghast had succeeded in putting into actual use one of his tires. — *Continental v. Single Tube*, 178 Fed. 452; 101 C. C. A. 436.

*Reed v. Cutter*, Fed. Cas. 11,645; *Marshall v. Mee*, Fed. Cas. 9129; *White v. Allen*, Fed. Cas. 17,535; *McCormick v. Minneapolis*, 42 Fed. 152; *Christie v. Seybold*, 55 Fed. 69; *Automatic v. Pneumatic*, 166 Fed. 288.

### § 862. Essential to Patentability.

In contemplation of law an invention does not exist until the inventor's ideas have been reduced to practical form. — *American v. Leeds*, 170 Fed. 327; 95 C. C. A. 511.

*Standard v. Peters*, 77 Fed. 630.

It seems to us that Drawing N shows little more than a tentative illustration of an untried experiment. Certainly if the invention were fully developed at that time and understood by the inventor, he showed no diligence in perfecting and reducing it to practice. We have been unable to discover any satisfactory proof to establish the complainant's contention that the invention was made in July, 1901. He may have had a mental conception thereof, but, so far as the testimony shows, there was no tangible reduction to practice, no practical illustration until the date of the drawings in April,



1903. The patentee may have had a well defined theory of what he could accomplish in 1901; he may have conversed eloquently and persuasively upon the subject, but it is requisite that something more tangible than a mental conception must be proved. — *Corrington v. Westinghouse*, 178 Fed. 711; 103 C. C. A. 479.

*Clark v. Willimantic*, 140 U. S. 481; *Machine Co. v. Pneumatic*, 166 Fed. 288.

## REISSUES.

### § 871. Broadening — Not Permissible — In General.

That where a disclaimer has been filed for the purpose of avoiding references and such disclaimer has been acted upon by the public, a reissue to eliminate such disclaimer and correspondingly broaden the patent is void, see — *Cassin v. Collins*, 174 Fed. 341; 98 C. C. A. 213.

That where a domestic and foreign patent are taken in identical form, a reissue of the domestic patent omitting limitations to avoid the prior art common to the original and the foreign patent is unduly broadened, see — *Potthoff v. Hanson*, 174 Fed. 983; 98 C. C. A. 595.

The application to recast the claims now under consideration was made, not for the purpose of narrowing the original patent because the patentee had claimed too much, but rather for the purpose of holding a wider monopoly than could have been built up under the invention described and disclosed in the original patent. Such an attempt must be held futile. — *Gen. Electric v. Richmond*, 178 Fed. 84; 102 C. C. A. 138.

*Miller v. Brass Co.* 104 U. S. 250; and see foot-note 178 Fed. 90.

The following is the law of the Seventh Circuit affecting change of claim in reissues:

1. The Commissioner of patents is without power to reissue a patent to *broaden* the claims when the specification (the description, not the claim) is sufficient.

By settled interpretation the word "specification" in the first sentence of § 4916, R. S., may cover the entire original patent. The inquiry, therefore, is what are the conditions under which a reissue may lawfully be granted in lieu of an original patent unaltered save by the addition of enlarging claims? One condition is that, on surrender of the original patent, a new patent "for the same invention" shall be issued. Other conditions, emphasizing the one just stated, are that "no new matter shall be introduced into the specification;" and, the original and reissue here being for a machine, and no model being filed, that "the drawings shall not be amended." \* \* \* But if enlargement is to come, not from evidence contained in the original patent (or in the proceedings to obtain it) but from what the inventor subsequently says (truthfully or untruthfully) was in his mind prior to filing the original application, a region of danger, of temptation to fraud and deception, would be opened wide, which Congress has commanded should be kept closed. For the reissue must be limited to the same invention that the inoperative patent discloses as the invention. — *McDowell v. Ideal*, 187 Fed. 814; 109 C. C. A. 574.

*Seymour v. Osborne*, 11 Wall. 516; *Gill v. Wells*, 22 Wall. 1; *Russell v. Dodge*, 93 U. S. 460; *Powder Co v. Powder Works*, 98 U. S. 126; *Parker v. Yale*, 123 U. S. 87; *Electric v. Boston*, 139 U. S. 481; *Freeman v. Asmus*, 145 U. S. 226; *Huber v. Nelson*, 148 U. S. 270.

Authority to grant reissues is now derived exclusively from the statute, R. S. § 4916. And the Commissioner goes beyond his jurisdiction if he grants

a reissue for an invention (though conceded to be the invention of the applicant) which is not the same invention that was disclosed and described as the applicant's invention (not merely that lurked in the drawings or description of the machine as a machine) in the original patent, which, by reason of inadvertence, accident, or mistake, is inoperative to secure the monopoly it shows on its face was intended to be secured. — *Moneyweight v. Toledo*, 187 Fed. 826; 109 C. C. A. 586.

*McDowell v. Ideal, supra.*

2. That when reissue is applied for promptly and there are no intervening rights, where the combination sought to be covered by the reissue has not been abandoned by previous rejection and amendment, where the specification and drawings disclose the combination, and where the failure to claim arose through inadvertence, accident, or mistake — in such case a reissue with a *specific claim* covering such unclaimed combination is valid.

The original patent and the file wrapper and contents were on their face sufficient proof that, if a claim adequate to cover the improved scale was ever drawn, it had been omitted, by accident in copying or otherwise, from presentation to the Patent Office. The original specification alone on its face was sufficient proof that, if a claim adequate to cover the improved scale was never drawn, the failure came from the lack of attentive comparison of the submitted claims with the invention particularly pointed out in the specification. This was inadvertence, "lack of heedfulness or attentiveness," irrespective of the real competence or incompetence of the solicitors. Was this inadvertence excusable? After the solicitors delivered the patent to their client, they could not be expected to give the matter any further attention. De Vilbiss (the patentee) was a layman and may be supposed to have been inexpert in construing patents. He may have rested on the assumption that his solicitors had procured a fully operative patent. How far such a reliance may go generally is not necessary to determine in this instance. Here the situation is the same as if De Vilbiss had applied for the reissue the very hour the patent issued, for no intervening rights of any sort accrued. Respecting the other reissue claims, it is sufficient to say that, while the original specification was notice of what the invention as an entirety was, the allowed claims were notice that the invention also covered combinations of less than all the parts; that none of the reissue claims corresponds with the subject-matter of any abandoned claim; and that no reissue claim is broader than the allowed claims. — *Moneyweight v. Toledo*, 187 Fed. 826; 109 C. C. A. 586.

*Note:* These two cases are in accord with previous tendencies in the Seventh Circuit, and may be regarded as extreme interpretations of the Supreme Court rules; but whether within these rules remains to be determined by the Supreme Court. The writer goes no farther than to say that it would seem that we have, with this line of decision, another situation of mixed and variable law, varying with no other logic than the arbitrary lines between circuit and circuit established by statute.

The inference seems plain that it was only when he found that chains with pintles composed of more than two parts would operate successfully that he sought by a reissue to compel them to pay tribute. The reissue statute was not intended to produce a result so inequitable. — *Morse Chain v. Link Belt*, 189 Fed. 584; 110 C. C. A. 564.

### § 873. Broadening — When Permissible.

A patentee by a reissue is not permitted to extend the invention which he described and intended to be protected in his original patent. In the original



patent in this case the features of the appellee's invention are clearly described. One of them is the use of the cardboard backings. The other is the arrangement of the record sheets and the carbon sheets. Both are covered by a single claim, but the patent did not cover the use of either when not combined with the other. Therein was the defect. — *Kitchen v. Levison*, 188 Fed. 658; 110 C. C. A. 424.

*Note:* From a reading of this case it would seem that here is direct conflict with the present rule of the Seventh Circuit. Certainly the claim is broadened in this case.

#### § 880. Decisions of Commissioner.

Findings by the Commissioner that a legal condition exists and is available are conclusive in so far as they depend upon credibility and weight of evidence; but, in so far as they depend upon the legal interpretation and effect of admittedly genuine documents or other undisputed evidence, they are reviewable in court. — *Gen. Electric v. Richmond*, 178 Fed. 84; 102 C. C. A. 138.

From the reissuance of the patent it is to be presumed that the law was complied with, and the proceedings can only be impeached for fraud. — *Kitchen v. Levison*, 188 Fed. 658; 110 C. C. A. 424.

*Seymour v. Osbourne*, 11 Wall. 516.

#### § 881. Different Invention.

Patent No. 607,304 was a mechanical invention, the process one of art, and complainant could not, under an application for a reissue, have included the process claim, as the machine and the process are separate inventions. — *Model Bottling Mach. v. Anheuser-Busch*, 190 Fed. 573; 111 C. C. A. 389.

*Powder v. Powder*, 98 U. S. 126; *Eachus v. Broomall*, 115 U. S. 429.

#### § 883. General Rules.

That the fact that the claims in the original patent were functional and did not cover patentable subject-matter is not ground within the statute for obtaining a reissue, see — *Penn v. Conroy*, 185 Fed. 511; 107 C. C. A. 611.

#### § 884. Grounds for.

Without the existence of one or the other of two conditions precedent, the Commissioner of Patents is not authorized to grant a reissue. Either the original specification must be defective or insufficient, or the original claims must embrace more than the patentee had a right to claim as new. Neither condition is available unless the error arose from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. — *Gen. Electric v. Richmond*, 178 Fed. 84; 102 C. C. A. 138.

*Note:* This statement is in accord with previous expressions of Judge Baker, but it is believed that it is too broad. A literal construction of the statement would bar, absolutely, every reissue containing a broader claim than the original, regardless of promptitude or absence of intervening rights.

#### § 885. Inadvertence, Accident, or Mistake.

The inadvertence of his solicitors was the applicant's inadvertence, and might therefore be availed of by him, if it existed. On the other hand, his solicitors' erroneous judgment in submitting to the rejections is his erroneous judgment, and he would be estopped from presenting any of the rejected

claims in an application for a reissue. — *Moneyweight v. Toledo*, 187 Fed. 826; 109 C. C. A. 586.

*Yale v. Berkshire*, 135 U. S. 342; *Corbin v. Eagle*, 150 U. S. 38.

### § 887. Surrender — Effect of.

The bill was based upon the reissue. And inasmuch as there existed none of the conditions precedent to the right of the Commissioner to grant a reissue, the grant is utterly void. — *Gen. Electric v. Richmond*, 178 Fed. 84; 102 C. C. A. 138.

*General v. Blackmore*, 156 Fed. 968.

## RES JUDICATA.

### § 893. Conclusiveness.

Our prior ruling was made upon an appeal from an interlocutory decree granting an injunction, but that did not render it less obligatory upon the Circuit Court, and does not except it from the settled rule that propositions once decided by an appellate court are not open to consideration in that court upon a subsequent appeal or writ of error. — *Brown v. Lanyon*, 179 Fed. 309; 102 C. C. A. 497.

*Smith v. Vulcan*, 165 U. S. 518; *In re Potts*, 166 U. S. 263; *United States v. California*, 148 U. S. 31; *In re Sanford*, 160 U. S. 247; *Illinois v. Illinois Central*, 184 U. S. 77; *Bissell v. Goshen*, 72 Fed. 545; *Burns v. Cooper*, 153 Fed. 148; *Crotty v. Chicago*, 169 Fed. 593; *Messinger v. Anderson*, 171 Fed. 785.

That where the complainant declared on certain claims which were held void, such decree is conclusive as to the entire patent in favor of the defendant and all in privity to the suit, see — *Marshall v. Bryant*, 185 Fed. 499; 107 C. C. A. 599.

## ROYALTIES.

### § 897. General Statement and the Decisions.

The contract provided "That the Goodyear Co. \* \* \* doth agree to pay to the said Dancel in each year while the letters patent remain in force as a valid patent the sum of \$5000 as an annuity, such annuity to be payable monthly." Dancel died before the expiration of the patent. *Held*: If it had been the intention of the parties that the payments should cease with the life of Dancel, that intention could have been easily expressed. We think such was not the intention of the parties. — *Goodyear v. Dancel*, 119 Fed. 692; 56 C. C. A. 300.

## SALE OF PATENTED ARTICLE.

### § 899. General Statement and Holdings.

By a sale of a patented article subject to no conditions the purchaser undeniably acquires the right to use the article for all the purposes of the patent so long as it endures. He may use it where, when and how he pleases, and may dispose of the same unlimited right to another. \* \* \* An absolute and unconditional sale operates to pass the patented thing outside the boundaries of the patent, because such a sale implies that the patentee consents that the purchaser may use the machine so long as its identity is preserved. \* \* \* The argument for the defendants ignores the distinction between the property right in the materials composing a patented machine, and the right to use for the purpose and in the manner pointed out by the patent. The latter may be and often is the greater element of value, and the buyer may desire it only to apply to some or all of the uses included in the invention. But the two things are separable rights. If sold unreservedly the right to



the entire use of the invention passes, because that is the implied intent; but this right to use is nothing more nor less than an unrestricted license presumed from an unconditional sale. A license is not an assignment of any interest in the patent. It is a mere permission granted by the patentee. It may be a license to make, sell and use, or it may be limited to any one of these separable rights. If it be a license to use, it operates only as a right to use without being liable as an infringer. If a licensee be sued, he can escape liability to the patentee for the use of his invention by showing that the use is within his license. But if his use be one prohibited by the license, the latter is of no avail as a defense. As a license passes no interest in the monopoly, it has been described as a mere-waiver of the right to sue by the patentee. We repeat. The property right to a patented machine may pass to a purchaser with no right to use, or with only the right to use in a specified way, or at a specified place, or for a specified purpose. The unlimited right of exclusive use which is possessed by and guaranteed to the patentee will be granted if the sale be unconditional. But if the right of use be confined by specific restriction, the use not permitted is necessarily reserved to the patentee. If that reserved control of use of the machine be violated, the patent is thereby invaded. This right to sever ownership and use is deducible from the nature of a patent monopoly and is recognized in the cases. — *Henry v. Dick*, 224 U. S. 1; 56 L. Ed. 645; 32 S. Ct. 364.

*Note:* This is the final authority on this question. Justice Lurton reviews all the leading cases, and in a foot-note gives a list of previous holdings. Reference thereto is sufficient.

However men may differ -- as do the dissenting minority by the opinion of Chief Justice White — upon the moral and economic aspect of this particular case, there is little doubt that the opinion of the majority is enforced by prior decisions, both American and English; and since motion for rehearing — in which the Attorney General joined — has been denied, the law is fixed.

If the manufacture of a machine upon an order for its construction, followed by its delivery and acceptance, constitutes a "sale" within the meaning of the patent statute, a sale is shown here. The transaction was completed by the delivery and acceptance of the machine. The title then passed. — *National v. American*, 178 Fed. 79; 101 C. C. A. 569.

*Campbell v. Mayor*, 36 Fed. 263; *Eastman v. New York*, 134 Fed. 844.

## SPECIFICATION.

### § 901. General Statement.

By settled interpretation the word "specification" in the first sentence of § 4916, R. S., may cover the entire original patent. — *McDowell v. Ideal*, 187 Fed. 814; 109 C. C. A. 574.

### § 905. Sufficiency — Accuracy.

An objection is that the specification is so vague and indefinite that no one could learn from it how to practise the alleged invention. The preferred proportions are stated, and if that is not a sufficient direction to those "skilled in the art or science to which the invention appertains, or with which it is most nearly connected," the deficiency will have to be established by evidence. — *Westrumite v. Commissioners*, 174 Fed. 144; 98 C. C. A. 178.

A patent is granted for solving a problem, not for stating one. Its description must explain the invention itself, the manner of making it, and the mode of putting it in practice. In the absence of knowledge upon these points, the invention is not available to the public without further experi-

ments and further exercise of inventive skill. — *Columbia v. Duerr*, 184 Fed. 893; 107 C. C. A. 215.

**§ 907. Sufficiency — Ambiguity.**

The teaching of the specification and the disclosure by the patentee must be such that, after the patent has expired, a user thereof shall not be left to the blind groping of experimental work, but by the plain teaching of the specification be enabled to use the process with certainty. — *Krupp v. Midvale*, 191 Fed. 588; 112 C. C. A. 194.

**§ 908. Sufficiency — Distinguishing New from Old.**

The specification does not indicate how much is new, or what is the improvement on the old art. The claims would indicate that the entire device was the product of Jacobs. It is fairly obnoxious to the criticisms expressed of a similar obscure and misleading patent in *Evans v. Eaton*, 7 Wheat. 356. — *Jacobs v. Almond*, 177 Fed. 935; 101 C. C. A. 215.

**§ 915. Sufficiency — Rules for Determining.**

To allow this negligible, unnoted, and indeed unlettered extreme section of the drawing to be made, as it must be, the foundation upon which this new claim rests, would be to base the monopoly on possible, instead of certain, disclosure. — *Hestonville v. McDuffee*, 185 Fed. 798; 109 C. C. A. 606.

**§ 916. Sufficiency — Scientific Knowledge.**

He must, indeed, make such disclosure and description of his invention that it may be put into practice. In this he must be clear. He must not put forth a puzzle for invention or experiment to solve, but the description is sufficient if those skilled in the art can understand it. This satisfies the law, which only requires as a condition of its protection that the world be given something new and that the world be taught how to use it. It is no concern of the world whether the principle upon which the new construction acts be obvious or obscure, so that it inheres in the new construction. — *Diamond Rubber v. Consolidated*, 220 U. S. 428; 55 L. Ed. 527; 31 S. Ct. 444.

**STATE STATUTES AND REGULATIONS AFFECTING PATENT RIGHTS.**

**§ 920. General Statement and Decisions.**

That the Arkansas statute (Kirby's Dig. §§ 513-6) which makes void a promissory note given in payment for a patented article, unless it shows upon its face that it was so given is void, is constitutional, see — *Ozan v. Union County*, 207 U. S. 251; 52 L. Ed. 195; 28 S. Ct. 89.

See — *Union County v. Ozan*, 179 Fed. 710.

That the statute of Arkansas (Kirby's Dig. §§ 513-6) which makes a note given in payment of a patented article void unless stated on its face to be so given, which statute was held constitutional in 207 U. S. 251, applies to notes given in usual course of business, notwithstanding the provisions of § 516, see — *Union County v. Ozan*, 179 Fed. 710; 103 C. C. A. 584.

*Note:* This is a most technical construction of the statute. Special attention is called to the dissenting opinion of Judge Hook, which I regard as a most masterful and sound statement.



## THREATS.

## § 924. General Statement.

That the owner of a patent may notify infringers of his claims, and warn them that, unless they desist, suits will be brought to protect him in his legal rights, is sustained by numerous decisions. The only limitation on the right to issue such warnings is the requirement of good faith. — *Virtue v. Creamery*, 179 Fed. 115; 102 C. C. A. 413.

*Kelley v. Ypsilanti*, 44 Fed. 19; *Computing v. National*, 79 Fed. 962; *Farquhar v. National*, 102 Fed. 714; *Warren v. Landauer*, 151 Fed. 130; *Mitchell v. International*, 169 Fed. 145; 30 Cyc. 1054.

## TITLE.

## § 927. Miscellaneous Rules.

That where, through oversight, complainant fails to prove his title, and the omission is not discovered until the case is before the appellate court, the case may be remanded for the taking of further proofs on condition of the payment of costs of both courts by the complainant, see — *St. Claire v. Union Jack*, 184 Fed. 989; 106 C. C. A. 667.

## WORDS AND PHRASES.

## § 936. "Means."

The word "means" appearing in claim 4 alleged to be infringed must be construed as referring to the condenser mentioned in the specifications. — *Kellogg v. Dean*, 182 Fed. 991; 105 C. C. A. 545.

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