

grant of the patent.<sup>2</sup> Nor is it necessary that the claims and specifications of the patent be set out at length, although it may be done, since the profert of the patent makes it part of the declaration when it is afterwards produced.<sup>3</sup> The patent should be indicated by its date and number, and if it be a re-issued patent its history should be traced by a recital of the grant of the original and intermediate re-issues as well as of the one on which the suit is brought.

§ 951. **The Declaration : Allegation of Legal Title of the Plaintiff.**

Under the third averment the exact legal title of the plaintiff must be set forth with certainty, as it appears or can be made to appear upon the records of the Patent Office.<sup>1</sup> If the plaintiff is the original inventor and patentee, this averment may consist of the simple affirmation that he is still the owner of the patent.<sup>2</sup> If he is an assignee of the inventor before patent, and by virtue of such assignment received the patent

<sup>2</sup> That the declaration need not aver that the preliminary steps to the issue of the patent were taken, see *Cutting v. Myers* (1818), 4 Wash. 220 ; 1 Robb, 159.

That the declaration must tender an issue on novelty and utility, not on the regularity of the proceedings in the Patent Office, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

That a declaration need not describe the invention otherwise than as the patent does, for the defendant can crave oyer, if he desires it, of the specification, see *Cutting v. Myers* (1818), 4 Wash. 220 ; 1 Robb, 159 ; *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

That the profert of the patent makes it part of the declaration when afterwards produced, see *Pitts v. Whitman* (1843), 2 Story, 609 ; 2 Robb, 189.

That oyer of a patent or other public record is not demandable, see *Smith v. Ely* (1849), 5 McLean, 76.

That a declaration averring the patent and specification to be in "lan-

guage of the import and effect following" and setting them out in their exact words is sufficient, and correctly describes their legal tenor and effect, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

That where profert is made of a recorded paper in the complaint it is part of the pleadings and demurrable, see *Bogart v. Hinds* (1885), 25 Fed. Rep. 484 ; 33 O. G. 1268.

§ 951. <sup>1</sup> That the declaration must show title in the plaintiff with sufficient certainty, and set out all matters which are of the essence of the action, see *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

That the declaration must aver that the plaintiff had obtained a patent, not merely that he claimed one, see *Stanley v. Whipple* (1839), 2 McLean, 35 ; 2 Robb, 1.

<sup>2</sup> That an averment that the patent was issued to the plaintiff is a sufficient allegation of his title, see *Cutting v. Myers* (1818), 4 Wash. 220 ; 1 Robb, 159.

in his own name from the government, or if he has become an assignee or grantee since the patent, or holds as personal representative of a deceased owner, his entire chain of title must be alleged with such particularity that the defendant can investigate it and judge of its validity.<sup>3</sup> Where his ownership is made dependent on the performance of conditions precedent, the conditions must be stated and their fulfillment be averred.<sup>4</sup> These allegations of title, in all cases but that of the patentee, ought properly to be accompanied by proof of the instruments on which it rests, or by a reference to the records of the Patent Office on which they appear, and an averment that they have been lawfully recorded.<sup>5</sup>

### § 952. The Declaration : Allegation of Infringement.

Under the fourth averment the plaintiff must allege that the defendant has infringed the patent by making, using, or selling the invention therein described, without authority from the owner of the patent. This violation must be stated as broadly as the right claimed in the patent, in order that it may clearly appear that the acts of the defendant related to the precise invention thereby protected.<sup>1</sup> No specific phraseology is necessary for this purpose, the assertion that the in-

<sup>3</sup> That an averment that the plaintiff became an assignee before the patent issued is a sufficient allegation of title, see *Rathbone v. Orr* (1850), 5 McLean, 131.

That a plaintiff assignee must fully set out the fact of the assignment, see *Dobson v. Campbell* (1833), 1 Sumner, 319 ; 1 Robb, 681.

<sup>4</sup> That when the plaintiff's title depends on the performance of certain acts, he must set them out, see *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

<sup>5</sup> That allegations of assignment should aver that the instruments have been duly recorded, see *Dobson v. Campbell* (1833), 1 Sumner, 319 ; 1 Robb, 681.

That an omission to aver material

facts in the declaration which must have been proved in order to obtain a verdict, and proof of which could have been made under the declaration, as, for example, the recording of an assignment, is cured by the verdict, see *Stanley v. Whipple* (1839), 2 McLean, 35 ; 2 Robb, 1 ; *Dobson v. Campbell* (1833), 1 Sumner, 319 ; 1 Robb, 681 ; *Gray v. James* (1817), Peters C. C. 476 ; 1 Robb, 140.

That if the declaration shows on its face that the plaintiff has not a legal title, but is merely a licensee, the defendant is entitled to judgment, see *Suydam v. Day* (1846), 2 Blatch. 20.

§ 952. <sup>1</sup> That a breach of the patent is to be assigned as broadly as the right is stated, see *Cutting v. Myers* (1818), 4 Wash. 220 ; 1 Robb, 159.



vention practised by the defendant was an "imitation of the patent," or any equivalent language, having been held sufficient.<sup>2</sup> Repeated acts of infringement may be alleged in the same manner.<sup>3</sup> In connection with this averment the acquiescence of all other persons in the plaintiff's exclusive right is sometimes declared, as well as the great worth and importance of the invention to the plaintiff, but these are not essential, since the infringement by the defendant is no less an actionable wrong though many others have been guilty of the same unlawful acts, and though the invention never has been recognized as possessing a commercial value.<sup>4</sup>

### § 953. The Declaration : Allegation of Damages.

The fifth averment is a formal though a necessary part of the declaration. It need not contain any special delineation of the methods in which the infringement has injuriously affected the plaintiff.<sup>1</sup> The law implies a damage to the owner

<sup>2</sup> That an averment that the defendant has made the device "in imitation of the patent" is sufficient, see *Parker v. Haworth* (1848), 4 McLean, 370 ; 2 Robb, 725.

That an averment that the defendant has "constructed, used, and vended" to others is sufficient, see *Case v. Redfield* (1849), 4 McLean, 526 ; 2 Robb, 741.

That the particular means by which the infringement was committed need not be averred, see *Turrell v. Cammerrer* (1868), 3 Fisher, 462 ; *Case v. Redfield* (1849), 4 McLean, 526 ; 2 Robb, 741.

<sup>3</sup> That numerous acts of infringement may be averred in the same declaration without duplicity, see *Wilder v. McCormick* (1846), 2 Blatch. 31 ; *Case v. Redfield* (1849), 4 McLean, 526 ; 2 Robb, 741.

That it is not necessary that each act of infringement be the subject of a distinct action at law, or the inventor might be ruined, see *Motte v. Bennett* (1849), 2 Fisher, 642.

That an allegation that one Claim in

the patent is infringed discloses a cause of action, see *Cook v. Ernest* (1872), 2 O. G. 89 ; 5 Fisher, 396 ; 1 Woods, 195 ; *Lee v. Blandy* (1860), 2 Fisher, 89 ; 1 Bond, 361 ; *Singer v. Walmsley* (1860), 1 Fisher, 558 ; *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43 ; *Emerson v. Hogg* (1845), 2 Blatch. 1 ; *Moody v. Fiske* (1820), 2 Mason, 112 ; 1 Robb, 312.

That when a patent claims two inventions a suit may be brought on it for the infringement of either, and the patent will be treated as if it contained only that Claim, see *McComb v. Brodie* (1872), 5 Fisher, 384 ; 2 O. G. 117 ; 1 Woods, 153.

<sup>4</sup> This averment is especially important where an injunction is, or is to be, moved for in connection with the suit, see §§ 1185-1188, and notes, *post*.

§ 953. <sup>1</sup> That a declaration beginning in case and demanding actual damages in gross as a debt due is good, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

of a patent from its wrongful invasion, and though evidence of actual loss is essential to the recovery of substantial damages the general averment is sufficient for the declaration.<sup>2</sup> A claim for treble damages is sometimes inserted, but as the power to award this increase over the amount found by the jury resides in the discretion of the court, it constitutes the proper subject of a motion rather than of the pleadings upon which the issues for the jury are to be framed.<sup>3</sup>

§ 954. **The Declaration : Formal Requisites.**

The language and logical coherence of a declaration are not severely scrutinized by the court, nor are objections to its modes of statement favored, if it accomplishes the object for which it was intended. It must put the defendant in possession of the facts on which the plaintiff's claim is based, and must leave open to the defendant every legal defence which he has a right to make. If it does this, its faults in other respects will not be critically regarded.<sup>1</sup> An omission to aver material facts which could have been proved under the pleadings as a whole, and which the jury must have found in order to have arrived at their decision, will be cured by verdict.<sup>2</sup>

<sup>2</sup> That nominal damages are implied from the violation of the patent, see *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62. See also §§ 1052, 1071, and notes, *post*.

That actual damages must be proved, see *Mayor of New York v. Ransom* (1859), 23 How. 487; *Seymour v. McCormick* (1853), 16 How. 480.

That in fixing the amount of damages the jury cannot exceed the sum named in the declaration, see *Winans v. N. Y. & Harlem R. R. Co.* (1855), 4 Fisher, 1.

<sup>3</sup> That the trebling of damages is a matter for the discretion of the court, see *Seymour v. McCormick* (1853), 16 How. 480; *Stimpson v. Railroads* (1847), 1 Wall. Jr. 164; 2 Robb, 595; *Guyon v. Serrell* (1847), 1 Blatch. 244.

§ 954. <sup>1</sup> That where a declaration contains all needed allegations to support the evidence of the plaintiff's right and its violation, and leaves every legal defence open to the defendants, it will not be critically regarded, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

<sup>2</sup> That a verdict cures the defects which must have been supplied in order to enable the jury to reach their decision, see *Stanley v. Whipple* (1839), 2 McLean, 35; 2 Robb, 1; *Dobson v. Campbell* (1833), 1 Sumner, 319; 1 Robb, 681; *Gray v. James* (1817), Peters C. C. 476; 1 Robb. 140.

That the declaration need not conclude *contra formam statuti*, see *Parker v. Haworth* (1848), 4 McLean, 370; 2 Robb, 725; *Tryon v. White* (1815), Peters C. C. 96; 1 Robb, 64.



§ 955. **The Declaration: Joinder of Several Patents where Violated by One Act of Infringement.**

A single and indivisible act of infringement may often violate more than one patent belonging to the plaintiff, and render it essential to the vindication of his rights that all such patents should be joined as the foundation of a single action.<sup>1</sup> Such a case arises where an original invention and its improvements are covered by several patents owned by the same person, and are unlawfully appropriated by the same infringer. Here it would be impossible, on separate suits based on each patent, to distinguish the loss resulting to the plaintiff by the wrongful use of the original from that produced by the employment of the improvement. Other cases present the same difficulty, and in these the only recourse of the plaintiff is to join all such patents in one action and in one claim for damages. This he is permitted to do, and in his declaration he must then set out concerning each patent the matters properly embraced in the first three of the described averments, — the inventive act of the patentee or his assignor, the issue of the patent, and the title of the plaintiff. The averments of infringement and damages may be general, and refer to all the patents collectively.<sup>2</sup>

§ 956. **Pleadings in Actions at Law: Pleas in Abatement.**

The pleadings of the defendant in an action for infringement are either in abatement, by demurrer, or in bar. A plea in abatement should be filed whenever the defendant desires to object to the mode in which the proceedings have been instituted, whether the fault resides in the process or its service, in the incapacity, misdescription, misjoinder or non-joinder of

§ 955. <sup>1</sup> That more than one patent may be included in the same suit, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

That separate suits between the same parties on separate patents, all infringed by the same machine, may be consolidated on motion, see *Deering v. Winona Harvester Works* (1885), 32 O. G. 654; 24 Fed. Rep. 90.

See as to the rule of joinder in equity cases, § 1108, and notes, *post*.

<sup>2</sup> That where the plaintiff is the owner of the patent for the original invention, and also of a patent for an improvement thereon, he cannot claim separate damages in separate suits for the infringement of each, if both are infringed, see *Case v. Redfield* (1849), 4 McLean, 526; 2 Robb, 741.

the parties, or the pendency of another action between the same parties seeking the same remedy for the same wrong. Most of these objections can be urged only under this dilatory plea, and are waived unless taken advantage of in this formal manner.<sup>1</sup> A suit is not abated on account of other suits against the same defendant for a different act of infringement, nor on account of other suits against different defendants for the same infringement.<sup>2</sup> The bankruptcy of the plaintiff during the litigation is no ground of abatement.<sup>3</sup> The issues

§ 956. <sup>1</sup> That a plea to the jurisdiction is proper both in law and equity though it be partly or wholly negative, see *Edison Electric Light Co. v. U. S. Electric Lighting Co.* (1888), 43 O. G. 1456.

That an objection to the right of an executor to sue must be taken by plea in abatement, see *Rubber Co. v. Goodyear* (1869), 9 Wall. 788.

That a non-joinder of executors, where necessary to join them, can be taken advantage of only by plea in abatement unless it appears on the record, see *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

That a denial of the plaintiff's corporate capacity must be made by a plea in abatement, see *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555; 3 Fisher, 87.

That if the plaintiffs are a corporation, the fact of their organization cannot be attacked in a plea in bar, but only by plea in abatement, see *Dental Vulcanite Co. v. Wetherbee* (1866), 3 Fisher, 87; 2 Clifford, 555.

That a plea that joint-infringers are not joined must allege that they all live within the district, see *Goodyear v. Toby* (1868), 6 Blatch. 130.

That if the defendant is sued out of his district he must plead his personal privilege, see *Teese v. Phelps* (1855), 1 McAllister, 17.

That defects in process or service, if

apparent on the face of the record, may be taken advantage of by motion to quash the service or abate the writ, and if not thus apparent, by plea in abatement, see *United States v. American Bell Telephone Co.* (1886), 29 Fed. Rep. 17; 38 O. G. 1237.

<sup>2</sup> That different suits for different infringements are proper though one is already pending, see *Rumford Chemical Works v. Hecker* (1874), 5 O. G. 644; 11 Blatch. 552; 1 Bann. & A. 120.

That a suit cannot be prosecuted for the infringement of an original patent pending an application for its re-issue, see *Burrell v. Hackley* (1888), 44 O. G. 1400; 35 Fed. Rep. 833.

That pending an accounting the plaintiff cannot sue at law for infringements committed since the decree, without leave of the court, see *Morse v. Knapp* (1888), 35 Fed. Rep. 218.

<sup>3</sup> That bankruptcy of the plaintiff is not a ground of abatement in equity, see *Gear v. Fitch* (1878), 16 O. G. 1231; 3 Bann. & A. 573.

That a plaintiff becoming bankrupt, and then purchasing the right of action from his assignee, cannot be met with a plea in abatement, see *Gear v. Fitch* (1878), 16 O. G. 1231; 3 Bann. & A. 573.

That no rule to plead will be granted until the defendant has properly appeared, see *Parker v. Bigler* (1857), 1 Fisher, 285.



formed upon a plea in abatement, as well as the judgment and the subsequent proceedings thereon, are similar to those in other civil actions.

**§ 957. Demurrers in Actions at Law.**

The defendant may demur to the declaration, either specially on account of its formal defects, or generally on the ground that it sets forth no cause of action. Defects of form are now so little regarded by the courts, and are so easily remedied by amendment, that a special demurrer in this as in other actions is of rare occurrence. A general demurrer will not be sustained, however imperfect in statement or arrangement the declaration may appear, if it substantially includes the five essential averments, and does not mislead the defendant or preclude him from making under the subsequent pleadings those defences which are open to him by the law.<sup>1</sup> The issue and judgment on demurrer, in this class of cases, do not differ from those in ordinary suits at law.

**§ 958. Pleas in Bar in Actions at Law: The Defences Possible in Actions at Law.**

A plea in bar in actions for infringement assumes the form either of the general issue alone, or of the general issue with notice of special matters, or of a special plea. Before considering these it is important to examine and classify the various defences which may be made to such an action on its merits, in order that the propriety and scope of each of the three forms of plea may be perceived.<sup>1</sup> The general character

§ 957. <sup>1</sup> That courts will sustain pleadings which are substantially sufficient even against a special demurrer, see *Wilder v. McCormick* (1846), 2 Blatch. 31.

§ 958. <sup>1</sup> The classification here attempted is not offered as complete and covering every defence which can at any time be made. New grounds of objection to recovery by a patentee from time to time appear in practice, and are sustained by the courts. An interesting instance occurs in the present condition

of that defence which rests upon a simple use of the invention by the public for over two years before the application. Until recently no such defence was recognized except as a part of the wider defence of abandonment, the public use having no significance unless acquiesced in by the inventor. Where acquiescence is not required in order to give this use the force of a complete defence, it no longer can be based on the idea of an abandonment or directly on that of an estoppel, but assumes the law to be

of these defences is indicated by the several averments contained in the declaration, each of which must be found true in order to support a judgment for the plaintiff. The first averment is true only when seven different facts concur: (1) When the alleged invention is the result of an inventive act; (2) When this inventive act has been performed by the patentee or his assignor; (3) When its performance by the patentee or his assignor preceded its performance by any other person in this country; (4) When the alleged invention is embraced within one of the six classes of inventions made patentable by the acts of Congress; (5) When it is legally new; (6) When it is practically useful; (7) When it has not been abandoned to the public. The second averment is true only when nine different facts exist; (1) When the patent described in the declaration has been actually issued by the government; (2) When it was issued in the mode provided by the law; (3) When the invention which it purports to protect is, on its face, a patentable subject-matter; (4) When the specification is free from fraudulent assertion or concealment; (5) When the description is without ambiguity; (6) When the Claims do not embrace more than the actual invention, or if originally embracing more have been or may now properly be cured by a disclaimer; (7) When the Claims are free from ambiguity; (8) When the patent has not been surrendered; (9) When the patent has not been repealed. The third averment is true only when the plaintiff was the legal owner of the patent at the date of the infringement, or at the date of the commencement of the suit was the legal owner of the patent and the assignee of the right of action for the infringement. The fourth averment is

that an invention is not patentable after having been before the public for the period named. This is essentially a new defence, and would if fully established in our practice constitute an eighth species of defences to the first averment of the declaration. In like manner other defences, once employed, are no more in use (such as the non-introduction into market of the invention of an alien,

etc.), and though found formerly in the courts, are here unnoticed.

That defences are not limited to those named in the statute, but embrace all violations of law in granting the patent, such violations raising questions of law on which the decision of the Commissioner is not final, see *Gardner v. Herz* (1886), 118 U. S. 180; 35 O. G. 998.



true only when four facts concur: (1) When the identical invention protected by the patent has been made, or used, or sold; (2) When the act of making, use, or sale has been performed by the defendant, either alone or in complicity with others; (3) When this act was performed while the patent was in force; (4) When this act was performed without authority from the owner of the patent. The fifth averment tenders no issue, its truth being implied by law to an extent sufficient to secure a verdict for some damages in favor of the plaintiff, if the other four averments are established. As each of these averments must be proved in order to entitle the plaintiff to a judgment, and as each of its subordinate facts must exist in order to the truth of each averment, it is apparent that the successful denial of any one of these subordinate propositions constitutes a complete defence to the action and requires the verdict to be given for the defendant. In addition to these defences there are four others of a special nature, not suggested by the declaration, but common to all actions at law; (1) The Statute of Limitations; (2) Estoppel; (3) Release; and (4) *Res Adjudicata*. In reference to most of these defences the courts have given further explanations, and in some of them the statutes recognize minuter subdivisions, which next require attention.

**§ 959. First Defence: Denial that the Patented Art or Instrument is the Result of an Inventive Act.**

The first defence in the order of the foregoing enumeration consists in a denial that the alleged invention is the result of an inventive act. An inventive act may be performed in either one of three different ways; (1) By the discovery of a new force, or of a new capability in a known force, and the practical application of this new force or capability to some object through some mode of application, such object and such mode of application being new or old; (2) By the discovery of a new object or of a new susceptibility in a known object, and by rendering this object or susceptibility practically useful by subjecting it to the operation of some force through some mode of application, such force and mode of application being new or old; (3) By the discovery and practical embodi-

ment of a new mode of application by which forces may be brought into connection with their objects, such forces and objects being new or old. When either of these three mental and physical operations produces a means, as distinguished from a mere function or effect, it constitutes a true inventive act. Contrariwise, if the alleged invention is only an effect or a function, or if, being a means, it has resulted from an act wanting either the element of discovery or that of practical application, no complete inventive act has been performed.<sup>1</sup> This defence, therefore, is properly subdivided into four: (1) That the alleged invention is a mere effect; (2) That it is a mere function; (3) That it involved no exercise of the inventor's powers of original discovery, but could have been produced by the employment of his imitative faculties; (4) That it has never been made practically available. This is a defence based solely on the scientific and inherent character of the invention as apprehended by a mind familiar with the state of the art at the time when the inventive act is claimed to have been performed. Of it the courts will take judicial notice, whether urged or not by the defendant, whenever from their knowledge of the art it is apparent to them that it might successfully be made.<sup>2</sup>

§ 959. <sup>1</sup> For a description of the inventive act and its patentable results, see §§ 78-156 and notes, *ante*.

That non-reduction to actual practice before application for a patent is no defence, see *Starr v. Farmer* (1883), 23 O. G. 2325; *Opinion Sec. Interior* (1883), 23 O. G. 2327; *Wheeler v. Clipper Mower & Reaper Co.* (1872), 2 O. G. 442; 6 *Fisher*, 1; 10 *Blatch*, 181.

<sup>2</sup> That where the court can see that a patent is void it may so declare it on a demurrer, see *Eclipse Mfg. Co. v. Adkins* (1888), 36 *Fed. Rep.* 554; *West v. Rae* (1887), 33 *Fed. Rep.* 45.

That a demurrer on the ground that the invention is not patentable should not be sustained unless the matter is so

evident that no question of fact can be made on it, see *Blessing v. Copper Works* (1888), 34 *Fed. Rep.* 753.

That a demurrer does not admit the patentability of the invention, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 *Fed. Rep.* 444; 39 O. G. 589.

That the courts will not entertain an action where it is apparent that no inventive act has been performed, though the defendant may not defend on that ground, see *Ligowski Clay Pigeon Co. v. American Clay Bird Co.* (1888), 34 *Fed. Rep.* 328; *Slawson v. Grand St., Prospect Park, & Flatbush R. R. Co.* (1883), 107 U. S. 649; 24 O. G. 99.



§ 960. **Second Defence : Denial that the Patented Art or Instrument Resulted from the Inventive Act of its Alleged Inventor.**

The second defence consists in a denial that the inventive act from which the alleged invention has resulted was ever performed by the patentee or his assignor. This defence raises no question as to the existence of an inventive act, but simply excludes the alleged inventor from among those by whose inventive skill the invention was produced. It is equivalent to an averment that the patentee has surreptitiously appropriated to himself and patented the invention of another, and is proper only when the invention, having been completely conceived by its real inventor, has become known to and been imitated by the patentee.<sup>1</sup> It does not necessarily involve an

§ 960. <sup>1</sup> This defence is liable to be confounded with the third, from the fact that the adverb "surreptitiously," which in the acts of 1790 and 1793 was employed in reference to the present subject, was in the act of 1836 and subsequent statutes applied to patents obtained by later inventors contrary to the rights of prior ones. This transfer of the adverb in the statutes has been followed naturally by its transfer in the decisions of the courts, and caution is thus necessary in its interpretation, lest the true nature of both defences be obscured.

The word "surreptitiously" first appears in the act of 1790, where it is used as an equivalent for "false suggestion," and is made a ground for repealing a patent thus obtained. In the act of 1793 it is employed in describing a defence of which the defendant must give previous notice to the plaintiff, the defence being that the patentee "had surreptitiously obtained a patent for the discovery of another person." Here again it conveys the idea of fraud either against the public whose rights are restricted by a patent granted to one who has no title to a monopoly, being a mere imitator of the invention of an-

other, or against the true inventor by forestalling him in the obtaining of a patent. (See *Dixon v. Moyer*, (1821), 4 Wash. 68; 1 Robb, 324.) The act of 1836 transfers the word to an entirely different defence by requiring notice, not when the patentee is denied to be an inventor, but when the defendant purposes to show "that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another who was using reasonable diligence in adapting and perfecting the same." This is obviously the third defence and not the second, for a patent is invalid when procured by the mere copyist of another's discovery, whether that other was using due diligence or not. But the word "surreptitiously" has here lost its former significance and become the equivalent of "unjustly," *i. e.*, against the rights of the prior inventor, since no fraud or deceit is necessary to render void a patent obtained by a later true inventor when the first inventor is complying with the obligation of diligence imposed upon him by the law. See *Phelps v. Brown* (1859), 4 Blatch. 362; 1 Fisher, 479; 18 How. Pr. 7; also § 995 and notes, *post*.

allegation of wilful deceit on the part of the patentee ; he may honestly but ignorantly believe that some substantial difference exists between his art or article and that which he has actually copied, and may suppose that his originated in his own inventive skill. The fact that instead of inventing a new means he has merely appropriated and obtained a patent for a means created by another, and is, therefore, not a true inventor, is sufficient to establish this defence.<sup>2</sup>

**§ 961. Third Defence : Denial that the Alleged Inventor was the First Inventor of the Patented Art or Instrument.**

The third defence consists in a denial that the patentee or his assignor performed the inventive act producing the alleged invention at an earlier date than any other inventors in this country. This defence concedes that the patentee or his assignor is a true inventor of the art or article in question, but denies that he was its *first* inventor.<sup>1</sup> It is equivalent to either one of two averments: (1) That rival inventors had completely conceived the idea of means embodied in the invention, and were using due diligence in reducing it to practice at the time when the patentee or his assignor conceived the same idea; or, (2) That although the patentee or his assignor had first conceived the idea he did not use due diligence in reducing it to practice, and that in the meantime some later conceiver but more prompt reducer had perfected the invention. This defence raises the same issue which is presented in interference cases in the Patent Office and in proceedings in equity to annul a rival patent, and is sustained when the evidence establishes either one of its equivalent averments.<sup>2</sup>

**§ 962. Fourth Defence : Denial that the Patented Art or Instrument is within the Patentable Classes of Inventions.**

The fourth defence consists in a denial that the invention falls within the classes protected by the acts of Congress as

<sup>2</sup> For the distinction between an imitation and a new invention, see § 78 and notes, *ante*.

§ 961. <sup>1</sup> For the relations of rival inventors to each other and the public, see §§ 370-391, and notes, *ante*.

<sup>2</sup> For a description of the issues raised in interference proceedings and actions to annul, see §§ 586-603, 724, and notes, *ante*.



those acts are interpreted by the courts. This defence is proper where the result of the inventive act performed by the patentee or his assignor is not an art, a machine, a manufacture, a composition of matter, a design, or an improvement.<sup>1</sup> It is also appropriate when the invention, though it purports to be a combination, is in reality a mere aggregation of independent elements.<sup>2</sup> This defence, like the first, is based upon the inherent character of the invention. When the nature of the invention is apparent, the application to it of the legal definitions given to the protected classes of inventions determines whether this defence is applicable. The court whose duty it is to ascertain from the description and Claims embodied in the patent what the invention is, and to apply thereto the tests afforded by these definitions, may, therefore, take judicial notice of this defence also without reference to the pleadings; and if it finds that the result of an inventive act, though new and useful, is not legally patentable under the acts of Congress, may refuse to entertain proceedings against those who have without authority employed it.<sup>3</sup>

**§ 963. Fifth Defence : Denial of the Novelty of the Patented Art or Instrument.**

The fifth defence consists in a denial that the invention resulting from the inventive act of the patentee or his assignor is new within the meaning of the law. The defence of want of legal novelty in the invention is sometimes related to the third defence of prior invention, but must not be confounded with it. If a prior rival inventor has perfected his invention, and either put it to practical use in this country, or patented

§ 962. <sup>1</sup> For the nature of each class of patentable inventions, see Art, §§ 159, 164-170, and notes, *ante*; Machine, §§ 173-179, and notes, *ante*; Manufacture, §§ 182-189, and notes, *ante*; Composition, §§ 192-197, and notes, *ante*; Design, §§ 200-207, and notes, *ante*; Improvement, §§ 210-218, 307-313, and notes, *ante*.

<sup>2</sup> For the nature of a combination, see §§ 153-156, 277-282, and notes, *ante*.

<sup>3</sup> That the court may take judicial notice of the nature of the patented invention and of the fact that it is not legally patentable, and may thereupon refuse to entertain the action, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444; 39 O. G. 589; *Slawson v. Grand St., Prospect Park & Flatbush R. R. Co.* (1883), 107 U. S. 649; 24 O. G. 99; and cases cited in § 959 note 2, *ante*.

it, or published a printed description of it, before its invention by the patentee or his assignor, the defence of want of legal novelty as well as that of prior invention is appropriate. But if the prior inventor has not practised his invention, or patented or published it before the patentee or his assignor performed the inventive act, or if the patentee or his assignor first conceived the idea but through his want of diligence in reduction has given a later conceiver and prompt reducer the superior right to the invention, the defence of want of legal novelty cannot be sustained. A patented invention is new, within the meaning of the law, unless before the date of its complete conception by the patentee or his assignor it had been known or used in this country, or had been patented or described in a printed publication either at home or abroad.<sup>1</sup> A prior use, in order to create a want of novelty, must consist in the practical employment of the identical invention for business purposes in the United States, in such a manner as to render the knowledge of the invention accessible to the public before and until the date of its conception by the patentee or his assignor.<sup>2</sup> A prior patent constitutes a want of novelty when it was issued to the public before the date of the inventive act in question, and contains so full and complete a description and claim of the identical invention as to enable any person skilled in the arts to practise it without further invention of his own.<sup>3</sup> A prior publication proves a want of novelty when in its printed text, distributed to the public before the patentee or his assignor conceived the idea of the invention, the essential characteristics of the art or article are so disclosed that those skilled in the art can by the guidance of the publication alone construct it and apply it to practical use.<sup>4</sup> It is to be remembered that these three conditions under which novelty is wanting are not merely evidence that the invention is not legally new, but are facts which cause it to be legally old. Novelty is a legal attribute consisting in

§ 963. <sup>1</sup> For the nature of legal novelty as distinguished from actual novelty, see §§ 113, 123, 222-228, 315, 316, and notes, *ante*.

<sup>2</sup> As to prior use, see §§ 317-324, and notes, *ante*.

<sup>3</sup> As to prior patent, see §§ 331-337, and notes, *ante*.

<sup>4</sup> As to prior publication, see §§ 325-330, and notes, *ante*.



the absence of these three conditions, and when the existence of either is established by sufficient proof it is a conclusion of law, and not an inference of fact, that the invention is not new. Thus the defence of want of novelty may logically be subdivided into the three defences of prior use, prior patent, and prior publication, each of which may be urged without the others, and if found true forms a complete bar to the action.

§ 964. **Sixth Defence: Denial of the Utility of the Patented Art or Instrument.**

The sixth defence consists in a denial of the utility of the invention. An invention is useful within the meaning of the law if it is available for any use which on the whole is beneficial to the public. An utterly frivolous and worthless art or article has no utility. An invention capable of beneficial use, but so dangerous or disastrous to its employers as to be necessarily productive of more injury than advantage, is not useful. An invention whose practice may promote the interest of the individual user, but is inevitably prejudicial to the public, also wants utility.<sup>1</sup> This defence is thus equivalent to an averment that the invention is incapable of any beneficial use, or that its use involves a greater loss than gain to its employers, or that its use is detrimental to the public.<sup>2</sup> Defendants who have actually practised the invention, especially those who have endeavored to induce the public to participate in its results by purchasing the fruits of their infringements, are estopped from urging it on their own behalf when sued for their wrong-doing.<sup>3</sup>

§ 964. <sup>1</sup> For the nature and necessity of utility, see §§ 338-343, and notes, *ante*.

<sup>2</sup> That the want of utility is a perfect defence, see *Bliss v. City of Brooklyn* (1873), 6 Fisher, 289; 3 O. G. 269; 10 Blatch. 521.

That the manifest frivolity of the invention patented is a good defence, see *Wilson v. Jones* (1854), 3 Blatch. 227.

That an immoral or dangerous in-

vention may lack utility, see § 340, and notes, *ante*.

<sup>3</sup> That to sustain a defence of want of utility the evidence must show that the invention is utterly worthless, and if the defendant has used it, that fact is a strong argument in favor of utility, see *Kearney v. Lehigh Valley R. Co.* (1887), 32 Fed. Rep. 320.

That want of utility avails little as a defence for parties who used the in-

§ 965. **Seventh Defence: Abandonment of the Invention to the Public.**

The seventh defence consists in an averment that the invention was abandoned to the public before the commission of the acts of which the defendant is accused. In this defence there is no question of incomplete and abandoned experiments performed by the patentee or his assignor while endeavoring to perfect the invention, or by rival inventors in their attempts to reach the same result. Evidence of such experiments may be admissible under the defences of prior invention and of prior use, but of themselves they constitute no bar to an action on the patent, and especially have no relation to this defence of abandonment. Abandonment is synonymous with dedication to the public. It assumes that the invention is complete and practically operative, and it occurs only where the invention, being in that condition, is intentionally and unreservedly surrendered to the public by its lawful owner.<sup>1</sup> This defence is, therefore, proper when such an intentional surrender has been made, either by the inventor or the patentee or any subsequent owner of the patent. A public use or sale of the invention, by the inventor or with his consent, for more than two years before his application for a patent, is one form of surrender.<sup>2</sup> Any other conduct of his or of the owner of the patent, which unequivocally manifests the same intention, is also an abandonment of the invention. Such conduct may consist either in acts or declarations of the inventor before his application, or in describing and not claiming the invention in his application, or in disclaiming it in connection

vention, see *Phillips v. Carroll* (1385), 23 Fed. Rep. 249; 31 O. G. 265; *Cook v. Ernest* (1872), 2 O. G. 89; 5 Fisher, 396; *Vance v. Campbell* (1859), 1 Fisher, 483.

That a defendant using an entire process is estopped to claim that any part of it is injurious, see *Whitney v. Mowry* (1870), 4 Fisher, 207.

That the defendant is estopped from denying the utility of the invention after having made and sold large quan-

ties of it, and especially after advertising that the new invention had revolutionized the trade, see *Robertson v. Garrett* (1873), 6 Fisher, 278; 10 Blatch. 490.

§ 965. <sup>1</sup> As to the nature of abandonment, and its distinction from abandoned experiments and abandoned inventions, see § 346 and notes, *ante*.

<sup>2</sup> As to abandonment by public use or sale, see §§ 354–360, and notes, *ante*.



with his application or his patent, or in words, actions, or omissions of the owner of the patent after the patent has been granted.<sup>3</sup> This defence has sometimes been subdivided into two: (1) Abandonment by public use or sale; (2) Abandonment by conduct other than public use or sale. Between these two there is an important distinction which is well recognized in the forms of pleading and in the rules of evidence. A public use or sale is not simply an act from which an intention to abandon may be inferred, but it is conclusive evidence of that intention; and when such use or sale is proved there is no room for any further question as to the dedication of the invention to the public. Conduct other than public use or sale is merely a fact from which an intention to abandon may be inferred, but affords no conclusive presumption of such intention and may be rebutted by any evidence affording a contrary indication.<sup>4</sup> This distinction in practical effect has led certain jurists of great authority to separate these two defences from each other, and to treat them as if resting upon different foundations.<sup>5</sup> The doctrine which underlies them is nevertheless identical, as is apparent from the definitions given by the courts to the terms "public use and sale," each of which is limited to cases where the use or sale involves a voluntary and intentional surrender by the inventor of all control over the invention, neither an experimental use, however public, nor any sale restricted by conditions which the inventor can enforce against the property in the invention sold, falling within such definitions.<sup>6</sup> This seventh defence

<sup>3</sup> As to abandonment by general conduct, see §§ 350-353, and notes, *ante*.

<sup>4</sup> That except in cases of public use or sale, the presumption of an intention to abandon may be rebutted, see §§ 347, 348, and notes, *ante*.

<sup>5</sup> In *Jones v. Sewall* (1873), 3 O. G. 630, Clifford, J.: (637) "Persons charged with the infringement of letters-patent may set up as a defence that the inventor suffered the invention to be in public use and on sale more than two years before he applied for a patent; and they may also set up as a distinct de-

fence, even in the same answer, that the inventor, before he applied for a patent, abandoned the invention to the public; but these two defences ought not to be blended in the same allegation, as they depend in many respects upon very different principles." 6 Fisher, 343 (365); 3 Clifford, 563 (589).

<sup>6</sup> That public use and sale are not abandonment except when unequivocal, unrestricted, and with the consent of the inventor, see §§ 354-360, and notes, *ante*.

completes the group of those which attack the merits of the invention and deny the right of the inventor or the owner of the patent to be protected in its exclusive use.<sup>7</sup>

**§ 966. Eighth Defence: Denial of the Grant of the Alleged Letters-Patent.**

The eighth defence, or the first one of that group which attacks the letters-patent as distinguished from the invention, consists in a denial that the patent described in the declaration was ever granted by the government. This defence is proper when the alleged invention never has been patented or when the patent which protects it is not correctly set forth by the declaration.<sup>1</sup> It simply raises an issue as to the existence of the document on which the plaintiff has based his suit, and is equivalent to the plea of *nul tiel record* at the common law. Any material variance between the actual patent and the statement of its tenor and effect in the declaration will support this defence, and unless cured by amendment will defeat the action.

<sup>7</sup> That the use of an invention without the consent of the inventor, pending his application, is no defence against the patent, see *Dental Vulcanite Co. v. Wetherbee* (1866), 3 Fisher, 87; 2 Clifford, 555.

That the defence of public use and sale more than two years "before the invention" is not known to our law, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

That under the defence of two years' public use, the defence of prior use cannot be made, nor is it sustained by evidence of a prior patent without the plaintiff's knowledge over two years before, see *Myers v. Busby* (1887), 32 Fed. Rep. 670; *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089.

That in an action brought after the act of 1837, ("two years") on a patent granted before it, public use prior to the application is a good defence, see

*Winans v. New York & Harlem R. R. Co.* (1855), 4 Fisher, 1.

That an application substituted at the instance of the Patent Office for one already filed dates from the filing of the former application as to the question of public use, see *International Tooth Crown Co. v. Richmond* (1887), 30 Fed. Rep. 775; 39 O. G. 1550.

N. B. In this seventh defence no notice is taken of the public use and sale "without the consent" of the inventor, which seems to be now recognized as a defence under the present statutes. That defence may perhaps rest indirectly on the doctrine of estoppel, but it is certainly not a simple dedication to the public. For a consideration of this subject, see §§ 357, 390, and notes, *ante*.

§ 966. <sup>1</sup> As to the averment of the patent in the declaration, see § 950 and notes, *ante*.



§ 967. Ninth Defence: Denial that the Letters-Patent were Issued in Conformity with Law.

The ninth defence consists in a denial that the patent, though actually issued by the government, was issued in accordance with the formal requirements of the law. It is equivalent to an averment that, in the allowance of the patent, the Patent Office has disregarded the established legal methods of procedure or performed acts beyond its jurisdiction. The law imposes numerous duties on an applicant as conditions precedent to the issue of a patent, the enforcement of which is entrusted to the Patent Office, whose decision in the premises the courts will not review.<sup>1</sup> A patent granted without the fulfilment of these prerequisites cannot be on that account attacked.<sup>2</sup> The omission of the prescribed oath or fee, the absence of the proper attestations, and other similar informalities are cured by the allowance of the patent, and cannot be set up as a defence in any action based thereon. Certain irregularities in the procedure of the Office of a trivial character are in like manner overlooked.<sup>3</sup> But there are some faults in the action of the Office of which courts do take notice and of which an infringer may avail himself in his defence. Thus if the patent has been issued upon a false oath or suggestion, or if the patent does not bear the signatures of the Secretary and Commissioner and the seal of the United States, or if it departs from the application and purports to protect a different invention or to secure it to a patentee other than the applicant or his lawful assignee,

§ 967. <sup>1</sup> That the action of the Patent Office upon certain of the prerequisites to a patent is final, see §§ 423, 451, 617, and notes, *ante*.

<sup>2</sup> That a patent cannot be collaterally attacked for informality in the grant, see *Dorsey Harvester Revolving Rake Co. v. Marsh* (1873), 6 Fisher, 387.

<sup>3</sup> That the want of legal prerequisites to the issue of the patent by the Commissioner, such as the grant for too long a term, or the want of proper signatures to the specification, is no defence to

an action for infringement, see *Railway Register Mfg. Co. v. North Hudson C. R. Co.* (1885), 23 Fed. Rep. 593; 32 O. G. 519.

That the unintentional issue of the patent by the Patent Office cannot be set up in defence, and that none but the United States can attack it on that ground, see *Doughty v. West* (1869), 3 Fisher, 580; 6 Blatch. 429.

That the omission of the oath or fee is cured by the allowance of the patent, see § 458 and notes, *ante*.

or if it has been granted without the required notice to a pending caveator, or if it issued to a sole applicant for a joint invention or to joint applicants as joint inventors when the inventive act was sole, — these are errors which may render it invalid, and can be urged against it by the defendant.<sup>4</sup> Where the patent has been re-issued under circumstances which show that the alleged defect in the original was voluntary and intentional, and did not occur through inadvertence, accident, or mistake; or when the amended patent embraces matter which the inventor evidently did not intend or endeavor to protect in the original, the action of the Patent Office in allowing the re-issue transcends its jurisdiction, and a suit on the re-issued patent cannot be sustained.<sup>5</sup> Fraud on the part of the officials of the government in issuing the patent is not, however, a permissible defence in any private action, — the United States alone having a right to seek the cancellation of a patent for this reason by instituting a suit for its repeal.<sup>6</sup>

<sup>4</sup> That where the Commissioner exceeds his authority in issuing a patent, under a mistake of law, the question may be reviewed on a suit for infringement, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

That a patent issued upon a false oath or suggestion is invalid, see § 456 and notes, *ante*.

*Contra*, where the matter of the oath is formal only, and the falsehood unintentional, see *Tondeur v. Chambers* (1889), 46 O. G. 1110; 37 Fed. Rep. 333.

That a patent issued without the required official signatures or seal is void, see *Marsh v. Nichols* (1888), 128 U. S. 605; and § 620 and notes, *ante*.

That a patent granted without notice to a caveator is invalid against him, see *Phelps v. Brown* (1859), 4 Blatch. 362; 18 How. Pr. 7; 1 Fisher, 479.

That a sole patent for a joint invention is void, see § 402 and notes, *ante*.

That a joint patent for a sole invention is invalid, see § 402 and notes, *ante*.

<sup>5</sup> That a re-issue embracing "new matter" is invalid, see §§ 635, 661-667, and notes, *ante*.

That the irregularity of re-issue proceedings is no defence unless it can be shown that the re-issue was contrary to law or was granted to the wrong party, see *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555; 3 Fisher, 87.

<sup>6</sup> That re-issued and extended patents cannot be impeached for fraud in suits for infringement, see *Schillinger v. Cranford* (1885), 4 Mackey, 450; 37 O. G. 1349; *Milligan & Higgins Glue Co. v. Upton* (1874), 6 O. G. 837; 4 Clifford, 237; 1 Bann. & A. 497; *Gear v. Grosvenor* (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

That no defence can be based on an allegation of fraud in procuring an extension, see *Tilghman v. Mitchell* (1871), 4 Fisher, 615; 9 Blatch. 18; *Whitney v. Mowry* (1870), 4 Fisher, 207; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

That the decision of the Commis-



**§ 968. Tenth Defence: Denial that the Invention Covered by the Patent is Legally Patentable.**

The tenth defence consists in a denial that the invention covered by the patent is patentable subject-matter under the laws of the United States. The nature of this objection is the same as that urged in the fourth defence, the difference being in the point to which they are directed.<sup>1</sup> In that, the claim of the defendant is that the inventive act of the patentee or his assignor has not resulted in the production of any art or article which is entitled to protection, or which can lawfully be made the basis of a patent; in this, he claims that, be the actual invention of the plaintiff what it may, the one described in his patent does not fall within the classes mentioned in the statute. When this defect exists it is apparent on the face of the patent, and hence may be judicially noticed by the court as well as if pleaded and insisted on by the defendant.

**§ 969. Eleventh Defence: Fraudulent Concealment or Misrepresentation in the Specification of the Patent.**

The eleventh defence consists in a denial that the patentee or his assignor has acted in good faith toward the public in disclosing his invention in the specification annexed to his patent. This defence is equivalent to an averment that, for the purpose of deceiving the public, the description of the invention in the specification was made to contain less than the whole truth in reference to the invention or more than is necessary to produce the desired effect.<sup>1</sup> The essence of this

sioner on an extension is not reviewable in defence to an infringement suit, see *Whitney v. Mowry* (1870), 4 Fisher, 207.

§ 968. <sup>1</sup> See § 962 and notes, *ante*.

§ 969. <sup>1</sup> This defence, though stated in the language of the statute requiring notice to be given to the plaintiff when the defence is to be urged, does not itself rest upon the statute. A patent obtained by, or containing, wilfully false representations concerning the nature of the invention, has always been held void both in this country and in

England, and the doctrine has sometimes been pushed to an extreme degree.

See *Grant v. Raymond* (1832), 6 Peters, 218; 1 Robb, 604; and cases cited in note 2, *post*; and § 494 and notes, *ante*.

Also, *Tetley v. Easton* (1852), Macrory, P. C. 48; *Walton v. Bateman* (1842), 1 Web. 613; *Neilson v. Harford* (1841), 1 Web. 295; *Lewis v. Marling* (1829), 1 Web. 493; 1 Abb. P. C. 421; *Bovill v. Moore* (1816), Davies P. C. 361; 1 Abb. P. C. 231.

defence is the fraudulent intent with which the erroneous description has been made.<sup>2</sup> Ambiguities of idea or expression arising from the want of clear conceptions in the mind of the inventor, or from inability to delineate them in words or drawings, do not enter into this defence.<sup>3</sup> A patent intended to deceive may be clear, precise, and graphic, and probably will be so; but however intelligible to those skilled in the art, if it is designed to mislead them as to the character of the real invention and either prevent them from employing it in its completeness or compel them to employ it at a disadvantage as compared with the inventor, his wilful endeavor to deceive forfeits all that right to protection which he might have otherwise enjoyed, and if established by sufficient evidence renders his patent void.<sup>4</sup>

**§ 970. Twelfth Defence: Ambiguity in the Description of the Invention in the Patent.**

The twelfth defence consists in an averment that the description of the invention in the specification is insufficient to enable persons skilled in the art to make and use it without the exercise of their own inventive skill. The law requires as a condition precedent to the issue of a patent that the applicant shall file in the Patent Office a written description of the invention, 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 to make, construct, compound, and use the same; and the decision of the Patent Office as to the applicant's compliance with this condition has, on numerous occasions, been held subject to reconsideration in the courts in cases of infringement.<sup>1</sup> Doubts have, however, been expressed from

<sup>2</sup> That to this defence a fraudulent intent is essential, see *Lowell v. Lewis* (1817), 1 Mason, 182; 1 Robb, 131; *Gray v. James* (1817), Peters C. C. 394; 1 Robb, 120; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.

<sup>3</sup> That ambiguity in the description is a defence only when persons skilled in the art could not from it practise

the invention, see § 493 and notes, *ante*, and §§ 970, 1034, 1035, and notes, *post*.

<sup>4</sup> That any fraudulent concealment or redundancy which gives the inventor an advantage over others, even in the mode of enjoying the invention, is fatal, see cases cited in note 1, *ante*.

§ 970. <sup>1</sup> Sec. 4888, Rev. Stat. 1874. That unless a person skilled in the



time to time, and recently by high authority, whether simple ambiguity in the description, though so great as to prevent the public from acquiring any practical knowledge of the invention, if not intentional or fraudulent, could vitiate the patent, or enable an infringer to attack it on this ground alone.<sup>2</sup> This question is of great importance and will bear a somewhat extended consideration. In the first place, it is evident that on principle an ambiguous description of the invention in a patent ought to be regarded as a fatal defect. The contract between the inventor and the public, which is theoretically the basis of his rights, obliges him to place the invention fully before the public, and render it practically available to them, in return for the temporary protection which they accord to him.<sup>3</sup> The method which the law prescribes to him for making this disclosure of his invention is its description in the specification; and if he there fails to sufficiently reveal it, the consequences to the public are the same whether the failure were inadvertent or intentional, since if, in either case, the patent were considered valid, the inventor would receive the protection he desired without bestowing on the public the consideration that the law provides. The doctrine that unless the failure is intentional and fraudulent the patent cannot be attacked therefor entirely loses sight of the true nature of the patent-contract, ignores the right of the public to the disclosure of the invention, and treats the inventor as responsible for no infraction of his own obligations unless they are not only voluntary but spring from a corrupt and evil motive. Such a doctrine is an anomaly in the law of contracts which uniformly regards a breach on one side, from whatever cause arising, as discharging the other party from his corresponding duties. In harmony with the spirit of that law, the protection given to

art can construct and practise the invention from the specification alone without further research or exercise of inventive skill the patent is invalid, see §§ 483-494, and notes, *ante*.

<sup>2</sup> That whether an insufficient description is a defence unless it is fraudulent, and the fraud is alleged, is doubt-

ful, see *Loom Co v. Higgins* (1882), 105 U. S. 530 ; 21 O. G. 2031.

<sup>3</sup> That the sole consideration for the grant of the monopoly is the communication of the invention to the public by the specification of the patent, see §§ 41, 42, 481, and notes, *ante*.

the patentee should be dependent on his performance of his part of the contract, and his omission to perform it should leave him in the same position which he would have occupied had the contract not been made.<sup>4</sup> Again, the law expressly provides that the patent shall not issue until a sufficient description has been filed. It does not authorize the Patent Office to grant a patent upon an honest attempt of the inventor to set forth his invention; it requires him to attain in his description a certain degree of perspicuity and completeness, to be measured by the ability of persons skilled in the art to practise the invention by merely following its directions. The Patent Office may not be able to subject the description to this test, and may award a patent upon a specification which will not endure it; but in so doing the Office acts beyond its jurisdiction as truly as if it had allowed the patent without requiring any specification whatever. The courts have always unhesitatingly gone behind the judgments of the Patent Office in all cases where its action was not warranted by law, and have held patents void whenever they were granted contrary to the express provisions of the law, although that fact could not be ascertained until some suit upon the patent gave the opportunity for an investigation of its merits.<sup>5</sup> The claim that this particular condition precedent may safely be omitted by the patentee rests upon no exception in the statute, and is not justified by any legal analogy. Again, the fault of ambiguity in the description differs entirely in its character from that of fraudulent redundancy or concealment. In the latter, the inventor endeavors to deceive the public, intending at the outset to obtain an unfair advantage over all those who may attempt to practise his invention. It does not alter his offence nor decrease its gravity that he distinctly

<sup>4</sup> That this doctrine works no hardship to the patentee is apparent from the fact that if his description is imperfect, experience must speedily demonstrate it to him, and the defect is then curable by re-issue. The hardship to the public of being compelled to respect the monopoly while unable to derive from the patent their lawful advantage

and of being debarred from defending actions for infringement unless deceit were provable is, on the contrary, great and irremediable.

<sup>5</sup> That the action of the Patent Office in issuing a patent is only *prima facie* evidence of its validity see § 714 and notes, *ante*, and § 1016 and notes, *post*.



communicates a new invention to the public and renders practically available to them an art or instrument they had not before enjoyed. He may do this and still conceal matters which render the invention more available, or falsely represent as necessary to its operation objects or acts which make it more expensive or difficult to use. Such deceit avoids even a beneficial patent, not on the ground that the public have received no consideration for the patent, but on the ground that the attempted fraud forfeits all right of the inventor to protection. Thus though a patentee, who without intending to deceive has failed to properly disclose his invention, may have his patent declared void for want of that particular condition precedent or failure of consideration, he does not lose his right to the protection of his actual invention, but may amend his patent by re-issue and thereafter vindicate his privilege against infringers. But the fraudulent patentee has no such remedy. His patent, being declared void for intentional misrepresentation or concealment, cannot be amended. The defects therein did not occur through inadvertence, accident, or mistake, and hence he must remain perpetually deprived of his exclusive privilege while his invention passes into the free enjoyment of the public. Were these two faults united into one with these distinctions in their individual character and effect, no unintentional insufficiency in the description would in any case require amendment except for the more definite interpretation it might thereby furnish to the Claim, and every judgment against a patentee on the ground of ambiguity in the description would not only destroy the existing patent but debar him from procuring a re-issue. Such certainly has never been the doctrine of the courts, nor could it be adopted at the present day without disorganizing most important branches of our patent jurisprudence. The view here controverted being thus unsound in principle, contrary to statute, and impracticable in application, may safely be regarded as erroneous, and the general current of decisions be relied upon as accurate statements of the law.<sup>6</sup> According to

<sup>6</sup> This misconception arose like many others in the infancy of our patent system and before the distinctions now familiar were clearly recognized. Under the act of 1793 the court had power in a suit for infringement not merely to de-

these, the fact that persons skilled in the art could not from the description alone, without the exercise of their own inventive skill, make and use the invention, invalidates the patent, and constitutes a proper and complete defence in any action for infringement.

§ 971. **Thirteenth Defence: Excessive Claims.**

The thirteenth defence consists in an averment that the Claims contained in the patent are excessive and include matters which are either open to the public or have resulted from the inventive skill of other individuals. A patentee who intentionally puts forward such excessive Claims, or who persists in them after the discovery of his error, is presumed to be attempting to obtain an unfair advantage over the public by appropriating to himself inventions which belong to them or

side in favor of the defendant but also to declare the patent itself entirely void, provided certain defences were asserted in a notice and maintained by evidence. Among these was that of fraudulent concealment or redundancy; and though it was always held that other defences known to the law of patents might be urged without such notice, for the purpose of defeating the action against the defendant without affecting the validity of the patent, it seems to have been assumed that when a defendant urged a defective specification it was urged under this statutory privilege and for this double purpose. Hence various decisions are found before the act of 1836, in which the view is taken that a fraudulent intent is necessary in order to render a patent void on account of a defective specification. (See *Gray v. James* (1817), Peters C. C. 394; 1 Robb, 120; *Lowell v. Lewis* (1817), 1 Mason, 182; 1 Robb, 131; *Whittemore v. Cutter* (1813), 1 Gallison, 429; 1 Robb, 28.) In the act of 1836, the power to declare the patent void in infringement suits was not bestowed on the court, but notice was still re-

quired to be given if the defendant desired to offer evidence that the specification was fraudulently defective. With this change in the statute the old doctrine of the courts should have also disappeared, especially after the decision in *Grant v. Raymond* (1832), 6 Peters 218; 1 Robb, 604, in which Marshall, J., stated that the notice and evidence of fraudulent intent was necessary only where the purpose of the defendant was to obtain a judgment avoiding the patent, while a defective specification was a good defence under the general issue when the defendant desired only to protect himself against the patentee. Like other errors, however, whose correction depends on an historical study of the law, it has been from time to time revived, and as seen in the case cited in note 2, has even extracted a *quere* from the Supreme Court itself. The paragraphs referred to in note 1 with the cases cited under them sufficiently indicate that the general current of authority supports the position that a defective specification without fraud is now a good defence to an action for infringement.



which they might receive from the actual inventors; and he, therefore, justly forfeits all those rights which otherwise his patent might confer.<sup>1</sup> Under the early English practice this question was determined by a mere inspection of the patent, and if it claimed too much upon its face, it was irremediably defective and invalid.<sup>2</sup> But under our present statutes an excessive Claim may be amended by re-issue or disclaimer when the excessive matter was inserted through inadvertence, accident, or mistake, without wilful default or intent to defraud or mislead the public, and when the remaining matter is a material or substantial part of the invention as originally claimed, and can exist independently of the excess as a complete and patentable invention, provided the amendment is made without unreasonable delay.<sup>3</sup> If, therefore, an excessive Claim is knowingly and wilfully inserted in the patent, or if although inserted without fault it cannot be amended without eliminating all patentable subject-matter from the Claim, or if although amendable its amendment has not been effected with reasonable diligence, the patentee cannot avail himself of the patent in the assertion or vindication of his rights. In all such cases this defence is proper, and the suit based on the patent fails. But in those cases where the Claim is amendable, and reasonable time for the amendment has not yet elapsed, the defect may be removed pending the suit, and this defence will only bar the plaintiff's right to costs.<sup>4</sup> After such an amendment all issues concerning the patentability of

§ 971. <sup>1</sup> That an intentional excessive Claim is an attempt to defraud the public and renders the patent void, see § 644 and notes, *ante*.

That where a Claim is intentionally excessive it cannot be cured by re-issue or disclaimer, see § 644 and notes, *ante*.

<sup>2</sup> That in England a Claim excessive on its face avoided the patent, see *Bovill v. Moore* (1816), *Davies P. C.* 361; *1 Abb. P. C.* 231; *Huddart v. Grimshaw* (1803), *1 Web.* 85; *1 Abb. P. C.* 128; *Rex v. Else* (1785), *1 Web.* 76; *1 Abb. P. C.* 40.

<sup>3</sup> That an excessive Claim, if not

intentional, is curable by re-issue or disclaimer, see §§ 642-644, 656-658, 687, and notes, *ante*.

<sup>4</sup> That a disclaimer restricting excessive Claims may be filed pending suit, and the plaintiff may then recover on the amended Claim, but without costs, see § 651 and notes, *ante*.

That where one Claim of a patent is declared invalid so nearly to the expiration of the patent that no disclaimer can be filed, the patentee can recover on the valid Claims, though he does not disclaim the invalid, see *Kittle v. Hall* (1887), *30 Fed. Rep.* 239.

the invention are limited to the subject-matter of the amended Claim.<sup>5</sup>

§ 972. **Fourteenth Defence: Ambiguity in the Claims.**

The fourteenth defence consists in a denial that the Claim defines the invention which the patent purports to protect with such precision and completeness as to distinguish it from all other inventions. It is equivalent to an averment that the Claim is ambiguous, uncertain, or unintelligible, and that the patent is therefore void. The Claim of a patent is the life of the patent; and either alone or as interpreted by the description, it must clearly and exactly draw the line between the inventions over which the patentee asserts his exclusive rights, and those which are beyond the scope of his monopoly. If the Claim is unintelligible and conveys no idea of the invention claimed; or if it is uncertain, conveying some idea but not precisely specifying its essential characteristics; or if it is ambiguous, expressing the ideas that underlie two or more different inventions but leaving it doubtful which the inventor actually intends to claim, the patent is inoperative as a grant, and affords no protection to the patentee.<sup>1</sup> In patents which embrace more than one Claim, either for the same or different inventions, the presence of defective Claims does not impair the validity of the others if these are in themselves sufficient.<sup>2</sup> Each Claim is judged by itself, and stands or falls as though it were the only one included in the patent. Hence this defence is proper in suits based on a patent which

<sup>5</sup> That after a disclaimer all questions in reference to the patent concern it only in its amended state, see *McCormick v. Seymour* (1854), 3 Blatch. 209; *Clark v. Kenrick* (1843), 12 M. & W. 221.

That where a disclaimer is made pending suit, the proceedings need not be recommenced, unless the defendant has been prejudiced, see *Libbey v. Mt. Washington Glass Co.* (1886), 36 O. G. 572; 26 Fed. Rep. 757.

§ 972. <sup>1</sup> That ambiguity in the Claim is fatal to the patent, see *Edgerton v.*

*Furst & Bradley Mfg. Co.* (1881), 10 Bissell, 402; 21 O. G. 261; 9 Fed. Rep. 450; *Blake v. Stafford* (1868), 6 Blatch. 195; 3 Fisher, 294; *Carr v. Rice* (1858), 4 Blatch. 200; 1 Fisher, 325; *Hovey v. Stevens* (1846), 3 W. & M. 17; 2 Robb, 567; *Brooks v. Jenkins* (1844), 3 McLean, 432; *Ames v. Howard* (1833), 1 Sumner, 482; 1 Robb, 689; *Barrett v. Hall* (1818), 1 Mason, 447; 1 Robb, 207.

<sup>2</sup> That defective Claims do not impair the validity of such as are sufficient, see §§ 537, 684, 695, and notes, *ante*.



contains a single and defective Claim, or on the invalid Claims of a patent which contains other perfect Claims not covering the infringed invention, but is of course inapplicable in cases where the invention in dispute is properly defined in any one Claim of the patent, however erroneously it is set forth in the others.

**§ 973. Fifteenth Defence: Surrender of the Patent.**

The fifteenth defence consists in a denial that the patent described in the declaration, though once existing as a valid patent, is now capable of serving as the foundation of a suit. This defence is equivalent to an averment that the patent and all rights of action under it have been extinguished. It concedes that the patent was lawfully issued to the patentee and complied with the various conditions requisite to its validity, but asserts that it has been determined in such a manner as to involve in its destruction all causes of action which had previously arisen. This can occur only in case of the surrender of a patent by its lawful owners, either for the purposes of a re-issue, or as a method of abandoning the invention to the public.<sup>1</sup> The expiration of a patent by lapse of the term for which it was granted does not affect the rights of action which already have accrued.<sup>2</sup> The repeal of a patent, whether at the suit of the government or of an interfering patentee, involves a judgment that it never existed as a valid patent. Thus this defence is applicable only in the case of a surrender, and is available whether the surrender took effect before or after the institution of the suit.

**§ 974. Sixteenth Defence: Repeal of the Patent.**

The sixteenth defence consists in a denial that the patent, though issued in apparent conformity with the requirements of the law, ever existed as a lawful patent, or still exists in any form whatever. It is equivalent to an averment that the patent was granted contrary to law, and has on that account

§ 973. <sup>1</sup> That the surrender of a patent extinguishes all existing rights of action, see *Moffitt v. Gaar* (1860), 1 Bond, 315.

<sup>2</sup> That an action may be maintained after the expiration of a patent for infringements committed during its term, see §§ 908, 937, 1092 and notes, *post*.

been recalled and cancelled by the government. This occurs in the two cases where a prior inventor and rival patentee obtains the revocation of the patent by an equitable proceeding for that purpose, and where the government itself institutes and prevails in a suit for its repeal. In these cases the patent is held void *ab initio*, all rights acquired under it existing in appearance only, and the monopoly which it purported to create being a wrongful and unwarranted imposition on the public or the true inventor.<sup>1</sup> Where the patent has been repealed *in toto*, as in proceedings by the government or between the rival patentees, this defence is available in any suit based on the patent. Where it has been annulled only in reference to certain owners of the rival patents, this defence is no bar to an action between other owners, the patent as to them remaining unaffected by the judgment.<sup>2</sup> This defence completes the group of those by which the patent is attacked, and its existence or validity denied, on grounds which do not touch the patentability of the invention or the right of the alleged inventor to a patent.

**§ 975. Seventeenth Defence: Denial of a Legal Title in the Plaintiff.**

The seventeenth defence attacks the title of the plaintiff to the patent, and consists in a denial that his interest in the patented invention is of such a character as to enable him to maintain an action at law. Questions concerning the capacity of the plaintiff to sue, whether they relate to defective corporate organization or to infancy or coverture, and questions concerning the misjoinder or non-joinder of plaintiffs, are not embraced in this defence, such matters being available to the defendant only in abatement.<sup>1</sup> This defence rests upon the

§ 974. <sup>1</sup> That the repeal or annulling of a patent is a rescission of the monopoly *ab initio*, and demonstrates that no rights under it could ever have existed, see §§ 723, 724, 730, and notes, *ante*.

<sup>2</sup> That where a patent is annulled as to certain parties or territory only, it remains in force as to other owners, see *Mowry v. Whitney* (1872), 14 Wall.

434 ; 1 O. G. 499 ; 5 Fisher, 513 ; and §§ 723, 724 and notes, *ante*.

§ 975. <sup>1</sup> That the want of corporate capacity on the part of the plaintiffs is no defence, except in abatement, see *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555 ; 3 Fisher, 87.

That a defect in the organization of a plaintiff corporation cannot be set up



doctrine that at law no one can sue for an infringement unless he is a legal owner of the monopoly, — that is, unless he is a patentee, an assignee, or a grantee enforcing his rights within his own territory.<sup>2</sup> Any defects in these legal titles may be taken advantage of under this defence, but equitable interests cannot be set up in a suit at law to defeat the claims of the record owner of the patent.<sup>3</sup>

**§ 976. Eighteenth Defence: Denial that the Art or Instrument Employed by the Defendant is Covered by the Patent.**

The eighteenth defence, which is the first one of the group raising an issue on the allegation of infringement, consists in a denial that the art or article employed by the defendant is covered by the patent of the plaintiff. This is equivalent to an averment that the idea of means, embodied and expressed in the invention described and claimed by the patent, is not identical with, or included in, the idea embodied in the invention used by the defendant. This defence does not simply deny the identity of the two inventions, for want of identity is not proof of non-infringement, — an original invention being infringed by the use of an improvement, though important differences subsist between them.<sup>1</sup> It denies that the defendant employs the patented invention either *in specie*, or as the foundation for, or as an element incorporated in, his own. Only, therefore, when his invention excludes the patented invention in every form can the defendant properly urge this defence, and seek escape from liability for an in-

as a defence in a suit for infringement, see *Dental Vulcanite Co. v. Wetherbee* (1866), 3 Fisher, 87; 2 Clifford, 555.

<sup>2</sup> That the legal owner of the patent at the date of the infringement, or the assignee of his cause of action, is the only proper plaintiff at law, see §§ 937-943 and notes, *ante*.

That it is no defence to a suit on an extended patent that third parties owned the territory where the infringement is claimed under the original patent, unless they owned the extension also, see *Aultman v. Holley* (1873), 5 O. G. 3.

<sup>3</sup> That the equitable interests of third persons in the patent cannot be set up in defence against the legal title of the plaintiff, see *Graham v. McCormick* (1880), 21 O. G. 1533; 11 Fed. Rep. 859; 10 Bissell, 39; 5 Bann. & A. 244.

§ 976. <sup>1</sup> That wherever the defendant uses the plaintiff's invention either alone or as part of another invention, or coupled with improvements, he is guilty of infringement, see §§ 891-894 and notes, *ante*.

fringement in the fact that the invention which he has employed is not within the monopoly created by the patent.<sup>2</sup>

**§ 977. Nineteenth Defence : Denial that the Acts of the Defendant were Infringing Acts.**

The nineteenth defence consists in a denial that the acts performed by the defendant in relation to the patented invention were of such a character as to subject him to an action for infringement. It is equivalent to an averment that whatever else he may have done, he has not voluntarily made or used or sold the patented invention. According to the judicial interpretation given to the terms "make" and "use" and "sell," they embrace many actions outside of their ordinary and technical meanings, their construction being extended to include the various artifices to which adroit infringers may resort, in order to effect the same results that are attained by the usual modes of making, use, or sale.<sup>1</sup> This defence is, therefore, appropriate when the conduct of the defendant in reference to the invention does not fall within the interpretation given to either of these terms. It is also proper where his acts, though in their nature true acts of infringement, were not voluntarily performed, as in the case of workmen, agents, or officials acting under orders and having no discretion as to the instruments or operations they employ in carrying out the commands of their superiors. In such cases the acts of infringement, though physically their own, are not legally imputable to them, but to the persons in obedience to whose orders and direction they have been committed.<sup>2</sup>

<sup>2</sup> That the defendant may show that he does not infringe at all or that he infringes only a part of the Claims, see *Bates v. Coe* (1878), 98 U. S. 31 ; 15 O. G. 337.

§ 977. <sup>1</sup> As to the various forms which acts of infringement may assume, see §§ 897-905, 922-930 and notes, *ante*.

<sup>2</sup> That an involuntary act, or an act in obedience to legal superiors is not an infringement, see *Hollister v. Benedict Mfg. Co.* (1885), 113 U. S. 59 ; *Heaton v. Quintard* (1869), 7 Blatch. 73 ; *Delano v. Scott* (1834), 1 Gilpin, 489 ; 1 Robb, 700.



§ 978. **Twentieth Defence: Denial that the Alleged Acts of Infringement were Committed while the Patent was in Force.**

The twentieth defence consists in a denial that the patent was in force when the alleged acts of infringement were committed. It concedes that the patented invention has been made or used or sold by the defendant, but avers that these acts were performed either before the patent issued or after it expired. Whatever rights of action may accrue at common law to the owner of an invention from its unauthorized use before the date of his patent, and whatever redress for such use may be awarded in the English courts in a suit based upon the patent, our own courts have uniformly held that no suit for infringement can be sustained under our Patent Law unless the acts complained of were performed after the patent had been granted.<sup>1</sup> The patent is regarded as the foundation of the right which is invaded by the infringement, and only acts committed while the patent is in force can violate the right which it creates. For this reason, also, acts perpetrated after the patent has expired are not infringements, except in cases where they are performed in consequence of plans devised and preparations made during the life of the patent, the present act thereby relating back and constituting one transaction with the former, and thus rendering the defendant liable for both.<sup>2</sup> This defence, therefore, either simply puts in issue the date of the alleged infringement as compared with the dates of the grant and the expiration of the patent, or, in addition to these, it raises the question whether the acts performed after the patent had expired were connected with preceding acts as to make them elements in a line of conduct which, taken as a whole, amounted to infringement. In estimating the duration of a patent the term expressed upon its face is not conclusive.<sup>3</sup> If prior foreign patents have been

§ 978. <sup>1</sup> That no infringement of the patent is possible until after the patent has been granted, see § 907 and notes, *ante*.

<sup>2</sup> That acts of infringement may be committed after the patent has expired, if relating back to preparations made

while the patent was in force, see § 908, and notes, *ante*.

<sup>3</sup> That the date of the expiration of a patent is fixed by law, whatever the term named therein may be, see § 622 and notes, *ante*.

issued for the same invention, the life of the domestic patent must be measured by that of the foreign patent which will first expire, if within the statutory period of seventeen years.<sup>4</sup>

**§ 979. Twenty-First Defence: Co-ownership of the Patent, or License from its Lawful Owner.**

The twenty-first defence consists in an averment that the acts of making, using, and selling the patented invention, though voluntarily performed by the defendant during the life of the patent, were not wrongful invasions of the plaintiff's rights. It is equivalent to a plea of justification, and an allegation that the defendant acted upon due authority. It is a proper defence where one part-owner of a patent is sued by his co-owner for acts which are confined to the employment of the patented invention, or where for similar acts a licensee is made defendant in proceedings instituted by his licensor.<sup>1</sup> But where the invention used by a part-owner or a licensee is not identical with that protected by the patent, this defence will not avail.<sup>2</sup> In such cases there is either no infringement because the invention practised does not include the patented invention, or the acts of the part-owner or licensee in employ-

<sup>4</sup> That the duration of a patent is limited by that of the prior foreign patent having the shortest term, see § 622-624 and notes, *ante*.

That an English patent, taken out without authority from the American inventor, cannot affect his rights in the United States, see *Kendrick v. Emmons* (1875), 9 O. G. 211; 2 Bann. & A. 208.

That the validity of an American patent is not affected by that of a foreign patent, though its duration may be, see *Cornely v. Marckwald* (1883), 24 O. G. 498; 21 Blatch. 367; 17 Fed. Rep. 83.

§ 979. <sup>1</sup> That a part-owner does not infringe by any use of the patented invention, see *Herring v. Gas Consumers Association* (1878), 9 Fed. Rep. 556; 21 O. G. 203; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253; also §§ 796, 797, 913 and notes, *ante*.

That the acts of alleged infringement are performed under a license, is a sufficient defence, see *Watson v. Smith* (1881), 20 O. G. 300; 7 Fed. Rep. 350.

See also § 915 and notes, *ante*.

<sup>2</sup> That a part-owner may infringe by using an infringing invention, see *Herring v. Gas Consumers Association* (1878), 9 Fed. Rep. 556; 21 O. G. 203; 13 O. G. 637; 3 McCrary, 206; 3 Bann. & A. 253; also § 913 and notes, *ante*.

That a licensee may infringe by using an infringing invention, or by any use of the patented invention which is not covered by his license, see §§ 819, 915 and notes, *ante*.

That a receiver of a firm cannot defend on the ground of a license granted personally to the copartners, see *Curran v. Craig* (1884), 22 Fed. Rep. 101.



ing other inventions which include the patented invention lie outside the authority conferred upon them by the patent or the license, and hence are true infringements.<sup>8</sup> This defence completes the group of those which, admitting the patentability of the invention, the validity of the patent, and the title of the plaintiff, deny that the defendant voluntarily and without authority made, used, or sold the patented invention.

**§ 980. Twenty-Second Defence : Statute of Limitations.**

The twenty-second defence is the first one of a special group whose members have no immediate resemblance to each other, save that they recognize the existence of a cause of action on the part of the plaintiff against the defendant, and aver that he has forfeited by his own conduct his right to legal redress. All these defences rest ultimately on the doctrine of estoppel, — the difference between them residing in the acts out of which the estoppel arises and the authority by which it is defined and enforced. The first consists in an averment that the plaintiff has not commenced his action within the time prescribed by the Statute of Limitations. Whether this defence is permissible in a suit for the infringement of a patent is a question of some difficulty, which has not been completely settled by the courts. That where an act of Congress fixes a period, within which actions of infringement must be brought, the expiration of that period effectually deprives the owner of the patent of his right to sue may be regarded as indisputable. But when no Federal statute of this character exists, as was the case before the

<sup>8</sup> That mere non-payment of royalties does not forfeit a license unless the contract so provides, and the continued use of the licensed invention is a mere breach of contract, not an infringement, see *Consolidated Middlings Purifier Co. v. Wolf* (1886), 37 O. G. 567 ; 28 Fed. Rep. 814.

That the covenants in a license cannot deprive a licensee of the right to show that he does not infringe, see *White v. Lee* (1882), 23 O. G. 1621 ; 14 Fed. Rep. 789.

That if a license set up in defence is shown to have been revoked before the infringement, the defence will be overruled, and the defendant allowed to defend like other infringers, see *Wooster v. Singer Mfg. Co.* (1883), 23 O. G. 2513.

That the rights of a purchaser from a foreign maker are subordinate to those of the patentee under his American patent, see *Graff v. Boesch* (1887), 33 Fed. Rep. 279.

act of 1870 and has been since the Revision of 1874, the limitation, if there be any, must result from the statutes of the State in which the action is commenced. Whether such statutes apply to suits under the Patent Law is doubtful. Some courts have affirmed while others have denied it.<sup>1</sup> In

§ 980. <sup>1</sup> In *Hayden v. Oriental Mills* (1883), 15 Fed. Rep. 605, Lowell, J. : (605) "Several judges of great ability and experience have held that the Statutes of Limitation of the States do not affect actions upon patent rights, upon the theory that Sec. 34 of the Judiciary Act (now Rev. Stat. Sec. 721), making the laws of the States the rules of decision in the courts of the United States, in actions at the common law, does not apply to actions which are within the exclusive jurisdiction of the courts of the United States. There are several able decisions on the other side, but perhaps the weight of authority is with the plaintiff on this point. We give the citations in a note at the end of this opinion. This is an action at law, and if the statutes in question do not apply, there is no limitation, unless it be that of Rhode Island in 1789, — for a court of common law has no discretion to refuse to entertain stale claims. This result appears to us to be inadmissible. No reason is given in any decision for excepting one class of cases out of Sec. 721. Some arguments upon the general question have been made which we shall advert to. There is no such exception in the statute itself, and none in its intent and purpose. Exclusive jurisdiction is given for reasons which are apart from this question. For instance, in patent cases the Federal courts have this control in order that the construction of the law and of the patents granted under it may be as nearly uniform as possible, not that the remedies of a patentee shall be of uniform duration. Equity is a uniform system in the Federal courts through-

out the United States, but the remedies in equity are barred in those courts by the State Statutes of Limitation in certain cases. . . . To us it seems as inadmissible to say that Sec. 721 does not apply to patent cases, as that the law adopting the general practice of the States does not apply to them. In one particular it perhaps does not, because the statute says that an action on the case shall be the remedy. This is a reproduction of the old law which was passed when all the States had that form of action, and may or may not now be an exclusive remedy; but no one can deny that in other respects the process and procedure acts apply to actions at law for the infringement of patent-rights. A dozen questions may arise in any patent case which can only be decided by the law of the State. There is no doubt, of course, of the right of Congress to make a Statute of Limitations for patent causes. The power is specially reserved in Sec. 721, and by the act of 1870, Sec. 55 (16 St. 206), they made such a law, which provides that all actions shall be brought within the term for which letters-patent shall be granted or extended, or within six years thereafter. Congress, when they passed this act, may have supposed that there was no limitation; but, if so, they found out their mistake, for they repealed this part of the patent law, when they passed the Revised Statutes, by omitting it from the chapter on patents. *Sayles v. Oregon Central R. R. Co.*, 6 Sawy. 31; *Vaughn v. East Tenn. &c. R. Co.*, 11 O. G. 789. When they thus repealed the act of Congress, the State law became again applicable



this divergence of authority no opinion can be more than probable. The peculiar nature of a patent right as a uni-

to future infringements, but one of the repealing sections (Sec. 5599) reserves all existing causes of action, so far as limitations are concerned, precisely as though no repeal had been made. *Sayles v. Oregon Central R. R. Co.*, *supra*; *Vaughn v. East Tenn. &c. R. Co. supra.*" 24 O. G. § 601 (601).

In *Sayles v. Richmond, Fredericksburg & Potomac R. R. Co.* (1879), 3 Hughes, 172, Hughes, J. : (173) "The thirty-fourth section of the Judiciary Act of 1789 (Sec. 721 of the Revised Statutes of the United States) is the only general statute of limitations known in Federal legislation. In providing that the laws of the several States shall be the rules of decision in trials at common law in courts of the United States, except where treaties or acts of Congress otherwise provide, Congress virtually adopted the Statute of Limitations of each State as the limitation of actions brought in the United States courts held in that State. This point is so thoroughly settled that it is useless for me to cite authorities on the subject." 4 Bann. & A. 239 (240); 16 O. G. 43 (43).

Further, that State Statutes of Limitation apply where there is no Federal statute, see *Royer v. Coupe* (1886), 29 Fed. Rep. 358; 39 O. G. 239; *Hayward v. City of St. Louis* (1882), 11 Fed. Rep. 427; 3 McCrary, 614; *Sayles v. Oregon Central R. R. Co.* (1879), 6 Sawyer, 31; 4 Bann. & A. 429; *Rich v. Ricketts* (1870), 7 Blatch. 230; *Parker v. Hawk* (1857), 2 Fisher, 58.

That State Statutes of Limitation do not apply where there is a Federal statute, see *Sayles v. Louisville City R. R. Co.* (1881), 9 Fed. Rep. 512; *Sayles v. Lake Shore & Michigan Southern R. R. Co.* (1879), 9 Fed. Rep. 515; *Sayles v. Dubuque & Sioux City R. R.*

*Co.* (1879), 9 Fed. Rep. 516; 5 Dillon, 561; 3 Bann. & A. 219.

*On the contrary:* In *Anthony v. Carroll* (1875), 2 Bann. & A. 195, Shepley, J. : (197) "Should the legislature of a State pass an act in express terms limiting the time for bringing an action in the Federal courts for infringement of patent-rights, there can be no reasonable doubt that such a statute would be unconstitutional and void. The policy of the government to provide a uniform system of rights and remedies throughout the United States upon the whole subject-matter of patents for new and useful inventions and discoveries by placing it under the control of Congress and the Federal courts would be frustrated if such State legislation could directly or indirectly limit, restrict, or take away the remedy. For these reasons I think no State Statute of Limitations can be pleaded in bar of this action." 9 O. G. 199 (200).

In *Read v. Miller* (1867), 3 Fisher, 310, McDonald, J. : (313) "Since, then, no State has any power to legislate concerning patent-rights, and no State court has jurisdiction to adjudicate concerning any violation of them, it can hardly be supposed that a State may, nevertheless, pass Statutes of Limitation concerning them, which shall control national courts in suits brought for their infringement. It ought not to be presumed that the State legislature, in passing a Statute of Limitation, ever intended it to extend to patent-right litigations, since such litigation cannot arise in a State court. Nor ought the presumption to be indulged that Sec. 34 of the Judiciary Act could have been intended to authorize State legislatures to pass Statutes of Limitation on subjects over which the States have no control. Moreover, it should

versal franchise co-extensive with the United States, its extreme susceptibility to secret invasion, the fact that numerous causes of action against different defendants involving in the main the same issues and practically requiring but one extended litigation often arise almost simultaneously, and the manifest advantage of uniformity throughout the entire country in all matters connected with the enforcement of any universal right, indicate that this important feature of remedial jurisprudence is solely within Federal jurisdiction, and can be regulated only by the acts of Congress. If these prescribe no period of limitation for the remedies which they provide in cases where the rights which they create are violated, it is a fair presumption that Congress, in whom the supreme power over all these subjects unquestionably resides, intends that no such limitation shall exist. In this view it seems probable that State Statutes of Limitation afford the defendant no ground of defence. The only Federal statute of this character which

be noted that Sec. 34 of the Judiciary Act only makes the laws of the several States rules of decision in the national courts '*in cases where they apply.*' Now, it appears to me that these State laws do not apply in cases over which State governments have no control whatever, and which are under the exclusive control of the general government. The counsel for the defendants seems to rely confidently on the case of *McLuny v. Silliman*, 3 Peters, 270, as sustaining the pleas in question. But I think that case not in point. It was an action against Silliman, a land officer, for official misconduct. Over the subject-matter of it, I suppose the State and national courts had concurrent jurisdiction. If so, the case evidently fell within the provisions of Sec. 34 of the Judiciary Act, and so it was decided by the Supreme Court. In that case, therefore, the plea of the Statute of Limitation of the State of Ohio was very properly held to be a good bar to the action. Upon the whole, I conclude that no State Statute of Limi-

tation can bar this action. And I think that, should a State legislature pass an act in express terms limiting the action on the case for violating patent-rights, a thing I believe never yet attempted by any State legislature, such an act would be unconstitutional and void." 2 Bissell, 12 (15).

Further, that State Statutes of Limitation do not apply to patent cases, see *May v. Logan Co.* (1887), 41 O. G. 1387; 30 Fed. Rep. 250; *May v. Ralls Co.* (1887), 40 O. G. 575; 31 Fed. Rep. 473; *May v. Cass Co.* (1887), 30 Fed. Rep. 762; *May v. Buchanan Co.* (1886), 39 O. G. 120; 29 Fed. Rep. 469; *Adams v. Bellaire Stamping Co.* (1885), 33 O. G. 623; 25 Fed. Rep. 270; *Anthony v. Carroll* (1875), 9 O. G. 199; 2 Bann. & A. 195; *Collins v. Peebles* (1865), 2 Fisher, 541.

That whether State Statutes of Limitation apply is doubtful, see *Stevens v. Kansas Pacific R. R. Co.* (1879), 5 Dillon, 486; *Sayles v. Dubuque & Sioux City R. R. Co.* (1878), 5 Dillon, 561; 3 Bann. & A. 219; 9 Fed. Rep. 516.



ever has existed formed a part of the Patent Act of 1870.<sup>2</sup> It provided that all actions should be brought during the term for which the letters-patent were granted or extended, or within six years after the expiration thereof. This enactment was omitted from the Revised Statutes of 1874, presumably because it was judged inexpedient to retain it. While it was in force its construction was disputed,—some authorities deciding that a cause of action arising under the original term of a patent was barred in six years after the expiration of that term although the patent might have been extended; others regarding the original and extended terms as legally but one and the statute as inoperative against any right of action until six years had elapsed after the patent had finally expired.<sup>3</sup> To what causes of action the limitation applied was

<sup>2</sup> That before July 8, 1870, no Federal Statute of Limitations applied to patent cases, see *Wood v. Cleveland Rolling Mill Co.* (1871), 4 Fisher, 550.

<sup>3</sup> In *Sayles v. Louisville City R. R. Co.* (1881), 9 Fed. Rep. 512, Barr, J. : (514) "It is not true that letters-patent run for only one term when the patent is extended. In such a case there are two terms,—the original term and the extended term,—and though the law provides that when a patent is extended it shall have the same effect in law as though it had been originally granted for twenty-one years, that does not change this fact, nor does it change the fact that the original term was for fourteen years, and not twenty-one years. The act does not provide that the two terms shall be considered as one term in law, but simply provides that the extension of a patent shall have the same effect in law as though it had been originally granted for twenty-one years. I think Congress has, in the clause under consideration, clearly recognized that an extended term and the original term of letters-patent are distinct terms. An extended term of letters-patent can have the same effect in law as though it had been granted for

twenty-one years, in the granting of a monopoly, without extending the time of the bar of the Statute of Limitation on existing causes of action. The patent-right is quite distinct from the causes of action which a patentee may have for its infringement; and because a patent-right may be extended it does not follow that the time within which such causes of action should be brought should also be extended."

In *Sayles v. Lake Shore & Mich. So. R. R. Co.* (1879), 9 Fed. Rep. 515, Harlan, J. : (515) "I have reached a conclusion entirely satisfactory to my own mind, and I think that statute means that where the party sues for any infringement under the original term, he must bring his action within six years after the expiration of that term; and when he sues for anything that has occurred under the extended term, he must sue within six years after the expiration of that extension; and that the statute does not mean, as contended for by the learned counsel for the complainant, that the party has the right to sue for an infringement, either under the original or extended term, within six years after the expiration of the extended term, and thus bring the

also doubtful. Under the general doctrine that Statutes of Limitation are not retrospective unless expressly so provided, this Federal statute could not affect a right of action existing at the date of its enactment, though based upon a patent which had long before expired, at least till after six years from the passage of the act.<sup>4</sup> Rights of action accruing under patents which expired while the act remained in force were held to have been barred in six years after such expiration, although meantime the act had been repealed.<sup>5</sup> And it has been asserted that rights of action, growing out of infringements committed during the existence of the statute against patents which expired after the statute was repealed, were also barred unless suit were commenced within six years after the patent had expired.<sup>6</sup> Giving to this defence its wid-

suit within twenty-seven years. I do not think that was the purpose of Congress, and I therefore sustain the grounds of demurrer as to all causes of action."

Further, that a suit for a cause of action arising under the original term must be brought within six years after such term expires, though the patent be meanwhile extended, see *Hayden v. Oriental Mills* (1884), 22 Fed. Rep. 103.

That under the Statute of Limitations of 1870, if a suit is brought within five years after the expiration of the extended term, the plaintiff may recover only for infringements during the extension, see *Sayles v. Dubuque & Sioux City R. R. Co.* (1878), 5 Dillon, 561; 3 Bann. & A. 219; 9 Fed. Rep. 516.

*Contra*: That where a patent has been extended and a suit is brought within the time limited by the statute after the extension expires, the plaintiff may recover for the entire twenty-one years of the patent, see *Sayles v. Richmond, Fredericksburg, & Potomac R. R. Co.* (1879), 3 Hughes, 172; 16 O. G. 43; 4 Bann. & A. 239.

<sup>4</sup> That Statutes of Limitation are only prospective unless the contrary appears, see *Vaughn v. East Tennessee, Vir-*

*ginia, & Georgia R. R. Co.* (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

That Sec. 55, act July 8, 1870, under Sec. 5599, Rev. Stat. 1874, applies to rights of action which were old enough at the time of its approval to have been fully barred by the State statute if such statute had been pleaded, see *Hayden v. Oriental Mills* (1884), 22 Fed. Rep. 103.

<sup>5</sup> That since the repeal of the limitation clause in Sec. 55, act of 1870, an action upon a patent expiring before the Revised Statutes were adopted may be brought within six years after the expiration of the patent, see *Vaughn v. East Tennessee, Virginia, & Georgia R. R. Co.* (1877), 11 O. G. 789; 1 Flippin, 621; 2 Bann. & A. 537.

<sup>6</sup> That Sec. 55, act of July 8, 1870, is not repealed so as to relieve either party from the rule limiting actions to six years after the end of the extended term, see *Hayward v. City of St. Louis* (1882), 11 Fed. Rep. 427; 3 McCrary, 614.

That no Federal Statute of Limitations affecting infringements committed since June 22, 1874, is now in force, see *May v. Logan Co.* (1887), 30 Fed. Rep. 250; 41 O. G. 1387.



est scope, it may, therefore, be proper for a defendant, now sued for an infringement committed while the Federal statute was in force, to urge that statute as a bar, in case the patent has expired more than six years before the suit was brought. It may also be proper to seek refuge in this statute in cases where the patent expired during its existence, although the infringement took place before it was enacted, as well as in cases where the patent had expired before the act was passed. It is not proper to urge the Federal statute where the infringement occurred after its repeal. In cases where the Federal statute is not applicable, a defence based on State statutes may be sustained. But the entire subject is involved in so much obscurity, through the doubt as to State jurisdiction in any case, and the confusion incident to the repeal of the Federal statute before the limitation could have affected any cause of action, that every form of this defence must be experimental until new legislation, or a decision of the court of last resort, shall make the matter plain.

§ 981. **Twenty-Third Defence . Estoppel.**

The twenty-third defence consists in an averment that the plaintiff, though having an existing cause of action, is estopped by his own conduct from pursuing any remedy against the defendant. This defence is based on that form of estoppel which arises out of the actions or omissions of the plaintiff in reference to the defendant or out of the relations which subsist between them. The doctrine of estoppel *in pais*, as applicable to suits at law, is not at the present time entirely clear. That where the plaintiff has designedly misled the defendant by his actions or omissions, he cannot take advantage of the position, in which the defendant has placed himself in consequence thereof, to injure the defendant, is now, as it has always been, a settled rule of law.<sup>1</sup> That where the law imposes on the plaintiff the performance of a

§ 981. <sup>1</sup> That the plaintiff cannot recover damages for acts which he has intentionally misled the defendant to perform, see *Dickerson v. Colgrove* (1879), 100 U. S. 578; *Morgan v. R.*

*R. Co.* (1877), 96 U. S. 716; *Barnard v. Campbell* (1874), 55 N. Y. 456; *Rice v. Barrett* (1874), 116 Mass. 312; *Bronson v. Chappell* (1870), 12 Wall. 681.

certain duty for the protection of the defendant, he cannot avail himself of any fault of the defendant which his own fulfilment of that legal duty might have prevented, is equally indisputable.<sup>2</sup> In both these cases there is present an element of wilful wrong on the part of the plaintiff, which the law will not permit him to employ to his own benefit and the defendant's injury. In equity, however, this element of wilful wrong is not essential in order that the plaintiff may be bound by an estoppel. Equity places on an equal footing acts of intentional wrong and intentional acts whose consequences are identical with those of acts of intentional wrong. It looks upon the effect of conduct, not upon its motive, and thus works an estoppel whenever the voluntary actions or omissions of the plaintiff were calculated to and did mislead the defendant, although the plaintiff may have actually contemplated and designed no such result.<sup>3</sup> While courts of equity and courts of law were entirely distinct, each retained its own doctrine of estoppel *in pais*, and administered it without modification by the other. But in the recent approach and intermingling of these two systems of practical jurisprudence, the courts of law have adopted wider views of this as well as many other doctrines, and the precise line of demarcation between them has disappeared. Thus, as a defence to an action at law, estoppel *in pais* might unquestionably be urged by the defendant whenever the plaintiff had intentionally misled him into the violation of the plaintiff's rights, or where the plaintiff had neglected some legal duty by whose performance such viola-

<sup>2</sup> That the plaintiff cannot recover damages for acts which it was his own legal duty to prevent the defendant from ignorantly committing, unless his duty has been performed, see *Pickard v. Sears* (1837), 6 A. & E. 469; *Young v. Grote* (1827), 4 Bing. 253.

That silence when it is a duty to speak works an estoppel, see *Bank v. Lee* (1839), 13 Peters, 107.

That a plaintiff is not estopped by silence, unless his failure to speak when it was his duty to do so has misled the defendant, see *Reay v. Raynor*, (1884),

26 O. G. 1111; 19 Fed. Rep. 308; 22 Blatch. 13; *N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 25 O. G. 1076; 18 Fed. Rep. 638; 21 Blatch. 519; *R. R. Co. v. DuBois* (1870), 12 Wall. 47.

<sup>3</sup> That in equity a plaintiff cannot recover for acts which his own conduct or declarations induced the defendant to perform, although such inducement were not intentional, see *Bispham*, Eq. Jur., Secs. 282-290; 2 Story, Eq. Jur., Sec. 1538.



tion might have been prevented. According to the current of authority this defence can also be made when the conduct of the plaintiff, though he did not explicitly intend to mislead the defendant, was of such a character that he might reasonably have expected that the defendant would thereby be misled.<sup>4</sup> But conduct of the plaintiff, lawful in itself, and not of such a nature or coupled with such circumstances as indicate that he must reasonably have expected the defendant to be influenced by it in his own behavior, seems not yet regarded as working an estoppel in a court of law.<sup>5</sup> The estoppel which arises out of the relations that subsist between the parties is also of equitable origin, and the extent to which it may be made available in courts of law is not determined. Applying the foregoing doctrines to a suit at law for the infringement of a patent, this defence may be urged whenever the conduct of the plaintiff toward the defendant has been such as might reasonably be expected to mislead and has misled the defendant into the commission of the acts for which he is now sued.<sup>6</sup> Any enumeration of the actions or omissions of the

<sup>4</sup> That a party is bound by acts which his own conduct or declarations induced others to perform, if under the circumstances he might reasonably have expected that they would be misled, see *Bassett v. Bradley* (1880), 48 Conn. 224.

That in this country equitable estoppel is as valid a defence at law as in equity, see *Concord v. Norton* (1883), 16 Fed. Rep. 477.

<sup>5</sup> That in law the mere fact that the defendant was misled by the conduct or declarations of the plaintiff does not work an estoppel on the latter, see *Drexel v. Berney* (1883), 16 Fed. Rep. 522; 21 Blatch. 348.

<sup>6</sup> That a patentee cannot sue persons using the invention under a license from a third party whose interest in the patent has been admitted by the patentee, unless they continue such use after being notified of his exclusive rights, see *Gear v. Grosvenor* (1873), 3 O. G. 380; 6 Fisher, 314; Holmes, 215.

That an inventor who permits another to take out a patent, and then himself takes out a different patent for a different invention, is estopped to allege that he invented the subject-matter of the first patent, see *Fraim v. Keen* (1885), 25 Fed. Rep. 820; 34 O. G. 1048.

That where the officers of an infringing corporation purchase the patent and retire from the corporation, they cannot sue the corporation for infringing the patent under their management, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1885), 24 Fed. Rep. 604; 32 O. G. 1356.

That the owner of the patent is not estopped from suing by his admissions that he was not the owner, if the admissions were in good faith and were recalled before they were acted on, see *Gear v. Grosvenor* (1873), Holmes, 215; 6 Fisher, 314; 3 O. G. 380.

That an inventor is not estopped by a mistaken claim in his application that

plaintiff which constitute such conduct is, of course, impossible. An estoppel is pre-eminently the creature of circumstances, and only in the light of all those which enter into and surround the given transaction can its character be definitely known. Many of the actions of the plaintiff which might be relied on as resulting in an estoppel have also been regarded by the courts as creating an implied license to practise the invention, and such acts may be taken advantage of either under this or that form of defence.<sup>7</sup> Among the omissions of the plaintiff, one derives its character and effect from the express provisions of the law. This consists in the neglect of the owner of the patent for an article to give the public information that the same is patented by stamping the article itself, or the package in which it is contained, with the word "patented," accompanied by the date of the patent. A plaintiff, who omits this duty, is estopped from claiming substantial damages for any infringement committed by the defendant before he receives notice from the plaintiff that his acts are an invasion of the patent.<sup>8</sup> An omission to commence legal proceedings against infringers, within a reasonable time after their infringements became known to the owner of the patent, may work an estoppel in a court of equity.<sup>9</sup> Whether it has the same effect in a court of law may well be doubted, except in cases where it is sufficient evidence of an abandonment of the invention to the public.<sup>10</sup> But the institution of a single suit against one infringer is notice to all others that the plaintiff intends to vindicate his rights under the patent, and no delay in suing them can then raise an estoppel in their favor.<sup>11</sup> The relation that subsists between

his invention is the same as that covered by his foreign patents, see *Commercial Mfg. Co. v. Fairbank Canning Co.* (1886), 27 Fed. Rep. 78; 36 O. G. 1473.

<sup>7</sup> For a discussion of license by estoppel, see § 834 and notes, *ante*.

<sup>8</sup> For the effect of a failure to stamp patented articles as required by law, see § 628 and notes, *ante*.

<sup>9</sup> That a mere delay in suing an infringer may work an estoppel in equity,

see §§ 1114, 1194, 1195, and notes, *post*.

<sup>10</sup> That in the absence of a Statute of Limitations a delay in suing an infringer does not work an estoppel, unless the conduct of the patentee is equivalent to an abandonment of the invention to the public, see *Ransom v. Mayor of New York* (1856), 1 Fisher, 252.

<sup>11</sup> That the bringing a suit against one infringer is, in equity, notice to all



a transferor or transferee of any interest in a patented invention is also ground for an estoppel in a court of law, in any case where the transferor is plaintiff, and in his suit he must attack either the existence or validity of the transfer he has made.<sup>12</sup>

**§ 982. Twenty-Fourth Defence: Release.**

The twenty-fourth defence consists in an averment that the cause of action formerly existing in favor of the plaintiff against the defendant has been voluntarily extinguished by the plaintiff. A cause of action arising from the infringement of a patent may be destroyed by the owner of the patent in either of two methods: (1) By a surrender of the patent to the government, which terminates alike the existence of the patent and all rights of action based thereon; or, (2) By a release to the infringer, which terminates the cause of action but does not affect the existence of the patent. As the present defence does not attack the validity or existence of the patent, but the cause of action only, it is proper in the single case where the owner of the patent, subsequently to the infringement, has expressly or impliedly released the infringer from his liability therefor.<sup>1</sup> Such a release may be in writing under seal, or may arise by presumption of law out of other transactions between the parties.<sup>2</sup> The releasor must have had the legal right to grant it, and the defendant must have received it in good faith

others of their liability, and prevents an estoppel by laches, see § 1114 and notes, *post*.

<sup>12</sup> That a transferor is estopped to deny the validity of the patent or the rights of his transferee, see *Birdsall v. Curran* (1887), 31 Fed. Rep. 918; 42 O. G. 1167; *American Paper Barrel Co. v. Laraway* (1886), 28 Fed. Rep. 141; 37 O. G. 674; *Alabastine Co. v. Payne* (1886), 27 Fed. Rep. 559; 35 O. G. 1438; *Parker v. McKee* (1885), 32 O. G. 137; 24 Fed. Rep. 808; *Underwood v. Warren* (1884), 21 Fed. Rep. 573; *Thomas v. Quintard* (1855), 5 Duer, 80; and §§ 787, 789, and notes, *ante*.

That a plaintiff cannot deny the ex-

istence of a corporation through which he derived title, see *Bogart v. Hinds* (1885), 33 O. G. 1268; 25 Fed. Rep. 484.

§ 982. <sup>1</sup> That a release is a good defence to an action for infringement, see *Goodyear v. McBurney* (1853), 3 Blatch. 32.

That a written release under seal of one of two joint infringers is a bar to a suit against the other, though he may still be enjoined from further infringements, see *Babcock & Wilcox Co. v. Pioneer Iron Works* (1888), 43 O. G. 756.

<sup>2</sup> That a release may be implied from circumstances, see 2 Pars. Cont. 715.

and not in fraud of other owners of the patented invention; and if it were conditional, such conditions must have been fulfilled.<sup>3</sup> A plaintiff having given a valid release to the defendant is bound by it, not only as a contract relinquishing his former cause of action, but as an estoppel which prevents him from pursuing any remedy thereon.<sup>4</sup>

§ 983. **Twenty-fifth Defence : Res Adjudicata.**

The twenty-fifth defence consists in an averment that whatever cause of action may have once subsisted in favor of the plaintiff against the defendant, it has now been merged in, or extinguished by, a lawful judgment. The doctrine of *res adjudicata* is fully applicable to cases of infringement. The recovery of a judgment by the plaintiff against the defendant for a given act of infringement changes the character of the plaintiff's claim from tort to contract, and when the judgment has been satisfied destroys it altogether. This defence is, therefore, proper when a second suit is instituted between the same parties on an infringement for which the plaintiff has already recovered a judgment against the defendant.<sup>1</sup> A judg-

<sup>3</sup> That no release is valid unless the releasor had at the time the legal right to grant it, see *Goodyear v. McBurney* (1853), 3 Blatch. 32.

That where in a suit by a patentee on behalf of a licensee the defendant sets up a release from the patentee, it will not avail him if the license was granted before the release, and this fact will be sufficient upon replication, see *Goodyear v. McBurney* (1853), 3 Blatch. 32.

That a fraudulent release is invalid, see 2 Pars. Cont. 715.

That an infringer, taking a release from one owner of a patent, receives it with notice of, and subject to, the equities of the other owners, see *Kearney v. Lehigh Valley R. R. Co.* (1886), 27 Fed. Rep. 699.

That a conditional release is no defence unless the conditions have been performed, see 2 Pars. Cont. 714.

<sup>4</sup> That a release destroys the cause

of action and prevents the application of the remedy, see 2 Pars. Cont. 713.

§ 983. <sup>1</sup> That a former recovery is a bar to a new suit for the same cause of action, see *Lyon v. Perin & Gaff Mfg. Co.* (1888), 43 O. G. 983; *Puetz v. Bransford*, (1887), 41 O. G. 353; 32 Fed. Rep. 318; *Cromwell v. County of Sac* (1876), 94 U. S. 351.

For the effect of a recovery against one joint infringer, see § 948, note 3, *ante*.

That the wrongful sale of an invention is a tort for which the plaintiff can recover in a tort action, or by waiving the tort in assumpsit for the price received; and in the latter case no one could at any time be sued, if recovery were once had against the seller, see *Steam Stone Cutter Co. v. Sheldons* (1883), 15 Fed. Rep. 608; 24 O. G. 703; 21 Blatch. 260.

That a recovery from a maker is no



ment in favor of the defendant in a suit for an infringement is equally conclusive on the rights of the parties, and estops the plaintiff from any subsequent assertion of his claim.<sup>2</sup> The judgments in both these cases must have been final judgments, rendered on the merits, and covering the same issue of infringement.<sup>3</sup> Interlocutory decisions and judgments in

defence to the vendee unless the judgment against the maker has been satisfied, and included the article sold to the vendee, and a plea not alleging such satisfaction discloses no defence, see *Fisher v. Consolidated Amador Mine* (1885), 25 Fed. Rep. 201 ; 11 Sawyer, 190.

That a judgment and payment of nominal damages by one defendant, in a suit brought by the patentee without joining his licensee, for making and selling one machine are no bar to a suit by the patentee and licensee, for the benefit of the licensee, against the vendee of such defendant for using the same machine, see *Birdsell v. Shaliol* (1884), 112 U. S. 485 ; 30 O. G. 261.

<sup>2</sup> That a decree of invalidity in the Federal courts is conclusive on the parties, see *Hawks v. Swett* (1875), 4 Hun, 146 ; 6 Thomp. & C. 529.

That a former judgment on the same title may be a bar if specially pleaded, though some of the parties are different, see *Richardson v. Lockwood* (1870), 4 Clifford, 128.

That a final decision in an interference is conclusive between the parties until reversed or affected by equity proceedings under Sec. 4915, Rev. Stat., see *Peck v. Collins* (1877), 70 N. Y. 376.

That a decree by consent on an issue of title is *res adjudicata* as to all the parties, see *Tomkinson v. Willets Mfg. Co.* (1884), 31 O. G. 918 ; 23 Fed. Rep. 895 ; 32 O. G. 382 ; *Ex parte Pentlarge* (1879), 17 Blatch. 306 ; 4 Bann. & A. 607.

That a decree by consent in a former

suit between the plaintiff's assignor and the present defendant is *res adjudicata*, see *United States Metallic Packing Co. v. Tripp* (1887), 39 O. G. 1554 ; 31 Fed. Rep. 350.

That a judgment works an estoppel only as to the matters controverted and decided, see *Steam Gauge & Lantern Co. v. Meyrose* (1886), 36 O. G. 1477 ; 27 Fed. Rep. 213.

That the judgment of a State court as to the contract relations of the parties is not *res adjudicata* on questions of title in the Federal courts, see *Oliver v. Rumsford Chemical Works* (1883), 109 U. S. 75 ; 25 O. G. 784.

<sup>3</sup> That a judgment of non-infringement is no bar to another action between the same parties for a different infringing act, see *Steam Gauge & Lantern Co. v. Meyrose* (1886), 27 Fed. Rep. 213 ; 36 O. G. 1477.

That though the Supreme Court has decided that a machine does not infringe an original patent it may still be an infringement of the re-issue, see *Wells v. Jacques* (1874), 5 O. G. 364 ; 1 Bann. & A. 60.

That a judgment is not conclusive on a plaintiff in favor of a licensee under his victorious rival, when afterward sued by him, if the license were granted before the judgment was rendered, see *Ingersoll v. Jewett* (1879), 16 Blatch. 378 ; 4 Bann. & A. 361.

That a judgment between two patentees on the question of priority affects the title of the junior patentee, but a judgment that the senior patentee was not the first inventor of an invention not claimed by the junior patent, does not

collateral proceedings, although disposing of the suit then pending, do not fall within the reason or the definition of this doctrine, and cannot be available as a defence on the main issues of the suit.<sup>4</sup>

§ 984. Defendant may Employ all his Defences unless Estopped.

Any or all of the foregoing defences may be set up by the defendant in an action for infringement, unless he is himself estopped from urging them.<sup>1</sup> The defendant is bound by his prior conduct equally with the plaintiff, and is not permitted to assume positions inconsistent with those which he has previously occupied and on which the plaintiff has relied in the direction of his own affairs.<sup>2</sup> Thus a former owner of the patent, through whom the plaintiff's title was derived, cannot deny its validity when sued for its infringement, although it is

affect the latter patent, nor bar the senior from suing the licensee of the junior if the license were taken after the first suit was commenced, and with knowledge of its pendency, although the invention of the junior cannot be made without using that of the senior, see *Brush v. Naugatuck R. R. Co.* (1885), 24 Fed. Rep. 371; 23 Blatch. 277; 32 O. G. 894.

<sup>4</sup> That no action short of final judgment on the merits, can be pleaded in bar, see *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530.

That whether an interlocutory decree, *pro confesso*, followed by a release of profits, etc., is *res adjudicata* and an estoppel is doubtful, and being doubtful should not bind, see *Roemer v. Neumann* (1886), 26 Fed. Rep. 332.

That a suit dismissed for want of prosecution is no bar to another one for the same cause of action, see *American Diamond Rock Boring Co. v. Sheldon* (1879), 17 Blatch. 208; 4 Bann. & A. 551.

That the pendency of a suit in one district is no bar to a suit in another,

though a recovery may be, see *Wheeler v. McCormick* (1873), 4 O. G. 692; 6 Fisher, 551; 11 Blatch. 334.

See further as to *Res Adjudicata* in patent cases, §§ 1017, 1048, 1175-1184, and notes, *post*.

§ 984. <sup>1</sup> That the same defences are applicable to a patent granted on a renewed application, as if granted on an original one, see *Lindsay v. Stein* (1882), 10 Fed. Rep. 907; 21 O. G. 613; 20 Blatch. 370; *United States Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 11 O. G. 373; 14 Blatch. 94; 2 Bann. & A. 493.

<sup>2</sup> That a defendant is estopped from setting up his defence to the same extent that a plaintiff may be estopped from bringing his action, see 1 Chitty on Pleading, 603.

That one who knowingly permits another to take out a patent for an invention, and then himself takes a patent for a different invention, is estopped to claim that he was the inventor of the former invention, see *Fraim v. Keen* (1885), 34 O. G. 1048; 25 Fed. Rep. 820.



invalid as against all others.<sup>3</sup> A licensee cannot attack the existence of the patent, nor the exclusive privilege which it creates, unless he first repudiates his license, although he may deny that the invention he employs is identical with that which it protects.<sup>4</sup> A defendant, who, without authority, has extensively practised a patented invention, cannot allege in his defence that it has no utility, especially if he has proclaimed its value to the public.<sup>5</sup> A fraudulent patentee, who has procured his patent knowing or believing that the inven-

<sup>3</sup> That a patentee is estopped from denying the validity of the patent in a suit for infringement brought by his assignee, see *Underwood v. Warren* (1884), 21 Fed. Rep. 573; *Many v. Jagger* (1848), 1 Blatch. 372; and cases cited in § 981, note 12, *ante*.

That a patentee is estopped from denying the validity of the patent or its re-issues in a suit against him by his assignee, although the re-issues were granted after the assignment, and the assignee ought to have known that they were void, see *Burdsall v. Curran* (1887), 31 Fed. Rep. 918; 42 O. G. 1167.

That where a member of an infringing firm was formerly a part-owner of the patent he is estopped from denying its validity, unless he conveyed his interest to the plaintiff without consideration, see *Parker v. McKee* (1885), 32 O. G. 137.

That an assignor is estopped from purchasing a prior patent and setting it up against his assignee, see *Curran v. Burdsall* (1883), 27 O. G. 1319.

That a defendant is estopped by a decree by consent in a suit where he was defendant and the present plaintiff's assignor was plaintiff, see *United States Metallic Packing Co. v. Tripp* (1887), 39 O. G. 1554; 31 Fed. Rep. 350.

See also as to estoppel of assignor, §§ 787, 981, and notes, *ante*.

<sup>4</sup> That a licensee, having covenanted not to deny the validity of the patent or the licensor's title, cannot defend against

an action while the license is in force, except on the ground that the license is not exceeded, see *Pope Mfg. Co. v. Owsley* (1886), 27 Fed. Rep. 100; 37 O. G. 781.

That a licensee having repudiated the license may deny validity, see *Brown v. Lapham* (1886), 23 Blatch. 475; 37 O. G. 676; 27 Fed. Rep. 77.

That a licensee who has paid large license fees and built up an extensive business under cover of a patent, though not technically estopped from denying its validity, urges such defence with every presumption against him, and if the rest of the public have acquiesced in the patent, he must produce the strongest of proof against it, see *Hobbie v. Smith* (1886), 27 Fed. Rep. 656.

That a defendant who is treated in the bill as an ordinary infringer may avail himself of any defence open to infringers, though he is only a licensee, see *Pelham v. Edelmeyer* (1883), 15 Fed. Rep. 262; 25 O. G. 292; 21 Blatch. 188.

That if a plaintiff sues in infringement instead of for royalties, a purchaser from the licensee is not estopped to deny the validity of the patent, see *Baltimore Car-Wheel Co. v. North Baltimore Passenger R. R. Co.* (1884), 21 Fed. Rep. 47.

Also see § 820 and notes, *ante*, and §§ 1251, 1252, and notes, *post*.

<sup>5</sup> That a defendant who has used and advertised an invention as of great

tion was not patentable or that he was not its first and true inventor, cannot dispute the patentability of the invention when sued by a rival *bona fide* patentee, although it may be evident that this defence would prove successful on behalf of any other defendant.<sup>6</sup> A *bona fide* patentee, however, even when defeated on an interference, may afterward deny the patentability of the invention in a suit brought against him by his rival.<sup>7</sup> A defendant is not estopped from setting up the invalidity of the patent by the fact that he once owned an

value thereby admits its utility, see *Stanley v. Whipple* (1839), 2 McLean, 35 ; 2 Robb, 1.

That a defendant who infringes both the patent for the original and that for the improvement cannot set up the former as anticipating the latter, see *Cantrell v. Wallick* (1886), 117 U. S. 689 ; 35 O. G. 871.

<sup>6</sup> That one who has fraudulently endeavored to patent an invention is estopped from defending against a prior patent on the ground that the invention was then open to the public, see *Greenwood v. Bracher* (1880), 17 O. G. 1151 ; 1 Fed. Rep. 856 ; 5 Bann. & A. 302.

<sup>7</sup> In *Greenwood v. Bracher* (1880), 1 Fed. Rep. 856, Nixon, J.: (858) "A new question is thus presented, and one by no means unimportant. Will the court allow a patentee, who has lost his rights to the protection of the law in consequence of proof that his alleged invention was anticipated by others, to protect himself in the continued use of the patented improvements by showing that neither he nor the other party was the first inventor? In other words, whether the issuing of a patent estops the patentee from proving that the invention claimed therein is not novel. I think the answer depends entirely upon the fact whether the party has acted in good faith in the matter. Every one making application for letters-patent is obliged to file therewith

an oath that he believes himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, for which he solicits the patent. Sec. 4892 of Rev. Stat. This is often done honestly, and yet untruthfully, owing to the ignorance on the part of the applicant of the state of the art. I can perceive no satisfactory reason why any one should not be permitted, after he has discovered his mistake, to set up the defence of want of novelty against another party who claims an exclusive right to patented improvements which, in truth, belong to the public. But if one with a knowledge of the state of the arts surreptitiously attempts to appropriate to himself what he knows does not belong to him, he should be estopped when his fraud is found out, from interposing such a defence, especially against a person whom the Patent Office has decided, as against his claim, to be the original and first inventor." 17 O. G. 1151 (1151); 5 Bann. & A. 302 (304).

See also *Shuter v. Davis* (1883), 24 O. G. 303 ; 16 Fed. Rep. 564 ; *Smith v. Halkyard* (1883), 23 O. G. 1833 ; 13 Fed. Rep. 414.

That a defeated party to an interference, denying the novelty of the invention, must clearly prove it, if he had knowledge of the state of the art when he made his own application, see *Smith v. Halkyard* (1883), 16 Fed. Rep. 414 ; 23 O. G. 1833.



interest therein, if there is no privity of title between him and the plaintiff.<sup>8</sup> Nor can he be prevented from denying the identity between his own device and that protected by the patent by an agreement not to make the former, unless he also has conceded it to be the same in its essential characteristics as the latter.<sup>9</sup> When there are several defendants an estoppel operating against one does not bind the others, unless they are in privity with him in reference to the subject-matter to which the estoppel appertains.<sup>10</sup>

**§ 985. Separate Defences Allowed against Each Patent and Each Claim in Controversy.**

Where several patents constitute the basis of a single suit, each may be separately attacked by any of the methods of defence herein described.<sup>1</sup> A patent which embraces several Claims, whether for the same or different inventions, stands in this respect on the same ground as if each Claim were embodied in a separate patent; and every Claim is, therefore, open to all those defences which do not relate solely to the patent as a whole.<sup>2</sup> Re-issued patents, and patents granted on renewed applications, may be met with the same objections as to invalidity and the want of patentability in the invention

<sup>8</sup> That a defendant with whom there is no privity of title in the plaintiff is not estopped to deny the validity of the patent, see *Baltimore Car-Wheel Co. v. North Baltimore Passenger R. R. Co.* (1884), 21 Fed. Rep. 47.

<sup>9</sup> That a defendant agreeing not to manufacture a device is not estopped by the agreement unless that device is conceded to be identical with the one patented, see *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796.

<sup>10</sup> That a defendant is not estopped by the conduct or relations of other persons unless privity of title exists between them, see *Baltimore Car-Wheel Co. v. North Baltimore Passenger R. R. Co.* (1884), 21 Fed. Rep. 47.

That an estoppel by conduct is avail-

able at law, see *Concord v. Norton* (1883), 16 Fed. Rep. 477.

§ 985. <sup>1</sup> That each patent in suit may be made the subject of separate defences if the defendant so elects, see *Kelleher v. Darling* (1878), 4 Clifford, 424; 14 O. G. 673; 3 Bann. & A. 438; *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

That each patent in suit may be defended against on the grounds of prior invention and prior use, see *Parks v. Booth* (1880), 102 U. S. 96; 17 O. G. 1089.

<sup>2</sup> That some Claims of a patent may be infringed and not others, and each may be defended against, like a separate patent, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

as are admissible against original patents and patents granted on original applications.<sup>3</sup>

§ 986. **Forms of Pleading Required for These Defences, a Matter of Dispute.**

In reference to the form in which these various defences should be pleaded, the conflict of authorities appears irreconcilable, — some holding that the greater number may be urged under the general issue, others requiring for nearly all a notice or a special plea. Recurring to first principles for light upon this subject, it is evident that in an action on the case at common law the general issue was sufficient to cover all possible defences, the point in controversy being not whether a cause of action once existed in favor of the plaintiff, but whether at the time of pleading he ought in justice and good conscience to recover judgment against the defendant.<sup>1</sup> Under this issue such special matters of avoidance as a license, or release, or an accord and satisfaction, could be claimed and proved by the defendant.<sup>2</sup> Thus in an action for the infringement of a patent all the defences heretofore enumerated, except the Statute of Limitations, were admissible under the usual plea of not guilty, and the practice in the English courts in patent cases was in conformity with this position until the change in the rules of pleading in the 5 & 6 W. IV. (1833) and the special act regulating the pleas in patent causes of 6 W. IV. (1835).<sup>3</sup> By this change in the rules of pleading the scope of the general issue in an action on the case was limited to a denial of the wrongful act on which the suit was based, and any matter in bar or in avoidance of any other averment in the declaration must be made the subject of a special plea. By the special act referred to, the defendant in an action for infringement is required to file with his plea a notice of all objections on which

<sup>3</sup> That patents on renewed applications under the act of 1870, Sec. 35, are open to all defences, see § 984, note 1, *ante*.

§ 986. <sup>1</sup> Gould on Pleading, ch. vi. §§ 54, 55.

<sup>2</sup> Gould on Pleading, ch. vi. § 55.

<sup>3</sup> Thus Godson : (177) "The usual plea is *not* guilty, which, putting in issue the whole of the declaration, forces the plaintiff to support the grant in all its parts, and gives to the defendant the greatest latitude for evidence."



he intends to rely at the trial.<sup>4</sup> Thus under the English practice the mode of pleading in patent cases has always been clear and imperative, — before the change the general issue only, and since the change a special plea or notice for all defences, except the single one of non-infringement. At the time of the creation of our patent system, the common law mode of pleading prevailed also in this country. It remained unaffected by the changes introduced into the English practice, and in the absence of statutory provisions of our own would still permit the defendant to avail himself of all his defences under the general issue. In each of the principal acts of Congress on which our patent jurisprudence rests it has, however, been prescribed that the defendant shall set up certain of these defences only under a notice connected with the general issue, or, what the courts have uniformly regarded as its equivalent, under a special plea. The defences thus distinguished are few in number, and have not, in all the acts of Congress, been the same. Some of them are analogous to others not included in the words of this requirement, and suggest that if the former should be specially set forth, the latter should be also. Thence have arisen doubts and difficulties in our practice which can perhaps be removed only by a new act that, like the English statutes, shall cover the entire field of pleading. If any other solution of the questions can be reached, it must be by a careful scrutiny of the provisions out of which they have arisen, in view of the spirit and intent of the law in which they were incorporated.

#### § 987. Pleadings under the Act of 1790.

The first appearance of this requirement is in the patent act of 1790, the earliest enactment of Congress in reference

<sup>4</sup> Thus Coryton: (272) "Formerly in an action for infringement the defendant could plead only the general issue. To provide against the surprise which was constantly occurring from the ignorance in which parties were left as to the real point intended to be urged against them at the trial, it is now required (Stat. 5 & 6 Will. IV.) that the

plaintiff in an action for infringement shall deliver, with his declaration, particulars of the breaches he complains of. Similarly, the defendant to the action . . . must deliver with his pleas, . . . the particulars of the objections he is prepared to urge to the validity of the patent. No evidence is admissible in these respects on the trial which is not

to patents for inventions. The structure of this act is peculiar, but it is clearly consistent with itself; and each of its provisions if interpreted in connection with the others is appropriate and intelligible. The first section provides for the granting of a patent to the inventor of a new art or article upon his petition therefor, if the officers of the government deem the invention sufficiently useful and important. The second section requires the patentee to file with the Secretary of State, at the time of the granting of the patent, a written specification, with drawings and a model when admissible, sufficiently complete and exact to distinguish the invention from all other matters before known and to enable a person skilled in the art to practise the invention, to the end that the public may have the full benefit thereof after the expiration of the patent. The fourth section prohibits all other persons from employing the patented invention without the written permission of the owner of the patent under penalty of forfeiting such a sum of money as a jury might assess as damages, and also the thing made, used, or sold in violation of the patent, to be recovered in an action on the case based on the statute. The sixth section provides that in all such actions the patent and specification shall be *prima facie* evidence that the patentee was the true and first inventor of the invention therein described, and that the description given was correct; but that nevertheless the defendant might plead the general issue and give the statute in evidence, and also, upon due notice to the plaintiff, any other special matter tending to prove that the specification, by the concealment of part of the invention or the addition of more than was necessary to produce the effect described, was intended to mislead the public, or did so mislead them that the effect described could not be produced by the means specified, and that if this fact were established by the proof the defendant should prevail.<sup>1</sup> The

contained in such particulars." These particulars are notices, not pleadings, and form no part of the record. See p. 276.

§ 987. <sup>1</sup> Particular importance attaches to the fact that according to this act of 1790, the defendant might give

the statute itself in evidence under the general issue. As the validity of the patent, the title of the patentee, and the liability of the defendant, were all dependent upon this statute, this provision set the whole case at issue under this common law plea, with the



extent of the departure of this statute from the common law and the English practice is at once perceptible. At common law the remedy for an infringement was an action on the case for compensatory damages merely, the general issue was a sufficient plea to put the plaintiff upon proof of all the facts on which his right to a recovery was based, and this proof must consist of testimony outside of the patent, upon all points except those of the issue of the patent and the title of the patentee. By our act of 1790 the remedy was an action on the statute for the recovery not only of damages but of one or more articles of personal property; the general issue did not permit the defendant to attack the sufficiency of the disclosure of the invention to the public without a notice to the plaintiff; and the patent was made *prima facie* evidence that the patentee was entitled to a patent and had complied with all the conditions imposed upon him by the law. Passing the first divergence as throwing no light on this question, since the form of action was still trespass on the case, it must be noticed that the other two departures do not affect the rules of pleading, but the rules of evidence. The statute did not require any other plea than the general issue, whatever defence the infringer might desire to present, following in this respect the common law; but it prohibited him from making one particular defence under the general issue unless he previously notified the plaintiff of his intention so to do. This notice has never been regarded as a plea.<sup>2</sup> Our courts have held that a special plea, setting up the same matters and served under the same conditions, might be substituted for the notice; but the notice itself, when given, formed no part of the pleadings in the action, was served upon the plaintiff instead of being filed in court, and has uniformly been considered as fulfilling its purpose when it put the plaintiff on his guard concerning the nature of the proposed attack upon his patent. Regarded simply as changes in the rules of evidence, the

single exception of the claim of concealment or redundancy in the description of the invention, which could not be made without a special notice. See *Corning v. Burden* (1853), 15 How. 252.

<sup>2</sup> That the notice of special matter is not a plea, see *Cottier v. Stimson* (1884), 20 Fed. Rep. 906; 10 Sawyer, 212.

effect of these two departures from the common law is obvious. To the validity of a patent three things were necessary: that the invention should be patentable; that the patentee should be its first and true inventor; that he should place his invention fully within the knowledge of the public. Under the common law the burden of proof rested upon the plaintiff, notwithstanding his patent, as to each of these essential conditions; and the defendant was at liberty to controvert either or all of them without other notice to the plaintiff than was implied in his plea of not guilty. Our statute made the patent itself *prima facie* evidence of these three facts. It left the defendant free to dispute the first two under the general issue without previous notice to the plaintiff, but required him to give such notice if he desired under that issue to avail himself of a denial of the third. The entire effect of these changes was, therefore, the introduction into our law of the doctrine that the grant of the patent raises a presumption of its validity which will prevail unless rebutted by opposing evidence, and the establishment of the rule that no opposing evidence shall be offered in reference to the sufficiency of the disclosure, unless the plaintiff has been forewarned that such an attack upon his patent will be made. The reason for requiring a notice upon this particular point and not upon the others readily suggests itself. The patentability of the invention and its original production by the patentee are indispensable conditions of his right to any patent whatever. They are facts which the patentee affirms by applying for the patent, and which he must at all times be ready to establish when his right to the patent is attacked. They are also existing and unalterable facts, not depending on human judgment nor subject to the tests of human insight and comprehension, but supported or denied by the positive, direct, and permanent evidence of the human senses. When our statute made the patent *prima facie* evidence of these facts, and threw upon the defendant the duty of opening the controversy concerning them, it was not deemed important to compel him to inform the plaintiff that he intended to deny what the plaintiff must have expected to become the subject of attack as the defendant's only mode of justifying his own



practice of the patented invention; and the act, therefore, permitted the defendant to make these defences in the same manner as at common law. The third condition was of a wholly different character. A failure to fulfil this condition did not affect the true inventor's right to a patent, but merely the validity of the patent which he had received, and though before the amendment of a patent was allowed the practical result to the patentee was the same as in the other cases, the difference between them in principle and in theory was fundamental. Justice then as now required that this difference should be recognized in jurisprudence, and that defects in statement, if not intended to deceive, should not invoke the same disastrous consequences to the patentee as want of patentability in the invention or the anticipation of his inventive act by that of a prior rival inventor. The fulfilment of this condition was also a fact which could not be evidenced by ordinary proof, but which must have been tested by human judgment and determined by experience. Until the specification was published and submitted to those skilled in the art, the patentee himself could not have known whether his disclosure was sufficient, and if it was intended to be a complete and exact description of his invention, he might safely assume it to be such until the contrary was alleged. To require him to be prepared at all times to meet attack on this ground would compel him to keep himself informed of the extent to which those skilled in the art had endeavored to practise the patented invention and of their success or failure in the attempt, and thus impose upon him a burden productive of no other benefit to himself than the ability to prove the sufficiency of his specification if it should ever chance to be denied. It was, therefore, with the utmost propriety that our law relieved the patentee from the necessity of investigating and accumulating evidence upon this point until notified by a defendant that such a denial would be made. The effect of the first Patent Act of the United States upon the rules of pleading and of evidence is evidently this: that the general issue still remained, as at common law, the proper plea in all cases without reference to the nature of the defence, but that in order to introduce testimony showing the insufficiency of

the specification, whether fraudulent or unintentional, the defendant must have previously notified the plaintiff and have thus afforded him an opportunity to prepare to sustain it.

§ 988. Pleadings under the Act of 1793.

The act of 1793, which superseded that of 1790, carried still further these alterations in the law. It changed the measure of damages to be recovered by the plaintiff, but left the form and statutory basis of the action undisturbed. In reference to the pleadings, it employed the same language as the prior act, but increased the number of defences upon which the defendant was forbidden to offer evidence without a previous notice to the plaintiff. It omitted the provision that the patent should be *prima facie* evidence of the right of the patentee to the patent and of the sufficiency of the description, and inserted a requirement that the patentee, before the patent issued, should make oath that he believed himself to be the first and true inventor of the art or article described. And it extended the effect of a judgment for the defendant upon any of the defences of which it required previous notice, so that not only was the defendant relieved from liability, but the patent itself was declared void. These changes indicate a different spirit and intention in the law from that embodied in the act of 1790. No attempt is made to modify the rules of pleading, the general issue being evidently deemed the proper mode of introducing all defences upon which an alleged infringer can rely. But an endeavor was apparent to make a suit for infringement serve a double purpose, — to vindicate the rights of the patentee if the patent were valid, and to operate as a repeal of the patent if it were void. To meet this latter object the rules of evidence were radically changed. The plaintiff was relegated to his common-law position in reference to the mode of proving his case, the patent being no longer *prima facie* evidence in his favor, and was compelled to assume the burden upon all defences except those on which the repeal or confirmation of his patent was to turn. Of these last defences there were four: a fraudulent specification; prior use; prior publication; and a surreptitious



patent obtained for the discovery of another person. Of these the defendant was required to give notice thirty days before the trial if he desired to offer evidence thereon either for his own deliverance or in the effort to destroy the patent. The reasons of the legislature for selecting these four as the grounds on which a judgment of repeal might be awarded are easily discerned. In a fraudulent specification the attempt to deceive the public is the real defect, and this attempt forfeits the right of the inventor to protection, however meritorious in other respects he may have been. The surreptitious application for, and reception of, a patent for another's invention is also an act which, if not wilfully fraudulent, has the effect of fraud and cannot be sustained or permitted to result in injury to the true inventor or the public by casting a cloud upon the title of the one, or unduly limiting the privileges of the other. An invention which has been in actual use or has been described in a public work before the patentee invented it is certainly not new and original with him, and independently of all other questions as to its patentability cannot become the subject-matter of a valid patent in his favor. These are defects necessarily fatal. They are proved, if provable at all, by clear and direct testimony as to past conditions and transactions. And if the attempt to introduce this new feature of repeal into a suit for infringement was practicable and expedient, the selection of these grounds for it and of this mode of procedure was commendable. But the provisions made for this purpose are not to be confounded with those existing in the act of 1790, where the sole object was to regulate the private controversy between the plaintiff and defendant, nor with those of later statutes which do not contemplate a judgment affecting the existence of the patent.<sup>1</sup>

§ 988. <sup>1</sup> In *Grant v. Raymond* (1832), 6 Peters, 218, Marshall, C. J., clearly recognizes this great distinction between the acts of 1790 and 1793, and refers to the failure of the courts to separate the two purposes which the latter act was intended to accomplish.

In *Kneass v. Schuylkill Bank*, (1820)

4 Wash. 9, the defendant pleaded the general issue without notice. The attention of the court was particularly directed to the provisions of the act of 1793, now under discussion, and the case was argued by distinguished counsel. The following questions were treated as matters of fact to be decided

§ 989. Pleadings under the Act of 1836.

The act of 1836 returned to the purpose and, to a great extent, to the methods of the act of 1790. The attempt to combine proceedings in repeal with an action for infringement was abandoned, and the defendant was permitted only to urge objections in his own behalf. The rules of pleading remained unchanged, and the general issue was allowed to cover every defence which the defendant might desire to raise against the several averments of the declaration, although a notice to the plaintiff was required when evidence on certain subjects was to be presented. In view of the fact that the alterations in the English practice, confining the general issue in all actions on the case to a denial of the wrongful act alleged and compelling the defendant to plead specially all other defences, were introduced three years before the passage of this statute, and that the Act 5 & 6 W. IV., providing that in all suits for infringement the defendant must file with his plea a particular statement of all the defences on which he purposed to rely, took effect only the year before, of both which changes in the English law Congress must be presumed to have had knowledge, the repetition in our statute of the common law rule of pleading is of the highest significance.<sup>1</sup> If it had not been the intention of Congress that the general issue should retain its ancient

under the pleadings: Whether the alleged invention belonged to either of the patentable classes; whether it possessed utility; whether it was a means or an effect; whether the specification so disclosed the invention as to enable persons skilled in the art to practise it. The learned judge also stated that under the general issue other questions might be determined, instancing the absence of a specification; that the patent is broader than the discovery; that the improvement is not distinguished from the original; that the patent does not contain the necessary recitals, etc. He further says that evidence of special matter cannot be given other than such as is particularly mentioned "unless it can be admitted upon general principles

of law, as included in the general issue," thus recognizing the general issue in patent cases as equally comprehensive with the same plea in other cases, except when coupled with the requirement of notice.

That Sec. 6, act of 1793, as to notice, does not include all defences which the defendant may make, see *Evans v. Hettick* (1822), 7 Wheaton, 453; 1 Robb, 417.

That on a general issue without notice the defendant cannot give in evidence any of the matters named in Sec. 6, act of 1793, see *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9; 1 Robb, 303.

§ 989. <sup>1</sup> See 1 Chitty on Pleading, 512.



comprehensiveness, it would certainly have been restricted by this statute, and other modes have been provided for the assertion of special matters in avoidance or in bar. The section of the act of 1836 which prescribes the mode of pleading and notice, therefore, so far from extending the defendant's common law rights of defence, imposes upon them a limitation, not affecting his right to plead but his right to offer evidence of a certain character under his plea, and restricts the latter right by making previous notice a condition of its exercise. The correctness of this interpretation of that section is established by the decisions of the courts concerning the propriety and method of substituting a special plea for the notice thus required. Such substitution is regarded as legitimate, provided the plea possesses the necessary attributes of the notice as to completeness of statement and time and mode of service, but not otherwise, — showing conclusively that it is not only as a plea putting matters in issue, but as a notice warning the plaintiff of the objections to be urged against his patent, that even a special plea must be employed. Thus there can be no doubt that the same practice prescribed by the act of 1790 in relation to the pleadings was revived and confirmed by the act of 1836. The changes in the rules of evidence consisted in an increase in the number, and some modification in the character, of the defences of which notice was required. Under the act of 1836 these were: a fraudulent specification; prior invention by another than the patentee; prior publication; abandonment by public use or sale; a surreptitious patent obtained for the invention of another; the failure of an alien patentee to put his patented invention on the market. None of these defences were identical with that of insufficient specification, for which a notice was essential under the act of 1790. Those mentioned in the act of 1793, however, are all represented, — prior invention covering the defence of prior use; and two are added, — abandonment by public use or sale, and the misconduct of an alien patentee in withholding his invention from the public. The reasons for retaining the four earlier defences under this rule are the same as those which made it proper in the first place to include them in its operation. The extension of the rule to the two additional

defences was equally justifiable. Both these defences were forms of abandonment. The public use or sale of the invention with the knowledge and consent of the inventor before his application for a patent destroyed his right to obtain a patent, and if he had obtained it rendered the patent void. The neglect of an alien patentee to put his invention into the hands of the public, within the period then limited by law, in the same manner forfeited his right to the patent and rendered the patent void. And as the law in all cases presumed against abandonment and permitted the patentee to rely on that presumption, it consistently required a defendant, who purposed to set up in his defence facts which the law regarded as conclusive evidence of an abandonment, to give the plaintiff a fair opportunity to meet and overthrow them.

**§ 990. Pleadings under the Act of 1870 and the Revised Statutes.**

The act of 1870, in the paragraph now forming Section 4920 of the Revised Statutes, repeats the provisions of the act of 1836 with even greater clearness and precision. It enacts that in any action for infringement the defendant may plead the general issue, and having given the required notice, may prove on trial any one or more of certain special matters.<sup>1</sup> There are but two ways of construing this enactment. Either it means that under the general issue the defendant may make all his defences as at common law, but that in reference to some he must give notice to the plaintiff as a condition precedent to offering evidence thereon, or it means that under the general issue he can make no defence except those of which notice is required. The latter interpretation is, of course, absurd.<sup>2</sup> The former harmonizes with all preceding statutes and with the doctrine and the practice under the common law, and hence must be the correct statement of the rule. The special matters of which notice is essential under this act are

§ 990. <sup>1</sup> That a defendant, upon filing the statutory notice, may give the special defences named in the act in evidence under the general issue, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

<sup>2</sup> Such a rule would forbid the defence of non-infringement, except under a special plea.



the same in substance as those mentioned in the act of 1836. To prior publication, prior patent is added as being a defence of the same nature and included in the spirit of the former. Abandonment by public use or sale is extended to embrace all modes of dedication to the public, and the failure of an alien patentee to practise his invention is omitted, that duty being no longer imposed on him by law.

**§ 991. Summary of the Law concerning Pleadings in Actions for Infringement from 1790 to 1874.**

As the result of this investigation and comparison of the various provisions of our Patent Laws concerning the form in which the defendant may present his different defences, the following propositions may be stated: (1) That no attempt has ever been made by Congress to change the rules of pleading in actions for infringement as they stood at common law when our patent system was inaugurated in 1790; (2) That at that period, and ever since, the general issue has been the proper form of pleading as to all defences which deny the existence of the plaintiff's right of action at the date of the filing of the plea; (3) That the rule requiring notice when certain defences are to be presented is a rule of evidence, intended not to provide a mode of raising issues but to protect the plaintiff against surprise; (4) That this rule has been and must be varied from time to time, as justice to the plaintiff may demand, but that such variations do not affect the attitude of either party before the court, or change the burden of proof, or impose any other obligation or disability upon the defendant than is contained in the simple duty of giving the prescribed notice to the plaintiff.

**§ 992. General Issue, with or without Notice, a Sufficient Plea in all Defences except the Statute of Limitations.**

Applying these propositions to the solution of the question now under consideration, it will be evident that the general issue is a sufficient plea for all defences which deny the existence of a cause of action in the plaintiff. Every defence which puts in issue any averment of the declaration comes within this description, whether it controverts the patent-

bility of the invention, or the right of the patentee to the monopoly, or the existence or validity of the patent, or the title of the plaintiff, or the practice of the invention by the defendant without due authority. Every defence which, admitting the former existence of a cause of action, claims that it has been extinguished either by release or by estoppel or by a former judgment belongs in the same class.<sup>1</sup> The only remaining defence is that of the Statute of Limitations which recognizes a subsisting cause of action, but avers that by his laches the plaintiff has lost the right to any legal remedy. This defence requires a special plea.<sup>2</sup> But while the general issue is permitted in the foregoing cases it is not incumbent on the defendant to employ it. He may plead specially any or all of his defences except that which denies his performance of the infringing act, and this is always his proper course when he desires to tender a specific issue to be simply traversed by the plaintiff.<sup>3</sup> If in such special plea he sets up any fact of which notice to the plaintiff is required, the plea must not only be duly filed, as a plea, but served on the plaintiff as a notice in the mode provided by the statute.<sup>4</sup> The same matter cannot be presented both in a special plea and by a notice under the general issue.<sup>5</sup> When the defendant pleads

§ 992. <sup>1</sup> Gould on Pleading, ch. vi. § 55.

<sup>2</sup> That the Statute of Limitations must be specially pleaded at common law, see 1 Chitty on Pleading, 479.

<sup>3</sup> For a discussion of the relation of special pleas to the general issue, see *Hubbell v. De Land* (1882), 14 Fed. Rep. 471; 11 Bissell, 382; 22 O. G. 1883.

That the five special defences under Sec. 4920, Rev. Stat., may be made by special pleas with the general issue, and that other defences may be pleaded specially, with or without the general issue, see *Cottier v. Stimson* (1883), 9 Sawyer, 435; 18 Fed. Rep. 689.

That matter may be shown in special pleas or in the general issue with notice, see *Root v. Ball* (1846), 4 McLean, 177; 2 Robb, 513.

That the defendant may plead specially matters which are proper under the general issue, see *Day v. New England Car-Spring Co.* (1854), 3 Blatch. 179.

That the general issue with special plea of license, but no notice of special matter, is a good plea, see *Day v. New England Car-Spring Co.* (1854), 3 Blatch. 179.

That matters not admissible under a general issue and notice may be specially pleaded, see *Wilder v. Gayler* (1850), 1 Blatch. 597.

<sup>4</sup> That where the special plea covers matter of which notice is required, it must be served like a notice, see *Cottier v. Stimson* (1884), 20 Fed. Rep. 906; 10 Sawyer, 212.

<sup>5</sup> That the defendant cannot plead the general issue with notice and set up the same matter in a special plea in bar,



the general issue, whether with or without a notice, the plaintiff closes the pleadings with a *similiter*. If the defendant pleads specially, the plaintiff may either demur or traverse, or reply with new matter, as in other common-law actions, and thence the pleadings may proceed until an issue of law or fact is reached.<sup>6</sup>

see *Read v. Miller* (1867), 3 Fisher, 310; 2 Bissell, 12.

<sup>6</sup> This question of pleadings is further complicated by Sec. 914, Rev. Stat., which provides that "the practice, pleadings, and forms and mode of proceeding in civil causes other than equity and admiralty causes, in the circuit and district courts, shall conform, as near as may be, to the practice, pleadings, and forms and modes of proceeding existing at the time in like causes in the courts of record of the State within which such circuit or district courts are held," etc. It has been claimed and decided that this provision applies to patent cases as well as others, see *Celluloid Mfg. Co. v. American Zylonite Co.* (1888), 34 Fed. Rep. 744; *Hayden v. Oriental Mills* (1883), 15 Fed. Rep. 605; 24 O. G. 601; *Cottier v. Stimson* (1883), 9 Sawyer, 435; 18 Fed. Rep. 689.

The reasons against this position are numerous and forcible. In the first place, the language of the rule does not include patent causes. It prescribes the adoption of local practice and procedure only so far as it exists *in like causes* in the State tribunals. Now, there are no *like causes* in reference to cases arising under the Patent Laws. In these cases the right, the wrong, and the remedy are *sui generis*, and require, as they have always had, a proceeding equally peculiar, which has ever been recognized as properly prescribed by Federal law alone.

In the second place, the complete destruction of that uniformity of procedure which is so essential to the de-

velopment of Patent Law must inevitably follow upon this application of the rule. That development depends largely upon the existence in this country of a body of trained patent lawyers, whose practice is unlimited by State boundaries, and whose learning, experience, and wisdom are thus rendered advantageous to the whole nation. The imposition upon this body of lawyers of the duty of acquainting themselves with the local practice of each State, and of changing their own methods as they pass from one area of conflict to another, can only be justified by greater necessities and clearer statutory enactments than have thus far appeared.

In the third place, this position contradicts the specific requirements of the Patent Law itself. Sec. 4919, Rev. Stat., expressly provides that the action at law for infringement shall be an action on the case. Sec. 4920, bestows on the defendant the privilege of pleading the general issue, *i. e.*, the *common law* general issue. As these sections are of equal authority with Sec. 914, all must be construed together, and no construction, saving all, is possible, except that which excludes patent cases from the operation of Sec. 914.

In the fourth place, it has been repeatedly decided that Sec. 914 does not apply to cases where Congress has legislated, nor include constructions placed upon common law remedies in the State courts, nor repeal by implication any previous act of Congress, providing a particular mode of proceeding. (See *Desty*, pp. 499, 500.) Hence it

**§ 993. General Issue : when Notice also Required.**

When the defendant pleads the general issue, he must also give a written notice to the plaintiff in any case where he desires to offer evidence tending to prove either of the five following states of fact: (1) That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; (2) That the patentee had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; (3) That the invention had been patented or described in some printed publication prior to his supposed invention or discovery thereof; (4) That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; (5) That the invention had been in public use or on sale in this country for more than two years before his application for a patent or had been abandoned to the public.<sup>1</sup> The relation of these states of fact to the defences already enumerated demands attention in order that the cases in which notice is required may be more easily distinguished.

**§ 994. Notice Required where the Defence rests on an Alleged Fraudulent Specification.**

The first of these states of fact is identical with that which constitutes the eleventh defence. It exists where the specification actually misleads the public, and was intended so to

is evident that so far as the substance of the proceedings in actions at law for infringement are concerned, the Federal statutes and the common law rules of pleading, as recognized in these statutes, still form the guide of the pleader and the court, however widely the local customs may lead to a departure in minor matters not relative to the essence of the cause.

The foregoing reasons, though not

all that might be urged, are at least sufficient to warrant a dissent from the position taken in the cases first cited, until a higher authority endorses it, or it is fully accepted and acted on by the profession at large.

See also *Read v. Miller* (1867), 3 Fisher, 310; 2 Bissell, 12; *Goodyear v. Providence Rubber Co.* (1864), 2 Fisher, 499; 2 Clifford, 351.

§ 993. <sup>1</sup> Sec. 4920, Rev. Stat.



do, by concealing some essential part of the invention, or by declaring some superfluous action or device to be necessary to its successful operation. A merely insufficient specification, as distinguished from a fraudulent one, although it fails to put the invention into the possession of the public, is not embraced in this state of facts, and may, therefore, be urged as a defence under the general issue without notice.<sup>1</sup>

**§ 995. Notice Required where the Defence rests on the Allegation that the Patentee or his Assignor is not a True Inventor or was not the First Inventor.**

The second state of facts is of less definite limitations, and whether it embraces the second defence only, or the third defence only, or both defences, is rendered doubtful by the variations which have taken place in the language of the statutes in reference to these defences. The act of 1793 required a notice where the invention was not originally discovered by the patentee but had been in use anterior to his supposed discovery; and under this provision it was held that evidence of any practical use, however slight and temporary, was sufficient to sustain this defence and defeat the patent. As the inventive act of the true discoverer could not be complete without such practical use, and as at that time the idea that diligence in reduction to practice causes the complete inventive act to relate back to the time of conception had not been incorporated into our law, it would appear that this clause of the act of 1793 referred to cases of prior rival invention, and prescribed a notice whenever the defendant, though conceding that the plaintiff was a true inventor, desired to show that he had been anticipated in his discovery by the previous performance of an entire inventive act. Then followed the clause requiring notice of the defence that the patentee had surreptitiously obtained a patent for the discovery of another person. This could not be interpreted as a

§ 994. <sup>1</sup> That no notice need be given where the defence rests on a merely defective but not fraudulent specification, see *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9; 1 Robb, 303.

That whether a defective but not fraudulent specification is a defence, see § 970 and notes, *ante*.

mere repetition of the preceding proposition. The language was widely different. It spoke of a surreptitious or fraudulent act by which the discovery of another was appropriated to the patentee. In view of its connection, as well as phraseology, this clause could, therefore, refer only to a case where an imitator had obtained a monopoly for the results of another's inventive skill. In passing from the act of 1793 to the act of 1836 these clauses were materially changed, and the radical distinctions between these two cases were obscured. The interim had witnessed the development of the doctrine that the first inventor, if diligent in reduction, was the rightful patentee, although prior to his reduction a later conceiver had completed his inventive act; and frequent cases had made it evident that proof of prior conception on the part of another than the patentee was essential to sustain either the second or the third defence. As the law then stood, according to the decisions, an imitator, who had appropriated the conception of another, and a true inventor, who had himself conceived the principle of the invention after another had conceived it and while that other was using reasonable diligence in reduction, were equally unable to obtain a patent or to vindicate it if obtained. The act of 1836 in one clause required a notice that "the patentee was not the original and first inventor or discoverer;" and in a separate clause "that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another who was using reasonable diligence in adapting and perfecting the same." If the latter clause had stood alone, and if the words "surreptitiously," etc., had not led the mind back to the provisions of the act of 1793, no doubt would have arisen but that this clause referred entirely to cases where a later but true conceiver had procured a patent, although another inventor by a prior conception and a diligent but subsequent reduction was the party actually entitled thereto; while the former clause referred to cases where the defendant claimed that the patentee was anticipated as to the entire inventive act, including both conception and reduction, by his rival,<sup>1</sup> and to cases where

§ 995. <sup>1</sup> To a correct understanding of relations of rival inventors to each other, this discussion, a clear recollection of the under the law, is essential. Rival in-



a mere imitator who of course could not be "the original and first discoverer" had obtained a patent; thus giving to these clauses, taken together, a construction covering all cases in which the patentee was alleged to be no inventor, or not the first to complete the inventive act, or not the first to conceive the idea of the invention. If this be the correct interpretation of the statute, as it probably is, the change which distinguishes the act of 1836 from that of 1793 consists in the transfer of the words "surreptitiously," etc., from the imitation of another's discovery to the wrongful appropriation by a subsequent inventor of that which had been previously

inventors may assume toward each other three distinct attitudes. The first conceiver may reduce to practice before reduction by the second conceiver; in which case the first conceiver is the only inventor whom the law can under any circumstances recognize. Or the second conceiver may reduce to practice before reduction by the first conceiver, although the first conceiver is employing reasonable diligence in that direction; in which case, also, the law regards the first conceiver as the only rightful patentee. Or the second conceiver may reduce to practice before reduction by the first conceiver, while the first conceiver is negligent in perfecting the invention; in which case, if the second conceiver obtains the prior patent, he is entitled to the monopoly against the first but negligent conceiver. Now, if the patent of the second conceiver were to be attacked by a defendant on the ground that the inventive act of the first conceiver had been first completed by reduction, it is obvious that the question of diligence would be immaterial. The second conceiver would occupy no better position than a mere imitator, since the law conclusively presumes that every invention, which has been in practical use to any extent whatever, is known to all alleged later inventors, and thus must have been simply copied by them. In such a

case the proper notice would be that described in this former clause, "that the patentee was not the original and first inventor or discoverer," etc., no mention being needed of the exercise of diligence on the part of the real inventor. But if the second conceiver had first reduced to practice and obtained a patent, an entirely different defence must be presented. The question would no longer be whether the inventive act of the patentee preceded that of his rival, for as a completed act it is conceded that it must have anticipated his. The issue raised is whether the diligence of the later reducer so connects his reduction with his conception that, although completed after that of the patentee, it does in law precede it and so confers on him the title to the patent. If this issue is decided in the negative the patent of the second conceiver stands; if in the affirmative, it falls. A notice under the former clause would, therefore, give no warning to the patentee of the real nature of the defence and might mislead him into a reliance on his earlier reduction as sufficient to sustain his patent. To avoid this surprise the second clause was inserted, requiring the defendant to forewarn him of the special inquiry into the causes to which the later reduction of his rival might be due.

conceived and was being diligently reduced to practice by another, leaving the mere imitator to forfeit his patent whether his imitation were fraudulent or not, and making the issue of a patent to the earliest completer of an inventive act "unjust" and "surreptitious" when a prior conceiver was exerting due diligence in reducing his idea to practice.<sup>2</sup> This view of the nature of the change in the statutes will be fully sustained by an examination of that current of decisions by means of which the alteration in the doctrine and consequently in the language of the law was gradually effected. These clauses of the act of 1836 are repeated in the act of 1870 and the Revised Statutes, and in the light of the foregoing considerations it appears that the notice "that the patentee had surreptitiously or unjustly obtained the patent for that which was in fact invented by another who was using reasonable diligence in adapting and perfecting the same" is required only in reference to a portion of the third defence, and is not applicable to the second, — the second being included in the fourth state of facts as previously enumerated.

**§ 996. Notice Required where the Defence Rests on the Allegation of Prior Patent or Publication.**

The third state of facts embraces two of the three conditions under which the patent must be void for want of legal novelty in the invention. The other condition is covered, with other matters, by the description of the fourth state of facts hereafter to be considered. A prior publication was made the subject of a notice in the acts of 1793 and 1836, and the provision was extended to a prior patent by the act of 1870.<sup>1</sup> Under our present law, therefore, the defendant must give notice whenever he desires to dispute the legal novelty of the invention by proving that it had been patented or described in some printed publication prior to its alleged invention by the patentee.<sup>2</sup>

<sup>2</sup> See §§ 960, 961, and notes, *ante*.

§ 996. <sup>1</sup> Sec. 6, act of 1793 ; Sec. 15, act of 1836 ; Sec. 61, act of 1870 ; *Stevenson v. Magowan* (1887), 31 Fed. Rep. 824 ; 42 O. G. 1063.

<sup>2</sup> That a patent not set up in the

notice or answer may be offered to show the date of the patented articles already in evidence, see *Atlantic Works v. Brady* (1883), 107 U. S. 192 ; 23 O. G. 1330.

That unless notice is given of a prior



§ 997. Notice Required where the Defence Rests on the Allegation of Prior Use.

The fourth state of facts embraces a field of wide extent, and covers several different defences. Its relation to prior invention and to mere imitation of the discovery of another person has already been sufficiently discussed.<sup>1</sup> It also includes that third condition of the want of legal novelty, in which, although the performance of the original inventive act cannot be traced to any definite individual, the use and knowledge of the invention by others in this country, prior to the date of its alleged invention by the patentee, proves that it could not have then been new. All the Principal Patent Acts, except that of 1790, have, under varied forms of phrasology, contained the substance of this provision.<sup>2</sup> The act of 1793 required a notice when the defendant wished to show that the patented invention "was not originally discovered by the patentee but had been in use" anterior thereto.<sup>3</sup> The act of 1836 made notice necessary when the defence was based upon the fact "that the patentee was not the original and first inventor or discoverer of the thing patented or of a substantial and material part thereof claimed as new."<sup>4</sup> The act of 1870 and the corresponding clause in the Revised Statutes prescribe notice when the defendant claims that the patentee "was not the original and first inventor or discoverer of some material and substantial part of the thing patented."<sup>5</sup> These clauses were intended to cover all cases of alleged prior use or knowledge of the invention under whatever form. The act of 1793

patent it will be disregarded by the court though referred to in the argument, see *Odiorne v. Denney* (1878), 13 O. G. 965; 3 Bann. & A. 287.

That a prior publication cannot be offered to prove a want of novelty unless due notice has been given, see *Silsby v. Foote* (1862), 14 How. 218.

That if the notice of publication is given only by special plea, and this is struck out by the court, the publication cannot be read, see *Foote v. Silsby* (1849), 1 Blatch. 445.

That a publication is not admissible

to show that the author had prior knowledge at a certain place unless due notice was given, see *Silsby v. Foote* (1862), 14 How. 218.

§ 997. <sup>1</sup> See § 995 and notes, *ante*.

<sup>2</sup> The act of 1790 provided a method for the repeal of a patent on the ground that the patentee was not the first and true inventor, and allowed the same fact to be urged in defence to a suit for infringement under the general issue.

<sup>3</sup> Sec. 6, act of 1793.

<sup>4</sup> Sec. 15, act of 1836.

<sup>5</sup> Sec. 61, act of 1870.

mentions such use in terms as equivalent to want of original discovery by the patentee. The later acts do not insert the word "use" in these clauses, but that it is included in the phrase they do employ is obvious from the subsequent requirement concerning the disclosure of the names and residences of those by whom the defendant claims that such use was made. As the provision stands in the acts now in force, it comprises every instance where the invention has been known or used in the United States before the date of the patentee's alleged inventive act, as well as where the origin of the invention in a prior rival, or prior sole inventor, can be definitely ascertained.<sup>6</sup> The second defence, with part of the third, and one of the three branches of the fifth are thus comprehended in this provision.

**§ 998. Notice Required where the Defence Rests on an Allegation of Abandonment to the Public.**

The fifth state of facts includes those which constitute the defence of abandonment in both its forms, — that which consists in acts affording a conclusive presumption of an intention to surrender the invention to the public, and that in which the general conduct of the inventor manifests the same determination. Under the earlier acts no notice was required to admit evidence of abandonment in any form. It was first prescribed in the act of 1836, in reference to abandonment by public use and sale or by the failure of an alien patentee to place his invention within reach of the public. The act of 1870 extended the requirement to all cases of abandonment, and thus made notice essential whenever the seventh defence is to be urged.<sup>1</sup>

<sup>6</sup> That the defendant cannot set up prior knowledge, invention, or use unless the thirty days notice has been given, see *Roemer v. Simon* (1877), 95 U. S. 214 ; 12 O. G. 796 ; *Pickering v. Phillips* (1876), 10 O. G. 420 ; 4 Clifford, 383 ; 2 Bann. & A. 417.

That evidence of a prior use not referred to in the notice can only be considered upon the question of the

state of the art, see *Geier v. Goetinger* (1874), 7 O. G. 563 ; 1 Bann. & A. 553.

§ 998. <sup>1</sup> That evidence of abandonment cannot be admitted without notice given, see *Bates v. Coe* (1878), 98 U. S. 31 ; 15 O. G. 337.

That upon due notice the defendant may show two years public use and sale before application, see *Bates v. Coe*



§ 999. Defences Available under the General Issue without Notice.

As the result of this examination of the rules governing notice in actions for infringement, it appears that of the twenty-five ordinary defences open to defendants in such actions nineteen may be set up and proved under the general issue, without notice or special plea.<sup>1</sup> These are: (1) That the alleged invention is not the product of inventive skill; (2) That it does not fall within either of the protected classes of inventions; (3) That it is not useful; (4) That no such patent as the one declared upon has ever existed; (5) That the plaintiff's patent was issued contrary to law; (6) That the invention described in the patent is neither an art, a machine, a manufacture, a composition of matter, a design, or an improvement; (7) That the specification is ambiguous; (8) That the Claim is excessive and has not been cured within reasonable time by a disclaimer; (9) That the Claim is ambiguous; (10) That the patent in force at the date of the infringement has been surrendered; (11) That the patent declared on has been repealed; (12) That the plaintiff has no such title to the patent as enables him to sue at law; (13) That the invention practised by the defendant is not identical with the one covered by the patent; (14) That the acts of the defendant in reference to the patented invention were not acts

(1878), 98 U. S. 31; 15 O. G. 337.

That public use and want of novelty as shown by prior use, &c., are two distinct defences, and require distinct and special notices, see *Myers v. Busby* (1887), 32 Fed. Rep. 670.

§ 999. <sup>1</sup> Herein the reader will perceive one of the marked distinctions between the pleadings at law and in equity. In his answer in a court of equity, as will hereafter appear (§§ 1114-1117), the defendant must specially set forth every defence of which he would avail himself, and is regarded as admitting whatever of the plaintiff's claims he does not thus traverse or avoid. As the answer in equity em-

braces both pleadings and notice, and as many of the requisites of the answer, as they are commonly referred to by the courts, are stated generally and not confined to the answer as a pleading, it might by the incautious reader be supposed that the law of notice extended to every defence which can be urged whether at equity or law. Traces of error arising from this source may be seen in various declarations, in court opinions and text-writers, concerning the necessity of special pleadings in order to admit defences, many of which have been admissible under the general issue alone ever since the patent system was established.

of making, use, or sale; (15) That the practice of the invention by the defendant occurred before the issue of the patent or after it had expired; (16) That the practice of the invention by the defendant was in pursuance of his lawful rights; (17) That the plaintiff is estopped by his own conduct from pursuing his action against the defendant; (18) That the plaintiff's right of action against the defendant has been duly released; (19) That the plaintiff's right of action against the defendant has been extinguished by, or merged in, a judgment.<sup>2</sup> One defence must be made by special plea, the Stat-

<sup>2</sup> If the pleadings in all the earlier patent cases were conveniently accessible much light upon this question might be easily obtained by collecting instances in which these various defences have been made without objection under the general issue without notice. At present the result would scarcely justify the labor. Mr. Curtis, on the general authority of the common law, and the causes then decided, affirms that no notice is required in order to show that the invention is not patentable subject-matter (except upon the point of novelty); that it is not useful; that the patent was unlawfully issued; that the specification is defective; that the plaintiff has no title; and that the defendant does not infringe. These cover the defences enumerated in this sentence of the text, omitting the 10th, 11th, 17th, 18th, and 19th. He regards a special plea as proper in order to set up a surrender after the cause of action arose, though whether he deems it necessary is doubtful from the language used. As to the mode of pleading a repeal, an estoppel, a release, and a former judgment, he is silent. The recognition by this distinguished jurist, whose work has so long been referred to by our courts as reliable authority on nearly every question of Patent Law, of the general issue without notice as the proper form of pleading, except in the special cases

prescribed in the statute, must be of great weight in this discussion, even though no judgments could be found sustaining his position.

That the plea of not guilty puts the novelty of the invention in issue, see *Blanchard v. Putnam* (1869), 8 Wall. 420.

That a defendant may raise the issue whether the thing patented is a patentable invention without statutory permission, see *Gardner v. Herz* (1886), 118 U. S. 180; 35 O. G. 999; *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

That the invention is not of one of the patentable classes may be shown on the general issue, see *Guidet v. Barber* (1873), 5 O. G. 149.

That an answer in equity need not set up that the patented invention was not of one of the patentable classes, see *Hendy v. Golden State & Miners Iron Works* (1888), 127 U. S. 370; 43 O. G. 1117.

That the invalidity of the patent on the ground that the inventor's representative substantially amended the application without a new oath may be urged without stating it in the pleadings, see *Eagleton Mfg. Co. v. West, Bradley, & Carey Mfg. Co.* (1884), 111 U. S. 490; 27 O. G. 1237.

That no notice is needed to admit evidence of non-infringement, see *Evans v. Hettick* (1822), 7 Wheaton, 453; 1 Robb, 417.



ute of Limitations. Five can be introduced under the general issue only after due notice: (1) That the inventive act resulting in the invention was not performed by the patentee, and that his patent was thus surreptitiously and unjustly obtained for the discovery of another; (2) That the patentee, though a true inventor, was not the first to perform the inventive act; (3) That the patented invention is not legally new; (4) That it has been abandoned to the public; (5) That the specification fraudulently misrepresents the scope of the invention or the mode of rendering it available in practice. Or the defendant may, if he prefers it, plead specially either or all of these five defences, and plead the general issue as to all the others except the Statute of Limitations.<sup>3</sup> When he does this, however, his special pleas must possess all the requisites which the law prescribes for notices under the general issue.

#### § 1000. Form and Service of Notice.

The purpose of the law in requiring notice to be given to the plaintiff in reference to these defences is to secure to him an opportunity to prepare himself to meet them, and to guard him against unwarrantable surprise. The rules governing the form, the particularity, and the service of the notice have been framed with the same intent, and must be complied with unless waived by the plaintiff. The notice must be in writing,<sup>1</sup> and must be complete and precise enough to answer the end in view, giving to the plaintiff such information as to events, persons, places, and dates as will enable him to acquaint himself with the truth of the matters thus alleged.<sup>2</sup> If the first

<sup>3</sup> That the special matters which may be given in evidence under the general issue may be pleaded specially, see *Cottier v. Stimson* (1884), 20 Fed. Rep. 906; 10 Sawyer, 212; *Cottier v. Stimson* (1883), 9 Sawyer, 435; 18 Fed. Rep. 689.

§ 1000. <sup>1</sup> That the notice must be in writing, see *New York Pharnical Co. v. Tilden* (1883), 21 Blatch. 191; 14 Fed. Rep. 740; 23 O. G. 272; *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539.

<sup>2</sup> In *Silshy v. Foote* (1852), 14 How. 218, Curtis, J.: (223) "The act does not attempt to prescribe the particulars which such a notice shall contain. It simply requires notice. But the least effect which can be allowed to this requirement is that the notice should be so full and particular as reasonably to answer the end in view. This end was not merely to put the patentee on inquiry, but to relieve him from the necessity of making useless inquiries and researches, and enable

notice is defective, another properly constructed may be substituted.<sup>3</sup> The notice is not to be pleaded, but must be served on the plaintiff or his attorney at least thirty days before the opening of the term at which the cause is to be tried, and a failure to make such service is good ground for a continuance of the case to the succeeding term.<sup>4</sup> In equity the notice is given in the answer, and by amendment, under the permission of the court, the stringency of this rule as to service is sometimes avoided.<sup>5</sup>

him to fix with precision upon what is relied on by the defendants, and to prepare himself to meet it at the trial. This highly salutary object should be kept in view, and a corresponding disclosure exacted from the defendant of all those particulars which he must be presumed to know, and which he may safely be required to state, without exposing him to any risk of losing his rights. Less than this would not be reasonable notice, and therefore would not be such a notice as the act must be presumed to have intended."

That it is enough if the sources of the defendant's proofs are indicated with such certainty that the plaintiff can resort to and identify them, see *Smith v. Frazer* (1872), 5 Fisher, 543; 2 O. G. 175.

<sup>3</sup> That the notice may be repeated if at first insufficient, see *Teese v. Huntingdon* (1859), 23 How. 2.

<sup>4</sup> That the notice of special matters of defence is not to be pleaded but served as a notice on the plaintiff, see *Cottier v. Stimson* (1884), 20 Fed. Rep. 906; 10 Sawyer, 212.

That the notice may be given without an order of court, see *Teese v. Huntingdon* (1859), 23 How. 2.

That the thirty days of notice means thirty days before the beginning of the term of trial, see *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636.

That notice of special matter must

be given thirty days before the term opens, not before trial merely, see *Westlake v. Cartter* (1873), 4 O. G. 636; 6 Fisher, 519.

That unless the notice is given thirty days before the trial, the evidence cannot be offered, see *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Cammeyer v. Newton* (1876), 94 U. S. 225; 11 O. G. 287; *Teese v. Huntingdon* (1859), 23 How. 2.

That the notice may be given after depositions have been taken and the depositions may then be admitted if pertinent, see *Teese v. Huntingdon* (1859), 23 How. 2.

That unless the notice or its equivalent plea or answer is filed thirty days before the term the plaintiff is entitled to a continuance, see *Phillips v. Combstock* (1849), 4 McLean, 525; 2 Robb, 724.

<sup>5</sup> That in equity the special defences are to be set up in the answer, not by plea or notice, see *Carrick v. McKesson* (1881), 19 Blatch. 369; 8 Fed. Rep. 807; *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337; *Pickering v. Phillips* (1876), 2 Bann. & A. 417; 10 O. G. 420; 4 Clifford, 383; *Doughty v. West* (1865), 2 Fisher, 553; *Pitts v. Edmonds* (1857), 2 Fisher, 52; 1 Bissell, 168.

See also §§ 1116, 1120, and notes, *post*, concerning notice in equity and its amendment when necessary.



§ 1001. **Notice of Fraudulent Specification : its Requisites.**

The notice of a fraudulent specification must point out the concealment or redundancy on which the defendant relies, and aver specifically that it originated in an intention to deceive the public.<sup>1</sup> A general statement that the specification was fraudulently made too comprehensive or too narrow is not sufficient.<sup>2</sup> An allegation that the Description is vague and ambiguous, or contains superfluous matter, or that the Claim is frivolous, without asserting an intention to deceive, is equally defective.<sup>3</sup> The plaintiff must be forewarned both of the particular errors in his specification and of the defendant's claim that they were committed in pursuance of a design to mislead the public. Otherwise the notice merely gives information of such matters as the defendant might prove, under the defence of ambiguity in the specification, without notice, and compels him to rely for his defence, not on the fraudulent want of correspondence between the specification and the invention, but on the failure of the specification to disclose the invention to persons skilled in the art in a practical and operative form.

§ 1002. **Notice that the Patentee or his Assignor, though a True Inventor, Surreptitiously Obtained the Patent for the Invention while a Prior Inventor was Diligently Reducing to Practice.**

The notice that the plaintiff surreptitiously and unjustly obtained the patent for that which was in fact the invention of another, who was using reasonable diligence in adapting and perfecting it, should, in analogy to the requirements of

§ 1001. <sup>1</sup> That where the defendant wishes to set up fraud or false representation in the patent, he must give notice thereof, see *Blake v. Stafford* (1868), 3 *Fisher*, 294 ; 6 *Blatch*. 195.

<sup>2</sup> That an allegation that "the claim is fraudulently and falsely made broader and more general and comprehensive than his invention," does not present any question of fact or allege fraud, see *Blake v. Stafford* (1868), 3 *Fisher*, 294 ; 6 *Blatch*. 195.

<sup>3</sup> That allegations that the specification "is vague, ambiguous and uncertain, and does not sufficiently describe the invention," or that "it contains more than is necessary," or that "the Claim is frivolous," or that "for divers other reasons the patent is void," do not raise questions of fact except whether the invention is so described that any one could make it, see *Blake v. Stafford* (1868), 3 *Fisher*, 294 ; 6 *Blatch*. 195.

the notice of prior knowledge or use, give the name and residence of the prior inventor, the date of his conception of the idea of means, the date of its conception by the patentee, and aver that the former was employing due diligence in reducing it to practice.<sup>1</sup> No allegations of fraud or wilful wrong are necessary, — the defence being complete if the facts already stated are established, whatever may have been the motive or opinion of the patentee.

§ 1003. **Notice of Prior Patent or Publication : its Requisites.**

The notice of a prior patent must give the name of the patentee, and the date of his patent, and allege it to be prior to the date of the patent in suit.<sup>1</sup> The notice of prior publication must set forth its title and date of publication, and mention the particular arts or articles described therein which are now claimed to be identical with the patented invention, and name the volume and page of the publication in which such description is to be found.<sup>2</sup> No earlier date can be

§ 1002. <sup>1</sup> That notice of prior invention must give the name and residence of the prior inventor, see *Kelleher v. Darling* (1878), 14 O. G. 673 ; 4 Clifford, 424 ; 3 Bann. & A. 438.

That a notice alleging that the prior conceiver was not the first inventor need not state that he abandoned the invention, see *Pennsylvania Diamond Drill Co. v. Simpson* (1886), 29 Fed. Rep. 288 ; 37 O. G. 218.

§ 1003. <sup>1</sup> That a notice of prior patent must give the name of the patentee and date of the patent, see *Judson v. Bradford* (1878), 16 O. G. 171 ; 3 Bann. & A. 539 ; *Kelleher v. Darling* (1878), 14 O. G. 673 ; 4 Clifford, 424 ; 3 Bann. & A. 438 ; *Roemer v. Simon* (1877), 95 U. S. 214 ; 12 O. G. 796.

That a notice of prior patent must allege its date as being prior to the date of the patent in suit, see *Kelleher v. Darling* (1878), 14 O. G. 673 ; 4 Clifford, 424 ; 3 Bann. & A. 438.

<sup>2</sup> In *Silby v. Foote* (1852), 14 How.

218, Curtis, J. : (223) “ Now we do not perceive that the defendants would be exposed to the risk of losing any right, by requiring them to indicate, in their notice, what particular things described in the printed publication they intended to aver were substantially the same as the thing patented. This they might have done either by reference to pages or titles, and perhaps in other ways, for the particular manner in which the things referred to are to be identified must depend much upon the contents of the volume and their arrangement.”

In *Foote v. Silsby* (1849), 1 Blatch. 445, Nelson, J. : (462) “ The notice should have specified the page or heading in the public work in which the invention had been previously described, so as to enable the patentee to turn to the article without searching through the entire volume. There can be no difficulty in giving a particular reference to the part of the book intended to be relied on, as the defendant is pre-



ascribed either to a patent or a publication than its actual date of issue.<sup>3</sup> A printed publication or a patent, not properly set out in the notice, cannot be used as evidence to show that the author or the patentee had prior knowledge of the invention; nor is defective notice of a prior publication aided by the evidence of experts that they would know where to look in it for a description of the patented invention.<sup>4</sup>

#### § 1004. Notice of Prior Use : its Requisites.

The notice of prior invention varies according to the nature of the defence which is to be supported by the evidence. When the defendant alleges that the patentee has imitated and appropriated the invention of another person, the notice should disclose the name and residence of the true inventor, with the date of his inventive act, and aver that the patentee obtained his own ideas of the invention from the art or article thus produced.<sup>1</sup> If the defendant admits that the patentee is a true inventor, but claims that a rival inventor first conceived the idea and first reduced it to practice, he must state the name and residence of the prior inventor, with the date of his inventive act, as well as that of the inventive act of the patentee.<sup>2</sup> But when the defendant denies the legal

sumed to have examined the article and to be familiar with it and with the page or heading where it may be found. A general reference to the work is calculated to mislead and embarrass the party, and ought not to be sanctioned, especially as there can be no difficulty in giving a more specific one."

That the notice of a prior publication, if it be a large book, must give the page or heading, see *Silsby v. Foote* (1852), 14 How. 218; *Foote v. Silsby* (1849), 1 Blatch. 445.

<sup>3</sup> That the date given by the notice to a patent or publication must not be earlier than its true issue, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

<sup>4</sup> That a defective description of a publication is not aided by offering it

to show the prior knowledge of the author of the book, nor by the evidence of experts and others that they should know where to find the description in the book, see *Foote v. Silsby* (1849), 1 Blatch. 445.

§ 1004. <sup>1</sup> This rule in regard to notice is here stated on the supposition that the law still requires some notice to be given in such cases under the fourth state of facts, though the specific defence, as it stood in the act of 1793, has disappeared from the statutes. If notice is necessary, the requisites of such notice cannot be less or other than those mentioned in the text. See *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

<sup>2</sup> That notice of prior invention must give the names and residences of the

novelty of the invention on the ground of prior use, his notice must be of an entirely different character. It is immaterial to the defence of prior use whether the first inventor of the art or article is known or unknown, — the fact that the invention itself was known or used before the patentee invented it being fatal to his patent. Here the notice must state the names and residences of the persons who had knowledge of the invention, or who used it, before the patentee invented it, and the localities in which it was used.<sup>3</sup> It being the object of this notice to save the plaintiff from useless inquiries, and not merely to put him upon inquiry, the defendant must give such detailed information as he possesses, and can fairly impart without prejudicing his own rights. The notice is sufficient when the plaintiff can readily identify the persons and places therein named, and resort to them for further knowledge.<sup>4</sup> The persons to be named are not the witnesses by whom a prior knowledge or use is now to be proved, but

persons who invented it, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

<sup>3</sup> That notice of prior knowledge or use must give the names and residences of the persons having such knowledge, and state where and by whom it had been used, see *Searls v. Bouton* (1882), 12 Fed. Rep. 140; 21 O. G. 1784; 20 Blatch. 426; *Allis v. Buckstaff* (1882), 22 O. G. 1705; 13 Fed. Rep. 879; *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438; *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796; *Earl v. Dexter* (1874), 6 O. G. 729; Holmes, 412; 1 Bann. & A. 400; *Union Paper Bag Mach. Co. v. Newell* (1874), 11 Blatch. 549; 1 Bann. & A. 113; 5 O. G. 459; *Decker v. Grote* (1873), 3 O. G. 65; 10 Blatch. 331; 6 Fisher, 143; *Seymour v. Osborne* (1870), 11 Wall. 516; *Graham v. Mason* (1869), 5 Fisher, 1; 4 Clifford, 88; *Agawam Co. v. Jordan* (1868), 7 Wall. 583; *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327;

*Hays v. Sulsor* (1859), 1 Fisher, 532; 1 Bond, 279.

That under Sec. 6, act of 1793, upon notice of use by A and others the defendant might prove a use by others as well as A, see *Treadwell v. Bladen* (1827), 4 Wash. 703; 1 Robb, 531; *Evans v. Kremer* (1816), Peters C. C. 215; 1 Robb, 66.

That due notice having been given, coupled with a statement that others, then unknown, had knowledge and used, and asking that when their names are discovered they might be added, such additions were allowed, no objection being made, and further notice is thus waived, see *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796.

That where one person was named as having prior knowledge and was not examined, another person not named might be called to prove the former's knowledge, see *Many v. Jagger* (1848), 1 Blatch. 372.

<sup>4</sup> In *Smith v. Frazer* (1872), 2 O. G. 175, McKennan, J.: (177) "The act was designed to secure the disclosure of



the individuals who had such knowledge or made such use of the invention before it was invented by the patentee, — any person, though not named in the notice, being a competent witness to prove such prior knowledge or use on the part of those actually named.<sup>5</sup> The notice may or may not mention

specific facts, presumptively without the complainant's knowledge, so that the patentee might be informed of the exact nature of the defence set up, and might be enabled to obtain full knowledge of all the facts and circumstances pertaining to it. Where prior knowledge and use are alleged, he must be informed of the name and residence of the person possessing such knowledge, and of the place where such use occurred. But it was not intended to dispense with the necessity of inquiry and research on the part of the patentee. The notice is only a guide to the sources of the defendant's proofs. If they are indicated with such distinctness that the complainant can readily identify and resort to them, the purpose of the law is answered." 5 Fisher, 543 (547).

In *Wise v. Allen* (1869), 9 Wall. 737, Miller, J. : (740) "Nor do we think that the party giving notice is bound to be so specific as to relieve the other from all inquiry or effort to investigate the facts. If he fairly puts his adversary in the way that he may ascertain all that is necessary to his defence or answer, it is all that can be required, and he is not bound by his notice to impose an unnecessary and embarrassing restriction on his own right of producing proof of what he asserts. We are all, therefore, of opinion, that when, in addition to the particular town or city in which such large objects as millstones are used, the name and residence of the witness by whom that use is to be proved is also given, there is sufficient precision and certainty in the notice."

<sup>5</sup> In *Allis v. Buckstaff* (1882), 13 Fed. Rep. 879, Dyer, J. : (884) "There are

reported cases to the effect that the names of the witnesses, by whom it is expected to prove the alleged prior use, should be stated in the answer. Such is the intimation, if not the positive ruling, in *Richardson v. Lockwood*, 6 Fisher, 454. But all cases in which it has been so held are overruled by *Roemer v. Simon*, 95 U. S. 219, and *Planing Machine Co. v. Keith*, 101 U. S. 479, wherein it is held that only the names of those who had invented or used the anticipating machine or improvement, and not of those who are to testify touching its invention or use, are required to be set forth." 22 O. G. 1705 (1706).

See also *Sutro v. Moll* (1881), 19 Blatch. 89 ; 8 Fed. Rep. 909 ; *Woodbury Patent Planing Mach. Co. v. Keith* (1879), 101 U. S. 479 ; 17 O. G. 1031 ; *Planing Mach. Co. v. Keith* (1879), 4 Bann. & A. 100 ; *Roemer v. Simon* (1877), 95 U. S. 214 ; 12 O. G. 796 ; *Wilton v. Railroads* (1847), 1 Wall. Jr. 192 ; 2 Robb, 641.

For cases in which it was stated that the names of the witnesses must be given, see *Wise v. Allen* (1869), 9 Wall. 737 ; *Judson v. Cope* (1860), 1 Fisher, 615 ; 1 Bond, 327.

Other cases recognize the same doctrine indirectly. See *La Baw v. Hawkins* (1874), 6 O. G. 724 ; 1 Bann. & A. 428 ; *Richardson v. Lockwood* (1873), 4 O. G. 398 ; 6 Fisher, 454.

It is easy to see the origin of this error. As the witnesses called to prove prior use or knowledge were frequently the very persons who had used or known the invention before the plaintiff's inventive act, the name "witnesses" was applied to them in the latter capacity as

the name and residence of the original inventor.<sup>6</sup> The locality in which the prior use of the invention was made must be alleged with reasonable certainty. It is not sufficient to describe it as occurring in a given county.<sup>7</sup> The mention of certain mining or manufacturing establishments within the county as the places of its use is, however, equally definite with that of towns or villages, and complies with this requirement of the law.<sup>8</sup> The statement of the residences of the persons using does not dispense with that of the places of the use, although the two localities may be the same. The notice must not only point out the places *of* which the users were inhabitants but those *at* which they employed the invention.<sup>9</sup> This is necessary in order to enable the plaintiff to inquire into the fact of use and the nature of the invention used, as well as concerning the persons by whom the use is claimed to have been made. The date of such knowledge and use need not be stated except by the general averment that it preceded the inventive act of the patentee.<sup>10</sup> The allegations of the notice must not be limited to one or more of the elements of which the patented art or article consists, but must extend to the entire invention claimed.<sup>11</sup> The want of such a notice

well as in that of individuals giving testimony before the court. By "witness," in most of the cases where notice of "the names and residences of witnesses" is spoken of, is evidently meant not the mere testifier, but the testifier to his own prior use or prior knowledge. Thence the transition to the idea that the witness, as a testifier generally, was the person to be named was natural.

<sup>6</sup> That notice of prior use need not name the original inventor, see *Evans v. Kremer* (1816), Peters C. C. 215; 1 Robb, 66.

<sup>7</sup> That to give the name of a county as the place of knowledge or use is not sufficiently definite, see *Hays v. Sulsor* (1859), 1 Fisher, 532; 1 Bond, 279.

<sup>8</sup> That it is enough to name certain mining establishments in a certain county as the places of use, see *Smith v. Frazer* (1872), 5 Fisher, 543; 2 O. G. 175.

That under Sec. 6, act of 1793, notice of prior use in some places admits evidence of it in other places not named, see *Evans v. Eaton* (1818), 3 Wheaton, 454; 1 Robb, 243.

That under Sec. 6, act of 1793, when the notice named certain mills where the invention was used evidence as to other mills might be given, see *Evans v. Eaton* (1816), Peters C. C. 322; 1 Robb, 68.

<sup>9</sup> That a notice naming persons using as *of* a certain place but not *at* any place is not sufficient, see *Searls v. Bouton* (1882), 21 O. G. 1784; 12 Fed. Rep. 140; 20 Blatch. 426.

<sup>10</sup> That the notice need not mention the time when the witness knew or used, but only his name and residence and the place of use, see *Phillips v. Page* (1860), 24 How. 164.

<sup>11</sup> That the notice of prior use must



cannot be supplied by any form in which the evidence may be presented.<sup>12</sup> Neither a prior publication, nor a patent, nor a rejected application, can be offered to prove use or knowledge by the author, patentee, or applicant, unless preceded by the proper warning to the plaintiff.<sup>13</sup> Where the plaintiff or his licensee was himself the prior user, and is now endeavoring to enforce a patent obtained by one whom his own acts have anticipated no notice of such prior use is necessary.<sup>14</sup>

**§ 1005. Notice of Abandonment to the Public : its Requisites.**

The notice of abandonment also differs according to the nature of the evidence to be adduced. Abandonment by public use or sale and abandonment by general conduct, though

apply to the whole invention as patented, see *Parks v. Booth* (1879), 102 U. S. 96 ; 17 O. G. 1089.

That the notice need not specify the particular portion of the letters-patent to which the evidence will relate, see *Westlake v. Cartter* (1873), 4 O. G. 636; 6 Fisher, 519.

<sup>12</sup> That no evidence of any form against the novelty of the invention can be admitted unless the proper notice is given, see *Marks v. Fox* (1880), 6 Fed. Rep. 727; 18 Blatch. 502 ; *American Saddle Co. v. Hogg* (1872), 2 O. G. 595; 6 Fisher, 67; *Holmes*, 177; *Railroad Co. v. Dubois* (1870), 12 Wall. 47.

That the witness cannot be examined unless the notice is given as the law requires, see *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448; 2 Robb, 46.

That if the evidence be received without notice and against objection the Supreme Court will reverse the judgment, though the appeal were based on different grounds, see *Blanchard v. Putnam* (1869), 8 Wall. 420.

<sup>13</sup> That in the absence of a notice of prior use, foreign patents and other evidence showing knowledge in this country are not admissible, see *Earl v. Dexter*

(1874), 6 O. G. 729 ; *Holmes*, 412 ; 1 Bann. & A. 400.

That the existence of the alleged prior devices cannot be shown without proper notice of prior use, see *Howe v. Williams* (1863), 2 Fisher, 395 ; 2 Clifford, 245.

That without notice of prior use the rejected application of a third person cannot be proved, see *Union Paper Bag Mach. Co. v. Pultz & Walkley Co.* (1878), 15 O. G. 423; 15 Blatch. 160; 3 Bann. & A. 403.

That a notice stating that a certain person made a prior application, not naming his residence, does not warrant the admission of his testimony as to his prior knowledge or use, see *Decker v. Grote* (1872), 3 O. G. 65 ; 10 Blatch. 331 ; 6 Fisher, 143.

<sup>14</sup> That notice need not be given of the time, place, and person of prior use when the person is the plaintiff himself or his licensee, see *American Hide & Leather Splitting & Dressing Mach. Co. v. American Tool & Machine Co.* (1870), 4 Fisher, 284 ; *Holmes*, 503. This proposition really belongs under the doctrine of public use, as the case cited shows, but is equally true of prior use when occurring as stated in the text.

not distinct defences, are widely separated from each other by the conclusive presumption attaching to the acts which constitute the former, and the defendant is required in his notice to specifically point out which of these two methods of abandonment he intends to prove.<sup>1</sup> If he relies on both, they must be set forth in separate allegations.<sup>2</sup> The notice of simple abandonment by general conduct is sufficient when it states that fact without particulars. The notice of abandonment by public use or sale must aver that such sale or use occurred more than two years before the application for a patent.<sup>3</sup> A notice of such use or sale more than two years before the invention was made by the patentee is insufficient, no such defence being known to the law.<sup>4</sup> Under a notice of public use or sale in proper form, evidence of prior use is inadmissible.<sup>5</sup>

**§ 1006. Evidence as to the State of the Art Admissible without Notice.**

No notice is required in order to admit evidence concerning the state of the art at the date when the inventive act of the patentee is claimed to have been performed.<sup>1</sup> The primary

§ 1005. <sup>1</sup> That abandonment by public use and sale rests on different principles from abandonment by general conduct, see *Jones v. Sewall* (1873), 6 Fisher, 343 ; 3 O. G. 630 ; 3 Clifford, 563.

<sup>2</sup> That if both modes of abandonment are to be urged, they must be separately noticed, see *Jones v. Sewall* (1873), 6 Fisher, 343 ; 3 O. G. 630 ; 3 Clifford, 563.

That abandonment by public use must be specially alleged, see *Bates v. Coe* (1878), 98 U. S. 31 ; 15 O. G. 337 ; *Wyeth v. Stone* (1840), 1 Story, 273 ; 2 Robb, 23.

<sup>3</sup> That the allegation of public use or sale must aver it to have been more than two years before the application, see *Agawam Co. v. Jordan* (1868), 7 Wall. 583 ; *Root v. Ball* (1846), 4 McLean, 177 ; 2 Robb, 513.

That the consent of the inventor to the public use need not now be alleged, see *Campbell v. City of New York* (1888), 35 Fed. Rep. 504.

<sup>4</sup> That notice of public use or sale two years before the plaintiff's *invention* is improper, see *Kelleher v. Darling* (1878), 4 Clifford, 424 ; 14 O. G. 673 ; 3 Bann. & A. 438.

<sup>5</sup> That prior use cannot be shown under a notice of public use, see *Kelleher v. Darling*, (1878), 4 Clifford, 424 ; 14 O. G. 673 ; 3 Bann. & A. 438.

§ 1006. <sup>1</sup> That evidence of the state of the art is admissible without notice, see *Stevenson v. Magowan* (1887), 31 Fed. Rep. 809 ; 42 O. G. 1063 ; *Eachus v. Broomall* (1885), 115 U. S. 429 ; 33 O. G. 1265 ; *Brown v. Piper* (1875), 91 U. S. 37 ; 10 O. G. 417 ; *La Baw v. Hawkins* (1874), 6



purpose of such evidence is to define the exact scope of the alleged invention by comparing the point to which the art had attained before the invention was made with that to which it was carried by the invention. Such evidence may actually disclose an entire want of legal novelty in the alleged invention, but this constitutes no reason for excluding it, although the court will not permit the defendant to derive any advantage from it upon that defence.<sup>2</sup> Thus patents issued before the date of the invention, the use of instruments of similar character by different persons, and the existence of articles resembling or identical with that covered by the patent, may be proved by the defendant, without notice, in all cases where they tend to throw light upon the art to which the patented invention appertains.<sup>3</sup> Evidence not having this effect, though offered for this purpose, is not admissible unless the proper notice has been served.<sup>4</sup>

O. G. 724 ; 1 Bann. & A. 428 ; Richardson v. Lockwood (1873), 4 O. G. 398 ; 6 Fisher, 454 ; American Saddle Co. v. Hogg (1872), 5 Fisher, 353 ; 2 O. G. 59 ; Holmes, 133 ; Vance v. Campbell (1861), 1 Black, 427.

<sup>2</sup> That evidence admissible only to show the state of the art must be confined thereto, though it also shows prior use, see Zane v. Soffe (1880), 2 Fed. Rep. 229 ; 5 Bann. & A. 284 ; Geier v. Goettinger (1874), 7 O. G. 563 ; 1 Bann. & A. 553.

<sup>3</sup> That prior patents may be offered without notice to show the state of the art and the proper construction of the present patent, see Grier v. Wilt (1887), 120 U. S. 412 ; 38 O. G. 1365 ; Westlake v. Cartter (1873), 4 O. G. 636 ; 6 Fisher, 519.

That a patent not set up in the answer cannot be admitted to show priority, but only the state of the art, see American Saddle Co. v. Hogg (1872), 2 O. G. 59 ; Holmes, 133 ; 5 Fisher, 353 ; Railroad Co. v. Dubois (1870), 12 Wall. 47.

That the existence and use of an

article may be proved without notice to show the state of the art, but not to show prior use, and must be confined thereto, see Zane v. Soffe (1880), 2 Fed. Rep. 229 ; 5 Bann. & A. 284.

That evidence as to the existence of certain improvements at the date of the plaintiff's invention is admissible without notice, see Vance v. Campbell (1861), 1 Black, 427.

That the date of a patent not set up in the answer may be shown as evidence of the existence at that time of a device otherwise shown to be in actual use, see Atlantic Works v. Brady (1882), 107 U. S. 192 ; 23 O. G. 1330.

That prior publications cannot be offered to show the state of the art, see Westlake v. Cartter (1873), 4 O. G. 636 ; 6 Fisher, 519.

<sup>4</sup> That when a patent not mentioned in the notice could only show that plaintiff's patent was anticipated, it is not admissible to prove the state of the art, see American Saddle Co. v. Hogg (1872), 5 Fisher, 353 ; 2 O. G. 59 ; Holmes, 133.

**§ 1007. Evidence in Actions at Law for Infringement Governed by the Usual Rules.**

The rules of evidence in actions for infringement are, in their general character, identical with those by which the Federal courts are guided in other suits at law. The various issues which arise in patent litigation differ so widely, however, from those which are presented by any controversy concerning other rights and wrongs that in their details, as developed and applied by judicial decision, those rules now constitute a peculiar and distinct department of our practical jurisprudence. In their discussion in these pages, such of their features as are derived from the common law of evidence may properly be passed over without special consideration, our attention being directed chiefly to those particular precepts and provisions which distinguish them as members of the body of our Patent Law.

**§ 1008. Rules of Evidence in the Federal Courts Identical with Those in Force in the Local Courts.**

The Judiciary Act of 1789, according to the interpretation given to it by the Supreme Court of the United States, provided that the rules of evidence prevailing in each State should be applied in actions at common law in the Federal courts held within that State, except when otherwise required by the Constitution, treaties, or statutes of the United States.<sup>1</sup> The act of 1862, affirming in this respect the Judiciary Act, enacted that the laws of the State in which the court is held should determine the competency of witnesses in trials at law in the Federal courts. Later acts removed from witnesses all incompetency on account of color, or of interest in the issue to be tried. Subject, therefore, to the modifications which are now to be considered the rules of evidence in actions for infringement, whether relating to the competency of witnesses on any other ground than that of color or interest, or to the production and effect of testimony, are those recog-

<sup>1</sup> That the rules of evidence in common law cases in the Federal Courts correspond with those in the State courts, except where modified by acts of Congress, according to the act of 1789, see Curtis, *Jurisdiction and Practice of U. S. Courts*, 227.



nized and followed by the courts of the State in which the Federal court is held.<sup>2</sup>

**§ 1009. Facts of which the Federal Courts in Actions at Law for Infringement Take Judicial Notice.**

All courts of common law jurisdiction take judicial notice of six classes of facts, concerning which no evidence is required from either party. These are: (1) Political facts, such as the existence of other nations, their flags and seals, the law of nations, the territorial divisions and political constitution of the State, the public matters which affect the State, its elections and general legislative meetings, its weights and measures, coins and other circulating medium, and its public and special fasts and festivals; (2) Legal facts, including the public laws of the State, its various courts with their jurisdiction and rules of practice, their officers and seals, the names and persons of their judges, the general customs of trade, and such other matters relating to law and usage as are equally well known to all citizens; (3) Official facts, embracing the names and functions of the President, senators, representatives, ambassadors, marshals, sheriffs, and all who hold office in the State by virtue of public election or appointment, the signatures of the President, marshals, and sheriffs, and the signatures and seals of notaries; (4) Public history, including the facts which constitute the political, social, and topographical development of the State and which are generally known and regarded as true; (5) Natural history, comprising such facts in nature as are permanent and uniform, and do not require special investigation in order to discover them, such as the number of days in a given month, the succession of the seasons, and the coincidence of week-days with certain days of the month and year; (6) The vernacular language, or the meaning of all common English words, and of such terms of art as are in common use.<sup>1</sup> As a general rule the Federal courts, in the trial of actions at law for infringe-

<sup>2</sup> Sec. 858, Rev. Stat.

§ 1009. <sup>1</sup> See 1 Greenleaf Ev. §§ 4-6; Robinson, Elementary Law, § 293.

That courts take judicial notice of all

other nations and their seals of State, but not of their inferior departments and seals, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881),

ment, accept these six classes of facts as established, without the production of any testimony, and a judge may refer to any source of recognized authority in order to refresh his memory concerning them.<sup>2</sup> They also take judicial notice of all objects in common use in the arts, and of all matters of ordinary knowledge, including matters of science, but not of the substantial differences between the successive conditions of the same material in the various stages of its manufacture.<sup>3</sup>

19 O. G. 1493 ; 7 Fed. Rep. 469 ; 19 Blatch. 209.

That a French patent, certified by the Director of the Conservatoire National des Arts et Metiers de France, under seal of that Department, verified by the Minister of Agriculture and Commerce and the Minister of Foreign Affairs under their seals, is duly authenticated and admissible, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881), 19 O. G. 1493 ; 7 Fed. Rep. 469 ; 19 Blatch. 209.

<sup>2</sup> That matters of public notoriety, affecting the right of the applicant to a patent, will be taken notice of judicially, see *Anson v. Woodbury* (1877), 12 O. G. 1.

That courts may refresh their recollections by any safe means, see *Brown v. Piper* (1875), 91 U. S. 37 ; 10 O. G. 417.

<sup>3</sup> That a court will take judicial notice of all things in common use and of all matters of common knowledge, see *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444 ; 39 O. G. 589 ; *Reed v. Lawrence* (1886), 29 Fed. Rep. 915 ; *King v. Gallun* (1883), 109 U. S. 99 ; 25 O. G. 980 ; *McCloskey v. Du Bois* (1881), 19 O. G. 1286 ; 20 O. G. 371 ; 8 Fed. Rep. 710 ; 19 Blatch. 205 ; *Terhune v. Phillips* (1878), 99 U. S. 592.

That courts will judicially notice whatever is generally known, including matters of science, see *Slawson v. Grand St., Prospect Park, & Flatbush R. R.*

*Co.* (1883), 107 U. S. 649 ; 24 O. G. 99 ; *Brown v. Piper* (1875), 91 U. S. 37 ; 10 O. G. 417.

That courts will take judicial notice of mechanical devices of common knowledge, see *Aron v. Manhattan Ry. Co.* (1886), 26 Fed. Rep. 314 ; 34 O. G. 1508 ; *Knapp v. Benedict* (1886), 26 Fed. Rep. 627 ; 35 O. G. 1226.

That the court may avail itself of common knowledge of things to aid it in defining the scope of a patent, see *Knapp v. Benedict* (1886), 35 O. G. 1226 ; 26 Fed. Rep. 627.

That where, on a demurrer in equity, the facts of which the court must take judicial notice, show that the invention is not patentable, the bill may be dismissed, see *West v. Rae* (1887), 33 Fed. Rep. 45 ; *Kaolatype Engraving Co. v. Hoke* (1887), 30 Fed. Rep. 444 ; 39 O. G. 589.

That a court will not dismiss on demurrer for non-patentability unless the case is perfectly clear, see *Eclipse Mfg. Co. v. Adkins* (1888), 36 Fed. Rep. 554 ; *Blessing v. Copper Works* (1888), 34 Fed. Rep. 753.

That where a patent is manifestly void it is the duty of the court to charge the jury to render a verdict for the defendant, see *Torrent & Arms Lumber Co. v. Rodgers* (1884), 112 U. S. 659 ; 30 O. G. 449.

That courts do not take judicial notice of the contents of encyclopedias, etc., unless they are within the knowledge of persons in general, see *Kaola-*



§ 1010. Competency of Witnesses.

Any person of sufficient age and mental capacity is a competent witness in an action for infringement, unless the laws of the State in which the court is held exclude him on some other ground than that of interest or color.<sup>1</sup> In judging of the credibility of a witness, however, the jury may consider his interest in the cause, as a motive operating upon his disposition to disclose the truth, and in this point of view the rules by which the existence and degree of his interest were formerly determined as a test of competency are still important.<sup>2</sup> The ancient rules were founded upon sound reason and long experience, and in departing from them under the exigencies of modern jurisprudence, the legislatures and the courts have not intended to put interested and disinterested parties on an equal footing as witnesses to controverted facts. The interest which formerly disqualified altogether still weakens the effect of testimony, and ought to exercise a potent influence on the judgment of a jury when evidence proceeding from individuals once incompetent to testify is contradicted by evidence to which no corresponding imputation is attached. The interest which under the earlier rule rendered a witness incompetent was either that of a party to the suit, or that arising from the certainty that he must either gain or lose by the direct legal operation and effect of the judgment or that the record would be legal evidence for or against him in some other action. An interest in the question to be decided, or a remote and contingent interest in the cause itself, was not sufficient to disqualify.<sup>3</sup> This distinction is of great consequence in patent cases, where one question—the validity of the patent—may form the only real issue in numerous suits against different infringers, all of whom are, therefore, interested in the question to be decided in each case, though not

type Engraving Co. v. Hoke (1887), 30 Fed. Rep. 444; 39 O. G. 589.

That courts do not take judicial notice of substantial differences between the different states of materials, such as lead, &c., see McCloskey v. Du Bois (1881), 19 O. G. 1286; 20 O. G. 371; 8 Fed. Rep. 710; 19 Blatch. 205.

§ 1010. <sup>1</sup> Sec. 858, Rev. Stat.

<sup>2</sup> That the defendant's witnesses are infringers or employees of infringers may be shown to affect their evidence, see Wetherell v. Keith (1886), 27 Fed. Rep. 364; 37 O. G. 337.

<sup>3</sup> See 1 Greenleaf, Ev., § 389-397.

in the judgment to be rendered for or against the individual defendant. Thus, while the ancient rule was still in force, a witness was competent although another suit was pending against him for the infringement of the same patent, or though he was conceded to have used devices resembling those belonging to the plaintiff.<sup>4</sup> Persons who claimed exclusive privileges under the same patent, such as grantees of other sectional interests or the assignor of the defendant when not bound by a covenant of warranty, and persons whose sole connection with the suit consisted in the pecuniary aid which they afforded to the parties litigant, were also competent to testify.<sup>5</sup> In all these and in similar cases the jury are to pass upon the credibility of the witness on the ordinary grounds of interest and bias, uninfluenced by that presumption of a want of credibility which exists when he possesses such an interest as would formerly have excluded him from offering any evidence whatever.

#### § 1011. Credibility of Witnesses.

The credibility of a witness is measured by his ability as well as his disposition to disclose the truth. His ability to disclose the truth depends upon the accuracy of his perceptions, the retentiveness of his memory, and his power to embody his recollections in suitable expressions. Perceptions are more or less accurate according to the familiarity of the witness with the object perceived, and the degree of attention which he devotes to its examination. The retentiveness of his memory is determined by his natural or acquired capacity

<sup>4</sup> That a witness is competent though he is defendant in another action for infringement, see *Evans v. Hettich* (1822), 7 Wheaton, 453 ; 1 Robb, 417.

That a witness who uses a device like the plaintiff's is competent, since the judgment cannot affect him, see *Evans v. Eaton* (1818), 3 Wash. 443 ; 1 Robb, 193.

<sup>5</sup> That a grantee of a different sectional interest from the plaintiff is a competent witness, the verdict not being evidence against him, see *Buck v. Hermance* (1848), 1 Blatch. 322.

That the assignor of an alleged prior patent to the defendant is a competent witness, having no interest in the event of the suit, see *Treadwell v. Bladen* (1827), 4 Wash. 703 ; 1 Robb, 531.

That a person who contributes to a fund to pay the expenses of witnesses in attending court is a competent witness, as the verdict could not affect him, see *Evans v. Hettick* (1818), 3 Wash. 408 ; 1 Robb, 166.



of recollection, and the occasion he has had to keep the controverted fact in mind. His power to represent the fact, as he remembers it, in words is governed by his ordinary command of language, and by his knowledge or ignorance of the terms in which the characteristics of the fact remembered are commonly described. Among honest and unbiassed witnesses there may thus be vast differences of credibility, arising solely from the differences in their ability to perceive, remember, and narrate the truth. This is particularly the case in testimony relating to inventions, the proper understanding of which so often demands extensive prior knowledge and the most careful and exact investigation, while their distinctive characteristics easily escape the memory unless it is constantly refreshed by re-investigation, and even when clearly recollected can be adequately described only in technical language which the most intelligent jury must fail to comprehend.<sup>1</sup> No question presents a greater difficulty, in this respect, than that of prior use, where the art or article by which the patented invention

§ 1011. <sup>1</sup> In *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86, Sprague, J. : (96) "Two things are to be regarded in weighing the testimony of all who testify, — the ability of the witness to tell the truth, and his disposition to tell the truth. These do not always go together. The ability to tell the truth as to past transactions, or those events that have transpired, may depend, in the first place, upon the accuracy of the observation, and in the accuracy of the knowledge at the time; then upon the occasion that the party has had to keep it in his mind and memory since; and in the tenacity of his memory is his ability. His disposition, his moral integrity, or freedom from bias, may lead him to testify one way or the other. Now, the accuracy of knowledge at the time, as well as the ability of the man to testify the truth, depend very much upon the subject-matter. Some things that men have a full, clear, and perfect knowledge of at the time they transpire,

may not be of that interesting character that they retain them in their memory. There are other things of which their knowledge at the time may not be perfect; and when you come to the question of machinery, a question of structure, the question whether the person had a full knowledge at the time may depend upon his habit of accurate observation, and his opportunity of observing the particular structure or machine, and his intelligence or understanding of it. For if he had not a clear idea at the time, of course he cannot have immediately afterward a very clear idea to communicate to others. You will consider, therefore, in weighing the evidence as to what it is that the witnesses undertake to describe, how far you can rely upon their memory in undertaking now to say what that was; so that you can ascertain the instrument, the operations, and effects, so as to compare that with the plaintiff's machine."

is claimed to have been anticipated has passed out of existence, and remains only in the memories of those who saw or used it. Unless the invention were so simple or so universal as to become a matter of ordinary knowledge, or were so fully understood and carefully examined by witnesses whose recollection cannot be impeached that it can be substantially reproduced from their description, it is evident that no great reliance can be placed on any impressions they may have concerning its identity with that which forms the subject of the patent.<sup>2</sup> Courts, therefore, are frequently called upon to caution juries against undue dependence upon such uncertain evidence, and to disparage witnesses whose disposition to disclose the truth is undeniable.

### § 1012. Expert Witnesses.

The uncertainty which, on this account, attaches to the testimony of an ordinary witness, in cases where the character and identity of inventions are in controversy, has led to the employment of a special class of witnesses, whose previous training and accurate habits of observation fit them to perceive, remember, and explain the essential attributes of the inventions submitted to their judgment.<sup>1</sup> Notwithstanding the strictures passed upon expert testimony by many jurists on each side of the Atlantic, and the truth of the assertions by which these censures have been justified, it is still certain

<sup>2</sup> That evidence from long recollection is often delusive, see *Parker v. Hulme* (1849), 1 *Fisher*, 44.

That evidence of witnesses as to events occurring thirty years before is not of great weight when unsupported by exhibits, and not consistent with admitted facts, see *Seibert Cylinder Oil Cup Co. v. Nightingale* (1887), 32 *Fed. Rep.* 171; 41 *O. G.* 1041.

That evidence of prior use when the thing used is not produced is of little weight, after a long interval, as to its identity with the patented invention, see *Adams & Westlake Mfg. Co. v. Rathbone* (1886), 26 *Fed. Rep.* 262; *Wetherell v. Keith* (1886), 27 *Fed. Rep.* 364;

37 *O. G.* 337; and other cases cited under § 1026, *post*, in reference to evidence of prior use.

That evidence of prior use is to be weighed in view of the lapse of time since the alleged use, see *Yale Lock Mfg. Co. v. Berkshire Nat. Bank* (1885), 26 *Fed. Rep.* 104.

§ 1012. <sup>1</sup> That the opinions of experts are admitted, contrary to the general rule that witnesses must testify to facts, see *Conover v. Rapp* (1859), 4 *Fisher*, 57.

That no person is an expert unless skilled in the science involved, see *Allen v. Hunter* (1855), 6 *McLean*, 303.



that in most patent cases expert evidence is, and must always be, indispensable.<sup>2</sup> That the expert is consulted before he is summoned as a witness; that when his opinion is unfavorable to the party who consults him he is not produced in court, at least on that side of the case; that when called as a witness his testimony is expected to support, and generally does support, the claims of the litigant on whose behalf he is presented,—are no doubt true; but this is only what occurs in every other trial where counsel have properly prepared their case.<sup>3</sup> The error lies with those who ascribe judicial functions to the patent-expert, and demand of him such freedom from partisanship as the exercise of judicial power requires. That there are experts in other departments of affairs upon whose opinion the court is forced to rely as the foundation of its own judgments, because incapable of forming an opinion for itself, and that such experts consequently fill the places of judges and should be beyond the influence and control of parties, must be conceded. But such is not the case with patent-experts, whose opinion is received in evidence only in connection with the reasons on which it is based, and is to be accepted or rejected by the jury according to their own view of its fallacy or truth.<sup>4</sup> The patent-expert, considered in his real

<sup>2</sup> That expert evidence is of little value, see *American Middlings Purifier Co. v. Christian* (1877), 4 Dillon, 448; 3 Bann. & A. 42; *King v. Louisville Cement Co.* (1873), 6 Fisher, 336; 4 O. G. 181.

That *ex parte* affidavits of experts are not valuable, see *Sargent v. Carter* (1857), 1 Fisher, 277.

<sup>3</sup> That experts usually agree where the data are the same, see *Sargent v. Carter* (1857), 1 Fisher, 277.

<sup>4</sup> In *Conover v. Roach* (1857), 4 Fisher, 12, Hall, J. : (27) "In reference to these opinions, it happens as it usually does in patent cases, that the opinions of the two experts on one side are apparently, if not actually, diametrically opposed to the opinions of the two experts on the other side. Indeed,

it may be assumed in this and in most other patent cases, that neither party would have called the experts on his own side, unless he had supposed that their opinions, in reference to the straining point of the case, would be directly opposed to the opinions which he supposes will be expressed by the experts of his adversary. Their well considered and deliberately formed opinions are asked in advance, and if they are found to be adverse to the party who seeks such opinion, that expert is not called on his part. I do not say this, gentlemen, to impeach the integrity or fairness of the experts, or to convey the impression that they are wanting in intelligence or mechanical knowledge, for few experts possess any of these qualities in a higher degree than those called in this

character, is an explorer, gifted with unusual powers of discernment and apprehension; a chronicler, trained to preserve the recollection of the essential attributes of things; an expositor, fitted to embody those essential attributes in accurate and intelligible language; a monitor, able to suggest the conclusions which follow from the premises he has described. His relation to the jury is not unlike that which counsel sustain to the court, as guides to a correct decision of the issues severally confided to their judgment,—the one pointing out facts and applying them in support of the claims advanced by his employer, as the other produces his authorities and applies them to the maintenance of his claims of law.<sup>5</sup> As no wise judge would undervalue the assistance which industrious and learned advocates afford him, on the ground that each was wedded to his own side of the cause, so no tribunal engaged in the examination of inventions can safely reject the light which the skill and experience of expert witnesses, though manifestly partisans, enable them to throw upon the nature and scope of an invention and its essential identity with, or diversity from, other inventions by which it is asserted to have been anticipated or to be infringed.<sup>6</sup> Their statements of fact are simply to be weighed, like those of all

case; but to show you that upon these questions of mechanical equivalents, of substantial identity, and substantial difference of organization and mode of operation, these *opinions* are to be regarded by you as *opinions* merely, and that you must decide which opinions are correct, after carefully considering such opinions, and the reasons upon which the experts have told you they are based, in connection with the other evidence in the case and that furnished by your own senses in the examination of the models which have been given in evidence. In no other way can you decide between the conflicting opinions of these experts, and it is your opinions and judgments, and not the opinions of the experts which must, in the end, determine the questions of substantial identity and equivalents litigated in the

case. In that you are to consider the evidence, the opinions of the experts, the reasons they have given for their opinions, to look and consider the models, to deliberately exercise your own judgments, and then decide.”

<sup>5</sup> That a patent-expert is an “auxiliary counsellor” who argues upon the law and the facts, see *Steam Gauge & Lantern Co. v. Ham Mfg. Co.* (1886), 28 Fed. Rep. 618.

<sup>6</sup> That expert evidence is of great value in patent cases, see *Potter v. Muller* (1864), 2 Fisher, 465; *Morris v. Barrett* (1859), 1 Bond, 254; 1 Fisher, 461; *Carr v. Rice* (1856), 1 Fisher, 198; *French v. Rogers* (1851), 1 Fisher, 133; *Parker v. Stiles* (1849), 5 McLean, 44; *Allen v. Blunt* (1845), 3 Story, 742; 2 Robb, 288; *Brooks v. Jenkins* (1844), 3 McLean, 432.



other witnesses, by their ability and disposition to disclose the truth; and their opinions are to be followed when, in the judgment of the jury, they are supported by the facts from which they are deduced.<sup>7</sup>

§ 1013. **Classes of Expert Witnesses: their Distinctions.**

Patent-experts are of two classes, — scientific experts and mechanical experts. A scientific expert is a witness who has made himself familiar, by study or experiments, with the principles of any science, and has thereby become qualified to understand, distinguish, and explain the properties of the objects to which such science appertains. A mechanical expert is a witness who, by practical training in an art, has acquired a degree of skill in its rules and manipulations which enables him to comprehend and apply its various instruments and methods.<sup>1</sup> The spheres of these two classes of experts are entirely distinct. The former brings to the examination of

<sup>7</sup> That expert evidence is not conclusive on the jury, see *Many v. Sizer* (1849), 1 Fisher, 17.

That expert evidence is judged by the same standards as ordinary evidence, see *May v. County of Fond du Lac* (1886), 27 Fed. Rep. 691; *Carter v. Baker* (1871), 4 Fisher, 404; 1 *Sawyer*, 512; *Page v. Ferry* (1857), 1 Fisher, 298.

That the jury are to give such weight to expert evidence as they see fit, according to its credibility, see *Johnson v. Root* (1858), 1 Fisher, 351; *Allen v. Hunter* (1855), 6 McLean, 303; *Brooks v. Jenkins* (1844), 3 McLean, 432.

That the evidence of experts usually varies, and their value depends on their skill, not their number, see *Brooks v. Bicknell* (1845), 4 McLean, 70.

That the value of expert opinions is measured by their reasons, see *Parham v. American Buttonhole, Overseaming & Sewing Mach. Co.* (1871), 4 Fisher, 468; *Jordan v. Dobson* (1870), 4 Fisher, 232; 7 *Phila.* 533; 2 *Abbott*, 398;

*Johnson v. Root* (1858), 1 Fisher, 351; *Whipple v. Baldwin Mfg. Co.* (1858), 4 Fisher, 29; *United States Annunciator & Bell Telegraph Mfg. Co. v. Sanderson* (1854), 3 Blatch. 184.

That when experts disagree the court will make an examination and decide for itself, see *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 *Bann. & A.* 428.

That in a conflict of scientific evidence the court may employ an independent expert to give advice as to the judgment, see *Anilin v. Levinstein* (1883), L. R. 24 Ch. D. 156.

That the evidence of an expert based on facts prevails over that of another based on mere theories, see *Béné v. Jeantet* (1889), 129 U. S. 685.

§ 1013. <sup>1</sup> That one "skilled in the art," a practical operator, not a scientific theorist, is an expert, see *Page v. Ferry* (1857), 1 Fisher, 298.

See for a description of these two classes of experts, *Curtis on Patents*, §§ 479-481.

an invention a broad and general knowledge of the fundamental truths of science, of the properties of matter, of the laws of chemistry and physics, of the progress of the arts, of the field open to inventors at any given period of time, and of the tests by which ideas of means can be distinguished from each other. His services become available whenever the character of an invention is to be determined, or its apparent scope is to be limited by the condition of the art at the date of its production, or the line is to be drawn between it and similar but independent triumphs of inventive skill.<sup>2</sup> Thus the evidence of scientific experts is admissible upon the following questions: (1) Whether the alleged invention is or is not the result of an inventive act; (2) Whether the elements described in the patent as constituting the invention, or included in its practical embodiment, are all essential to the expression of its idea of means; (3) Whether a given invention embraces or excludes a different invention; (4) Whether a given invention is substantially the same in principle, in function, or in effect, with any other invention. The mechanical expert, on the other hand, represents the skilled workman in his art, and brings to his examination of an invention the practical knowledge which enables him to pass upon its usefulness, and on his own ability or that of other artisans to reproduce it from the disclosure made by its inventors. His evidence is important in the following cases: (1) Where, on a defence of want of novelty, a prior patent or publication has been offered, as to the sufficiency of whose description of the invention a dispute has arisen; (2) Where the defence is

<sup>2</sup> That expert evidence is admissible to prove that the principle of two inventions is the same, see *Tillotson v. Ramsay* (1878), 51 Vt. 309; *Tucker v. Spaulding* (1871), 13 Wall. 453; 1 O. G. 144; 5 Fisher, 297; *Page v. Ferry* (1857), 1 Fisher, 298.

That experts are admitted to testify on questions of mechanical difference, and if qualified and unbiassed, their opinions are entitled to great respect, see *Morris v. Barrett* (1859), 1 Fisher, 461; 1 Bond, 254.

That whether one thing is the equivalent of another is a question of fact on the evidence of experts on an inspection of the inventions, see *Foss v. Herbert* (1856), 2 Fisher, 31; 1 Bissell, 121.

That an expert cannot testify, from his investigation of books and otherwise, that the invention was well known before the application, this being matter of fact and not opinion, see *McMahon v. Tyng* (1867), 14 Allen, 167.



based on the alleged inutility of the invention ; (3) Where the defendant claims that the description in the specification of the patent is ambiguous, and does not furnish to those skilled in the art the necessary guidance in the practice of the invention. The wide diversity between these spheres of expert evidence, and between the qualifications of the witnesses in each, does not, however, forbid the same person from appearing and testifying in both capacities, if he possesses the required skill and knowledge.

**§ 1014. Expert Testimony: when Admissible.**

The opinions of experts, with their reasons, are admissible in reference to questions which are to be decided by the court, as well as upon those which are to be submitted to the jury, provided the subject-matter of the question is one to which such evidence can be properly applied. The construction of a patent lies within the province of the judge, whose duty it is to determine, from the specification of the patent, what the invention is, and whose interpretation of the patent thus furnishes the standard with which all alleged infringing or anticipating inventions are to be compared.<sup>1</sup> Whether a prior patent covers the same invention as the patent in dispute, and whether a re-issue departs from its original, are also questions settled by the court, which construes each of the related patents, and judges their inventions to be identical, or distinct, or one inclusive of the other. In the performance of this duty of construction, the court is at liberty to avail itself of expert evidence to such an extent as it deems expedient.<sup>2</sup> Neither party has a right to offer it, nor is it error in the judge to refuse to admit or consider it.<sup>3</sup> On the contrary, if

§ 1014. <sup>1</sup> That the evidence of experts is useful to show the operation of devices, but they cannot tell what the patent is for (this being the province of the court), nor whether it has been infringed (this being for the court and jury), see *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43.

That the opinion of a witness as to

whether a patent is for a process or a machine is not admissible, see *Corning v. Burden* (1853), 15 How. 252.

<sup>2</sup> That experts may aid the court in construing a patent, see *Day v. Stellman* (1859), 1 Fisher, 487 ; *Winans v. N. Y. & Erie R. R. Co.* (1858), 21 How. 88.

<sup>3</sup> That the judge cannot be compelled to receive expert evidence to aid

an inspection of the invention practised by the defendant, in connection with the one described and claimed in the patent, satisfies the court that there has been no infringement, or if its interpretation of the present and a prior patent proves the former void for want of novelty, or if it is apparent that a re-issue cannot legitimately bear a construction which will enable it to be regarded as an amendment of its original, there is no occasion for extraneous evidence, and the court should direct the jury to return a verdict for the defendant without further inquiry.<sup>4</sup> In any doubtful case, however, the

in construing a patent, but may call on experts if he desires it, see *Winans v. N. Y. & Erie R. R. Co.* (1858), 21 How. 88.

<sup>4</sup> In *Bischoff v. Wethered* (1869), 9 Wall. 812, Bradley, J. : (814) "It is undoubtedly the common practice of the United States Circuit Courts, in actions at law, on questions of priority of invention, where a patent under consideration is attempted to be invalidated by a prior patent, to take the evidence of experts as to the nature of the various mechanisms or manufactures described in the different patents produced, and as to the identity or diversity between them ; and to submit all the evidence to the jury under general instructions as to the rules by which they are to consider the evidence. A case may sometimes be so clear that the court may feel no need of an expert to explain the terms of art or the descriptions contained in the respective patents, and may therefore feel authorized to leave the question of identity to the jury, under such general instructions as the nature of the documents seems to require. And in such plain cases the court would probably feel authorized to set aside a verdict unsatisfactory to itself, as against the weight of evidence. But in all such cases the question would still be treated as a question of fact for the jury, and not as a question of law for the court. And

under this rule of practice, counsel would not have the right to require the court, as matter of law, to pronounce upon the identity or diversity of the several inventions described in the patents produced. Such, we think, has been the prevailing rule in this country, and we see no sufficient reason for changing it. The control which the courts can always exercise over unsatisfactory verdicts will enable them to prevent any wrong or injustice arising from the action of juries ; whereas, if the courts themselves were compellable to decide on these often recondite and difficult questions, without the aid of scientific persons familiar with the subjects of the inventions in question, they might be led into irremediable errors which would produce great injustice to suitors. We are disposed to think that the practice adopted by our courts is, on the whole, the safest and most conducive to justice. It may be objected to this view that it is the province of the court, and not the jury, to construe the meaning of documentary evidence. This is true. But the specifications of patents for inventions are documents of a peculiar kind. They profess to describe mechanisms and complicated machinery, chemical compositions, and other manufactured products which have their existence *in pais*, outside of the documents themselves, and which are commonly described by terms



courts accept the aid of experts, and when their opinions are supported by sufficient reasons, attach to them great value and importance. But neither a court nor a jury are permitted to follow the guidance of any expert in defiance of the results of practical operation and experiment, nor against conclusions derived by necessary inferences from established facts.<sup>5</sup>

of the art or mystery to which they respectively belong ; and these descriptions and terms of art often require peculiar knowledge and education to understand them aright ; and slight verbal variations, scarcely noticeable to a common reader, would be detected by an expert in the art, as indicating an important variation in the invention. Indeed, the whole subject-matter of a patent is an embodied conception outside of the patent itself, which, to the mind of those expert in the art, stands out in clear and distinct relief, whilst it is often unperceived, or but dimly perceived, by the uninitiated. This outward embodiment of the terms contained in the patent is the thing invented, and is to be properly sought, like the explanation of all latent ambiguities arising from the description of external things, by evidence *in pais*."

In *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64, Sprague, J. : (76) "It will not follow that because experts have expressed an opinion that Whipple's patent is like a preceding patent, the court will consider that as evidence to go to a jury. The court must look at it itself. It might be urged, I know, that this is evidence, and that, therefore, it is a matter to be weighed by a jury. That is not always true of opinions of experts. We must see how much the opinions of experts embody questions of law as well as of

fact, or whether they embrace in them any question of law. When a question of law is involved in the opinion of experts, that is not to be left to a jury ; and when the fact stated involves, in effect, the construction of a patent, that fact is founded on a question of law, and is of no force except as it embraces a question of law. Consequently the opinion of the experts contains nothing to go to a jury and in fact nothing on which they can sustain themselves."

See also § 1019 note 2, *post*.

<sup>5</sup> That the opinions of experts cannot prevail over established facts, see *Tilghman v. Werk* (1862), 2 Fisher, 229 ; 1 Bond, 511.

That expert opinions are outweighed by practical operation and experiment, see *Hudson v. Draper* (1870), 4 Fisher, 256 ; 4 Clifford, 178.

That the opinion of experts that a device is impracticable does not weigh much against evidence that it succeeds in actual use, see *Seymour v. Marsh* (1872), 2 O. G. 675 ; 6 Fisher, 115 ; 9 Phila. 380.

That for the purpose of an injunction *ex parte* affidavits and opinions of experts, contradicted by equal evidence, prove neither the validity of the plaintiff's patent nor an infringement, see *Pullman Palace Car Co. v. Baltimore & Ohio R. R. Co.* (1881), 19 O. G. 224 ; 4 Hughes, 236 ; 5 Fed. Rep. 72.

§ 1015. **Documentary Evidence in Actions at Law for Infringement.**

The principal documentary evidence available in actions for infringement is drawn from the files and records of the Patent Office, and from the private agreements of the parties. The patent in dispute is admissible, if regular on its face, though it contains no recital that the prerequisites have been fulfilled.<sup>1</sup> Other patents, whether foreign or domestic, when duly verified by the appropriate officers according to the law of the government from which they issue, are also admissible when relevant to the matter in controversy.<sup>2</sup> The specifications, drawings, and models annexed to or connected with such patents are likewise proper evidence if legally authenticated.<sup>3</sup> Assignments, grants, and licenses are competent to show the title to the patented invention, and the authority conferred on the defendant to make, or use, or sell it.<sup>4</sup> A caveat may be offered to prove the claims of the caveator

§ 1015. <sup>1</sup> That a patent is admissible though it contains no recital that the prerequisites were fulfilled, see *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448 ; 2 Robb, 46.

That a patent not properly signed is not evidence nor can copies of the record of the patent as complete be admitted, see *Marsh v. Nichols* (1888), 128 U. S. 605 ; *Marsh v. Nichols* (1883), 24 O. G. 901 ; 15 Fed. Rep. 914.

<sup>2</sup> That foreign patents duly authenticated are admissible when relevant, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881), 19 O. G. 1493 ; 7 Fed. Rep. 469 ; 19 Blatch. 209.

<sup>3</sup> That specifications annexed to or connected with their applications are admissible, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881), 19 O. G. 1493 ; 7 Fed. Rep. 469 ; 19 Blatch. 209 ; *Northwestern Fire Extinguisher Co. v. Phila. Fire Extinguisher Co.* (1874), 10 Phila. 227 ; 1 Bann. & A. 177 ; 6 O. G. 34 ; *Davis v. Gray* (1867), 17 Ohio St. 330 ; *Winans v. Schenectady & Troy R. R. Co.* (1851), 2 Blatch.

279 ; *Peck v. Farrington* (1832), 9 Wend. 44.

That drawings may be shown in evidence, see *Tinker v. Wilbers Eureka Mower & Reaper Mfg. Co.* (1880), 1 Fed. Rep. 138 ; 5 Bann. & A. 92 ; *Winans v. Schenectady & Troy R. R. Co.* (1851), 2 Blatch. 279.

That models may be admitted, see *Everet v. Thatcher* (1878), 2 Flippin, 234 ; 3 Bann. & A. 435 ; 16 O. G. 1046 ; *Johnsen v. Beard* (1875), 2 Bann. & A. 50 ; 8 O. G. 435 ; *Carter v. Baker* (1871), 1 Sawyer, 512 ; 4 Fisher, 404 ; *Swift v. Whisen* (1867), 2 Bond, 115 ; 3 Fisher, 343 ; *Blanchard v. Puttman* (1867), 2 Bond, 84 ; 3 Fisher, 186.

<sup>4</sup> That an assignment may be offered in evidence, see *Dederick v. Whitman Agricultural Co.* (1886), 26 Fed. Rep. 763 ; 36 O. G. 570 ; *New York Pharmaceutical Association v. Tilden* (1883), 21 Blatch. 190 ; 23 O. G. 272 ; 14 Fed. Rep. 740 ; *Lee v. Blandy* (1860), 2 Fisher, 89 ; 1 Bond, 361 ; *Pitts v. Whitman* (1843), 2 Story, 609 ; 2 Robb, 189.



concerning the invention at the date of its transmission to the Patent Office, and the existence in his mind of the ideas therein described, but not that the invention was then wholly or in part perfected.<sup>5</sup> A disclaimer is appropriate evidence upon the question of abandonment, or to limit the scope of the invention to which it refers, and is admissible if signed and filed by the patentee.<sup>6</sup> The application for the patent, and the correspondence of the applicant with the Patent Office in explanation or assertion of his rights, may be produced as declarations accompanying an act, and as tending to define the nature of the patented invention and the relations toward it of the applicant and patentee.<sup>7</sup> Preliminary papers filed by third parties are generally inadmissible, being *res inter alios acta*, and mere hearsay evidence;<sup>8</sup> but are some-

<sup>5</sup> That a caveat surreptitiously placed on file is admissible for what it is worth, although the attorney who placed it there has been disbarred, see *Campbell v. James* (1879), 18 O. G. 979; 17 Blatch. 42; 4 Bann. & A. 456. See also § 446 and notes, *ante*.

<sup>6</sup> That a disclaimer is not admissible unless proved to be signed by the patentee, and shown to be either an original or a certified copy, see *Foote v. Silsby* (1849), 1 Blatch. 445.

<sup>7</sup> That the application of the patentee is admissible, see *Toohy v. Harding* (1880), 1 Fed. Rep. 174; 4 Hughes, 253; 5 Bann. & A. 195.

That the correspondence with the Patent Office is admissible as a declaration accompanying an act or *res gestæ*, see *Allen v. Blunt* (1846), 2 W. & M. 121; 2 Robb, 530.

That the file-wrapper and contents are admissible to show the transactions between the inventor and the Patent Office, see *Sutter v. Robinson* (1886), 119 U. S. 530; 38 O. G. 230.

That the file-wrapper and correspondence between the patentee and the Office are admissible to aid in the interpretation of the patent, see *Wirt v. Brown* (1887), 32 Fed. Rep. 283.

That the preliminary statement filed in interference proceedings is admissible evidence in the courts, see *Detroit Lubricator Co. v. Lunkenheimer* (1886), 30 Fed. Rep. 190; 38 O. G. 331.

That evidence of what passed in the Patent Office pending the examination of an application is admissible, see *Ewart Mfg. Co. v. Bridgeport Malleable Iron Co.* (1887), 31 Fed. Rep. 149.

That the correspondence between the Patent Office and the inventor is admissible to show what the latter said his Claims meant, see *Pike v. Potter* (1859), 3 Fisher, 55.

That letters of the plaintiff to the Secretary of State containing the application and specification and certified under seal as papers in that department are admissible, see *Pettibone v. Derringer* (1818), 4 Wash. 215; 1 Robb, 152.

<sup>8</sup> That preliminary papers filed in the Patent Office by strangers to the litigated patent are mere declarations of third parties and are hearsay, see *Howes v. McNeal* (1880), 17 O. G. 799; 17 Blatch. 396; 4 Fed. Rep. 151; 5 Bann. & A. 77.

times received to fix a date or to describe more clearly the attributes of an invention whose existence has been otherwise established.<sup>9</sup> Of all these documents written or printed copies, authenticated by the seal of the Patent Office and certified by the Commissioner or Assistant Commissioner, are by statute made evidence of equal weight and pertinency with the originals.<sup>10</sup> The admissibility of private writings, includ-

<sup>9</sup> In *Northwestern Fire Extinguisher Co. v. Phila. Fire Extinguisher Co.* (1874), 6 O. G. 34, McKennan, J.: (37) "But it does not follow that a rejected specification and drawings are, under all circumstances, inadmissible as evidence. By themselves they are inconsequential, but when the inventor's idea is perfected by a practical adaptation of it, in the form of mechanism, they are valuable guides in ascertaining the date of the invention, the design of the inventor, and the principle, intended functions, and mode of operation of his mechanism, and they must, therefore, necessarily be considered in connection with it." 10 Phila. 227 (231); 1 Bann. & A. 177 (186).

That the contents of a re-issue file may be examined in order to determine the scope of the re-issue, see *Hopkins & Dickinson Mfg. Co. v. Corbin* (1881), 103 U. S. 786; 20 O. G. 297.

<sup>10</sup> That the statute renders admissible copies of records, &c., in the Patent Office and patents duly authenticated in the United States, and copies duly certified of the specifications of foreign patents, and makes them *prima facie* evidence, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881), 19 O. G. 1493; 7 Fed. Rep. 469; 19 Blatch. 209; *Brooks v. Jenkins* (1844), 3 McLean, 432; *Peck v. Farrington* (1832), 9 Wend. 44.

That the copies of foreign patents deposited in the Patent Office sufficiently show their dates and numbers, see *Ex parte Trotter* (1885), 32 O. G. 1603.

That a copy of a drawing filed under Sec. 1, act of 1837, where the original had none, is admissible, and with the original patent and specification is *prima facie* evidence of the particulars of the invention, see *Winans v. Schenectady & Troy R. R. Co.* (1851), 2 Blatch. 279.

That a copy of a second drawing, filed to amend one which was filed to supply one burnt in 1837, is admissible, see *Emerson v. Hogg* (1845), 2 Blatch. 1.

That a certified and sealed copy of the specifications not accompanied by a copy of the patent to which they belong is not evidence of the existence or contents of the patent, see *Davis v. Gray* (1867), 17 Ohio St. 330.

That certified copies of papers in the Patent Office, such as applications, letters, waivers, &c., may be admitted in proper cases, see *Toohy v. Harding* (1880), 1 Fed. Rep. 174; 4 Hughes, 253; 5 Bann. & A. 195.

That certified copies of assignments, &c., are admissible, see *Dederick v. Whitman Agricultural Co.* (1886), 26 Fed. Rep. 763; 36 O. G. 570; *Lee v. Blandy* (1860), 2 Fisher, 89; 1 Bond, 361; *Brooks v. Jenkins* (1844), 3 McLean, 432.

That an incorrect transcript from the Patent Office may be corrected by a new transcript, see *Brooks v. Jenkins* (1844), 3 McLean, 432.

That a clerk in the Patent Office is a proper witness to prove what documents are on record or on file in the Patent Office, see *Sone v. Palmer* (1859), 28 Mo. 539.



ing contracts, books kept in the usual course of business, and entries against interest, as well as that of parol evidence to supply defects and correct errors in the written, are governed by the same rules as in ordinary actions.<sup>11</sup>

### § 1016. The Patent as Evidence.

A patent, regular on its face, is *prima facie* evidence of all the facts which are essential to its own validity.<sup>1</sup> This rule appeared as an express provision in the act of 1790; and though omitted from subsequent statutes, and discarded by

<sup>11</sup> That pleadings in avoidance are not evidence, but are to be supported by evidence, see *Howe v. Williams* (1863), 2 Clifford, 245; 2 Fisher, 395.

That records of companies of which the plaintiff is not a member cannot be offered by the defendant, see *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

That records showing that a certain company acknowledged the plaintiffs as inventors of an art cannot be read, the defendant not being a member of the company and not claiming that the company invented it, see *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

That parol proof of lost memoranda, containing a list of persons to whom the patentee has sold rights and showing a sale to the defendant's assignors is inadmissible, such right not being capable of proof by parol, see *Baldwin v. Sibley* (1858), 1 Clifford, 150.

§ 1016. <sup>1</sup> That the patent is *prima facie* evidence of its own validity, and can be overcome only by clear evidence, see *Frankfort Whiskey Process Co. v. Mill Creek Distilling Co.* (1889), 37 Fed. Rep. 533; *Vulcanite Paving Co. v. American Artificial Stone Paving Co.* (1887), 42 O. G. 828; *Comstock v. Sandusky Seat Co.* (1878), 3 Bann. & A. 188; 13 O. G. 230; *Kelleher v. Darling* (1878), 14 O. G.

673; 4 Clifford, 424; 3 Bann. & A. 438; *Storrs v. Howe* (1876), 10 O. G. 421; 4 Clifford, 388; 2 Bann. & A. 420; *Brady v. Atlantic Works* (1876), 10 O. G. 702; 4 Clifford, 408; 2 Bann. & A. 436; *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636; *Hoffheins v. Brandt* (1867), 3 Fisher, 218; *Wing v. Richardson* (1865), 2 Clifford, 449; 2 Fisher, 535; *Potter v. Holland* (1858), 1 Fisher, 382; 4 Blatch. 238; *Allen v. Hunter* (1855), 6 McLean, 303; *Heinrich v. Luther* (1855), 6 McLean, 345; *Brooks v. Jenkins* (1844), 3 McLean, 432; *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448; 2 Robb, 46.

That whenever the evidence is doubtful the patent will prevail, see *American Bell Telephone Co. v. People's Telephone Co.* (1884), 22 Fed. Rep. 309; 22 Blatch. 531; 29 O. G. 1029; *Crouch v. Speer* (1874), 6 O. G. 187; 1 Bann. & A. 145; *Agawam Co. v. Jordan* (1868), 7 Wall. 583.

That in order to defeat the patent the evidence must remove all reasonable doubt, see *Campbell v. Mayor of New York* (1831), 9 Fed. Rep. 500; 20 O. G. 1817; 20 Blatch. 67; *Shirley v. Sanderson* (1881), 8 Fed. Rep. 905.

That the issue of a patent is not conclusive proof of its validity, see *Andrews v. Hovey* (1888), 42 O. G. 1235.

the courts until after the reconstruction of the patent system by the act of 1836, it has ever since the latter date been recognized as an established doctrine of our law. Thus, until contradicted, the patent proves that the alleged invention is the result of an inventive act; that the patentee or his assignor was its first and true inventor; that the invention is patentable subject-matter; that it is new and useful; and has not been abandoned to the public. It also demonstrates that the patent was lawfully issued to the proper patentee; if a re-issue, that it corresponds with the original; if an extension, that the requirements of the law have been obeyed; that the invention described therein differs essentially from all other inventions described and claimed in any prior patent; that its specification is without fraud and free from ambiguity; that its Claims are not excessive and clearly define the actual invention; and that the patent has neither been surrendered nor repealed.<sup>2</sup> When the plaintiff is the patentee it

<sup>2</sup> In *Poppenhusen v. New York Gutta Percha Comb Co.* (1858), 2 Fisher, 62, Ingersoll, J.: (67) "And the law is that the patent, when produced in evidence, is *prima facie* evidence that the patentee was the inventor; that the thing patented was new and useful; and that in the specification there is contained a description in such full, clear, and exact terms as will enable any one skilled in the art to which it appertains to put it in practice from the description contained in the specification."

In *Potter v. Holland* (1858), 1 Fisher, 382, Ingersoll, J.: (387) "The patent is *prima facie* evidence that the several grants of right contained in it were valid, that the several things, methods, and devices granted were new, that they were useful, that they required invention, and that they were the invention of Wilson. And this *prima facie* evidence must have full effect, unless it is rebutted by countervailing evidence."  
4 Blatch. 238 (241).

In *Parker v. Stiles* (1849), 5 McLean,

44, Leavitt, J.: (60) "The patent, however, raises the presumption of the novelty and utility of the plaintiff's invention. Before a patent can issue, the person applying for it is required to make oath that he is, as he verily believes, 'the original and first inventor or discoverer' of the improvement or invention for which he seeks a patent. And it has been held that this oath, constituting as it does a part of the letters-patent, and being in evidence to the jury, forms a legal ground for the presumption of the novelty and originality of the patentees' claim, until the contrary be proved. Upon this inquiry the burden of proof is thrown upon the defendant; it being the province of the court to decide what constitutes novelty, and of the jury to determine from the evidence adduced whether the patentees' invention is new. The same remarks apply also to the subject of the utility of the invention."

That a patent is *prima facie* evidence that the invention has been made, that the patentee is the inventor, that the



is, in like manner, *prima facie* evidence of his legal title to the patented invention, and of his right to maintain an action for its infringement.<sup>3</sup> The weight of a patent as *prima facie* evidence is increased by its re-issue, by the success of the patentee in an interference proceeding, by its extension, and by the long and continuous recognition of its validity on the part of the public.<sup>4</sup> A patent granted to or owned by a de-

invention is new and useful, and that the patent has been lawfully issued, see *Byerly v. Cleveland Linseed Oil Works* (1887), 31 Fed. Rep. 73.

That a patent affords *prima facie* evidence of the patentee's right to all matters contained in it, see *Johnson v. Root* (1858), 1 Fisher, 351.

That a patent and a certified copy of the record thereof, and of its drawings are, under the act of Mar. 3, 1837, *prima facie* proof of the particulars patented, see *Winans v. N. Y. & Erie R. R. Co.* (1856), 1 Fisher, 213.

That the patent is *prima facie* evidence of novelty, see *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68; 41 O. G. 232; *Vulcanite Paving Co. v. American Artificial Stone Paving Co.* (1887), 42 O. G. 828; *Dean v. Hodge* (1886), 35 Minn. 146; *Lehnbeuter v. Holthaus* (1881), 105 U. S. 94; 21 O. G. 1783; *Miller v. Smith* (1880), 18 O. G. 1047; 5 Fed. Rep. 359; *Crouch v. Speer* (1874), 6 O. G. 187; 1 Bann. & A. 145; *Roberts v. Dickey* (1871), 4 Brews. (Pa.) 260; 4 Fisher, 532; 1 O. G. 4; *Tompkins v. Gage* (1865), 2 Fisher, 577; 5 Blatch. 268.

That the patent is *prima facie* evidence of utility, see *Kirk v. DuBois* (1887), 33 Fed. Rep. 252; *Dean v. Hodge* (1886), 35 Minn. 146; *Lehnbeuter v. Holthaus* (1881), 105 U. S. 94; 21 O. G. 1783.

See also as to each issue, §§ 1022-1040, and notes, *post*.

That where the state of the art has been shown, the question of patent-

ability is open, without any presumption arising from the patent, see *Adams v. Bellaire Stamping Co.* (1886), 28 Fed. Rep. 360; 36 O. G. 567.

<sup>3</sup> That the patent is *prima facie* evidence of the title of the patentee, see *Fischer v. Neil* (1881), 6 Fed. Rep. 89; 19 O. G. 603.

That a patent gives the patentee a *prima facie* right to recover from every infringer, see *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.* (1876), 10 O. G. 41; 13 Blatch. 375; 2 Bann. & A. 334.

<sup>4</sup> That a re-issue increases the weight of a patent as *prima facie* evidence, see *Tyler v. Crane* (1880), 7 Fed. Rep. 775; 19 O. G. 128; *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428.

That a recovery in interference aids the force of the patent, see *Ayling v. Hull* (1865), 2 Clifford, 494.

That an extension increases the weight of a patent as *prima facie* evidence, see *Tyler v. Crane* (1880), 7 Fed. Rep. 775; 19 O. G. 128; *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428; *Cook v. Ernest* (1872), 5 Fisher, 396; 2 O. G. 89; *Whitney v. Mowry* (1867), 3 Fisher, 157; 2 Bond, 45; *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115; *Ransom v. Mayor of New York* (1856), 1 Fisher, 252.

That long admitted validity is a strong support to a patent, see *Tyler v. Crane* (1880), 7 Fed. Rep. 775; 19 O. G. 129. See also §§ 1185-1188, and notes, *post*.

defendant or his licensor enjoys the same rank as evidence, and raises the same presumptions, as one issued to the plaintiff.<sup>5</sup> An extension or a re-issue represents its expired or surrendered original, and is *prima facie* evidence of all the facts necessary to the validity of either.<sup>6</sup> A patent furnishes no evidence, however, that the defendant has been guilty of infringement.<sup>7</sup>

### § 1017. Records of Former Judgments as Evidence.

The records of former judgments are admissible, not only as matters of estoppel, but for various purposes connected with the interpretation of the patent, the patentability of the invention, and the identity of the defendant's process or device with that protected by the patent. A judgment between the same parties, on the same issues, by the same or a superior tribunal, is conclusive against the defeated litigant and his privies, as well as against all who so participated in the suit as to control the conduct of the action.<sup>1</sup> Judgments on the same points between the same parties in co-ordinate or inferior tribunals are of more or less weight according to the nature of the points decided, and the consideration to which the tribunal may be legally entitled. Such judgments cannot be departed from in any manner which simply revives the former controversy and gives the defeated party a new trial on the merits of the decided cause, except in an appellate court

<sup>5</sup> That the defendant's patent raises the same presumptions of novelty, &c., see *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Blanchard v. Puttman* (1867), 3 Fisher, 186; 2 Bond, 84; *House v. Young* (1867), 3 Fisher, 335.

<sup>6</sup> That a re-issue has the same effect as evidence as the original, see *Serrell v. Collins* (1857), 1 Fisher, 289.

<sup>7</sup> That the patent is not *prima facie* evidence of infringement, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86.

§ 1017. <sup>1</sup> That all persons who are interested in the subject-matter of a suit and have a right to make defence,

control the proceedings, or produce evidence are bound by a decree, if they have knowledge of the suit, whether or not they appear to protect their rights, but all other persons are strangers to the cause, see *American Bell Telephone Co. v. National Improved Telephone Co.* (1886), 27 Fed. Rep. 663.

That a judgment is not *res adjudicata* except as to the exact points in controversy, see *Brush v. Naugatuck R. R. Co.* (1885), 23 Blatch. 277; 24 Fed. Rep. 371; 32 O. G. 894.

That a judgment is of no weight except upon the questions raised at the trial, see *Celluloid Mfg. Co. v. Tower* (1885), 26 Fed. Rep. 451.



to which the case is taken by due course of law. But these judgments, like those rendered in suits between other parties in the same or different tribunals, are often of great value upon questions relating to the construction of the patent, the identity and patentability of inventions, and other matters which must present the same aspects by whomsoever and wheresoever the questions may be raised; and in all such cases the records of these judgments, with the opinions of the court, are proper subjects for consideration, and may either be submitted in the form of evidence or cited as authorities bearing upon the issues in the case at bar.<sup>2</sup>

<sup>2</sup> That decisions of co-ordinate courts are of great weight and will usually be followed in order to preserve uniformity in the legal position of the patent, see *Celluloid Mfg. Co. v. Zylonite Brush & Comb Co.* (1886), 27 Fed. Rep. 291; 35 O. G. 1228.

That former judgments on the same patent will be followed where there is no new evidence, see *American Bell Telephone Co. v. Wallace Electric Co.* (1889), 37 Fed. Rep. 672.

That a judgment between other parties though not conclusive is entitled to great weight, see *Asmus v. Alden* (1886), 27 Fed. Rep. 684; 36 O. G. 231.

That a judgment is of greater weight against a person who was familiar with the suit and might have aided the defendant by suggestions, etc., than against one ignorant of it, see *Cary v. Lovell Mfg. Co.* (1885), 24 Fed. Rep. 141; 32 O. G. 1009.

That where a patent has been held invalid in one circuit, for not embracing patentable matter, no future bill will be entertained in that circuit on the same facts, see *McCloskey v. Hamill* (1883), 15 Fed. Rep. 750; 23 O. G. 2122.

That a concurrent line of decisions for years, in favor of a patent, are not conclusive in another circuit on other

states of fact, see *United Nickel Co. v. California Electrical Works* (1885), 25 Fed. Rep. 475; 11 Sawyer, 251.

That a judgment after a long contest covering all ordinary defences is almost conclusive upon the question of validity, see *Cary v. Domestic Spring-Bed Co.* (1885), 27 Fed. Rep. 299.

That no judgment can be a precedent unless rendered after full argument, see *Celluloid Mfg. Co. v. Tower* (1885), 26 Fed. Rep. 451.

That a former judgment sustaining the patent is of no weight where the present objections raise questions not before considered, see *Lockwood v. Faber* (1886), 27 Fed. Rep. 63.

That where the validity of a re-issue has been fully considered and decided in a former case, and an appeal is pending in the Supreme Court, no opinion will be expressed thereon, see *Green v. French* (1882), 11 Fed. Rep. 591; 21 O. G. 1351.

That the rejection of an application by the Patent Office is not *res adjudicata*, see *Mathews v. Flower* (1885), 25 Fed. Rep. 830; 33 O. G. 887.

That judgments of the Patent Office are *prima facie* not conclusive, see *Wilson v. Barnum* (1849), 2 Fisher, 635; 1 Wall. Jr. 347; 2 Robb, 749.

That the judgment of a State court for damages will not be enforced against

### § 1018. Burden of Proof.

Where the pleadings in an action for infringement are closed upon the general issue, either with or without notice, the burden of proof is upon the plaintiff in reference to all the averments in his declaration. He must offer evidence to show the patentability of the invention, the validity of the patent, his own legal title, the infringement by the defendant, and the damages he has sustained.<sup>1</sup> The exhibition of his patent, or a certified copy thereof, makes out a *prima facie* case upon the first and second of these points, and if he is the patentee, upon the third also.<sup>2</sup> If he is an assignee or grantee, the instruments of conveyance, or duly authenticated copies, are sufficient evidence of his right to sue.<sup>3</sup> His averments of infringement, and of damages if he would recover

the patent in the United States courts, see *Ryan v. Lee* (1882), 10 Fed. Rep. 917.

On this subject of former judgments and their effect as estoppels or precedents, see §§ 1175-1184, and notes, *post*.

§ 1018. <sup>1</sup> In *Reckendorfer v. Faber* (1875), 92 U. S. 347, Hunt, J. : (350) "Looking at this section alone it may be safely said no one is entitled to a patent unless (1) he has discovered or invented an art, machine, or manufacture; (2) which art, machine, or manufacture is new; (3) which is also useful; (4) which is not known or patented as therein mentioned. It is not sufficient that it is alleged, or supposed, or even adjudged by some officer to possess these requisites. It must in fact possess them; and that it does possess them the claimant must be prepared to establish in the mode in which all other claims are established, to wit, before the judicial tribunals of the country." 10 O. G. 71 (72).

That the burden of proof rests upon the plaintiff to show the validity of his patent, see *Miller v. Smith* (1880), 5 Fed. Rep. 359; 18 O. G. 1047;

*Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438; *Storrs v. Howe* (1876), 10 O. G. 421; 4 Clifford, 388; 2 Bann. & A. 420; *Brady v. Atlantic Works* (1876), 10 O. G. 702; 4 Clifford, 408; 2 Bann. & A. 436.

That the burden of proof as to infringement is on the plaintiff, see *Rogers v. Beecher* (1880), 18 O. G. 793; 5 Bann. & A. 619; 3 Fed. Rep. 639.

See also § 1041 and notes, *post*.

That the burden as to damages is on the plaintiff, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007; *Fitch v. Bragg* (1883), 16 Fed. Rep. 243; 21 Blatch. 302.

See also § 1071 and notes, *post*.

<sup>2</sup> That the patent is *prima facie* evidence of patentability, validity, and the title of the patentee, see § 1016 and notes, *ante*.

<sup>3</sup> That the production of duly authenticated instruments of assignment or grant satisfies the burden as to title, see *Brooks v. Jenkins* (1844), 3 McLean, 432.

See also § 1040 and notes, *post*.



more than nominal damages, must be supported by proper testimony.<sup>4</sup> On the last two issues the burden of proof remains upon him during the entire progress of the cause. On the first three it shifts to the defendant upon the exhibition of the patent and the muniments of title, and he must overcome the presumptions of patentability, validity, and ownership thus created, by clear and satisfactory evidence, removing every reasonable doubt.<sup>5</sup> Where the defendant files a special plea the burden rests on the party having the affirmative upon the pleadings as they are finally closed; but in this case also the patent satisfies the burden in reference to all the matters of which it is *prima facie* evidence, and imposes upon the defendant the task of overcoming its presumptions by conclusive proof.<sup>6</sup>

**§ 1019. Evidence concerning the Nature of the Patented Invention Limited by the Interpretation given to the Patent by the Court.**

A patent covers the invention or inventions which the court, in construing its provisions, decides that it describes and claims.<sup>1</sup> By this decision the parties and the jury are

<sup>4</sup> That the patent is not *prima facie* evidence of infringement, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86.

<sup>5</sup> That the patent being in evidence, and infringement shown by the plaintiff, the burden of proof rests on the defendant to show that the patent is invalid, unless it is defective on its face, see *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796; *Hoffheins v. Brandt* (1867), 3 Fisher, 218.

That unless the defendant by conclusive evidence overcomes the *prima facie* evidence of the patent, the novelty, and utility of the invention, its result from an inventive act, its invention by the patentee as the first and true inventor, and the validity of the patent, will be regarded as established, see *American Bell Telephone Co. v. People's Telephone Co.* (1884), 22 Fed. Rep. 309; 22 Blatch. 531; 29 O. G.

1029; *Cushman v. Parham* (1876), 9 O. G. 1108; *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459.

That where the evidence leaves a question in doubt the burden of proof is not satisfied, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86.

That where the burden of proof is on the defendant and the evidence is conflicting the plaintiff will prevail, see *Patterson v. Duff* (1884), 20 Fed. Rep. 641.

<sup>6</sup> That the burden of proof is on the defendant to sustain his plea or answer and support all his defences, see *Collender v. Came* (1876), 10 O. G. 467; 4 Clifford, 393; 2 Bann. & A. 412; *Crouch v. Speer* (1874), 6 O. G. 187; 1 Bann. & A. 145.

§ 1019. <sup>1</sup> That the patent grants what the court construes it to grant and

bound, and the former must present their cause, and the latter must determine it, upon the hypothesis that the invention really is what the court has thus interpreted it to be. Evidence offered under any other view of the patent is inadmissible, and a verdict based on any other construction is contrary to law and will be set aside and a new trial granted.<sup>2</sup> This rule applies to patents introduced by the defendant as well as to those on which the plaintiff's case depends. In its interpretation of a patent the court may have recourse to any testimony to explain the meaning of its language, or to expert evidence to ascertain the essential characteristics of the described invention and the differences between it and other patented inventions, or to papers in the Patent Office which are connected with the patent or whose contents were known to the inventor at the date of his application, to show the significance which he attached to the terms that he employed.<sup>3</sup> But of whatever aid the courts avail themselves, their interpretation must be based upon the patent as it stands, and when its scope is once fairly apparent it can neither be limited nor extended by extraneous evidence.<sup>4</sup>

the jury are so to take it, see *Johnson v. Root* (1858), 1 Fisher, 351; *Serrell v. Collins* (1857), 1 Fisher, 289; *Page v. Ferry* (1857), 1 Fisher, 298.

See also §§ 731-751, and notes, *ante*.

<sup>2</sup> That unless the jury follow the instructions of the court as to the meaning and effect of a patent the verdict will be set aside and a new trial granted, see *Johnson v. Root* (1862), 2 Clifford, 80; 2 Fisher, 291.

That patents offered in evidence by the defendant are to be construed by the court, and if as thus construed they do not support the issue they are inadmissible, see *Cahoon v. Ring* (1861), 1 Clifford, 592.

That the construction of a patent offered as evidence of prior invention is for the court, see *Clark Patent Steam & Fire Regulator Co. v. Copeland* (1862), 2 Fisher, 221.

That patents offered by defendant to defeat plaintiff's patent cannot be rendered admissible by extraneous evidence, see *Cahoon v. Ring* (1861), 1 Clifford, 592.

That the court may determine that the specification of the patent in question does not cover the same invention as a preceding patent, and the jury are bound by this decision, see *Serrell v. Collins* (1857), 1 Fisher, 289.

<sup>3</sup> That evidence is admissible to show the meaning of terms used in the patent, see *Loom Co. v. Higgins* (1882), 105 U. S. 580; 21 O. G. 2031.

See also § 1015 and notes, *post*.

<sup>4</sup> That the file-wrapper and contents are not admissible to limit the construction of the patent, see *Westlake v. Cartter* (1873), 6 Fisher, 519; 4 O. G. 636.

That correspondence with and proceedings in the Patent Office are not



§ 1020. Evidence Concerning the State of the Art at the Date of the Invention.

Evidence as to the state of the art at the date of the conception of an invention is always admissible for the purpose of showing what was then known, of distinguishing the new features of the invention from the old, and of thus enabling the court to perceive the precise limits of the inventive act.<sup>1</sup> Such evidence requires no previous notice to either party.<sup>2</sup> It may consist of printed or written documents, of the oral testimony of witnesses then familiar with the art, or of specimens and exhibits of the devices then employed. Evidence offered for this purpose, though in its nature applicable to one or more of the defences to which notice is essential, cannot be considered by the jury as bearing upon such defences unless the necessary notice has been given.<sup>3</sup>

admissible to vary or enlarge the Claims of a patent, see *Goodyear Dental Vulcanite Co. v. Gardiner* (1871), 3 Clifford, 408 ; 4 Fisher, 224.

See also § 1015 and notes, *ante*.

That the model and rejected application of a third person are admissible to show the circumstances of the invention, in connection with evidence that the patentee knew of them, and so give construction to the patent, see *Union Paper Bag Mach. Co. v. Pultz & Walkley Co.* (1878), 15 O. G. 423 ; 15 Blatch. 160 ; 3 Bann. & A. 403.

§ 1020. <sup>1</sup> That evidence is admissible to show the state of the art at the date of the invention in order to enable the jury or court to understand the invention, see *Loom Co. v. Higgins* (1882), 105 U. S. 580 ; 21 O. G. 2031.

That the state of the art is proof of what was old and in general use at the date of the invention, see *Brown v. Piper* (1875), 91 U. S. 37 ; 10 O. G. 417.

That the state of the art is provable for three purposes : (1) To show what was then old ; (2) To distinguish what was then new ; (3) To aid the court in construing the patent, — see *Brown v.*

*Piper* (1875), 91 U. S. 37 ; 10 O. G. 417.

That evidence as to the state of the art, though it may not show prior use, may narrow the field of invention and limit the range of inquiry, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 19 O. G. 173 ; 4 Fed. Rep. 900 ; 10 Bissell, 65.

That an earlier English provisional specification may show the state of the art and thus negative invention, see *McNab & Harlem Mfg. Co. v. Nathan Mfg. Co.* (1887), 40 O. G. 1240 ; 32 Fed. Rep. 155.

<sup>2</sup> That evidence of the state of the art is admissible without notice or mention in the answer, see *Brown v. Piper* (1875), 91 U. S. 37 ; 10 O. G. 417.

See also § 1006 and notes, *ante*.

<sup>3</sup> That proof of the state of the art may aid the court in construing the patent, but cannot be permitted to defeat the suit by anticipating the invention unless that issue is raised by the pleadings, see *Middletown Tool Co. v. Judd* (1867), 3 Fisher, 141.

That evidence given as to prior use

§ 1021. Evidence Excluded on the Ground of Estoppel.

Evidence otherwise admissible may be excluded on the ground that the witness through whom it must be presented is estopped, by matter of record or *in pais*, from claiming these facts against the adverse party. A party is not permitted to deny the truth of documents or of assertions either by word or conduct, by means of which he has induced the other party to act in such a manner as might now be prejudicial to his interests if these documents or assertions could be contradicted.<sup>1</sup> Thus a patentee is not allowed to set up, as against his own assignee, that the patented invention is worthless or was abandoned, or that for any other cause the patent is invalid.<sup>2</sup> A disclaimer debars the disclaimant from asserting that the part disclaimed was actually embraced in the invention.<sup>3</sup> Admissions by a patentee in his application or description that any element of an invention is covered by a prior patent estop him from denying its validity.<sup>4</sup> An inventor, having obtained a patent for his invention, is thereby precluded from claiming that the same invention is protected under a prior patent, or that a subsequent patent for the same invention can be valid.<sup>5</sup> Joint patentees are estopped from averring that the invention was sole as long as the joint patent is in force, and sole patentees are in like manner dis-

by parties not named in the answer can only be considered in reference to the state of the art at the date of the invention, and the same rule applies to publications, see *Geier v. Goetinger* (1874), 7 O. G. 563; 1 Bann. & A. 553; *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428; *Richardson v. Lockwood* (1873), 4 O. G. 398; 6 Fisher, 454.

See also § 1006 and notes, *ante*.

§ 1021. <sup>1</sup> That a witness may be estopped from giving evidence to defeat rights which he has previously induced the plaintiff to acquire, see 1 Greenleaf, Ev., § 383, etc.; and notes to § 981, *ante*.

<sup>2</sup> That an assignor cannot testify against his assignee in denial of the

validity of the patent, see *Many v. Jagger* (1848), 1 Blatch. 372.

<sup>3</sup> That a disclaimer in the defendant's patent of the devices found in the plaintiff's prior patent, referring thereto, admits the validity of the plaintiff's patent, see *Waterbury Brass Co. v. N. Y. & Brooklyn Brass Co.* (1858), 3 Fisher, 43.

<sup>4</sup> That the patentee's admission in his application or specification cannot be afterwards contradicted by him, see *Moffitt v. Rogers* (1881), 8 Fed. Rep. 147.

<sup>5</sup> That a patentee cannot claim that he was not the first inventor of the patented invention, see *American Paper Barrel Co. v. Laraway* (1886), 28 Fed. Rep. 141; 37 O. G. 674.



bled from alleging that the inventive act was joint. The assignor of a patented invention cannot urge against his assignee that his own title was defective, and that the title of his alienee must, therefore, fail. These various estoppels rest upon the ordinary rule, that no person shall be permitted to deceive another by causing him to believe in the existence of a fact and afterwards attempting to disprove it.

§ 1022. Evidence under the First Defence: Origin of the Alleged Invention in an Inventive Act.

The evidence applicable to each of the several defences which may be offered to an action of infringement is governed by rules deduced from the foregoing general principles in connection with the nature of the particular defence. The first defence raises the question whether inventive skill was involved in the production of the alleged invention. This is a question for the jury in view of the state of the art at the date of the supposed inventive act and of the result attained,<sup>1</sup> unless it is apparent on the face of the patent that the art or article required no inventive skill, when the court will take judicial notice of that fact and declare the patent invalid.<sup>2</sup> The burden of proof upon this question rests upon the plaintiff, but is satisfied by the introduction of the patent, and the defendant must then overcome the presumptions arising therefrom.<sup>3</sup> He may prove, if he is able, by the testimony of com-

§ 1022. <sup>1</sup> That inventive skill is a question of evidence in view of the condition of the art and the result accomplished, see *In re Pennock* (1874), 1 MacArthur, 531 ; 5 O. G. 668.

<sup>2</sup> That if the want of inventive skill is apparent from the description in the patent, the court may declare the patent invalid, see *Slawson v. Grand St., Prospect Park, & Flatbush R. R. Co.* (1883), 107 U. S. 649 ; 24 O. G. 99.

<sup>3</sup> That the patent itself is *prima facie* evidence that the alleged invention is the result of an inventive act, see *Smith v. Woodruff* (1873), 6 Fish-

er, 476 ; 4 O. G. 635 ; 1 MacArthur, 459 ; *Potter v. Holland* (1858), 1 Fisher, 382 ; 4 Blatch. 238.

That the patent is *prima facie* evidence that the invention had been made when the application was filed, see *Jones v. Sewall* (1873), 3 Clifford, 563 ; 3 O. G. 630 ; 6 Fisher, 343 ; *Wing v. Richardson* (1865), 2 Fisher, 535 ; 2 Clifford, 449 ; *White v. Allen* (1863), 2 Fisher, 440 ; 2 Clifford, 224 ; *Johnson v. Root* (1862), 2 Fisher, 291 ; 2 Clifford, 108.

That reduction to practice need be shown only by the specifications and drawings, when the invention as thus

petent witnesses, either lay or expert, that the idea embodied in the invention was sufficiently suggested by then existing appliances to enable any person skilled in the art to construct and use it. He may show that the alleged inventor has not discovered either a new capability in the force employed or a new susceptibility in the object acted on, or a new mode of connecting the force and object with each other, but has merely re-arranged, or varied in constructive details, an invention which had been already known. He may attack the idea conceived by the inventor and prove that it is not a true idea of means but only of a force or function or effect. He may deny that it had ever passed beyond the mental conception of the inventor, and the verbal or graphical descriptions of the patents, into a tangible and practical embodiment. In opposition to this evidence the plaintiff may, in his rebuttal, demonstrate by proper testimony, that the idea expressed in his invention is an idea of means, and that it was reduced to practice before his application for a patent.<sup>4</sup> That inventive skill was necessary to its production he may prove by the evidence of experts and others skilled in the art. He may show its great utility and general acceptance by the public as the basis of an inference that if mechanical skill could have derived it from existing arts or articles it would have long before been given to mankind.<sup>5</sup> He may disclose its essential

disclosed is evidently practical, see *Starr v. Farmer* (1883), 23 O. G. 2327.

That where an original patent and the re-issue agree, the specification of the re-issue may be conclusive evidence that the invention was made and the means invented, as described in the original, but if they differ in substance it is not such evidence, see *Sickels v. Evans* (1863), 2 Clifford, 203; 2 Fisher, 417.

<sup>4</sup> That reduction to practice may be shown by actual use, see *Coffin v. Ogden* (1869), 3 Fisher, 640; 7 Blatch. 61.

See also as to reduction, §§ 125, 126, and notes, *ante*.

<sup>5</sup> That the great utility of the de-

vice may be shown to prove that if known it must have been in general use, see *In re Pennock* (1874), 1 MacArthur, 531; 5 O. G. 668; *Sayles v. Chicago & Northwestern Railway Co.* (1871), 4 Fisher, 584; 3 Bissell, 52; *Judson v. Moore* (1860), 1 Fisher, 544; 1 Bond, 285.

That the superior working of the plaintiff's invention is competent evidence of its novelty, see *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327.

That the general acceptance and use of a device indicates that it is the result of an inventive act, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 4 Fed. Rep. 900; 19 O. G. 173; 10 Bissell,



diversity from all other inventions before known, to indicate that inventive genius could alone have taken the forward step that resulted in its conception and development. If upon the entire oral testimony the jury entertain a reasonable doubt as to the exercise of inventive skill by the inventor, the *prima facie* evidence of the patent must prevail, and the issue must be found in favor of the plaintiff.

**§ 1023. Evidence under the Second Defence: Performance of the Inventive Act by the Alleged Inventor.**

The second defence presents the question whether the patentee or his assignor has himself performed the inventive act resulting in the alleged invention, or has unlawfully appropriated and obtained a patent for what was in fact the invention of another. Upon this question the patent affords *prima facie* evidence in favor of the plaintiff.<sup>1</sup> To overthrow this evidence the defendant must prove by conclusive testimony that the patented invention was conceived by some specific person other than the alleged inventor, that the alleged inventor in some manner obtained a knowledge of the invention thus conceived, and falsely claiming it to be the result of his own creative skill, procured a patent for it to be issued to himself.<sup>2</sup> The inventive act of the true inventor may be shown by his

65; *Strobridge v. Lindsay* (1880), 18 O. G. 62; 2 Fed. Rep. 692; 5 Bann. & A. 411; *Judson v. Moore* (1860), 1 Fisher, 544; 1 Bond, 285.

That success is not conclusive evidence of novelty, for the old may not have become widely known, see *Crandall v. Richardson* (1881), 8 Fed. Rep. 808; 19 O. G. 1628.

That where a pressing want has existed strong evidence is necessary to show that an old device would have filled it, see *Howe v. Morton* (1860), 1 Fisher, 586.

For a more complete discussion of inventive skill and its indications, see §§ 78-124, and notes, *ante*.

§ 1023. <sup>1</sup> That the patent is *prima facie* evidence that the patentee was a

true inventor, see *Potter v. Holland* (1858), 1 Fisher, 382; 4 Blatch. 238.

<sup>2</sup> That on the defence that the plaintiff derived his idea of the invention from a third party, the burden of proof is on the defendant, and any doubt is fatal to him, see *Locke v. Lane & Bodley Co.* (1888), 35 Fed. Rep. 289; *Duffy v. Reynolds* (1885), 24 Fed. Rep. 855; 33 O. G. 621; *McMillin v. Barclay* (1871), 4 Brews. (Pa.) 275; 5 Fisher, 189.

That an allegation that the defendant received the information from a government employee who was the true inventor and used it for the United States must be affirmatively proved, see *Brady v. Atlantic Works* (1876), 4 Clifford, 408; 10 O. G. 702; 2 Bann. & A. 436.

own testimony, if he is accessible as a witness, or by the evidence of persons acquainted with the facts, or by any descriptions or models embodying the invention which can be identified as original with him. That the patentee or his assignor did not perform the inventive act may be established by his own admissions, by the declarations of others within his knowledge and uncontradicted by him, or by proof of his unsuccessful attempts in the same direction until he learned of the result accomplished by the true inventor and of his immediate adoption of that result as the product of his own inventive faculties.<sup>3</sup> No evidence of actual bad faith or intentional piracy is necessary; it is sufficient that there has been piracy in fact. In rebutting this testimony of the defendant, the plaintiff may introduce the person described in his patent as the inventor to detail the steps by which he reached the art or article in question, and thus demonstrate that it originated in his own mind, and was not imitated by him from the invention of another. The testimony of other persons who were cognizant of his experiments and successes, his own descriptions given before the conception of the alleged actual inventor had been sufficiently disclosed to communicate all its essential attributes, and any evidence tending to show his non-acquaintance with the achievements of the one to whose inventive genius the defendant ascribes the invention, are also admissible for the same purpose.<sup>4</sup> If doubt exists upon the entire testimony offered, the plaintiff is entitled to a verdict on this issue in his favor.<sup>5</sup>

<sup>3</sup> That the records of a company of which the plaintiff was a member, and which claimed the invention, are admissible to show that the plaintiff did not invent it, see *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

<sup>4</sup> Upon this issue any evidence proper to show an inventive act in either of the alleged inventors and the date of such act, as well as the relations between them, and the borrowing or opportunity to borrow the conceptions of each other are admissible.

See as to the Inventive Act, §§ 99,

100, 376-379, and notes, *ante*; Suggestions of others, §§ 84, 393-395, and notes, *ante*; Date of Inventive Act, §§ 132, 380-386, 400, and notes, *ante*, and 1024, 1026, and notes, *post*.

See also *Union Paper Collar Co. v. Van Deusen* (1874), 23 Wall. 530; 7 O. G. 919; *Alden v. Dewey* (1840), 1 Story, 336; 2 Robb, 17.

<sup>5</sup> As to the value of this second defence, and the facts necessary to be proved thereunder, see also § 960 and notes, *ante*.



§ 1024. Evidence under the Third Defence: Priority of the Inventive Act of the Alleged Inventor.

The third defence raises the question whether the inventive act performed by the patentee, or his assignor, preceded or followed that of a rival inventor who has produced the same invention. Here, also, the patent makes out a *prima facie* case for the plaintiff, and being offered in evidence throws on the defendant the burden of proof.<sup>1</sup> To satisfy this burden

§ 1024. <sup>1</sup> That the patent is *prima facie* evidence that the patentee is the first inventor, see *Maurice v. Devol* (1883), 23 W. Va. 247; *Corvallis Fruit Co. v. Curran* (1881), 8 Fed. Rep. 150; 7 Sawyer, 270; *Rogers v. Beecher* (1880), 18 O. G. 793; 5 Bann. & A. 619; 3 Fed. Rep. 639; *Miller v. Smith* (1880), 18 O. G. 1047; 5 Fed. Rep. 359; *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; *Haskell v. Shoe Machinery Mfg. Co.* (1878), 15 O. G. 509; 3 Bann. & A. 553; *Cahill v. Brown* (1878), 15 O. G. 697; 3 Bann. & A. 580; *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Roemer v. Simon* (1877), 95 U. S. 214; 12 O. G. 796; *Crouch v. Roemer* (1877), 11 O. G. 1112; 2 Bann. & A. 637; *Smith v. Goodyear Dental Vulcanite Co.* (1876), 93 U. S. 486; 11 O. G. 246; *Cammeyer v. Newton* (1876), 94 U. S. 225; 11 O. G. 287; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464; 4 Clifford, 397; 2 Bann. & A. 401; *Needham v. Washburn* (1874), 7 O. G. 649; 4 Clifford, 254; 1 Bann. & A. 537; *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Goodyear Dental Vulcanite Co. v. Gardner* (1870), 4 Fisher, 224; 3 Clifford, 408; *Seymour v. Osborne* (1870), 11 Wall. 516; *Sands v. Wardwell* (1869), 3 Clifford, 277; *Hoffheins v. Brandt* (1867), 3 Fisher, 218; *Brodie v. Ophir Silver Mining Co.* (1867), 4 Fisher, 137; 5 Sawyer, 608; *Johnson v. Root* (1862), 2 Fisher, 291;

2 Clifford, 108; *Cahoon v. Ring* (1859), 1 Fisher, 397; 1 Clifford, 592; *Potter v. Holland* (1858), 1 Fisher, 382; 4 Blatch. 238; *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62; *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27; *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448; 2 Robb, 46; *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106; 3 Fisher, 1.

That the patent, including its specification and drawings, is *prima facie* evidence that the patentee is the original inventor of the described improvements, and the burden of proof is on the defendant to show prior invention, see *Cahoon v. Ring* (1859), 1 Fisher, 397; 1 Clifford, 592.

That a re-issued patent is *prima facie* evidence that the patentee was the first inventor and can be overcome only by clear proof, see *Herring v. Nelson* (1877), 12 O. G. 753; 14 Blatch. 293; 3 Bann. & A. 55.

That the presumption that the patentee is the original inventor arises only at the grant of the patent, and does not relate back beyond the filing of the application, see *Wing v. Richardson* (1865), 2 Clifford, 449; 2 Fisher, 535.

That the patent being in evidence the burden of proof is on the defendant to show that the patentee was not the first inventor, see *American Bell Telephone Co. v. People's Telephone Co.* (1884), 29 O. G. 1029; 22 Fed. Rep. 309:

the defendant must show that the alleged rival inventor conceived the invention before the idea of means which it embodies was generated in the mind of the inventor named in the patent, and that he either first reduced it to practice or exercised reasonable diligence in the endeavor so to do.<sup>2</sup> The date of the conception of the invention by the plaintiff's inventor is, at this stage of the case, assumed to be that of the patent itself, or if the application is referred to in the patent, to be that of the filing of the application.<sup>3</sup> The date of its conception by the alleged rival inventor may be shown by his own testimony, or by contemporaneous models or descriptions indicating that the idea was then present in his mind.<sup>4</sup> The date of his reduction to practice may be fixed by

22 Blatch. 531; Worswick Mfg. Co. v. City of Buffalo (1884), 20 Fed. Rep. 126; 27 O. G. 1239; 22 Blatch. 157; Putnam v. Hollender (1881), 6 Fed. Rep. 882; 19 O. G. 1423; 19 Blatch. 48; Rogers v. Beecher (1880), 18 O. G. 793; 5 Bann. & A. 619; 3 Fed. Rep. 639; Crouch v. Roemer (1877), 11 O. G. 1112; 2 Bann. & A. 637; Taylor v. Wood (1874), 8 O. G. 90; 1 Bann. & A. 270; 12 Blatch. 110; Doherty v. Haynes (1874), 6 O. G. 118; 1 Bann. & A. 289; 4 Clifford, 291; McMillin v. Barclay (1871), 4 Brews. (Pa.) 275; 5 Fisher, 189; Sands v. Wardwell (1869), 3 Clifford, 277; Hoffheins v. Brandt (1867), 3 Fisher, 218; Brodie v. Ophir Silver Mining Co. (1867), 4 Fisher, 137; 5 Sawyer, 608; Wayne v. Holmes (1856), 2 Fisher, 20; 1 Bond, 27; Pitts v. Hall (1851), 2 Blatch. 229; Knight v. Baltimore & Ohio R. R. Co. (1840), Taney, 106; 3 Fisher, 1.

That the defence of prior invention rests upon evidence controlled by the party asserting it, and must be proved beyond reasonable doubt, see Thayer v. Hart (1884), 28 O. G. 542; 20 Fed. Rep. 693; 22 Blatch. 229.

That the preliminary statement filed in interference proceedings is admissible in evidence on the question of

priority in rebuttal of the claimant's testimony, see Detroit Lubricator Co. v. Lunkenheimer (1886), 30 Fed. Rep. 190; 38 O. G. 331.

<sup>2</sup> That the defendant must show that the date of the prior invention was earlier than the plaintiff's could have been, according to the evidence adduced, see United States Stamping Co. v. Jewett (1880), 18 Blatch. 469; 18 O. G. 1529; 7 Fed. Rep. 869.

<sup>3</sup> That the date of the patent is *prima facie* the date of the invention, see Webster Loom Co. v. Higgins (1879), 16 O. G. 675; 15 Blatch. 446; 4 Bann. & A. 88.

That if the application is referred to in the patent the date when it was filed is *prima facie* that of the inventive act, see § 1026, note 15, *post*.

<sup>4</sup> That descriptions of the invention, given by the alleged inventor to others, may be shown for the purpose of proving that he had then invented it, as no one but himself can otherwise become aware of that fact, see Sayles v. Hapgood (1869), 3 Fisher, 632; 2 Bissell, 189; Philadelphia & Trenton R. Co. v. Stimpson (1840), 14 Peters, 448; 2 Robb, 46; Evans v. Hettick (1818), 3 Wash. 408; 1 Robb, 166.



witnesses who knew of his production of the art or article in a form available for immediate practical use.<sup>5</sup> His diligence in perfecting the invention may be proved by any evidence establishing his perseverance in the effort to render it available as far as his health, his means, and his command of his own time and energies reasonably permitted.<sup>6</sup> The plaintiff, in rebutter, may show that the date of the inventive act performed by his inventor preceded that of his patent or his application, and was in fact earlier than its performance by his rival, offering for this purpose the same class of evidence by which the date of his rival's inventive act might have been established.<sup>7</sup> Or failing in this he may attack the diligence of his rival by testimony proving that his opportunities for perfecting the invention were unreasonably neglected, and that his rights as first conceiver were thereby forfeited in favor of the prompt reducer to whom the patent has been issued. Where this question of priority of invention has already been decided in an interference proceeding, the record of that judgment is admissible in favor of the then successful party, and though not conclusive on the jury is entitled to grave consideration.<sup>8</sup> But the defendant must establish his position be-

<sup>5</sup> That actual use proves reduction to practice, see *Coffin v. Ogden* (1869), 3 Fisher, 640 ; 7 Blatch. 61.

<sup>6</sup> For rules concerning diligence in reduction, see §§ 383-387, and notes, *ante*.

That if the patentee temporarily abandoned his efforts and then resumed them after another inventor had applied for a patent, he cannot show that he invented before the date of his resumption, see *Johnson v. Root* (1862), 2 Fisher, 291 ; 2 Clifford, 108.

That where the later inventor first reduced to practice and applied for and obtained a patent, and the earlier inventor applied for a patent before he had reduced to practice, and was not diligent, the later inventor does not infringe the earlier inventor's patent, see *Electric R. R. Signal Co. v. Hall R. R. Signal Co.* (1881), 6 Fed. Rep. 603.

<sup>7</sup> That when the defendant proves that he invented the device before the plaintiff filed his application, the burden is on the plaintiff to show that he invented before the defendant did, see *Thayer v. Hart* (1884), 20 Fed. Rep. 693 ; 28 O. G. 542 ; 22 Blatch. 229.

That a foreign inventor cannot carry the date of his invention back by showing acts done in a foreign country, see *Boulton v. Illingworth* (1888), 43 O. G. 508.

That the fact that an alleged prior inventor, though patenting other kindred inventions, did not patent this one is competent evidence against his invention of it, see *Frink v. Petry* (1874), 11 Blatch. 422 ; 1 Bann. & A. 1 ; 5 O. G. 201.

<sup>8</sup> That a patent is increased in weight as *prima facie* evidence of priority by the success of the patentee in interference

yond reasonable doubt; otherwise the presumption arising in favor of the patentee from his own oath as to priority, confirmed by the issue of the patent, will prevail.<sup>9</sup> The question involved in this defence sometimes presents itself in a modified form, as where the plaintiff's inventor was the first conceiver of the invention but is alleged by the defendant to have forfeited his right to a patent in favor of a later inventor, by his unreasonable delay in its reduction. The attitude of the parties toward certain of the issues raised by this defence are thus reversed, the defendant now attacking and the plaintiff supporting the diligence of the first conceiver; but the evidence applicable to these issues remains the same, and the burden of proof still rests on the defendant to overcome the presumptions created by the plaintiff's patent. This burden is not removed by the fact that the defendant has himself received a subsequent patent for the same invention.<sup>10</sup>

proceedings, see *Ayling v. Hull* (1865), 2 Clifford, 494.

That the burden of proof as to priority rests on him to whom the decision of the Patent Office on an interference is adverse, see *Wire Book Sewing Mach. Co. v. Stevenson* (1882), 11 Fed. Rep. 155.

That the decisions of the Commissioner as to priority are not conclusive, though entitled to very great weight, see *Gloucester Isinglass & Glue Co. v. Brooks* (1884), 19 Fed. Rep. 426.

<sup>9</sup> That the defendant's evidence of prior invention must remove all reasonable doubt, see *Donoughe v. Hubbard* (1886), 27 Fed. Rep. 742; 35 O. G. 1561; *Worswick Mfg. Co. v. City of Buffalo* (1884), 20 Fed. Rep. 126; 22 Blatch. 157; 27 O. G. 1239; *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4.

That the presumption that the patentee is the first inventor arises from his oath, and remains till the contrary is proved, see *Elizabeth v. Pavement Co.* (1877), 97 U. S. 126; *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639; *Bartholo-*

*mew v. Sawyer* (1859), 1 Fisher, 516; 4 Blatch. 347.

<sup>10</sup> That the introduction of the defendant's subsequent patent does not change the burden of proof as to priority of invention, see *Goodyear Dental Vulcanite Co. v. Gardner* (1870), 4 Fisher, 224; 3 Clifford, 408.

That when the plaintiff first applied for a patent and the defendant obtained his by disclaiming the plaintiff's invention, but after the plaintiff's patent was granted re-issued his to cover the matter before disclaimed, the burden of proof is on him to show that his inventive act was the earliest, see *Smith v. Allen* (1865), 2 Fisher, 572.

That the testimony of a defendant that he was the first inventor of the article is overcome by proof that after the date of his alleged invention he applied for a patent relating to the same subject but based on an essentially different principle, see *Lanison Cash Railway Co. v. Osgood Cash Car Co.* (1886), 29 Fed. Rep. 210; 38 O. G. 1490.

That inferences drawn by the court



§ 1025. Evidence under the Fourth Defence: the Alleged Invention not within the Protected Classes.

The fourth defence raises the question whether the patented invention is embraced within either of those six classes of inventions which are made patentable by the Acts of Congress. Though this is a question for the jury, the court may take judicial notice that the invention is not among those thus protected, when that fact is evident from the patent, and may then, without testimony, direct a verdict on this issue for the defendant.<sup>1</sup> The plaintiff's patent furnishes *prima facie* evidence that the invention described and claimed therein is patentable.<sup>2</sup> The defendant may contradict this evidence by expert and other testimony that the alleged invention does not possess the essential characteristics either of an art, a machine, a manufacture, a composition of matter, a design, or an improvement. If the alleged invention purports to be a combination, he may prove by similar evidence that its elements do not co-operate for the production of a unitary result, and that it is, therefore, a simple aggregation. In his rebutter, the plaintiff offers evidence of the same nature to

from the conduct of a party may outweigh the direct testimony of any number of witnesses, see the Telephone Cases (1888), 126 U. S. 1 ; 43 O. G. 377.

That the fact that one who now claims to have been the first inventor made no protest against the use of the invention or against the claims of another to be its inventor, but patented an improvement on it without attempting to cover the original, is strong proof against his present claims, see Hutchinson v. Everett (1885), 35 O. G. 1110 ; 26 Fed. Rep. 531.

Upon the subject of priority as between rival inventors, see §§ 370-391, 961, and notes, *ante*.

§ 1025. <sup>1</sup> That the court may order a verdict for the defendant if it is apparent on the face of the patent that the invention is not within the protected classes, see Blessing v. Copper Works (1888), 34 Fed. Rep. 753 ; West

v. Rae (1887), 33 Fed. Rep. 45 ; Slawson v. Grand St., Prospect Park, & Flatbush R. R. Co. (1882), 107 U. S. 649 ; 24 O. G. 99 ; Everett v. Thatcher (1878), 16 O. G. 1046 ; 2 Flippin, 234 ; 3 Bann. & A. 435. These were cases in equity, but the same principles there applied would compel the court to protect the defendant against an adverse verdict at law. See also § 962, and notes, *ante*.

<sup>2</sup> That the patent is *prima facie* evidence of the patentability of the invention, see Fraim v. Keen (1885), 25 Fed. Rep. 820 ; 34 O. G. 1048 ; Strobridge v. Lindsay (1880), 18 O. G. 62 ; 2 Fed. Rep. 692 ; 5 Bann. & A. 411.

That the presumption of patentability arising from the patent is not repelled when the device, though needed, is not shown to have been in use before, see Patterson v. Duff (1884), 20 Fed. Rep. 641.

controvert these positions of the defendant. The effect of such evidence, on either side, must be confined to the conformity of the invention claimed in the patent with the legal definition of these patentable classes of inventions. What the necessary attributes of the patented invention are is settled by the court through its construction of the patent, and cannot be affected by extraneous evidence.<sup>3</sup> What the essential characteristics of each of the six classes of patentable inventions are is matter of determinate law, and equally beyond the sphere of testimony.<sup>4</sup> Evidence is admissible to show that the attributes of the invention, as ascertained by the court, correspond with the essentials of a patentable art or article as defined by the law; but this evidence must consist almost entirely of the opinions of persons skilled in the detection of resemblances and differences, rather than of observers and narrators of specific facts. In many cases, indeed, the field of evidence is so narrow that the whole question must be practically treated as a question of law, the jury being required to follow the instruction of the court in reference to its decision.

**§ 1026. Evidence under the Fifth Defence: Novelty of the Patented Invention: Prior Use.**

The fifth defence raises an issue as to the legal novelty of the patented invention. This issue embraces three questions: (1) Whether the invention had been used in such a manner in this country as to render it accessible to the public at the date of its alleged invention by the patentee or his assignor; (2) Whether it had been patented anteriorly to that date; (3) Whether it had been described in any printed publication which, before that date, had been placed within reach of the public. An affirmative answer to either of these three questions is equivalent to a denial of the legal novelty of the pat-

<sup>3</sup> That the patented invention is what the court construes the patent to cover and cannot be varied by other evidence, see §§ 731, 1019, and notes, *ante*.

<sup>4</sup> For the essential attributes of each

class of inventions, see §§ 159-220, and notes, *ante*.

For the characteristics of a patentable combination, see §§ 153-156, and notes, *ante*.



ented invention, and, therefore, of the validity of the patent in which it is described and claimed.<sup>1</sup> The patent answers all these questions in the negative, and thus throws upon the defendant the burden of proving the affirmative, in reference to at least one of them, beyond a reasonable doubt in order to maintain this defence.<sup>2</sup> The question of prior use is

§ 1026. <sup>1</sup> That if the defence of want of legal novelty is satisfactorily proved, it must avail, see *Miller v. Smith* (1880), 5 Fed. Rep. 359; 18 O. G. 1047.

As to the scope of this defence, see § 963, and notes, *ante*.

That legal novelty cannot exist where there was either prior use, prior patent, or prior publication, see §§ 113, 123, 222, 315, 316, and notes, *ante*.

<sup>2</sup> That the patent itself is *prima facie* evidence of the novelty of the invention, see *Byerly v. Cleveland Linseed Oil Works* (1887), 31 Fed. Rep. 73; *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68; 41 O. G. 232; *Deane v. Hodge* (1886), 35 Minn. 146; *Lehnbeuter v. Holthaus* (1881), 105 U. S. 94; 21 O. G. 1783; *Corvallis Fruit Co. v. Curran* (1881), 8 Fed. Rep. 150; 7 Sawyer, 270; *Rogers v. Beecher* (1880), 18 O. G. 793; 3 Fed. Rep. 639; 5 Bann. & A. 619; *Thomas v. Shoe Machinery Mfg. Co.* (1878), 16 O. G. 541; 3 Bann. & A. 557; *Miller & Peters Mfg. Co. v. Du Brul* (1877), 12 O. G. 351; 2 Bann. & A. 618; *Needham v. Washburn* (1874), 7 O. G. 649; 4 Clifford, 254; 1 Bann. & A. 537; *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Roberts v. Dickey* (1871), 4 Brews. (Pa.) 260; 4 Fisher, 532; 1 O. G. 4; *Whitney v. Mowry* (1867), 3 Fisher, 157; 2 Bond, 45; *Blanchard v. Puttman* (1867), 3 Fisher, 186; 2 Bond, 84; *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115; *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62; *Potter v. Holland* (1858),

1 Fisher, 382; 4 Blatch. 238; *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27; *Ransom v. Mayor of New York* (1856), 1 Fisher, 252; *Teese v. Phelps* (1855), 1 McAllister, 48; *Parker v. Stiles* (1849), 5 McLean, 44.

That a patent for a combination of old elements is *prima facie* evidence that it is new, see *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68; 41 O. G. 232.

That a re-issued patent is evidence that the invention was new, see *Serrell v. Collins* (1857), 1 Fisher, 289.

That an extension after a hearing is strong evidence of novelty, see *Black v. Thorne* (1872), 2 O. G. 388; 5 Fisher, 550; 10 Blatch. 66; *Whitney v. Mowry* (1867), 3 Fisher, 157; 2 Bond, 45; *Swift v. Whisen* (1867), 2 Fisher, 343; 2 Bond, 115.

That a British patent under the great seal proves itself, but is only *prima facie* evidence that the invention is new and useful and of some probable value, see *Gatling v. Newell* (1857), 9 Ind. 572.

That the weight of a patent as *prima facie* evidence of novelty may be aided by showing that the invention was subjected to rigid scrutiny and comparison with previous patents in the Patent Office, see *Shaver v. Skinner Mfg. Co.* (1887), 30 Fed. Rep. 68; 41 O. G. 232.

That the patent being in evidence the burden of proof rests on the defendant to show want of novelty, see *Vulcanite Paving Co. v. American Artificial Stone Pavement Co.* (1887), 42 O. G. 828; *Bostock v. Goodrich* (1884), 21 Fed. Rep. 316; 29 O. G. 278; *Double-*

further divisible into two others: (1) Whether the art or article alleged to have been previously used was identical with the patented invention; (2) Whether the use alleged was such as to have rendered the invention accessible to the public at the date of its conception by the plaintiff's inventor.<sup>3</sup>

day v. Beatty (1882), 11 Fed. Rep. 729; 22 O. G. 859; Green v. French (1882), 11 Fed. Rep. 591; 21 O. G. 1351; Woven Wire Mattress Co. v. Wire-Web Bed Co. (1881), 8 Fed. Rep. 87; Miller v. Smith (1880), 18 O. G. 1047; 5 Fed. Rep. 359; Gear v. Grosvenor (1873), 6 Fisher, 314; 3 O. G. 380; Holmes, 215; Clark v. Scott (1872), 2 O. G. 4; 9 Blatch. 301; 5 Fisher, 245; Baldwin v. Schultz (1871), 2 O. G. 315; 9 Blatch. 494; 5 Fisher, 75; Roberts v. Dickey (1871), 1 O. G. 4; 4 Brews. (Pa.) 260; 4 Fisher, 532; Howes v. Nute (1870), 4 Fisher, 263; 4 Clifford, 173; Tompkins v. Gage (1865), 2 Fisher, 577; 5 Blatch. 268; Union Sugar Refinery v. Matthiesson (1865), 2 Fisher, 600; 3 Clifford, 639; Allen v. Blunt (1846), 2 W. & M. 121; 2 Robb, 530.

That the defendant must prove want of novelty beyond reasonable doubt, see American Bell Telephone Co. v. Globe Telephone Co. (1887), 31 Fed. Rep. 729; Cary v. Lovell Mfg. Co. (1887), 31 Fed. Rep. 344; 40 O. G. 1239; Cohansey Glass Mfg. Co. v. Wharton (1886), 28 Fed. Rep. 189; 86 O. G. 343; Doubleday v. Beatty (1882), 11 Fed. Rep. 729; 22 O. G. 859; Crouch v. Speer (1874), 6 O. G. 187; 1 Bann. & A. 145; Wood v. Cleveland Rolling Mill Co. (1871), 4 Fisher, 550; Tompkins v. Gage (1865), 2 Fisher, 577; 5 Blatch. 268.

That although the defendant has received a patent and introduces it, the burden of proof on the question of novelty still rests on him, see Goodyear Dental Vulcanite Co. v. Gardner (1870), 4 Fisher, 224; 3 Clifford, 408.

<sup>3</sup> That proof of actual prior use does overcome the presumption arising from the patent, see Judson v. Bradford (1878), 16 O. G. 171; 3 Bann. & A. 539.

That prior use is a question of fact, see Fisk v. Church (1872), 1 O. G. 634; 5 Fisher, 540.

That where the prior invention was identical with the one patented, was complete, capable of producing some result, and was known in this country, the defence will prevail, see Stitt v. Eastern R. R. Co. (1884), 22 Fed. Rep. 649.

That the *prima facie* evidence of novelty afforded by the patent is not overcome unless true anticipating inventions are definitely proved to have been in prior use, see Butler v. Bainbridge (1886), 29 Fed. Rep. 142; 37 O. G. 1124.

That evidence showing the existence of practical operative devices, before their conception by the patentee, invalidates the patent, see American Bell Telephone Co. v. People's Telephone Co. (1884), 29 O. G. 1029; 22 Blatch. 531; 22 Fed. Rep. 309.

That what would infringe, if later, anticipates, if earlier, see Peters v. Active Mfg. Co. (1884), 28 O. G. 1102; 21 Fed. Rep. 319.

That prior use of articles, less perfect but identical in principle, invalidates the patent, see Magin v. McKay (1885), 32 O. G. 1237; 24 Fed. Rep. 743.

That a prior use of similar but not identical devices cannot defeat the patent, though they may show the state of the art and thus limit the patent, see McFarland v. Spencer (1885), 32 O. G.



Upon both of these points the defendant's evidence must be conclusive.<sup>4</sup> The identity of the prior art or article with the patented invention may be established by any kind of relevant testimony.<sup>5</sup> If the invention is an article, specimens in exist-

893; 23 Fed. Rep. 150; 23 Blatch. 155.

That a small device may show prior use, see *Peters v. Active Mfg. Co.* (1889), 129 U. S. 530.

That courts cannot pronounce a patent void for prior use unless the evidence shows that the same principles were before employed, see *Case v. Morey* (1818), 1 N. H. 347.

That a defence to a patent for a combination as a whole must apply to the entire combination and not to separate parts, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

<sup>4</sup> That the burden of proof rests upon the defendant to show the existence of the identical invention before the grant of the plaintiff's patent, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86.

That a defendant has the burden of proof on the question of prior use, see *Thayer v. Spaulding* (1886), 27 Fed. Rep. 66; 36 O. G. 1044; *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871; *Dreyfus v. Schneider* (1885), 25 Fed. Rep. 481; *Worswick Mfg. Co. v. City of Buffalo* (1884), 27 O. G. 1239; 20 Fed. Rep. 126; 22 Blatch. 157; *Parker v. Remhoff* (1879), 17 Blatch. 206; 14 O. G. 601; 3 Bann. & A. 550; *Webster Loom Co. v. Higgins* (1879), 16 O. G. 675; 15 Blatch. 446; 4 Bann. & A. 88; *Fisk v. Church* (1872), 1 O. G. 634; 5 Fisher, 540; *Baldwin v. Schultz* (1871), 5 Fisher, 75; 2 O. G. 315; 9 Blatch. 494; *Magic Ruffle Co. v. Douglass* (1863), 2 Fisher, 330; *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27.

That prior use must be proved beyond reasonable doubt, see *Osborne v. Glazier* (1887), 40 O. G. 1137; 31 Fed.

Rep. 402; *Cluett v. Claffin* (1887), 30 Fed. Rep. 921; 41 O. G. 1042; *Wetherill v. Keith* (1886), 27 Fed. Rep. 364; 37 O. G. 337; *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871; *Thayer v. Spaulding* (1886), 27 Fed. Rep. 66; 36 O. G. 1044; *Dreyfus v. Schneider* (1885), 25 Fed. Rep. 481; *Everest v. Buffalo Lubricating Oil Co.* (1884), 20 Fed. Rep. 848; 28 O. G. 1101; *American Bell Telephone Co. v. People's Telephone Co.* (1884), 22 Fed. Rep. 309; 29 O. G. 1029; 22 Blatch. 531; *Thayer v. Hart* (1884), 20 Fed. Rep. 693; 22 Blatch. 229; 28 O. G. 542; *Campbell v. James* (1879), 18 O. G. 979; 4 Bann. & A. 456; 17 Blatch. 42; *Hawes v. Antisdel* (1875), 8 O. G. 685; 2 Bann. & A. 10; *Coffin v. Ogden* (1873), 18 Wall. 120; 5 O. G. 270; *Magic Ruffle Co. v. Douglass* (1863), 2 Fisher, 330; *Washburn v. Gould* (1844), 3 Story, 122; 2 Robb. 206.

That every reasonable doubt in regard to prior use must be resolved in favor of the plaintiff, see *Washburn & Moen Mfg. Co. v. Haish* (1880), 4 Fed. Rep. 900; 19 O. G. 173; 10 Bissell, 65; *Hawes v. Antisdel* (1875), 8 O. G. 685; 2 Bann. & A. 10; *Coffin v. Ogden* (1873), 18 Wall. 120; 5 O. G. 270; *Parham v. American Buttonhole Overseaming & Sewing Mach. Co.* (1871), 4 Fisher, 468; *Washburn v. Gould* (1844), 3 Story, 122; 2 Robb. 206.

That mere preponderance of evidence cannot establish anticipations twenty years before, see *Smith v. Fay* (1873), 6 Fisher, 446.

<sup>5</sup> In *Stitt v. Eastern R. R. Co.* (1884), 22 Fed. Rep. 649, Colt, J.: (651) "The primary inquiry is one of identity between

ence before the date of the plaintiff's patent may be produced and compared with the patented invention, with or without the aid of expert evidence.<sup>6</sup> Descriptions of the invention, written or printed, whether in private papers or in prior patents, applications, or other documents in the Patent Office, may be introduced to show its essential characteristics and its correspondence with the patented invention.<sup>7</sup> The testimony of

two things. If the identity can only be known by actual use, such use should be proved. If the identity is apparent on inspection, it is not necessary to prove actual use. If there is a reasonable doubt as to identity, want of novelty is not made out. Walk. Pat. § 72. By the weight of authority and of reason, it would seem that if the prior invention was the same as that described in the patent; if it was complete, and capable of producing the same result, and was known in this country, it is sufficient to sustain the defence of want of novelty."

In *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86, Sprague, J.: (102) "Gentlemen, this is, as I have already mentioned to you, a question of what existed some seventeen years ago. Now, I think it proper to say to you, that where an invention of any useful machine or structure, or improvement in any machine, is shown to have been made, and it is sought to be invalidated by an old machine made years ago, the jury should examine the testimony and the evidence with care and caution, so as to be satisfied that that which is said to have existed was actually and substantially the same. The rule of law is a reasonable one, at all events it is a rule of law, that a party who sets up such an old instrument, that has passed away, has upon him the burden of satisfying the jury upon a preponderance of evidence that it is substantially the same as what has taken place, before they will set aside the patent. If they are so satisfied by the evidence, that it was

substantially the same and known before, then it is their duty so to say when considering the patent."

<sup>6</sup> That whether one thing is identical with or the "equivalent" of another is a question of fact on the evidence of experts on an inspection of the inventions, see *Foss v. Herbert* (1856), 2 Fisher, 31; 1 Bissell, 121.

That prior machines are admissible to show that if defendant copies them he does not infringe, or if he does infringe, then the patent is void for prior use, see *Whipple v. Baldwin Mfg. Co.* (1858), 4 Fisher, 29.

That in attacking novelty specimens of the anticipating invention itself should be offered, not specimens since made from the descriptions given by those who saw the old, see *Theberath v. Rubber & Celluloid Harness Trimming Co.* (1883), 15 Fed. Rep. 246; 23 O. G. 1121.

That prior use is proved if a sample of the article used is produced and verified by several witnesses whose character for truth is not impeached, see *Miller v. Foree* (1885), 116 U. S. 22; 33 O. G. 1496.

<sup>7</sup> That an application which fully describes an invention is conclusive evidence that the invention was made before the application was filed, see *Kearney v. Lehigh Valley R. R. Co.* (1887), 32 Fed. Rep. 320.

That the record of a rejected application to the Patent Office with its specification, models, etc., is admissible to establish prior invention, in connection with other proof that a working machine



persons who saw the article, or observed the practice of the art, may also be received for the same purpose. Of these three forms of evidence, that of existing specimens is, of course, the most reliable; and when they do exist, and are under the control of the defendant, his failure to present them raises a strong presumption against their identity with the article protected by the plaintiff's patent.<sup>8</sup> The evidence of witnesses who speak from personal recollection only is of comparatively little value, its weight being diminished in proportion to the remoteness of their observation, and the intricacy of the invention which they endeavor to recall.<sup>9</sup> To merit any consideration it must be positive and specific, not conjectural and indefinite.<sup>10</sup> Identity cannot be inferred from

embodying the invention was made, and that successful experiments with it were performed in public, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 10 Phila. 227; 1 Bann. & A. 177.

That a prior application without evidence of reduction to practice cannot show prior use, see *Adams v. Howard* (1884), 26 O. G. 825; 19 Fed. Rep. 317.

<sup>8</sup> That machines as shown by their models are evidence of the highest class, see *Morris v. Barrett* (1859), 1 Fisher, 461; 1 Bond, 254.

That doubtful evidence as to prior use becomes still more doubtful if the defendant fails to produce specimens of the devices used, see *Chase v. Wesson* (1873), 6 Fisher, 517; 4 O. G. 476; *Holmes*, 274.

That if the defendant has possession of an alleged prior article and does not produce it, the presumption will be strong against him, see *Bailey Washing & Wringing Mach. Co. v. Lincoln* (1871), 4 Fisher, 379.

<sup>9</sup> That evidence concerning anticipation must be weighed in view of the lapse of time since the alleged prior use, see *Yale Lock Mfg. Co. v. Berkshire Nat. Bank* (1885), 26 Fed. Rep. 104.

That recollections, after many years, of devices, none of which are produced in court, are not reliable testimony, see *Adams & Westlake Mfg. Co. v. Rathbone* (1886), 26 Fed. Rep. 262.

That the memory of a witness as to an article he saw twenty-one years before is not very reliable, see *Ely v. Monson & Brimfield Mfg. Co.* (1860), 4 Fisher, 64.

That the patent will not be set aside on the testimony of a single witness that many years ago he saw an article like the one claimed, see *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428.

That the unreliability of the memory as to dates, the delay of an alleged prior inventor in utilizing or patenting the invention, &c., tend to prevent the evidence from removing reasonable doubt, see *Osborne v. Glazier* (1887), 31 Fed. Rep. 402; 40 O. G. 1137.

<sup>10</sup> That indefinite recollections of a use twenty years past, no models being produced, is not sufficient proof of prior use, see *Wetherell v. Keith* (1886), 27 Fed. Rep. 364; 37 O. G. 337.

That testimony of witnesses who say they saw the device in use many years before, but who are contradicted by others, is not sufficient when the de-

the opinion of a witness that the alleged anticipating device might have been altered to become the patented invention, or might have been employed to perform its functions, or that a product then existing might have resulted from a process similar to that claimed by the plaintiff in his patent.<sup>11</sup> Even when positive and specific, such evidence is easily overcome by acts or testimony inconsistent with its truth. The silence of the maker of the prior article, if present in court in the interest of the defendant but not examined on this subject, outweighs the declarations of numerous observers.<sup>12</sup> The oral statement of a patentee that his invention, as originally produced, possessed the characteristic features of the plaintiff's, is negatived by their absence from the description in his patent.<sup>13</sup> The asseveration of a workman that he used the same invention in his employers' business, is contradicted by the fact that at a later period they sought the invention elsewhere.<sup>14</sup> Still,

vices are not produced, see *Wetherell v. Keith* (1886), 27 Fed. Rep. 364; 37 O. G. 337; *Washburn & Moen Mfg. Co. v. Haish* (1880), 19 O. G. 173; 4 Fed. Rep. 900; 10 Bissell, 65; *Smith v. Fay* (1873), 6 Fisher, 446.

<sup>11</sup> That on the issue of novelty evidence as to what might have been done with prior machines, or that these could have been altered into the one patented, is not admissible, see *Cook v. Ernest* (1872), 2 O. G. 89; 5 Fisher, 396; *Livingston v. Jones* (1859), 1 Fisher 521.

That evidence as to what might have been done with prior machines is mere speculation and avails nothing, see *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327.

That evidence that a witness had seen an article which might have been made by a device like the plaintiff's before his invention, cannot outweigh the patent unless the jury are satisfied that it was made by this device, see *Treadwell v. Bladen* (1827), 4 Wash. 703; 1 Robb, 531.

<sup>12</sup> That the maker of an alleged prior

machine is present but is not examined is to be considered in estimating the value of other evidence, see *Wood v. Cleveland Rolling Mill Co.* (1871), 4 Fisher, 550.

<sup>13</sup> That the oral testimony of a patentee that he made the device, when his own patent does not show it, and the device is not produced, is not sufficient, see *Woven Wire Mattress Co. v. Wire-Web Bed Co.* (1881), 8 Fed. Rep. 87.

<sup>14</sup> That a witness swearing to prior use is rendered unreliable by evidence that his employers, after having the benefit of his skill, sought the right elsewhere, see *St. Louis Stamping Co. v. Quinby* (1879), 16 O. G. 135; 4 Bann. & A. 192.

That testimony of prior use is overthrown by evidence that the witnesses accepted and operated under a license from the patentee, see *Lockwood v. Hooper* (1885), 25 Fed. Rep. 910.

That the plaintiff may show that the defendant offered a large sum for the patent, and then took out patents for similar devices, this being inconsistent



with all its necessary infirmities, this species of evidence is admissible and may be sufficient to convince a jury, even without specimens or contemporaneous descriptions, that the prior art or article was identical with the patented invention. Identity being thus established, the defendant must further prove that the art or article in question was used in such a manner as to render the invention accessible to the public at the date of its conception by the plaintiff's inventor. Here, as elsewhere, the date of the inventive act of the plaintiff's inventor is assumed to be that of his patent or his application; and it is sufficient for the defendant to show that the use of the invention was prior to that date, in order to throw upon the plaintiff the burden of proving that his conception of the invention preceded not merely the date of his own application but also that of the use shown by the defendant.<sup>15</sup> However,

with his claim of want of novelty, see *Bostock v. Goodrich* (1884), 21 Fed. Rep. 316; 29 O. G. 278.

That a circular published by a person claiming that the invention was then new outweighs his parol evidence that it had previously existed, see *Masury v. Tiemann* (1871), 4 Fisher, 524; 8 Blatch. 426.

<sup>15</sup> That the date of the plaintiff's patent is *prima facie* the date of his inventive act, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 2 Fed. Rep. 774; 17 O. G. 1504; 18 Blatch. 218; 5 Bann. & A. 475.

That the invention claimed in a re-issue is presumed to have been made at the date of the original, see *House v. Young* (1867), 3 Fisher, 335.

That if the application accompanies the patent, the date of the application is *prima facie* the date of the inventive act, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 17 O. G. 1504; 2 Fed. Rep. 774; 18 Blatch. 218; 5 Bann. & A. 475; *Wing v. Richardson* (1865), 2 Fisher, 535; 2 Clifford, 449.

That on a question of prior use the

patent relates back to the date of the original discovery, see *Consolidated Bunting Apparatus Co. v. Woerle* (1887), 29 Fed. Rep. 449; 38 O. G. 1015.

That the date of filing the application cannot be shown by parol but by the records of the Patent Office, see *Wayne v. Winter* (1855), 6 McLean, 344.

That if the defendant shows knowledge or use prior to the application, or patent if the application be not in evidence, the burden shifts to the plaintiff to prove that his inventive act preceded such knowledge or use, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 17 O. G. 1504; 18 Blatch. 218; 2 Fed. Rep. 774; 5 Bann. & A. 475; *Webster Loom Co. v. Higgins* (1879), 16 O. G. 675; 4 Bann. & A. 88; 15 Blatch. 446; *Hazelip v. Richardson* (1876), 10 O. G. 747; *Jones v. Sewall* (1873), 6 Fisher, 343; 3 O. G. 630; 3 Clifford, 563; *Wing v. Richardson* (1865), 2 Fisher, 535; 2 Clifford, 449; *Union Sugar Refinery v. Matthiesson* (1865), 2 Fisher, 600; 3 Clifford, 639.

That the burden of proof is on the

as the defendant is not allowed to reproduce his evidence of prior use after the rebuttal of the plaintiff, it is incumbent on him, when making his defence, to exhaust his testimony as to the remoteness of such use, and fix its date as early as his evidence permits.<sup>16</sup> The use of an invention renders it accessible to the public only when the invention is complete and operative, and when it is practically used in such a manner as to disclose its character, construction, and mode of operation to the public.<sup>17</sup> That an invention was complete and operative may be shown by specimens, if any still exist, or by the testimony of witnesses having personal knowledge of its condition. Descriptions, printed or written, sketches and drawings, are not sufficient of themselves to prove that the invention was operative, or was practically used.<sup>18</sup> The evidence of practical use must be derived from witnesses who actually used the invention or had knowledge of its use by others. Such use must have been in public, not in secret, and in the practical application of the invention to industrial purposes.<sup>19</sup>

patentee to show that he made the invention before the date of filing his application, and he must show that it was before that time reduced to practice, see *Johnson v. Root* (1862), 2 Fisher, 291 ; 2 Clifford, 108.

<sup>16</sup> That new evidence for the defendant is not allowed after the plaintiff's rebuttal, see *Ames v. Howard* (1833), 1 Sumner, 482 ; 1 Robb, 689.

<sup>17</sup> That prior use is not proved by the existence of a device capable of such use, it must have been practically used, see *Piper v. Brown* (1870), Holmes, 20 ; 4 Fisher, 175 ; *Pennock v. Dialogue* (1825), 4 Wash. 538 ; 1 Robb, 466.

That sufficient prior use must be shown to prove that the device will accomplish what is claimed, see *Sayles v. Chicago & Northwestern Railway Co.* (1871), 4 Fisher, 584 ; 3 Bissell, 52.

<sup>18</sup> That a rejected application is not evidence that the invention was completed or in use, see *Howes v. McNeal* (1878), 15 O. G. 608 ; 15 Blatch. 103 ; 3 Bann. & A. 376 ; *Rubber Step Mfg.*

*Co. v. Metropolitan R. R. Co.* (1878), 13 O. G. 549 ; 3 Bann. & A. 252.

That file-wrappers, &c., are not evidence to show the reduction to practice of inventions claimed to be prior to the one patented, being only hearsay evidence and declarations of third parties, see *Howes v. McNeal* (1880), 4 Fed. Rep. 151 ; 17 O. G. 799 ; 17 Blatch. 396 ; 5 Bann. & A. 77.

That a prior patent does not show a use earlier than the date of the patent, see *Howes v. McNeal* (1880), 17 O. G. 799 ; 17 Blatch. 396 ; 4 Fed. Rep. 151 ; 5 Bann. & A. 77 ; *Kelleher v. Darling* (1878), 4 Clifford, 424 ; 14 O. G. 673 ; 3 Bann. & A. 438.

That a caveat is not conclusive evidence that an invention is not perfected, see *Johnson v. Root* (1858), 1 Fisher, 851.

That catalogues, etc., may be offered to show prior use, see *Forschner v. Baumgarten* (1886), 26 Fed. Rep. 858 ; 35 O. G. 137.

<sup>19</sup> That to overcome the presumption



A single instance of such use being established the defence is complete without proof of continued user, except in cases where the use was so remote that the knowledge thus communicated to the public was extinguished, and the invention had become a lost art, at the date of its conception by the plaintiff's inventor.<sup>20</sup> It has been held that proof of actual use is not essential when the invention in its complete and operative state fully disclosed its character and mode of operation without practical employment, and was known in that condition to the public.<sup>21</sup> This cannot be true of an art, since an art can be perceived only while in process of employment, nor of articles whose qualities are manifested only during their practical application. Other articles, disclosing their essential attributes to mere inspection, if shown to have been subject to public observation, may, however, become known by the public without actual use, and in such cases evidence of knowledge without use may be sufficient. Under all other circumstances actual use must be established. Such use must have occurred in the United States, — a use abroad, though known to persons in this country, not impairing the validity of a domestic patent.<sup>22</sup> Even a foreign use of the invention,

arising from the grant of the patent the evidence must show such prior knowledge as gave the public a right to use the invention, see *Crouch v. Speer* (1874), 6 O. G. 187; 1 Bann. & A. 145.

<sup>20</sup> That prior use may be proved though the use has been abandoned, see *Shoup v. Henrici* (1872), 9 O. G. 1162; 2 Bann. & A. 249; *Evans v. Hettick* (1818), 3 Wash. 408; 1 Robb, 166.

That a device was in use twenty-five years ago does not warrant a finding that it is still in operation, see *Seymour v. McCormick* (1856), 19 How. 96.

<sup>21</sup> That both prior knowledge and use need not be proved, for the use may or may not be the sole evidence of identity and knowledge, see *Stitt v. Eastern R. R. Co.* (1884), 22 Fed. Rep. 649.

That evidence of prior use is sufficient if it shows that the invention was

complete and capable of working and was known to a number of persons and had been in use, see *Judson v. Bradford* (1878), 16 O. G. 171; 3 Bann. & A. 539; *Coffin v. Ogden* (1873), 18 Wall. 120; 5 O. G. 270.

<sup>22</sup> That evidence of reduction to practice abroad prior to invention in the United States is inadmissible, see *Bell v. Brooks* (1881), 19 O. G. 290.

That evidence of use abroad is not admissible, see *Doyle v. Spaulding* (1884), 27 O. G. 300; *Schillinger v. Greenway Brewing Co.* (1883), 24 O. G. 495; 21 Blatch. 383; 17 Fed. Rep. 244; *Judson v. Cope* (1860), 1 Fisher, 615; 1 Bond, 327.

That a prior foreign patent is not admissible to prove prior use, see *Cornely v. Marckwald* (1883), 17 Fed. Rep. 83; 24 O. G. 498; 21 Blatch. 367.

That foreign machines not arriving in

of which the plaintiff's inventor was cognizant when he made oath to his application, does not disprove the legal novelty of the invention, although the fraud and falsehood of the applicant would invalidate the patent.<sup>23</sup> The testimony of witnesses as to the fact of use and the completeness and availability of the invention is not open to the same suspicion as their evidence concerning its identity with the patented invention. The recollection of an honest witness as to the operativeness and actual employment of an art or article, whose existence is conceded or established, may in all ordinary cases be regarded as reliable. But where his statements are inconsistent with the general current of events, or where the use to which he testifies must have been observed, if it occurred, by others who deny all knowledge of such use, his evidence is wanting in the conclusiveness and credibility which it must possess in order to overcome the presumptions arising from the patent, and satisfy that burden of proof which the law throws upon the defendant.<sup>24</sup> The plaintiff in rebutting the defendant's evidence of prior use may attack either the identity or the use of the prior art or article. He may disprove its identity by evidence of the same species as that by which the

this country until after the date of the plaintiff's inventive act, have no bearing on the question of novelty, see *Weston Dynamo Electric Mach. Co. v. Arnoux* (1884), 28 O. G. 285; 20 Fed. Rep. 112.

That the issue of an American patent, in the case of a foreign invention, does not prove an introduction into common use, without other evidence, see *Weston v. White* (1876), 9 O. G. 1196; 13 Blatch. 364; 2 Bann. & A. 321.

<sup>23</sup> That the oath of the patentee, that he believed himself to be the first inventor, is not contradicted by proof of foreign prior use, see *Bartholomew v. Sawyer* (1859), 4 Blatch. 347; 1 Fisher, 516; *Furbush v. Cook* (1857), 2 Fisher, 668.

<sup>24</sup> That the testimony of witnesses as to a reduction to practice is incredible, when the devices themselves will

not operate, see *American Bell Telephone Co. v. People's Telephone Co.* (1885), 25 Fed. Rep. 725; 34 O. G. 561.

That the patent is not overcome by the testimony of a single witness that the device was in use twenty years before in a large town, where, if it were so, many must have known it, and when no model or machine is now in existence, and there is no evidence of a general use though the device must have been of great utility, see *Blake v. Eagle Works Mfg. Co.* (1871), 4 Fisher, 591; 3 Bissell, 77.

That the evidence must be very clear in order to show that an old patent on an article well known and constantly used is invalid for a prior use occurring twenty-three years before the prior use was known, see *Zane v. Peck Bros.* (1881), 9 Fed. Rep. 101.



defendant has attempted to affirm it. In addition thereto, he may show the superior utility of either invention to the other as the basis of an inference that differences of such extent in the effect could only proceed from a substantial difference of means.<sup>25</sup> This superior utility may be established by comparing the two inventions, or their practical operation, or their acceptance by the public; the commercial success of one invention and the failure of the other being regarded as an indication of greater usefulness, and consequently of essential differences, in the former.<sup>26</sup> In attacking the alleged use of the invention the plaintiff may endeavor to show either that the invention was not complete and operative, or that it was not practically used in public, or that its use did not anticipate the inventive act of his own inventor. Upon the first point, positive evidence of any kind tending to show that the invention was inoperative and incomplete, until the date of its conception by the inventor from whom he derives it, is admissible. Besides this, he may prove that the prior article or art, after the use referred to by the defendant's witnesses, was abandoned by its inventor as an unsuccessful experiment, and such abandonment may be inferred from the cessation of its use where the invention, if successful, would have been of great utility and would have satisfied a recognized public want.<sup>27</sup> Upon the second point, where he cannot impeach the

<sup>25</sup> That where novelty or *modus operandi* are in question it is proper to show what the effect of the invention is, see *Klein v. Russell* (1873), 19 Wall. 433.

<sup>26</sup> That superior utility shows want of identity, see §§ 116-121, 344, and notes, *ante*.

<sup>27</sup> In *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86, Sprague, J. : (102) "If there were experiments made, gentlemen, and they tend to a certain point, and there is no certainty to what extent they went, then the subsequent conduct of the parties who made experiments, and were interested in it, may aid you in forming an opinion of what they accomplished. If they preserved

it as a thing valuable, it has a weight in one direction as showing that they had accomplished something. If they did not preserve it but abandoned it, the evidence is to be weighed whether it was abandoned or not; whether a success has been obtained in anything that was worthy of preservation, or could accomplish a practical and useful purpose; and the weight of this you will probably know is in proportion to the importance of the thing. There may be an invention, gentlemen, of so unimportant a character, that although it be really an invention, something of practical use, it may be in relation to a subject-matter of so little importance, or of transient interest, that the occa-

testimony of the witnesses who claim to have used the invention or to have knowledge of its use, he may attempt to prove that the invention became a lost art, and passed from the knowledge of the public, and that it was discovered and again bestowed upon them by his own inventor.<sup>28</sup> The negative evidence of witnesses, who would have been acquainted with the invention if it had been practically used and known, is here of great importance, and may be offered to contradict the fact of use, as well as its continuance and publicity, and the accessibility of the invention to the public at the date of its conception by the inventor named in the patent.<sup>29</sup> Upon the third point, it is only necessary for the plaintiff to carry back the date of the inventive act of his inventor to a period anterior to the earliest practical use in public which has been already proved by the defendant. If such use did not precede the filing of the application for a patent, a certified copy of the application from the Patent Office with the date of its reception is sufficient. If the use occurred before the application, evidence of the earlier conception of the invention may be offered, consisting either of specimens made or descriptions framed before the alleged use, or of the testimony of witnesses

sion may pass by and it may be laid aside and never used afterward, because there was no occasion for it. . . . On the other hand, if the invention be of something which can be of great practical importance, an enduring importance, then you will consider how much stronger will be the incentive to success in perfecting that which would have been of importance; and the greater the importance of the invention, the less probable that if achieved it would have been laid aside and not extended itself to others interested in its use."

<sup>28</sup> That the existence of an invention which became a lost art before the inventive act of the patentee does not show prior use, see §§ 321-324, and notes, *ante*.

<sup>29</sup> That negative evidence is important, such as non-attack upon patent,

non-publication in books, etc., non-acquaintance of those skilled in the art, etc., see *Parker v. Hulme* (1842), 1 Fisher, 44.

That the evidence of a witness that at a particular time the plaintiff made a device which the witness never before saw or heard of is admissible, see *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

That silence raises a stronger presumption than the evidence of witnesses, see *Smith v. Fay* (1873), 6 Fisher, 446.

That intangible presumptions must yield to positive proof, see *Bliss v. Merrill* (1837), 42 O. G. 97.

That positive evidence of witnesses as to the existence of prior devices must outweigh merely negative proof, see *Sayles v. Chicago & Northwestern Railway Co.* (1871), 4 Fisher, 584; 3 Bissell, 52.



who, prior to such use, saw the invention which he had produced, or in some other way derived from him a knowledge of its essential characteristics.<sup>80</sup> The burden of proof, on this point, shifts to the plaintiff when the defendant proves a use anterior to the date of the application, especially where the existence of the invention is evidenced by a patent issued before the patent of the plaintiff. With this exception, the burden on the entire issue of prior use rests upon the defendant, and though when proved it is destructive to the patent, yet if his testimony falls short of removing every reasonable doubt, and leaves a mere preponderance in his favor, the *prima facie* evidence of the patent is not overcome and the novelty of the invention remains unimpeached.<sup>81</sup> This issue of prior use may be raised by the defendant in reference to several distinct inventions, each of which he claims as an anticipation of, the one covered by the plaintiff's patent. In such a case each stands alone as to the questions of identity and actual use, and must not only be separately considered by the jury but also distinguished in their verdict, unless the issue is found alike on all in favor of the plaintiff.<sup>82</sup> The same

<sup>80</sup> In *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448, Story, J. : (462) "The conversations and declarations of a patentee, merely affirming that at some former period he invented that particular machine, might well be objected to. But his conversations and declarations, stating that he had made an invention, and describing its details and explaining its operations, are properly to be deemed an assertion of his right, at that time, as an inventor to the extent of the facts and details which he then makes known; although not their existence at an antecedent time." 2 Robb, 46 (69).

That the plaintiff in rebutting the evidence attacking the novelty of his invention, may show the date of his inventive act by sketches and drawings, see *Kneeland v. Sheriff* (1880), 18 O. G. 242; 2 Fed. Rep. 901; 5 Bann. & A. 482; *Draper v. Potomska Mills Co.*

(1878), 13 O. G. 276; 3 Bann. & A. 214; *Reeves v. Keystone Bridge Co.* (1872), 1 O. G. 466; 5 Fisher, 456; 9 Phila. 368.

That the plaintiff may show that alleged prior users subsequently became his licensees, see *Evans v. Eaton* (1818), 3 Wheaton, 454; 1 Robb, 243.

That the former testimony of the plaintiff that he had invented does not constitute invention, see *Pennsylvania Diamond Drill Co. v. Simpson* (1886), 37 O. G. 218; 29 Fed. Rep. 288.

<sup>81</sup> That the court will presume against prior knowledge or use in case of doubt, see note 4, *ante*.

That when the defendant's evidence is fully up to the standard, the novelty is successfully impugned, see *Doubleday v. Beatty* (1882), 11 Fed. Rep. 729; 22 O. G. 859.

<sup>82</sup> That where several prior inventions are offered to defeat a patent each

rule applies where several prior patents or publications are set up by the defendant.

§ 1027. Evidence under the Fifth Defence: Novelty of the Patented Invention: Prior Patent.

When the defendant denies the novelty of the invention on the ground of a prior patent, two questions, similar to those involved in the defence of prior use, also arise: (1) Whether the invention described and claimed in the plaintiff's patent is identical with or included in the invention described and claimed by the alleged prior patent; (2) Whether the prior patent was duly issued before the conception of the invention by the plaintiff's inventor. The plaintiff's patent is *prima facie* evidence that the invention described and claimed therein is essentially distinct from all inventions covered by preceding patents.<sup>1</sup> The defendant must, therefore, affirmatively prove that the prior patent embraced the invention of the plaintiff. His evidence on this point is the prior patent itself, construed by the court in connection with the plaintiff's patent.<sup>2</sup> Other testimony is unnecessary on either side, unless the court de-

stands alone as to evidence and verdict, and the jury must agree on each separately, and if they find for the defendant on one of them they must agree on that one, see *Waterman v. Thomson* (1863), 2 Fisher, 461.

That when a patent claims three inventions the plaintiff must prove a right to each, see *Heinrich v. Luther* (1855), 8 McLean, 345.

§ 1027. <sup>1</sup> That the grant of a patent is a decision by the Commissioner that the invention is not covered by prior patents, see *Putnam v. Keystone Bottle-Stopper Co.* (1889), 38 Fed. Rep. 234; *Serrell v. Collins* (1857), 1 Fisher, 289.

That the patent is *prima facie* evidence that the thing patented differs from every other patented invention and from anything described in any specification of any patent, see *Poppenhusen v. N. Y. Gutta-Percha Comb Co.* (1858), 2 Fisher, 62.

That a patent for a later machine is strong *prima facie* evidence of its essential difference from an earlier patented machine, especially if the later patent has been re-issued and extended, see *La Baw v. Hawkins* (1874), 6 O. G. 724; 1 Bann. & A. 428.

<sup>2</sup> That a defendant may offer in evidence his own patent, see *Corning v. Burden* (1853), 15 How. 252.

That the defendant's patent is *prima facie* proof of the novelty and utility of his invention, see *Worswick Mfg. Co. v. City of Kansas* (1889), 38 Fed. Rep. 239.

That a defendant who infringes both the patent for the original and that for the improvement, cannot set up the former patent as anticipating the latter, see *Cantrell v. Wallick* (1886), 117 U. S. 689; 35 O. G. 871.



sires the aid of experts in explaining and comparing the claims and descriptions of the patents.<sup>3</sup> Upon the second question the defendant also has the burden of proof. To satisfy it he must show that the alleged prior patent is a public document, that it was made accessible to the public before the conception of the invention by the plaintiff's inventor, and that its description of the invention is sufficiently precise and complete to enable persons skilled in the art to practise it without the exercise of their own inventive faculties.<sup>4</sup> Whether or not a prior patent is a public document depends upon the provisions of the law under which it issues. A patent granted by the United States is always of that character, but in some foreign countries patents are public or secret as the government in each case may determine. It is incumbent on the defendant to show that the patent which he offers as anticipating that of the plaintiff is a public patent according to the law of the place in which it has been granted.<sup>5</sup> He must also prove that it was issued to the public before the date of the inventive act under which the plaintiff claims. The date of the prior patent is regarded as the earliest date at which it could have been given to the public, and evidence of its preceding publication or existence is inadmissible.<sup>6</sup> The date of

<sup>3</sup> That the prior patent is to be submitted to the jury with the evidence of experts as to identity, see *Tucker v. Spalding* (1871), 13 Wall. 453; 1 O. G. 144; 5 Fisher, 297.

<sup>4</sup> For the requisites of a prior patent, see §§ 331-337, and notes, *ante*.

That the defence of prior patent is not established where the original prior patent did not cover the invention, and has been re-issued to embrace it since the date of the patent in dispute, see *Vogler v. Semple* (1877), 11 O. G. 923; 7 Bissell, 382; 2 Bann. & A. 556.

<sup>5</sup> That French patents, being some private, some public, the defendant must show which they are, see *Brooks v. Norcross* (1857), 2 Fisher, 661.

That although some French patents are secret, yet one verified after the manner of public records is to be re-

garded as a public one, see *Schoerken v. Swift & Courtney & Beecher Mfg. Co.* (1881), 19 O. G. 1493; 7 Fed. Rep. 469; 19 Blatch. 209.

That copies of specifications and drawings without the patent do not show that an invention was patented, see *Brooks v. Norcross* (1851), 2 Fisher, 661.

<sup>6</sup> That patents cited as anticipating the plaintiff's invention are regarded only as public grants, and nothing from the Patent Office is admissible to show an earlier date than that of the patent, see *Howes v. McNeal* (1880), 17 O. G. 799; 17 Blatch. 396; 4 Fed. Rep. 151; 5 Bann. & A. 77; *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

That a patent issued upon an application filed before the date of a conflicting patent is presumed to have priority

the patent itself is not, however, evidence that it then became accessible to the public. Under our own system, the issue of the patent and its publication are substantially contemporaneous, but under other systems the grant of the monopoly may be awarded before the full disclosure of the invention to the public is required. In such cases the patent takes effect as a prior and anticipating patent only at the time when its completed specification is filed and published, and the defendant must, therefore, fix by his evidence the date of this disclosure as the date from which his prior patent operates against all subsequent inventors.<sup>7</sup> Such proof is generally furnished by the certified copies of the specifications and drawings of the patent, which are by statute made *prima facie* evidence of the existence of the patent and of its date and contents.<sup>8</sup> Where these are unobtainable, the date of publication may be proved by any other competent and accessible testimony. If the date thus fixed by the defendant as that of the publication of the alleged prior patent is anterior to the date of the plaintiff's patent, it becomes the duty of the plaintiff to prove that the invention was conceived by his inventor before the prior patent had been given to the public.<sup>9</sup> His evidence upon this

unless the contrary appears, see *Kearney v. Lehigh Valley R. R. Co.* (1887), 32 Fed. Rep. 320.

That file-wrappers, contents, and drawings of a patent set up in defence do not show that the invention was made at the date of the oath or was then reduced to practice, see *Howes v. McNeal* (1880), 17 O. G. 799; 17 Blatch. 396; 4 Fed. Rep. 151; 5 Bann. & A. 77.

<sup>7</sup> That under Sec. 4920, Rev. Stat., an English patent is not issued until a complete specification is filed, see *Coburn v. Schroeder* (1882), 22 O. G. 419; 11 Fed. Rep. 425; 20 Blatch. 392.

That an English patent is effective as an anticipation only from the date of its sealing, see *Bliss v. Merrill* (1887), 42 O. G. 97.

That an earlier English provisional specification may show the state of the

art and thus negative invention, see *McNab & Harlow Mfg. Co. v. Nathan Mfg. Co.* (1887), 40 O. G. 1240; 32 Fed. Rep. 155.

<sup>8</sup> That copies of domestic or foreign patents from the Patent Office, duly authenticated, are sufficient evidence of their issue and date, see §§ 1015, 1016, and notes, *ante*.

<sup>9</sup> That the defence of prior patent is sustained when the date of the patent is earlier than that of the patent in suit, and the plaintiff must then carry his date back beyond it by the application or by some other evidence, see *Kelleher v. Darling* (1878), 14 O. G. 673; 4 Clifford, 424; 3 Bann. & A. 438.

That a prior patent is held prior if its date is prior to the one in suit, unless the latter is accompanied by its application, or the parol proof shows that its patentee invented before the



point is the same as that required whenever the date of an inventive act is to be ascertained. In proving that the prior patent disclosed the invention with sufficient completeness and precision to enable any person skilled in the art to practise it, the defendant must rely upon the testimony of persons who have actually constructed and used it under the guidance of the prior patent, or on that of experts and practical workmen that the invention could be practised, from the descriptions and directions in the patent, by skilled artisans without the exercise of their own inventive powers. To this evidence the plaintiff may reply with testimony of the same character, and the credibility and weight to be attached to the antagonistic proof must be determined by the jury from their own general acquaintance with the subject and from the apparent ability and integrity of the witnesses produced.<sup>10</sup> In case of doubt the plaintiff must prevail.

**§ 1028. Evidence under the Fifth Defence : Novelty of the Patented Invention : Prior Publication.**

A denial of the novelty of the patented invention on the ground of a prior publication also embraces two questions: (1) Whether the invention patented is identical with or included in the one described in the alleged publication; (2) Whether the alleged publication constitutes such a disclosure of the invention to the public as is by law made fatal to the patent. The burden of proof on both points rests on the defendant after the patent of the plaintiff has been introduced. The identity of the two inventions may be shown by comparing the descriptions, with or without the aid of experts, or by the examination of specimens proved to have been made

date of the rival patent, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

That the defendant may offer his own re-issue of a patent earlier than the plaintiff's, and if the evidence rests there, he will prevail, see *House v. Young* (1867), 3 Fisher, 335.

That the patentee may prove that he invented and reduced to practice before

the date of a foreign patent which was granted before he filed his application, see *White v. Allen* (1863), 2 Fisher, 440; 2 Clifford, 224.

<sup>10</sup> That if a foreign patent is offered to anticipate the plaintiff's patent he may show that the device therein described is inoperative and worthless, see *Harwood v. Mill River Woollen Mfg. Co.* (1869), 3 Fisher, 526.

under the sole direction of the publication and without a knowledge of the invention of the plaintiff. Counter-evidence of the same class may be offered for the plaintiff in rebuttal. The legal sufficiency of the publication to invalidate the plaintiff's patent depends on its possession of the following requisites: (1) It must be in its nature a public work; (2) It must describe the invention in such a manner that any person skilled in the art can practise it without further directions; (3) It must have been made accessible to the public before the conception of the invention by the plaintiff's inventor.<sup>1</sup> That the publication is a public work may appear from its general contents, from the source whence it proceeds, or from the persons for whom it is evidently intended. The printing of a book or document for unrestricted circulation, or for the use of all who may require it, or for any extensive class of persons, is sufficient to give the work the necessary public character.<sup>2</sup> These facts may be established by an inspection of the work itself, or may be proved by any witness acquainted with its origin and purpose. That the description renders the invention clear to competent workmen, and enables them to practise it, is shown or contradicted by the testimony of experts and practical mechanics, and of those artisans who have succeeded or failed in their endeavors to construct or use it in obedience to the directions given. To prove that the printed book or document has been made accessible to the public, evidence of actual presentation to the public, in some form, must be offered. If the work has been placed in a public library and duly catalogued, or otherwise brought within the reach of those who may be interested in its contents, or if it has been publicly exposed for sale, or gratuitously distributed to the community, or lodged in some governmental office where it may be consulted or copies of its statements may be obtained on application, it is regarded as communicating to the public

§ 1028. <sup>1</sup> For the general requisites of a prior publication, see §§ 325-330 and notes, *ante*.

<sup>2</sup> That a report to a hose company describing the invention is not a public work and cannot be read by the defend-

*ant*, see *Pennock v. Dialogue* (1825), 4 Wash. 538; 1 Robb, 466.

That catalogues, etc., may be admitted as prior publications if notice of them as such has been given, see *Forschner v. Baumgarten* (1886), 26 Fed. Rep. 858; 35 O. G. 187.



whatever information it contains.<sup>3</sup> Either or all of these acts, and others of a similar character, may be proved by the defendant by any testimony, oral or written, that may be available. This evidence must also show that the act of publication occurred before the date of the conception of the invention by the plaintiff's inventor. The latter date is *prima facie* that of the plaintiff's patent or his application, but inasmuch as in rebuttal he may anticipate that date by the usual evidence of an earlier inventive act, the defendant must establish for the act of publication a date anterior to any which the plaintiff can maintain, or the issue will eventually be found against him.<sup>4</sup> For the purpose of fixing the date of publication, the imprint of the work is not sufficient.<sup>5</sup> Extraneous evidence showing the fact of presentation to the public on or before a given day is necessary, there being no presumption that a book or document was placed in circulation at or near the period mentioned in its pages. Much of the testimony on the several points involved in this defence of prior publication is ordinarily derived from the printed book or document itself, which is produced in court and submitted to the examination of the witnesses and jury. Where the defendant is unable to obtain a copy for production, and satisfactorily accounts for its absence, he is permitted to prove by parol not only the

<sup>3</sup> See as to the fact of publication § 827 and notes, *ante*.

That the evidence of the prior publication is proof of the fact of publication only, see *Seymour v. McCormick* (1856), 19 How. 96.

That under Sec. 61, act of 1870, a defence of previous publication by an English provisional specification must be clearly proved, see *Cohn v. United States Corset Co.* (1874), 6 O. G. 259; 12 Blatch. 225; 1 Bann. & A. 340.

<sup>4</sup> That if a complete description was published before the date of the patent in controversy, the defendant has sustained his defence until the plaintiff proves that his own inventive act was earlier, see *Kelleher v. Darling* (1878), 14 O. G. 678; 4 Clifford, 424; 3 Bann. & A. 438.

<sup>5</sup> In *Reeves v. Keystone Bridge Co.* (1872), 1 O. G. 466, McKennan, J.: (471) "It is not shown that the work was published before the date of the complainant's patent. This must be directly proved. It is not deducible from the imprint on the title-page. That the work was then printed may be inferred from this imprint; but when it was put in circulation or offered to the public is a distinct fact, which must be proved independently. The intended circulation of a book of a public nature may be presumed from its being put into print; but it does not follow that a work such as the one in question was made accessible to the public as soon as it was printed, or that it was actually published at all." 9 Phila. 868 (374); 5 Fisher, 456 (467).

fact and date of publication, but the contents of the work in reference to the invention.<sup>6</sup> Such evidence is, however, always subject to serious infirmities arising from faulty recollection and unintentional misstatement, and is entitled to slight consideration when opposed by other testimony.

§ 1029. Evidence under the Sixth Defence: Utility of the Patented Invention.

The sixth defence denies the utility of the patented invention. The patent is *prima facie* evidence in favor of the plaintiff on this issue, and the defendant must therefore prove the uselessness of the invention beyond reasonable doubt.<sup>1</sup> The testimony ordinarily available for this purpose is that of experts whose inspection of the invention has satisfied them of its inutility, and that of practical mechanics who

<sup>6</sup> That the date and contents of a publication may, in some extreme cases, be shown by parol, see *Allen v. Hunter* (1855), 6 McLean, 303.

§ 1029. <sup>1</sup> That the patent is *prima facie* evidence of utility, see *Kirk v. Du Bois* (1887), 33 Fed. Rep. 252; *Deane v. Hodge* (1886), 35 Minn. 146; *Lehnbeuter v. Holthaus* (1881), 105 U. S. 94; 21 O. G. 1783; *Corvallis Fruit Co. v. Curran* (1881), 8 Fed. Rep. 150; 7 Sawyer, 270; *Thomas v. Shoe Mach. Mfg. Co.* (1878), 16 O. G. 541; 3 Bann. & A. 557; *Miller & Peters Mfg. Co. v. Du Brul* (1877), 12 O. G. 351; 2 Bann. & A. 618; *Smith v. Woodruff* (1873), 6 Fisher, 476; 4 O. G. 635; 1 MacArthur, 459; *Whitney v. Mowry* (1867), 3 Fisher, 157; 2 Bond, 45; *Blanchard v. Puttman* (1867), 3 Fisher, 186; 2 Bond, 84; *Swift v. Whisen* (1867), 3 Fisher, 343; 2 Bond, 115; *Bell v. Daniels* (1858), 1 Fisher, 372; 1 Bond, 212; *Poppenhusen v. N. Y. Gutta Percha Comb Co.* (1858), 2 Fisher, 62; *Ransom v. Mayor of N. Y.* (1856), 1 Fisher, 252; *Parker v. Stiles* (1849), 5 McLean, 44.

That the patent is *prima facie* evi-

dence of utility although the invention be very simple and not the best mode of effecting the result, see *Bell v. Daniels* (1858), 1 Fisher, 372; 1 Bond, 212.

That courts do not usually reverse the decision of the Patent Office that an invention is useful, however slight the utility, see *Doherty v. Haynes* (1874), 6 O. G. 118; 4 Clifford, 291; 1 Bann. & A. 289.

That a patent, whether an original or a re-issue, is *prima facie* evidence that the invention is useful, see *Serrell v. Collins* (1857), 1 Fisher, 289.

That the patent is only *prima facie* evidence of utility, see *Green v. Stuart* (1874), 7 Baxter (Tenn.), 418.

That the patent being in evidence the burden of proof rests on the defendant to show want of utility, see *Vance v. Campbell* (1859), 1 Fisher, 483; *Parker v. Stiles* (1844), 5 McLean, 44.

That the defence of want of utility can prevail only when there is no reasonable doubt, see *Kearney v. Lehigh Valley R. R. Co.* (1887), 32 Fed. Rep. 320; *Whitney v. Mowry* (1867), 2 Bond, 45; 3 Fisher, 157; *Tilghman v. Werk* (1862), 1 Bond, 511; 2 Fisher, 229.



have attempted to employ it and have found it worthless. If this testimony demonstrates that the invention is either mischievous or frivolous, the defence will be sustained.<sup>2</sup> The plaintiff may rebut the evidence of the defendant by introducing experts who have formed opposite opinions, and practical mechanics who have had a contrary experience. He may prove its extensive use, its general effect upon the state of the art, or its commercial success, from either of which facts its utility may be inferred.<sup>3</sup> The very contest of the parties over the invention affords some indication of its value.<sup>4</sup> A defendant who is shown to have actually used the invention, whether wrongfully or under a license from the patentee, or who has obtained a patent covering substantially the same art or article, is estopped from denying its utility.<sup>5</sup>

<sup>2</sup> As to utility in general, see §§ 338-344, and notes, *ante*.

As to want of utility as a defence, see § 964, and notes, *ante*.

<sup>3</sup> That the effect of the invention may indicate its utility, see *Klein v. Russell* (1873), 19 Wall. 433.

That success and practical results are evidence of utility, see *Judson v. Moore* (1860), 1 Fisher, 544 ; 1 Bond, 285.

That utility is shown by extensive use, see *Turrill v. Spaeth* (1878), 3 Bann. & A. 458 ; 14 O. G. 377 ; *Adams v. Edwards* (1848), 1 Fisher, 1.

<sup>4</sup> That the very contest of the parties over the patent is some evidence of utility, see *Middletown Tool Co. v. Judd* (1867), 3 Fisher, 141.

<sup>5</sup> That a defendant who has used the invention cannot deny its utility, see *La Rue v. Western Electric Co.* (1887), 31 Fed. Rep. 80 ; 40 O. G. 576 ; *Newbury v. Fowler* (1886), 28 Fed. Rep. 454 ; 36 O. G. 817 ; *Palmer v. United States* (1884), 19 Ct. of Claims, 669 ; *Bliss v. City of Brooklyn* (1871), 8 Blatch. 533 ; 4 Fisher, 596 ; *Lee v. Blandy* (1860), 2 Fisher, 89 ; 1 Bond, 361 ; *Haya v. Sulzor* (1859), 1 Bond, 279 ; 1 Fisher, 532 ; *Simpson v. Mad River R. R. Co.* (1855), 6 McLean, 608 ;

*Kneass v. Schuylkill Bank* (1820), 4 Wash. 9 ; 1 Robb, 303.

That use by defendant is strong evidence of utility, see *Kearney v. Lehigh Valley R. R. Co.* (1887), 32 Fed. Rep. 320 ; *Adams & Westlake Mfg. Co. v. Rathbone* (1886), 26 Fed. Rep. 262 ; *Niles Tool Works v. Betts Mach. Co.* (1886), 27 Fed. Rep. 301 ; *Phillips v. Carroll* (1885), 23 Fed. Rep. 249 ; 31 O. G. 265 ; *Hancock Inspirator Co. v. Jenks* (1884), 21 Fed. Rep. 911 ; *Foye v. Nichols* (1882), 8 Sawyer, 201 ; 22 O. G. 2243 ; 13 Fed. Rep. 125 ; *Tyler v. Crane* (1880), 7 Fed. Rep. 775 ; 19 O. G. 129 ; *Smith v. Glendale Elastic Fabrics Co.* (1874), Holmes, 340 ; 5 O. G. 429 ; 1 Bann. & A. 58 ; *Turrill v. Illinois Central R. R. Co.* (1867), 3 Fisher, 330 ; 3 Bissell, 66 ; *Mabie v. Haskell* (1865), 2 Clifford, 507.

That every doubt as to utility is resolved against a defendant who used the invention, see *Phillips v. Carroll* (1885), 31 O. G. 265 ; *Whitney v. Mowry* (1870), 4 Fisher, 207.

That a former license to the defendant to use the invention is evidence of its utility, see *Lee v. Blandy* (1860), 2 Fisher, 89 ; 1 Bond, 361.

That features claimed to be useful in

§ 1030. Evidence under the Seventh Defence: Abandonment of the Patented Invention to the Public.

The seventh defence asserts that the invention was abandoned and passed into the possession of the public before the date of the infringement. An invention may be abandoned either before the application for a patent, or by or during the pendency of the application, or after the patent has been granted. The patent itself is *prima facie* evidence that there has been no abandonment at any time, and the defendant must overcome this evidence by conclusive proof of dedication to the public.<sup>1</sup> No abandonment can take place unless the invention is complete and operative, and available for immediate public use. The certainty and weight of evidence required to prove abandonment varies according to the period at which it is alleged to have occurred, — the presumption against it being stronger after than before the application, and strongest after the issue of the patent.<sup>2</sup> Abandonment before the application may be shown by evidence of any acts or declarations of the inventor, manifesting an intention to abandon. His mere omission to practise the invention or to make application for a patent is not sufficient;<sup>3</sup> but proof

the defendant's machine must be useful also in the plaintiff's, see *Foye v. Nichols* (1882), 22 O. G. 2243; 13 Fed. Rep. 125; 8 Sawyer, 201.

§ 1030. <sup>1</sup> As to abandonment as a defence, see § 965 and notes, *ante*.

That the patent is *prima facie* evidence that there has been no abandonment by public use or otherwise, see *United States Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 11 O. G. 373; 14 Blatch. 94; 2 Bann. & A. 493; *Brown v. Whittemore* (1872), 5 Fisher, 524; 2 O. G. 248; *Johnsen v. Fassman* (1872), 5 Fisher, 471; 2 O. G. 94; 1 Woods, 138.

That the burden of proof rests on the defendant to shew that the invention was in public use or on sale two years before the application, see *American Hide & Leather Splitting & Dressing Mach. Co. v. American Tool & Machine*

*Co.* (1870), 4 Fisher, 284; *Holmes*, 508; *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134; *Knight v. Baltimore & Ohio R. R. Co.* (1840), Taney, 106; 3 Fisher, 1.

That the evidence of abandonment must be conclusive, see *Pitts v. Hall* (1851) 2 Blatch. 229; *McCormick v. Seymour* (1851), 2 Blatch. 240.

<sup>2</sup> That evidence that the plaintiff has abandoned his patent is admissible, see *Wayne v. Holmes* (1856), 2 Fisher, 20; 1 Bond, 27.

That the evidence of abandonment after patent must be very strong, see *Bell v. Daniels* (1858), 1 Fisher, 372; 1 Bond, 212.

<sup>3</sup> The present condition of the authorities renders this doctrine doubtful, however strongly it may have been asserted in past decisions. See §§ 357, 388-390, and notes, *ante*.



that he has voluntarily destroyed the finished article without intending to rebuild it, or that he has distributed it to others asserting that no effort would be made to patent it, or has permitted its universal public use without objection or the expression of his intention to protect his rights, will, if uncontradicted, justify the jury in finding this issue for the defendant.<sup>4</sup> In replying to this evidence the plaintiff may offer testimony contradicting the statements of the defendant's witnesses, or showing other acts and declarations of the inventor from which a contrary intention is to be inferred. The filing of the application for the patent proves irrefutably that the inventor did not then intend to abandon, and is of greater weight than any doubtful acts of prior dedication.<sup>5</sup> Declarations of the inventor that it was not his purpose to forego his rights cannot, however, overcome those inferences concerning his intention which necessarily arise from his admitted conduct.<sup>6</sup> Abandonment before the application may be also shown by evidence of any public use or sale of the invention, with the acquiescence of the inventor, more than two years before the application was filed. The proof of a single instance of such sale or use conclusively establishes abandonment and invalidates the patent. The evidence on this point must disclose a practical use for business purposes, either by the public or subject to their observation, or a sale

<sup>4</sup> That the abandonment of an unpatented invention may be shown by its being broken up without intent to reconstruct it, see *Johnson v. Root* (1862), 2 Clifford, 108 ; 2 Fisher, 291.

That a machine was abandoned shows it to have been an unsuccessful experiment, see *Hayden v. Suffolk Mfg. Co.* (1862), 4 Fisher, 86. See also §§ 318, 351, and notes, *ante*.

<sup>6</sup> That the filing of an application is conclusive evidence that the inventor did not then intend to abandon the invention, but does not prove the want of subsequent intention, see *United States Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 11 O. G. 373 ; 14 Blatch. 94 ; 2 Bann. & A. 493.

That to rebut a claim of abandonment the plaintiff may show the filing of drawings or any other act in assertion of his rights, see *Emerson v. Hogg* (1845), 2 Blatch. 1.

<sup>6</sup> That where the acts of the inventor show abandonment, his statement that he did not intend to abandon is of little weight, see *Bevin v. East Hampton Bell Co.* (1871), 5 Fisher, 23 ; 9 Blatch. 50.

That a mere averment in the bill alleging non-abandonment does not avail against facts showing it, see *Marsh v. Sayles* (1872), 5 Fisher, 610 ; 2 O. G. 340.

untrammelled by conditions which still retain the invention under the control of the inventor. This evidence may be produced by witnesses who participated in or had knowledge of the transactions to which it relates.<sup>7</sup> The acquiescence of the inventor in such use or sale may be inferred from words or actions indicating his intelligent consent, or from his failure when acquainted with such use or sale to protest or seek the interference of the Patent Office or the courts for his protection.<sup>8</sup> Tortious uses and sales without his knowledge, and uses or sales under the authority of unknown rival inventors, even though these have obtained patents, are not proof of abandonment by him.<sup>9</sup> The plaintiff may rebut the evidence of public use or sale by testimony which denies the fact of use or sale, or shows the use to have been experimental or in secret, or the sale to have been conditional, or either use or sale to have been without the inventor's knowledge. An abandonment by application may consist in a specific disclaimer of the invention, or in describing but omitting to insert it in the Claim.<sup>10</sup> The first form of abandonment is proved by a certified copy of the application in which the disclaimer is contained. This evidence is usually conclusive on the plaintiff, though where no rival claimant exists, and the disclaimer was inserted by mistake and was corrected within reasonable time after the discovery of the error, or reasonable time for its correction has not yet elapsed, the plaintiff may be properly allowed to show the truth, and either escape the conse-

<sup>7</sup> As to public use or sale and their requisites, see §§ 354-360, and notes, *ante*.

That under the defence of public use the defendant must show two years' sale or use before the application with the consent of the inventor, see *Jones v. Sewall* (1873), 6 *Fisher*, 343; 3 *O. G.* 630; 3 *Clifford*, 563.

<sup>8</sup> That the evidence of abandonment by public use or sale must be clear and conclusive, see *Campbell v. James* (1879), 18 *O. G.* 979; 17 *Blatch.* 42; 4 *Bann. & A.* 456.

That where a two years' public use is proved the burden is on the plaintiff

to show that it was experimental, see *Smith & Griggs Mfg. Co. v. Sprague* (1887), 123 *U. S.* 249; 41 *O. G.* 1037.

<sup>9</sup> That tortious uses or sales are piracies and no public use grows out of them, see *Jones v. Sewall* (1873), 6 *Fisher*, 343; 3 *O. G.* 630; 3 *Clifford*, 563; see also § 357 and notes, *ante*.

<sup>10</sup> As to abandonment by application, see §§ 352, 506, 690-692, and notes, *ante*.

That abandonment may be shown by the absence of the invention from the model or caveat, see *Johnson v. Root* (1862), 2 *Clifford*, 108; 2 *Fisher*, 291.



quences of his former inadvertence or secure an opportunity for the amendment of his patent.<sup>11</sup> The omission to claim an invention which is fully disclosed in the description is regarded as conclusively establishing a dedication to the public, unless the omitted invention is embraced in a new application, or in an amendment of the former specification, within a reasonable time.<sup>12</sup> The evidence in reference to this form of abandonment must be adapted to the circumstances under which the issue has arisen. When the suit is based on the original patent, in which the description and Claim of the application are now embodied, their construction by the court simply shows that the omitted invention is not covered by the patent, and leaves no room for any question of fact or issue of abandonment. If the suit is based on a re-issue in which the original defect has been supplied, the issue arises, not under the defence of abandonment, but on the validity of the re-issue under the ninth defence. Thus this form of abandonment seems to be available as a subdivision of the present seventh defence only in an action founded on a new patent containing matter described, but not claimed, in a former patent to the same inventor. This new patent, though otherwise impregnable, is invalid on the ground of abandonment, if the invention which it covers was disclosed to the public but not claimed by the inventor in the application for the former patent, and his application for the new patent has been unreasonably delayed. In proving such abandonment, the former patent, or a certified copy thereof, may be offered by the defendant to exhibit the variance between its Claim and

<sup>11</sup> That a mistaken disclaimer is not conclusive when there are no private adverse interests, see *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134. See also § 689, and notes, *ante*.

<sup>12</sup> That omission to claim a fully described invention is abandonment unless the error be at once corrected, see *Parker & Whipple Co. v. Yale Lock Co.* (1887), 123 U. S. 87; 41 O. G. 811; *Wollensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301. See also § 690, and notes, *ante*.

That a description of the invention in a prior patent to the same inventor is no bar to a patent and does not show abandonment, see *Vulcanite Paving Co. v. American Artificial Stone Pavement Co.* (1887), 42 O. G. 828.

That a re-issue, unless fraudulent, is *prima facie* evidence that there has been no abandonment, and that all necessary prerequisites were complied with, see *Hoffheins v. Brandt* (1867), 3 Fisher, 218.

its description. If this discrepancy is not apparent on the face of the patent, the record of a judicial interpretation, if it has received one, may be introduced, or any evidence concerning the state of the art or the nature of the invention, which tends to show that the inventor must have known of the divergence between his description and his Claim.<sup>13</sup> His unreasonable delay in securing a new patent, after such knowledge was acquired, may appear from evidence of his ability and opportunity to do so at a period of time substantially earlier than the one in which it was accomplished. An error of this character, evident on the face of his former patent, demands instant correction, in order that the public may not be misled, and any avoidable delay is unreasonable if the rights of other innocent parties or of the public intervene; but in cases where the error is ascertained only by the result of litigation, or after a more intimate acquaintance with the art, a wider latitude is permitted to the inventor, though still within such limits as preserve the just and equitable privileges of others.<sup>14</sup> The evidence must, in both these cases, show that the inventor could have applied for the new patent sooner than he did after the necessity therefor became known to him, and that he either acquiesced in the disclosure of his unprotected invention for a period too long to be consistent with an original intention on his part to claim it, or while he had such knowledge of its appropriation by others as now estops him from averring that he did not then intend to dedicate it to the public.<sup>15</sup> The plaintiff, in replying to this evidence, is confined to the question of unreasonable delay except in cases where his knowledge of the insufficiency of his Claim is said to be derived from other sources than the language of his patent or its interpretation by the courts. His cognizance of an evident discrepancy, or of a defect revealed by the decision of the court of last resort, he cannot be permitted to deny. But where his knowledge is inferred from extraneous facts,

<sup>13</sup> That the patentee's knowledge of the defect may appear from the face of the patent, see *Wollensak v. Reiher* (1885), 115 U. S. 96; 31 O. G. 1301; and other cases cited in § 690, note 2, *ante*.

<sup>14</sup> That an apparent defect must be immediately corrected, see § 690 and notes, *ante*.

<sup>15</sup> As to unreasonable delay in re-issue, see §§ 690-692, and notes, *ante*.



he may contradict both facts and inference by any evidence which shows that no such notice of the error had been given him as to charge him with the duty of correcting it. Upon the question of unreasonable delay he may prove any circumstances in his own condition which rendered it impracticable for him to make an earlier effort for his protection, or may show that his avoidable delay has not misled the public or made his late assertion of his rights a cause of injury to others. An abandonment during the pendency of the application can occur by an amendment or disclaimer which excludes the invention from the application as one already in possession of the public. Such an exclusion is a solemn admission on the part of the inventor that the excluded matter is not patentable, and even when made at the demand of the examiner, and as a condition of the allowance of the patent, it cannot be recalled, unless in certain cases of gross mistake and where the recall would prejudice no other interests.<sup>16</sup> While the amendment or disclaimer remains in force it is sufficient proof of the abandonment. It may be shown by certified copies of the papers in the Patent Office, and cannot be rebutted. An abandonment after the patent is granted may be effected by overt acts or express declarations, or even by neglect to act when action is evidently required. Every presumption is against such an abandonment, however, and the proof must, therefore, be of the strongest and most conclusive character. Mere non-user of the invention, whatever be its duration, is of no significance on this point, but long continued acquiescence in its use by others, or an entire neglect to claim its advantages for himself when it had proved to be of great commercial value and had been widely accepted by the community, may satisfy the jury, as well as positive conduct or assertions, of his intention to relinquish all exclusive privileges and finally confer the invention on the public.<sup>17</sup> Evidence of such acts, or declarations, or

<sup>16</sup> As to the effect of disclaimer in the Patent Office, see §§ 688, 689, and notes, *ante*.

As to the effect of an amendment excluding patentable matter from the application, see § 689 and notes, *ante*.

<sup>17</sup> That abandonment after patent may be shown by acts of surrender or relinquishment to the public, see *Bell v. Daniels* (1858), 1 Fisher, 372; 1 Bond, 212.

That proof of the abandonment of

omissions may be drawn from any source of testimony which is able to supply it, and counter-evidence of the same character may be offered by the plaintiff in reply.

**§ 1031. Evidence under the Eighth Defence: Non-existence of the Letters-Patent.**

The eighth defence denies the existence of the patent described in the declaration. The plaintiff's evidence on this point, as well as that of the defendant, is the patent itself. If it corresponds substantially with the averments in the declaration, the issue must be found for the plaintiff. If a substantial variance appears, the defendant is entitled to a judgment. It is sufficient that the patent and its description agree in such formal parts as are essential to distinguish it from every other patent, such as its date, title, number, and grantee, and in the general tenor of its statements concerning the nature of the patented invention. Thus the averment of a patent for several distinct inventions is supported by the production of a re-issue in an equal number of divisions, the whole relating back to one original, and constituting substantially but a single patent.<sup>1</sup>

**§ 1032. Evidence under the Ninth Defence: Illegality of the Letters-Patent.**

The ninth defence asserts that the grant of the patent was unlawful, either because certain essential prerequisites were not fulfilled, or because the grant, as made, exceeded the jurisdiction of the Patent Office. When it appears from the patent itself that the formal requirements of the law have not been heeded, no other evidence is necessary.<sup>1</sup> Where the

some less important part of an invention does not show that the entire invention was abandoned, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.* (1883), 18 Fed. Rep. 638; 25 O. G. 1076; 21 Blatch. 519.

§ 1031. <sup>1</sup> That a declaration that a patent was granted for one principal and three minor improvements is supported by evidence of a re-issue in four divisions, one for each, these re-issues

relating back to the original, see *Read v. Bowman* (1864), 2 Wall. 591.

See also § 966 and notes, *ante*.

§ 1032. <sup>1</sup> See as to this defence in general § 967 and notes, *ante*.

The omission of formal requirements can appear from the patent only when the patent affirmatively declares that they have been omitted. Mere absence of statement shows nothing. See note 3, *post*.



patent asserts that they have been complied with, no contrary testimony can be offered, unless the defendant claims that a fraud has been committed against the Patent Office and the public.<sup>2</sup> When the patent is silent upon this point, its issue creates a presumption that all prerequisites have been observed, and throws the burden of proving the contrary upon the defendant. The chief defects, of which the law allows notice to be taken in an action for infringement, are the absence from the patent of the necessary official signatures, and falsehood in the oath accompanying the application. The absence of the necessary signatures is apparent on the face of the patent, and is a fatal defect of which no further evidence is required.<sup>3</sup> The entire omission of the oath, or its improper form, is a fault which the Patent Office can condone, as it can overlook nearly all other formal defects, but

<sup>2</sup> That the averments of the patent concerning the fulfilment of prerequisites are conclusive in the absence of fraud, see *Hancock Inspirator Co. v. Jenks* (1884), 21 Fed. Rep. 911.

That the decision of the Commissioner on matters within his exclusive jurisdiction, such as the sufficiency of formal acts, etc., is final, see *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 11 O. G. 373 ; 14 Blatch. 94 ; 2 Bann. & A. 493.

That the decision of the Commissioner that the application is properly made cannot be collaterally attacked, see *Hoe v. Cottrell* (1880), 18 O. G. 59 ; 17 Blatch. 546 ; 5 Bann. & A. 256 ; 1 Fed. Rep. 597.

That the decision of the Commissioner as to the abandonment of the application is not conclusive, see *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479 ; 17 O. G. 1031.

That the decision of the Commissioner allowing an extension is conclusive evidence as to all the facts he is required to find, see *Jordan v. Dobson* (1870), 4 Fisher, 282 ; 2 Abbott, 398 ; 7 Phila. 533.

That the issue of a patent is a judgment that all the facts entitling the patentee to the patent do exist, and constitutes *prima facie* evidence thereof, see *Wooster v. Muser* (1884), 28 O. G. 286 ; 20 Fed. Rep. 162 ; *Konold v. Klein* (1878), 3 Bann. & A. 226.

That patents, being issued upon an adjudication of a public officer, are presumed correct, see *Sands v. Wardwell* (1869), 3 Clifford, 277.

That a patent cannot be objected to on account of matters not appearing on its face concerning the power of the Commissioner or Assistant Commissioner to issue it, see *Woodworth v. Hall* (1846), 1 W. & M. 389 ; 2 Robb, 517.

<sup>3</sup> That the signatures of the Secretary and Commissioner are essential to a patent and if omitted cannot be supplied by their successors, nor is the defect aided by a copy of the record in which the signatures appear, see *Marsh v. Nichols* (1888), 128 U. S. 605 ; *Marsh v. Nichols* (1883), 24 O. G. 901 ; 15 Fed. Rep. 914.

a wilful false oath is a fraud which forfeits all the rights of the inventor.<sup>4</sup> It is immaterial whether the falsehood relates to some matter which affects the allowance of the patent, or to one which simply enlarges the privileges thereby conferred; in either case the attempt to deceive may be shown by proper evidence, and when established will defeat the patent.<sup>5</sup> The oath made by the applicant is proved by a certified copy of the jurat from the records of the Patent Office; its falsehood by evidence disclosing the true state of the facts concerning which it speaks; the intention to deceive, by testimony from which the applicant's knowledge of the truth may be inferred.<sup>6</sup> The plaintiff may contradict this evidence by any relevant testimony concerning the existence of the facts deposed, or the knowledge and intent of the deponent. The

<sup>4</sup> That a patent cannot be attacked on the ground that the application oath was omitted, see *Crompton v. Belknap Mills* (1869), 3 Fisher, 536; and § 458 and notes, *ante*.

That a patent can be attacked on the ground that the application oath was wilfully false, see § 456 and notes, *ante*. But see *Tonduer v. Chambers* (1889), 37 Fed. Rep. 333.

That the issue of a patent on an application amended by the inventor's representative without a new oath is invalid, and a defence on this ground need not be set up in the pleadings, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1884), 111 U. S. 490; 27 O. G. 1237.

That in the absence of fraud the patent recitals are conclusive evidence that proper oaths were taken, see *Seymour v. Osborne* (1870), 11 Wall. 516.

That a patent issued on an amended application, which recites that the patentee has made oath to his application, is conclusive in the absence of fraud, on an infringement suit, that the necessary oath was taken, see *Hancock Inspirator Co. v. Jenks* (1884), 21 Fed. Rep. 911.

<sup>5</sup> That the nature of the falsehood

sworn to is unimportant if the false oath were material and wilful, see *Child v. Adams* (1854), 8 Wall. Jr. 20; 1 Fisher, 189.

<sup>6</sup> That the defendant may show prior use abroad as having been known to the plaintiff in rebutting his oath that he believed himself to be the first inventor, see *Furbush v. Cook* (1857), 2 Fisher, 668.

That proof that a patentee made an improper oath in form on his application must also show that he made no other oath or it is immaterial, see *Hoe v. Kahler* (1885), 23 Blatch. 354; 34 O. G. 127; 25 Fed. Rep. 271; *Hoe v. Kahler* (1882), 20 Blatch. 430; 12 Fed. Rep. 111.

That the discovery among the papers of an unfilled blank form of oath does not overcome the *prima facie* proof arising from the recital that the oath was taken, see *Crompton v. Belknap Mills* (1869), 3 Fisher, 536.

That while the presence of papers in a file-wrapper from the Patent Office proves their existence, their absence does not show that they did not exist, see *Hoe v. Kahler* (1885), 23 Blatch. 354; 34 O. G. 127; 25 Fed. Rep. 271.



principal cases, in which the grant exceeds the jurisdiction of the Patent Office, are the issue of letters-patent to sole patentees for joint inventions, or the contrary, and the allowance of re-issues which include new inventions or inventions intentionally excluded from the original patent. A joint patent for a sole invention, and a sole patent for a joint invention, are alike void.<sup>7</sup> *Prima facie*, the patent as it stands is correct and valid, and the defendant can overcome it only by the clearest and most reliable testimony.<sup>8</sup> The existence of a prior foreign patent in favor of the same inventor or inventors, but directly opposed to the domestic patent in its statements concerning the joint or several origin of the invention, does not change the burden of proof, — the American patent not only outweighing the foreign patent, but in the absence of conclusive extraneous evidence determining the issue for the plaintiff.<sup>9</sup> As the patent

<sup>7</sup> That a joint patent for a sole invention is void, see *Stewart v. Tenk* (1887), 41 O. G. 1502; and § 402, note 3, *ante*.

That a sole patent for a joint invention is void, see *Slemmer's Appeal* (1868), 58 Pa. St. 155; and § 402, note 2, *ante*.

That this latter position is modified in cases where the sole patentee can in equity be treated as trustee for his co-inventor, see § 402 and notes, *ante*.

<sup>8</sup> That a sole patent is *prima facie* evidence that the patentee was a sole inventor, see *Puetz v. Bransford* (1887), 31 Fed. Rep. 458; 39 O. G. 1083.

That a joint application for a patent raises a presumption that the applicants are joint inventors, which can only be overcome by proof, see *Consolidated Bunting Apparatus Co. v. Woerle* (1887), 29 Fed. Rep. 449; 38 O. G. 1015.

That the defence that joint patentees were not joint inventors is not favored unless the conduct of the patentees was disingenuous or misled the defendant, see *Consolidated Bunting Apparatus Co. v. Woerle* (1887), 29 Fed. Rep.

449; 38 O. G. 1015; *Butler v. Bainbridge* (1886), 29 Fed. Rep. 142; 37 O. G. 1124.

That the burden of proof rests on the defendant to show that a sole patentee was a joint inventor, see *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; *Ashcroft v. Cutler* (1869), 6 Blatch. 511.

That the burden of proof rests on the defendant to show by clear and unequivocal evidence that an invention applied for, sworn to, and patented as a joint invention, was a several one, see *Worden v. Fisher* (1882), 11 Fed. Rep. 505; 21 O. G. 1957; *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; *Gottfried v. Phillip Best Brewing Co.* (1879), 17 O. G. 675; 5 Bann. & A. 4.

<sup>9</sup> That the burden of proof rests on the defendant to show that the patentee is not the sole inventor, though there is a prior joint foreign patent to him and others, see *Hoe v. Cottrell* (1880), 1 Fed. Rep. 597; 18 O. G. 59; 17 Blatch. 546; 5 Bann. & A. 256.

That where there is a joint foreign

shows to whom it has been granted, the defendant sustains his position if he proves that the inventive act was joint or sole, contrary to the assertions of the patent. An inventive act is joint when the conception of the idea of means has been evolved by the mutual consultations, suggestions, and experiments of the inventors. It is sole when the conception has arisen and been developed by the operation of one mind, though aided by the advice or achievements of others.<sup>10</sup> That the inventive act was sole may be established by evidence which proves that it existed, complete and ready for reduction to practice, in the mind of the sole inventor before his connection with the alleged joint inventor. Such evidence may consist in his contemporaneous descriptions, drawings, or models of the invention or in his own testimony detailing the steps by which the invention was produced. Evidence that the inventive act was joint may be found in the absence of any memorandum or communication of the complete idea before the inventors met in consultation, as well as in the efforts which they jointly made and in the joint successes they attained. The defendant introduces such of this testimony as supports his claims. The plaintiff, in rebuttal, offers the contrary evidence. In most cases, where any unity of endeavor has existed, it is difficult, if not impossible, to ascertain how much of the result is due to either party, and the law, therefore, is inclined to recognize the merits of both and regard them as joint inventors. But where this question has been once decided by the issue of a patent, the presumption in its favor overcomes all doubts, and can be counteracted only by the most conclusive proof. The jurisdiction of the Patent Office over the subject of re-issues was conferred solely for the purpose of enabling an inventor to correct a defective patent, and thereby cause it to protect, with greater certainty, the invention which he had attempted to secure by the original. It was

patent to A and B and a sole American patent to B, and A swears that the invention was joint and B swears it was sole and there is no other evidence, the American patent will prevail, see *Hoe v. Cottrell* (1880), 18 O. G. 59; 17

Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256.

<sup>10</sup> For the characteristics of a joint inventive act, the legal presumptions regarding it, and the facts by which its joint nature is indicated, see §§ 396-402 and notes, *ante*.



never intended as a method of extending an existing patent to cover new inventions, or old inventions which had been intentionally omitted from the original patent. Hence, while the invention claimed in the re-issue must be found in the original description, the Claims of the re-issue must also be confined to inventions which were not advertently excluded from the original Claims.<sup>11</sup> Such an exclusion occurs where an invention fully disclosed in the original description is not embraced within the original Claims, and no amendment of these Claims is attempted within a reasonable time.<sup>12</sup> The departure of the re-issue from the original is shown by comparing the two patents.<sup>13</sup> The defendant must introduce the original patent and from it satisfactorily establish either that the re-issue includes new inventions or inventions which though embraced in the original description are not contained in the original Claims.<sup>14</sup> In this comparison he may avail himself of expert evidence to point out the differences between the inventions claimed in the respective patents, and may offer copies of the files, and models from the Patent Office to

<sup>11</sup> As to the purpose and scope of re-issues, see §§ 633-635, 653-659, and notes, *ante*.

<sup>12</sup> As to abandonment by describing and not claiming or amending within reasonable time, see §§ 352, 506, 690, 691, 1030, and notes, *ante*.

That a re-issue may be defended against as departing from the original, see *Parker & Whipple Co. v. Yale Lock Co.* (1887), 123 U. S. 87; 41 O. G. 811; *Newton v. Furst & Bradley Mfg. Co.* (1882), 14 Fed. Rep. 465; 11 Bissell, 405.

That a delay in a re-issue is fatal unless the plaintiff proves original inadvertence, see *Newton v. Furst & Bradley Mfg. Co.* (1882), 14 Fed. Rep. 465; 11 Bissell, 405.

<sup>13</sup> That the want of identity between an original and a re-issue must be shown by comparing them, see *Doherty v. Haynes* (1874), 6 O. G. 118; 4 Clifford, 291; 1 Bann. & A. 289.

<sup>14</sup> That when the validity of a re-issue is in dispute the original patent must be put in evidence by the defendant, or the validity of the re-issue will be presumed, see *Knapp v. Shaw* (1883), 15 Fed. Rep. 115; 23 O. G. 2236; *National Pump Cylinder Co. v. Simons Hardware Co.* (1883), 5 McClary, 592; 18 Fed. Rep. 324; *Searls v. Bouton* (1881), 21 O. G. 1784; 12 Fed. Rep. 140; 20 Blatch. 426; *Doherty v. Haynes* (1874); 4 Clifford, 291; 6 O. G. 118; 1 Bann. & A. 289; *Seymour v. Osborne* (1870), 11 Wall. 516.

That on a defence that the re-issue is not the same as the original, the plaintiff is not obliged to introduce the original in evidence, and the defence does not avail in the Supreme Court unless the original is apparent on the record, see *Bates v. Coe* (1878), 98 U. S. 31; 15 O. G. 337.

demonstrate more fully the nature of the invention which the original and re-issue were intended to protect.<sup>15</sup> If he succeeds in showing that the re-issue covers new matter the fault must be cured by disclaimer or the suit will fail.<sup>16</sup> If he proves that matter, disclosed but not protected by the original, has now been claimed in the re-issue, the question of intentional exclusion arises, and further evidence must be produced to show that after the insufficiency of his Claims became known to the inventor he omitted to apply for their amendment within reasonable time. This question is similar to that raised under the seventh defence, on abandonment by the application; and the testimony of the defendant in support of the intention to exclude and of the plaintiff in denial are substantially the same.<sup>17</sup> If it appears that the inventions which the Claims of the re-issue were extended to embrace had been designedly omitted from the original patent, a disclaimer alone can save the re-issued patent and the suit. The decision of the Commissioner allowing the re-issue is of great weight with the court on all these controverted points, since all are presumed to have been fully considered and adjudged by him.<sup>18</sup>

<sup>15</sup> That if the re-issued patent is in evidence, with a different drawing from the original, and a model is then introduced conforming to the changed drawing, the defendant may show the condition of the model when it was filed in the Patent Office, and at the date of the original patent, and the case will be re-opened to receive such proof if newly discovered, see *Johnsen v. Beard* (1875), 8 O. G. 435; 2 Bann. & A. 50.

That evidence of what passed in the Patent Office pending the application for the original is admissible on the question of identity in the re-issue, see *McCormick v. Graham* (1889), 129 U. S. 1; *Ewart Mfg. Co. v. Bridgeport Malleable Iron Co.* (1887), 31 Fed. Rep. 149.

<sup>16</sup> That a claim of new matter in the re-issue may be cured by disclaimer, see *Torrent v. Duluth Lumber Co.* (1887), 30 Fed. Rep. 830; 39 O. G.

1425; *Schillinger v. Cranford* (1885), 4 Mackey, 450; 37 O. G. 1349; *Schillinger v. Gunther* (1879), 16 O. G. 905; 17 Blatch. 66; 4 Bann. & A. 479.

That if the suit can be sustained only by extending the scope of the re-issue beyond the original invention, the defendant will prevail, see *Covell v. Pratt* (1880), 18 O. G. 301; 18 Blatch. 126; 2 Fed. Rep. 359; 5 Bann. & A. 380.

<sup>17</sup> See § 1030 and notes, *ante*.

<sup>18</sup> That a re-issued patent is *prima facie* evidence that the re-issue is legal, see *Spaeth v. Barney* (1885), 30 O. G. 997; 22 Fed. Rep. 828.

That the decision of the Commissioner on the identity of the re-issue with the original is of great weight with the court, see *Hussey v. Bradley* (1863), 2 Fisher, 362; 5 Blatch. 134.

That technical objections to patents are to be strictly construed, see *Wood-*