

who have any legal or equitable interest with the defendant in the litigation, and who are informed of the granting of the injunction; even though they were not defendants in the suit, nor served with an injunction writ¹ And when an injunction is dissolved which ought not to have been granted, the enjoined party is without redress for the injury or inconvenience he may have suffered, unless the court when granting the injunction, made an order that the complainant should pay the defendant such resulting damages as he might sustain in case it be finally decided that the injunction ought not to have been granted; or required the complainant to file a bond to secure those damages, as a condition precedent to the issuing of the injunction.²

§ 696a. An appeal is demandable to the Circuit Court of Appeals, from any order of a Circuit Court which grants, continues, refuses, dissolves or refuses to dissolve a preliminary injunction forbidding the infringement of a patent, *pendente lite*, at any time within thirty days from the entry of such order; and such appeals take precedence in the appellate court; but they do not stay the other proceedings in the case in the court below, during the pendency of the appeal, unless that court so orders.³ Nor does such an appeal give the appellant a right to a supersedeas of the injunction pending the appeal; and the suspension of the injunction during that time, may be granted or refused at his discretion, by the judge who granted the injunction.⁴ The decision of an appeal from an order granting a preliminary injunction, primarily depends upon the question of the providence of the injunction; and that question may or may not depend, according to circumstances, upon the ultimate

¹ *Stahl v. Ertel*, 62 Fed. Rep. 922, 1893.

² *Lexington & Ohio Railroad Co. v. Applegate*, 8 Dana (Ken.) 289, 1839; *Sturgis v. Knapp*, 33 Vermont, 486, 1860; *McKay v. Jack-*

man, 16 Reporter, 164, 1883.

³ 28 Statutes at Large, Ch. 96, p. 666.

⁴ *In re Haberman Mfg. Co.* 147 U. S. 529, 1893.

merits of the case.¹ In deciding the question of the providence of the injunction, the adjudication or acquiescence upon which the injunction was based in the Circuit Court, will generally have the same strength in the Circuit Court of Appeals, that it ought to have had in the court below;² but where it was plainly wrong or insufficient, it will not be followed.³ And an appeal from a preliminary injunction will be dismissed without adjudication, in the Circuit Court of Appeals, when the patent has expired since the injunction was granted, because the injunction will have terminated at the same time.⁴

§ 697. A permanent injunction follows a decision in favor of the complainant, on the interlocutory hearing of a patent case, unless some special reason exists for its being refused, or being postponed till after the master's report, or being suspended pending an appeal.⁵

§ 698. A refusal of a permanent injunction will generally follow from the fact that the patent has expired at the time of the interlocutory decree.⁶ If there is an exception to this rule, it is only where the defendant may be enjoined from using or selling, after the expiration of the patent, those specimens of the patented thing which he unlawfully made before that expiration.⁷ But Justice MILLER wisely decided that there is no such exception; because such an exception would practically prolong many patents beyond

¹ *Blount v. Societe*, 53 Fed. Rep. 98, 1892; *Consolidated Electric Storage Co. v. Accumulator Co.* 55 Fed. Rep. 485, 1893.

² *American Paper Pail Co. v. National Folding Box Co.* 51 Fed. Rep. 232, 1892.

³ *Curtis v. Overman Wheel Co.* 58 Fed. Rep. 784, 1893.

⁴ *Gamewell Fire Alarm Telegraph Co. v. Municipal Signal Co.* 61 Fed. Rep. 208, 1894.

⁵ *Potter v. Mack*, 3 Fisher, 430, 1868; *Rumford Chemical Works v. Hecker*, 2 Bann. & Ard. 388, 1876.

⁶ *Jordan v. Dobson*, 2 Abbott's U. S. Reports, 415, 1870; *Bignal v. Harvey*, 18 Blatch. 356, 1880.

⁷ *Parker v. Sears*, 1 Fisher, 102, 1850; *American Diamond Rock Boring Co. v. Sheldon*, 1 Fed. Rep. 870, 1880; *American Diamond Rock Boring Co. v. Marble Co.* 2 Fed. Rep. 353, 355, 356, 1880; *Reay v. Raynor*, 19 Fed. Rep. 308, 1884; *Toledo Reaper Co. v. Harvester Co.* 24 Fed. Rep. 739, 1885; *New York Packing Co. v. Magowan*, 27 Fed. Rep. 111, 1886.

the statutory term thereof; and because damages are a sufficient remedy for such unlawful making.¹ And no injunction will issue to prevent preparation, during the life of a patent, for making, selling, or using the patented matter after the patent expires.²

§ 699. A refusal of a permanent injunction will also occur where the complainant is shown to have assigned, prior to the interlocutory decree, all his interest in the future duration of the patent right infringed by the defendant.³ But no such refusal will be based on the fact that the complainant is not employing his invention in competition with the defendant,⁴ or upon the fact that the defendant can accomplish his result by non-infringing means.⁵

§ 700. So, also, a refusal of an injunction will be necessary, where the infringing defendant is dead at the time of the interlocutory decree, even though the suit may have been revived against his legal representative.⁶ In such a case no injunction will lie against the dead defendant, because he is no longer within the jurisdiction of the court; and none will lie against the legal representative, because he never infringed the patent. For reasons of similar legal import, an injunction will be refused where the defendant is a corporation and undergoes legal dissolution before the interlocutory decree. This point of law is based on the doctrine that a court will not direct a writ against a dead corporation;⁷ and also upon the rule that it will not enjoin an act which, from the nature of the case, cannot be committed.⁸

¹ *Westinghouse v. Carpenter*, 43 Fed. Rep. 894, 1888.

² *White v. Walbridge*, 46 Fed. Rep. 526, 1891.

³ *Wheeler v. McCormick*, 11 Blatch. 345, 1873; *Boomer v. Powder Press Co.* 13 Blatch. 107, 1875.

⁴ *American Bell Telephone Co. v. Cushman Telephone Co.* 36 Fed. Rep. 488, 1888; *Wirt v. Hicks*, 46

Fed. Rep. 71, 1891.

⁵ *Du Bois v. Kirk*, 158 U. S. 66 1895.

⁶ *Draper v. Hudson*, 1 Holmes, 208, 1873.

⁷ *Mumma v. Potomac Co.* 8 Peters, 286, 1834.

⁸ *Potter v. Crowell*, 3 Fisher, 115, 1866.

§ 701. But the fact that the defendant has ceased to infringe the patent, and says that he will not infringe it in the future, is no reason for refusing an injunction against him.¹ Whatever tort a man has once committed, he is likely to commit again, unless restrained from so doing.

§ 702. A permanent injunction will be postponed till a final decree, when such a postponement is necessary to save the defendant from special hardship, and is not injurious to the just rights of the complainant;² or where an immediate discontinuance of the defendant's use of the patented article is contrary to public policy.³ But where such a postponement would be injurious to the just rights of the complainant, it will not be granted to avert from the defendant the consequences of his infringement, even where those consequences may be hard to bear.⁴ And where such a postponement is allowed, the defendant should be required to give a bond for the security of the complainant.⁵

§ 703. A permanent injunction may be suspended, pending an appeal from the interlocutory decree which granted it, at the discretion of the judge who decided the case, upon such terms as to bond or otherwise as he may consider proper for the security of the rights of the opposite party.⁶ Such a bond should be conditioned upon the result of the

¹ *Jenkins v. Greenwald*, 2 Fisher, 42, 1857; *Potter v. Crowell*, 3 Fisher, 115, 1866; *Rumford Chemical Works v. Vice*, 14 Blatch. 180, 1877; *Bullock Printing Press Co. v. Jones*, 3 Bann. & Ard. 195, 1878; *Facer v. Midvale Steel-Work Co.* 38 Fed. Rep. 231, 1888; *Norton v. Automatic Can Co.* 45 Fed. Rep. 638, 1891; *California Electrical Works v. Henzel*, 48 Fed. Rep. 377, 1891; *Henzel v. California Electrical Works*, 51 Fed. Rep. 754, 1892; *Winchester Arms Co. v. American Buckle Co.* 54 Fed. Rep. 711, 1893.

² *Barnard v. Gibson*, 7 Howard, 657, 1849; *Yale & Greenleaf Mfg.*

Co. v. North, 5 Blatch. 462, 1867; *Potter v. Mack*, 3 Fisher, 428, 1868; *Dorsey Harvester Rake Co. v. Marsh*, 6 Fisher, 401, 1873; *West Publishing Co. v. Co-operative Publishing Co.* 53 Fed. Rep. 269, 1893.

³ *Ballard v. Pittsburg*, 12 Fed. Rep. 783, 1882.

⁴ *Brown v. Deere*, 6 Fed. Rep. 487, 1880.

⁵ *American Middlings Purifier Co. v. Christian*, 3 Bann. & Ard. 53, 1877.

⁶ *In re Haberman Mfg. Co.* 147 U. S. 525, 1893; Section 644a of this book.

appeal, and should secure the profits and damages to accrue after the interlocutory decree, and before the decision of the Circuit Court of Appeals thereon, and also those which may possibly accrue after that decision, and before its reviewal in the Supreme Court, in the event that the case should go to that tribunal.

And a permanent injunction may be suspended, for an extraordinary cause, pending an appeal from a final decree to the Circuit Court of Appeals, at the discretion of the judge who decided the case and allowed the appeal, upon such terms as will secure the rights of the complainant.¹ Those rights include the right to recover the profits and damages which may accrue after the final decree, and before the end of the suspension of the injunction; and therefore the security of those rights will require a bond to cover those profits and damages, in addition to the supersedeas bond which must be filed to cover the profits and damages which accrued prior to the final decree.

Where no money recovery could indemnify the complainant for the defendant's unrestrained doings pending an appeal, it will be reasonable not to suspend the permanent injunction, because the presumption and the probability are that the decree of the circuit court is right, and because of two evils it is better to incur the risk of that which is least to be expected.

§ 704. A permanent injunction may be dissolved at any time within six months after the expiration of the term of court at which the final decree in the case was entered; and such a dissolution will be had where the defendant, by means of a supplemental bill in the nature of a bill of review, or by a bill of review, secures a cancellation of that decree.² And such a dissolution must, of course, occur whenever the decree which granted the injunction, is reversed by a higher court.

¹ *Munson v. New York*, 19 Fed. Rep. 313, 1884; Equity Rule 93.

² Sections 647 to 653 of this book.

§ 705. Injunctions to restrain infringements of patents may be granted independent of all other relief;¹ and an injunction may also be granted to restrain a complainant from bringing actions against persons who are using or are selling those articles, for the making of which the action at bar was brought against the defendant;² or to restrain the complainant from bringing an action at law against the defendant, for the same infringements as any of those covered by the action in equity.³ But no injunction will be issued on account of an infringement which is so trivial as to be below the dignity of the court;⁴ nor to restrain a junior patentee from bringing actions on his patent, while that patent is still free from an adjudication of invalidity.⁵

§ 706. The duration of injunctions in patent cases depends upon a variety of circumstances. Unless such a writ is expressly made to apply to the use or sale, after the expiration of the patent, of specimens of the patented thing which were made before that time, such injunction cannot continue after that expiration; and surely no such writ will be made to apply to such use or sale of unpatented parts of an infringing combination.⁶ Indeed, no injunction ought in any case to continue after the expiration of the patent.⁷ Permanent injunctions are sometimes called perpetual injunctions; but in patent cases that would be a misnomer, for no injunction can stand longer than the right upon which it is based, and patent rights are never perpetual.

§ 707. And the duration of an injunction sometimes depends upon whether it was issued by a circuit court in

¹ *American Cotton Tie Supply Co. v. McCready*, 17 Blatch. 291, 1879.

² *Birdsall v. Mfg. Co.* 1 Hughes, 64, 1877; *Allis v. Stowell*, 16 Fed. Rep. 788, 1883; *Ide v. Engine Co.* 31 Fed. Rep. 901, 1887; *National Cash Register Co. v. Boston Cash Recorder Co.* 41 Fed. Rep. 51, 1889.

³ *Morss v. Knapp*, 35 Fed. Rep. 218, 1888.

⁴ *Lowell Mfg. Co. v. Hartford Crapet Co.* 2 Fisher, 472, 1864; *Wickwire v. Wire Fabric Co.* 41 Fed. Rep. 36, 1889.

⁵ *Asbestos Felting Co. v. Salamander Felting Co.* 13 Blatch. 453, 1876.

⁶ *Johnson v. Brooklyn Co.* 37 Fed. Rep. 147, 1888.

⁷ *Westinghouse v. Carpenter*, 43 Fed. Rep. 894, 1888.

term time, or by one of the judges in vacation. The statutes draw a plain distinction between a circuit court and a judge thereof. When a circuit court is in session during one of its terms, its jurisdiction is the same whether it is held by the circuit justice allotted to the circuit, or by a circuit judge of the circuit, or by the district judge of the district, or by any two or more of them sitting together, or by a circuit judge of some other circuit, or by the district judge of some other district, holding the court in a special emergency.¹ As to the duration of injunctions issued by circuit courts so held, the rules stated in the last section uniformly apply. But it often happens that injunctions become necessary during the time which elapses after the adjournment of one term of the circuit court in a particular district, and before the beginning of the next term of the same court. In such a case, an injunction may be granted by the circuit justice allotted to that circuit, or by a circuit judge of that circuit, or by the district judge of that district, under the following circumstances respectively, and with the respective durations about to be mentioned. The circuit justice or a circuit judge may sit at any time at any place within his circuit to grant an injunction in any proper case pending in the circuit court of any district in that circuit; and the circuit justice may so sit, at any other place in the United States, whenever the motion cannot be heard by a circuit judge of the circuit, or by the district judge of the district, whether the inability of the local judges arose from absence from their respective jurisdictions, or from any other cause;² and an injunction, when so granted, will have the same duration as if granted by the circuit court for the district.³ The district judge of any district may sit at any time, at any place within his district, to grant an injunction

¹ Revised Statutes, Sections 609, 617, 618, 591, 592, 593, 594, 595, 596, and 611; *Goodyear Dental Vulcanite Co. v. Folsom*, 5 Bann. & Ard. 591, 1880.

² Revised Statutes, Section 719; *Searls v. Railroad Co.* 2 Woods, 622, 1873.

³ *Gray v. Railroad Co.* 1 Woolworth, 68, 1864.

in any proper case pending in the circuit court of that district, provided the mover did not have a reasonable time to apply to the circuit court for the writ; but such an injunction will not continue in force after the beginning of the next term of the circuit court unless the court, when it sits, makes an order to that effect.¹ If the next term of the circuit court is held by some other judge than the district judge who granted the injunction, the approval of the injunction, by the judge so holding court, will therefore be necessary to its continued vitality; but if the next term happens to be held by the district judge who issued the writ, his order continuing it in force will be equally efficacious. In either event, orders to continue injunctions issued by district judges in vacation, have become so much a matter of form, that they are seldom actually asked for or entered. But the formality ought to be revived and followed, because in its absence, no attachment can lie against one who disregards such an injunction after the beginning of the ensuing term of the circuit court.²

§ 708. An attachment will issue to bring an enjoined defendant before the court for punishment,³ whenever the complainant institutes proper proceedings therefor, and proves that the defendant was promptly⁴ served with a writ of injunction, and that the writ contained a concise description of the particular thing, all specimens of which it forbade the defendant to make, use, or sell,⁵ and that the defendant did make, or use, or sell, or did cause to be made, used, or sold a specimen of that thing, or of a thing clearly the same, after having been served with that writ.⁶ And an attach-

¹ Revised Statutes, Section 719.

² *Parker v. The Judges*, 12 Wheaton, 564, 1827; *Gray v. Railroad Co.* 1 Woolworth, 63, 1864.

³ *Bate Refrigerating Co. v. Gillett*, 30 Fed. Rep. 684, 1887.

⁴ *McCormick v. Jerome*, 3 Blatch. 486, 1856.

⁵ *Whipple v. Hutchinson*, 4 Blatch. 191, 1875; *Bate Refrigerat-*

ing Co. v. Gillett, 24 Fed. Rep. 696, 1885.

⁶ *Birdsall v. Mfg. Co.* 2 Bann. & Ard. 519, 1877; *Allis v. Stowell*, 19 Off. Gaz. 727, 1881; *Atlantic Giant Powder Co. v. Dittmar Powder Mfg. Co.* 9 Fed. Rep. 316, 1881; *Mundy v. Mfg. Co.* 34 Fed. Rep. 541, 1888.

ment will likewise issue for a similar infringement, against any person who had an interest in the litigation with the defendant, and who was informed of the injunction, even though not a nominal defendant, nor served with an injunction writ.¹

But an attachment will not issue against a stranger to the suit, merely because he has succeeded to the business in the conduct of which the defendant incidentally, infringed the complainant's patent, even where that successor has likewise infringed.² Where the defendant is a corporation, and where the officer of that corporation upon whom the writ was served, was privy to its violation, an attachment will issue against him in person ;³ and indeed an injunction duly served on a corporation is binding on all persons acting for that corporation, and who have notice of the writ and of its contents, whether they were actually served or not.⁴

Where the thing proved to have been done by the enjoined defendant, consists in sending to some foreign country, and selling there, articles which were made in the United States, in infringement of the patent, before the injunction was granted, an attachment will not issue ; because such a transaction is not a violation of an injunction against the infringement of a patent.⁵ And an attachment will not issue where the character of the defendant's doings, after the injunction, is doubtful.⁶ Where the thing proved to have been made, used, or sold by the enjoined defendant, differs from the article described in the writ of injunction, a question of infringement may arise, which may require to be brought before the court on a motion for another and a specific writ

¹ *Stahl v. Ertel*, 62 Fed. Rep. 922, 1893.

² *Bate Refrigerating Co. v. Gillett*, 30 Fed. Rep. 684, 1887.

³ *Wetherill v. Zinc Co.* 1 Bann. & Ard. 150, 1874.

⁴ *Phillips v. Detroit*, 3 Bann. & Ard. 150, 1877.

⁵ *Gould v. Sessions*, 67 Fed. Rep. 163, 1895.

⁶ *Accumulator Co. v. Storage Co.* 53 Fed. Rep. 793, 1892.

of injunction, rather than on a motion for an attachment.¹ If that question is a doubtful one, an attachment, if moved for, will not issue ;² because doubtful questions will not be decided on summary proceedings to commit persons for contempt of court. But not every question is doubtful which is difficult, or which is complex, or about which the evidence is conflicting. It is therefore the duty of the court, on a hearing of a motion for an attachment, to examine what the defendant is proved to have done, and to issue an attachment if his doings satisfactorily appear in the eye of the law to constitute infringement of a claim covered by the writ of injunction.³ A motion for an attachment cannot be anticipated and outflanked by a motion to expressly limit the injunction, so as to exclude the doings of the defendant.⁴ And where a motion for an attachment is denied, on the ground of infringement being too doubtful to be decided on such a motion, that denial does not prevent a decision finding infringement, in a new suit between the same parties on the same facts.⁵

A motion for an attachment for contempt of court for violating an injunction is an independent criminal case,

¹ *Gold & Stock Telegraph Co. v. Pearce*, 19 Fed. Rep. 419, 1884; *Truax v. Detweiler*, 46 Fed. Rep. 118, 1891; *Bonsack Machine Co. v. Cigarette Co.* 64 Fed. Rep. 858, 1894.

² *California Paving Co. v. Molitor*, 113 U. S. 617, 1884; *Liddle v. Cory*, 7 Blatch. 1, 1866; *Welling v. Trimming Co.* 2 Bann. & Ard. 1, 1875; *Buerk v. Imhaeuser*, 2 Bann. & Ard. 465, 1876; *Onderdonk v. Fanning*, 5 Bann. & Ard. 431, 1880; *Bate Refrigerating Co. v. Eastman*, 11 Fed. Rep. 902, 1881; *Higby v. Rubber Co.* 18 Fed. Rep. 601, 1883; *Smith v. Halkyard*, 19 Fed. Rep. 602, 1884; *Wirt v. Brown*, 30 Fed. Rep. 187, 1887; *Temple Pump Co. v. Mfg. Co.*

31 Fed. Rep. 292, 1887; *Howard v. Mast*, 33 Fed. Rep. 867, 1888; *Mundy v. Mfg. Co.* 34 Fed. Rep. 541, 1888; *Pennsylvania Drill Co. v. Simpson*, 39 Fed. Rep. 284, 1889; *Enterprise Mfg. Co. v. Sargent*, 48 Fed. Rep. 453, 1891; *Mack v. Levy*, 49 Fed. Rep. 857, 1892.

³ *Wetherill v. Zinc Co.* 1 Bann. & Ard. 105, 1874; *Schillinger v. Gunther*, 2 Bann. & Ard. 545, 1877; *Morss v. Knapp*, 37 Fed. Rep. 353, 1889.

⁴ *Edison Electric Light Co. v. Westinghouse Electric Co.* 54 Fed. Rep. 504, 1893.

⁵ *Mack v. Levy*, 59 Fed. Rep. 468, 1894.

which can be taken to the Circuit Court of Appeals for review on a writ of error, while the action in equity out of which it arose, is still pending and progressing in the Circuit Court.¹

§ 709. It is no defence to a motion for an attachment to show that the decision in pursuance of which the injunction was granted was wrong;² or that new evidence has since been discovered which, if it had been known at the hearing, would have caused a contrary decision;³ or that the defendant was advised by counsel that his doings did not violate the injunction;⁴ or that what the defendant did was done as the employee of another;⁵ or that the writ of injunction was for a while suspended in its operation, by the consent of the complainant without any order of court;⁶ or that the writ of injunction was inadvertently made broader than the decision of the court would warrant.⁷ In such a case as the last of these, the defendant may apply to the court to correct the writ, but he must not disobey it while it remains unchanged. But where an injunction was based on a consent decree, which decree was entered in pursuance of a compromise of the parties, an attachment will not issue for a disregard of that injunction, if that compromise has been set aside by a court of competent jurisdiction, or if such a court has enjoined the complainant from enforcing the contract of compromise.⁸

§ 710. The penalty for a violation of an injunction depends upon the circumstances of the particular case at bar. Where

¹ *Sessions v. Gould*, 63 Fed. Rep. 1002, 1894; *Gould v. Sessions*, 67 Fed. Rep. 163, 1895.

² *Woodworth v. Rogers*, 3 Woodbury & Minot, 135, 1847; *Liddle v. Cory*, 7 Blatch. 1, 1865.

³ *Whipple v. Hutchinson*, 4 Blatch. 190, 1858; *Phillips v. Detroit*, 3 Bann. & Ard. 150, 1877.

⁴ *Hamilton v. Simons*, 5 Bissell, 77, 1869.

⁵ *Sickles v. Borden*, 4 Blatch. 15

1857; *Goodyear v. Mullee*, 5 Blatch. 437, 1867; *Potter v. Muller*, 1 Bond. 601, 1865; *Iowa Barb Steel Wire Co. v. Barbed Wire Co.* 30 Fed. Rep. 123, 1887.

⁶ *Pentlarge v. Beeston*, 1 Fed. Rep. 862, 1880.

⁷ *Sickles v. Borden*, 4 Blatch. 15, 1857.

⁸ *Pentlarge v. Beeston*, 1 Fed. Rep. 862, 1880.

it appears that the defendant had no intention to disobey the writ, the penalty may be confined to an enforced payment of the costs of the motion for an attachment.¹ Where the defendant had no intention to disobey the writ, but imprudently did so, the penalty may include the costs and a small fine.² Where the disobedience is less excusable, the defendant may be compelled to pay all the expenses and counsel fees incurred by the complainant in relation to the motion.³ And where disobedience of an injunction is excuseless and defiant, the penalty may be a reasonable fine and a reasonable imprisonment.

¹ *Carsteadt v. Corset Co.* 13 Blatch. 371, 1876; *Strowbridge v. Lindsay*, 6 Fed. Rep. 510, 1881; *Macbeth v. Gillinder*, 54 Fed. Rep. 172, 1891; *Macbeth v. Braddock Glass Co.* 54 Fed. Rep. 173, 1890; *Braddock Glass Co. v. Macbeth*, 64 Fed. Rep. 120, 1894.

² *Norton v. Automatic Can Co.* 59 Fed. Rep. 137, 1893.

³ *Doubleday v. Sherman*, 4 Fisher. 253, 1870; *Schillinger v. Gunther*, 2 Bann. & Ard. 545, 1877; *Stahl v. Ertel*, 62 Fed. Rep. 922, 1893.

CHAPTER XXII.

PROFITS.

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§ 711. THE profits which are recoverable in equity for the infringement of a patent, are those which the defendant made from that infringement.¹ They are the profits which he actually made; not those which with worse,² or better,³ management he would or might have made.

Where a particular infringer realized no profit from his infringement, none can be recovered from him; but where he did make such a profit, it can be recovered, whether the general business, of which the infringement formed a part, was profitable to him or not,⁴ and whether or not the complainant was employing, at the time, the invention which was covered by the patent infringed.⁵

The recoverable profits are those which resulted directly, and do not include any which resulted indirectly, from the infringement.⁶ The case of *Piper v. Brown* is cited as an example of this distinction. The difference between the amount of money for which the defendants sold their preserved fish, and the aggregate cost of that fish and of preserving it by the patented apparatus, was there held to be direct profit. But it appeared that the defendants were also dealers in fresh fish, and that they sold a large amount of such fish at higher prices than they could have done, had they not reduced the supply in the market by means of

¹ *Rubber Co. v. Goodyear*, 9 Wallace, 801, 1869; *Tilghman v. Proctor*, 125 U. S. 144, 1888.

² *Lawther v. Hamilton*, 64 Fed. Rep. 224, 1892.

³ *Livingston v. Woodworth*, 15 Howard, 546, 1853; *Dean v. Mason*, 20 Howard, 203, 1857; *Keystone Mfg. Co. v. Adams*, 151 U. S. 147, 1894; *Coupe v. Royer*, 155 U. S. 565, 1895.

⁴ *Elizabeth v. Pavement Co.* 97 U. S. 138, 1877; *Tilghman v. Proctor*, 125 U. S. 146, 1888.

⁵ *Crosby Steam Gauge & Valve Co. v. Safety Valve Co.* 141 U. S. 452, 1891.

⁶ *Piper v. Brown*, 1 Holmes, 198, 1873; *Heaton Button Fastener Co. v. Macdonald*, 57 Fed. Rep. 649, 1893.

preserving fish by the patented apparatus. The increase in the price of fresh fish, which was thus caused by the defendants' infringement, was one and one-half cents per pound; and the consequent profits made by the defendants, amounted to more than six thousand dollars. But the court held that those profits could not be recovered by the patentee, because they did not directly result from the infringement of his patent.

§ 712. Where several defendants were joint infringers of a patent, but where all the resulting profits were received by part of the wrong-doers, the decree for profits will be rendered only against those defendants who realized them.¹ Where all of the defendants realized profits during a portion of the time covered by the infringement in suit, and where a part of them realized profits during the residue of that time, the respective profits may be recovered accordingly, and a decree be entered against all of the defendants for the profits in which all participated, and against a part of the defendants for the profits which that part alone realized.² And where one part of the profits of joint infringement was realized by one of the joint infringers, and the residue by another; the decree will go against each, for his own share only.³

§ 713. Where a part of the infringement of a defendant resulted in profits, and the residue resulted in losses, the complainant is entitled to recover those profits without any deduction on account of those losses.⁴ Each infringement is treated by itself. If it resulted in profit, that profit belongs to the patentee. If it resulted in loss, that loss must be borne by the infringer. It cannot be set off against

¹ *Elizabeth v. Pavement Co.* 97 U. S. 140, 1877.

² *Tatham v. Lowber*, 4 Blatch. 87, 1857; *Herring v. Gage*, 3 Bann. & Ard. 402, 1878; *New York Grape Sugar Co. v. American Grape Sugar Co.* 42 Fed. Rep. 456; 1890.

³ *Covert v. Sargent*, 38 Fed. Rep.

238, 1889.

⁴ *Callaghan v. Myers*, 128 U. S. 664, 1888; *Crosby Valve Co. v. Safety Valve Co.* 141 U. S. 453, 1891; *Graham v. Mason*, 1 Holmes, 90, 1872; *Steam Stone Cutter Co. v. Mfg. Co.* 17 Blatch. 27, 1879.

the patentee's right of action for the profitable infringement, any more than it could be made the basis of a right of action against the patentee if no infringement had been profitable.

§ 714. An account of profits cannot be had where none arose before the action was begun,¹ but such an account is not confined to those profits, nor indeed to those which accrued before the interlocutory decree was entered, but may be made to include all profits realized by the defendant from infringing the complainant's right, at any time prior to the closing of the account.² And such an account will be taken in conformity with the statutes relevant thereto, as they existed at the respective dates when the infringement occurred.³

§ 715. The generic rule for ascertaining the amount of the profits recoverable in equity for the infringement of a patent, is that of treating the infringer as though he were a trustee for the patentee in respect of the profits which he realized from his infringement.⁴ The specific rules by means of which this generic rule is administered, are somewhat numerous and somewhat elastic. They are adapted to the varying natures of patented inventions, and to the varying circumstances under which the patents for those inventions are respectively infringed.⁵ They all require the best evidence, of which the nature of each particular case to which they may be respectively applied, will reasonably admit,⁶ and that evidence must be reasonably definite⁷ and convincing.⁸

¹ *Marsh v. Nichols*, 128 U. S. 616, 1888.

² *Rubber Co. v. Goodyear*, 9 Wallace, 800, 1869; *Knox v. Quicksilver Mining Co.* 6 Sawyer, 435, 1878; *Creamer v. Bowers*, 35 Fed. Rep. 209, 1888.

³ *Untermeyer v. Freund*, 58 Fed. Rep. 212, 1893.

⁴ *Root v. Railway Co.* 105 U. S. 214, 1881; *Tilghman v. Proctor*, 125

U. S. 148, 1888.

⁵ *Wetherill v. Zinc Co.* 1 Bann. & Ard. 486, 1874.

⁶ *Herring v. Gage*, 3 Bann. & Ard. 399, 1878; *Emigh v. Railroad Co.* 6 Fed. Rep. 283, 1881.

⁷ *Fischer v. Hayes*, 39 Fed. Rep. 613, 1889.

⁸ *Locomotive Safety Truck Co. v. Railroad Co.* 2 Fed. Rep. 681, 1880.

§ 716. The patentee's royalty is no measure of the defendant's profits,¹ even in a case where the patentee habitually exercised his exclusive right by granting licenses to others.² Nor are any other facts which relate to the measure of the complainant's damages, material to inquiries touching the amount of the defendant's profits.³

§ 717. The difference between the amount it cost the defendant to make and sell his specimens of the patented thing, and the amount which he received for those specimens, is in many cases the amount of his profits.⁴ That is the fact where the only infringement consisted of such making and selling, and where no part of ascertainable cost or value, other than those covered by the patent in suit, entered into the composition of the specimens which were made and sold.⁵ In the first case just cited, it appears that the patent did not cover all the elements of the articles of merchandise which were made and sold by the defendant. But those unpatented elements were disregarded in that case, because the conduct of the defendant had rendered impossible a separate account of the profits due to the patented, and those due to the unpatented features of those articles. In the second of the cited cases, it appeared that the pavement which was made by the New Jersey Wood Paving Co. for the city of Elizabeth, contained the entire invention of the complainant, and contained an addition thereto, which addition might or might not have contributed to the profit which resulted to the Paving Co. from its contract. Under those circumstances, the Supreme Court held that the entire profit should go to the patentee, because it

¹ Knox v. Quicksilver Mining Co. 6 Sawyer, 430, 1878.

² Tilghman v. Proctor, 125 U. S. 143, 1888; Wooster v. Taylor, 14 Blatch. 403, 1878.

³ Elizabeth v. Pavement Co. 97 U. S. 143, 1877.

⁴ Simpson v. Davis, 22 Fed. Rep. 444, 1884; Shannon v. Bruner, 33

Fed. Rep. 872, 1888; Am Ende v. Seabury, 43 Fed. Rep. 672, 1890.

⁵ Rubber Co. v. Goodyear, 9 Wallace, 803, 1869; Elizabeth v. Pavement Co. 97 U. S. 141, 1877; Warren v. Keep, 155 U. S. 268, 1894; Jenkins v. Greenwald, 1 Bond, 141, 1857; Sayre v. Scott, 55 Fed. Rep. 675, 1893.

was not ascertainable how much was due to the additional element. The principle of both these precedents on this point appears to be, that where a defendant mingled profits which he made as an infringer, with those he made otherwise, and where there is no criterion by means of which they can be separated, he must submit to the recovery of the whole. In the third case, the infringement consisted in making and selling a particular kind of stove grates, which was admitted to infringe all the claims of the complainant's patent thereon. The Supreme Court affirmed a decree for the difference between the complainant's evidence of the cost of making the grates, and the amount for which the defendant sold them.

§ 718. When taking an account of profits in the method indicated in the last section, it is generally easy to ascertain the amount which the defendant realized for the articles which he made and sold; but it is generally difficult to determine how much it cost him to make and sell them. One such inquiry occupied ex-Chancellor WALWORTH, as master, more than ten years, and occupied the judge who passed upon the exceptions to his report at least as many weeks.¹ When such accounts are taken, the elements which are allowed to enter into that cost are the following:

1. The market value of materials on hand at the time the infringement began, and the actual cost of materials subsequently purchased, but not the market value of the latter at the time they were used in infringing.²

2. Money paid in good faith to employees engaged in making and selling the infringing articles, even where those employees were officers or stockholders of the infringing corporation.³

3. Proper remuneration for the labor of the infringer in conducting the infringement. This element has been disal-

¹ *Troy Iron & Nail Factory v. Corning*, 6 Blatch. 328, 1869.

² *Rubber Co. v. Goodyear*, 9 Wallace, 803, 1869.

³ *Rubber Co. v. Goodyear*, 9 Wal-

lace, 803, 1869; *American Nicholson Pavement Co. v. Elizabeth*, 1 Bann. & Ard. 442, 1874; *Steam Stone Cutter Co. v. Mfg. Co.* 17 Blatch. 29, 1879.

lowed in one case;¹ but the same reasoning which justified the Supreme Court in allowing the members of a defendant corporation for their personal services, calls for the same allowance where the men who infringe, do so as partners or as individuals. Where a number of men form a corporation and, as such, infringe a patent by making and selling specimens of a patented thing, the Supreme Court approves a proper allowance for their labor, being made an element in the cost of those specimens, when those men are forced to pay over those profits to the patentee. There is the same reason for making the same allowance, where two such men make and sell such specimens as partners, or where one man does so alone. But it is the labor of the infringer in making or selling infringing articles, or in performing an infringing process, that is contemplated in this paragraph. Salaries which are received by partners in the place of partnership profits, or which are paid for a general oversight of partnership business, do not come in this category.²

4. Interest on borrowed money;³ but not interest on capital stock, except where the property represented by the capital stock was used only in conducting the infringing business, or where the defendant clearly proves what portion of the value of that property was thus used, so as to enable an apportionment of interest to be made between the infringing business, and the other business contemporaneously conducted by the defendant.⁴

5. Expenses of selling, including advertising.⁵

6. Miscellaneous expenses equitably chargeable to the infringing business.⁶

§ 719. Where the thing made and sold by the defendant contained not only the invention of the complainant, but

¹ *Williams v. Leonard*, 9 Blatch. 476, 1872.

² *Callaghan v. Myers*, 128 U. S. 663, 1888.

³ *Rubber Co. v. Goodyear*, 9 Wall. 804, 1869.

⁴ *Seabury v. Am Ende*, 152 U. S. 564, 1894.

⁵ *Rubber Co. v. Goodyear*, 9 Wallace, 804, 1869; *Manufacturing Co. v. Cowing*, 105 U. S. 257, 1884; *La Baw v. Hawkins*, 2 Bann. & Ard. 566, 1877.

⁶ *Winchester Arms Co. v. American Cartridge Co.* 62 Fed. Rep. 278, 1894.

contained also some other invention or feature of ascertainable cost and provable value, the complainant, except in design cases, can recover only that part of the defendant's profit which was due to the infringing parts or features of the thing made and sold by the defendant, and the burden is on the complainant to prove the amount of that part.¹ In doing that work, a complainant should proceed in view of the following rules; but his evidence needs not to be severely accurate, and may be sufficient where it furnishes foundation for just inferences, rather than certain knowledge.²

§ 720. Where the defendant made and sold the complainant's invention separately, as well as in connection with other inventions, the profit which he made on the separate sales, is the measure of that part which is to be credited to the complainant's invention, of the profit which the defendant made on the joint sales.³ This is a fairer method of division in such a case, than would be a division of the gross profits in proportion of the comparative cost of the elements covered by the patent in suit, and those not so covered; because the comparative cost is not always the best evidence of the comparative utility of two devices, nor of the comparative profit at which they can be made and sold.⁴

§ 721. Where the defendant has paid or contracted to pay other patentees a royalty for that part of the thing made and sold by him, which is not covered by the complainant's patent, that royalty may be taken as the measure of that part of the gross profits due to that part of the article in suit.⁵ But it seems that this rule is not to be applied in any case where the division of the profits can be made

¹ *Blake v. Robertson*, 94 U. S. 733, 1876; *Garretson v. Clark*, 111 U. S. 120, 1884; *Dobson v. Carpet Co.* 114 U. S. 445, 1884; *Dobson v. Dornan*, 118 U. S. 17, 1885; *Keystone Mfg. Co. v. Adams*, 151 U. S. 147, 1894.

² *Adams v. Keystone Mfg. Co.* 41

Fed. Rep. 597, 1890.

³ *Mason v. Graham*, 23 Wallace, 276, 1874.

⁴ *Graham v. Mason*, 1 Holmes, 89, 1872.

⁵ *Elizabeth v. Pavement Co.* 97 U. S. 141, 1877; *La Baw v. Hawkins*, 2 Bann. & Ard. 565, 1877.

under the rule of the last section; because it may sometimes be that the profits due to that part of the infringing thing which is not covered by the complainant's patent, are larger than the royalty which the defendant had to pay for the right to make and sell that part.

§ 722. Where the thing made and sold by the defendant would be useless for its special purpose without the part covered by the complainant's patent, or where no other known article would answer that purpose well enough to find purchasers; all the profits which the infringer derived from making and selling the entire thing are clearly due to the patented part, and are therefore recoverable by the complainant.¹

§ 723. Where the profits due to the infringing, and those due to the non-infringing, elements of a defendant's article of manufacture and sale cannot be separated by any other rule, then the apportionment may be made by dividing the aggregate profits in proportion of the respective cost of the different parts. This method of making the division is based on the presumption that similar articles of merchandise are sold at a like percentage of profit on the cost of producing them. But this is not likely to be the fact where one of those articles is covered by a patent while the others are not so covered, because monopolies tend to enhance prices. This method of making the required division will therefore always be more favorable to the defendant than to the complainant; where no part of the article made and sold by the former is covered by a patent, except the part which is covered by the patent of the latter. The principle of this method was approved in *Rubber Co. v. Goodyear*,² though in that case it was applied to the work of dividing profits between things covered and other things not covered by the complainant's patent, instead of between parts of

¹ *Manufacturing Co. v. Cowing*, 105 U. S. 256, 1881; *Hurlbut v. Schillinger*, 130 U. S. 456, 1889; *Crosby Valve Co. v. Safety Valve*

Co. 141 U. S. 453, 1891.

² *Rubber Co. v. Goodyear*, 9 Wallace, 802, 1869.

the same thing so covered, and other parts not so covered.

§ 723*a*. In cases for infringement of design patents, a special statute provides that the total profits made from the manufacture or sale of the article or articles, to which the design, or a colorable imitation thereof, has been applied, shall be recoverable.¹ But in order to recover under this statute, the complainant must show that the defendant knew of the complainant's design, and knew of the complainant's patent, or at least knew of facts which put him upon his inquiry for that patent,² and knew that the design was applied to the infringing article, without the license of the owner of the patent.³

§ 724. Where the infringement consisted only in selling specimens of the article covered by the complainant's patent, the profits may be readily ascertained by deducting the cost of purchasing and selling the articles, from the amount received for them when sold. Where the subject-matter of the patent is a part of a larger article, and where a separate price is paid, and a separate price is obtained for it, the gross profit on the thing covered by the patent may be ascertained by deducting the former from the latter. But in such a case, the complainant is not entitled to recover the whole of that gross profit. It must be charged with such a proportion of the expenses incurred in selling the entire article, as the aggregate money received from the infringing device bears to the aggregate received for the entire apparatus or machine.⁴ The principle of this rule is also applicable where the infringer made the articles he sold instead of buying them; and the rules applicable to the latter class of cases, and heretofore set forth, are applicable, with some reasonable modifications, to cases where the infringer bought the infringing articles which he sold, instead of making them himself.

¹ 24 Statutes at Large, Chap. 105, p. 387; *Untermeyer v. Freund*, 58 Fed. Rep. 211, 1893; *Ripley v. Elson Glass Co.* 49 Fed. Rep. 927, 1892.

² *Smith v. Stewart*, 55 Fed. Rep.

484, 1893.

³ *Anderson v. Pittsburgh Lumber Co.* 47 Fed. Rep. 68, 1891.

⁴ *The Tremolo Patent*, 23 Wallace, 528, 1874.

§ 725. Where unlawful using of a patented article or process constitutes the infringement involved in an action in equity, the infringer's profits are ascertained by a rule quite different from either of the foregoing. That rule, in its generic character, may be formulated as follows: The advantage which the defendant derived from using the complainant's invention, over what he could have derived from using any other process or thing, which was known prior to that invention, constitutes the profits which the complainant is entitled to recover. The other process or thing mentioned in the rule, is called the standard of comparison in the case. While that standard of comparison must have been known prior to the complainant's invention,¹ it needs not to have been open to the public at any time, except in the sense that it must be open to the public so far as the complainant's patent in suit is concerned.² The advantage which is contemplated by the general rule, is the result of some superiority of the complainant's invention over the standard of comparison; and that superiority may consist in the fact that the complainant's invention performs the function common to both, with equal cheapness and greater excellence, or with greater cheapness and equal excellence, or with greater cheapness and greater excellence; and therefore the advantage may consist either in affirmative gain or in saving from loss, or in both of those elements.

§ 729. The advantage consists in an affirmative gain, in cases wherein the patented process or thing produces a valuable article from materials which otherwise would be useless, or, if useful at all, useful only for purposes of inferior value. The Goodyear process patent,³ if it had been valid, would have been a patent of this sort, and would have been entitled to an account of profits ascertained according

¹ *Turrill v. Illinois Central R. R. Co.* 20 Fed. Rep. 912; following *Cawood Patent*, 94 U. S. 710; and affirmed by *Illinois Central R. R. Co. v. Turrill*, 110 U. S. 302, 1884; *Sessions v. Romadka*, 145 U. S. 45,

1892; *Lawther v. Hamilton*, 64 Fed. Rep. 224, 1892.

² *McCreary v. Pennsylvania Canal Co.* 141 U. S. 464, 1891.

³ *Rubber Co. v. Goodyear*, 9 Wallace, 794, 1869.

to the rule of Section 725. But as the only patent sustained in the Goodyear case was the patent for the product, and inasmuch as that patent was infringed by the defendant only in making and selling specimens of the invention it covered, the profits were ascertained on an entirely different plan.

§ 730. But the advantage consisted in saving from loss, in most of the cases which have been adjudicated under the general rule.

In *Mowry v. Whitney*,¹ the advantage was a saving of materials and labor, realized from the use of the complainant's process in manufacturing car-wheels, as compared with what it would have been necessary to expend in producing similar car-wheels, salable at the same price, without the use of that process. In the case of the Cawood Patent² the advantage was a saving of labor and of fuel, realized from the use of the complainant's swage-block in mending the exfoliated ends of railroad rails, as compared with the labor and fuel it would have been necessary to expend in mending those rails upon a common anvil.

In *Mevs v. Conover*,³ the advantage was a saving of labor in splitting kindling-wood by means of the patented machine of the complainant, as compared with the labor which would have been required to split the same quantity of wood by hand, or by any other machine. The justice of the decision last cited has sometimes been questioned; on the ground that there was no actual profit made by the infringer in splitting the wood, and on the contention that he would not have split the wood at all if he had been obliged to do so otherwise than by the patented machine, and that to save a man from a loss which he would not have incurred in any event, is not to confer a profit upon him, and therefore that savings ought not to be accounted as profits except where they result in actual gains. But the case as reported from

¹ *Mowry v. Whitney*, 14 Wallace, 1876.
651, 1871.

² Cawood Patent, 94 U. S. 709, 1876.

³ *Mevs v. Conover*, 125 U. S. 144,

the circuit court,¹ shows that the defendant did continue to split kindling-wood after the bringing of the suit caused him to discontinue the use of the complainant's invention for that purpose. It was probably necessary for him to do so, in order to hold his customers for other kinds of fuel. Therefore the case is not a precedent for the proposition that savings are profits, where there was no actual profit in the particular business in which the complainant's invention was used, and where there was no reason why the defendant should have pursued that business, if obliged to do so at a positive loss. It is entirely consistent with the principle of the general rule to hold that savings are profits, only so far as they result in affirmative gains from the particular business in which the infringer used the patented invention; unless that particular business was so necessary to the general business of the infringer, that he could have afforded to conduct it at an additional loss, at least equal to the saving he made from the use of the complainant's invention, and therefore presumably would have conducted it at that loss, if he had not used that invention.²

In *Webster Loom Co. v. Higgins*,³ the advantage was a saving of machinery for weaving carpets, it appearing, in the aspect of the proofs most favorable to the complainant that the defendants could have made all the carpeting they did make, if instead of using their sixty-one infringing looms, they had used twice that number of non-infringing looms. On this basis, the complainant contended that it was entitled to recover all the profits which were made by the defendants, on those yards of carpeting which they made on the sixty-one infringing looms, over and above the much smaller number of yards which they could have made on sixty-one non-infringing looms. But that contention was overruled by the court, on the ground that nothing hindered the defendants from using one hundred and twenty-two non-

¹ *Conover v. Mevs*, 11 Blatch, 198, 1873.

² *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* 40 Fed. Rep. 477, 1889;

Tuttle v. Claffin, 62 Fed. Rep. 455, 1894.

³ *Webster Loom Co. v. Higgins*, 43 Fed. Rep. 675, 1890.

infringing looms, instead of sixty-one infringing looms, and that the cost of the use of whatever number of non-infringing looms would have been necessary to make the carpeting which was made on the sixty-one infringing looms, was the proper standard of comparison in the case.

In *Sessions v. Romadka*,¹ the saving consisted in the difference between the cost of the patented trunk fasteners, which the defendant used in manufacturing trunks, and the greater cost of the straps, buckles, and dowels previously in use, in the place of those trunk fasteners.

§ 731. The advantage referred to, consisted both in affirmative gains and in savings from loss, in a number of important cases. In *Tilghman v. Proctor*,² it consisted in savings of lime and sulphuric acid; and in gain on account of the increased value of the glycerine obtainable by means of the complainant's invention, as compared with that obtainable by other processes. In *Wetherill v. Zinc Co.*³ the advantage consisted in savings of coal and labor, in reducing zinc ores; and in gain on account of the increased proportion of zinc obtained by the complainant's process, as compared with other processes used for that purpose.

§ 732. The standard of comparison set up by a defendant needs not to have been used by him at any time,⁴ and where it never was so used, the evidence of its utility, as compared with the invention in suit, may be drawn from persons who have used the two under the same conditions;⁵ or from any other source which is capable of furnishing convincing evidence upon the point. And even where the defendants have used the standard of comparison, they may show that it was used with better results by others, and may have the benefit of that superiority on the accounting.⁶

¹ *Sessions v. Romadka*, 145 U. S. 45, 1892.

² *Tilghman v. Proctor*, 125 U. S. 142, 1888.

³ *Wetherill v. Zinc Co.* 1 Bann. & Ard. 486, 1874.

⁴ *Locomotive Safety Truck Co. v. Railroad Co.* 2 Fed. Rep. 679, 1880.

⁵ *Emigh v. Railroad Co.* 6 Fed. Rep. 283, 1881.

⁶ *Tilghman v. Proctor*, 125 U. S. 150, 1888.

§ 734. To determine what is the proper standard of comparison in a particular case, it is not necessary for the complainant to affirmatively prove that a particular thing was absolutely the next best thing to his invention at the time of the infringement. Such a requirement would not be reasonable, because it could never be performed. It would involve evidence enough to negative the existence of a better thing than the one fixed upon; and to prove that no better thing existed anywhere, would obviously be impossible. The regular course of practice on the point is for the complainant to select what appears to him to be the proper standard of comparison, and to produce evidence to prove what advantage the defendant derived from using the complainant's invention over what he could have derived from using the thing so selected. Where the defendant knows of no standard of comparison more favorable to himself than the one selected by the complainant, the only remaining issue relates to the utility and cheapness of that thing, as compared with the complainant's invention.¹ Where the defendant is not satisfied that the complainant has made the proper selection of a standard of comparison, he may select another, and may produce evidence to show its utility and cheapness as compared with that of the invention covered by the patent in suit; and when the case comes to a hearing before the master, the first question to be decided by him will be as to which of the parties has made the proper selection, and that standard will be used in the accounting, whether it was selected by the complainant or by the defendant; and all evidence about the merits of the other proposed standard will become and remain immaterial to the case.²

The true standard of comparison in a particular case is that prior thing which, next to the complainant's invention, could have been most advantageously used by the defendant

¹ *Emigh v. Railroad Co.* 6 Fed. Rep. 285, 1881.

² *Webster Loom Co. v. Higgins*, 39 Fed. Rep. 465, 1889.

in place of that invention at the time he used the latter. To determine this point, comparative utility is one guide, but regard must also be had to cheapness, for the advantage contemplated by the general rule of Section 725 is the equalized result of these two elements.

§ 735. The rule of Section 725 has no application to those cases of infringement which consist in making and selling a patented article, or in the latter of those acts alone; except where a patented article is used as a component part of a much larger article which is made and sold by the infringer.¹ In *Elizabeth v. Pavement Co.* the infringement consisted only in making the patented pavement to order; that is to say, it consisted in making and selling the patented article. The defendants sought to have the profits determined, under the rule of Section 725, by setting up other pavements as standards of comparison, but the Supreme Court held their position on the point to be without foundation.² The same rule was also unsuccessfully invoked in the case of *Burdett v. Estey*, though the argument in favor of its application was supported by evidence that the defendant might have made and sold a different device, at nearly or quite the same profit that he derived from making and selling the device covered by the complainant's patent.³

§ 736. Interest on infringer's profits is allowed from the date of the master's report, which ascertains the amount of those profits.⁴

§ 739. After an interlocutory decree is entered directing a master commissioner of the court to take and report an account of the defendant's profits, or appointing a master *pro hac vice* for that purpose, it becomes the business of the complainant to introduce evidence before such master to

¹ *Sessions v. Romadka*, 145 U. S. 569, 1890.
48, 1892.

² *Elizabeth v. Pavement Co.* 97 U. S. 141, 1877.

³ *Burdett v. Estey*, 3 Fed. Rep.

⁴ *Tilghman v. Proctor*, 125 U. S. 160, 1887; *Crosby Valve Co. v. Safety Valve Co.* 141 U. S. 457,

1891.

prove the amount of those profits. The complainant must take the initiative. It is not the province of the master to suggest any specific line of proof or theory of accounting. His function is to pass upon whatever evidence the complainant produces, in the light of whatever is produced by the defendant.¹ And his fees must be paid by the defendant when they accrue, and must be borne by him in the final taxation of costs, if he is finally defeated,² but must be borne by the complainant if the bill is finally dismissed.³

§ 740. The evidence upon which the master may base his report, may consist of any evidence taken in the case prior to the interlocutory decree,⁴ and of documents introduced and depositions taken by the parties for the express purpose of the accounting, and of testimony taken *viva voce* in the presence of the master,⁵ anywhere in the world,⁶ and of personal examination by him of the structures or processes which are involved in the questions before him.⁷ If the required documents are not produced voluntarily, the master may require their production; and any necessary depositions may be taken upon commissions to be issued upon his certificate, from the clerk's office, or they may be taken according to the acts of Congress.⁸ When testimony is taken *viva voce* before a master, either party may require that it be taken down in writing, in order that, if necessary, it may be used by the court.⁹ In the course of an accounting before a master, that officer has full authority to do all acts and to direct all proceedings which he may deem necessary and proper to the justice and merits of the case.¹⁰ If, for example, an account to be transcribed or deduced from the defendant's books, is necessary to a just decision

¹ Garretson v. Clark, 4 Bann. & Ard. 537, 1879.

² Urner v. Kayton, 17 Fed. Rep. 539, 845, 1883.

³ American Diamond Drill Co. v. Machine Co. 32 Fed. Rep. 552, 1885.

⁴ Equity Rule 80; Bell v. Stamping Co. 32 Fed. Rep. 549, 1887.

⁵ Equity Rule 77.

⁶ Bate Refrigerating Co. v. Gillette, 28 Fed. Rep. 673, 1886.

⁷ Piper v. Brown, 1 Holmes, 198, 1873.

⁸ Equity Rule 77; Revised Statutes, Sections 863, 864, and 865; Section 535 of this book.

⁹ Equity Rule 81.

¹⁰ Equity Rule 77.

of the cause, the master may make an order that the defendant furnish such an account by a certain day; and such an order, when served on the defendant by any disinterested person, must be obeyed, or the defendant will be guilty of contempt of court for not obeying it.¹

§ 741. Objections to evidence, in order to be availing, must be made when the objectionable piece of evidence is offered, or the objectionable question is put, or the objectionable answer is given. If the master is present at the time, he ought to rule upon the objection at once, and if either party would appeal from that ruling, he must enter an immediate objection thereto. If the ruling is against the evidence objected to, it is necessary for the party who offers the evidence, if he would appeal from the ruling, to do so by an immediate motion to the court to direct the master to reverse his decision upon the point.² The reason for this practice is that if such an appeal could be taken in an exception to the master's report, it would, when taken successfully, necessitate a recommittal of the case to the master, in order to enable him to admit the evidence which he erroneously rejected. If the master's ruling is in favor of the evidence objected to, that evidence will of course be admitted subject to the objection, and that ruling may be reviewed by the court on exceptions to the report of the master, as well as by means of an immediate motion. It may be reviewed on exceptions, because, if it is reversed, that reversal will not necessitate any addition to the evidence before the court, but will merely cause the court to eliminate the objectionable evidence from among the factors of the problems before it.

If the master is not present when the cause of an objection arises, the practice is for the notary or other magistrate who is taking the deposition, to note the objections thereon, and to take down the evidence objected to; for he has no authority to make any ruling. In such cases the objections

¹ *Kerosene Lamp Heater Co. v. Fisher*, 5 Bann. & Ard. 79, 1880.

² *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* 40 Fed. Rep. 477, 1889.

which are noted upon the depositions, may be brought to the attention of the master on the argument before him, and his specific rulings thereon may be required, and those rulings may be reviewed by the court, on exceptions to the report of the master, as far as they have affected that report. Most of the points stated in this section are contained in an excellent decision of Judge W. D. SHIPMAN,¹ and the residue are deducible from that decision, or from plain principles of practice.

§ 742. The extent of the defendant's infringement must be determined by the master in order to enable him to ascertain the amount of the profits which the defendant derived from that infringement. Where the infringement was all alike, or where the interlocutory decree specifies the particular doings of the defendant which are to be accounted for as infringements, the only question for the master to decide on this point is a question of quantity. But where the interlocutory decree merely directs the master to take and report an account of the profits which the defendant derived from infringing the complainant's patent, and where the complainant claims that certain doings of the defendant which were not proved prior to the interlocutory decree, constitute such an infringement, it becomes the duty of the master to decide the question of infringement involved.² Nor would it be unprecedented for a court, when directing a master to take and report an account of infringers' profits, to direct him also to decide and report which of various machines used by the defendant were infringements of the complainant's patent, and to make up his account accordingly,³ or for the master to spontaneously report upon a form of infringement which was not previously before the court.⁴ But the most convenient

¹ *Troy Iron and Nail Factory v. Corning*, 6 Blatch. 333, 1869.

Co. 53 Fed. Rep. 245, 1892.

² *Knox v. Quicksilver Mining Co.*
6 Sawyer, 436, 1878; *Ball Glove Fastening Co. v. Socket Fastener*

³ *Cawood Patent*, 94 U. S. 708, 1876.

⁴ *Adams v. Keystone Mfg. Co.* 41 Fed. Rep. 596, 1890.

and least expensive practice is for the court to decide all questions of infringement, before entering an interlocutory decree.

§ 743. Where the alleged infringements involved in a suit, are of several sorts, the master generally ought to report in a separate item the profits due to each kind; so that the Circuit Court on exceptions, or a higher court on an appeal, may render a decree for part or for all of those items, according to its decision upon the questions of infringement involved. This is but a rule of convenience, and may be departed from when convenience would thus be better served. Where the defendant used two different sorts of machines, both of which the complainant claims infringe his patent, if the points upon which those questions of infringement depend are apparently the same in both cases, and if the two sorts of machines were so used by the defendant, that it would be difficult to separate the profits derived from the use of one from those flowing from the use of the other, it will be most convenient not to attempt to do so. In such a case there is but little probability that the courts will hold one of the two sorts of machines to infringe, while holding that the other does not, and there is correspondingly little probability that a necessity will arise for a division of the profits due to the use of the two kinds.

§ 744. A draft report of a mastery in chancery, is one which the master draws up after the testimony has all been taken, and the parties have been heard in argument on that testimony, and the master has formed an opinion on the questions involved in the reference before him. Such a report is requisite to enable the parties to correct any misapprehension into which the master may have fallen, without the alternative necessity of presenting the point to the court. When completed, such a report is either filed in the case, or served on the parties or their solicitors; and it thereupon devolves upon any party who is dissatisfied with the master's finding, to file such exceptions to his draft report, as will call his attention to each alleged error of

which the dissatisfied party proposes to complain.¹ It then becomes the duty of the master to consider or reconsider the questions involved in those exceptions, and thereupon to prepare and file his final report in the case. The latter will be identical with the draft report, if the consideration of the exceptions to the earlier document fails to convince the master that it was wrong; but if he is so convinced, he will concert his final report in such a manner as to make it embody his changed opinion.² No new evidence can be introduced before a master after he has made his draft report;³ the proceedings upon exceptions thereto, being merely in the nature of a rehearing for errors apparent on the face of the record. According to strict equity practice, it is necessary to give a master this opportunity to correct his findings, in order to save time and labor of the judge.⁴ But this strict practice has often been omitted by counsel in patent cases, and its omission been condoned by opposing counsel or by the court.⁵ But it is not safe to omit the filing of such exceptions with the master, for the rule which requires them, is always liable to be enforced, and the enforcement consists in the court disregarding every exception to a master's final report, which was not taken before the master himself, by way of exceptions to his draft report.⁶ A final report of a master is merely advisory to the court;⁷ and though its conclusions of fact will not be reviewed otherwise than on exceptions thereto,⁸ its conclusions of

¹ *Fischer v. Hayes*, 16 Fed. Rep. 469, 1883.

² *Sugar Refinery Co. v. Mathieson*, 3 Cliff. 149, 1868; *Troy Iron & Nail Factory v. Corning*, 6 Blatch. 332, 1869.

³ *Piper v. Brown*, 1 Holmes, 196, 1873.

⁴ *Story v. Livingston*, 13 Peters, 366, 1839; *Topliff v. Topliff*, 145 U. S. 172, 1892.

⁵ *Fischer v. Hayes*, 16 Fed. Rep.

469, 1883; *Jennings v. Dolan*, 29 Fed. Rep. 861, 1887.

⁶ *McMickin v. Perin*, 18 Howard, 510, 1855; *Troy Iron & Nail Factory v. Corning*; 6 Blatch. 333, 1869; *Celluloid Mfg. Co. v. Cellonite Mfg. Co.* 40 Fed. Rep. 476, 1889.

⁷ *Boesch v. Graff*, 133 U. S. 705, 1890.

⁸ *Topliff v. Topliff*, 145 U. S. 172, 1892.

law will be verified or corrected by the court, before any final decree is based thereon.¹

§ 745. Exceptions to masters' reports ought to be aimed with precision at the errors which such reports are alleged to contain.² Such exceptions may be filed by the complainant, if he thinks that the master has erred in not finding any profits, or in not finding any damages, or in finding either of those foundations of recovery to have been smaller than the evidence would warrant; and such exceptions may be filed by the defendant, if he thinks that the master erred in finding profits or in finding damages to an amount in excess of what the evidence can sustain.

§ 746. Defendants' exceptions to masters' reports are divisible into four classes. 1. Exceptions which state that there is evidence in the case, proving that the defendant derived no profit, and that the complainant sustained no damage, on account of the infringement. 2. Exceptions which state that there is evidence in the case proving that the master's finding of profits or of damages, is too large in amount. 3. Exceptions which deny that there is any admissible evidence in the case proving that the defendant derived profit, or that the complainant sustained damage, on account of the infringement. 4. Exceptions which deny that there is any admissible evidence in the case proving that the defendant derived profit, or that the complainant sustained damage, on account of the infringement, to so great an amount as the master reported.

The first two of these classes of exceptions rely upon affirmations, and the last two rely upon negations, of definite points of fact. For the purposes of the present explanation, the four classes may be treated in two groups: those which are affirmative requiring one sort of management in practice, and those which are negative requiring another.

§ 747. Defendants' affirmative exceptions to a draft report, must specify the particular evidence upon which they are

¹ Celluloid Mfg. Co. v. Cellonite Mfg. Co. 40 Fed. Rep. 477, 1889.

² Sheffield Ry. Co. v. Gordon, 151 U. S. 290, 1894.

respectively based. If this rule were otherwise, such an exception would not point out error, and would therefore fail to perform its only function. Defendants' affirmative exceptions to a final report, must be supported by reference to the particular evidence upon which the exceptor relies ; or by such special statements of the master, as justify the exceptor in affirming the existence of the particular facts upon which he relies to support such exceptions. Were the court required to wander at large into the evidence which was before the master, the reference to him would be of little value. Indeed that evidence need not be reported, further than it is relied upon to support, explain, or oppose a particular exception ;¹ and there is no presumption in any case, in the absence of a certificate, that the master reported to the court all the evidence which was before him.²

§ 748. Defendants' negative exceptions are those which call in question the admissibility of the evidence upon which the master based his finding, and those which deny the presence in the record of any evidence sufficient to support that conclusion. An exception of the first of these sorts, so far partakes of the nature of an affirmative exception, that it ought to specify the particular evidence objected to, so that the master, on exceptions to his draft report, or the court, on exceptions to the final report of the master, may have a precise issue in the law of evidence presented for decision. But an exception of the second of these kinds cannot be expected to specify any particular evidence, because it assumes that there is none in the record. In such a case, the proper practice is for the exceptor to require the master to make a special statement, in his final report, of the particular evidence which convinced his judgment, and to transmit that evidence with his report into court.³

¹ *Harding v. Handy*, 11 Wheaton, 126, 1826.

² *Sheffield Ry. Co. v. Gordon*, 151 U. S. 293, 1894.

³ *In re Hemiup*, 3 Paige (N. Y.), 307, 1832; *Greene v. Bishop*, 1 Cliff. 195, 1858; *The Commander-in-Chief*, 1 Wallace, 50, 1863.

§ 749. Complainant's exceptions to a master's report may be of two classes. 1. Exceptions which state that there is evidence in the case proving that the defendant derived larger profits, or that the complainant sustained larger damages than the master reported. 2. Exceptions which state that the master erred in admitting inadmissible evidence. Both of these sorts are affirmative in their nature, and when made to a draft report, must therefore be supported by references to the particular evidence upon which the exceptor relies, or by reference to the particular evidence which he claims was improperly admitted against his objection, as the case may happen to require. When made to a final report, a complainant's exceptions, like the affirmative exceptions of a defendant, must be supported either by references to the particular evidence involved, or be based upon such special statements of the master as will obviate that necessity.

§ 750. The system of practice relevant to a master's finding appears to present the following outlines when reviewed as a whole. It is a master's function to investigate the questions which are referred to him by the court, and to investigate no others. To that end, he takes testimony and receives other evidence, and decides what conclusions are justified thereby; and those conclusions will stand unless they are clearly erroneous.¹ Unless the court otherwise directs, the master's draft report should contain those conclusions alone; and his final report should contain only his final conclusions, together with such statements of fact and statements and pieces of evidence as the parties lawfully require him to attach thereto. Where the exceptions to the draft report involve no issues save such as pertain to the admissibility of particular evidence, nothing need accompany the final report except the evidence objected to, and a statement of the ground upon which it was admitted. Where those exceptions merely affirm the presence of evi-

¹ *Tilghman v. Proctor*, 125 U. S. 149, 1887; *Callaghan v. Myers*, 128 U. S. 666, 1889; *Kimberly v. Arms*, 129 U. S. 512, 1889.

dence requiring a different conclusion from that of the master, nothing need accompany the final report save the particular evidence which those exceptions specify in that behalf. Where those exceptions merely deny the presence of evidence to justify the draft report, nothing need accompany the final report save the evidence which carried the master to the conclusion at which he arrived. Where a master receives no direction from the court, and no request from either of the parties, to report any evidence; his report contains nothing but his finding, and his finding is conclusive.¹

¹ *Harding v. Handy*, 11 Wheaton, 126, 1826; *The Commander-in-Chief*, 1 Wallace, 50, 1863; *In re Hemiup*, 3 Paige (N. Y.), 307, 1832; *Dexter v. Arnold*, 2 Sumner, 131, 1834; *Donnell v. Insurance Co.* 2 Sumner, 371, 1836; *Boston Iron Co. v. King*, 2 Cushing (Mass.), 405, 1848; *Adams v. Brown*, 7 Cushing (Mass.), 222,

1851; *Howe v. Russell*, 36 Maine, 127, 1853; *Sparhawk v. Wills*, 5 Gray (Mass.), 431, 1855; *Greene v. Bishop*, 1 Cliff. 195, 1858; *Mason v. Railroad Co.* 52 Maine, 115, 1861; *Piper v. Brown*, 1 Holmes, 198, 1873; *Hammacher v. Wilson*, 32 Fed. Rep. 797, 1887; *Keep v. Fuller*, 42 Fed. Rep. 896, 1890.

APPENDIX.

THE PATENT STATUTES.

PATENT ACT OF 1790.

1 STATUTES AT LARGE, 109.

An Act to promote the progress of useful Arts.

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

who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters-patent so certified to the President, who shall cause the seal of the United States to be thereto affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and indorsed on the patent by the said Secretary at the time of granting the same.

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

SECTION 3. *And be it further enacted*, That upon the application of any person to the Secretary of State, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the Secretary to give such a copy, and to permit the person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant.

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

SECTION 5. *And be it further enacted,* That upon oath or affirmation made before the judge of the district court where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously by, or upon false suggestion, and motion made to the said court, within one year after issuing the said patent, but not afterwards, it shall and may be lawful to and for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators, or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee or patentees, his, her, or their executors, administrators, or assigns. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent or patents; and if the party at whose complaint the process issued shall have judgment given against him, he shall pay all such costs

as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in such manner as costs expended by defendants shall be recovered in due course of law.

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

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

APPROVED April 10, 1790.

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

PATENT ACT OF 1793.

1 STATUTES AT LARGE, 318.

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

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters-patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters-patent shall be delivered to the Attorney-General of the United States, to be examined ; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of State, who shall present the letters-patent, thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed ; and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

SECTION 2. *Provided always, and be it further enacted,* That any person who shall have discovered an improvement in the

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

SECTION 3. *And be it further enacted,* That every inventor, before he can receive a patent, shall swear or affirm, that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent, which oath or affirmation may be made before any person authorized to administer oaths, and shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions ; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings, or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter ; which description, signed by himself, and attested by two witnesses, shall be filed in the office of the Secretary of State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing, touching such patent right shall come in question. And such inventor shall, moreover, deliver a model of his machine, provided the Secretary shall deem such model to be necessary.

SECTION 4. *And be it further enacted,* That it shall be lawful for any inventor, his executor or administrator, to assign the title and interest in the said invention, at any time, and

the assignee, having recorded the said assignmer in the office of the Secretary of State, shall thereafter stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assigns, to any degree.

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

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

SECTION 7. *And be it further enacted*, That where any State, before its adoption of the present form of government, shall have granted an exclusive right to any invention, the party claiming that right shall not be capable of obtaining an exclusive right under this act, but on relinquishing his right

under such particular State, and of such relinquishment, his obtaining an exclusive right under this act shall be sufficient evidence.

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

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

SECTION 10. *And be it further enacted,* That upon oath or affirmation being made before the judge of the district court where the patentee, his executors, administrators, or assigns, reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or upon false suggestion, and motion made to the said court, within three years after issuing the said patent, but not afterward, it shall and may be lawful for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule, that the patentee, or his executor, administrator, or assign show cause why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the con-

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

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

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

within the purview of this act, in respect to the violation of their rights : provided such violations shall be committed after the passing of this act.

APPROVED February 21, 1793.

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

PATENT ACT OF 1794.

1 STATUTES AT LARGE, 393.

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

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That all suits, actions, process and proceedings, heretofore had in any District Court of the United States, under an act passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled " An act to promote the progress of useful arts," which may have been set aside, suspended or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said court, to the same situation, in which they may have been when they were so set aside, suspended, or abated ; and that the parties to the said suits, actions, process or proceedings be, and are hereby, entitled to proceed in such cases, as if no such repeal of the act aforesaid had taken place : *Provided always,* That before any order or proceeding, other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceeding as is used in other cases for compelling the appearance of a party.

APPROVED June 7, 1794.

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

PATENT ACT OF 1800.

2 STATUTES AT LARGE, 37.

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

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That all and singular the rights and privileges given, intended or provided to citizens of the United States, respecting patents for new inventions, discoveries, and improvements, by the act intituled “ An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose,” shall be, and hereby are, extended and given to all aliens who at the time of petitioning in the manner prescribed by the said act, shall have resided for two years within the United States, which privileges shall be obtained, used, and enjoyed by such persons, in as full and ample manner, and under the same conditions, limitations, and restrictions, as by the said act is provided and directed in the case of citizens of the United States: *Provided always,* That every person petitioning for a patent for any invention, art, or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths before such patent shall be granted, that such invention, art, or discovery hath not, to the best of his or her knowledge or belief, been known or used either in this or any foreign country, and that every patent which shall be obtained pursuant to this act, for any invention, art, or discovery, which it shall afterwards appear had been known or used previous to such application for a patent, shall be utterly void.

SECTION 2. *And be it further enacted,* That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might, by virtue of this or the above-mentioned act, be granted to such person, and shall die before any patent shall be granted therefor, the right of applying for and obtaining such

patent, shall devolve on the legal representatives of such person in trust for the heirs at law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions as the same was held, or might have been claimed or enjoyed by such person, in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation, provided in the third section of the before-mentioned act, shall be so varied as to be applicable to them.

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

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

APPROVED April 17, 1800.

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

PATENT ACT OF 1819.

3 STATUTES AT LARGE, 481.

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

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

APPROVED February 15, 1819.

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

PATENT ACT OF JULY 3, 1832.

4 STATUTES AT LARGE, 559.

An Act concerning patents for useful inventions.

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

SECTION 2. *And be it further enacted,* That application to Congress to prolong or renew the term of a patent shall be made

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

SECTION 3. *And be it further enacted,* That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of the act of Congress, entitled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," passed on the twenty-first day of February, in the year of our Lord, one thousand seven hundred and ninety-three, or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first-mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of the said act. And, in case of his death, or any assignment by him made of the same patent, the like right shall vest in his executors and administrators, or assignee or assignees: *Provided however,* That such new patent so granted shall, in all respects, be liable to the same matters of objection and defence as any original patent granted under the said first-mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor,

or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid.

APPROVED July 3, 1832.

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

PATENT ACT OF JULY 13, 1832.

4 STATUTES AT LARGE, 577.

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

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

APPROVED July 13, 1832.

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

PATENT ACT OF 1836.

5 STATUTES AT LARGE, 117.

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

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

SECTION 2. *And be it further enacted,* That there shall be in said office an inferior officer, to be appointed by the said principal officer, with the approval of the Secretary of State, to receive an annual salary of seventeen hundred dollars, and to be called the Chief Clerk of the Patent Office; who in all cases during the necessary absence of the Commissioner, or when then said principal office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers, machines, models, and all other things belonging to the said office, and shall perform the duties of Commissioner

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

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

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

paying for the written copies the sum of ten cents for every page of one hundred words; and for copies of drawings the reasonable expense of making the same.

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

SECTION 6. *And be it further enacted,* That any person or persons, having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application, in writing, to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use

the same ; and in case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions ; and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. He shall, furthermore, accompany the whole with a drawing or drawings, and written references, where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter ; which descriptions and drawings, signed by the inventor and attested by two witnesses, shall be filed in the Patent Office ; and he shall moreover furnish a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. The applicant shall also make oath or affirmation that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used ; and also of what country he is a citizen ; which oath or affirmation may be made before any person authorized by law to administer oaths.

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

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

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

SECTION 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be ; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act ; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters-patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And whenever the applicant shall request it, the patent shall take date from the time

of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent ; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent to be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

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

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

or affirmation provided in the sixth section of this act shall be so varied as to be applicable to them.

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

SECTION 12. *And be it further enacted,* That any citizen of the United States, or alien, who shall have been a resident of the United States one year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire further time to make the same, may, on paying to the credit of the treasury, in manner as provided in the ninth section of this act, the sum of twenty dollars, file in the Patent Office a caveat, setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right till he shall have matured his invention; which sum of twenty dollars, in case the person filing such caveat shall afterwards take out a patent for the invention therein mentioned, shall be considered a part of the sum herein required for the same. And such caveat shall be filed in the confidential archives of the office, and preserved in secrecy. And if application shall be made by any other person within one year from the time of filing such caveat, for a patent of any invention with which it may in any respect interfere, it shall be the duty of the Commissioner to deposit the description, specifications, drawings, and model, in the confidential archives of the office, and to give notice, by mail, to the person filing the caveat, of such application, who shall, within three months after receiving the notice, if he would avail himself of the benefit of his caveat, file his description, specifications, drawings, and model; and if, in the opinion of

the Commissioner, the specifications of claim interfere with each other, like proceedings may be had in all respects as are in this act provided in the case of interfering applications: *Provided however*, That no opinion or decision of any board of examiners, under the provisions of this act, shall preclude any person, interested in favor of or against the validity of any patent which has been or may hereafter be granted, from the right to contest the same in any judicial court in any action in which its validity may come in question.

SECTION 13. *And be it further enacted*, That whenever any patent which has heretofore been granted, or which shall hereafter be granted, shall be inoperative, or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention more than he had or shall have a right to claim as new; if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification. And in case of his death, or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assignees. And the patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent. And whenever the original patentee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery which shall have been invented or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the payment of fifteen dollars as hereinbefore provided, have the same annexed to the

original description and specification ; and the Commissioner shall certify, on the margin of such annexed description and specification, the time of its being annexed and recorded ; and the same shall thereafter have the same effect in law, to all intents and purposes, as though it had been embraced in the original description and specification.

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

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

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

SECTION 16. *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity ;

and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however,* That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

SECTION 17. *And be it further enacted,* That all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, by the circuit courts of the United States, or any district court having the power and jurisdiction of a circuit court; which courts shall have power, upon a bill in equity filed by any party aggrieved, in any such case, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor as secured to him by any law of the United States, on such terms and conditions as said courts may deem reasonable: *Provided however,* That from all judgments and decrees from any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of circuit courts, and in all other cases in which the court shall deem it reasonable to allow the same.

SECTION 18. *And be it further enacted,* That whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and the Commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury, as in the case of an original application for a patent, cause to be published in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence produced before them both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment

and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein: *Provided however*, That no extension of a patent shall be granted after the expiration of the term for which it was originally issued.

SECTION 19. *And be it further enacted*, That there shall be provided for the use of said office, a library of scientific works and periodical publications, both foreign and American, calculated to facilitate the discharge of the duties hereby required of the chief officers therein, to be purchased under the direction of the Committee of the Library of Congress. And the sum of fifteen hundred dollars is hereby appropriated for that purpose, to be paid out of the patent fund.

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

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

passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage hereof.

APPROVED July 4, 1836.

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

PATENT ACT OF 1837.

5 STATUTES AT LARGE, 191.

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

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

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

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

SECTION 3. *And be it further enacted,* That whenever it shall appear to the Commissioner that any patent was destroyed by the burning of the Patent Office building on the aforesaid fifteenth day of December, or was otherwise lost prior thereto, it shall be his duty, on application therefor by the patentee or other person interested therein, to issue a new patent for the same invention or discovery, bearing the date of the original

patent, with his certificate thereon that it was made and issued pursuant to the provisions of the third section of this act, and shall enter the same of record : *Provided however,* That before such patent shall be issued the applicant therefor shall deposit in the Patent Office a duplicate, as near as may be, of the original model, drawings, and description, with specification of the invention or discovery, verified by oath, as shall be required by the Commissioner ; and such patent, and copies of such drawings and descriptions, duly certified, shall be admissible as evidence in any judicial court of the United States, and shall protect the rights of the patentee, his administrators, heirs, and assigns, to the extent only in which they would have been protected by the original patent and specification.

SECTION 4. *And be it further enacted,* That it shall be the duty of the Commissioner to procure a duplicate of such of the models, destroyed by fire on the aforesaid fifteenth day of December, as were most valuable and interesting, and whose preservation would be important to the public ; and such as would be necessary to facilitate the just discharge of the duties imposed by law on the Commissioner in issuing patents, and to protect the rights of the public and of patentees in patented inventions and improvements : *Provided,* That a duplicate of such models may be obtained at a reasonable expense : *And provided also,* That the whole amount of expenditure for this purpose shall not exceed the sum of one hundred thousand dollars. And there shall be a temporary board of Commissioners, to be composed of the Commissioner of the Patent Office and two other persons to be appointed by the President, whose duty it shall be to consider and determine upon the best and most judicious mode of obtaining models of suitable construction ; and also to consider and determine what models may be procured in pursuance of, and in accordance with, the provisions and limitations in this section contained. And said commissioners may make and establish all such regulations, terms, and conditions, not inconsistent with law, as in their opinion may be proper and necessary to carry the provisions of this section into effect, according to its true intent.

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

Nor shall any addition of an improvement be made to any patent heretofore granted, nor any new patent be issued for an improvement made in any machine, manufacture, or process, to the original inventor, assignee, or possessor of a patent therefor, nor any disclaimer be admitted to record, until a duplicate model and drawing of the thing originally intended, verified as aforesaid, shall have been deposited in the Patent Office, if the Commissioner shall require the same ; nor shall any patent be granted for an invention, improvement, or discovery, the model or drawing of which shall have been lost, until another model and drawing, if required by the Commissioner, shall, in like manner, be deposited in the Patent Office.

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

SECTION 6. *And be it further enacted,* That any patent hereafter to be issued may be made and issued to the assignee or assignees of the inventor or discoverer, the assignment thereof being first entered of record, and the application therefor being duly made, and the specification duly sworn to by the inventor. And in all cases hereafter, the applicant for a patent shall be held to furnish duplicate drawings, when-

ever the case admits of drawings, one of which to be deposited in the office, and the other to be annexed to the patent, and considered a part of the specification.

SECTION 7. *And be it further enacted,* That, whenever any patentee shall have, through inadvertence, accident, or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material or substantial part of the thing patented being truly and justly his own, any such patentee, his administrators, executors, and assigns, whether of the whole or of a sectional interest therein, may make disclaimer of such parts of the thing patented as the disclaimant shall not claim to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; which disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, on payment by the person disclaiming in manner as other patent duties are required by law to be paid, of the sum of ten dollars. And such disclaimer shall thereafter be taken and considered as part of the original specification, to the extent of the interest which shall be possessed in the patent or right secured thereby, by the disclaimant, and by those claiming by or under him subsequent to the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing the same.

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

the benefit of the same privileges and proceedings as are provided by law in the case of original applications for patents.

SECTION 9. *And be it further enacted*, any thing in the fifteenth section of the act to which this is additional to the contrary notwithstanding, That, whenever by mistake, accident, or inadvertence, and without any wilful default or intent to defraud or mislead the public, any patentee shall have in his specification claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be deemed good and valid for so much of the invention or discovery as shall be truly and *bonâ fide* his own ; *Provided*, It shall be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid. And every such patentee, his executors, administrators, and assigns, whether of the whole, or of a sectional interest therein, shall be entitled to maintain a suit at law or in equity on such patent for any infringement of such part of the invention or discovery as shall be *bonâ fide* his own as aforesaid, notwithstanding the specification may embrace more than he shall have any legal right to claim. But, in every such case in which a judgment or verdict shall be rendered for the plaintiff, he shall not be entitled to recover costs against the defendant, unless he shall have entered at the Patent Office, prior to the commencement of the suit, a disclaimer of all that part of the thing patented which was so claimed without right. *Provided however*, That no person bringing any such suit shall be entitled to the benefits of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer as aforesaid.

SECTION 10. *And be it further enacted*, That the Commissioner is hereby authorized and empowered to appoint agents, in not exceeding twenty of the principal cities or towns in the United States as may best accommodate the different sections of the country, for the purpose of receiving and forwarding to the Patent Office all such models, specimens of ingredients

and manufactures, as shall be intended to be patented or deposited therein, the transportation of the same to be chargeable to the patent fund.

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

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

SECTION 13. *And be it further enacted*, That in all cases in which an oath is required by this act, or by the act to which this is additional, if the person of whom it is required shall be conscientiously scrupulous of taking an oath, affirmation may be substituted therefor.

SECTION 14. *And be it further enacted*, That all moneys paid into the treasury of the United States for patents and for fees for copies furnished by the Superintendent of the Patent Office prior to the passage of the act to which this is additional, shall be carried to the credit of the patent fund created by said act; and the moneys constituting said fund shall be, and the same are hereby, appropriated for the payment of the salaries

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

APPROVED March 3, 1837.

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

PATENT ACT OF 1839.

5 STATUTES AT LARGE, 353.

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

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

SECTION 2. *And be it further enacted,* That the Commissioner be authorized to employ temporary clerks to do any necessary transcribing, whenever the current business of the office requires

it; *Provided however*, That instead of salary, a compensation shall be allowed, at a rate not greater than is charged for copies now furnished by the office.

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

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

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

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

SECTION 7. *And be it further enacted*, That every person or corporation who has, or shall have, purchased or constructed any newly invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or

composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention ; and no patent shall be held to be invalid, by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public ; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.

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

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

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

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

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

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

APPROVED March 3, 1839.

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

PATENT ACT OF 1842.

5 STATUTES AT LARGE, 543.

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

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

SECTION 2. *And be it further enacted,* That the third section of the act of March, eighteen hundred and thirty-seven, which authorizes the renewing of patents lost prior to the fifteenth of December, eighteen hundred and thirty-six, is extended to patents granted prior to said fifteenth day of December, though they may have been lost subsequently: *Provided however,* The same shall not have been recorded anew under the provisions of said act.

SECTION 3. *And be it further enacted,* That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woollen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas-relief or composition in alto or basso relievo, or any new

and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application in writing to the Commissioner of Patents expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent: *Provided*, That the fee in such cases, which by the now existing laws would be required of the particular applicant, shall be one half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section.

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

SECTION 5. *And be it further enacted*, That if any person or persons shall paint or print or mould, cast, carve, or engrave, or stamp, upon anything made, used, or sold, by him, for the sole making or selling which he hath not or shall not have obtained letters-patent, the name or any imitation of the name of any other person who hath or shall have obtained letters-patent for the sole making and vending of such thing, without consent of such patentee, or his assigns or legal representatives; or if any person, upon any such thing not having

been purchased from the patentee, or some person who purchased it from or under such patentee, or not having the license or consent of such patentee, or his assigns or legal representatives, shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise make or affix the word "patent," or the words "letters-patent," or the word "patentee," or any word or words of like kind, meaning, or import, with the view or intent of imitating or counterfeiting the stamp, mark, or other device, of the patentee, or shall affix the same, or any word, stamp, or device, of like import, on any unpatented article, for the purpose of deceiving the public, he, she, or they, so offending, shall be liable for such offence to a penalty of not less than one hundred dollars, with costs, to be recovered by action in any of the circuit courts of the United States, or in any of the district courts of the United States having the powers and jurisdiction of a circuit court; one half of which penalty, as recovered, shall be paid to the patent fund, and the other half to any person or persons who shall sue for the same.

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

APPROVED August 29, 1842.

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

PATENT ACT OF 1848.

9 STATUTES AT LARGE, 231.

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

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress as-*

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

SECTION 2. *And be it further enacted*, That hereafter the Commissioner of Patents shall require a fee of one dollar for recording any assignment, grant, or conveyance of the whole or any part of the interest in letters-patent, or power of attorney, or license to make or use the thing patented, when such instrument shall not exceed three hundred words; the sum of two dollars when it shall exceed three hundred and shall not exceed one thousand words; and the sum of three dollars when it shall exceed one thousand words; which fees shall in all cases be paid in advance.

SECTION 3. *And be it further enacted*, That there shall be

appointed in manner aforesaid, two clerks, to be employed in copying and recording, and in other services in the Patent Office, who shall each be paid a salary of one thousand two hundred dollars per annum.

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

APPROVED May 27, 1848.

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

PATENT ACT OF 1849.

9 STATUTES AT LARGE, 395.

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

SECTION 2. *And be it further enacted*, That the Secretary of the Interior shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents, now exercised by the Secretary of State ; and the said Secretary of the Interior shall sign all requisitions for the advance or payment of money out of the Treasury on estimates or accounts, subject to the same adjustment or control now exercised on similar estimates or accounts by the First or Fifth Auditor and First Comptroller of the Treasury.

APPROVED March 3, 1849.

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

PATENT ACT OF 1852.

10 STATUTES AT LARGE, 75.

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

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

SECTION 2. *And be it further enacted,* That in case appeals shall be made to the said chief judge, or to either of the said assistant judges, the Commissioner of Patents shall pay to such chief judge or assistant judge the sum of twenty-five dollars, required to be paid by the appellant into the Patent Office by the eleventh section of said act, on said appeal.

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

APPROVED August 30, 1852.

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

PATENT ACT OF FEBRUARY 18, 1861.

12 STATUTES AT LARGE, 130.

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

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That from all judgments and decrees of any Circuit Court rendered in any action, suit, controversy, or case, at law or in equity, arising under any law of the United States granting or confirming to authors the exclusive right to their respective writings, or to inventors the exclusive right to their inventions or discoveries, a writ of error or appeal, as the case may require, shall lie, at the instance of either party, to the Supreme Court of the United States, in the same manner and

under the same circumstances as is now provided by law in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy in the action.

APPROVED February 18, 1861.

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

PATENT ACT OF MARCH 2, 1861.

12 STATUTES AT LARGE, 246.

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

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

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

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

SECTION 3. *And be it further enacted*, That no appeal shall be allowed to the examiners in chief from the decisions of the primary examiners, except in interference cases, until after the application shall have been twice rejected ; and the second examination of the application by the primary examiner shall

not be had until the applicant, in view of the references given on the first rejection, shall have renewed the oath of invention, as provided for in the seventh section of the act entitled "An act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six.

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

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

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

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

SECTION 8. *And be it further enacted*, That the Commissioner may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of

the parties filing such papers ; and for gross misconduct he may refuse to recognize any person as a patent agent, either generally or in any particular case ; but the reasons of the Commissioner for such refusal shall be duly recorded, and be subject to the approval of the President of the United States.

SECTION 9. *And be it further enacted*, That no money paid as a fee, on any application for a patent after the passage of this act, shall be withdrawn or refunded, nor shall the fee paid on filing a caveat be considered as part of the sum required to be paid on filing a subsequent application for a patent for the same invention. That the three months' notice given to any caveator, in pursuance of the requirements of the twelfth section of the act of July fourth, eighteen hundred and thirty-six, shall be computed from the day on which such notice is deposited in the post-office at Washington, with the regular time for the transmission of the same added thereto, which time shall be indorsed on the notice ; and that so much of the thirteenth section of the act of Congress, approved July fourth, eighteen hundred and thirty-six, as authorizes the annexing to letters-patent of the description and specification of additional improvements is hereby repealed, and in all cases where additional improvements would now be admissible, independent patents must be applied for.

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

On filing each caveat, ten dollars.

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

On issuing each original patent, twenty dollars.

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

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

On every application for the extension of a patent, fifty

dollars ; and fifty dollars in addition, on the granting of every extension.

On filing each disclaimer, ten dollars.

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

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

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

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

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

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

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

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

SECTION 13. *And be it further enacted*, That in all cases where an article is made or vendued by any person under the protection of letters-patent, it shall be the duty of such person to give sufficient notice to the public that said article is so patented, either by fixing thereon the word "patented," together with the day and year the patent was granted ; or when, from the character of the article patented, that may be impracticable, by enveloping one or more of the said articles, and affixing a label to the package, or otherwise attaching thereto a label on which the notice, with the date, is printed ; on failure of which, in any suit for the infringement of letters-patent by the party failing so to mark the article the right to which is infringed upon, no damage shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued after such notice to make

or vend the article patented. And the sixth section of the act entitled "An act in addition to an act to promote the progress of the useful arts," and so forth, approved the twenty-ninth day of August, eighteen hundred and forty-two, be, and the same is hereby, repealed.

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

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

SECTION 16. *And be it further enacted*, That all patents hereafter granted shall remain in force for the term of seventeen years from the date of issue; and all extension of such patents is hereby prohibited.

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

APPROVED March 2, 1861.

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

PATENT ACT OF 1862.

12 STATUTES AT LARGE, 583.

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

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

APPROVED July 16, 1862.

PATENT ACT OF 1863.

12 STATUTES AT LARGE, 796.

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

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

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

SECTION 3. *And be it further enacted*, That every patent shall be dated as of a day not later than six months after the time at which it was passed and allowed, and notice thereof sent to the applicant or his agent. And if the final fee for

such patent be not paid within the said six months, the patent shall be withheld, and the invention therein described shall become public property as against the applicant therefor: *Provided*, That in all cases where patents have been allowed previous to the passage of this act, the said six months shall be reckoned from the date of such passage.

APPROVED March 3, 1863.

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

PATENT ACT OF 1864.

13 STATUTES AT LARGE, 194.

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

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

APPROVED June 25, 1864.

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

PATENT ACT OF 1865.

13 STATUTES AT LARGE, 533.

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

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

APPROVED March 3, 1865.

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

PATENT STATUTE OF 1866.

14 STATUTES AT LARGE, 76.

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

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That upon appealing for the first time from the decision of the primary examiner to the examiners-in-chief in the Patent

Office, the appellant shall pay a fee of ten dollars into the Patent Office, to the credit of the patent fund : and no appeal from the primary examiner to the examiners-in-chief shall hereafter be allowed until the appellant shall pay said fee.

APPROVED June 27, 1866.

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

CONSOLIDATED PATENT ACT OF 1870.

16 STATUTES AT LARGE, 198.

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

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be attached to the Department of the Interior the office, heretofore established, known as the Patent Office, wherein all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved. [See Revised Statutes, Section 475.]

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

SECTION 3. *And be it further enacted,* That the Secretary of the Interior may also appoint, upon like nomination, such additional clerks of classes two and one, and of lower grades, copyists of drawings, female copyists, skilled laborers, labor-

ors and watchmen, as may be from time to time appropriated for by Congress. [See Revised Statutes, Section 169.]

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

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

Of the assistant commissioner, three thousand dollars.

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

Of the chief clerk, two thousand five hundred dollars.

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

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

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

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

Of the librarian, one thousand eight hundred dollars.

Of the machinist, one thousand six hundred dollars.

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

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

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

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

Of the messenger and purchasing clerk, one thousand dollars.

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

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

SECTION 5. *And be it further enacted*, That all officers and employees of the Patent Office shall, before entering upon their duties, make oath or affirmation truly and faithfully to

execute the trusts committed to them. [See Revised Statutes, Sections 1756 and 1757.]

SECTION 6. *And be it further enacted*, That the commissioner and chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their duties, and that they will render to the proper officers of the treasury a true account of all money received by virtue of their office. [See Revised Statutes, Section 479.]

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

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

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

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

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

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

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

SECTION 14. *And be it further enacted,* That the commissioner may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the treasury, as other patent moneys are directed to be paid. [See Revised Statutes, Section 485.]

SECTION 15. *And be it further enacted,* That there shall be purchased, for the use of said office, a library of such scien-

tific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated by Congress for that purpose. [See Revised Statutes, Section 486.]

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

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

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

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

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

SECTION 21. *And be it further enacted,* That all patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the commissioner, and they shall be recorded, together with the specifica-

tion, in said office, in books to be kept for that purpose. [See Revised Statutes, Section 4883.]

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

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

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

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

shortest term ; but in no case shall it be in force more than seventeen years. [See Revised Statutes, Section 4887.]

SECTION 26. *And be it further enacted*, That before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the commissioner, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same ; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle so as to distinguish it from other inventions ; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery ; and said specification and claim shall be signed by the inventor and attested by two witnesses. [See Revised Statutes, Section 4888.]

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

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

SECTION 29. *And be it further enacted*, That in all cases which admit of representation by model, the applicant, if required by the commissioner, shall furnish one of convenient size to exhibit advantageously the several parts of his invention or discovery. [See Revised Statutes, Section 4891.]

SECTION 30. *And be it further enacted*, That the applicant

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

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

SECTION 32. *And be it further enacted*, That all applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the commissioner that such delay was unavoidable. [See Revised Statutes, Section 4894.]

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

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

SECTION 35. *And be it further enacted,* That any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who has failed to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application: *Provided,* That the second application be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent, as aforesaid, was ordered to issue, prior to the issue thereof: *And provided further,* That when an application for a patent has been rejected or withdrawn, prior to the passage of this act, the applicant shall have six months from the date of such passage to renew his application, or to file a new one; and if he omit to do either, his application shall be held to have been abandoned. Upon the hearing of such renewed applications abandonment shall be considered as a question of fact. [See Revised Statutes, Section 4897.]

SECTION 36. *And be it further enacted,* That every patent or any interest therein shall be assignable in law, by an instru-

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

SECTION 37. *And be it further enacted,* That every person who may have purchased of the inventor, or with his knowledge and consent may have constructed any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or sold or used one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. [See Revised Statutes, Section 4899.]

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

SECTION 39. *And be it further enacted,* That if any person shall, in any manner, mark upon any thing made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor, without the consent of such patentee, or his assigns or legal representatives; or shall in any manner mark

upon or affix to any such patented article the word "patent" or "patentee," or the words "letters-patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives: or shall in any manner mark upon or affix to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, he shall be liable for every such offence to a penalty of not less than one hundred dollars, with costs; one moiety of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offence may have been committed. [See Revised Statutes, Section 4901.]

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

of his caveat, and made oath of his intention to become a citizen. [See Revised Statutes, Section 4902.]

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

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

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

SECTION 44. *And be it further enacted,* That the clerk of any court of the United States, for any district or territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or his agent or attorney, issue [a] subpoena for any witness residing or being within said district or terri-

cory, commanding him to appear and testify before any officer in said district or territory authorized to take depositions and affidavits, at any time and place in the subpoena stated ; and if any witness, after being duly served with such subpoena, shall neglect or refuse to appear, or after appearing shall refuse to testify, the judge of the court whose clerk issued the subpoena, may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience as in other like cases. [See Revised Statutes, Sections 4906 and 4908.]

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

SECTION 46. *And be it further enacted,* That every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interference[s], in such case to the board of examiners-in-chief, having once paid the fee for such appeal provided by law. [See Revised Statutes, Section 4909.]

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

SECTION 48. *And be it further enacted,* That if such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court

of the District of Columbia, sitting in banc. [See Revised Statutes, Section 4911.]

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

SECTION 50. *And be it further enacted,* That it shall be the duty of said court, on petition, to hear and determine such appeal, and to revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint, notifying the commissioner of the time and place of hearing; and the revision shall be confined to the points set forth in the reasons of appeal. And after hearing the case, the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. [See Revised Statutes, Section 4914.]

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

SECTION 52. *And be it further enacted,* That whenever a patent on application is refused, for any reason whatever,

either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity ; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. [See Revised Statutes, Section 4915.]

SECTION 53. *And be it further enacted,* That whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such a patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or assignment of the whole or any undivided part of the original patent, to his executors, administrators, or assigns, for the unexpired part of the term of the original patent, the surrender of which shall take effect upon the issue of the amended patent ; and the commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters-patent. And the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. And the patent so reissued, together with the corrected speci-

fication, shall have the effect and operation in law, on the trial of all actions for causes thereafter arising, as though the same had been originally filed in such corrected form ; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other ; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. [See Revised Statutes, Section 4916.]

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

SECTION 55. *And be it further enacted*, That all actions, suits, controversies, and cases arising under the patent laws of the United States shall be originally cognizable, as well in equity as at law, by the circuit courts of the United States, or any district court having the powers and jurisdiction of a circuit court, or by the Supreme Court of the District of Colum-

bia, or of any territory ; and the court shall have power, upon bill in equity filed by any party aggrieved, to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable ; and upon a decree being rendered in any such case for an infringement, the *claimant* [complainant] shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction, and the court shall have the same powers to increase the same in its discretion that are given by this act to increase the damages found by verdicts in actions upon the case ; but all actions shall be brought during the term for which the letters-patent shall be granted or extended, or within six years after the expiration thereof. [See Revised Statutes, Section 629, ¶ 9, and Section 4921.]

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

SECTION 57. *And be it further enacted*, That written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters-patent under the signature of the commissioner or acting commissioner, with the seal of office affixed, shall be competent evidence in all cases wherein the originals could be evidence, and any person making application therefor, and paying the fee required by law, shall have certified copies thereof. And copies of the specifications and drawings of foreign letters-patent, certified in like manner, shall be *primâ facie* evidence of the fact of the granting of such foreign letters-patent, and of the date

and contents thereof. [See Revised Statutes, Sections 892 and 893.]

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

SECTION 59. *And be it further enacted,* That damages for the infringement of any patent may be recovered by action on the case in any circuit court of the United States, or district court exercising the jurisdiction of a circuit court, or in the Supreme Court of the District of Columbia, or of any Territory, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict shall be rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. [See Revised Statutes, Section 629, ¶ 9, and Section 4919.]

SECTION 60. *And be it further enacted,* That whenever, through inadvertence, accident, or mistake, and without any wil[1]ful default or intent to defraud or mislead the public, a patentee shall have (in his specification) claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the

original and first inventor or discoverer as aforesaid, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bonâ fide his own, provided it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the parts so claimed, without right as aforesaid, notwithstanding the specifications may embrace more than that of which the patentee was the original or first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit; nor shall he be entitled to the benefits of this section if he shall have unreasonably neglected or delayed to enter said disclaimer. [See Revised Statutes, Section 4922.]

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

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

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

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

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

Fifth. That it had been in public use or on sale in this

country, for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defences may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. [See Revised Statutes, Section 4920.]

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

SECTION 63. *And be it further enacted,* That where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of his patent beyond the original term of its limitation, he shall make application therefor, in writing, to the commissioner, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of said invention or discovery. And said application shall be filed not more than six months nor less than ninety days before the expiration of the

original term of the patent ; and no extension shall be granted after the expiration of said original term. [See Revised Statutes, Section 4924.]

SECTION 64. *And be it further enacted,* That upon the receipt of such application, and the payment of the duty required by law, the commissioner shall cause to be published in one newspaper in the city of Washington, and in such other papers published in the section of the country most interested adversely to the extension of the patent as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. [See Revised Statutes, Section 4925.]

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

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

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

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

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

On issuing each original patent, twenty dollars.

On filing each caveat, ten dollars.

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

On filing each disclaimer, ten dollars.

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

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

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

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

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

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

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

SECTION 69. *And be it further enacted,* That patent fees may be paid to the commissioner, or to the treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor. And all money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the treasury as received, without any deduction whatever ; and all disbursements for said office shall be made

by the disbursing clerk of the Interior Department. [See Revised Statutes, Sections 496 and 4935.]

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

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

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

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

SECTION 74. *And be it further enacted*, That patentees of designs issued prior to March two, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents

for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries issued prior to the second day of March, eighteen hundred and sixty-one. [See Revised Statutes, Section 4932.]

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

For three years and six months, ten dollars.

For seven years, fifteen dollars.

For fourteen years, thirty dollars.

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

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

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

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

and punishable under any of said acts, and all penalties and forfeitures created thereby and incurred before this act takes effect, may be prosecuted, sued for, and recovered, and such offences punished according to the provision of said acts, which are continued in force for such purpose.

APPROVED July 8, 1870.

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

PATENT ACT OF MARCH 3, 1871.

16 STATUTES AT LARGE, 583.

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

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

APPROVED March 3, 1871.

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

PATENT ACT OF MARCH 24, 1871.

17 STATUTES AT LARGE, 2.

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

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That if, in the judgment of the joint committee on printing, the provisions of the joint resolution providing for publishing specifications and drawings of the Patent Office, approved January eleventh, eighteen hundred and seventy-one, can be

performed under the direction of the Commissioner of Patents more advantageously than in the manner provided in said joint resolution, it shall be so done, under such limitations and conditions as the joint committee on printing may from time to time prescribe.

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

APPROVED March 24, 1871.

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

THE REVISED STATUTES

RELATING TO PATENTS.

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

* * * * *

In the Patent Office :

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Fifth. Patents for inventions. [See prior patent statutes : Section 1, 1870 ; Section 2, 1849.]

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

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

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

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

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

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

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

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

SECTION 480. All officers and employés of the Patent-Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the Office. [See prior patent statutes : Section 16, 1870.]

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

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

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

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

SECTION 485. The Commissioner of Patents may restore to the respective applicants such of the models belonging to

rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the Treasury, as other patent-moneys are directed to be paid. [See prior patent statutes : Section 14, 1870 ; Section 5, 1861.]

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

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

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

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

SECTION 490. The Commissioner of Patents is authorized to have printed, from time to time, for gratuitous distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent hereafter issued, together with suitable indexes, one copy to be placed for free public inspection in each capitol of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or territorial capitols, and one in the Library of Congress, which copies shall be cer-

tified under the hand of the Commissioner and seal of the Patent-Office, and shall not be taken from the depositories for any other purpose than to be used as evidence. [See Joint Resolution No. 5, January 11, 1871, 16 Statutes at Large, 590.]

SECTION 491. The Commissioner of Patents is authorized to have printed such additional numbers of copies of specifications and drawings, certified as provided in the preceding section, at a price not to exceed the contract price for such drawings, for sale, as may be warranted by the actual demand for the same ; and he is also authorized to furnish a complete set of such specifications and drawings to any public library which will pay for binding the same into volumes to correspond with those in the Patent-Office, and for the transportation of the same, and which shall also provide for proper custody for the same, with convenient access for the public thereto, under such regulations as the Commissioner shall deem reasonable. [See Joint Resolution No. 5, January 11, 1871, 16 Statutes at Large, 590.]

SECTION 492. The lithographing and engraving required by the two preceding sections shall be awarded to the lowest and best bidders for the interests of the Government, due regard being paid to the execution of the work, after due advertising by the Congressional Printer, under the direction of the Joint Committee on Printing ; but the Joint Committee on Printing may empower the Congressional Printer to make immediate contracts for engraving, whenever, in their opinion, the exigencies of the public service will not justify waiting for advertisement and award ; or if, in the judgment of the Joint Committee on Printing, the work can be performed under the direction of the Commissioner of Patents more advantageously than in the manner above prescribed, it shall be so done, under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe. [See Joint Resolution No. 5, January 11, 1871, 16 Statutes at Large, 590, and Section 1 of Patent Act of March 24, 1871.]

SECTION 493. The price to be paid for uncertified printed copies of specifications and drawings of patents shall be deter-

mined by the Commissioner of Patents, within the limits of ten cents as the minimum and fifty cents as the maximum price. [See prior patent statute : Section 1, March 24, 1871.]

SECTION 494. The Commissioner of Patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever ; a detailed statement of all expenditures for contingent and miscellaneous expenses ; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents ; an alphabetical list of all the patentees, with their places of residence ; a list of all patents which have been extended during the year ; and such other information of the condition of the Patent-Office as may be useful to Congress or the public. [See prior patent statutes : Section 9, 1870 ; Section 14, 1837 ; Section 1, July 3, 1832.]

SECTION 496. All disbursements for the Patent-Office shall be made by the disbursing clerk of the Interior Department. [See prior patent statutes : Section 69, 1870 ; Section 14, 1837.]

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

Ninth. Of all suits at law or in equity arising under the patent or copyright laws of the United States. [See prior patent statutes : Section 55, 1870 ; Section 14, 1836 ; Section 1, 1819.]

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

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

SECTION 892. Written or printed copies of any records,

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

SECTION 893. Copies of the specifications and drawings of foreign letters-patent, certified as provided in the preceding section, shall be *prima-facie* evidence of the fact of the granting of such letters-patent, and of the date and contents thereof. [See prior patent statute : Section 57, 1870.]

SECTION 894. The printed copies of specifications and drawings of patents, which the Commissioner of Patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained. [See Joint Resolution No. 5, January 11, 1871 ; 16 Statutes at Large, 590.]

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

SECTION 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose. [See prior pat-

ent statutes : Section 21, 1870 ; Section 5, 1836 ; Section 1, 1793 ; Section 1, 1790.]

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

SECTION 4885. Every patent shall bear date as of a day not later than six months from the time at which it was passed and allowed and notice thereof was sent to the applicant or his agent ; and if the final fee is not paid within that period the patent shall be withheld. [See prior patent statutes : Section 23, 1870 ; Section 3, 1863 ; Section 8, 1836.]

SECTION 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor. [See prior patent statutes : Section 24, 1870 ; Sections 6 and 7, 1836 ; Section 1, 1800 ; Section 1, 1793.]

SECTION 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a

foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years. [See prior patent statutes : Section 25, 1870 ; Section 6, 1839 ; Section 8, 1836.]

SECTION 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent-Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same ; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions ; and he shall particularly point out and distinctly claim, the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses. [See prior patent statutes : Section 26, 1870 ; Section 6, 1836 ; Section 1, 1793 ; Section 2, 1790.]

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

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

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

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

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

SECTION 4894. All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable. [See prior patent statutes : Section 32, 1870 ; Section 12, 1861.]

SECTION 4895. Patents may be granted and issued or re-issued to the assignee of the inventor or discoverer ; but the assignment must first be entered of record in the Patent-Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer ; and in all cases of an application for a re-issue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July, eighteen hundred and seventy. [See prior patent statutes : Section 33, 1870 ; Section 6, 1837.]

SECTION 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate ; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his life time ; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them. [See prior patent statutes : Section 34, 1870 ; Section 10, 1836 ; Section 2, 1800.]

SECTION 4897. Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was

ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact. [See prior patent statutes : Section 35, 1870 ; Section 1, 1865 ; Section 1, 1864.]

SECTION 4898. Every patent or any interest therein shall be assignable in law, by an instrument in writing ; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent-Office within three months from the date thereof. [See prior patent statutes : Section 36, 1870 ; Section 11, 1836 ; Section 4, 1793.]

SECTION 4899. Every person who purchases of the inventor or discoverer, or with his knowledge and consent constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. [See prior patent statutes : Section 37, 1870 ; Section 7, 1839.]

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

patent statutes : Section 38, 1870 ; Section 13, 1861 ; Section 6, 1842.]

SECTION 4901. Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives ; or

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

Who, in any manner, marks upon or affixes to any unpatented article the word " patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offence, to a penalty of not less than one hundred dollars, with costs ; one half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States, within whose jurisdiction such offence may have been committed. [See prior patent statutes : Section 39, 1870 ; Section 5, 1842.]

SECTION 4902. Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the Patent-Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof ; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by

mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto ; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen. [See prior patent statutes : Section 40, 1870 ; Section 9, 1861 ; Section 12, 1836.]

SECTION 4903. Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification ; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case. [See prior patent statutes : Section 41, 1870 ; Section 7, 1836.]

SECTION 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe. [See prior patent statutes : Section 42, 1870 ; Section 8, 1836 ; Section 9, 1793.]

SECTION 4905. The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent-Office, and such affidavits and depositions may be taken before any officer authorized by law to take

depositions to be used in the courts of the United States, or of the State where the officer resides. [See prior patent statutes : Section 43, 1870 ; Section 1, March 3, 1861 ; Section 12, 1839.]

SECTION 4906. The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent-Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him. [See prior patent statutes : Section 44, 1870 ; Section 1, 1861.]

SECTION 4907. Every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States. [See prior patent statutes : Section 45, 1870 ; Section 1, 1861.]

SECTION 4908. Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and travelling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena ; nor for refusing to disclose any secret invention or discovery made or owned by himself. [See prior patent statutes : Sections 44 and 45, 1870 ; Section 1, 1861.]

SECTION 4909. Every applicant for a patent or for the re-issue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-

in-chief ; having once paid the fee for such appeal. [See prior patent statutes : Section 46, 1870 ; Section 1, 1866.]

SECTION 4910. If such party is dissatisfied with the decision of the examiners-in chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person. [See prior patent statutes : Section 47, 1870 ; Section 2, 1861.]

SECTION 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc. [See prior patent statutes : Section 48, 1870 ; Section 1, 1852 ; Section 11, 1839.]

SECTION 4912. When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent-Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing. [See prior patent statute : Section 49, 1870.]

SECTION 4913. The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded. [See prior patent statute : Section 51, 1870.]

SECTION 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint ; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its pro-

ceedings and decision, which shall be entered of record in the Patent-Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. [See prior patent statute : Section 50, 1870.]

SECTION 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity ; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent-Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner ; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. [See Revised Statutes and prior patent statutes : Section 52, 1870 ; Section 10, 1839.]

SECTION 4916. Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the

unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a re-issue for each of such re-issued letters-patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so re-issued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form ; but no new matter shall be introduced into the specification, nor in case of a machine-patent shall the model or drawings be amended, except each by the other ; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. [See prior patent statutes : Section 53, 1870 ; Sections 5 and 8, 1837 ; Section 13, 1836 ; Section 3, 1832.]

SECTION 4917. Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented ; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent-Office ; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under

him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. [See prior patent statutes : Section 54, 1870 ; Section 7, 1837.]

SECTION 4918. Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent ; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. [See prior patent statutes : Section 58, 1870 ; Section 16, 1836.]

SECTION 4919. Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. [See prior patent statutes : Section 55, 1870 ; Section 14, 1836 ; Section 3, 1800 ; Section 5, 1793 ; Section 4, 1790.]

SECTION 4920. In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters :

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent-

Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect ; or,

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

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

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

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

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used ; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defences may be pleaded in any suit in equity for relief against an alleged infringement ; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. [See prior patent statutes : Section 61, 1870 ; Section 15, 1836 ; Section 6, 1793 ; Section 6, 1790.]

SECTION 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable ; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the dam-

ages the complainant has sustained thereby ; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case. [See prior patent statutes : Section 55, 1870 ; Section 17, 1836 ; Section 1, 1819.]

SECTION 4922. Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bonâ fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent-Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. [See prior patent statutes : Section 60, 1870 ; Section 9, 1837.]

SECTION 4923. Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. [See prior patent statutes : Section 62, 1870 ; Section 15, 1836.]

SECTION 4924. Where the patentee of any invention or dis-

covery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of this patent beyond the original term of its limitation, he shall make application therefor, in writing, to the Commissioner of Patents, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of the invention or discovery. Such application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of the original term. [See prior patent statutes: Section 63, 1870; Section 1, 1848; Section 18, 1836; Section 2, July 3, 1832.]

SECTION 4925. Upon the receipt of such application, and the payment of the fees required by law, the Commissioner shall cause to be published in one newspaper in the city of Washington, and in such other papers published in the section of the country most interested adversely to the extension of the patent as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. [See prior patent statutes: Section 64, 1870; Section 18, 1836.]

SECTION 4926. Upon the publication of the notice of an application for an extension, the Commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make the Commissioner a full report of the case, stating particularly whether the invention or discovery was new and patentable when the original patent was granted. [See prior patent statutes: Section 65, 1870; Section 1, 1848; Section 18, 1836.]

SECTION 4927. The Commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence produced, both for and against the extension;

and if it shall appear to the satisfaction of the Commissioner that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the Commissioner shall make a certificate thereon, renewing and extending the patent for the term of seven years from the expiration of the first term. Such certificate shall be recorded in the Patent-Office ; and thereupon such patent shall have the same effect in law as though it had been originally granted for twenty-one years. [See prior patent statutes : Section 66, 1870 ; Section 18, 1836.]

SECTION 4928. The benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented, to the extent of their interest therein. [See prior patent statutes : Section 67, 1870 ; Section 18, 1836.]

SECTION 4929. Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief ; any new and original design for the printing of woollen, silk, cotton, or other fabrics ; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture ; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor. [See prior patent statutes : Section 71, 1870 ; Section 11, March 2, 1861 ; Section 3, 1842.]

SECTION 4930. The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. [See prior patent statute : Section 72, 1870.]

SECTION 4931. Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. [See prior patent statutes : Section 73, 1870 ; Section 11, 1861 ; Section 3, 1842.]

SECTION 4932. Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty-one. [See prior patent statutes : Section 74, 1870 ; Section 11, March 2, 1861.]

SECTION 4933. All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this Title, shall apply to patents for designs. [See prior patent statute : Section 76, 1870.]

SECTION 4934. The following shall be the rate for patent-fees :

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

On issuing each original patent, except in design cases, twenty dollars.

In design cases : For three years and six months, ten dollars ; for seven years, fifteen dollars ; for fourteen years, thirty dollars.

On filing each caveat, ten dollars.

On every application for the re-issue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

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

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

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

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

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

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

For copies of drawings, the reasonable cost of making them. [See prior patent statutes: Section 2, March 24, 1871; Sections 68 and 75, 1870; Section 1, 1866; Section 10, March 2, 1861; Section 2, 1848; Section 8, 1839; Sections 4, 9, 11, 1836; Section 11, 1793; Section 7, 1790.]

SECTION 4935. Patent-fees may be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the designated depositories, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent-Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever. [See prior patent statutes: Section 69, 1870; Section 14, 1837.]

SECTION 4936. The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or depository, to the credit of the Treasury, as for fees accruing at the Patent-Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents. [See prior patent statutes: Section 69, 1870; Section 1, 1842.]

APPROVED June 22, 1874.

PATENT ACT OF FEBRUARY 16, 1875.

18 STATUTES AT LARGE, PART 3, 316.

Section 2 of an Act to facilitate the disposition of cases in the Supreme Court of the United States, and for other purposes.

SECTION 2. The said [circuit] courts, when sitting in equity

for the trial of patent causes, may empanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises, as may from time to time be made by the Supreme Court, and submit to them such questions of fact arising in such cause as such circuit court shall deem expedient; and the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with such findings.

APPROVED February 16, 1875.

PATENT ACT OF 1887.

24 STATUTES AT LARGE, CHAP. 105.

An Act to amend the law relating to patents, trade-marks and copyright.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That hereafter, during the term of letters patent for a design, it shall be unlawful for any person, other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall without the license of the owner, have been applied, knowing that the same has been so applied.

Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of two hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars.

And the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any circuit court of the United States, having jurisdiction of the parties, either by action at law, or upon a bill in equity for an injunction to restrain such infringement.

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

APPROVED February 4, 1887.

PATENT ACT OF 1888.

25 STATUTES AT LARGE, CHAP. 15.

An Act to amend section four thousand eight hundred and eighty-three of the Revised Statutes, to enable the Assistant Secretary of the Interior to sign patents.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section four thousand eight hundred and eighty-three of the Revised Statutes is hereby amended by inserting after the words "Secretary of the Interior," where they occur therein, the following words: "or under his direction by one of the Assistant Secretaries of the Interior," so that the said section as amended will read as follows:

"SECTION 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior, or under his direction by one of the Assistant Secretaries of the Interior, and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose."

APPROVED February 18, 1888.

JUDICIARY ACT OF 1891.*

26 STATUTES AT LARGE, CHAP. 517.

As Amended February 18, 1895.

28 STATUTES AT LARGE, CHAP. 96.

An Act to establish Circuit Courts of Appeals, and to define and regulate in certain cases the jurisdiction of the Courts of the United States, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress Assembled,

SECTION 6. That the Circuit Courts of Appeals, established by this act, shall exercise appellate jurisdiction to review by appeal or by writ of error final, decisions in the District Courts and the existing Circuit Courts, unless otherwise provided by law, and the judgments or decrees of the Circuit Courts of Appeals shall be final in all cases arising under the patent laws, excepting that in every such subject within its appellate jurisdiction, the Circuit Court of Appeals at any time may certify to the Supreme Court of the United States any questions or propositions of law concerning which it desires the instruction of that court for its proper decision. And thereupon the Supreme Court may either give its instruction on the questions and propositions certified to it, which shall be binding upon the Circuit Courts of Appeals in such case, or it may require that the whole record and cause may be sent up to it for its consideration, and thereupon shall decide the whole matter in controversy in the same manner as if it had been brought there for review by writ of error or appeal. And excepting also that in any such case as is hereinbefore made final in the Circuit Court of Appeals, it shall be competent for the Supreme Court to require, by certiorari or otherwise, any such case to be certified to the Supreme Court for its review and determination, with the same power and authority in the case as if it had been carried by appeal or writ of error to the Supreme Court.

* The parts which are not relevant to patent cases are omitted.

SECTION 7. That where, upon a hearing in equity in a District Court or a Circuit Court, an injunction shall be granted, continued, refused, or dissolved by an interlocutory order or decree, or an application to dissolve an injunction shall be refused, in a case in which an appeal from a final decree may be taken under the provisions of this Act to the Circuit Court of Appeals, an appeal may be taken from such interlocutory order or decree, granting, continuing, refusing, dissolving or refusing to dissolve an injunction, to the Circuit Court of Appeals; *Provided*, That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed, unless otherwise ordered by that court during the pendency of such appeal; *And provided* further that the court below may in its discretion require as a condition of the appeal, an additional injunction bond.

SECTION 10. And whenever on appeal or writ of error or otherwise, a case coming from a Circuit Court of Appeals shall be reviewed and determined in the Supreme Court, the cause shall be remanded by the Supreme Court to the proper District or Circuit Court, for further proceedings in pursuance of such determination. Whenever on appeal or writ of error or otherwise a case coming from a District or Circuit Court shall be reviewed and determined in the Circuit Court of Appeals, in a case in which the decision in the Circuit Court of Appeals is final, such cause shall be remanded to the said District or Circuit Court, for further proceedings to be there taken in pursuance of such determination.

SECTION 11. That no appeal or writ of error by which any order, judgment, or decree may be reviewed in the Circuit Courts of Appeals under the provisions of this Act, shall be taken or sued out except within six months after the entry of the order, judgment, or decree sought to be reviewed. And all provisions of law now in force regulating the methods and system of review, through appeals or

writs of error, shall regulate the methods and system of appeals and writs of error provided for in this act in respect of the Circuit Courts of Appeals, including all provisions for bonds or other securities to be required and taken on such appeals and writs of error, and any judge of the Circuit Courts of Appeals, in respect of cases brought or to be brought to that court, shall have the same powers and duties as to the allowance of appeals or writs of error, and the conditions of such allowance, as now by law belong to the justices or judges in respect of the existing courts of the United States respectively.

SECTION 14. And all acts and parts of acts relating to appeals or writs of error inconsistent with the provisions for review by appeals or writs of error in the preceding sections five and six of this act are hereby repealed.

SECTION 15. That the Circuit Court of Appeals in cases in which the judgments of the Circuit Courts of Appeals are made final by this act shall have the same appellate jurisdiction, by writ of error or appeal, to review the judgments, orders, and decrees of the Supreme Courts of the several Territories as by this act they may have to review the judgments, orders, and decrees of the District Courts and Circuit Courts; and for that purpose the several Territories shall, by order of the Supreme Court, to be made from time to time, be assigned to particular circuits.

APPROVED March 3, 1891.

JUDICIARY ACT OF 1893.*

27 STATUTES AT LARGE, CHAP. 74.

AN ACT to establish a Court of Appeals for the District of Columbia, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That there shall be, and there is hereby, established in the District of Columbia a court, to be known as the Court of Appeals of the District of Columbia, which shall consist of

* All parts not relevant to patent law, are omitted.

one chief justice and two associate justices, who shall be appointed by the President, by and with the advice and consent of the Senate, and shall hold office during good behavior.

SECTION 7. That any party aggrieved by any final order, judgment, or decree of the Supreme Court of the District of Columbia, or of any justice thereof, may appeal therefrom to the Court of Appeals hereby created; and upon such appeal the Court of Appeals shall review such order, judgment, or decree, and affirm, reverse, or modify the same as shall be just. Appeals shall also be allowed to said Court of Appeals from all interlocutory orders of the Supreme Court of the District of Columbia, or by any justice thereof, whereby the possession of property is changed or affected, such as orders for the appointment of receivers, granting injunctions, dissolving writs of attachment, and the like; and also from any other interlocutory order, in the discretion of said Court of Appeals, whenever it is made to appear to said court upon petition that it will be in the interest of justice to allow such appeal.

SECTION 8. That any final judgment or decree of the said Court of Appeals may be re-examined and affirmed, reversed or modified by the Supreme Court of the United States, upon writ of error or appeal, in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent.

SECTION 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals.

APPROVED February 9, 1893.

FORMS OF PATENT PLEADINGS.

DECLARATION.

CIRCUIT COURT OF THE UNITED STATES,
FOR THE DISTRICT OF CONNECTICUT.

OF THE SEPTEMBER TERM OF THE YEAR EIGHTEEN HUNDRED AND
NINETY-FIVE.

DISTRICT OF CONNECTICUT, *ss.*

THOMAS TRACY, of Hartford, Connecticut, who is a citizen of the State of Connecticut, and of the United States, plaintiff in this suit, by John Jay, his attorney, complains of the Atherton Electric Company, which is a corporation created and existing in due form of law in the State of Connecticut, defendant, of a plea of trespass on the case.

For that, Samuel Sinclair, of New Haven, Connecticut, before and at the time of his application for the hereinafter mentioned letters patent, was a citizen of the United States, and was the true original and first inventor of a certain new and useful machine, fully described in the specification of the letters patent hereinafter mentioned, and named therein an "Improved Dynamo," and which was not known or used in this country, and not patented or described in any printed publication in this or in any foreign country, before his invention thereof; and was not in public use or on sale, in this country, more than two years prior to his application for letters patent of the United States therefor.

And for that, heretofore, to wit: on the first day of June, 1878, and before the issuing of the hereinafter mentioned

letters patent, the said Samuel Sinclair, by an instrument in writing duly executed and delivered by him, and bearing date on the last named day, did assign to Rufus Russell, of Meriden, Connecticut, all the right, title, and interest whatever in said invention; and for that, said instrument in writing was duly recorded in the Patent Office on the tenth day of June, 1878.

And for that, on the sixteenth day of July, 1878, letters patent No. 206,206 for said invention, in due form of law, were, on the application of said Samuel Sinclair, issued and delivered to said Rufus Russell, in the name of the United States of America, and under the seal of the Patent Office of the United States, and were signed by the Secretary of the Interior of the United States, and countersigned by the Commissioner of Patents; and for that, said letters patent did grant to said Rufus Russell, his heirs or assigns, for the term of seventeen years, the exclusive right to make, use, and vend the said invention, throughout the United States, and the Territories thereof; and which letters patent the plaintiff now brings here into court.

And the plaintiff says, that the said Rufus Russell, before the committing of the grievances hereinafter mentioned, to wit: on the sixteenth day of September, 1880, by a certain instrument in writing, duly executed and delivered by him, and bearing date on said last mentioned day, did assign to the said plaintiff, the entire right, title, and interest in and to the then unexpired portion of the term of said letters patent, which instrument in writing was recorded in the Patent Office on the thirty-first day of October, 1880.

And the plaintiff further says, that always hitherto, from the time of the execution of the said last mentioned instrument, up to the expiration of the said letters patent, he was the sole owner of said letters patent, and is now the sole owner of all rights of action which arose from any infringement thereof during that time.

And the plaintiff further says, that the said Rufus Russell, and the said plaintiff, and all persons who ever made or sold any specimen of said "Improved Dynamo" for or

under them, or either of them, gave sufficient notice to the public that the same was patented, by fixing thereon the word "patented" together with the day and year the said letters patent were granted.

Yet the defendant, well knowing the premises, but contriving to injure the plaintiff, heretofore, to wit : on and after the first day of January, 1881, and up to and on the sixteenth day of July, 1895, and during and within the term of seventeen years mentioned in said letters patent, and after the execution of the said assignment to the plaintiff, and before the bringing of this suit, and within the United States, unlawfully, wrongfully, and injuriously, and with intent to deprive the plaintiff of the royalties which he might and otherwise would have derived from the sale of licenses to make and use and sell specimens of said machine, and without the license of the plaintiff or of the said Rufus Russell, and against the will of the plaintiff, did make, and did use, and did sell, and did cause to be made, and did cause to be used, and did cause to be sold, sundry specimens of said machine, and of machines which contained and employed substantially the invention covered by said letters patent, and particularly pointed out in the third claim thereof, in infringement of the said exclusive rights secured to the said Rufus Russell by the letters patent aforesaid, and assigned by him to the said plaintiff, as hereinbefore set forth, and contrary to the statutes of the United States in such cases made and provided ; whereby the plaintiff has been and is greatly injured, and has been deprived of large royalties which he might and otherwise would have derived from the sale of licenses to make and use and sell specimens of said machine, and has sustained actual damages thereby to the amount of ten thousand dollars.

Wherefore, by force of the statutes of the United States, a right of action has accrued to the said plaintiff to recover the said actual damages, and such additional amount, not exceeding, in the whole, three times the amount of such actual damages, as the court may see fit to adjudge and order, besides costs.

Yet the defendant, though often requested so to do, has never paid the same, nor any part thereof, but has refused, and still refuses so to do, and therefore the plaintiff brings his suit.

JOHN JAY,
Attorney for the Plaintiff.

PLEA IN BAR.

CIRCUIT COURT OF THE UNITED STATES,
FOR THE DISTRICT OF CONNECTICUT.

THOMAS TRACY

v.

THE ATHERTON ELECTRIC COMPANY.

*Trespass on the
Case.*

And the said defendant, by Richard Ray, its attorney, comes and defends the wrong and injury when, etc., and says, that it is not guilty of the supposed grievances above laid to its charge, or any or either of them, or any part thereof, in manner and form as the said plaintiff has above thereof complained against it. And of this the defendant puts itself upon the country.

And for a further plea in this behalf, the defendant says, that the machine covered by the letters patent mentioned in the plaintiff's declaration, was not an invention when produced by the said Samuel Sinclair. And of this the defendant puts itself upon the country.

And for a further plea in this behalf, the defendant says, that the said machine was not novel when produced by the said Samuel Sinclair; for that, a machine substantially identical with it in character, was previously patented in

letters patent of the United States, granted to Mason Montgomery, May 16, 1872; and for that, another like machine was previously described on page 777 of a certain printed book entitled "The Day of the Dynamo," published in London, England, in the year 1873, by William Wright, of Paternoster Row; and for that, still another like machine was previously known and used by Nathan Norris, of Rochester, New York, in said Rochester, in the year 1874. And of this the defendant puts itself upon the country.

And for a further plea in this behalf, the defendant says, that said Samuel Sinclair actually abandoned his said alleged invention, before said letters patent were granted. And this the defendant is ready to verify.

And for a further plea in this behalf, the defendant says, that said alleged invention was in public use in this country more than two years before said Samuel Sinclair made any application for letters patent thereon. And of this the defendant puts itself upon the country.

And for a further plea in this behalf, the defendant says, that the invention covered by said letters patent of July 16, 1878, was previously patented in the republic of France, to said Samuel Sinclair, for fifteen years from August 1, 1877, and that the foreign patent thus granted expired August 1, 1892. And this the defendant is ready to verify.

And for a further plea in this behalf, the defendant says, that the plaintiff's action is barred by Section 1375 of the General Statutes of Connecticut, so far as said action is based upon any alleged doings of the defendant prior to August 10, 1889. And this the defendant is ready to verify.

RICHARD RAY,

Attorney for the Defendant.

REPLICATION.

CIRCUIT COURT OF THE UNITED STATES,
FOR THE DISTRICT OF CONNECTICUT.

THOMAS TRACY

v.

THE ATHERTON ELECTRIC COMPANY.

*Trespass on the
Case.*

And the said plaintiff, as to the said pleas of the said defendant by it above pleaded, of which it has put itself upon the country, doth the like.

And the plaintiff, as to the said plea of the defendant, by it fourthly above pleaded, says that the said Samuel Sinclair did not actually abandon said invention before said letters patent were granted. And of this the plaintiff puts himself upon the country.

And the plaintiff, as to the said plea of the defendant, sixthly above pleaded, says that the invention covered by said letters patent of July 16, 1878, was not previously patented in the republic of France. And of this the plaintiff puts himself upon the country.

And the plaintiff, as to the said plea of the defendant, seventhly above pleaded, says that the defendant fraudulently concealed from the plaintiff, until after August 10, 1889, the existence of that part which accrued prior to that day, of the cause of the plaintiff's action. And this the plaintiff is ready to verify.

JOHN JAY,

Attorney for the Plaintiff.

REJOINDER.

CIRCUIT COURT OF THE UNITED STATES,
FOR THE DISTRICT OF CONNECTICUT.

THOMAS TRACY

v.

THE ATHERTON ELECTRIC COMPANY.

*Trespass on the
Case.*

And the said defendant, as to the said replication of the said plaintiff, to the said fourth and sixth pleas of the said defendant, and of which he hath put himself upon the country, doth the like.

And the said defendant, as to the replication of the plaintiff, to the said seventh plea of the defendant, says that the defendant did not fraudulently conceal from the plaintiff until after August 10, 1889, or at any time, the existence of that part which accrued prior to that day of the alleged cause of the plaintiff's action. And of this the defendant puts itself upon the country.

RICHARD RAY,
Attorney for the Defendant.

SUR-REJOINDER.

CIRCUIT COURT OF THE UNITED STATES,
FOR THE DISTRICT OF CONNECTICUT.

<p style="text-align: center;">THOMAS TRACY</p> <p style="text-align: center;">v.</p> <p style="text-align: center;">THE ATHERTON ELECTRIC COMPANY.</p>	}	<p style="text-align: center;"><i>Trespass on the Case.</i></p>
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And the said plaintiff, as to the said rejoinder of the said defendant, and whereof it hath put itself upon the country, doth the like.

JOHN JAY,
Attorney for the Plaintiff.

BILL OF COMPLAINT.

CIRCUIT COURT OF THE UNITED STATES,
FOR THE DISTRICT OF CONNECTICUT.

To the Judges of the Circuit Court of the United States,
for the District of Connecticut.

IN EQUITY.

THOMAS TRACY, of Hartford, Connecticut, who is a citizen of the State of Connecticut, and of the United States, brings this his bill into this court, against The Atherton Electric Company, which is a corporation created and existing in due form of law in the State of Connecticut.

And thereupon your orator complains and says, on information and belief, that Samuel Sinclair, of New Haven, Connecticut, before and at the time of his application for the hereinafter mentioned letters patent, was a citizen of the United States, and was the true original and first inventor of a certain new and useful machine, fully described in the

specification of the letters patent hereinafter mentioned, and named therein an "Improved Dynamo," and which was not known or used in this country, and not patented or described in any printed publication in this or in any foreign country, before his invention thereof; and was not in public use or on sale, in this country, more than two years prior to his application for letters patent of the United States therefor.

And your orator further shows unto your Honors, on information and belief, that on the first day of June, 1888, and before the issuing of the hereinafter mentioned letters patent, the said Samuel Sinclair, by an instrument in writing duly executed and delivered by him, and bearing date on the last named day, did assign to Rufus Russell, of Meriden, Connecticut, all the right, title and interest whatever in said invention; and that said instrument in writing was duly recorded in the Patent Office on the tenth day of June, 1888.

And your orator further shows, on information and belief, that on the sixteenth day of July, 1888, letters patent No. 386,386, for said invention, in due form of law, were on the application of said Samuel Sinclair, issued and delivered to said Rufus Russell, in the name of the United States of America, and under the seal of the Patent Office of the United States, and were signed by the Secretary of the Interior of the United States, and countersigned by the Commissioner of Patents; and that the said letters patent did grant to the said Rufus Russell, his heirs or assigns, for the term of seventeen years, the exclusive right to make, use and vend the said invention throughout the United States and the Territories thereof; and which letters patent the complainant now brings here into court.

And your orator further shows, that the said Rufus Russell, on the sixteenth day of September, 1888, by a certain instrument in writing, duly executed and delivered by him, and bearing date on said last mentioned day, did assign to your orator the entire right, title, and interest, in and to the then unexpired portion of the term of said letters patent;

and that said instrument in writing was recorded in the Patent Office on the thirty-first day of October, 1888.

And your orator further shows, that always hitherto, from the time of the execution of the said last mentioned instrument, up to the beginning of this action, he was, and that he now is, the sole owner of said letters patent, and is now the sole owner of all rights of action which arose from any infringement thereof, since the execution of the said last mentioned instrument.

And your orator further shows, on information and belief, that the said Rufus Russell and your orator, and all persons who ever made or sold any specimen of said "Improved Dynamo" for or under them, or either of them, gave sufficient notice to the public that the same was patented, by fixing thereon the word "patented," together with the day and year said letters patent were granted.

And your orator further shows, on information and belief, that the said defendant, on and after the first day of January, 1889, and up to the time of the commencement of this action, and during and within the term of seventeen years mentioned in said letters patent, and after the execution of the said assignment to your orator, and before the commencement of this action, and within the United States, unlawfully, wrongfully, and injuriously, with intent to derive profits from making and using and selling specimens of said machine, and to deprive your orator of the royalties which he might and otherwise would have derived from the sale of licenses to make, and use and sell specimens thereof, and without the license of your orator, or of the said Rufus Russell, and against the will of your orator, did make and did use, and did sell, and did cause to be made, and did cause to be used, and did cause to be sold, sundry specimens of said machine, and of machines which contained and employed substantially the invention, covered by said letters patent, and particularly pointed out in the third claim thereof, in infringement of the said exclusive rights secured to the said Rufus Russell, by the letters patent aforesaid, and assigned by him to your orator as here-

inbefore set forth; but how many such specimens the defendant so made, and used, and sold, or caused to be made, and used, and sold, respectively, your orator is ignorant, and cannot set forth; but your orator avers, on information and belief, that the defendant so made, and used, and sold, and caused to be made, and used, and sold, a large number thereof, and that it derived large profits therefrom, but to what amount your orator is ignorant and cannot set forth, and that your orator has been deprived of large royalties by reason of the aforesaid infringement of the defendant, and has thus incurred large damages thereby.

And your orator further shows, that he fears, and has reason to fear, that unless the defendant is restrained by a writ of injunction, issuing out of this court, it will continue to make, and to use, and to sell, numbers of specimens of said machine, and thereby will cause irreparable injury to your orator's aforesaid exclusive rights.

And your orator further shows, on information and belief, that the validity of the said letters patent, has heretofore been uniformly affirmed, after strenuous litigation, by verdicts and judgments at law, and by final decrees in equity, in several of the Circuit Courts of the United States; and that the electric companies of the United States have long generally acquiesced in that validity.

And your orator prays your Honors to grant unto your orator a preliminary, and also a permanent writ of injunction, issuing out of and under the seal of this honorable Court, directed to the said The Atherton Electric Company, and strictly enjoining it and its officers, agents, and employees, not to make, or use, or sell, nor cause to be made, or used, or sold, any machine or apparatus containing or employing the invention covered and secured by said letters patent, and particularly pointed out in the third claim thereof.

And your orator further prays, that the defendant, by a decree of this Court, may be compelled to account for, and pay over to your orator, all the profits which the defendant

has derived, or shall have derived, from any making and using, or from any making and selling, or from any using, of any specimen of the machine covered and secured by said letters patent, and particularly pointed out in the third claim thereof; and also that the defendant be decreed to pay all the damages which your orator has incurred, or shall have incurred, on account of the defendant's infringement of said letters patent; and that the defendant be decreed to also pay the costs of this suit; and that your orator may have such further and other relief, as the equity of the case, or the statutes of the United States, may require, and to this Court may seem just.

To the end, therefore, that the defendant may, if it can, show why your orator should not have the relief hereby prayed, and may (but not under oath, any oath being hereby expressly waived) full, true, direct, and perfect answer make to such of the several interrogatories hereinafter numbered and set forth, as by the note hereinunder written, it is required to answer; that is to say:

1. Whether, after the first day of January, 1889, it made or used, or sold, or caused to be made or used or sold, anywhere in the United States, any specimen of any machine or apparatus which contained or employed the invention covered and secured by said letters patent, and particularly pointed out in the third claim thereof; and if so, how many such specimens it so made, and how many it so sold, and how many it so used, and how long it used the same.

May it please your Honors to grant unto your orator a writ of *subpœna ad respondendum*, issuing out of and under the seal of this Honorable Court, and directed to the said The Atherton Electric Company, and commanding it to appear and make answer to this bill of complaint, and to perform and abide by such order and decree herein, as to this Court shall seem just.

And your orator will ever pray. THOMAS TRACY,
Complainant.

LUTHER LEARNED, JOHN JAY,
Of Counsel. Solicitor for the Complainant.

The defendant, The Atherton Electric Company, is required to answer the interrogatory numbered 1.

JOHN JAY,
Solicitor for the Complainant.

STATE OF CONNECTICUT, COUNTY OF HARTFORD, ss.

On this tenth day of August, 1895, before me personally appeared Thomas Tracy, and made oath that he has read the foregoing bill, subscribed by him, and knows the contents thereof, and that the same is true of his own knowledge, except as to matters which are therein stated to be based on information and belief, and that as to those matters he believes it to be true.

{ L. S. }

ARTHUR ANSON,
Notary Public.

PLEA IN EQUITY.

CIRCUIT COURT OF THE UNITED STATES,
FOR THE DISTRICT OF CONNECTICUT.

THOMAS TRACY

v.

THE ATHERTON ELECTRIC COMPANY.

In Equity.

The plea of The Atherton Electric Company, defendant, to the bill of complaint of Thomas Tracy, complainant.

This defendant, by protestation, not confessing or acknowledging the matters and things in and by said bill set forth and alleged to be true, in such manner and form

as the same are thereby and therein set forth and alleged ; for plea to the whole of said bill, says that, prior to January 1, 1889, the Gray Electric Company, and the Franklin Electric Company, were separate corporations, created and existing in due form of law in the State of Connecticut; and that each had theretofore, on August 1, 1888, purchased, and then possessed, a license in writing executed by said Rufus Russell, authorizing the licensee to make, use and sell any convenient number of specimens of said machine throughout the term of said letters patent ; and that on or about the said January 1, 1889, the said Gray Electric Company and the said Franklin Electric Company, were lawfully consolidated into one corporation, to wit : this defendant.

All which statements this defendant doth aver to be true, and it pleads the said licenses to the said complainant's bill, and prays the judgment of this Honorable Court, whether it should be compelled to make any other or further answer to the said bill, and prays to be hence dismissed with its costs in this behalf sustained.

In witness whereof, the said defendant, The Atherton Electric Company, has hereunto affixed its corporate seal, and caused the same to be attested by Charles Clark, its secretary.

{ L. S. }

CHARLES CLARK,
Secretary.

RICHARD RAY,
Solicitor and Counsel for the Defendant.

I hereby certify that in my opinion the foregoing plea is well founded in point of law.

RICHARD RAY,
Solicitor and Counsel for the Defendant.

STATE OF CONNECTICUT, COUNTY OF HARTFORD, ss.

On this seventh day of October, 1895, before me personally appeared Charles Clark, and made oath that he has

read the above plea, and knows the contents thereof, and that it is not interposed for delay, and that it is true in point of fact.

{ L. S. }

ARTHUR ANSON,
Notary Public.

ANSWER.

CIRCUIT COURT OF THE UNITED STATES,
FOR THE DISTRICT OF CONNECTICUT.

THOMAS TRACY

v.

THE ATHERTON ELECTRIC COMPANY.

In Equity.

The defendant, for answer to the bill of complaint of the complainant, answering, says :

The defendant admits, that it is a corporation created and existing in due form of law in the State of Connecticut.

The defendant denies, on information and belief, that Samuel Sinclair was the true, original, and first inventor of the machine covered by the alleged letters patent mentioned in said bill ; and the defendant says, on information and belief, that said apparatus was not an invention when produced by said Samuel Sinclair ; and that it was not novel at that time, and that an apparatus substantially identical with it in character was previously patented in letters patent of the United States, granted to Mason Montgomery, May 16, 1872 ; and that another like apparatus was previously described on page 777 of a certain printed book entitled "The Day of the Dynamo," published in London, England,

in the year 1873, by William Wright, of Paternoster Row; and that still another like machine was previously known and used by Nathan Norris, of Rochester, New York, in said Rochester, in the year 1874

And the defendant further says, on information and belief, that said Samuel Sinclair actually abandoned his said alleged invention, before said letters patent were granted.

And the defendant further says, on information and belief, that the said alleged invention was in public use, in this country, more than two years before said Samuel Sinclair made any application for letters patent thereon.

And the defendant further says, that it has no knowledge whether the said Samuel Sinclair ever executed and delivered any instrument of assignment to Rufus Russell, purporting to convey the entire right, title, and interest in said alleged invention.

And the defendant further says, that it has no knowledge whether the alleged letters patent for said alleged invention, were ever issued and delivered to said Rufus Russell.

And the defendant further says, that it has no knowledge whether the said Rufus Russell ever executed and delivered any instrument of assignment to the complainant, purporting to convey the entire right, title, and interest in and to the then unexpired portion of the term of said alleged letters patent.

And the defendant further says, on information and belief, that the invention covered by said letters patent of July 16, 1888, and particularly pointed out in the third claim thereof, was previously patented in the republic of France to said Samuel Sinclair, for fifteen years from August 1, 1884, and that the foreign patent thus granted will expire August 1, 1899.

And the defendant further says, that the plaintiff's action is barred by Section 1375 of the General Statutes of Connecticut, so far as said action is based upon any alleged doings of the defendant prior to August 10, 1889.

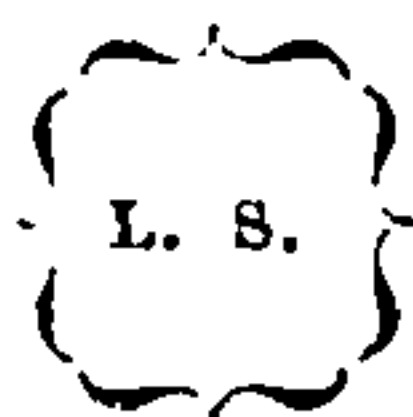
And the defendant denies, on information and belief, that it ever made, or used, or sold, or caused to be made, or

used, or sold, any machine which contained or employed any invention covered by said letters patent; and likewise denies that it ever derived any profit from any such making, or using, or selling; and likewise denies that the complainant ever incurred any damage on account of any such transaction, committed or caused to be committed by the defendant.

The defendant further says, that it has no knowledge whether the validity of any such alleged letters patent has heretofore been uniformly affirmed, after strenuous litigation, by verdicts or judgments at law, or by final decrees in equity, in several of the Circuit Courts of the United States; but the defendant denies, on information and belief, that any such validity has been generally acquiesced in by the electric companies of the United States.

All of which statements and defences this defendant is ready to aver, maintain, and prove, as this Honorable Court shall direct; and it prays hence to be dismissed with its costs in this behalf sustained.

In witness whereof, the said defendant, The Atherton Electric Company, has hereunto affixed its corporate seal, and caused the same to be attested by Charles Clark, its Secretary.



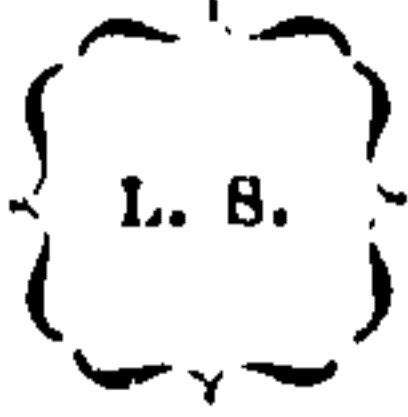
CHARLES CLARK,
Secretary.

RICHARD RAY,
Solicitor and Counsel for the Defendant.

STATE OF CONNECTICUT, COUNTY OF HARTFORD, ss.

On the fourth day of November, 1895, before me personally appeared Charles Clark, and made oath that he has read the foregoing answer, and knows the contents thereof; and that the same is true of his own knowledge, except as to the matters which are therein admitted, or stated to be based on

information and belief, and as to those matters he believes it to be true.



ARTHUR ANSON,

Notary Public.

REPLICATION IN EQUITY.

CIRCUIT COURT OF THE UNITED STATES,

FOR THE DISTRICT OF CONNECTICUT.

THOMAS TRACY

v.

THE ATHERTON ELECTRIC
COMPANY.

In Equity.

This repliant, saving and reserving unto himself all and all manner of advantage of exception to the manifold insufficiencies of the said answer, for replication thereunto saith, that he will aver and prove his said bill to be true, certain, and sufficient in the law to be answered unto; and that the said answer of the said defendant is uncertain, untrue, and insufficient to be replied unto by this repliant; without this, that any other matter or thing whatsoever in the said answer contained, material or effectual in the law to be replied unto, confessed and avoided, traversed or denied, is true; all which matters and things this repliant is, and will be, ready to aver and prove, as this Honorable Court shall direct; and humbly prays, as in and by his said bill he hath already prayed.

JOHN JAY,

Solicitor for the Complainant.

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