

has omitted or failed to prove infringement as having occurred in the district where the suit is pending.¹

§ 390. Where a district contains more than one division, every action for infringement of a patent, which is brought in that district on the ground of the habitation of the defendant therein, must be brought in the division where he resides; and where there are two or more defendants residing in different divisions of a district, such an action, if brought against them in that district, on the ground of their habitation therein, must be brought in one of those divisions.

§ 391. The Court of Claims is the tribunal which has jurisdiction of all actions brought by owners of patent rights against the government of the United States, for compensation for express or implied licenses to the government, to make and use patented inventions.² Such suits are subject to a six year statute of limitation; and in the absence of an established royalty the claimant is entitled to recover what a reasonable royalty for an express license would have been.³ But no implied contract for a royalty arises, where the patentee is an officer of the United States government, making the patented invention in the course of his official duty, at the expense of the government, and for the public service.⁴

§ 392. What remedy a patentee has when the government makes or uses specimens of his patented invention without his consent, is a question which was long debated. The United States cannot be sued, except where it has consented thereto by a statute; and it has now been settled that the Court of Claims has no jurisdiction, under any existing statute, of an infringement suit brought against the United States.⁵

¹ *Streat v. American Rubber Co.*, 115 F. R. 634, 1902.

² *United States v. Burns*, 12 Wallace, 246, 1870; *United States v. Palmer*, 128 U. S. 269, 1888.

³ *United States v. Berdan Fire Arms Co.*, 156 U. S. 569, 1895.

⁴ *Solomons v. United States*, 22 Court of Claims, 342, 1887; *Davis v. United States*, 23 Court of Claims, 334, 1888.

⁵ *Schillinger v. United States*, 155 U. S. 169, 1894.

§ 393. The Court of Claims having no jurisdiction of a case based upon an unauthorized making or using by the government, of a patented invention, it is important to know whether, in such a case, an action will lie against those agents of the government who personally committed the infringement. That question was long unsettled; but the law of the subject can now be deduced from the aggregate of the sources thereof. That law may be formulated as follows.

Where the government, without any license, has made, used or sold the subject of a patent; some action or other will lie against those agents of the government who personally conducted the infringement. Where the infringement consisted in making, or using, or in making and using, a patented machine or other article, without any prospect of making or using any more, or of selling the one thus made or used; that action is an action at law for damages. An action in equity will not lie in such a case; because the patentee is not entitled to an injunction therein, and because a right to an injunction is the only foundation of an action in equity in such a case. Where the infringement consisted in making, or in making and using, or in making and selling a number of specimens of a patented machine or other article, with a prospect of future continuation thereof; an action in equity will lie, because an injunction is proper in such a case, to prevent future manufacture and future sales, though not proper to prevent future use of articles already made by or for the government, and belonging to it. Where the infringement consisted in using a patented process; an action in equity will lie; because an injunction is proper in such a case, to prevent a continuation of infringement, and because such an injunction is not objectionable in depriving the government of the use of any specimen belonging to it, of any patented article.¹

§ 394. The plaintiff or complainant in an action based on an infringement of a patent may be the patentee, or the

¹ *Belknap v. Schild*, 161 U. S. 10, 1896; *Head v. Porter*, 48 F. R. 481, 1891; *International Postal Supply Co. v. Bruce*, 114 F. R. 511, 1902.

sole assignee of that patent; or any grantee under a patent may sue alone, for any infringement committed within his territory.¹ And the plaintiff or complainant may be a partnership, as well as a person or a corporation; and may sue in the partnership name, though that name is an artificial one, quite unlike the names of the partners.²

It is not necessary for the plaintiff, in an action at law, to own any interest in the patent at the time he brings his action. It is enough if he was the patentee, assignee, or grantee of the rights infringed, at the time the infringement sued upon was committed.³ But this rule does not generally apply to actions in equity, for such actions are generally dependent upon an injunction, and no injunction can be granted to restrain future infringements of a patent, on the suit of a person who has no interest in the patent threatened to be infringed.⁴ Though where a complainant owns a patent infringed, when he files his bill for an injunction and a money recovery, jurisdiction will not lapse when he assigns the future of his patent.⁵

§ 395. Actions at law brought by assignees or grantees, for infringements committed prior to the time they obtained title, must, according to the common law, be brought in the name of the person who held the legal title to the patent right when and where it was infringed by the defendant. This rule was not abrogated by the statute which permits suits to be brought by assignees; because the assignees which are contemplated by that statute, are assignees of patents and not assignees of rights of action under patents.⁶

An action in equity, if maintainable at all in such a case, may be brought in the name of the assignee; and such an

¹ Revised Statutes. Section 4919: *Wilson v. Rousseau*, 4 Howard, 646, 1846; *Stein v. Goddard*, 1 McAlister, 82, 1856; *Seibert Oil Cup Co. v. Beggs*, 32 F. R. 790, 1887.

² *Fruit Cleaning Co. v. Fresno Home Packing Co.*, 94 F. R. 847, 1899.

³ *Moore v. Marsh*, 7 Wallace, 515, 1868.

⁴ *Waterman v. Mackenzie*, 138 U. S. 255, 1891.

⁵ *New York Belting Co. v. New Jersey Rubber Co.*, 47 F. R. 505, 1891.

⁶ *Moore v. Marsh*, 7 Wallace, 515, 1868; *Armstrong, Whitworth &*

action will be maintainable where the suit is based on infringements and threatened infringements, committed after the complainant obtained title, as well as upon infringements committed before that event.¹ An action in equity will also be maintainable in such a case, if the assignor of the right of action was a corporation, and has been dissolved or has expired;² or if for any reason it is impossible for the assignee of the right of action to sue in the name of the assignor.³

Where the assignor is dead at the time the assignee desires to bring an action at law, and where no legal representative of the assignor exists, or is likely to exist unless the appointment of one is obtained for the special purpose of using his name as nominal plaintiff in the assignee's suit, it would seem no great stretch of equity jurisdiction to allow the assignee to file a bill in his own name, and thus avoid the useless and expensive circuitry of compelling him first to secure the appointment of an administrator, and then to bring an action at law in the name of the latter. No principle adverse to such a proceeding was perceived by Chief Justice MARSHALL, when, in a similar case of expensive circuitry at law, the more direct and less expensive methods of equity were invoked before him.⁴

§ 396. Where a patentee, assignee, or grantee, who was entitled to sue for an infringement of a patent, died before beginning an action thereon, such an action may be brought by his executor or administrator,⁵ upon his fulfilling the conditions and giving the guarantees of fidelity and solvency required by the law of the State wherein the court is estab-

Co. v. Norton, 15 App. D. C. 232, 1899.

¹ Dibble v. Augur, 7 Blatch. 86, 1869; Henry v. Stove Co., 2 Bann. & Ard. 224, 1876; Gordon v. Anthony, 16 Blatch. 234, 1879; Merriam v. Smith, 11 F. R. 589, 1882; Shaw v. Lead Co., 11 F. R. 715, 1882; Consolidated Oil Well Packer Co. v. Eaton, 12 F. R. 870, 1882.

² Lenox v. Roberts, 2 Wheaton, 373, 1817.

³ Hayward v. Andrews, 106 U. S. 675, 1882.

⁴ Riddle v. Mandeville, 5 Cranch, 329, 1809.

⁵ May v. County of Logan, 30 F. R. 253, 1887.

lished in which the action is proposed to be brought.¹ But it is not certain that, when beginning a patent action in a Federal court in a State other than that of his appointment, an executor or administrator must conform to the conditions, or give the guarantees, prescribed by the local laws.² Whether the various State laws, relevant to foreign executors or administrators suing in State courts, are binding in such cases as these, is a point upon which there appears to be a conflict of authority. The cases last cited appear to support the negative of the question, while those cited just before seem to sustain the affirmative view. It is possible that a distinction may be drawn on this point between actions based on patents and actions arising out of local law and brought into Federal courts on grounds of diverse citizenship. If that distinction is found to be important, it may lead to a decision that executors and administrators may begin and prosecute patent cases in Federal courts in States other than that of their appointment, without any regard to the probate or other analogous laws of those States. If it is held otherwise, then the laws of the States relevant to the conditions upon which foreign executors or administrators are permitted to sue in their courts, will require the attention of the practitioner in such cases. In some States those conditions amount to local probate, and in others they amount to no more than the giving of a bond for costs. But whether onerous or easy, and whether necessary or unnecessary to be regarded in patent cases, an omission to regard them cannot be availed of by a defendant, unless availed of in his pleadings.³

§ 397. Where an executor or administrator of a deceased patentee, or assignee or grantee of a patent right, assigns that right to another, or assigns to another a right of action

¹ *Rubber Co. v. Goodyear*, 9 Wallace, 791, 1869; *Wilkins v. Elliott*, 108 U. S. 256, 1882; *Picquet v. Swan*, 3 Mason, 472, 1824.

² *Hodge v. Railroad Cos.*, 4 Fisher, 162, 1870; *Northwestern*

Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co., 1 Bann. & Ard. 177, 1874.

³ *Rubber Co. v. Goodyear*, 9 Wallace, 791, 1869.

for its infringement, that other can sue thereon in any State, without any proceedings in the nature of local probate, provided he can sue in his own name.¹ Whether he can sue in his own name will depend upon whether he is entitled to an injunction; or if not entitled to an injunction, it will depend upon whether equity can take jurisdiction on some other ground; or if not entitled to sue in equity at all, it will depend upon whether the laws of the particular State authorize assignees of rights of action to bring actions at law in their own respective names.²

§ 398. Patentees and other persons entitled to bring actions for infringements of patents may appoint attorneys in fact to bring those actions in the names of the appointers; but not in the names of the attorneys in fact.³

§ 399. Owners in common of patent rights must sue jointly for their infringement, or the defendant may plead in abatement or demur.⁴ This rule applies where a patentee has assigned an undivided part of his patent,⁵ and also to cases where the owner of the patent has granted an undivided interest therein, in that part of the territory of the United States wherein the infringement sued upon was committed. In the first of these cases the action must be brought by the patentee and assignee jointly; and in the other case it must be jointly brought by the owner of the patent and his grantee. Indeed, the rule necessarily applies to every case where a plurality of persons own the undivided interest in a patent right, whether in the whole, or only in a part of the territory of the United States. And it has been held in one case, that the owner of a patent right in a part of the ter-

¹ *Harper v. Butler*, 2 Peters, 238, 1829; *Trecothick v. Austin*, 4 Mason, 36, 1825; *Leake v. Gilchrist*, 2 Devereaux (N. C.), 73, 1829; *Peterson v. Chemical Bank*, 32 N. Y. 21, 1865; *Riddick v. Moore*, 65 N. C. 382, 1871; *May v. County of Logan*, 30 F. R. 253, 1887.

² *May v. County of Logan*, 30 F. R. 253, 1887.

³ *Goldsmith v. Collar Co.*, 18 Blatch. 82, 1880.

⁴ *Van Orden v. Nashville*, 67 F. R. 332, 1895; *Postal Tel. Cable Co. v. Netter*, 102 F. R. 691, 1900.

⁵ *Moore v. Marsh*, 7 Wallace, 515, 1868; *Waterman v. Mackenzie*, 138 U. S. 255, 1891; *Dick v. Struthers*, 25 F. R. 104, 1885.

ritory of the United States, may join with the owner of the same patent right in another part of that territory, in suing for infringement of the patent in the territory of the latter, on the ground that all the owners of territorial rights under the patent are interested in having it sustained.¹ But there is no occasion for a person who has only an interest in the proceeds of a patent, without having any title in the patent itself, to join in a suit for its infringement.²

§ 400. Licensees under patents cannot bring actions for their infringement.³ Where a person has received an exclusive license to use or to sell a patented invention within a specified territory, all actions at law against persons who, without right, have done anything covered by the license, must be brought in the name of the owner of the patent right, but generally for the use of the licensee;⁴ and all actions in equity must be brought by the owner of the patent right and the exclusive licensees suing together as joint complainants;⁵ even where the license is oral,⁶ or is an incident of a partnership.⁷

But the holder of a license less than exclusive must not join in an action in equity for an infringement of the patent under which he is licensed,⁸ even where the infringement consisted in making and selling one form of the patented

¹ *Otis Mfg. Co. v. Crane Mfg. Co.*, 27 F. R. 558, 1886.

² *Bogart v. Hinds*, 25 F. R. 485, 1885.

³ *Gayler v. Wilder*, 10 Howard, 477, 1850; *Paper-Bag Cases*, 105 U. S. 766, 1881; *Blanchard v. Eldridge*, 1 Wallace, Jr. 337, 1849; *Potter v. Holland*, 4 Blatch. 206, 1858; *Sanford v. Messer*, 1 Holmes, 149, 1872; *Nelson v. McMann*, 4 Bann. & Ard. 203, 1879; *Gamewell Telegraph Co. v. Brooklyn*, 14 F. R. 255, 1882; *Ingalls v. Tice*, 14 F. R. 297, 1882; *Wilson v. Chickering*, 14 F. R. 917, 1883.

⁴ *Littlefield v. Perry*, 21 Wal-

lace, 223, 1874; *Goodyear v. McBurney*, 3 Blatch. 32, 1853; *New York Filtration Co. v. City of Sullivan*, 111 F. R. 181, 1901.

⁵ *Waterman v. Mackenzie*, 138 U. S. 255, 1891; *Hammond v. Hunt*, 4 Bann. & Ard. 113, 1879; *Huber v. Sanitary Depot*, 34 F. R. 752, 1888.

⁶ *Sharpless v. Moseley & Stoddard Mfg. Co.*, 75 F. R. 595, 1896.

⁷ *Chisholm v. Johnson*, 106 F. R. 213, 1901.

⁸ *Blair v. Lippincott Glass Co.*, 52 F. R. 226, 1892; *American Graphophone Co. v. Walcutt*, 87 F. R. 557, 1898.

invention, which the licensee was exclusively licensed to make and sell.¹ And an exclusive licensee who has assigned his license, must not join in an action in equity for an infringement of the patent, even against a defendant who infringed before the license was assigned; for such a person is not entitled to pray for an injunction, and therefore is not entitled to invoke a court of equity to decree a money recovery for past infringement.

Actions at law brought in the name of the owner of a patent right, but actually begun by an exclusive licensee, may be maintained by the latter, even against the will of the nominal plaintiff.² And where an exclusive licensee brings an action in equity in the name of himself and the owner of the patent right, that action may be maintained without the co-operation and even against the objection of the latter.³

Where the owner of a patent is himself an infringer of a licensee's exclusive right to use or to sell the invention covered thereby, no action at law can remedy the wrong. The licensee cannot bring such an action in his own name in that case, any more than in another; and he cannot sue in the name of the wrong-doer, for he would thus make the latter both plaintiff and defendant. Such a state of facts constitutes such an impediment to an action at law as authorizes the licensee to sue the owner of a patent in a court of equity.⁴ And a stranger to the title who joined in the infringement, may be joined with the owner as a defendant.⁵

Where an exclusive licensee, who pays royalties in pro-

¹ *Pope Mfg. Co. v. Clark*, 46 F. R. 792, 1891.

² *Goodyear v. Bishop*, 4 Blatch. 438, 1860.

³ *Brush-Swan Electric Light Co. v. Electric Co.*, 48 F. R. 224, 1891; *Brush Electric Co. v. Electric Co. of San José*, 49 F. R. 73, 1892; *Brush Electric Co. v. California Electric Co.*, 52 F. R. 945, 1892; *Excelsior Wooden-Pipe Co. v. Allen*, 104 F. R. 553, 1900; *Chisholm v. Johnson*, 106 F. R. 212, 1901;

Excelsior Wooden-Pipe Co. v. City of Seattle, 117 F. R. 140, 1902.

⁴ *Littlefield v. Perry*, 21 Wall. 223, 1874; *Root v. Railway Co.*, 105 U. S. 216, 1881; *Rapp v. Kelling*, 41 F. R. 792, 1890; *Adriance v. McCormick Mach. Co.*, 55 F. R. 290, 1893; 56 F. R. 918, 1893; *Smith v. Ridgely*, 103 F. R. 876, 1900.

⁵ *Waterman v. Shipman*, 55 F. R. 986, 1893.

portion to the extent of his use or his sales of the patented invention, allows infringers to use or to sell that invention without interference from him, the owner of the patent right may sue those infringers in his own name and for his own use.¹

§ 401. The defendant in an action for an infringement of a patent may be a natural person, or a partnership. A private corporation may also be held liable as defendant in such an action.² And a receiver, appointed by a State court for an infringing corporation, may be sued for its infringement or for his own infringement as receiver, without the consent of the State court which appointed him.³ Among public corporations, the liability of a city for infringing a patent has been affirmed,⁴ and that of a county has sometimes been affirmed and sometimes denied.⁵ If such a distinction exists between a city and a county, it is founded on the fact that cities are created and exist mainly for the special use of the people who compose them; while counties are subdivisions of States, made for the purposes of political organization, and civil and judicial administration.⁶ The same reasons, if valid, would indicate that organized villages are generally liable for infringements, while ordinary townships are not. The general rule on the subject would then appear to be that cities and villages are liable for infringements of patents, unless the charters or statutes which created or which regulate them, otherwise require or provide, while counties and townships

¹ *Still v. Reading*, 20 O. G. 1026, 1881.

² *York & Maryland Line Railroad Co. v. Winans*, 17 Howard, 30, 1854.

³ *Hupfeld v. Automaton Piano Co.*, 66 F. R. 789, 1895; *Union Switch & Signal Co. v. Philadelphia & Reading Railroad Co.*, 69 F. R. 833, 1895.

⁴ *Bliss v. Brooklyn*, 4 Fisher, 596, 1871; *Asbestine Mfg. Co. v. Hepp*, 39 F. R. 326, 1889.

⁵ *Jacobs v. Hamilton County*, 4 Fisher, 81, 1862; *May v. County of Mercer*, 30 F. R. 246, 1887; *May v. County of Juneau*, 30 F. R. 241, 1887; *May v. County of Logan*, 30 F. R. 260, 1887; *May v. County of Ralls*, 31 F. R. 473, 1887.

⁶ *Ward v. County of Hartford*, 12 Connecticut, 406, 1838; *Commissioners of Hamilton County v. Mighels*, 7 Ohio State, 118, 1857.

are not so liable unless they are made so by the legislative power which called them into being.¹ School districts probably fall in the same category as townships in respect to this sort of liability.² No State can be sued for any infringement of a patent without its statutory consent.³ And it has been held that a State officer is not responsible for any infringement of a patent which occurs in any State work conducted by him, where he did not direct the infringement to be committed, and did not know the fact of infringement till after it was done.⁴

§ 402. Natural persons cannot escape liability for their infringements of patents on the ground that they are minors or married women.⁵ A minor is not less liable to an action because the act of infringement was done at the command of his father;⁶ but if a married woman commits an infringement in the presence of her husband, she is not liable to an action therefor, unless it can be shown that she did it without his influence or consent.⁷ In the absence of such evidence, the husband is alone liable for the torts of the wife which are committed in his presence;⁸ or under his direction;⁹ and for the infringements which are committed jointly by both.¹⁰

§ 403. An agent or salesman who sells or leases specimens of a patented thing, is liable as an infringer for so doing.¹¹ The foreman of a factory is liable for infringements done

¹ *May v. County of Buchanan*, 29 F. R. 473, 1886; *May v. County of Cass*, 30 F. R. 762, 1887.

² *Wilson v. School District*, 32 New Hampshire, 118, 1855.

³ Eleventh Amendment to the Constitution of the United States; *Hans v. Louisiana*, 134 U. S. 17, 1890.

⁴ *Standard Fireproofing Co. v. Toole*, 122 F. R. 652, 1903.

⁵ *Cooley on Torts*, Chapter IV.

⁶ *Humphreys v. Douglass*, 10 Vermont, 71, 1838; *Scott v. Watson*, 46 Maine, 362, 1859.

⁷ *Bishop's Law of Married Women*, Volume 2, Section 258.

⁸ *Bishop's Law of Married Women*, Volume 1, Section 43.

⁹ *American Bell Telephone Co. v. Cushman*, 57 F. R. 844, 1893.

¹⁰ *Green v. Austin*, 22 O. G. 683, 1882.

¹¹ *Potter v. Crowell*, 3 Fisher, 112, 1866; *Maltby v. Bobo*, 14 Blatch. 53, 1876; *Steiger v. Heidelberg*, 4 F. R. 455, 1880; *Cramer v. Fry*, 68 F. R. 207, 1895; *Graham v. Earl*, 82 F. R. 743, 1897.

under his supervision.¹ And any employed person who has derived a distinct and independent benefit from infringing a patent under the direction of his employer, is himself liable to an action based on that infringement.² But a mechanic who, when working for wages, makes or uses a patented thing, or uses a patented process, at the command of his employer, is not liable to an action at law, on that account,³ though he may doubtless be restrained by an injunction from continuing such making or using;⁴ provided his employer is also subject to be thus restrained.⁵ A decree for an account of profits would not be proper in such a case, because a mechanic cannot be said to make any profits from such an infringement. Nor would a decree for damages be any more proper in an action in equity, than would a judgment for damages in an action at law.

§ 404. Whoever directs or requests another to infringe a patent, is himself liable to an action for the resulting infringement, on the principle that what one does by another he does by himself.⁶ So, also, if an infringement is committed by A. B. for the benefit of C. D., but without the knowledge or authority of the latter, the latter will still be liable as an infringer, if he approves the tort after its commission.⁷ An infringement which is committed by an employee in the regular course of his employer's business will also render the latter liable to an action, even if the employer forbade the acts which constituted the infringement,⁸ or even if the em-

¹ *Cahoone Mfg. Co. v. Harness Co.*, 45 F. R. 584, 1891.

² *Palmer v. Landphere*, 99 F. R. 568, 1900; and 118 F. R. 52, 1902.

³ *Delano v. Scott; Gilpin*, 498, 1834; *United Nickel Co. v. Worthington*, 13 F. R. 392, 1882; *Young v. Foerster*, 37 F. R. 203, 1889; *Graham v. Earl*, 82 F. R. 742, 1897.

⁴ *Goodyear v. Mullee*, 5 Blatch. 437, 1867; *Regent Mfg. Co. v.*

Penn. Electrical & Mfg. Co., 121 F. R. 80, 1902.

⁵ *Boston Lasting-Mach. Co. v. Woodward*, 82 F. R. 98, 1897.

⁶ *Green v. Gardner*, 22 O. G. 683, 1882; *Chisholm v. Johnson*, 106 F. R. 207, 1901.

⁷ See *Judson v. Cook*, 11 Barbour (N. Y.), 642, 1852; *Alfred v. Bray*, 41 Missouri, 484, 1867.

⁸ See *Philadelphia & Reading Railroad Co. v. Derby*, 14 Howard, 468, 1852.

ployer did not know that such was the character of those acts.¹

§ 405. It is a general principle of law, that whoever does an act which naturally causes another to commit a tort, is himself liable to an action therefor.² For example, if A. B. unlawfully makes a specimen of a patented thing, and sells it to C. D., a man whose business it is to use things of that class, there is no injustice in holding the former responsible, not only for his own illegal making and selling, but also for the illegal using committed by the latter, for that making and selling naturally resulted in that using. On the other hand, if E. F., a merchant, gives G. H., a manufacturer, an order for a quantity of articles which may be made either with or without a particular patented process or machine, and if G. H. makes those articles with that machine or process, it is clear that E. F. is not liable for that unlawful making.³ But where the articles can be made only by infringing a patent, any merchant who causes them to be made for him is liable to an injunction restraining him from a continuation of his conduct.⁴ And a person who makes plans for infringing machinery, or other subject of a patent, and obtains bids for its manufacture, and receives compensation for work in its erection, is liable as infringer of the patent on the structure thus produced.⁵

§ 406. Where several persons co-operate in any infringement, all those persons are liable therefor as contributors thereto.⁶ In that, as in all cases of torts for which several persons are liable, all may be sued jointly, or any of them may be sued alone.⁷ But where a patentee sues one of sev-

¹ *Wooster v. Marks*, 17 Blatch. 368, 1879; *McKnight v. McNiece*, 64 F. R. 116, 1894.

² *Guille v. Swan*, 19 Johnson (N. Y.), 381, 1822; *Brooks v. Ashburn*, 9 Georgia, 297, 1851; *Lewis v. Johns*, 34 California, 620, 1868; *Smith v. Felt*, 50 Barbour (N. Y.), 612, 1868.

³ *Keplinger v. De Young*, 10

Wheaton, 358, 1825; *Brown v. District of Columbia*, 3 Mackey, 502, 1884.

⁴ *Welsbach Light Co. v. Freeman*, 100 F. R. 298, 1900.

⁵ *Risdon Iron & Locomotive Works v. Trent*, 92 F. R. 390, 1899.

⁶ *Chisholm v. Johnson*, 100 F. R. 209, 1901.

⁷ *Jennings v. Dolan*, 29 F. R. 862,

eral joint infringers collusively, for the purpose of getting a mutual advantage over another joint infringer, the court, on learning the facts, will dismiss the case.¹

So, also, an action may be brought against several joint defendants, and sustained against such of them as the evidence shows to be liable, even though not sustained against all.² Where an action at law is sustained against several joint infringers, the judgment will be entered against all, regardless of whether the benefits of the infringement were confined to part of them, or extended to the whole;³ though only one payment can be enforced;⁴ and a decree for profits, in an action in equity, will be entered only against those of the defendants who are proved to have actually realized profits from the infringement.⁵

§ 407. Contributory infringement is intentional aid or cooperation in transactions, which collectively constitute complete infringement. For example; where a person furnishes one part of a patented combination, intending that it shall be assembled with the other parts thereof, and that the complete combination shall be used or sold; that person is liable to an action, as infringer of the patent on the complete combination.⁶ And where a person furnishes a machine which is useful only for the purpose of making a patented article, intending that it shall be thus used; that person is himself

1887; *Bray v. Denning*, 56 F. R. 1019, 1893; *Columbia Wire Co. v. Freeman Wire Co.*, 71 F. R. 306, 1895; *Bowers Dredging Co. v. New York Dredging Co.*, 77 F. R. 983, 1896.

¹ *Ring Refrigerator Co. v. St. Louis Ice Mfg. Co.*, 67 F. R. 535, 1895.

² *Reutgen v. Kanowrs*, 1 Washington, 172, 1804.

³ *Cooley on Torts*, p. 136.

⁴ *Jennings v. Dolan*, 29 F. R. 862, 1887.

⁵ *Elizabeth v. Pavement Co.*, 97 U. S. 140, 1877; *Featherstone v. Cycle Co.*, 53 F. R. 110, 1892.

⁶ *Wallace v. Holmes*, 9 Blatch. 73, 1871; *Schneider v. Pountney*, 21 F. R. 403, 1884; *Travers v. Beyer*, 26 F. R. 450, 1886; *Stearns v. Phillips*, 43 F. R. 795, 1890; *Thomson-Houston Electric Co. v. Kelsey Electric Railway Specialty Co.*, 72 F. R. 1016, 1896; and 75 F. R. 1005, 1896; *American Graphophone Co. v. Amet*, 74 F. R. 791, 1896; *Thomson-Houston Co. v. Ohio Brass Co.*, 80 F. R. 721, 1897; *Red Jacket Mfg. Co. v. Davis*, 82 F. R. 432, 1897; *American Graphophone Co. v. Leeds*, 87 F. R. 874, 1898; *Wilkins Shoe-Button Fastener Co. v. Webb*, 89 F. R. 996, 1898.

liable for any infringement which is afterward committed, in the manufacture of that article with that machine.¹ So also, a person is chargeable with contributory infringement of a patent on a machine, where he furnishes articles for that machine to operate upon, intending that the machine shall be used by operating on those articles.² Furthermore, where a person furnishes a machine, composition of matter or other article, which is particularly adapted to be used in performing a patented process, and which the person furnishing the same, intends shall be thus used; that person is liable as a contributory infringer, for any infringement which afterward occurs in accordance with his intention.³ But where the machine or other property thus furnished, is useful for some other purpose than to be a part of a patented combination, or to make a patented article, or to be operated upon by a patented machine, or to be used in performing a patented process, and where he who furnishes the property, does not intend or know, when furnishing the same, that it is to be thus used, he incurs no liability to an action for infringement.⁴ But if he knew or intended that the property furnished by him was to be used in either of the infringing ways; he cannot defeat an action for infringement, by showing that the furnished property could have been used in some non-infringing way.⁵

¹ American Graphophone Co. v. Hawthorne, 92 F. R. 516, 1899.

² Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co., 77 F. R. 288, 1896; Tubular Rivet & Stud Co. v. O'Brien, 93 F. R. 200, 1898.

³ Rumford Chemical Works v. Hecker, 2 Bann. & Ard. 363, 1876; Willis v. McCullen, 29 F. R. 641, 1886; Alabastine Co. v. Payne, 27 F. R. 560, 1886; Celluloid Mfg. Co. v. Zylonite Co., 30 F. R. 437, 1887; Boyd v. Cherry, 50 F. R. 282, 1883; New York Filter Co. v. Jackson, 91 F. R. 425, 1898; German-Ameri-

can Filter Co. v. Loew Filter Co., 103 F. R. 303, 1900; John R. Williams Co. v. Miller, DuBrul & Peters Co., 107 F. R. 290, 1901; Loew Filter Co. v. German-American Filter Co., 107 F. R. 949, 1901.

⁴ Maynard v. Pawling. ⁵ Bann. & Ard. 551, 1880; Millner v. Schofield, 4 Hughes, 261, 1881; Snyder v. Bunnell, 29 F. R. 47, 1886; Geis v. Kimber, 36 F. R. 109, 1888; Edison Electric Light Co. v. Peninsular Light, Power & Heat Co., 95 F. R. 673, 1899.

⁵ Saxe v. Hammond, 1 Holmes, 456, 1875; Bowker v. Dows, 3

Persons who contribute money for the purpose of supporting others in infringing a patent, are also liable as infringers.¹ Where an infringer makes a voluntary assignment for the benefit of creditors, and the assignee continues the infringement, both may be sued jointly for the infringement committed before, and also that committed after the assignment.² And a corporation and its receiver may be joined as defendants, for infringements begun by the company and continued by the receiver.³

Where the owner of a patent on something which infringes an older patent, licenses another to use his device, and furnishes to his licensee, plans and drawings for making his device, and requiring, to that end, the making of the device of the prior patent, without procuring or intending to procure the consent of its owner, that licensor is a joint infringer with his licensee of the prior patent.⁴ Where one man owns and others operate an infringing machine, all are jointly liable to an action therefor.⁵ And where one who has contracted to erect a building, lets a portion of the work to a sub-contractor, and in the prosecution of their respective parts, each of them infringes a patent of another, both of them are liable as joint infringers.⁶

Where one of several joint infringers is sued for their infringement, the other one or ones may be admitted as joint defendant or defendants to help defend the suit.⁷

And while the maker, the seller and the user of a patented machine, manufacture, or other article, are not joint infringers of the patent thereon;⁸ the maker may be admitted by

Bann. & Ard. 518, 1878; Imperial Chemical Mfg. Co. v. Stein, 69 F. R. 617, 1895.

¹ Bate Refrigerating Co. v. Gillett, 30 F. R. 684, 1887.

² Gordon v. Harvester Works, 23 F. R. 147, 1885.

³ Union Switch & Signal Co. v. Philadelphia & Reading Railroad Co., 69 F. R. 834, 1895.

⁴ Toppan v. Tiffany Car Co., 39 F. R. 420, 1889.

⁵ Woodworth v. Edwards, 3 Woodbury & Minot, 121, 1847.

⁶ Jackson v. Nagle, 47 F. R. 703, 1891.

⁷ Curran v. Car Co., 32 F. R. 835, 1887; Standard Oil Co. v. Southern Pacific Co., 54 F. R. 521, 1893; Ring Refrigerator Co. v. St. Louis Ice Mfg. Co., 67 F. R. 540, 1895.

⁸ Consolidated Car Heating Co. v. American Electric Heating Corp. 82 F. R. 998, 1897.

the court to defend a suit against the seller, or a suit against the user, and the seller may be admitted to defend the user, when the user is sued for using the article sold to him.¹

§ 408. A partnership is liable to an action for an infringement committed in the regular course of the partnership business, by one or more of the partners, or under his or their orders; and also for any infringement committed outside of that regular course of business, if it was previously authorized or afterward adopted as the act of the partnership by all the partners. But no partnership is liable for any infringement committed outside of the regular course of the partnership business, unless it was so authorized or adopted.² A person who is employed as manager of a partnership, and in that capacity infringes a patent, is a joint infringer with the partners.³

§ 409. Private corporations are responsible for infringement, committed, authorized, or ratified by them, under substantially the same rules as those which govern the similar responsibility of natural persons. It was formerly supposed that corporations could not be held liable for torts, because torts are never authorized by corporate charters, and are therefore *ultra vires*. But this idea was soon found to produce gross injustice in its practical operation; and was therefore abandoned by the courts.⁴ The law is, that every private corporation is liable for all the torts which were authorized by that corporation, and for all torts done in pursuance of any authority to act on its behalf, on the subject to which the torts relate, and for all torts ratified by the corporation after they are committed.⁵ And in deciding upon this liability, the courts consider corporate officers, agents, and servants as possessing a large discretion, and they ac-

¹ Consolidated Rubber Tire Co. v. Finley Rubber Tire Co., 119 F. R. 705, 1902.

² See Story on Partnership, Sections 166 and 168.

³ Featherstone v. Cycle Co., 53 F. R. 110, 1892; Trent v. Risdon

Iron & Locomotive Works, 102 F. R. 635, 1900.

⁴ Baltimore & Potomac Railroad Co. v. Fifth Baptist Church, 108 U. S. 330, 1882; Salt Lake City v. Hollister, 118 U. S. 256, 1886.

⁵ May v. County of Mercer, 30 F. R. 248, 1887.

cordingly hold the corporation liable for all their acts within the most extensive range of the corporate powers.¹ The agent of a corporation in committing an infringement may be another corporation; and the relation of agency exists and binds the principal, where the agent infringes a patent in authorized pursuance of the business which the principal was chartered to transact.² And a corporation organized for the purpose of conducting a particular business, alleged to infringe a particular patent, may be sued on that patent, without waiting for the infringement to begin.³ Unless their charters otherwise provide, public corporations which are liable at all for infringements of patents, are doubtless liable under the same circumstances and to the same extent as private corporations are.⁴

§ 410. Under what circumstances and to what extent an officer, director, or stockholder of a corporation is personally liable for infringements committed by it, is a compound question, the analysis of which is complicated. There are three kinds of liability for infringements of patents. These are, liability to an injunction; liability to a recovery of infringer's profits; and liability to a recovery of patentee's damages.

The liability to an injunction can be enforced against every person connected with a corporation, without making any person a defendant to the action in equity which seeks to enforce that liability; because a decree for an injunction against a corporation, can properly be made to equally restrain all the officers, directors and stockholders of that corporation from doing whatever the decree forbids the corporation to do.⁵ Therefore, a patentee can have no motive to sue such officer, director or stockholder, for an injunction; except to impose on him the burden of the expenses and costs of patent litigation. That motive is not such as is apt to move a court of

¹ See Cooley on Torts, p. 11.

² York & Maryland Line Railroad Co. v. Winans, 17 Howard, 38, 1854.

³ National Mechanical Directory Co. v. Polk, 121 F. R. 746, 1903.

⁴ May v. County of Mercer, 30 F. R. 248, 1887.

⁵ Howard v. St. Paul Plow-Works, 35 F. R. 747, 1888; Boston Woven Hose Co. v. Star Rubber Co., 40 F. R. 167, 1889; Mergen-

equity into action, and therefore many such courts have dismissed such representatives of corporations from suits, which sought to make them defendants to prayers for injunctions.¹

No person is liable to a recovery of infringer's profits, except such profits as were made by himself; though the profits made by a joint infringer with him, may have been much larger than any made by him.² Where a person has no connection with a corporation, except as an officer, director or stockholder; he makes no profit from any infringement committed by that corporation; except such as he may receive in dividends or in salary. As long as a corporation is solvent enough to pay over to a patentee, all the profits which it made from its infringement of the patent of that patentee; there is no good reason for a court of equity to go further in search of money for that purpose. There is, therefore, no good reason for such a court taking jurisdiction of any officer, director or stockholder of the corporation, with a view of tracing into his hands, the money needed to satisfy the patentee's claim for infringer's profits. It follows that an officer, director or stockholder in a corporation is not liable to a recovery of infringer's profits, on account of any infringement committed by the corporation; except where the corporation is so insolvent as to be unable to itself respond to an execution for the amount of those profits.³ And even in that exceptional case, no person is liable to a recovery of infringer's profits, out of money received by him, as a fair compensation for services rendered to the corporation. But in the ex-

thaler Linotype Co. v. Ridder, 65 F. R. 853, 1895.

¹ Howard v. St. Paul Plow-Works, 35 F. R. 744, 1888; Boston Woven Hose Co. v. Starr Rubber Co., 40 F. R. 167, 1889; Mergenthaler Linotype Co. v. Ridder, 65 F. R. 854, 1895; Consolidated Brake-Shoe Co. v. Chicago, P. & St. L. Ry. Co., 69 F. R. 412, 1895; Bowers v. Atlantic Gulf & Pacific Co., 104 F. R. 888, 1900; Loomis-Manning Filter Co. v. Manhattan Filter Co.,

117 F. R. 325, 1902; Farmers' Mfg. Co. v. Spruks Mfg. Co., 119 F. R. 594, 1902; Greene v. Buckley, 120 F. R. 955, 1902.

² Elizabeth v. Pavement Co., 97 U. S. 140, 1877.

³ Boston Woven Hose Co. v. Star Rubber Co., 40 F. R. 167, 1889; Mergenthaler Linotype Co. v. Ridder, 65 F. R. 854, 1895; Western Electric Co. v. Home Telephone Co., 85 F. R. 661, 1898; Bowers v. Atlantic, Gulf & Pacific Co., 104

ceptional case, dividends can be reached in the hands of stockholders, and subjected to the payment of the infringer's profits; because a court of equity will pursue the money of a corporation into whosoever possession it may be transferred, when that pursuit is necessary to reach means for paying the corporate obligations.¹

§ 410*a*. The liability to a recovery of patentee's damages, depends upon different reasons from those which negative or condition the liability to a recovery of infringer's profits; where those damages or those profits are sought to be recovered from an officer, director, or stockholder of an infringing corporation. Judge JOHN LOWELL, in 1882, held that an action at law cannot be maintained against the officers, directors, or shareholders of a corporation which infringes a patent, even where such persons personally conducted the business which constituted the infringement.² But that decision was expressly overruled, in respect of the liability of directors, in 1899, by Judge FRANCIS C. LOWELL, when writing the opinion of the majority of the Circuit Court of Appeals for the first circuit.³ Still, one of the three judges who heard that case, dissented from the decision of the majority; and the case did not deal with the liability of officers or stockholders. The compound question of the liability of officers, directors and stockholders in such cases is important. Upon it may sometimes depend the just reward of a meritorious inventor, and the just retribution of a willful infringer. A full explanation of the subject, is therefore presented, in the next five sections of this book.

§ 411. Wrongs are divisible, in one aspect, into two classes: wrongs of commission and wrongs of omission. Where an officer, director, or stockholder of a corporation

F. R. 888, 1900; *Loomis-Manning Filter Co. v. Manhattan Filter Co.*, 117 F. R. 325, 1902; *Greene v. Buckley*, 120 F. R. 955, 1902.

¹ *Mumma v. Potomac Co.*, 8 Peters, 286, 1834; *Curran v. Arkansas*, 15 Howard, 311, 1853;

Railroad Co. v. Howard, 7 Wallace, 409, 1868.

² *United Nickel Co. v. Worthington*, 13 F. R. 393, 1882.

³ *National Cash Register Co. v. Leland*, 94 F. R. 514, 1899.

is engaged in managing its business, and as a part of that business manages and directs the infringement of a patent, that person is chargeable with a wrong of commission. Where such a person has power to prevent his corporation from infringing a patent, and omits to exercise that power, and where the corporation therefore infringes that patent, then that person is chargeable with a wrong of omission. Where a person is an officer, director, or stockholder of a corporation, but has no personal power to cause it to infringe a particular patent, nor to restrain it from so doing, that person is chargeable with no wrong of either sort.

§ 412. Stockholders seldom have any power, merely as stockholders, to control the action of their corporation in such a matter of detail as the infringement of a particular patent. Unless it can be shown that the stockholder whom it is sought to hold liable in a particular case, did possess power of that kind, it is clear that the common law will not compel him to respond in damages for any infringement with which he was not personally connected. If the law were otherwise, a man could lawfully be made to suffer for wrongs which he did not commit, and could not prevent, and from which he received no advantage. Indeed, it is the general rule of the common law that mere stockholders in a corporation are not liable for its debts,¹ and if not liable for its debts, they surely ought not to be liable for its torts.

§ 413. The officers of a corporation are the persons who are charged with the superintendence and control of its transactions. It is doubtless their duty to refrain from directing infringements to be committed; and also to prevent the agents and servants of their corporations from committing infringements of patents when prosecuting the corporate business. If such an officer directs and causes a specific thing to be done, which turns out to constitute an infringement, it is doubtless difficult to see why he should be permitted to shift all the responsibility for the tort upon the intangible corporation, that is to say, upon the innocent stockholders as a body.

¹ *Shaw v. Boylan*, 16 Indiana, 386, 1861.

If an agent or a servant of a corporation commits an infringement in the course of the corporate business, the officers whose function it is to control that agent or that servant are chargeable with a wrong of omission. They are guilty of *non-feasance* in the performance of their official duties. If their omission to prevent the infringement is the result of gross inattention on their part, they are liable to the corporation for any loss it may incur on account of the infringement; but it is otherwise if the omission resulted from an error of judgment.¹ Whether such an officer is liable at common law to the owners of the patent infringed, seems to depend upon other considerations.

If an officer, in pursuance of his general authority, directs a servant of a corporation to make a machine for a particular purpose, which machine may be made so as to infringe a patent, or may be made so as not to have that effect, it seems that the officer is bound to see that it is not made so as to infringe, and that if the servant makes it in that way, the officer is liable to the patentee.² But if a servant of a corporation, without any special orders to do so, makes or uses or sells a thing which turns out to be an infringement of a patent, it seems that no superior officer is personally liable therefor at common law.³ It appears reasonable that officers of corporations should be bound to see that whatever they cause to be done is done lawfully; but it would perhaps not be ordinarily right to make them personally responsible to strangers for acts spontaneously committed by their subordinates.

§ 414. Directors of corporations, unlike other officers, act only in a collective capacity. Where an entire board of directors unanimously order a particular thing to be done which will constitute an infringement of a patent, and where that thing is accordingly done by the corporation's agents or servants, there seems to be no reason why those directors should

¹ Spring's Appeal, 71 Pennsylvania State, 11, 1872.

² See *Hewett v. Swift*, 3 Allen (Mass.), 425, 1862.

³ See *Bath v. Caton*, 37 Michigan, 202, 1877.

not be held personally liable to an action for that infringement. If the corporation is alone liable in such a case, then crafty and dishonest men may often manage to divide the spoils of infringement, and leave nothing but an insolvent or dormant corporation to be sued by the patentee. It would evidently be a reproach to our laws if such a scheme could be made to work. Whoever attempts to defend the legal safety of such a mode of reaping the harvest of another, should have his attention called to the following sentence, written by Justice CAMPBELL, and approved by the Supreme Court, and worthy to be quoted in every law-book, and remembered by every man. "It is certainly true that the law will strip a corporation or individual of every disguise, and enforce a responsibility according to the very right, in despite of their artifices."¹

Where the action of a board of directors in ordering an infringement, results from the votes of a majority only, the relations of the minority voters to the resulting infringement must be different from that of the others. The members of the minority ought not, in such a case, to be held liable for the action of the board, or for its results, unless they afterward adopt it by ratification. Where an infringement is ordered by a quorum of a board of directors, in the absence of the residue, the residue will be free from common law liability for the wrong, unless they afterward ratify it, or unless they are chargeable with such gross non-attendance upon the meetings of the board as justly causes them to be held responsible for whatever is done by their colleagues in their absence. The mere fact of being a director in a corporation is not sufficient to render a person liable at common law for any tort committed by that corporation or its managers or agents.²

§ 415. But there is a statutory liability in such cases as those which we are considering. Most of the States have statutes which provide that, under various circumstances therein specified, the officers, directors, or stockholders of a

¹ York & Maryland Line Railroad Co. v. Winans, 17 Howard, 40, 1854.

² Arthur v. Griswold, 55 New York, 406, 1874.

corporation shall be personally liable for its debts or liabilities. Section 721 of the Revised Statutes of the United States provides that "The laws of the several States, except where the Constitution, treaties, or statutes of the United States otherwise require or provide, shall be regarded as rules of decision in trials at common law, in cases where they apply." Under this section of the Revised Statutes, these laws of the States will probably have the same effect in a patent suit in a United States court, that they would have in any action of trespass on the case in a State court.¹ Such of the State statutes referred to as make stockholders, officers, or directors responsible for the "liabilities" of their corporations are clearly broad enough to cover liabilities arising out of infringements of patents. Indeed Justice STORY decided that such liabilities were covered by the word "debts" in such a statute.² In most of the States the statutory, individual liability of officers, directors, and stockholders of corporations is more limited than it was in Massachusetts when Justice STORY made that decision. It is outside the scope of this text-book to set forth the details of the State statutes which bear upon the point. It will frequently happen that the controlling legislative edicts, which relate to the matter, will be found in the special charters of particular corporations, rather than in the general statutes of the several States. The general principle which runs through all such laws seems to be that where a corporation is so managed that it cannot be made to respond to lawful claims based on its contracts or torts, those officers or directors who caused that inability, or those officers, directors, or stockholders who profited thereby, shall be made to respond in its place.

¹ McCluny v. Silliman, 3 Peters, 270, 1830; McNeil v. Holbrook, 12 Peters, 84, 1838; Vance v. Campbell, 1 Black, 427, 1861; Hausknecht v. Claypool, 1 Black, 431, 1861; Wright v. Bales, 2 Black, 535, 1862; Leffingwell v. Warren, 2 Black, 599, 1862; Hanger v. Abbott, 6 Wallace, 537, 1867; Camp-

bell v. Haverhill, 155 U. S. 614, 1895; Parker v. Hall, 2 Fisher, 62, 1857; Parker v. Hawk, 2 Fisher, 58, 1857; Rich v. Ricketts, 7 Blatch. 230, 1870; Hayden v. Oriental Mills, 15 F. R. 605, 1883.

² Carver v. Mfg. Co., 2 Story, 448, 1843.

§ 416. A consolidated corporation is liable to actions in equity for infringements committed before the consolidation, by each of its constituents, if the property and franchises which the consolidated corporation acquired from that constituent were of sufficient value, over and above all paramount claims, to equal the profits or damages sought to be recovered in such actions.¹ This proposition results from the fact that equity regards the property of a corporation as held in trust for the payment of its debts, and recognizes the right of creditors to pursue that property into whosesoever possession it may be transferred, unless it has passed into the hands of a *bona fide* purchaser.²

The liability of consolidated corporations to actions at law, for infringements committed by their constituent corporations, before the consolidation, is a matter which does not rest on common law principles, so much as upon the statutes of the States wherein those consolidated corporations came into being, or upon the private Acts which authorized the consolidations, or upon the charters of the constituent or of the consolidated companies. Whenever occasion arises to hold a consolidated corporation liable to an action at law for such a cause, a proper authority for so doing can probably always be found in one or another of these sources.

§ 417. A plurality of patents may be sued upon in one action, where the inventions covered by those patents are embodied in one infringing process, machine, manufacture, or composition of matter;³ but not other-

¹ Sayles v. The Lake Shore & Michigan Southern Railway Co., Manuscript, 1878.

² Mumma v. Potomac Co., 8 Peters, 286, 1834; Curran v. Arkansas, 15 Howard, 311, 1853; Railroad Co. v. Howard, 7 Wallace, 409, 1868.

³ Seymour v. Osborne, 11 Wallace, 516, 1870; Bates v. Coe, 98 U. S. 48, 1878; Nourse v. Allen, 3 Fisher, 63, 1859; Gillespie v. Cum-

mings, 3 Sawyer, 259, 1874; Horman Patent Mfg. Co. v. Railroad Co., 15 Blatch. 444, 1879; Game-well Fire-Alarm Telegraph Co. v. Chillicothe, 7 F. R. 351, 1881; Nellis v. Mfg. Co., 13 F. R. 451, 1882; Lilliendahl v. Detweiler, 18 F. R. 177, 1883; Consolidated Electric Light Co. v. Electric Light Co., 20 F. R. 502, 1884; Griffith v. Segar, 29 F. R. 707, 1887; Diamond Match Co. v. Ohio Match

wise.¹ But any action based on alleged infringement, in one process or thing, of a plurality of patents, may be sustained by evidence that one of those patents was so infringed, though the others were not;² and an action brought for alleged unlawful making, using, and selling may be sustained by evidence of either of those three sorts of infringement.³ So also, an action may be based on infringement committed during the first term, and on infringement committed during an extended term, of any patent, and may be sustained on proof of either or both of those infringements. And several actions may be based on several infringements of the same patent, committed at different times by the same infringer.⁴ It has also been held that one action will lie for an infringement of a patent and an infringement of a trade-mark, where the trade-mark and the patent were both infringed together.⁵

Co., 80 F. R. 117, 1897; *Wilkins Shoe-Button Fastener Co. v. Webb*, 89 F. R. 992, 1898; *Continental Gin Co. v. F. H. Lummus Sons' Co.*, 110 F. R. 390, 1901; *Edison Phonograph Co. v. Victor Talking Mach. Co.*, 120 F. R. 305, 1903.

¹ *Nellis v. McLanahan*, 6 Fisher, 286, 1873; *Hayes v. Dayton*, 8 F. R. 702, 1880; *Barney v. Peck*, 16 F. R. 413, 1883; *Hayes v. Bickelhaupt*, 23 F. R. 184, 1885; *Huber v. Sanitary Depot*, 34 F. R. 752, 1888; *Union Switch & Signal Co. v. Philadelphia & Reading Railroad Co.*, 68 F. R. 913, 1895; *Louden*

Mach. Co. v. Montgomery Ward & Co., 96 F. R. 232, 1899; *Russell v. Winchester Arms Co.*, 97 F. R. 634, 1899.

² *Matthews v. Mfg. Co.*, 18 Blatch. 86, 1880; *Green v. City of Lynn*, 81 F. R. 387, 1897; *Chisholm v. Johnson*, 106 F. R. 211, 1901.

³ *Locomotive Truck Co. v. Railway Co.*, 10 Blatch. 293, 1872.

⁴ *Roemer v. Neumann*, 23 F. R. 447, 1885.

⁵ *Jaros Underwear Co. v. Fleece Underwear Co.*, 60 F. R. 622, 1894.

CHAPTER XVIII.

ACTIONS AT LAW.

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§ 421. One section of the Revised Statutes provides that "Damages for the infringement of any patent may be recovered by action on the case."¹ Another section provides that "The practice, pleadings, and forms and modes of proceeding in civil causes, other than equity and admiralty causes, in the circuit and district courts, shall conform, as near as may be, to the practice, pleadings, and forms and modes of proceeding existing at the time in like causes in the courts of record of the State, within which such circuit or district courts are held, any rule of court to the contrary notwithstanding."² Both these apparently inconsistent provisions are contained in the same enactment. They must therefore be construed together; and effect must be given to both. This result is reached by following Section 4919 as far as it necessarily goes, and by conforming in other respects to Section 914.³ With this view, it has been held that the complaints and petitions which are prescribed for civil actions by the codes of sundry of the States, may be used in bringing actions on the case for infringements of patents in Federal courts sitting in those States, respectively;⁴ and indeed, in one case, it has been held that the forms of pleading and procedure in such an action in a Federal court should

¹ Revised Statutes, Section 4919.

² Revised Statutes, Section 914.

³ *Cottier v. Stimson*, 18 F. R. 690, 1883.

⁴ *May v. County of Mercer*, 30 F. R. 250, 1887.

be the same as those employed in civil actions in the State courts of the State in which that Federal court is located.¹ But in a later case, it has been decided, that the pleadings in an action at law, for infringement of a patent, should conform to the common law, even in a code State;² and inasmuch as many of the States still employ common law actions and pleadings in their own courts, it is necessary for pleaders to accurately know the proper characteristics of a declaration, in an action of trespass on the case, for the infringement of a patent.

§ 422. The proper parts of such a declaration are the following: 1. The title of the court. 2. The title of the term. 3. The venue. 4. The commencement. 5. The statement of the right of action. 6. The conclusion.

The true title of the United States Circuit Court established in Connecticut is "Circuit Court of the United States for the District of Connecticut," and the title of the circuit court which is established in any other district is the same, except as to the name of the district.³

The proper term of the court in which to entitle the declaration, is the term at which the appearance of the defendant is due.⁴ It is unnecessary to entitle a declaration in the name of the case in which it is filed; though it is convenient to indorse that name on the back of the declaration, for the purpose of enabling the document to be readily found in a file.

The venue should be laid in the district where the action is commenced, regardless of the district or districts wherein the infringement was committed.⁵

The commencement contains a statement of the names of the parties to the action, and of the capacity in which they respectively sue or are sued, if it is other than a natural personal capacity. Though it is probably unnecessary, it

¹ *Celluloid Mfg. Co. v. Zylonite Co.*, 34 F. R. 744, 1888.

² *Myers v. Cunningham*, 44 F. R. 349, 1890.

³ Revised Statutes, Section 608.

⁴ 1 Chitty on Pleading, 15 American Edition, p. 263.

⁵ *McKenna v. Fisk*, 1 Howard, 248, 1843.

is undoubtedly prudent to state the nation of which the parties are respectively citizens, and if that nation is the United States, to allege also the particular State of which the parties are citizens respectively. Where either party is a corporation, that fact must be stated, and the name of the State or other sovereignty wherein it was created and exists should also be alleged. The commencement properly closes with a brief recital that the form of action is that of trespass on the case.

§ 423. The statement of the right of action should contain the name and residence and citizenship of the inventor, upon whose application the patent, on which the action is based, was granted.

§ 424. The novelty and the utility of the invention must be put in issue by proper averments in the declaration;¹ which averments include not only the general statement that the invention was new and useful, but also those details of the elements of novelty which are defined by the statute,² and which consist in actual newness in this country, and technical novelty throughout the world. But it is not necessary to state the particular time at which the invention was made, so that it appears to have been made before the application for the patent was filed.³

§ 425. The statement of the right of action must also aver that the invention was not in public use or on sale in this country for more than two years before the inventor's application for the patent.⁴ And where a declaration is based on a patent which was applied for after 1897; the statement of the right of action must likewise aver that the invention

¹ *Coop v. Development Institute*, 47 F. R. 900, 1891; *Overman Wheel Co. v. Elliott Cycle Co.*, 49 F. R. 859, 1892; *Goebel v. Supply Co.*, 55 F. R. 827, 1893; *Ross v. Ft. Wayne*, 58 F. R. 407, 1893.

² Revised Statutes, Section 4886; *Diamond Match Co. v. Ohio Match Co.*, 80 F. R. 117, 1897; *Rubber-Tire Wheel Co. v. Davie*, 100 F. R. 85, 1900; *Elliott & Hatch Book-*

Typewriter Co. v. Fisher Typewriter Co., 109 F. R. 330, 1901.

³ *Wilder v. McCormick*, 2 Blatch. 31, 1846.

⁴ Revised Statutes, Section 4886; *Gandy v. Belting Co.*, 143 U. S. 592, 1892; *Gray v. James*, 1 Peters' Circuit Court Reports, 482, 1817; *Blessing v. Copper Works*, 34 F. R. 754, 1888; *Nathan Mfg. Co. v. Craig*, 47 F. R. 522, 1891; *Con-*

was not patented or described in any printed publication, more than two years prior to the application for that patent.¹

§ 426. If the patentee is neither a party to the action, nor the inventor of the thing or process covered by the patent; it is natural and proper to separately state his name in order to fully and surely identify the patent. It is well also to state his residence and his citizenship, though there is no requirement of law on either of these points.

§ 427. It is not necessary to state in a declaration the particulars of the application for the letters patent, nor the particulars of the proceedings of the Patent Office in considering that application;² nor to make any statement about any application, except that the letters patent were granted upon the application of the inventor named in the declaration.³

§ 428. The declaration may indicate the letters patent in the language of the grant, and make profert thereof; and if that is done, it is not necessary to set out the specification either verbatim or substantially;⁴ for the profert imports the patent, by implication into the declaration.⁵

Where a declaration is based on a patent which was granted before April 11, 1902; the declaration must state that the letters patent were issued in the name of the United States of America, under the seal of the Patent Office, and were signed by the Secretary of the Interior, or an Assistant Secretary of the Interior, as the case may be, and countersigned by the Commissioner of Patents, and that they were delivered to the patentee.⁶ And where a declaration is based on a patent granted after April 11, 1902; the declaration must state that the letters patent were issued in the name

Consolidated Brake-Shoe Co. v. Detroit Spring Co., 47 F. R. 895, 1890.

¹ Revised Statutes, Section 4886, as amended March 3, 1897; 29 Statutes at Large, p. 692, Ch. 391, Section 1; *Rubber-Tire Wheel Co. v. Davie*, 100 F. R. 85, 1900.

² *Cutting v. Myers*, 4 Washington, 221, 1818.

³ *Wilder v. McCormick*, 2 Blatch. 31, 1846.

⁴ *Cutting v. Myers*, 4 Washington, 223, 1818.

⁵ *Graham v. Earl*, 82 F. R. 737, 1897.

⁶ Revised Statutes, Section 4883; 25 Statutes at Large, Ch. 15, p. 40; *Cutting v. Myers*, 4 Washington, 222, 1818.

of the United States of America, under the seal of the Patent Office, and were signed by the Commissioner of Patents.¹

Inasmuch as patents are granted for various spaces of time, it is necessary to state the particular term for which the letters patent in suit were issued. It is necessary also to plead the legal effect of the patent, by saying that it did grant to the patentee, his heirs or assigns, the exclusive right to make, use and vend the invention covered thereby, throughout the United States and the Territories thereof.²

§ 429. Where the patent upon which the action is based is a reissue, the original letters patent should be set forth precisely as though no surrender and reissue had occurred; and in addition thereto, it is proper to state the particular kind of defect which made the original a proper subject of a reissue; and to state also that such defect arose from inadvertence, accident, or mistake, as the case may be, and without any fraudulent or deceptive intention; and to state that the original patent was surrendered, and who surrendered it; and to state that the Commissioner of Patents caused a new patent to be issued for the same invention; and to state finally the name of the person to whom such new patent was granted. These particulars lie at the foundation of the right of the grantee of a reissue patent to receive such a grant; and although the reissue is *prima facie* evidence that the truth on all these points is favorable to the validity of the patent, it is none the less proper to put those facts in issue by proper pleading. And it is hardly prudent to venture a case on a more indefinite form of pleading; though a more indefinite form of pleading has once been held sufficient in such a case.³

§ 430. Where a disclaimer has been filed, that fact ought to be stated in the declaration, and its legal effect ought to be indicated, because disclaimers constitute amendments of original patents, and operate to vary their scope.⁴ In such a case also, the declaration ought to state that the disclaimer

¹ 32 Statutes at Large, Part I, page 95, Ch. 417.

² Revised Statutes, Section 4884.

³ *Spaeth v. Barney*, 22 F. R. 828, 1885.

⁴ Revised Statutes, Section 4917.

was filed without unreasonable delay, because that fact is necessary to the right of a patentee to maintain a suit on a patent which required a disclaimer.¹

§ 431. Where the patent in suit has been extended by a special Act of Congress, and where the suit is partly or wholly based on such extension, the declaration must state the legal effect of the Act of extension, and it must specially show the particular space of time covered thereby.

§ 432. Where the plaintiff is an assignee or grantee of the patentee, it is safer to set forth all the mesne assignments or grants down to him, than merely to state that the exclusive right which was infringed by the defendant, came to the plaintiff by assignment or by grant. And a declaration must not only state how and when the plaintiff became the owner of the patent right, but must also allege ownership during the time of the infringement upon which the declaration is based. Title papers should be set forth by their legal effect, and not be copied bodily in the declaration.

§ 433. No profert need be made in any declaration, of any assignment or grant of any interest under letters patent. But where the title papers of a plaintiff include letters testamentary or letters of administration, he must make profert of those documents. If profert is made of any document of which it is not necessary, it will be treated as surplusage, and will not entitle the defendant to oyer.

§ 433a. The declaration must state, either that no person ever made or sold the patented article under the authority of the patent; or that such of the patented articles as were thus made or sold, had the word "patented," together with the day and year the patent was granted, fixed thereon, or when, from the character of the article, this could not be done, then to the package wherein one or more of them was enclosed; or otherwise that the defendant was duly notified that his doings were an infringement of the patent, and continued, after such notice, to infringe.²

§ 434. The statement of infringement should allege that

¹ Revised Statutes, Section 4922.

² *Dunlap v. Schofield*, 152 U. S. 244, 1894.

the defendant, without any license, did make, or that he did use, or that he did sell, the subject of whatever claim or claims of the patent the plaintiff intends to prosecute at the trial; and that the infringement occurred within the territory covered by the plaintiff's title to the patent, and within the time during which the plaintiff held the title within that territory, and contrary to the statutes of the United States, in such cases made and provided.

While an allegation of either making, using, or selling will be sufficient in a declaration to show a cause of action, no allegation of any one of these kinds of infringement will support evidence of either of the others. A declaration ought therefore to allege as many of them as the plaintiff has any expectation of being able to prove.

§ 435. The time of the infringement is properly stated, by alleging that it occurred on a specified day, and on divers other days between that day and some later specified date; and no plaintiff will be permitted to prove infringement outside of the space of time which he specified in his declaration.¹ Repeated infringements may be sued for in one action;² but all of the infringements complained of in one declaration must have been committed after the plaintiff obtained the title to the patent, and before the beginning of the action. Where the plaintiff is an assignee, and where he not only has rights of action against the defendant, for infringements committed after the date of his assignment, but also has purchased rights of action against the same party, for infringements committed before such purchase, he must, if he sues at law, bring a separate action for the latter causes, and must bring that action in the name of the person who owned the patent at the time they accrued.

§ 436. The damages incurred by the plaintiff on account of a defendant's infringement must be stated specially, because no particular damage necessarily arises from infringements of patents, and therefore none is implied by the law.³

¹ *Eastman v. Bodfish*, 1 Story, 530, 1841; *LePage Co. v. Russia Cement Co.*, 51 F. R. 949, 1892.

² *Wilder v. McCormick*, 2 Blatch. 32, 1846.

³ 1 Chitty on Pleading, 396.

The special damages to be alleged in any particular case depend upon the circumstances of that case: depend upon the particular criterion of damages upon which the plaintiff relies. The various measures of damages in patent cases are stated and explained in the nineteenth chapter of this book. One or more of them will be found to be applicable to every case which is likely to arise. From among them, the pleader may select those which he expects to be able to prove to be pertinent, and may then draw his special statement of damages accordingly. Such a special statement is required by the substantial principles of pleading, as well as by its technical rules. Without it, the defendant would not be apprised of all the issues of the case. He would not know, till the day of trial, whether the plaintiff would prove an established royalty, or would prove loss or reduction of his sales, or would prove reduction of his prices, as the criterion of his damages. The defendant would therefore have to go to court provided with witnesses on all these points, or would have to trust his sagacity, and guess which of these points he would be called upon to meet. It was to prevent such inconveniences that written pleadings were originally designed; and for the same purpose, among others, they are still retained in actions in courts.

§ 437. The conclusion of a proper declaration in a patent case alleges that, by force of the statutes of the United States, a right of action has accrued to the plaintiff to recover the actual damages which the declaration specifies, 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. The conclusion ends with the ancient allegation of bringing suit.

§ 438. A declaration, though not drawn in due form, is sufficient for practical purposes, if it contains all that is essential to enable the plaintiff to give evidence of his right, and of its violation by the defendant, and affords to the defendant the opportunity of interposing every defence allowed to him by law.¹ Courts do not encourage merely

¹ *Wilder v. McCormick*, 2 Blatch. 37, 1846.

technical objections to pleadings, and even on special demurrer, will seek to sustain those which, though not technically accurate, are substantially sufficient for the real purposes of pleading.

§ 439. Dilatory pleas in patent actions are not materially different in their nature and operation from corresponding pleas in other common law cases. It is therefore unnecessary to treat those preliminary defences in this book. Recourse may be had to the standard works on common law pleading for whatever information the patent pleader may require upon the subject.

§ 440. The defences which are pleadable in bar to an action, are very numerous in the patent law, and most of them are peculiar to this branch of jurisprudence. Where the facts appear to warrant so doing, a defendant may plead: 1. That the matter covered by the letters patent was not a statutory subject of a patent: or 2. That it was not an invention: or 3. That it was not novel at the time of its alleged invention: or 4. That it was not useful at that time: or 5. That the inventor actually abandoned the invention: or 6. That he constructively abandoned it, by not applying for a patent on it, during the time allowed by the statutes for such an application to be made: or 7. That the invention claimed in the original patent is substantially different from any indicated, suggested, or described in the original application therefor: or 8. That the patentee surreptitiously or unjustly obtained the patent for that which was in fact the invention of another, who was using reasonable diligence in adapting and perfecting the same: or 9. That the invention was made by another jointly with the sole applicant: or 10. That it was made by one only of two or more joint applicants: or 11. That for the purpose of deceiving the public, the description and specification filed in the Patent Office was made to cover less than the whole truth relevant to the invention, or was made to cover more than was necessary to produce the desired effect: or 12. That the description of the invention in the specification is not 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: or 13. That the claims of the patent are not distinct: or 14. That the patentee unreasonably delayed to enter a needed disclaimer: or 15. That the original patent was surrendered and reissued in the absence of every statutory foundation thereof: or 16. That the claims of the reissue patent in suit are broader than those of the original, and that the reissue was not applied for till a long time had elapsed after the original was granted: or 17. That the reissue patent in suit covers a different invention from any which the original patent shows was intended to be secured thereby: or 18. That the invention claimed in the original patent, is substantially identical with an invention claimed in a prior patent granted on the application of the same inventor: or 19. That the patent was repealed: or 20. That the patent legally expired before the alleged infringement began, or before it ended: or 21. That the patentee made or sold specimens of the invention covered by his patent, without marking them "patented," and without notifying the defendant of his infringement: or 22. That the plaintiff has no title to the patent, or no such title as can enable him to maintain the action: or 23. That the defendant has a license, which authorized part or all of the doings which constitute the alleged infringement: or 24. That the defendant has a release, discharging him from liability on account of part or all of the alleged infringement: or 25. That the defendant is not guilty of any infringement of the patent upon which he is sued: or 26. That the plaintiff is estopped from enforcing any right of action against the defendant: or 27. That the cause of action sued upon, is partly or wholly barred by some statute of limitation.

§ 441. The first fourteen of these defences assail the validity of original patents; and either of them, if successfully maintained, will defeat any such patent, and therefore defeat any action based thereon. All of the fourteen are also applicable to actions based upon reissue patents, for though a defective or insufficient specification, or a defective or insufficient claim, or an excessive claim, can be cured by

surrender and reissue,¹ those faults are sometimes retained and sometimes introduced in reissues.

The fifteenth, sixteenth, and seventeenth of these defences assail reissues as reissues. To what extent those defences, if successful, will affect the patent, or the action, are points which are explained in the chapter on reissues.²

The eighteenth defence assails the validity of original patents, and it may be applicable to all the claims of such a patent, or it may be applicable to only some of them. And a patent will not be invalidated throughout, by the fact that one or more of its claims, less than all of them, must be invalidated on this ground, any more than where such invalidity arises out of any other reason.

The nineteenth defence, when true, will certainly be a full one to any action based on alleged infringements which were committed after the repeal of the patent. Whether it will be a defence to any infringement committed before that time, will depend upon whether the patent is repealed *ab initio*, or only *in futuro*.

The twentieth defence will be available against any patent which was applied for before 1898, where the defendant can prove that the invention was patented with the knowledge and consent of the inventor in some foreign country before it was patented in the United States, and that such foreign patent expired before the United States patent purported to terminate. This defence, if successful, will not affect the validity of the patent. It will merely limit its duration to less than seventeen years.³

The twenty-first defence, if successful, will bar the action, but it will not affect the patent. Any oral or written notice of infringement, if given to the defendant without stopping his infringement, will oust the defence as to subsequent infringements.⁴

The last six of the twenty-seven defences are all without relevancy to the validity of the patent. Either of them may

¹ Revised Statutes, Section 4916.

² Sections 221 and 249 of this book.

³ Section 163 of this book.

⁴ New York Pharmaceutical Association *v.* Tilden, 14 F. R. 740, 1882; Allen *v.* Deacon, 21 F. R. 122, 1884.

be partly or wholly successful, according to the circumstance of each action, regardless of the success or want of success which may attend the other twenty-one.

§ 442. Such of these defences as can be established from the face of the declaration, or of the letters patent upon which the suit is based, or can be based upon a fact of which the court will take judicial notice, may be made by demurrer; but if so made and overruled, such a defence cannot afterward be made in a plea, without leave of the court.¹

The ancient rules of common law pleading would require a special plea for either of the twenty-seven defences which are enumerated in Section 440, save only the defence of non-infringement, and sometimes that of want of title.² But a loose and unscientific relaxation of that part of those rules crept at one time into practical pleadings, both in England and America. The abuse was reformed in England in the fourth year of William the Fourth;³ but in the United States it has continued, except so far as it has been limited or enlarged by legislation in particular States. But there was never any principle which guided this departure from the ancient law, and therefore no foundation for any science of the subject. Where an authoritative precedent can be found for a particular relaxation, that particular relaxation must be regarded. In the absence of such a precedent, the safe and proper course is to conform to the ancient common law rules, unless the pleader is willing to risk his defence upon the theory that State statutes relevant to pleadings are binding on Federal courts when trying patent actions of trespass on the case.

§ 443. The patent statute provides that five of the twenty-seven defences may be made under the general issue, accompanied with a certain statutory notice of special matter.⁴ Those are the defences which, in Section 440 of this book, are numbered three, five, six, eight, and eleven, respectively. Either of these five defences may also be made under a special plea, instead of under the general issue accompanied by

¹ *Brickill v. Hartford*, 57 F. R. 218, 1893.

² *Stephen on Pleading*, 160.

³ *Stephen on Pleading*, 158.

⁴ Revised Statutes, Section 4920, as amended in 29 Statutes at Large, p. 692, Ch. 391, Section 2.

notice, if the defendant so determines.¹ But if any defendant uses both these forms of pleading for any one defence, the court will, on motion, call upon him to select the one which he prefers, and to abandon the other.²

§ 444. Notices of special matter must be in writing, and must be served on the plaintiff or his attorney at least thirty days before the trial of the case.³ No such notice requires any order of court as a prerequisite thereto; and depositions taken before the service of such a notice are as admissible under it as if taken afterward.⁴ It is not the purpose of the statute to oblige the defendant to give notice of anticipating matter before taking depositions. Its only purpose is to give the plaintiff thirty days before the trial, in which to secure evidence to contradict the testimony of the defendant's witnesses, in case the latter is untrue. Notices of special matter are not required to be filed in court; and if filed they are not examinable by demurrers. Their sufficiency is decided at the time of trial, by admitting or excluding evidence offered thereunder.⁵

Notices of want of novelty must state the names of the prior patentees, and the dates of their patents, where prior patents are relied upon; and where prior knowledge or use is relied upon, such a notice must state the names and residences of the persons alleged to have had the prior knowledge of the thing patented, and where and by whom it was used.⁶ Where prior printed publications are relied upon as negating the novelty of the patented invention, the statute does not say how such publications are to be identified in such notices. But the Supreme Court has decided that they must be pointed out with sufficient definiteness to relieve the plaintiff from making an unnecessarily laborious search therefor.⁷ In the case just cited, a notice

¹ *Evans v. Eaton*, 3 Wheaton, 454, 1818; *Grant v. Raymond*, 6 Peters, 218, 1832; *Day v. Car-Spring Co.*, 3 Blatch. 181, 1854; *Henry v. United States*, 22 Court of Claims, 78, 1887.

² *Read v. Miller*, 2 Bissell, 16, 1867.

³ Revised Statutes, Section 4920.

⁴ *Teese v. Huntingdon*, 23 Howard, 2, 1859.

⁵ *Henry v. United States*, 22 Court of Claims, 79, 1887.

⁶ Revised Statutes, Section 4920.

⁷ *Silsby v. Foote*, 14 Howard, 218, 1852.

was held to be insufficient, which stated that the patented thing was described in a certain book therein mentioned, but did not state in what part of that book it was so described. Notices of prior knowledge or use are sufficiently specific, when they specify the city in which that knowledge or use existed or occurred, and give the names of persons who had that knowledge, or who engaged in that use, and state in what city those persons reside.¹ That is to say: the word "where" and the word "residence," as those words are used in the statute, refer to cities, villages, or towns, as the case may be, and do not refer to particular houses, factories or farms.

The names of witnesses as such, need not be mentioned in a notice, yet it is often necessary to use as witnesses, persons who are named in the notice as having been engaged in the prior use to be proved, or as having known of the anticipating process or thing. Accordingly where a notice alleges that A. B. used an anticipating machine in a certain city, and that C. D. had knowledge of that prior use, those facts may both be proved by E. F. without mentioning his name in the notice.² But if A. B. is the only available person by whom to prove his prior use, or if his testimony on that point is to be taken together with that of others, his name must still be mentioned in the notice: mentioned not as a witness to be called to prove a fact, but as the person who transacted that fact.

Notices need not state the particular time when an anticipating printed publication was published, nor when an anticipating process or thing was known or used;³ but they must state the dates of all alleged anticipating patents.⁴ If a notice does unnecessarily state a particular time, that statement will be regarded as harmless surplusage, and a variance therefrom in the evidence, will not render the latter inadmissible.⁵

¹ *Wise v. Allis*, 9 Wallace, 737, 1869.

² *Planing-Machine Co. v. Keith*, 101 U. S. 492, 1879; *Many v. Jagger*, 1 Blatch. 376, 1848.

³ *Phillips v. Page*, 24 Howard, 164, 1860.

⁴ Revised Statutes, Section 4920.

⁵ *Phillips v. Page*, 24 Howard, 164, 1860.

§ 445. Where any defence to a patent action can be based upon a fact of which the court will take judicial notice without evidence, that defence may be made under the general issue without any special pleading.¹

§ 446. The first and second defences are those which come within the rule of the last section relevant to judicial notice. The first defence is applicable mainly or only when a "principle" has been patented, as for example by the eighth claim of Morse,² or by the anæsthesia patent of Morton and Jackson.³ The applicability of judicial notice to that defence is perhaps invariable.

But there appears to be no warrant for saying that the second defence need not be pleaded, where a patent is assailed for want of invention, on account of prior facts which must be proved by evidence, in order to be acted upon by courts.⁴ Justice requires that the plaintiff be notified beforehand of such a defence, as truly as of the defence of want of novelty; for it may equally be based on facts outside of the patent, and outside of the knowledge of the inventor and of the plaintiff.

§ 447. The third defence may be based upon a special plea, instead of on the general issue accompanied by notice; and when that practice is adopted, that plea is the only notice which the plaintiff can claim.⁵ It has been held that special pleas, when used instead of notices, must be filed at least thirty days before the term of trial, or the plaintiff will be entitled to a continuance.⁶ This holding was so reasonable that it can be supported on the ground that every court has power to make reasonable rules to regulate the time of filing pleas.⁷ A special plea which has been stricken out by order of court, cannot operate as a notice, and thus furnish the

¹ *May v. Juneau County*, 137 U. S. 408, 1890.

² *O'Reilly v. Morse*, 15 Howard, 112, 1853.

³ *Morton v. Infirmity*, 5 Blatch. 116, 1862.

⁴ *Brickill v. Hartford*, 57 F. R.

217, 1893; *Britton v. White Mfg. Co.*, 61 F. R. 95, 1894.

⁵ *Evans v. Eaton*, 3 Wheaton, 504, 1818.

⁶ *Phillips v. Comstock*, 4 McLean, 525, 1849.

⁷ *Packet Co. v. Sickles*, 19 Wallace, 611, 1873.

foundation of a defence which requires a notice in the absence of a special plea.¹ And a plea or notice of want of novelty must state that the anticipating fact occurred before the invention claimed by the patent was made; for it is not enough to state that the anticipating fact occurred before the date of the patent.²

§ 448. The fourth defence is not among those which can be made under the general issue accompanied by notice. There is probably no case in which it has been successfully made at law, without being set up in a special plea. In the absence of such precedents, it would be unsafe for a pleader to attempt such an innovation on the rules of the common law.

§ 449. The fifth and sixth defences always require evidence outside of the patent, and outside of the doctrines of judicial notice. They may be made under the general issue accompanied by the statutory notice,³ or under a special plea, but there is no reason to suppose that they can lawfully be made under the general issue alone.

§ 450. The seventh defence is not based on any express statute. Its foundation is the general spirit of the patent laws; and it has been expounded in a number of cases, beginning in the case of *Railway Co. v. Sayles*.⁴ Evidence to support it must always be drawn from outside of the patent, and must be regularly introduced into the case. This defence is therefore to be made by a special plea, when it is made at all.

§ 451. The eighth defence may be made either by the general issue accompanied by notice,⁵ or by special plea. It

¹ *Foote v. Silsby*, 1 Blatch. 445, 1849.

² *Brickill v. Hartford*, 57 F. R. 219, 1893.

³ Revised Statutes, Section 4920.

⁴ *Railway Co. v. Sayles*, 97 U. S. 563, 1878; *Consolidated Electric Light Co. v. McKeesport Light Co.*, 40 F. R. 26, 1889; *Beach v. Box Machine Co.*, 63 F. R. 604,

1894; *Michigan Central Railroad Co. v. Car-Heating Co.*, 67 F. R. 126, 1895; *Bowers v. San Francisco Bridge Co.*, 69 F. R. 644, 1895; *Erie Rubber Co. v. American Dunlop Tire Co.*, 70 F. R. 62, 1895; *Hulett v. Long*, 15 App. D. C. 291, 1899.

⁵ Revised Statutes, Section 4920.

applies to cases where another than the patentee preceded him in the first conception of the patented thing, but did not precede him in adapting it to actual use. If that other stopped with that conception, the validity of the patent is not affected thereby, but if he used reasonable diligence in adapting and perfecting the invention so conceived, no subsequent inventor can have a valid patent, surreptitiously or unjustly obtained by him for the same invention. Such a patent is surreptitiously obtained, where the patentee appropriates the idea from the first conceiver, and, exceeding him in speed, reduces the invention to proper form, and secures the patent, while the first conceiver is diligently laboring to adapt the invention to use. Such a patent is unjustly obtained, if it is issued to a subsequent inventor, when the first conceiver is using due diligence to reduce his invention to practice.¹ Where this defence is pleaded, all its elements must be incorporated in the plea. The allegation of unjust or surreptitious obtaining of the patent, must be accompanied by an allegation that the first conceiver was at the time using reasonable diligence in adapting and perfecting the invention.²

§ 452. The ninth and tenth defences are based on the fact that patents can lawfully be granted to no one but the inventors of the things covered thereby, or to those who represent them as assigns or legal representatives.³ Neither of those defences can ever receive any support from the face of the patent, or from any fact of which any court can take judicial notice. Both depend upon evidence *aliunde*, and either must be interposed in a special plea, for the statute does not include either among those defences which may be made under the general issue accompanied by notice.⁴

§ 453. The eleventh defence may be set up under the general issue accompanied by notice,⁵ or in a special plea; and in

¹ *Yates v. Huson*, 8 App. D. C. 93, 1896.

² *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868.

³ Sections 50 and 51 of this book.

⁴ *Butler v. Bainbridge*, 29 F. R. 143, 1886.

⁵ Revised Statutes, Section 4920.

either way, this defence must be stated with particularity.¹ Even where a patent does contain too much or too little, this defense does not apply, unless the fault was intended, and was intended to deceive the public.² But those intentions will be implied from proof of the fact that the inventor knew the true importance of what he wrongly omitted from his specification, or wrongly inserted therein.³

§ 454. The twelfth defence is somewhat similar to the first member of the eleventh; but unlike that, it cannot be based on the general issue accompanied by notice; and it does not require the element of intention to deceive. It is based upon that provision of the statute which makes a full, clear, concise, and exact description of the invention a prerequisite to the jurisdiction of the Commissioner to grant a patent.⁴ If a patent falls below the statutory requirement in that respect, that patent is void.⁵ Whether a given patent does so fall is a question of evidence and not of construction.⁶ Therefore this defence cannot be made by demurrer.⁷ This defence must be interposed in a special plea; for neither the statute nor any precedent contemplates its being based on the general issue, either with or without notice; and still less does any rule of law provide for its being made on the trial of an action without being pleaded at all.

§ 455. The thirteenth defence is based on the statute which requires that, before any inventor shall receive a patent for his invention, he shall particularly point out, and distinctly claim, the part, improvement or combination which he claims as his invention.⁸ It is a defence of decided merit, aimed by the policy of the law at nebulous claims. The

¹ *American Sulphite Pulp Co. v. Howland Falls Pulp Co.*, 70 F. R. 992, 1895.

² *Hotchkiss v. Oliver*, 5 Denio (N. Y.), 314, 1848; *Celluloid Mfg. Co. v. Russell*, 37 F. R. 679, 1889.

³ *Electric Boot & Shoe Finishing Co. v. Little*, 75 F. R. 276, 1896.

⁴ Revised Statutes, Section 4888.

⁵ *O'Reilly v. Morse*, 15 Howard,

62, 1853; *Pacific Cable Ry. Co. v. Butte City Ry. Co.*, 58 F. R. 422, 1893; *National Chemical & Fertilizer Co. v. Swift & Co.*, 100 F. R. 451, 1900.

⁶ *Loom Co. v. Higgins*, 105 U. S. 580, 1881.

⁷ *Chase v. Fillebrown*, 58 F. R. 376, 1893.

⁸ Revised Statutes, Section 4888.

courts have not heretofore gone so far in upholding this defence as the statute would justify. Probably the strongest judicial language heretofore used on the subject is that of the Supreme Court in the case of *Carlton v. Bokee*.¹ In that case Justice BRADLEY, in delivering the opinion, said that: "Where a specification, by ambiguity and a needless multiplication of nebulous claims, is calculated to deceive and mislead the public, the patent is void." This defence may be made by demurrer;² because the question of the validity of a patent, as against it, is a question of construction of the document, to decide which, a judge will seldom require aid from other evidence than the letters patent themselves. But a special plea is probably the best means of interposing this defence; though there is less meritorious necessity for special pleading to support it, than there is to support any other defence which assails the validity of a patent.

§ 456. The fourteenth defence is based upon the statute which provides that where a new invention and an old one are both claimed in a patent, the patentee may sustain an action on the former, but not unless he disclaims the latter without unreasonable delay.³ That the old invention was old, and that the delay to disclaim it was unreasonable, are matters of fact depending upon evidence. There is therefore no reason to suppose that this defence can be made in any action at law, without a special plea to give it entrance.

§ 457. The fifteenth defence goes to the jurisdiction of the Commissioner to reissue the patent in suit. In the chapter on reissues the defence is discussed with some fullness.⁴ Whatever doubt may exist relevant to its scope, it is clear that the questions which are involved in its applicability to a particular case, are mainly questions of fact, depending upon evidence *in pais*, and that a special plea is therefore the proper means of bringing it to the attention of the court.

§ 458. The sixteenth defence originated in the year 1882,⁵

¹ *Carlton v. Bokee*, 17 Wallace, 472, 1873.

² *Brickill v. Hartford*, 49 F. R. 373, 1892.

³ Revised Statutes, Section 4922.

⁴ Section 221 of this book.

⁵ *Miller v. Brass Co.*, 104 U. S. 350, 1882.

and though not based on the letter of any statute, it has been many times enforced. The first element in its foundation is a point of comparative construction of the original and the reissue patent. But inasmuch as a plaintiff, suing on a reissue, need not introduce the original in evidence, even that element depends upon proof by the defendant of the contents of the original. The second element is a variable quantity, for the particular length of time between the date of an original and the application for a reissue patent, which will be fatal to a broadened reissue, depends upon the circumstances of each case, and those circumstances can be made known to the court through evidence alone. These considerations point to the propriety of disregarding this defence, in an action at law, unless it is set up in a special plea, and the plaintiff thus notified of what he must meet on the trial.

§ 459. The seventeenth defence depends upon proof of the original patent, and requires at least that amount of evidence to support it. In cases where the question of sameness or difference of invention is a complicated one, courts may require the benefit of evidence on that subject to aid them in deciding the point. In order to give both sides an opportunity to produce such evidence, a special plea seems necessary; but it has been decided that a general denial of the declaration is enough.¹

§ 460. The eighteenth defence can be made by a demurrer in a case which is based on the prior patent, as well as on its alleged double;² but in other cases it requires a special plea, because it is a defence in confession and avoidance of the declaration.

§ 461. The nineteenth defence will of course require evidence of the record of the court which repealed the patent. But as that record cannot be contradicted by any evidence, and as no repeal could have been had without the knowledge of the plaintiff or his privies, there seems to be no meritorious reason why a special plea should be insisted upon

¹ Oregon Imp. Co. v. Excelsior Coal Co., 132 U. S. 215, 1889.

² Russell v. Kern, 64 F. R. 581, 1894.

to sustain this defence. But in the absence of a precedent, that will be the safest pleading for the defendant to file.

§ 462. The twentieth defence demands a special plea, where it is based on the expiration of a foreign patent on the same invention as that of the patent in suit; because the evidence to prove the existence and the expiration of the foreign patent, must come from outside the patent in suit, and must generally be supported by expert testimony that the foreign patent produced is really one for the same invention as the patent in suit. Indeed, the defense may fail even then, for it cannot stand against proof that the foreign patent was surreptitiously taken out by another than the United States patentee, and without his knowledge or consent. It would be unjust to allow a plaintiff to be surprised on the trial of an action at law, with proof of a foreign patent for his invention granted to another, after his invention was made, but before the date of his patent. Such a piece of evidence, if unexplained, might limit the duration of the United States patent, and thus perhaps defeat the suit. It is clear, therefore, that no such issue ought to be sprung upon a plaintiff when before the court. A special plea is requisite to give him notice of a fact apparently so unfavorable.

§ 463. The twenty-first defence can be made under the general issue, for it must be negatived in the declaration.¹

§ 464. The twenty-second defence can be made under the general issue, where the defendant merely proposes to argue that the plaintiff's evidence does not make out any title, or makes out no such title as enables him to sue in an action at law. But where the defendant attacks the plaintiff's title on the basis of a paramount assignment to another, he ought to plead the defence specially, for otherwise the plaintiff might be surprised on the trial with evidence which, with a little time for preparation, he could perhaps explain away, or perhaps overthrow.

§ 465. The twenty-third and twenty-fourth defences both required to be pleaded specially according to the pleading rules of the ancient common law.² But under the relaxa-

¹ *Dunlap v. Schofield*, 152 U. S. 244, 1894. ² *Stephen on Pleading*, 158.

tion which obtained in England, in the eighteenth century, they could, in ordinary cases, have been proved under the general issue.¹ That relaxation does not, however, deserve to be extended by any process of reasoning by analogy; and it is possible that the courts will hold that it does not apply to patent litigation in the United States.

§ 466. The twenty-fifth defence is one to which the plea of the general issue is, and always was, appropriate, for it is a defence which consists simply in a denial of the alleged infringement.² And even where a proper defence of non-infringement involves evidence of the state of the art, the general issue is a sufficient plea under which to make such a defence, because no notice to the plaintiff is necessary to render such evidence admissible.³

§ 467. The twenty-sixth defence is as proper in an action at law as it is in an action in equity.⁴ Estoppels in patent cases are like those in other cases, in that they are divisible into three classes: Estoppels by matter of record; by matter of deed; and by matter *in pais*. The principles of estoppel constitute a systematic department of the law, to the delineation and development of which a number of text-writers have devoted careful and thorough consideration. No extensive discussion of the subject is therefore to be expected in this book. Something has already been written about estoppel *in pais*, in connection with the subject of implied licenses.⁵ And it may be mentioned here, that a defendant is not estopped from denying the validity of a patent, by the fact that he formerly thought and represented it to be valid,⁶ or the fact that he once made an application himself, for a patent on the same invention.⁷ And something more may be added in this place, about estoppels by matter of record, and by matter of deed, for the patent precedents contain a

¹ 1 Chitty on Pleading, 491.

² Stephen on Pleading, 160.

³ Dunbar v. Myers, 94 U. S. 108, 1876; Eachus v. Broomall, 115 U. S. 434, 1885; Grier v. Wilt, 120 U. S. 429, 1886.

⁴ Dickerson v. Colgrove, 100 U.

S. 584, 1879; City of Concord v. Norton, 10 F. R. 477, 1883.

⁵ Section 313 of this book.

⁶ De La Vergne Machine Co. v. Featherstone, 49 F. R. 919, 1892.

⁷ Page v. Buckley, 67 F. R. 142, 1895.

few cases in which those doctrines have been applied to controversies touching letters patent for inventions. But the investigator will often need to resort to the standard textbooks on estoppel, when seeking for the law applicable to such matters, as they may hereafter arise in patent litigation; for the instances in which the doctrines of estoppel have heretofore been applied to patent cases are comparatively few. These doctrines may, however, be deduced from other kinds of causes, and then applied in patent litigation with all their inherent forces.¹

§ 468. Estoppel by matter of record arises out of the doctrine of *res judicata*; and indeed that sort of estoppel generally and properly passes under the name of that doctrine. It is a requirement of public policy and of private peace, that each particular litigation shall duly come to an end, and that when once ended, it shall not be revived. The law therefore properly requires that things adjudicated shall not again be drawn in question between the same parties, or between any persons whose connection with the adjudication is such that it ought to bind them all.² But a person cannot invoke an adjudication, on the ground that he contributed money to the litigation which produced it, unless that fact was known, at the time it occurred, to the party against whom the adjudication is sought to be invoked.³ Interlocutory decrees furnish no foundation for a plea of *res judicata*.⁴ And it is only in respect of questions actually litigated and decided in a prior case, that the judgment is conclusive in another action.⁵

A final decree is pleadable, in a subsequent action, notwithstanding the defendant may have new defences to inter-

¹ *Duboise v. Railroad Co.*, 5 Fisher, 208, 1871.

² *Hubbell v. United States*, 171 U. S. 209, 1898; *Bradley Mfg. Co. v. Eagle Mfg. Co.*, 57 F. R. 985, 1893; *Westinghouse Electric & Mfg. Co. v. Stanley Electric Mfg. Co.*, 117 F. R. 309, 1902.

³ *Cramer v. Singer Mfg. Co.*, 93 F. R. 636, 1899; *Lane v. Welds*, 99 F. R. 287, 1899; *Hanks Dental*

Ass'n v. International Tooth Crown Co., 122 F. R. 74, 1903.

⁴ *Rumford Chemical Works v. Hecker*, 2 Bann. & Ard. 359, 1876; *Roemer v. Neumann*, 26 F. R. 332, 1886; *Morss v. Knapp*, 37 F. R. 353, 1889; *Harmon v. Struthers*, 48 F. R. 260, 1891; *Brush Electric Co. v. Western Electric Co.*, 76 F. R. 764, 1896.

⁵ *Bruise v. Peck*, 54 F. R. 822.

pose: defences, which he did not deem it necessary to make to the former suit, or did not learn of in time to set them up in the former litigation.¹ And final decrees or judgments are not only binding on the parties to the actions from which they resulted, but they are also conclusive against or for all persons who purchase interests in the subject-matter of litigation after such decrees or judgments are entered;² or even before such entry, if after the beginning of the action which resulted in those judgments or decrees;³ and also against or for persons who openly assumed the control and expense of the former litigation, even though not parties thereto.⁴ So, also, judgments by default, decrees *pro confesso*, and consent decrees are pleadable as *res judicata*, if they are final in their nature, with the same effect as are judgments or decrees which were rendered after long-contested litigations.⁵

But in order to be binding on either party to a new action, a former judgment or decree must be binding on both.⁶ No former adjudication is pleadable in favor of either party to a suit, unless it would have been pleadable against him, if it had been rendered the other way.⁷ But a decree may be

1893; *Mack v. Levy*, 60 F. R. 751, 1894; *Norton v. Jansen*, 81 F. R. 505, 1897.

¹ *Duboise v. Railroad Co.*, 5 Fisher, 210, 1871; *Gloucester Isinglass Co. v. LePage*, 30 F. R. 371, 1887; *Bradley Mfg. Co. v. Eagle Mfg. Co.*, 57 F. R. 989, 1893; *Mack v. Levy*, 60 F. R. 752, 1894.

² *Consolidated Fruit Jar Co. v. Whitney*, 2 Bann. & Ard. 33, 1875; *Pennington v. Hunt*, 20 F. R. 195, 1884; *Norton v. San Jose Fruit-Packing Co.*, 79 F. R. 793, 1897; *Newton Mfg. Co. v. Wilgus*, 90 F. R. 484, 1898.

³ *Carroll v. Goldschmidt*, 83 F. R. 509, 1897.

⁴ *United States Felting Co. v. Asbestos Felting Co.*, 4 F. R. 816, 1880; *American Bell Telephone*

Co. v. National Telephone Co., 27 F. R. 665, 1886; *Eagle Mfg. Co. v. Miller*, 41 F. R. 357, 1890; *Eagle Mfg. Co. v. Bradley Mfg. Co.*, 50 F. R. 193, 1891; *Bradley Mfg. Co. v. Eagle Mfg. Co.*, 57 F. R. 985, 1893; *National Folding-Box Co. v. Dayton Paper Novelty Co.*, 95 F. R. 991, 1899.

⁵ *Bradford v. Bradford*, 5 Connecticut, 131, 1823; *Davis v. Murphy*, 2 Rich. (S. C.) 560, 1846; *United States Packing Co. v. Tripp*, 31 F. R. 350, 1887; *Carroll v. Goldschmidt*, 83 F. R. 509, 1897.

⁶ *Mack v. Levy*, 60 F. R. 752, 1894.

⁷ *Ingersoll v. Jewett*, 16 Blatch. 378, 1879; *Dale v. Roosevelt*, 1 Paige (N. Y.), 35, 1828; *Paynes v. Coles*, 1 Munford (Va.), 394,

pleadable against a complainant, only on a single point in a subsequent case, though it would have been pleadable against the defendant on all the points in that case, if it had been rendered the other way; because to be rendered the other way, all those points would have to be decided for the complainant, whereas only one of those points might have to be decided against the complainant, in order to necessitate a decree for the defendant.¹ On the other hand, a decree may be pleadable for the complainant, only on the subject of the validity of his patent, and not upon the question of its infringement by the defendant.²

§ 469. Estoppel by matter of deed may also arise in patent affairs. Where, for example, an assignor or grantor of a patent right, afterward infringes the right which he conveyed, he is estopped by his conveyance, from denying the plaintiff's title,³ or the validity of the patent, when sued for its infringement,⁴ even where the invalidity is due to an unlawful reissue obtained after the assignment.⁵ But such an assignor or grantor is not estopped, by his conveyance, from showing how narrowly the patent must be construed.⁶

§ 470. The defence of estoppel requires a special plea to

1810; *Greene v. City of Lynn*, 55 F. R. 522, 1893.

¹ *Steam Gauge & Lantern Co. v. Meyrose*, 27 F. R. 213, 1886.

² *Bradley Mfg. Co. v. Eagle Mfg. Co.*, 57 F. R. 988, 1893.

³ *Woodward v. Lasting Mach. Co.*, 60 F. R. 284, 1894.

⁴ *Consolidated Middlings Purifier Co. v. Guilder*, 9 F. R. 156, 1881; *Adee v. Thomas*, 41 F. R. 345, 1890; *Corbin Lock Co. v. Yale & Towne Mfg. Co.*, 58 F. R. 565, 1893; *Martin & Hill Cash Carrier Co. v. Martin*, 67 F. R. 787, 1895; *National Conduit Co. v. Connecticut Pipe Mfg. Co.*, 73 F. R. 491, 1896; *Daniel v. Miller*, 81 F. R. 1000, 1897; *Griffith v. Shaw*, 89 F. R. 313, 1898; *Smith v. Ridgely*,

103 F. R. 875, 1900; *Force v. Sawyer-Boss Mfg. Co.*, 111 F. R. 902, 1901; *Consolidated Rubber Tire Co. v. Finley Rubber Tire Co.*, 116 F. R. 629, 1902.

⁵ *Burdsall v. Curran*, 31 F. R. 919, 1887.

⁶ *Babeock v. Clarkson*, 63 F. R. 607, 1894; *Western Telephone Construction Co. v. Stromberg*, 66 F. R. 551, 1895; *Martin Cash Carrier Co. v. Martin*, 67 F. R. 787, 1895; *Missouri Lamp & Mfg. Co. v. Stempel*, 75 F. R. 583, 1896; *Noonan v. Chester Park Athletic Club Co.*, 99 F. R. 90, 1900; *Alvin Mfg. Co. v. Scharling*, 100 F. R. 87, 1900; *Smith v. Ridgely*, 103 F. R. 875, 1900.

introduce it into a litigation. Thus, for example, if a former judgment or decree is not pleaded as an estoppel by a defendant, he refers the merits of the controversy anew to the court. The former adjudication may be used as an argument, but it cannot be relied upon as a bar, unless it is set up in a special plea.¹

§ 471. The twenty-seventh defence may be made by demurrer,² but if not so interposed it must always be specially pleaded by the defendant, or it will be disregarded by the court.³ No defendant can avail himself of any statute of limitation, upon the general issue.⁴

§ 472. A national statute of limitation for patent suits, has been in existence and in force since the beginning of 1898. That statute provides that there shall be no money recovery in any such suit, for any infringement committed more than six years before the beginning of such an action.⁵

§ 476. State statutes of limitation can never apply to any right of action under a patent, if that particular right is subject to the running of a national statute of limitations.⁶ This point of law follows from the fact that the States have no right to control the operation of the patent laws;⁷ and from the fact that Congress never adopted State laws for the government of Federal courts in any case where the constitution, treaties or statutes of the United States specially attend to the subject.⁸

§ 477. State statutes of limitation, on actions based on torts unaccompanied by force, apply to such actions for infringements of patents, as are not subject to any national statute of limitation.⁹

¹ 1 Chitty on Pleading, 509.

² Brickill v. Hartford, 49 F. R. 373, 1882.

³ 1 Chitty on Pleading, 498.

⁴ Neale v. Walker, 1 Cranch's Circuit Court Reports, 57, 1802.

⁵ 29 Statutes at Large, p. 694, Ch. 391, Section 6.

⁶ Sayles v. Oregon Central Railroad Co., 4 Bann. & Ard. 429, 1879; Hayden v. Oriental Mills, 22

F. R. 103, 1884; May v. County of Logan, 30 F. R. 256, 1887.

⁷ M'Culloch v. Maryland, 4 Wheaton, 436, 1819.

⁸ Revised Statutes, Section 721; Section 34 of the Judiciary Act of 1789; 1 Statutes at Large, Ch. 20, p. 92.

⁹ Campbell v. Haverhill, 155 U. S. 613, 1895.

§ 478. Replications and subsequent pleadings are seldom required in patent cases, because most of the pleas applicable to such cases are pleas in bar by way of traverse, and not by way of confession and avoidance.¹ The principal exceptions are the plea of a license, the plea of a release, and the plea of a statute of limitation. If the plaintiff purposes to deny the existence of a license or release, as the case may be, his replication should be by way of traverse to the plea, and should conclude to the country, and thus tender issue. So, also, if the plaintiff can show that the license or release covered only a part of the infringement covered by the declaration, the general replication by way of traverse will be sufficient.² If the plaintiff cannot deny the existence of a full paper, but purposes to show that it was obtained by duress or by fraud, or that it has been effectually revoked, his replication will state the facts by way of confession and avoidance of the plea, and will conclude with a verification. It will then be the duty of the defendant to file a rejoinder to the replication. If he can deny the duress, or the fraud, or the revocation, as the case may be, his rejoinder will be by way of traverse, and will conclude by tendering issue. If, however, he cannot deny the truth of the replication, but can avoid its effect by showing that the plaintiff freely ratified the license or release after the alleged duress terminated, or the alleged fraud became known to him, or that he annulled the revocation after making it, then the defendant's rejoinder will be by way of confession and avoidance, and will conclude with a verification, and will render necessary a sur-rejoinder from the plaintiff, denying the truth of the rejoinder, and putting himself upon the country.

§ 481. A similiter must be filed or added by or on behalf of the other party, whenever either the plaintiff or defendant properly tenders issue. As the party to whom issue is well tendered, has no option but to accept it, the similiter may be added for him. It is a mere matter of form, but

¹ *Brickill v. Hartford*, 57 F. R. 219, 1893.

² 1 *Chitty on Pleading*, 596.

it is a form which should always be attended to in common-law pleading. Its omission has sometimes constituted a fatal defect.¹

§ 482. A demurrer may be interposed by either party in an action at law, to any pleading of his opponent, except another demurrer.² When a demurrer is interposed, the court will examine all the pleadings in the case, and will generally decide against the party who first filed a substantially defective one.³ The principal exception to this rule is, that where the declaration is the pleading demurred to, the demurrer will not be sustained if it is too large; that is, if it is pointed at an entire declaration, some independent part of which is good in law.⁴ This exception does not apply to demurrers to pleas,⁵ or replications,⁶ or rejoinders,⁷ for it is in the nature of those pleadings to be entire, and if bad in part, to be bad for the whole.

§ 483. Demurrable declarations occur in patent cases when the patent appears to be void on its face, or by reason of some fact within judicial notice; or when the plaintiff's pleader omits some of the allegations which are necessary parts of such a pleading; or when he makes those allegations in improper form; or where he makes the statement of infringement cover a space of time, part or all of which is remote enough to be barred by the statute of limitation. It will rarely occur that the whole of an infringement declared upon can plausibly be claimed to be thus barred; but it may not be unknown for declarations to allege that the infringement sued on began at a point of time more than six years before the beginning of the action, and was continued till after that limit was passed. If, in such a case, the defendant would interpose the statute of limitation to that part of the infringement which occurred more than six years before the bringing of the suit, he may do so by a special demurrer aimed at the questionable part of the right of

¹ Earle v. Hall, 22 Pickering (Mass.), 102, 1839.

² 1 Chitty on Pleading, 661, 666.

³ 1 Chitty on Pleading, 668.

⁴ 1 Chitty on Pleading, 665.

⁵ 1 Chitty on Pleading, 546.

⁶ 1 Chitty on Pleading, 644.

⁷ 1 Chitty on Pleading, 651.

action. If, in such a case, he demurs generally to the whole declaration, his demurrer will be overruled, because it will appear on the argument that an independent, divisible part of the right of action sued upon is unbarred by the statute.¹

§ 484. Demurrable pleas occur in patent cases whenever the facts stated therein constitute no defence to the action; or when they are in improper form; or when the statute of limitation is pleaded to the whole of a right of action, only a part of which is old enough to be barred thereby; for a plea which is bad in part, is bad altogether.²

§ 486. A joinder in demurrer is the proper response to such a pleading in a patent action, as well as any other. If a plaintiff attempts to demur to a demurrer, or refuses to join issue of law upon it, he thereby discontinues his action; and if a defendant does so he discontinues his defence.³ But the actual filing in writing of a joinder in demurrer is generally waived, and demurrers are generally brought on for argument without that formality.

When a demurrer to an entire declaration is sustained, on a ground which cannot be cured by amendment, the plaintiff may file an exception, and take the case to the Circuit Court of Appeals for a review of the decision upon the demurrer; and he must do so, or abandon his action. But where a demurrer to a declaration is overruled, the defendant may either file an exception and take the case to the Circuit Court of Appeals for review, or may obtain leave of court to file a plea to the declaration. If he takes the latter course, he cannot set up in that plea any defence which was set up in the overruled demurrer. And if his other defences fail on the trial, and he afterward takes the case to the Circuit Court of Appeals, he cannot get a review of the decision of the Circuit Court overruling his demurrer to the declaration. For this reason, it is not wise to trust any vital defence to the carriage of a demurrer, except where

¹ 1 Chitty on Pleading, 665.

² 1 Chitty on Pleading, 546.

³ Gould's Pleadings, Ch. IX, Sec-

tion 33; 1 Chitty on Pleading,

169.

the defendant has no other vital defence, or except where he is certain that his demurrer will not be overruled.

Where a demurrer to a plea is sustained, on a ground which cannot be cured by amendment, the defendant may file an exception, and take the case to the Circuit Court of Appeals for a review of the decision upon the demurrer: or he may go to trial upon any other plea which he may have filed, and which has not been demurred to, or has repelled a demurrer. If he takes the latter course, and is beaten on the trial, and afterward takes the case to the Circuit Court of Appeals, he ought, in that tribunal, to get a review of the decision of the Circuit Court sustaining the demurrer to his plea; for he could not prevent the filing of that demurrer, and without such a review can get no appeal from the decision of the Circuit Court sustaining it. But where a demurrer to a plea is overruled, the plaintiff must stand by that demurrer, and take the case to the Circuit Court of Appeals upon that issue alone, or if he goes to trial without doing so, he will thereby waive his demurrer; and if he is unsuccessful on the trial, and thereafter takes the case to the Circuit Court of Appeals, he cannot secure in that court a review of the decision of the court below, overruling his demurrer to the plea.

§ 487. The trial of an action at law for infringement of a patent may be by a jury, or by a judge, or by a referee. The first of these sorts of trial is the only proper one, except in cases where both parties agree to substitute one of the others. Cases of the kind may be tried by the judge, where the parties file with the clerk a stipulation in writing waiving a jury;¹ and trial by a referee appointed by the court, with the consent of both parties, is a mode of trial fully warranted by law.²

§ 488. Trial by jury must, in the absence of contrary consent by the parties, be by a jury of twelve men. Unanimity is necessary to a verdict of a jury in a Federal court, even in California or Nevada; though the statutes of

¹ Revised Statutes, Section 649.

² *Heckers v. Fowler*, 2 Wallace, 123, 1864.

those States provide that in their courts, a legal verdict may be found when three-fourths of the members of a jury agree. The laws of those States on that point are not covered by Section 721 of the Revised Statutes, and so made rules of decision in Federal courts; because the Federal Constitution otherwise provides. That provision is found in its seventh amendment, and in the following language: "In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved." It is true that unanimity was not necessary to the verdicts of juries in England till after the reign of Edward the First,¹ and that it was never required in Scotland.² But the kind of "trial by jury," known in England and in the United States when the seventh amendment was proposed by Congress,³ and when it was ratified by three-fourths of the States,⁴ is doubtless the kind of trial guaranteed by that amendment.⁵ Therefore, no law providing for any other kind of trial by jury can be enforced in a United States court.

§ 489. The practice in actions at law in the Federal courts is not uniform throughout the United States. There are no general rules governing the Circuit Courts when sitting as law courts. When thus sitting, each Circuit Court is governed, in matters of practice, by the laws of the State in which it is established, so far as those laws are applicable;⁶ and on points where no law exists, it is governed by rules or customs of its own making or observance. No Act of Congress is necessary to enable a United States court to make and enforce its own rules of practice. It is only necessary that such rules be not repugnant to the laws of the United States.⁷

§ 490. The rules of evidence which are used in the trial

¹ Bracton, Liber IV. Ch. 19; Fleta, Liber IV. Ch. 9; Britton, Liber II, Ch. 21.

² Barrington on the Statutes, Ch. 29, p. 20; 17 & 18 Victoria, Ch. 59; 22 & 23 Victoria, Ch. 7; 31 & 32 Victoria, Ch. 100, Section 48.

³ September 25, 1789.

⁴ November 3, 1791.

⁵ Thompson v. Utah, 170 U. S. 349, 1898.

⁶ Revised Statutes, Section 914.

⁷ Heckers v. Fowler, 2 Wallace, 123, 1864.

of patent causes are the ordinary rules of the common law, as modified by the statutes of the particular States in which such trials occur,¹ and as adapted to the circumstances of patent litigation by the decisions of the United States courts.

§ 491. Evidence to support his declaration must of course be introduced by a plaintiff in a patent suit before the defendant can be called upon to prove any defence. Where the complainant or the defendant is a corporation, and that fact is not admitted in the defendant's plea, it must be proved by the plaintiff; and it may be proved by a certified copy of its charter or articles of incorporation. Aside from that preliminary matter, the first item of the plaintiff's evidence consists of the letters patent sued upon, or of a written or printed copy of the same, authenticated by the seal and certified by the Commissioner or the Acting Commissioner of the Patent Office.² Either the letters patent, or such a copy thereof, is *prima facie* evidence of the validity of the letters patent, unless it appears on its face not to be such a form of document as the statute prescribes.³ But the printed memorandum, which is usually made at the head of the specification of a patent, and which states the date of the filing of the application for that patent, is not even *prima facie* evidence of that date.⁴ That point, if it is material in a particular case, must be proved by a certified copy of the application itself.

§ 492. Reissue letters patent are also *prima facie* evidence of their own validity, on all of the three points which are involved in that question. They are so in respect of the fifteenth defence; because the fact that the Commissioner

¹ *Vance v. Campbell*, 1 Black, 427, 1861; *Hausknecht v. Claypool*, 1 Black, 431, 1861; *Wright v. Bales*, 2 Black, 535, 1862.

² Revised Statutes, Section 892.

³ *Hunt Bros. Fruit Packing Co. v. Cassidy*, 53 F. R. 259, 1892; *Singer Mfg. Co. v. Brill*, 54 F. R. 383, 1892; *Holloway v. Dow*, 54 F. R. 514, 1893; *Harper & Rey-*

nolds Co. v. Wilgus, 56 F. R. 588, 1893; *Chase v. Fillebrown*, 58 F. R. 376, 1893; *Schwarzwaelder v. Detroit*, 77 F. R. 889, 1896; *J. J. Warren Co. v. Rosenblatt*, 80 F. R. 540, 1897; *Wilkins Shoe-Button Fastener Co. v. Webb*, 89 F. R. 996, 1898.

⁴ *International Terra Cotta Co. v. Maurer*, 44 F. R. 620, 1890.

assumed jurisdiction, by treating the original letters patent as a proper subject for a reissue, is at least *prima facie* evidence that he had jurisdiction.¹ They are so in respect of the sixteenth defence; because the presumption is that the Commissioner knew the law, and, knowing it, would not grant a broadened reissue after a long lapse of time from the date of the original.² They are so in respect of the seventeenth defence; because the presumption is that the Commissioner would not violate the law, by granting a reissue for a different invention from any which the original letters patent shows was intended to have been claimed therein.

§ 494. It is an undoubted presumption of law that letters patent, which appear on their face to be in full force, are so in fact. Such a document is therefore *prima facie* evidence that it neither has been repealed by a decree of court, nor has expired because of the expiration of some foreign patent for the same invention. It follows that neither the nineteenth nor twentieth defence needs to be anticipated by a plaintiff when introducing his *prima facie* evidence.

§ 495. After introducing the letters patent in evidence, unless the plaintiff is himself the patentee, his next step is to prove his title to the right, upon the infringement of which the action is based. Where the letters patent were originally granted to an assignee of the inventor, they are *prima facie* evidence of title in that assignee.³ But where the plaintiff obtained his title after the letters patent were granted, he must prove himself to have been the assignee of the patent, or at least a grantee under it as to the territory wherein the alleged infringement occurred, when that infringement occurred. He may do either of these, by properly introducing in evidence the original assignments or grants which constitute his chain of title.

Where such a document was acknowledged before a notary

¹ Brooks v. Bicknell, 3 McLean, 258, 1843.

² Clark v. Wooster, 119 U. S. 326, 1886.

³ Whitcomb v. Coal Co., 47 F. R. 655, 1891.

public, or other magistrate specified in the statute, the certificate of that acknowledgment is *prima facie* evidence of the execution of the document.¹ In the absence of such an acknowledgment; it is necessary to prove such a paper according to the rules of the common law. When proceeding under those rules, to prove a paper which appears to have been subscribed by a witness, as well as by the grantor or assignor; the first step is to produce that witness, and take his testimony to the fact and the genuineness of his signature; or if he cannot be produced, the first step consists in proving, if possible, what has become of him, and if that is impossible, in proving that fact. When this step has been taken, and also where there is no subscribing witness to the document to be proved, it can be proved by testimony of the genuineness of the signature of him who executed it, as assignor or grantor, as the case may be. Where an original assignment or grant, which is essential to the plaintiff's title, cannot be produced, its character may be proved according to the rules of the law of evidence relevant to such cases.

Whether a certified copy of the Patent Office record of an assignment or grant of a patent is admissible evidence of the original document or of the Patent Office record thereof, is a question which was long ago decided in the affirmative,² and afterward was decided in the negative,³ and then in the affirmative again,⁴ and finally again in the negative.⁵ Assuming the negative decisions to be right; it seems that the

¹ 29 Statutes at Large, Ch. 391, Section 5, p. 693; *De Laval Separator Co. v. Vermont Farm-Mach. Co.*, 109 F. R. 813, 1901; *Lanyon Zinc Co. v. Brown*, 115 F. R. 154, 1902.

² *Brooks v. Jenkins*, 3 McLean, 436, 1844; *Parker v. Haworth*, 4 McLean, 370, 1848; *Lee v. Blandy*, 2 Fisher, 91, 1860; *Dederick v. Whitman Agricultural Co.*, 26 F. R. 763, 1886; *National Folding Box & Paper Co. v. American*

Paper Pail & Box Co., 55 F. R. 488, 1893.

³ *Paine v. Trask*, 56 F. R. 233, 1893; *Mayor of New York v. American Cable Ry. Co.*, 60 F. R. 1016, 1894.

⁴ *Standard Elevator Co. v. Crane Elevator Co.*, 76 F. R. 792, 1896.

⁵ *National Cash Register Co. v. Navy Cash Register Co.*, 99 F. R. 89, 1900.

inadmissibility of such a certified copy is waived by an omission to make a proper objection when such a copy is offered in evidence.¹

§ 496. It is not necessary for any plaintiff to prove in his *prima facie* evidence that the defendant has no license or release with which to defend.² But it is required of him to prove that he never made nor sold any specimen of the invention without marking it "patented," together with the day and year the patent was granted; or that the defendant was duly notified that his doings constituted an infringement of the patent, and, after such notice, continued to infringe.³

§ 497. Proof of the making, selling, or using, by the defendant, before the beginning of the suit, of a specimen or specimens of a process or thing which the plaintiff claims is covered by his patent, constitutes the next step to be taken in proving a *prima facie* case. This point is often covered by a stipulation of the parties. In the absence of such a stipulation the point of proof may be one of difficulty, for courts of law have no power to order inspections of a defendant's works;⁴ though the defendant may be called as a witness, and compelled to describe what he has done;⁵ and a discovery of the defendant's doings may be obtained by a bill in equity filed in aid of an action at law.⁶ Where a defendant cannot be relied upon to testify fairly and fully, the plaintiff must secure other evidence; for it is necessary to a verdict in an action at law for an infringement of a patent, that both the nature and extent of that infringement be shown to the jury by satisfactory proof. Evidence of the nature of a defendant's doings is the first element of evi-

¹ *International Tooth-Crown Co. v. Bennett*, 72 F. R. 170, 1896; *A. B. Dick Co. v. Henry*, 75 F. R. 388, 1896.

² *Fischer v. Hayes*, 6 F. R. 79, 1881.

³ *Dunlap v. Schofield*, 152 U. S. 244, 1894; *Traver v. Brown*, 62 F. R. 933, 1894; *Matthews & Willard Mfg. Co. v. National Brass & Iron*

Works, 71 F. R. 518, 1895; *Campbell v. City of New York*, 81 F. R. 184, 1897.

⁴ *Parker v. Bigler*, 1 Fisher, 287, 1857.

⁵ *Roberts v. Walley*, 14 F. R. 169, 1882; *Delamater v. Reinhardt*, 43 F. R. 76, 1890.

⁶ *Colgate v. Compagnie Francaise*, 23 F. R. 85, 1885.

dence of infringement; and evidence of their extent is an indispensable part of the necessary evidence of damages.¹

§ 498. Evidence of infringement is completed with evidence of the defendant's doings, if what he did was obviously and unquestionably identical with what is covered by the patent in suit,² or if he is estopped from denying identity between those doings and that patent.³ And even where differences are apparent, the complainant, if he chooses, may rest when he has introduced evidence or a stipulation stating the character of the acts done by the defendant. In that case the court will interpret the words of the patent in the sense in which they are ordinarily employed, and, with the knowledge of the invention thus acquired, will determine whether the acts done by the defendant amount to infringement.⁴ But judges do not always possess the requisite knowledge of the meaning of the terms of art or science used in letters patent, and are not always able to accurately weigh similarities and differences in mechanics, chemistry, electricity, or other physics, without receiving special information thereon. Therefore it is always proper and generally necessary to introduce expert testimony to show that the differences are all immaterial, and to show that the defendant's doings actually did constitute an infringement of the plaintiff's patent.⁵

Experts in patent cases are mainly experts in mechanics, chemistry, or electricity; and a man who has extensive theoretical and practical knowledge of either of those sciences, is a mechanical, chemical, or electrical expert, as the case may be; and a man may be an expert in any other

¹ *National Car-Brake Shoe Co. v. Mfg. Co.*, 19 F. R. 519, 1884.

² *Jennings v. Kibbe*, 10 F. R. 669, 1882; *Barrett v. Hall*, 1 Mason, 471, 1818; *Hayes v. Bickelhaupt*, 23 F. R. 184, 1885; *Freese v. Swartchild*, 35 F. R. 141, 1888; *Sugar Mfg. Co. v. Yaryan Mfg. Co.*, 43 F. R. 148, 1890; *Hardwick v. Mas-*

land, 71 F. R. 889, 1895; *McDowell v. Kurtz*, 77 F. R. 207, 1896.

³ *Time Telegraph Co. v. Himmer*, 19 F. R. 322, 1884.

⁴ *American Linoleum Co. v. Nairn Linoleum Co.*, 44 F. R. 756, 1890.

⁵ *Overweight Elevator Co. v. Improved Order of Red Men*, 94 F. R. 161, 1899.

science, who possesses the same qualifications in it. The opinions of such experts are admissible upon the points of fact to which they are relevant; but in order to have much weight, they must be accompanied by statements of good reasons upon which they are based.¹ An expert may properly write out in advance, the testimony he intends to give; but he cannot properly adopt and insert in his deposition, or read in open court as his testimony, any exposition of the subject which was written by another man.² Communications between expert witnesses and the parties or the counsel who employ them, are not privileged,³ and therefore it is proper on cross-examination to ascertain and record the origin and the development of the opinions which such witnesses state in their depositions or oral testimony.

In deciding between contradictory expert testimony, juries should consider the respective reasons, ability, knowledge, and fairness of the experts.⁴ To judge according to their number or their fame would be unsafe. The wealthier litigants are generally those who employ the more numerous and the more expensive expert witnesses; but it is not always the wealthier litigant who is right in a controversy, nor always the more famous expert who is right in his opinion. The carefully digested views of a young and studious scientist, may be more nearly true than the more hastily formed opinion of a more distinguished man. And testi-

¹ *United States Annunciator Co. v. Sanderson*, 3 Blatch. 184, 1854; *Livingston v. Jones*, 1 Fisher, 521, 1859; *Conover v. Rapp*, 4 Fisher, 57, 1859; *Norton v. Jensen*, 49 F. R. 864, 1892; *Briggs v. Central Ice Co.*, 54 F. R. 379, 1892.

² *Emerson Co. v. Nimocks*, 88 F. R. 282, 1898.

³ *Lalancé & Grosjean Mfg. Co. v. Haberman Mfg. Co.*, 87 F. R. 364, 1898.

⁴ *Johnson v. Root*, 1 Fisher, 351, 1858; *Many v. Sizer*, 1 Fisher, 17,

1849; *Hudson v. Draper*, 4 Fisher, 256, 1870; *Page v. Ferry*, 1 Fisher, 298, 1857; *Carter v. Baker*, 1 Sawyer, 512, 1871; *Spaulding v. Tucker: Deady*, 649, 1869; *Cahoon v. Ring*, 1 Cliff. 592, 1861; *Cox v. Griggs*, 1 Bissell, 362, 1861; *Conover v. Roach*, 4 Fisher, 12, 1857; *Whipple v. Mfg. Co.*, 4 Fisher, 29, 1858; *Conover v. Rapp*, 4 Fisher, 57, 1859; *Waterbury Brass Co. v. New York Brass Co.*, 3 Fisher, 43, 1858; *Bierce v. Stocking*, 11 Gray (Mass.), 174, 1858.

mony based on experience is more weighty than testimony based on theoretical consideration.¹

§ 499. No expert can know whether a particular thing, done or made by a defendant, is the same as any thing covered by a particular patent, until he ascertains what that patent covers. But the latter question is one of construction for the court, and not a question of evidence, to be sworn to by an expert, and decided by the jury. In the regular course of proceedings in trials at law, as well as in hearings in equity, the construction of the patent is not announced by the judge till after the evidence is taken. This practice makes it proper to put hypothetical questions to expert witnesses. The hypothesis in such a question is one which embodies that construction of the patent upon which the examining counsel thinks it both safe and sufficient to rely. If, when charging the jury, the judge gives a different construction from that embodied in the hypothetical question, then the answer to that question will be seen to be immaterial, and the jury will do right to disregard it. Examining counsel ought therefore to be very certain that his hypothetical construction is the true one; or otherwise, to put as many hypothetical questions as there are probable favorable constructions. Doing the latter, he may have a favorable answer upon which to argue to the jury, if he secures from the judge a construction which corresponds with either of his hypothetical questions. A statement of a witness that a particular thing does or does not infringe a particular patent, is inadmissible in evidence, because that statement includes a construction of the patent, and construction of patents is the duty of courts, and not of experts.²

§ 500. Though not permitted to testify to the construction of a patent,³ experts are sometimes called upon to testify to facts which positively control that construction.⁴ Where the

¹ *Young v. Wolfe*, 120 F. R. 958, 1903.

² *Marsh v. Stove Co.*, 51 F. R. 203, 1892; *Holmes v. Truman*, 67 F. R. 545, 1895.

³ *Waterbury Brass Co. v. New York Brass Co.*, 3 Fisher, 54, 1858.

⁴ *Marsh v. Stove Co.*, 51 F. R. 203, 1892.

state of the art is the subject of inconsistent evidence, and where the construction of the patent depends on what is the fact in that regard, the judge will not charge the jury that the patent means thus and so, but will tell them that if they find the state of the art to be so and so, then the patent is entitled to such and such a construction.¹ In cases of this kind it may occur that the jury, in deciding upon the state of the art, must receive information from experts relevant to the mechanical nature of prior things,² as well as information from other sources relevant to the prior existence of those things. All questions of similarities or of differences between things, are questions for the jury in an action at law,³ and are therefore proper to be testified about by experts.⁴ Where a patent covers such of the things described, as perform a particular function, it is the business of the jury to decide, and therefore proper for an expert to testify, which those things are.⁵

Though not permitted to testify directly on any question of infringement, experts are permitted to testify on points of fact which control the answers to such questions. For example, where a question of infringement depends on comparative mode of operation; an expert may testify that the modes of operation of two machines are substantially the same, or are substantially different, as the case may be. And where a question of infringement depends on whether a particular part of one machine, is an equivalent of a particular part of another machine; an expert may testify whether they perform the same function, and if so whether they perform that function in substantially the same way.

§ 501. Where an expert, in his direct examination, expounds the whole, or a part, of the prior art, his cross-examination may extend to the same sources of knowledge or domains of experience. But where an expert is giving testi-

¹ *Burdell v. Denig*, 92 U. S. 722, 1875.

² *McKay & Copeland Mach. Co. v. Clafin*, 58 F. R. 354, 1893.

³ *Tyler v. Boston*, 7 Wallace, 327, 1868.

⁴ *Myers v. Sternheim*, 97 F. R. 625, 1899.

⁵ *Silby v. Foote*, 14 Howard, 218, 1852.

mony in chief, upon points of fact relevant to infringement, and confines that testimony to the similarities and differences between the plaintiff's patent and the defendant's doings, he cannot be cross-examined on the prior art; except by inquiring whether he took the prior art into consideration, when forming his opinion on the significance of the differences between the plaintiff's patent and the defendant's doings. That exceptional question is proper; because the answer will show whether the expert treated the plaintiff's patent as a primary patent, or treated it as a secondary patent, when he was weighing the differences between it and the defendant's doings; and because the validity of his estimate of those differences, may depend on whether he was right or was wrong in treating it as he did, in that respect.

The cross-examination of experts, cannot extend to inquiries into the characteristics of things not relevant to the case, put to them for the purpose of testing their knowledge or their fairness; because if the answers appeared to be undeniably correct, they would be wholly immaterial, and if thought to be erroneous they could be shown to be so, only by the testimony of others, who might themselves be the mistaken ones. To allow such a question, would thus operate to introduce an immaterial issue of fact into a case, and to draw the attention of the jury away from the issues of the pleadings.¹

§ 502. The last part of a plaintiff's *prima facie* evidence, consists in proof of the amount of his damages, sometimes supplemented by evidence tending to show that a judgment ought to be entered for an amount greater than the actual damages sustained by him.² The matter is mentioned in this connection for the sake of symmetry; but it is so large that it constitutes the subject of a separate chapter of this book. To that chapter, recourse may be had for detailed information upon the subject.

§ 503. Except where a defendant exercises his right to demur to the evidence, or to move the court to direct the

¹ *Odiorne v. Winkley*, 2 Gallison, 51, 1814.

² Revised Statutes, Section 4919.

jury to return a verdict for him, at the close of the plaintiff's evidence in chief; the next part of a trial is the introduction of evidence by the defendant to sustain his defences. The possible defences in patent cases are twenty-seven in number. In prior sections in this chapter, they are consecutively numbered for purposes of easy reference, and are treated in respect of the pleadings which they respectively require, and the results which they respectively produce in patent actions at law. It is now convenient to set forth, in the same order, the leading points of the law of evidence applicable to each.

§ 504. The first defence will sometimes require evidence to show that the terms of art or science which are used in the patent, have such a meaning that the court is bound to construe the patent to be one for a principle, or for something other than a patentable process, or a machine, manufacture, composition of matter, or design. But where a patent plainly claims only the peculiar function of a described machine, the first defence can be maintained without any evidence outside of the patent.

§ 505. The second defence may sometimes be supported by facts of which the court will take judicial notice.¹ But evidence to show the state of the art, is often required to show want of invention. A patent granted for an implement of agriculture, consisting of a hoe-handle with a hoe on one end and a rake on the other, would be void for want of invention, even if both new and useful.² The court would take judicial notice of the prior existence of handles having hoes attached thereto, and of other like handles having rakes fastened to one end; and on the basis of that judicial notice, would pronounce such a patent to be invalid.

A patent for a particular alleged combination in a complicated machine, may also be open to the same sort of objection; while the facts upon which it rests in the particular case, may

¹ *Brown v. Piper*, 91 U. S. 37, 1875; *Slawson v. Railroad Co.*, 107 U. S. 649, 1882; *Phillips v. Detroit*, 111 U. S. 606, 1883; *Specialty Mfg. Co. v. Fenton Mfg. Co.*, 174 U. S. 497, 1899.

² *Reckendorfer v. Faber*, 92 U. S. 347, 1875.

be unknown to people generally, and unknown to judges who hear patent causes; though well understood by some experts and some mechanics. In such a case, it is necessary to introduce evidence of those facts in order to show want of invention. Such evidence may consist of proof of the prior existence of the parts of the alleged combination, and proof of the fact that their union in the machine, constitutes not a real combination, but an aggregation only.

So also, where want of invention results from some other reason than aggregation, the prior art must generally be proved in order to support the second defence; and that proof will generally consist of one or more prior patents or printed publications. The method of introducing them in evidence, is explained in the next two sections where substantial identity between the invention of the patent in suit and the invention disclosed in a prior patent or printed publication, is presupposed. But where a prior patent or printed publication is set up to negative invention, rather than to negative novelty, identity may be absent. In such a case, the question is whether the difference or differences between the subject claimed in the patent in suit and the prior art, amount to invention; and it is generally necessary for a defendant to introduce expert testimony on that point;¹ for a question of invention is a question of fact.² That testimony may state the character and the results of experiments made with the processes or articles involved in the comparison, or it may be based on knowledge otherwise acquired by the expert who testifies.

§ 506. The third defence, and the facts which support it, are explained at large in the third chapter of this book. In this connection, it is only necessary to explain the kinds of evidence by which those facts may be proved, and to state the special rules which govern the weight of such evidence.

Where novelty is duly sought to be negatived by prior United States patents, duly certified copies of those patents

¹ *Waterman v. Shipman*, 55 F. R. 987. 1893. *Belting Co.*, 97 F. R. 508. 1899; *Willis v. Miller*, 121 F. R. 985,

² *Kisinger-Ison Co. v. Bradford* 1903.

are admissible;¹ and it is a general practice among patent lawyers to waive the certificate, where a printed copy from the Patent Office is presented by opposing counsel. The certified copies of letters patent, which are admissible in evidence, include not only such individual copies as are furnished to private persons on payment of the proper fees; but also the certified bound volumes of copies which are gratuitously distributed by the Commissioner of Patents to all the State and Territorial capitols, and to all the United States District Court clerk's offices, except those which are located at the capitals of the States and Territories.²

Where prior foreign patents are duly pleaded to negative novelty, they may be proved *prima facie*, by duly certified copies of those copies thereof, which are kept in the United States Patent Office.³ If plenary proof of foreign letters patent is required, it can be made by producing a copy thereof, duly certified by that officer of the foreign government which issued the patent, who corresponds to the Commissioner of Patents in the United States.⁴ Where an error creeps into a certified copy of any letters patent, it may be corrected by another and more carefully compared certified copy from the same office.⁵ Letters patent, to be admissible, must agree in name and date with the statements in the pleadings, in proof of which they are offered.⁶

§ 507. Prior printed publications must be proved by the introduction of a specimen of the printed thing, which is relied upon, and by satisfactory evidence that it was published before the date of the patent in suit. Parol testimony of the contents of such printed matter is generally inadmissible.⁷ The testimony of a person, that the printed thing produced was published before the date of the invention in suit, if believed by the jury, would be sufficient evidence on that point. What evidence short of that in con-

¹ Revised Statutes, Section 892.

² Revised Statutes, Section 490.

³ Revised Statutes, Section 893.

⁴ *Schoerken v. Swift & Courtney & Beecher Co.*, 7 F. R. 469, 1881.

⁵ *Brooks v. Jenkins*, 3 McLean, 432, 1844.

⁶ *Bellas v. Hays*, 5 Sergeant & Rawle (Penn.), 427, 1819.

⁷ *McMahon v. Tyng*, 14 Allen (Mass.), 167, 1867.

vincing force, would answer the purpose in hand, has not been judicially settled. Printed publications are not generally evidence of the truth of the statements which they contain.¹ But where a book or public periodical appears to have been published in a specified year, or on a specified day, and where it contains matter which furnishes collateral evidence of the genuineness of the date, and where it is free from the suspicion of having been changed after it was put forth, it will be received in evidence, without direct testimony that it was published when it purports to have been.² But a certificate of the Commissioner of Patents, that a particular book was in the library of the Patent Office as early as a particular date, is not evidence of that fact.³

§ 508. Prior knowledge or use of a thing patented, may be proved by the testimony of the person or persons who had such prior knowledge, or who know of such prior use. Such testimony includes three points: the existence, the character, and the date of the thing previously known or used. Where a witness relies wholly on his memory for all three of these points, his testimony, though admissible, is not strong. It is generally impossible to remember with certainty the particular construction of a thing of which no specimen is known to remain in existence; and most memories are nearly unreliable on questions of dates. It is therefore desirable to fortify testimony of prior knowledge or use by producing the anticipating thing, or a specimen thereof, and by connecting the history of that thing with events about which there is no room for doubt. Where the anticipating thing cannot be produced, the testimony which supports its prior existence, may still prevail, if the construction of the article was so simple, and so well understood, as to be unlikely to be forgotten, and especially if a number of credible witnesses agree in regard to its character and its date.

§ 509. Parol evidence of an anticipating thing, is likely

¹ *Seymour v. McCormick*, 19 Howard, 106, 1856.

² *Britton v. White Mfg. Co.*, 61 F. R. 95, 1894.

³ *Travers v. Cordage Co.*, 64 F. R. 773, 1894.

to be met by other parol evidence, tending to show that such a thing never existed at the place alleged; or that it was substantially different from the patented invention sought to be anticipated; or that it did not exist at the alleged place till after the date of the patented invention. Testimony of the first sort is negative in its character, and therefore not so weighty as the affirmative evidence which it contradicts.¹ But it does not need to be so weighty, in order to overthrow the latter; for a mere preponderance of evidence will not sustain the defence of want of novelty. That defence, in order to prevail, must be proved beyond a reasonable doubt.² Testimony of an anticipating thing may also be met by evidence that the witness purchased a license under the patent; but such answering evidence is generally entitled to very little weight,³ because the witness may not have understood that the facts of which he knew, constituted a legal defence to the patent, or he may have preferred to pay for a license, rather than to undergo the annoyance and incur the expense which are generally incident to actions for infringement.

§ 510. When anticipating matter is undeniably proved to have existed before the date of the patent in suit, want of novelty is *prima facie* proved;⁴ because the printed memorandum of the date of the application for the patent, which is put at the head of the specification, is not evidence of that date.⁵ But the plaintiff may meet the defendant's evidence of anticipating matter by proof that he, or his assignor, made the invention at a still earlier date. He may sometimes do this by means of a certified copy of the specification and drawings of his original application; but not by parol evidence relevant to the time when the petition, specification, or drawing was filed.⁶ If his application was not early enough for the purpose, the plaintiff may prove the real date of his invention by proving the date of either of those facts, which,

¹ Union Sugar Refinery v. Matthiessen, 2 Fisher, 600, 1865.

² Section 76 of this book.

³ Evans v. Eaton, 3 Wheaton, 454, 1818.

⁴ Havemeyer v. Randall, 21 F. R. 404, 1884.

⁵ International Terra Cotta Co. v. Maurer, 44 F. R. 619, 1890.

⁶ Wayne v. Winter, 6 McLean, 344, 1855.

in the chapter on novelty, were shown to constitute the birth of an invention thereafter patented.¹ If that fact was a tangible thing, its establishment requires the production and proof of that thing, or requires proof of its loss or destruction, and the best obtainable evidence of what its character was.²

After the plaintiff has introduced evidence that he, or his assignor, made the invention at a still earlier date than that proved for the anticipating matter; the defendant cannot introduce evidence to carry the date of the anticipating matter back of the new date thus proved by the plaintiff; but the defendant may introduce evidence to disprove, if he can, the plaintiff's new date of invention.³

§ 511. The fourth defence requires evidence that the patented invention will not perform any function which is ascribed to it in the letters patent,⁴ or proof that its function is not a useful one, within the meaning of the law on that subject.⁵

The first of these sorts of proof may consist of testimony of a person who is skillful in the art to which the invention pertains, and who has endeavored, in good faith, to make the patented thing work, and has been unable to do so. In plain cases, it may also consist of the testimony of such a person, who has not actually experimented with a specimen of the patented thing, but who is able to show theoretically, that it is impossible for such a specimen to operate.⁶ And in all cases the evidence must show a total incapacity in the invention to do anything claimed for it, because neither imperfect operation, nor a total failure to perform part of the claimed functions, will sustain a defence of want of utility.⁷ And either practical or theoretical evidence of want of utility

¹ Section 70 of this book.

² *Richardson v. Hicks*, 1 *McArthur's Patent Cases*, 336, 1854.

³ *St. Paul Plow Works v. Starling*, 140 U. S. 198, 1891.

⁴ *Rowe v. Blanchard*, 18 *Wisconsin*, 462, 1864.

⁵ Sections 82 to 84 of this book.

⁶ *Campbell Printing-Press Co. v. Duplex Printing-Press Co.*, 86 F. R. 330, 1898; *Crown Cork & Seal Co. v. Aluminum Stopper Co.*, 108 F. R. 849, 1901.

⁷ *Seymour v. Marsh*, 6 *Fisher*, 115, 1872.

in the sense now under consideration, may be overthrown by the testimony of a person who has succeeded in causing the patented process or thing to produce a result ascribed to it in the patent.

The second of these sorts of proof may consist of evidence that the function of the patented thing is one which people generally profess to condemn as dangerous or immoral. Conventional and not absolute ethics is the criterion of judgment on this point.

§ 512. The fifth defence may be supported by any competent evidence which shows that the inventor relinquished all expectation to secure a patent, and formed an expectation that the invention would always be free to the public.¹ Such evidence may be either direct or circumstantial, but a mere preponderance of evidence cannot sustain this defence of actual abandonment, because it is one of those which, in order to prevail, must be proved beyond a reasonable doubt.²

§ 513. The sixth defence requires proof that the inventor omitted to apply for the patent, during the time allowed by the statutes for such an application to be made, in his particular case.³ That proof, to be effective, must establish the fact beyond a reasonable doubt.⁴

§ 514. The seventh defence requires the introduction of the original application papers, or certified copies thereof; and in all except very plain cases it requires the testimony of experts to explain the outward embodiment of the terms contained in the original letters patent, and in the original application respectively.⁵

§ 515. The eighth defence calls for evidence that another than the patentee conceived the invention before he did; and that the other used reasonable diligence in adapting and perfecting the same; and that the patentee knew of that prior conception, and obtained the patent surreptitiously; or, if

¹ Babcock v. Degener, 1 McArthur's Patent Cases, 616, 1859.

² McCormick v. Seymour, 2 Blatch. 256, 1851.

³ Andrews v. Hovey, 123 U. S. 267; 124 U. S. 694, 1887.

⁴ Hanifen v. Godshalk, 78 F. R. 816, 1896.

⁵ Bischoff v. Wethered, 9 Wallace, 812, 1869.

he did not know of the prior conception, that he obtained the patent unjustly, by applying for it when the prior conceiver was not chargeable with laches in reducing the invention to practice, or in preparing and filing an application for a patent thereon.¹

§ 516. The ninth defence requires proof that another than the patentee was joint inventor with him of the thing covered by the patent. Testimony on this point must be strong in order to prevail, because the tendency of courts and juries is to assign such evidence to the category of mechanical assistance in construction, or to that of suggested substitution of equivalents.²

§ 517. The tenth defence is more likely to be successful in the proof than the ninth; because it may not only be based on the counterpart of the circumstances which underlie the latter, but also on other circumstances, where those do not exist. It has sometimes happened that an inventor, having sold an undivided half interest in his invention, has joined with his vendee in applying as joint inventor for a patent therefor. Such errors have been known to result from ignorance of the law; and such an error has been said to have occurred in one case on account of a desire to give an important patent the benefit of the name of a more distinguished scientist than him who was the real producer of the subject of the claim. But in any case, it is certain that very clear and unequivocal evidence is necessary to support this defence.³

§ 518. The eleventh defence calls for proof that the letters patent contains less than the whole truth relevant to the invention, or that it contains more than is necessary to produce the

¹ Revised Statutes. Section 4920; *Yates v. Huson*, 8 App. D. C. 93, 1896.

² *Agawam Co. v. Jordan*, 7 Wallace, 587, 1868; *Pitts v. Hall*, 2 Blatch. 229, 1851; *Locke v. Lane Co.*, 35 F. R. 293, 1888; *Hall Signal Co. v. Union Switch & Signal Co.*, 115 F. R. 643, 1901.

³ *Gottfried v. Brewing Co.*, 5

Bann. & Ard. 4, 1879; *Butler v. Bainbridge*, 29 F. R. 142, 1886; *Consolidated Apparatus Co. v. Woerle*, 29 F. R. 449, 1887; *Schlicht & Field Co. v. Sewing Machine Co.*, 36 F. R. 585, 1888; *Welsbach Light Co. v. Cosmopolitan Gaslight Co.*, 100 F. R. 650, 1900.

desired result, and that the fault arose from intention to deceive the public. But positive and direct evidence is not required on the latter point. It is sufficiently shown by proof of any circumstances which satisfy the jury that such intention existed.¹

§ 519. The twelfth defence can be supported by no evidence except that of persons skilled in the art to which the invention pertains, or with which it is most nearly connected. A patent for a chemical composition or process cannot be overthrown, on the ground of an insufficient description, by the testimony of a mechanical expert; nor can a patent for an improvement of a loom be overthrown on that ground, by the testimony of a machinist skilled only in printing-presses. If a description is sufficiently full, clear, concise, and exact to be effectually understood by any person skilled in that kind of machinery, or other subject of a patent, it is sufficiently so to meet this defence.²

§ 520. The thirteenth defence may sometimes succeed without any evidence outside of the letters patent themselves. It will, however, always be prudent to fortify the defence by the testimony of an expert who can show that the outward embodiment of the terms of the claim, is uncertain in character or in extent.

§ 521. The fourteenth defence requires several items of evidence for its support. It requires proof that one or more of the claims of the patent are void for want of embodying a subject matter of a patent,³ or for want of invention, or for want of novelty;⁴ and that the patentee has long known the facts which make it invalid in that behalf. No disclaimer is ever necessary, in the absence of all of the first three of these circumstances; and no delay to file one is unreasonable in the absence of the fourth. Indeed, proof of a necessity for a disclaimer, and of long-existing knowledge of the facts out of which that necessity arose, will not

¹ *Gray v. James*, 1 Peters' Circuit Court Reports, 394, 1817; *Dyson v. Danforth*, 4 Fisher, 133, 1865.

² *Loom Co. v. Higgins*, 105 U. S. 580, 1881.

³ *O'Reilly v. Morse*, 15 Howard, 121, 1853.

⁴ Revised Statutes, Section 4922.

always sustain this defence; because delay to file a disclaimer is not unreasonable, so long as there is any reasonable doubt whether the known facts constitute a necessity for such a document.¹

§ 522. The fifteenth defence can seldom be supported by evidence that the original patent was neither inoperative nor invalid by reason of a defective or insufficient specification; because inoperativeness, from one of these causes, exists whenever the patent does not secure and cover all the inventions which it indicated, suggested, or described, and which might lawfully have been claimed in it;² and because, when not granted on account of such inoperativeness, reissues are generally granted on account of invalidity which arose by reason of a defective or insufficient specification, or by reason of a too extensive claim.³ This defence therefore generally requires to be sustained by evidence showing that, whatever inoperativeness or invalidity on account of defective or insufficient specification, or on account of too extensive claims, is to be found in the original patent; the error arose otherwise than by inadvertence, accident, or mistake. The absence of all three of these mishaps from the history of the preparation of any original specification, may be proved by evidence which shows that the statements or claims alleged to have been omitted in one or another of these ways, were in fact omitted with deliberation or with care, or were omitted because they had to be, in order to secure the original patent,⁴ or were disclaimed in order to secure an extension thereof.⁵ Evidence to show either of the last two of these circumstances, if it exists at all, may generally be found among the correspondence on file in the Patent Office, and may be introduced in the form of certified copies of the letters which contain it.⁶

¹ *Silby v. Foote*, 20 Howard, 290, 1857; *Matthews v. Flower*, 25 F. R. 834, 1885.

² *Wilson v. Coon*, 18 Blatch. 532, 1880.

³ Revised Statutes, Section 4916.

⁴ *James v. Campbell*, 104 U. S.

356, 1881; *Yale Lock Co. v. Berkshire Bank*, 135 U. S. 379, 1890; *Dobson v. Lees*, 137 U. S. 265, 1890.

⁵ *Leggett v. Avery*, 101 U. S. 256, 1879.

⁶ Revised Statutes, Section 892.

§ 523. The sixteenth defence can be supported by the introduction of the original patent, if when it is compared with the reissue, the latter appears to claim something which the original did not, and appears to have been applied for a long time after the original was granted. How long this space of time must be, in order to sustain this defence, depends largely upon the particular circumstances of particular cases. Different spaces of time which have been held to be sufficient for the purpose, are collated in the chapter on reissues,¹ and the burden is on the plaintiff to excuse delay for more than two years.²

§ 524. The seventeenth defence always requires to be supported by the introduction of the original patent;³ and generally requires expert testimony showing that the outward embodiment of something claimed in the reissue, is substantially different from anything described in the original patent and apparently intended to be claimed therein. The judge will not reject such expert testimony, unless the case is so clear that he would have decided the question on a demurrer, if it had been presented to him by that pleading.

§ 525. The eighteenth defence requires the introduction in evidence of the prior patent, granted on the application of the same inventor; but it will seldom require expert testimony, because, in order to prevail at all, this defence requires the claim of the prior patent to be so clearly co-extensive with the claim of the patent in suit, that its co-extensiveness is apparent upon the faces of the two patents. But expert testimony may be necessary to show such substantial identity of claims, where one or both of the claims may be formulated in phraseology, which cannot be understood without expert explanation.

§ 526. The nineteenth defence would require to be supported by the introduction of an officially attested copy of the record of the court repealing the patent,⁴ or if that

¹ Section 227 of this book.

³ *Seymour v. Osborne*, 11 Wal-

² *Wollensak v. Reiher*, 115 U. S. 101, 1884; *Hoskin v. Fisher*, 125 U. S. 222, 1887.

lace, 516, 1870.

⁴ Revised Statutes, Section 905.

record is proved to have been destroyed by fire,¹ or rendered illegible by wear or time,² and not restored by the court to which it pertains,³ it may be proved by a witness who examined and copied it when it was still unharmed.⁴ But parol evidence will not be admitted of a record of which only a part is lost. The part which still exists, must be produced or proved by an officially attested copy.⁵

§ 527. The twentieth defence calls for the introduction in evidence, of a properly certified copy of the foreign patent which is relied upon to curtail the term of the patent in suit; and if the parties offer no testimony to aid the court in determining whether the foreign patent, so proved, is for the same invention as the United States patent upon which the action is based, then the court will determine that point from an inspection of the two documents.⁶ But if expert evidence on that subject is offered, it will doubtless be received.⁷ And a foreign patent is evidence of its own duration; and will be held not to have been extended, in the absence of evidence that it has been.⁸

§ 528. The twenty-first defence is supported by proof that the plaintiff has made or sold one or more specimens of the patented article without marking it "patented," together with the day and year whereon the patent was granted.⁹ When such evidence is introduced, the burden is shifted to the plaintiff, to show that before suit was brought the defendant was duly notified that he was infringing the patent, and that he continued to infringe after such notice.¹⁰ A voluntary statement made to the infringer by a third person, that his doings infringe a patent, is not such a notice of infringement as is contemplated by the statute;¹¹ but such a

¹ *United States v. Delespine's Heirs*, 12 Peters, 654, 1838.

² *Little v. Downing*, 37 New Hampshire, 355, 1858.

³ Revised Statutes, Sections 899 and 900.

⁴ 1 Wharton on Evidence, 135.

⁵ *Nims v. Johnson*, 7 California, 110, 1857.

⁶ *De Florez v. Reynolds*, 17 Blatch. 439, 1880.

⁷ *Bischoff v. Wethered*, 9 Wallace, 812, 1869.

⁸ *Edison Electric Light Co. v. Electric Supply Co.*, 60 F. R. 404, 1890; *Bonsack Mach. Co. v. Smith*, 70 F. R. 383, 1895.

⁹ Revised Statutes, Section 4900.

¹⁰ *Goodyear v. Allyn*, 6 Blatch. 36, 1868.

¹¹ *Puirpoint Mfg. Co. v. Eldridge Co.*, 71 F. R. 309, 1896.

notice does reside in the beginning of a suit for infringement.¹

The twenty-first defence does not apply to any patent for a process; because processes are not made or sold. They are only used, and the statute on this subject is expressly confined to cases of making or to cases of selling, without marking "patented."²

§ 529. The twenty-second defence may sometimes be sustained by means of pointing out faults in the plaintiff's proof of title. Where that proof is apparently complete, it can be attacked by the introduction of assignments or grants in writing, which intervene between some of the links of the plaintiff's chain of title in such a way as to destroy or impair its continuity. The numerous points of law relevant to title are explained in the eleventh chapter of this book. It is enough to say, in this connection, that no title will be recognized in a court of law, unless it is evidenced by instruments in writing.³

§ 530. The twenty-third defence may be sustained by evidence of a written or a parol license, or of an express or an implied license. And a license may be a defence to an infringement suit, even where the license fee is in arrears.⁴ Licenses form the subject of the twelfth chapter of this book, and to that chapter recourse may be had for further information in regard to the proper evidence to support this defence.

§ 531. The twenty-fourth defence may be sustained by proof of a total or partial release, given after the infringement was committed and before the action was commenced, or it may be sustained *pro tanto*, by a partial release given even after the action was begun.⁵ A paper cannot be a release, if executed before the infringement to which it

¹ United States Mitis Co. v. Carnegie Steel Co., 89 F. R. 206, 1898.

² United States Mitis Co. v. Carnegie Steel Co., 89 F. R. 206, 1898.

³ Revised Statutes, Section 4898.

⁴ Keyes v. Mining Co., 158 U. S. 150, 1895.

⁵ Burdell v. Denig, 92 U. S. 721, 1875.

refers was committed, because no man can relinquish what he does not possess.

Whether a release, given only to a joint infringer with the defendant, can be invoked by the defendant himself, is a question to which no categorical answer can at present be given. It depends upon the question whether contribution can be enforced between infringers, and that point has never been settled by the courts. Nothing more useful can therefore be said in this connection, than to state the principles upon which the two questions seem to depend.

The doctrine that there can be no contribution between tort-feasors, does not generally apply to cases where the wrong-doers suppose their doings to be lawful.¹ This is generally true of infringers of patents. When they infringe, they are perhaps ignorant of the patents which they violate; or if they know of the patents, they are apt to give themselves the benefit of every suggested ground for doubt, and thus suppose that their doings do not constitute any infringement. Therefore, it seems to be generally true, that where one of several joint infringers is sued alone, and suffers and pays a judgment for the joint infringement, he may compel his co-infringers to contribute their due portion of that payment, by means of an action to enforce its refunding. That being so, it will follow that a release to one joint infringer will operate to release all his co-infringers from the claim of the patentee. Where contribution can be enforced between tort-feasors, a full release to one must release all; for if it did not do so, it would not fully release that one. The releasee would not be fully protected by his release, unless his co-infringers would also be protected by it; because otherwise the releasee would still be liable to an action for contribution, brought against him by a joint tort-feasor who had been compelled to respond in damages for the joint infringement. The true rule, therefore, appears to be that a plain release given to either of several joint infringers may be successfully invoked in a court of law, not only by the nominal releasee, but also by any or all of his co-infringers.

¹ Bailey v. Bussing, 28 Connecticut, 461, 1859.

A release given to an infringer, by one of several owners in common of a patent right, is not a defence to an action of the other owners against the infringer;¹ and those other owners will be permitted to prosecute their rights, by making the releasing co-owner a co-plaintiff against his will, if that is necessary in a particular jurisdiction. In a suit thus prosecuted, the release will be a defence to the damages due to the releasing co-owner, but not to those due to the others.

§ 532. The twenty-fifth defence may be successful without any evidence, because the burden of proof is upon a plaintiff to show an infringement,² and because a plaintiff may fail to sustain that burden. Accordingly, in one leading law case, the defendant was the prevailing party on the circuit, and in the Supreme Court, though the plow which he made was nearly identical with that covered by the plaintiff's patent, and though the defendant introduced no evidence on the subject of infringement, nor indeed on any other.³ So, also, in a leading case in equity, the defendant, though beaten on the circuit, successfully interposed the defence of non-infringement in the Supreme Court, without any evidence on that side of the issue, and against the contrary testimony of several experts.⁴ Several cases have also been successfully defended in Circuit Courts, on the ground of non-infringement, without any expert testimony on that side of that issue, and against regular expert depositions asserting and arguing the proposition of infringement.⁵

But where a thing made or used or sold by the defendant is proved or is stipulated, and where a competent expert testifies that it is substantially the same as that which appears to be covered by the patent in suit, it is generally advisable, and sometimes necessary, for the defendant to introduce evidence tending to show non-infringement, if he means to rely upon

¹ *Lalancé & Grosjean Mfg. Co. v. Haberman Mfg. Co.*, 93 F. R. 198, 1899.

² *Brooks v. Jenkins*, 3 McLean, 453, 1844; *Royer v. Mfg. Co.*, 20 F. R. 853, 1884; *Dowagiac Mfg. Co. v. Brennan*, 118 F. R. 146, 1902.

³ *Prouty v. Ruggles*, 16 Peters, 336, 1842.

⁴ *Railway Co. v. Sayles*, 97 U. S. 554, 1878.

⁵ *Enterprise Co. v. Snow*, 72 F. R. 263, 1896; 80 F. R. 537, 1897; *Beale v. Spate*, 74 F. R. 869, 1896.

that defence.¹ Evidence of this sort may consist of the testimony of experts who are acquainted with the letters patent in suit, and with the doings of the defendant, and are of opinion that those doings are substantially different from everything which appears to be secured by the letters patent, and can give an intelligent reason for that opinion. But such testimony must describe the defendant's doings, to enable the court to judge the correctness of its comparisons.² This testimony, like other testimony of experts on questions of infringement, is necessarily based on hypothetical constructions of the patents in suit, and is therefore to be disregarded, if the judge finds those hypothetical constructions to be substantially erroneous.

Whether the fact that the defendant conformed his doings to a junior patent, is admissible as tending to show non-infringement of the patent in suit, is a question which the Supreme Court once decided in the affirmative,³ and afterward in the negative,⁴ but finally in the affirmative.⁵ The lower courts have uniformly followed the last of these decisions, ever since it was rendered in 1895; so that now the law of the point appears to be established and confirmed.⁶

§ 533. The twenty-sixth defence requires to be proved as pleaded. Where it depends upon estoppel *in pais*, it may be proved by parol, or by the production of documents, according as the ground of the estoppel consists of things done, or words spoken, or consists of words which were committed to writing. Where the defence depends upon estoppel by deed, the document must be produced or otherwise proved according to the rules of evidence applicable to such cases; and where it depends upon estoppel by record,

¹ Bennet *v.* Fowler, 8 Wallace, 447, 1869.

² Goldie *v.* Iron Co., 64 F. R. 240, 1894.

³ Corning *v.* Burden, 15 Howard, 252, 1853.

⁴ Blanchard *v.* Putnam, 8 Wallace, 420, 1869.

⁵ Boyd *v.* Janesville Hay Tool Co., 158 U. S. 261, 1895.

⁶ Ransome *v.* Hyatt, 69 F. R. 149, 1895; New Departure Bell Co. *v.* Hardware Specialty Co., 69 F. R. 156, 1895; Ney *v.* Ney Mfg. Co., 69 F. R. 407, 1895; Illinois Steel Co. *v.* Kilmer Mfg. Co., 70 F. R. 1015, 1895; Wolff *v.* Du Pont, 122 F. R. 959, 1903.

or *res judicata*, the record must be proved in accordance with the laws governing such evidence. But if the record, when proved, stops short of showing that the point in question was decided in the former case, that fact may be proved by extrinsic evidence.¹

§ 534. The twenty-seventh defence seldom requires any evidence to sustain it, because the Federal courts take judicial notice of the statutes of limitation;² and because the plaintiff's pleadings and proofs, when taken together, will generally show when the infringement sued upon was committed. But if the plaintiff's presentation of the case leaves the latter point uncertain to such an extent as to affect the question of the operation of a statute of limitation, the burden is then cast upon the defendant to prove that part or all of the infringement is old enough to be barred by the statute which he pleaded.³

§ 535. Testimony in actions at law for infringements of patents may always be taken orally in open court. It may also be taken by depositions in writing, where the witness lives more than one hundred miles from the place of trial, or when he is bound on a voyage at sea, or is about to go out of the United States and out of the judicial district in which the case is to be tried, or to a greater distance than one hundred miles from the place of trial, before the time of trial, or when he is ancient and infirm. The sorts of magistrates before whom such a deposition may be taken are judges of any United States court; judges of any supreme, superior, or county court, or court of common pleas in any of the United States; commissioners of United States circuit courts; clerks of United States circuit or district courts; mayors or chief magistrates of cities: and notaries public. If any such magistrate is counsel or attorney for either party, or interested in the event of the cause, he is disqualified from acting. Before such a deposition is taken, reasonable notice thereof must be given in writing by the party intending to

¹ *Southern Pacific Co. v. Earl*, 82 F. R. 693, 1897.

² *Pennington v. Gibson*, 16 How-

ard, 79, 1853; *Cheever v. Wilson*, 9 Wallace, 121, 1869.

³ *Russell v. Barney*, 6 McLean, 577, 1855.

take it, or his attorney of record, to the opposite party, or his attorney of record, as either may be nearest, and that notice must state the name of the witness, and the time and place of taking the deposition.¹

The formalities to be observed in taking and transmitting such depositions are prescribed in Sections 864 and 865 of the Revised Statutes; and they must be strictly complied with, in order to make such depositions admissible as against proper objections. Indeed, no such deposition is admissible in any event, unless it appears to the satisfaction of the court that the witness is dead, or gone out of the United States, or to a greater distance than one hundred miles from the place where the court is sitting, or that, by reason of age, sickness, bodily infirmity, or imprisonment, he is unable to travel and appear at court.² Where the witness testified in his deposition to the then existence of the fact which authorized its taking, that fact is presumed to exist at the time the deposition is offered in evidence, and in the absence of contrary proof, the deposition itself will satisfy the court that it is entitled to be admitted.³ Depositions may also be taken in actions at law for infringements of patents, in the modes prescribed by the laws of the respective States,⁴ in any instance in which such a deposition can be taken under Sections 864 and 865 of the Revised Statutes of the United States.⁵

Where a deposition is being taken from a witness who cannot testify in the English language; the magistrate who takes it, may translate the questions into the language of the witness, and propound them to him therein, and may translate the answers into English and record them in that language.⁶

Most objections to depositions, in order to be efficacious, must be made before the depositions are received in evidence; for when introduced with the acquiescence of the opposite

¹ Revised Statutes, Section 863.

² Revised Statutes, Section 865.

³ *Whitford v. Clark County*, 119 U. S. 524, 1886.

⁴ 27 Statutes at Large, Ch. 14, p. 7.

⁵ *National Cash Register Co. v.*

Leland, 77 F. R. 242, 1896; *Despeaux v. Pennsylvania Railroad Co.*, 81 F. R. 897, 1897; *National Cash Register Co. v. Leland*, 94 F. R. 505, 1899.

⁶ *Meyer v. Rothe*, 13 App. D. C. 103, 1898.

party, they cannot afterward be excluded on the ground that they were not taken in accordance with the rules prescribed therefor.¹ But where evidence is pertinent to either of several possible defences, one or more of which were pleaded, and one or more of which were not pleaded by the defendant; the fact that the evidence was not objected to when taken or admitted, does not make it admissible in support of any defence which was not pleaded.²

§ 536. The judge may direct the jury to return a verdict for the defendant, where it is entirely clear that the plaintiff cannot recover, but not otherwise.³ Such a direction may therefore be given, where want of novelty or want of invention is clearly shown by a prior patent,⁴ but not where that question is doubtful.⁵ And such a direction may be given where the question of infringement depends entirely upon the construction of the patent; and where that construction does not depend upon any doubtful question of the prior art.⁶

But where the question of infringement depends upon the construction of the patent, and that construction depends upon a doubtful question in the prior art, the latter question should be left to the jury; and the dependent question of infringement should also be left to the jury to decide.⁷ A motion that the judge direct the jury to return a verdict for the defendant needs not to specify the reason on which it is based; but that reason will naturally be stated in the argument which is made to support the motion.⁸

§ 537. Instructions to juries set forth the construction of

¹ *Evans v. Hettich*, 7 Wheaton, 453, 1822; *Howard v. Stillwell & Bierce Mfg. Co.*, 139 U. S. 199, 1891; *Bibb v. Allen*, 149 U. S. 481, 1893; *Meyer v. Rothe*, 13 App. D. C. 99, 1898.

² *Zane v. Soffe*, 5 Bann. & Ard. 284, 1880.

³ *Klein v. Russell*, 19 Wall. 463, 1873; *Keyes v. Grant*, 118 U. S. 25, 1886.

⁴ *Market St. Ry. Co. v. Rowley*, 155 U. S. 625, 1895.

⁵ *San Francisco Bridge Co. v. Keating*, 68 F. R. 353, 1895.

⁶ *DeLorica v. Whitney*, 63 F. R. 611, 1894; *Cramer v. Fry*, 68 F. R. 201, 1895; *Jackson v. Western Fireproofing Co.*, 112 F. R. 361, 1901.

⁷ *Royer v. Belting Co.*, 135 U. S. 325, 1890.

⁸ *May v. Juneau County*, 137 U. S. 410, 1890.

patents¹ and embody all the law that is applicable to the material facts in evidence, but need embody no other.² In ascertaining that law, the judges resort to the statutes of the United States, and to the decisions of the United States Supreme Court; and where further information is required, they examine or call to mind the decisions of the Circuit Courts of Appeals, and of the Circuit Courts of the United States.

But judges are not bound to conform their instructions to any statement of law contained in any opinion of any court, unless that statement was applicable to the case in which it was made.³ The Supreme Court has sometimes decided cases, contrary to its own previous *obiter dicta*; and the circuit court decisions contain many remarks which cannot be harmonized with the decisions of the supreme tribunal, nor be incorporated into any systematic science. The statements of the best text-writers are more likely to be followed by the Federal courts than are the *dicta* of the judges of those courts; because the best legal authors fill their minds with the subjects which they treat, and hold those subjects in solution there when writing their books; while the *dicta* of judges are separately written down, without adequate comparison with adjudicated precedents, or full harmonization with established principles.

Instructions to juries may express the opinions of the judges upon the questions of fact to be decided,⁴ but an instruction should not enforce those opinions upon the jury for its guidance,⁵ and should not include the reading of a charge which has been given to a jury in another case.⁶ While the judge is bound not to tell the jury how to decide any issue of fact, the judge will tell them what issues of fact they are

¹ Holmes v. Truman, 67 F. R. 545, 1895.

² Haines v. McLaughlin, 135 U. S. 598, 1890.

³ Day v. Rubber Co., 20 Howard, 216, 1857; Day v. Stellman, 1 Fisher, 487, 1859.

⁴ Haines v. McLaughlin, 135 U.

S. 593, 1890; Coupe v. Royer, 155 U. S. 579, 1895; International Tooth Crown Co. v. Hanks Dental Ass'n, 111 F. R. 919, 1901.

⁵ Turrill v. Railroad Co., 1 Wallace, 491, 1863.

⁶ Arey v. DeLoria, 55 F. R. 323, 1893.

to decide, and those are the issues in the pleadings, and not some other issue which the judge may think is the one upon which the merits of the case really depend.¹

In the State courts of most of the States, counsel have a right to require all instructions to be given in writing; but the judges of the Federal courts are not controlled by State regulations in the manner of charging juries, and therefore instructions in patent cases may be given in writing, or may be given orally, at the option of the court.²

§ 538. The verdict in a patent action will be for the plaintiff, if every defence except non-infringement fails, and if that fails as to any one claim of the letters patent.³ So also, the plaintiff is entitled to a verdict, where every defence fails except the sixteenth, seventeenth, and eighteenth, and where those defences lack application to one or more of the claims shown to have been violated.⁴ So also, if the twenty-second, twenty-third, or twenty-fourth defence is the only successful one, and if that is successful only as to part of the alleged infringement, the plaintiff will be entitled to a verdict as to the residue; and the same thing may be true of the twenty-sixth or of the twenty-seventh defence.

§ 539. A new trial may be obtained by the defeated party, if the jury disregarded the instructions of the judge;⁵ or failed to correctly apply them to the issues of the case;⁶ but not where the only error complained of is an alleged wrong decision of such an issue, unless it was decidedly against the weight of evidence.⁷

Excessive assessment of damages, even where it is unde-

¹ Grant v. Raymond, 6 Peters, 244, 1832.

² Lincoln v. Power, 151 U. S. 442, 1894.

³ Waterbury Brass Co. v. New York Brass Co., 3 Fisher, 43, 1858.

⁴ Gage v. Herring, 107 U. S. 640, 1882; Gould v. Spicer, 15 F. R. 344, 1882; Cote v. Moffitt, 15 F. R. 345, 1883.

⁵ Tucker v. Spalding, 13 Wallace, 453, 1881.

⁶ Johnson v. Root, 2 Cliff. 108, 1862.

⁷ Alden v. Dewey, 1 Story, 336, 1840; Stimpson v. Railroads, 1 Wallace, Jr. 164, 1847; Allen v. Blunt, 2 Woodbury & Minot, 121, 1846; Aiken v. Bemis, 3 Woodbury & Minot, 348, 1847; Wilson v. Janes, 3 Blatch. 227, 1854; Bray v. Hartshorn, 1 Cliff. 538, 1860; Roberts v. Schuyler, 12 Blatch. 448, 1875.

niably so, does not always entitle the defendant to a new trial. Such an error may be cured by the plaintiff remitting such a sum as the judge thinks constitutes the excess, in all cases where he thinks that the error of the jury arose from inadvertence; but where the circumstances of the case clearly indicate that the error arose from prejudice, or from reckless disregard of duty on the part of the jury, a new trial will be granted.¹ But no excessive verdict can be corrected by the Circuit Court of Appeals, unless the trial judge made some error which entitles the defeated party to a new trial.²

Errors made by judges may also entitle a party to a new trial, but no such error will have that effect unless it was excepted to at the time it was committed; nor where it consisted in erroneous admission of evidence, which the subsequent course of the trial rendered nugatory.³ So, also, where the error of the judge consisted in erroneous instructions relevant to damages, the plaintiff may avoid a new trial by consenting that the verdict be reduced to nominal damages and costs.⁴

Newly discovered evidence may also furnish a good ground for granting a new trial; but not where that evidence might, with due diligence, have been obtained before the former trial,⁵ nor where it is merely cumulative.⁶ But evidence is not merely cumulative, where it refers to facts not before agitated, though it may refer to defences which, in the former trial, were based on other facts.⁷ A party moving for a new trial upon the ground of alleged newly discovered evidence, must succeed or fail on the strength or weakness of the case as it is disclosed in his affidavits, and in the answering affidavits of the other party; for the moving party is not permitted to rebut the latter; nor will he be entitled to

¹ *Stafford v. Hair-Cloth Co.*, 2 Cliff. 83, 1862; *Johnson v. Root*, 2 Cliff. 108, 1862; *Russell v. Place*, 9 Blatch. 175, 1871.

² *Hogg v. Emerson*, 11 Howard, 607, 1850.

³ *Allen v. Blunt*, 2 Woodbury & Minot, 121, 1846.

⁴ *Cowing v. Rumsey*, 8 Blatch. 36, 1870.

⁵ *Washburn v. Gould*, 3 Story, 122, 1844.

⁶ *Ames v. Howard*, 1 Sumner, 482, 1833.

⁷ *Aiken v. Bemis*, 3 Woodbury & Minot, 358, 1847.

a new trial, if the opposing affidavits make out a strong case against him.¹ When a new trial is granted on the ground of newly discovered evidence, the terms usually are that the costs of the former trial must first be paid by the appellant.²

§ 540. Trials by a judge without a jury require to be so managed that the issues of law and the issues of fact are kept entirely distinct; for his decisions on the former are reviewable by the Circuit Court of Appeals, while his finding of fact has the same operation as the verdict of a jury.³ If the finding of the judge be a general one, it is conclusive on all issues of fact, and is also conclusive on all questions of law, except those which arise upon the pleadings, and those which the bill of exceptions specifically presents as having been ruled upon and excepted to in the progress of the trial.⁴ If the finding of the judge be a special one, it will still be conclusive on the facts found; but the sufficiency of those facts to support the judgment will be open to review in the Circuit Court of Appeals.⁵ Where the judge simply finds for the defendant, and enters a judgment accordingly, that judgment can be taken to the Circuit Court of Appeals for review only in the regular common law method of a bill of exceptions and a writ of error, and only on pure questions of law.⁶ Where the judge finds as a fact that the patent is void for want of novelty, or that the defendant has not infringed it, and thereupon enters a judgment for the latter, it is undeniable that the fact so found is sufficient to support that judgment. In arriving at his opinion, the judge may have misunderstood or misapplied the tests of novelty, or of infringement, but still his finding is conclusive; because the Circuit Court of Appeals is authorized to examine nothing but the sufficiency of the facts found.⁷

But if the judge finds that A. B. invented, made and used

¹ *Ames v. Howard*, 1 Sumner, 491, 1833.

² *Aiken v. Bemis*, 3 Woodbury & Minot, 358, 1847.

³ Revised Statutes, Section 649; *St. Paul Plow Works v. Starling*, 140 U. S. 197, 1891.

⁴ *Insurance Co. v. Sea*, 21 Wallace, 160, 1874.

⁵ Revised Statutes, Section 700.

⁶ Revised Statutes, Sections 649 and 700.

⁷ *Jennisons v. Leonard*, 21 Wallace, 307, 1874.

a certain described thing in the United States, prior to the invention of the patentee, or that the defendant made or used or sold only a certain described thing during the life of the patent, and therefore renders a judgment for the defendant, that judgment will be reversed by the Circuit Court of Appeals on a writ of error, if that court is of opinion that the thing invented, made and used by A. B. did not negative the novelty of the patent, or is of opinion that the thing made, used or sold by the defendant did really infringe the patent in suit.¹ These illustrations of the practice in trials by a judge without the aid of a jury, show that where special findings of facts are adopted as the method of laying a foundation for a review of the case by the Circuit Court of Appeals, the finding ought to relate to the fundamental facts of the case, and not merely to the conclusions of fact which are deducible therefrom.

§ 541. Trial by referee may be instituted by an entry of the clerk of the court, made at the request of the parties, simply indicating that the case is to be referred to the person or persons named as referee; or it may be ordained by a stipulation in writing, signed by the parties or their attorneys, and filed in the case. When that is done, a rule may be issued, or an order of court may be entered, referring the case to the referee indicated by the parties, and directing him to hear and determine all the issues thereof. It thereupon becomes the duty of the referee to hear the parties, and then to decide the controversy and make a report to the court. The report may be special, setting forth the details of the evidence upon which it is based, or it may be general, giving only the conclusions to which that evidence carried the mind of the referee. To that report, either party may except in writing, and upon the hearing of those exceptions, the court may adopt or reject the report and enter judgment accordingly, or it may recommit the report to the referee with further directions.²

Such is substantially the outline of the trial by referee,

¹ French v. Edwards, 21 Wallace, 147, 1874; Insurance Co. v. Sea, 21 Wallace, 160, 1874.

² Heckers v. Fowler, 2 Wallace, 132, 1864.

which is delineated in the decision just cited. Inasmuch as that form of trial is not provided for by any United States statute, its details are regulated by the laws of the particular State in which such a trial is had.¹ Recourse must therefore be had to those laws for sundry points of information relevant to the methods of taking testimony before referees; the time when referees' reports must be made; the weight attached to such reports on issues of fact; and the proper practice by means of which to secure the judgment of the court upon reviewable points.

§ 542. Judgments follow verdicts of juries, findings of judges, or reports of referees; unless those verdicts are set aside, those findings reconsidered and modified, or those reports rejected or recommitted. It is not the practice of the United States Circuit Courts to require a rule for a judgment to be entered in any case. Judgments are entered by the clerk of the court under a special or general authority from the judge, and where so entered are binding as the act of the court.² The circumstances which justify courts in entering judgments in patent cases, for any sum above the amount of the verdict, finding, or report, but not exceeding three times the amount thereof, are explained in the chapter on damages. That the court has the same power in this particular, in cases where the damages are ascertained by the finding of the judge, or by the report of a referee, that it has in cases where they are ascertained by the verdict of a jury, is a point which has not been judicially decided, but is one which can hardly be doubted.

§ 543. Costs are recoverable by all plaintiffs who secure judgments for infringements of patents;³ even for nominal damages only;⁴ except where it appears on the trial that one or more of the claims of the letters patent are void for lack of being the subject of a patent, or for want of invention, or for want of novelty, and it does not appear that the proper

¹ Revised Statutes, Sections 721 and 914.

² *Heckers v. Fowler*, 2 Wallace, 132, 1864.

³ Revised Statutes, Section 4919;

Merchant v. Lewis, 1 Bond, 172, 1857.

⁴ *Williames v. McNeely*, 77 F. R. 895, 1896.

disclaimer was filed in the Patent Office before the commencement of the action;¹ and except where only a small part of the infringement alleged by the plaintiff is found by the verdict;² and except where the defendant offered before the suit was begun, to submit to the patent and to pay a definite sum as damages for his infringement, and which sum was as large as the plaintiff's recovery;³ and except where part of the patents or part of the claims sued upon, are not recovered upon.⁴ In the last mentioned case, the plaintiff may sometimes recover costs on account of his successful patent or patents, or his successful claim or claims,⁵ and sometimes not.⁶

There is no United States statute which provides that defendants shall recover costs in any patent case. The common law of England allowed no costs to either party in any action at law;⁷ and the statutes of Gloucester,⁸ which supplied that defect as to plaintiffs, did not supply it as to defendants. The statute of 23 Henry VIII., Chapter 15, enacted, however, that where, in actions on the case, the plaintiff is nonsuited after the appearance of the defendant; or where the verdict happens to pass, by lawful trial, against the plaintiff, the defendant shall have judgment to recover his costs against the plaintiff, and shall have such process and execution for the recovery of the same, as the plaintiff might have had against the defendant, in case the judgment had been given for the plaintiff. This statute of Henry

¹ Revised Statutes, Sections 973, 4917, and 4922; *Metallic Extraction Co. v. Brown*, 110 F. R. 665, 1901.

² *Marks' Chair Co. v. Wilson*, 43 F. R. 304, 1890.

³ *Lowell Mfg. Co. v. Whittall*, 71 F. R. 515, 1895.

⁴ *Adams v. Howard*, 19 F. R. 319, 1884; *Albany Steam Trap Co. v. Felthousen*, 20 F. R. 640, 1884; *Mann's Car Co. v. Monarch Car Co.*, 34 F. R. 130, 1888; *Ligowski Clay-Pigeon Co. v. Clay-Bird Co.*, 34 F. R. 328, 1888; *National Machine Co. v. Brown*, 36 F. R. 322,

1888; *Schmid v. Mfg. Co.*, 37 F. R. 348, 1889; *Thomson-Houston Electric Co. v. Elmira Ry. Co.*, 71 F. R. 886, 1895; *American Saddle Co. v. Sager Gear Co.*, 122 F. R. 645, 1903.

⁵ *Green v. Lynn*, 81 F. R. 388, 1897.

⁶ *Brill v. Delaware County Electric Ry. Co.*, 109 F. R. 901, 1901; *Ide v. Trorlicht, Duncker & Renard Carpet Co.*, 115 F. R. 150, 1902.

⁷ *Day v. Woodworth*, 13 Howard, 372, 1851.

⁸ 6 Edward I. Chapter I. 1278.

VIII. having been enacted before the founding of the English colonies in America, and being suited to the condition of society in the United States, is in force in the United States courts to the same extent that it would be if it were one of the rules of the common law.¹

§ 544. All the items of costs which are taxable in a United States court are specified in the United States statutes,² or in some rules of that court authorized by such a statute.³ The province of a taxing officer is therefore limited to comparing suggested items with the particulars of those statutes and rules, and to taxing those, and only those, which he finds enumerated therein.⁴ And no expenses, other than taxable costs, can be lawfully inserted in any cost bill.⁵ On most points, the statutes relevant to fees are so clear that they require no explanation; but in some particulars they needed and have received judicial construction. Several such cases may be conveniently explained in a few of the sections which immediately follow.

§ 545. One attorney's docket fee is taxable in each case against the defeated party.⁶ There is no warrant for taxing the unsuccessful party with a separate docket fee for each of his adversary's attorneys, nor with a separate docket fee for each term during which a case has been pending in court, nor for taxing any docket fee in favor of any attorney of the defeated party. Neither is there any warrant for taxing an attorney's deposition fee in favor of any attorney of the beaten party, or in favor of more than one attorney of the party which prevails in the action.⁷ And taxable attorney's fees are taxed in favor of clients to help them pay

¹ *Hathaway v. Roach*, 2 *Woodbury & Minot*, 69, 1846; *Bunker v. Stevens*, 26 *F. R.* 249, 1885.

² Revised Statutes, Sections 823, 983; *The Baltimore*, 8 *Wallace*, 392, 1869; *Lyell v. Miller*, 6 *McLean*, 422, 1855; *Wooster v. Handy*, 23 *F. R.* 60, 1885; *Kelly v. Springfield Ry. Co.*, 83 *F. R.* 183, 1897.

³ *Tesla Electric Co. v. Scott*, 101 *F. R.* 524, 1900.

⁴ *Dedekam v. Vose*, 3 *Blatch.* 153, 1853.

⁵ *Parks v. Booth*, 102 *U. S.* 106, 1880.

⁶ *Dedekam v. Vose*, 3 *Blatch.* 153, 1853; *Troy Iron & Nail Factory v. Corning*, 7 *Blatch.* 17, 1869; *Parker v. Bigler*, 1 *Fisher.* 285, 1857.

⁷ Revised Statutes, Section 824.

their attorneys, and not in favor of attorneys as extra compensation.¹

§ 546. The fees of the clerk of the court are in general taxable against the defeated party; but several of the items to which he is entitled are not so taxable, but are to be paid by the party for which he rendered the services to which they refer. Among those items, are copies of the record ordered by a party for his own use.² As the greater must include the less, this rule must apply also to copies of pleadings, depositions or other papers which form parts of the records of cases.³ The extent to which clerks may make records, and charge defeated parties therefor, depends upon the rules of each court in actions at law; but in actions in equity, that matter is regulated by Section 750 of the Revised Statutes.

§ 547. The fees of a commissioner or other magistrate, who takes a deposition in a case, are strictly limited to twenty cents for each hundred words in the deposition.⁴ Those fees are generally taxable against the defeated party,⁵ but if the deposition is not offered in evidence at the trial, those fees cannot be so taxed.⁶ And reasoning by analogy from the taxation of attorneys' deposition fees, it should follow that magistrates' fees are not taxable on depositions which are offered in evidence, but are not admitted.⁷

§ 548. Witness fees are generally taxable against the defeated party, whether the testimony was given orally in court or by deposition before a magistrate.⁸ But they are not so taxable when the testimony is taken by deposition and the deposition is not offered,⁹ or if offered, is not admitted in evidence.¹⁰ Nor will a defeated party be taxed

¹ *Celluloid Mfg. Co. v. Chandler*, 27 F. R. 9, 1886.

² *Caldwell v. Jackson*, 7 Cranch, 277, 1812.

³ *Tesla Electric Co. v. Scott*, 101 F. R. 525, 1900.

⁴ *Tesla Electric Co. v. Scott*, 101 F. R. 525, 1900.

⁵ *Fry v. Yeaton*, 1 Cranch's Circuit Court Reports, 550, 1809.

⁶ *Hathaway v. Roach*, 2 Woodbury & Minot, 75, 1846.

⁷ Revised Statutes, Section 824.

⁸ Revised Statutes, Section 848.

⁹ *Hathaway v. Roach*, 2 Woodbury & Minot, 63, 1846.

¹⁰ Section 547 of this book.

with the fees of more than three witnesses to one fact, unless the prevailing party satisfies the court by affidavit, that the additional witnesses were really necessary to adequately support his contention on that point.¹

Whether any defeated party is taxable with the fees of any witness who testified on request and without a subpoena, is an unsettled question, upon which there are two decisions in the affirmative,² and three decisions in the negative.³ If it is necessary, in order to make witness fees taxable, that the witness should be served with a subpoena, it is not necessary that he should be so served by any officer. Service by a private person is sufficient.⁴

Witness fees are taxable in favor of a defendant, though his witnesses are not examined, because the action is not prosecuted; and where witnesses attend more than once at the same term, because of a stipulated postponement of the trial; their fees are to be taxed as for continuous attendance during the interim, and not as for repeated journeys from their homes.⁵ Witnesses from a distance are entitled to fees for Sunday, where they are detained over that day.⁶

§ 549. The taxation of costs may properly be made at the time the judgment is entered, and that is the course which best secures the rights of the parties. But a blank may be left in the judgment for that purpose, and may be filled by a taxation made *nunc pro tunc*, after the judgment has been affirmed by the Circuit Court of Appeals.⁷ Where the former practice is followed, the legality of the taxation may probably be reviewed by the Circuit Court of Appeals, if the case is taken to that forum by the defendant, to secure a reversal of a judgment against him for substantial

¹ Bussard v. Catalino, 2 Cranch's Circuit Court Reports, 421, 1823.

² Cummings v. Plaster Co., 6 Blatch. 510, 1869; Dennis v. Eddy, 12 Blatch. 196, 1874.

³ Dreskill v. Parish, 5 McLean, 213, 1851; Woodruff v. Barney, 2 Fisher, 244, 1862; Spalding v. Tucker, 4 Fisher, 637, 1871.

⁴ Power v. Semmes, 1 Cranch's Circuit Court Reports, 247, 1805.

⁵ Hathaway v. Roach, 2 Woodbury & Minot, 63, 1846.

⁶ Schott v. Benson, 1 Blatch. 564, 1850.

⁷ Sizer v. Many, 16 Howard, 98, 1853.

damages as well as costs, and if the court affirms or modifies the judgment as to the damages.¹ But where only nominal damages and costs are adjudged against a defendant, he cannot take the case to the Circuit Court of Appeals for the purpose of securing a reversal of the judgment or a diminution of the costs.² Where a judgment for costs is entered against a plaintiff on the basis of a verdict for the defendant, the plaintiff may go to the Circuit Court of Appeals on a writ of error. If he secures a reversal of the judgment for errors on the trial, there will be no occasion for the court to consider the correctness of the taxation of costs. If, on the other hand, the court finds no error upon which to ground a reversal, it will seek for no error in the taxation.³

The clerks of the Circuit Courts are the primary taxing officers of those tribunals; but they perform that duty under the general or particular direction of the judges. And such directions may properly be given by a judge when entering a judgment in a case.⁴

The taxation of costs is ordinarily made by the clerk on his own motion, or at the request of the prevailing party, and without notice to the defeated party. If the latter is dissatisfied with the result, the court will hear his motion for a retaxation. If such a motion is accompanied with an explanation showing colorable ground for a claim of error in the taxation, the court will order the clerk to retax the costs, upon the mover giving the opposite party due notice of the time and place thereof, and paying the costs occasioned thereby.⁵ Then, if either party is dissatisfied with the result of the retaxation, he may appeal to the court; but as a foundation for the hearing of such an appeal, he must secure from the clerk an itemized bill of the charges

¹ *Parks v. Booth*, 102 U. S. 106, 1880.

² *Elastic Fabrics Co. v. Smith*, 100 U. S. 110, 1879; *Paper-Bag Cases*, 105 U. S. 772, 1881.

³ *Canter v. Insurance Companies*, 3 Peters, 318, 1830; *Robbins v.*

Illinois Watch Co., 81 F. R. 959, 1897.

⁴ *Eastman Co. v. Getz*, 84 F. R. 462, 1898.

⁵ *Collins v. Hathaway*, *Olcott's Reports*, 182, 1845.

to which he objects;¹ and as a foundation for success on that hearing, must show that part or all of those items are unwarranted by the statute, or are untaxable because they refer to evidence which was immaterial to the case, and improperly taken therein.² All of these proceedings must take place at the term in which the judgment is entered;³ except in a case where a blank for costs is left in a judgment, pending a writ of error.

§ 550. A writ of error properly taken out from the office of the clerk of any Circuit Court of Appeals,⁴ will carry any action at law for an infringement of a patent from any court subordinate thereto, to that court, regardless of the amount of damages in controversy;⁵ and whether the case was tried by a jury, by a referee, or by a judge alone.⁶ But no writ of error can carry any question of fact to a Circuit Court of Appeals.⁷

The sole function of such a writ is to secure from such tribunal a review of the questions of law involved in a case, or, where the finding below was made by a judge, and was special, to secure a review of the question whether the facts so found are sufficient to support the judgment based thereon.⁸

Any action at law for infringement of a patent which has been pending, and has been decided in the Supreme Court of the District of Columbia, may be taken by a writ of error to the Court of Appeals of the District of Columbia,⁹ and if the validity of the patent is involved, the case may likewise be taken from that court to the Supreme Court of the United States.¹⁰

¹ *Dedekam v. Vose*, 3 Blatch. 153, 1853.

² *Ecaubert v. Appleton*, 67 F. R. 926, 1895.

³ *Blagrove v. Ringgold*, 2 Cranch's Circuit Court Reports, 407, 1823.

⁴ *West v. Barnes*, 2 Dallas, 401, 1791.

⁵ Revised Statutes, Section 699; 26 Statutes at Large, p. 826, Ch. 517, Section 6.

⁶ *York & Cumberland Railroad*

Co. v. Myers, 18 Howard, 246, 1855; *Heckers v. Fowler*, 2 Wallace, 123, 1864.

⁷ *Heckers v. Fowler*, 2 Wallace, 123, 1864.

⁸ Revised Statutes, Section 700; *Singer Mfg. Co. v. Cramer*, 109 F. R. 652, 1901.

⁹ 27 Statutes at Large, Ch. 74, Section, 7, p. 435.

¹⁰ 27 Statutes at Large, Ch. 74, Section 8, p. 436.

Where a new trial is had in a Circuit Court, or in the Supreme Court of the District of Columbia, in pursuance of a writ of error, and where the case is again taken to an appellate court by another writ of error, that upper court is bound by its own prior decision on all the points decided therein.¹

Actions at law for infringements of patents cannot be taken by a writ of error, from any Circuit Court of Appeals, to the Supreme Court of the United States.

Any Circuit Court of Appeals may certify to the Supreme Court any pure question of law, upon which it desires the instruction of that court for its proper decision.² And the Supreme Court may send a certiorari to any Circuit Court of Appeals, requiring any case for infringement of a patent to be sent to the Supreme Court for its review and determination.³

§ 551. Bills of exception, allowed and signed, or sealed by the judge, constitute the only mode by which the questions of law that arise on the trial of a case, can be prepared for transmission to an appellate court in pursuance of a writ of error.⁴ But a paper which is incorporated in the record, and which has all the substantial characteristics of a bill of exceptions, will be treated as such, even though it is not so entitled.⁵ Such a document should state no more of the case than is necessary to present the questions which are reviewable in the appellate court, and which the plaintiff in error seeks to have reviewed there.⁶ If those questions relate only to the pleadings, the pleadings only should be inserted in the bill of exceptions. Where those questions relate only to the competency of a witness, the bill of exceptions need only show that the witness was offered, and was accepted or rejected, as the case may be, and that such

¹ *Standard Sewing Mach. Co. v. Leslie*, 118 F. R. 559, 1902.

² *Graver v. Faurot*, 162 U. S. 435, 1896; *Cross v. Evans*, 167 U. S. 60, 1897.

³ 26 Statutes at Large, p. 826, Ch. 517, Section 6.

⁴ *Insurance Co. v. Lanier*, 95 U. S. 171, 1877.

⁵ *Herbert v. Butler*, 97 U. S. 319, 1877.

⁶ *Hausknecht v. Claypool*, 1 Black, 431, 1861.

admission or rejection was duly excepted to, and, in case of a rejection of a witness to want of novelty, that due notice of the fact, to be proved by him, was served on the opposite party;¹ and where particular answers of a competent witness were excluded by the court below, the bill of exceptions must contain those answers, and must show that they were material to the issues; and where particular questions were excluded, and therefore not answered, the bill of exceptions must show what facts the party offered to prove by means of those questions, and that such facts were material to the case.² And where a particular question was objected to, but was admitted and was answered, the bill of exceptions must show what the answer was, in order to enable the appellate court to pass upon the propriety of the evidence.³

§ 552. Where the questions which are sought to be brought before the Court of Appeals, relate only to the instructions which the court below gave, or refused to give to the jury, the bill of exceptions should set forth the issues of the pleadings, and the substance of the charge or refusal to charge, as the case may be, together with whatever part of the evidence is necessary to enable the Court of Appeals to decide upon the propriety, or impropriety, of the action of the court below.

The issues of the pleadings should be stated in the bill of exceptions, for otherwise the appellate tribunal cannot know whether the charge or refusal to charge, which was excepted to, was material to the case; and because the Court of Appeals will not sit to try moot issues of law, nor to establish legal propositions in cases wherein those propositions are not involved.⁴

The substance of the charge, rather than the charge *in extenso*, should be stated in the bill, because the Court of Appeals cannot afford to be occupied in listening to minute

¹ Philadelphia & Trenton Railroad Co. v. Stimpson, 14 Peters, 448, 1840; Blanchard v. Putnam, 8 Wallace, 420, 1869.

² Railroad Co. v. Smith, 21 Wallace, 255, 1874.

³ Lovell v. Davis, 101 U. S. 542, 1879.

⁴ Jones v. Buckell, 104 U. S. 554, 1881.

criticisms and observations upon expressions incidentally introduced into a charge for purposes of argument or illustration, and which, if they were the direct point in judgment, might need qualification, but which do not show, that the relevant law was not justly expounded to the jury.¹ But the whole substance of the charge should be stated where nothing but charged matter is excepted to; because if part is omitted, the Court of Appeals cannot know that the omitted portion did not cure the faults of the parts inserted.² So also, where the matter which is excepted to is a refusal to charge; not only the refused instruction, but also the whole substance of the given charge, should be inserted in the bill of exceptions; for otherwise the Court of Appeals cannot be informed whether the refused instruction was not substantially contained in the charge which was actually given; and because judges are never bound to instruct juries in the form requested, provided they substantially embody the whole of the relevant law in the charges which they give.³

Where nothing but charged matter is excepted to, the bill of exceptions should not contain any part of the evidence; because the only question before the Court of Appeals in such a case is the correctness of the charge.⁴ But where a refusal to charge is excepted to, the bill must contain the evidence to which the refused instruction relates, or must contain a statement of facts pertinent to that point, and a statement that evidence was introduced tending to prove those facts; because no court is bound to give any charge which does not relate to the evidence, no matter how sound the proposed instruction may be, as a proposition of law.

§ 553. Specific exceptions must be made to instructions, in order to entitle the objector to a review of those instructions in the Court of Appeals. Where a requested instruction is refused, and the refusal is excepted to, that refusal will be sustained by the Court of Appeals, if the requested

¹ *Evans v. Eaton*, 7 Wharton, 356, 1822.

² *Meyers v. Sternheim*, 97 F. R. 625, 1899.

³ *Indianapolis & St. Louis Rail-*

road Co. v. Horst, 93 U. S. 295, 1876.

⁴ *Pennock v. Dialogue*, 2 Peters, 1, 1829.

instruction was unsound in any particular.¹ Counsel ought therefore to carefully separate their propositions of law from each other, when framing their requests for instructions, lest one erroneous proposition deprive them of the benefit of several sound ones.

§ 554. Exceptions to charges, or to refusals to charge, must be made and noted while the jury is at the bar.² But bills of exception may be drawn up, and signed or sealed by the judge at any time before the expiration of the term, unless the judge enforces some rule of his court which prescribes a shorter time for the preparation and presentation of such documents for his approval. And, if not otherwise too late, such bills may be prepared and signed after a writ of error has been sued out from the Court of Appeals, to transfer the case to that tribunal.³

¹ *Indianapolis & St. Louis Railroad Co. v. Horst*, 93 U. S. 295, 1876.

² *Phelps v. Mayer*, 15 Howard, 160, 1853.

³ *Hunnicut v. Peyton*, 102 U. S. 353, 1880.

CHAPTER XIX.

DAMAGES.

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| 555. The generic measure of damages. | 563. Hurtful competition in the absence of an established royalty, causes recoverable damages. |
| 556. Established royalties as specific measures of damages. | 564. Damages for unlicensed making, without unlicensed selling or using. |
| 557. Tests applied to royalties on behalf of defendants. | 565. Evidence of damages. |
| 558. Tests applied to royalties on behalf of plaintiffs. | 566. Indirect consequential damages. |
| 559. Money paid for infringement already committed, is no measure of damages in another case. | 567. Exemplary damages. |
| 560. Royalties reserved on sales of patents. | 568. Increased damages. |
| 561. Royalties for licenses to make and use, and royalties for licenses to make and sell. | 569. Actual damages not affected by infringement being unintended. |
| 562. Proportion of licensed to unlicensed practice of an invention. | 570. Counsel fees and other expenses. |
| | 571. Interest on damages. |
| | 571a. Damages in design cases. |

§ 555. THE pecuniary injury which a plaintiff incurs by reason of a defendant's infringement of his patent, is the generic measure of the damages which that plaintiff is entitled to recover on account of that infringement.¹ Such an injury is often called the plaintiff's loss,² and sometimes it is strictly that, but often it is a loss only in the sense that it is a failure to acquire a just and deserved gain.³ Whether the injury caused to a plaintiff by an infringement was a loss in one or the other of these senses, its magnitude must always be ascertained, in order to ascertain the

¹ *Coupe v. Royer*, 155 U. S. 582, 1895; *Goodyear v. Bishop*, 2 Fisher, 158, 1861; *Graham v. Mfg. Co.*, 24 F. R. 643, 1881; *Brickill v. Baltimore*, 60 F. R. 98, 1894.

² *Suffolk Co. v. Hayden*, 3 Wallace, 315, 1865; *Cowing v. Rumsey*,

8 Blatch. 36, 1870; *McComb v. Brodie*, 1 Woods, 161, 1871; *La Baw v. Hawkins*, 2 Bann. & Ard. 563, 1877.

³ *Hobbie v. Smith*, 27 F. R. 662, 1886.

amount of the damages which he is entitled to recover. The amount of the profits which the defendant derived from his infringement, has no direct relevancy to the question of the plaintiff's damages; because these profits are sometimes much larger than the plaintiff's pecuniary injury;¹ and where they are smaller, that fact is no defence to the plaintiff's right to recover full damages for the pecuniary injury which the infringement caused him to incur.² But where a patentee has elected to recover the infringer's profits, instead of his own damages, in an action in equity; he cannot recover, for the same infringement, his damages in an action at law.³

To ascertain the extent of the pecuniary injury which a particular infringement caused a particular plaintiff, it is necessary to ascertain the difference between his pecuniary condition after that infringement, and what that condition would have been if that infringement had not occurred.⁴ That difference depends upon the way in which the plaintiff availed himself of the exclusive right infringed, at the time the infringement took place. If he so availed himself, by granting licenses to others to do the things which the defendant did without a license, then that difference consists in his not having received the royalty which such a license would have brought him.⁵ If he so availed himself, by keeping his patent right a close monopoly and granting licenses to no one, then that difference consists of the money he would have realized from such a close monopoly if the defendant had not infringed; but which that infringe-

¹ *Seymour v. McCormick*, 16 Howard, 480, 1853; *New York v. Ransom*, 23 Howard, 487, 1859; *Packet Co. v. Sickles*, 19 Wallace, 611, 1873.

² *Emerson v. Simm*, 6 Fisher, 281, 1873; *Dental Vulcanite Co. v. Van Antwerp*, 2 Bann. & Ard. 255, 1876.

³ *Child v. Iron Works*, 19 F. R. 258, 1884.

⁴ *Yale Lock Co. v. Sargent*, 117 U. S. 552, 1885.

⁵ *Seymour v. McCormick*, 16 Howard, 480, 1853; *New York v. Ransom*, 23 Howard 487, 1859; *Philip v. Nock*, 17 Wallace, 462, 1873; *Clark v. Wooster*, 119 U. S. 326, 1886; *Tilghman v. Proctor*, 125 U. S. 143, 1887; *Graham v. Mfg. Co.*, 24 F. R. 643, 1881; *Timken v. Olin*, 41 F. R. 171, 1890.

ment prevented him from receiving.¹ Therefore there are several methods of assessing damages for infringements of patents. The primary method consists in using the plaintiff's established royalty as the measure of those damages;² and the second consists in ascertaining those damages by ascertaining what the defendant's interference with the plaintiff's close monopoly prevented the latter from deriving therefrom.³ It is convenient to consider these two criteria of damages separately, and in the order in which they have been stated.

§ 556. Royalties, as measures of damages, are sometimes objected to by defendants, and sometimes by plaintiffs. When invoked by a plaintiff, a royalty is liable to one class of tests, applied on behalf of the defendant; and when invoked by a defendant to limit the plaintiff's recovery, it is liable to another class of tests, applied on behalf of the plaintiff.

§ 557. A defendant may successfully object to a given royalty, as a measure of the plaintiff's damages, unless it was uniform, and was actually paid or secured before the defendant's infringement was committed, by a sufficient number of persons to show that people who have occasion to purchase a license under the patent, can afford to pay that royalty.⁴ The sale of a single license is not sufficient to establish a royalty,⁵ because one purchaser may give a larger sum for a license than he or any other can afford to pay; whereas such a business error is not likely to be made by a considerable number of persons when buying licenses under the same patent. The unanimous opinion of twelve

¹ Philip v. Nock, 17 Wallace, 462, 1873; Yale Lock Co. v. Sargent, 117 U. S. 552, 1885; McComb v. Brodie, 1 Woods, 153, 1871; Covert v. Sargent, 38 F. R. 238, 1880.

² Brickill v. Baltimore, 60 F. R. 98, 1894.

³ Zane v. Peck, 13 F. R. 475, 1882.

⁴ Rude v. Westcott, 130 U. S.

152, 1889; Adams v. Stamping Co., 28 F. R. 366, 1886; Hunt Bros. Fruit Packing Co. v. Cassidy, 53 F. R. 262, 1892; Houston Ry. Co. v. Stern, 74 F. R. 630, 1896.

⁵ Judson v. Bradford, 3 Bann. & Ard. 549, 1878; Vulcanite Paving Co. v. Pavement Co., 36 F. R. 378, 1888.

average men is thought to be the most reliable criterion of guilt or innocence; but no reasonable person would hold that view, of the opinion of any one of the twelve. In like manner, the unanimous acquiescence of a considerable number of men in a particular royalty, is evidence of its substantial justice, while the acquiescence of one only of the same men would have no convincing force.

The amount of the royalty relied upon must have been actually paid or secured by the licensees in order to make it a measure of damages against other infringers. Were the rule otherwise, there would be no safeguard against collusion between patentees and licensees for the purpose of imposing on infringers and other third parties. It follows that the mere production of a quantity of licenses, purporting to have been granted at a certain rate, cannot establish a royalty at that rate. Somebody must make oath that the ostensible price of the licenses was their true price, before they can have that effect. The oath and not the license being the best evidence of the royalty, the royalty may be proved by the oath without the production of the license, even where the license is in writing.¹

A royalty, in order to be binding on a defendant who was a stranger to the licenses which established it, must be a uniform royalty.² This rule does not imply that a patentee may not change the rate of his royalty as often as he can get a sufficient number of licensees to acquiesce in such a change;³ but it does exclude from consideration all such licenses as were given at variant rates, for no better reason than variant ability on the part of the licensees to negotiate for a license or to resist a suit for infringement.⁴

So, also, a particular royalty may be successfully objected to by a defendant, if it was not established till after the

¹ *Wooster v. Simonson*, 20 F. R. 316, 1884; *Timken v. Olin*, 41 F. R. 170, 1890.

² *Westcott v. Rude*, 19 F. R. 833, 1884.

³ *Asmus v. Freeman*, 34 F. R. 902, 1888.

⁴ *Black v. Munson*, 14 Blatch. 268, 1877; *United Nickel Co. v. Railroad Co.*, 36 F. R. 190, 1888.

infringement sued upon was committed.¹ And it is probable that a defendant may avoid the application of a particular royalty by showing that a different rate was established in the particular city, county or State wherein he unlawfully availed himself of the patentee's invention.

§ 558. A plaintiff may successfully object to a particular royalty as a measure of his damages, where that royalty was established, and was intended to be established, within a particular territory only, or where it was changed or abandoned before the infringement in suit was committed. These two points rest upon obvious reasons. A patentee may wish to hold a close monopoly on his invention in Maine, while willing to grant licenses in Florida; or he may rightfully demand a much larger royalty in Minnesota than that which he is willing to accept in Texas or in Oregon. In such a case, it is clear that his Oregon royalty is not to be forced upon him for infringement committed in Minnesota; and that his business in Maine is not to be ruined by infringers who have nothing worse to fear at the end of the suit than the payment of a royalty like that established in Florida.

So, also, it has often happened, and may happen again, that an inventor is forced by poverty, or other misfortune, to accept inadequate royalties during the earlier years of his exclusive right. In such a case, it is clear that he ought to be permitted to increase the rate whenever he can get licensees to consent thereto, or to abandon his royalty altogether and hold a close monopoly on his invention, as far as he can do so consistently with licenses outstanding.

§ 559. Money paid for infringement already committed does not establish nor tend to establish a royalty.² A price

¹ *Emigh v. Railroad Co.*, 6 F. R. 284, 1881.

² *Rude v. Westcott*, 130 U. S. 152, 1889; *Cornely v. Marekwald*, 131 U. S. 159, 1889; *Black v. Munson*, 14 Blatch. 268, 1877; *Greenleaf v. Mfg. Co.*, 17 Blatch. 253, 1879; *Matthews v. Spangenberg*,

14 F. R. 350, 1882; *National Car Brake Shoe Co. v. Mfg. Co.*, 19 F. R. 517, 1884; *Westcott v. Rude*, 19 F. R. 832, 1884; *Gottfried v. Brewing Co.*, 22 F. R. 433, 1884; *Cornely v. Marekwald*, 32 F. R. 292, 1885; *United Nickel Co. v. Railroad Co.*, 36 F. R. 190, 1888; *Keyes v. Re-*

paid to compromise a pending action, or an existing right of action, may sometimes be larger and sometimes be smaller than a proper royalty would be. It may be larger where the infringer is a person who is disinclined to litigation, or where he has some reason to fear a judgment for triple damages, or where the compromise releases him not only from damages, but also from all rights of action for infringer's profits. It may be smaller where the infringer is presumably insolvent, or where the amount involved is too small to justify the expense incident to its collection by an action at law.

§ 560. A royalty which is reserved as the whole or a part of the purchase price of a patent, is not a proper one to measure damages as against an infringer.¹ It may be too large, or it may be too small for that purpose. It will be too large when the patent is of such a nature that the buyer can afford to pay more for a close monopoly, than for a license to compete with other licensees.² It will be too small, where it is for the interest of the owners of the patent to subdivide the right to practice the invention. In the latter class of cases, the buyer, in order to get paid for introducing the invention and retailing the licenses, must sell them at a higher rate than that which he pays to the patentee.

§ 561. A royalty provided for in licenses to make and use, is no measure of damages for an infringement which consisted of making and selling the patented thing; nor is a royalty which was established by licenses to make and sell specimens of the invention covered by a patent, any criterion of the injury which may have been inflicted on the pecuniary interests of the owner by unlawfully making and using such specimens.³ These rules rest upon undeniable reasons. The value of some patents resides almost entirely

fining Co., 43 F. R. 478, 1890;
Ewart Mfg. Co. v. Baldwin Cycle-
Chain Co., 91 F. R. 265, 1898.

² Colgate v. Mfg. Co., 28 F. R.
147, 1886.

¹ La Baw v. Hawkins, 2 Bann.
& Ard. 564, 1877.

³ Colgate v. Mfg. Co., 28 F. R.
147, 1886.

in the exclusive right to make and sell, while that of others consists almost wholly in the exclusive right to make and use the inventions which they respectively cover.

§ 562. In measuring damages with a royalty, due regard must be had to proportion. Where an infringement was smaller in extent or shorter in duration than the corresponding doings which were authorized by the licenses which established the royalty, it is but just that the damages should be assessed at a correspondingly smaller sum, unless there are special facts in the case which render the particular extent of the infringement immaterial to the plaintiff.¹ In like manner, damages will amount to a sum correspondingly larger than the royalty which constitutes their criterion, when the infringement in suit was larger or was longer than the doings authorized by the licenses which established the royalty.

So, also, where only part of the inventions covered by a particular patent are unlawfully appropriated by an infringer, he is liable for only an equitable proportion of the royalty which has been established for all of those inventions jointly;² and where a royalty has been established for the joint employment of all of the inventions covered by several patents, damages for the infringement of part of those patents may be equitably assessed by dividing that royalty into portions proportionate to the value of the several inventions covered by those patents.³ But the plaintiff must furnish data in his evidence, upon which to make this division.⁴

§ 563. Where no established royalty is applicable as a measure of the damages caused by a particular infringement, those damages may be ascertained by the second method; that is, by finding what the plaintiff would have

¹ *Birdsall v. Coolidge*, 93 U. S. 70, 1876; *Judson v. Bradford*, 3 Bann. & Ard. 549, 1878; *Wooster v. Simonson*, 16 F. R. 680, 1883; *Westcott v. Rude*, 19 F. R. 834, 1884; *Bates v. Railroad Co.*, 32 F. R. 628, 1887.

² *Willimantic Thread Co. v. Clark*

Thread Co., 27 F. R. 865, 1886; *Asmus v. Freeman*, 34 F. R. 903, 1888.

³ *Porter Needle Co. v. Needle Co.*, 22 F. R. 829, 1885.

⁴ *Hunt Bros. Fruit Packing Co. v. Cassidy*, 53 F. R. 262, 1892.

derived from his monopoly if the defendant had not interfered, but which he failed to realize because of that interference with his rights.

Where the owner of a patent is able to supply the whole demand for the article it covers, and where the whole demand would go to him in the absence of infringement; the losses inflicted upon him by an infringer, may consist in reducing his sales, or in reducing his prices, or in both those injurious ways. His sales may be reduced by the omission of the infringer to buy from him, while procuring infringing articles elsewhere or otherwise. His sales may also be reduced by competing sales made by the infringer to others, who in the absence of that competition, would have purchased from the patentee. The sum of the profits which the patentee would have derived from the sales which the infringer's course prevented the patentee from making, and the sum of the reduction in prices which the infringer's course compelled the patentee to make on the sales which he did effect, or either of those elements in the absence of the other, make up the amount of the damages which the patentee is entitled to recover from the infringer, where there is no established royalty applicable to their measurement.¹

Proof of the element of lost sales, includes evidence to show what profits the patentee would have derived from the sales which the infringer's course prevented him from making;² and evidence to show that he could have supplied the articles which the infringer procured elsewhere,³ and the articles which the infringer's competition prevented him from selling to others;⁴ and evidence to show that the in-

¹ *Yale Lock Co. v. Sargent*, 117 U. S. 552, 1885; *Boesch v. Graff*, 133 U. S. 705, 1891; *Seabury v. Am Ende*, 152 U. S. 569, 1894; *Fitch v. Bragg*, 16 F. R. 247, 1883; *Hobbie v. Smith*, 27 F. R. 662, 1886; *Creamer v. Bowers*, 35 F. R. 207, 1888; *Am Ende v. Seabury*, 43 F. R. 673, 1890.

² *Cornely v. Marekwald*, 131 U. S. 161, 1889.

³ *Rose v. Hirsh*, 94 F. R. 178, 1899.

⁴ *Crosby Valve Co. v. Safety Valve Co.*, 141 U. S. 452, 1891; *Regina Music Box Co. v. Otto*, 114 F. R. 505, 1902.

fringer would have purchased from him, rather than do without such articles;¹ and evidence to show that the persons who purchased infringing articles from the infringer, would have bought them from the patentee, if they could not otherwise have procured them.²

The first three of the five elements of evidence specified in the last paragraph must be direct and strong. The last two of those elements, though not necessarily direct, must at least be legitimate circumstantial evidence.³ But where the defendant's infringement was wanton, that evidence needs not to be so strong, as where it was unintentional or was the result of error of information or of judgment.⁴

Proof of the element of reduced prices includes evidence to show that it was the defendant's infringement that caused, or helped to cause, the reduction of prices which the patentee was compelled to make,⁵ and evidence of the extent of the reduction so caused;⁶ but it does not include evidence that the patentee would have been asked to supply the particular demand which was supplied by the defendant, if the defendant had not supplied it.

Where damages cannot be assessed on the basis of a royalty, nor on that of lost sales, nor on that of hurtful competition; only nominal damages can be recovered for the infringement of a patent.⁷

§ 564. Damages for infringement by making, without unlawfully selling or using, specimens of a patented thing will

¹ *Rose v. Hirsh*, 94 F. R. 178, 1899.

² *Dobson v. Dornan*, 118 U. S. 18, 1885; *Goodyear v. Bishop*, 2 Fisher, 161, 1861; *Magie Ruffle Co. v. Douglas*, 2 Fisher, 340, 1863; *Sargent v. Mfg. Co.*, 17 Blatch. 247, 1879; *Hall v. Stern*, 20 F. R. 788, 1884; *Roemer v. Simon*, 31 F. R. 41, 1887; *Bell v. Stamping Co.*, 32 F. R. 551, 1887; *Tatum v. Gregory*, 51 F. R. 447, 1892.

³ *Covert v. Sargent*, 38 F. R.

237, 1889; *Kinner v. Shepard*, 107 F. R. 952, 1907.

⁴ *Rose v. Hirsh*, 94 F. R. 178, 1899; *Regina v. Box Co.*, 114 F. R. 2.

⁵ *Ingersoll v. Bann. & Ard.*, 304, 1878; *James v. Truman*, 67 F. R. 545, 1895.

⁶ *Cornely v. Marekwald*, 131 U. S. 161, 1889; *Boesch v. Graff*, 133 U. S. 703, 1890.

⁷ *City of Seattle v. McNamara*, 81 F. R. 863, 1897.

be nominal only,¹ unless there is an established royalty for such making,² or unless some definite damage can be proved on some basis not yet discoverable in the statutes or in the precedents.

§ 565. The evidence of damages must be reasonably definite,³ in order to justify a jury in finding a verdict for more than a nominal amount. Conjecture will not perform the office of proof, nor can imagination take the place of calculation in this behalf.⁴ But this rule is not to be used to defeat the ends of justice. It may happen that a plaintiff can prove the measure of his damages with precision, while unable to prove the real extent of the defendant's infringement. In such a case, the defendant can usually remove the uncertainty, because he is likely to know or be able to ascertain what and how much he has done. If, by omitting to supply the information, a defendant could avert a verdict for proper damages, he could easily defeat a meritorious cause. But the law will not allow itself to be thus circumvented. On the contrary, it is the rule that where a plaintiff introduces evidence to show that the damages were large, and to show the amount of those damages as accurately as the nature of the case permits him to do, and where the defendant offers no evidence upon the subject, it becomes the function of the jury to estimate those damages as best they can, on the basis of the plaintiff's evidence.⁵ In making such an estimate, a jury ought to resolve every point of uncertainty against the defendant, for he had it in his power to give them accurate data upon which to compute.⁶

§ 566. Remote consequential damages cannot be embodied in a verdict for an infringement of a patent.⁷ The instances

¹ *Whittemore v. Cutter*, 1 Gallison, 483, 1813; *Carter v. Baker*, 4 Fisher, 419, 1871.

² *Ketchum Harvester Co. v. Johnson Harvester Co.*, 8 F. R. 586, 1881.

³ *Creamer v. Bowers*, 35 F. R. 208, 1888; *Williames v. McNeely*, 77 F. R. 894, 1896.

⁴ *New York v. Ransom*, 23 Howard, 487, 1859.

⁵ *Stephens v. Felt*, 2 Blatch. 38, 1846.

⁶ *National Car-Brake Shoe Co. v. Mfg. Co.*, 19 F. R. 520, 1884.

⁷ *Carter v. Baker*, 4 Fisher, 421, 1871.

in which such damages have been claimed are but few, but they are likely to become more numerous hereafter. It is therefore proper to mention such injuries as will probably be held to fall within such a category.

Pecuniary injury may result to a patentee from a particular infringement, in that it caused him to incur competition and consequent loss, in business outside of the patent infringed; or in that it so unexpectedly reduced the business of the patentee as to make it necessary for him to sell unpatented property at less than its real value, or to borrow money at more than a proper rate of interest, in order to meet his pecuniary engagements; or in that it encouraged other persons to infringe, from whom, by reason of insolvency or other obstacle, no recovery can be obtained; or in that such infringement caused the patentee so much trouble and anxiety that he incurred loss from inability to attend to other business. But pecuniary injury of either of these kinds would be such an indirect consequential matter as not to furnish any part of a proper basis for recoverable damages.

§ 567. Exemplary damages cannot lawfully be given by a jury for any infringement of a patent.¹ The meaning of this rule is that juries are to base verdicts on plaintiff's injuries, and not on defendant's ill-deserts. Their function is to award compensation to the injured, not punishment to the injurer. The power to inflict punitive damages is committed by the statute to the judge. He may exercise that power by entering a judgment for any sum above the amount of the verdict, not exceeding three times that amount, together with costs,² or by declining to increase the damages beyond the amount found by the verdict; and in either case his judgment will not be overruled by the Circuit Court of Appeals, unless the evidence clearly demands it.³ The

¹ *Wilbur v. Beecher*, 2 Blatch. 143, 1850; *Hall v. Wiles*, 2 Blatch. 200, 1851; *Parker v. Hulme*, 1 Fisher, 56, 1849; *Haselden v. Ogden*, 3 Fisher, 378, 1868; *Russell v. Place*, 5 Fisher, 134, 1871.

² Revised Statutes, Section 4919; *Seymour v. McCormick*, 16 Howard, 489, 1853.

³ *Topliff v. Topliff*, 145 U. S. 174, 1892.

costs are to be added to the increased verdict, and the judgment cannot be entered for a sum three times greater than the aggregate of the verdict and the costs; and if, for any reason, no costs are awarded to the plaintiff, that fact neither ousts the power of the court to enter a judgment for a sum larger than the verdict, nor constitutes a reason for exercising that power where no other reason exists.¹ But that power will be exercised where the defendant's infringement was deliberate and intentional, even though it may have been committed under an erroneous opinion of the plaintiff's rights;² or where the defendant acted in bad faith, or has been stubbornly litigious, or has caused unnecessary trouble and expense to the plaintiff;³ but not merely because the defendant's defence was so extensive as to require great expenditure to overcome it.⁴

§ 568. Increased damages may properly be awarded by a court, where it is necessary to award them in order to prevent a defendant infringer from profiting from his own wrong, whether that wrong was intentional or was unwitting. The power conferred by the statute is general. It is not confined to awarding punitive damages, but is to be exercised "according to the circumstances of the case."⁵ Among the circumstances of patent cases is the fact that the profits, which defendants derive from their infringements, are often larger than the actual damages which those infringements cause plaintiffs to sustain. If, in such a case, the defendant is forced to pay no more than the actual damages, it is clear that he will have derived advantage from his own wrong. It would be an imperfect system of law that would thus put a premium upon its own violation. Exemplary or increased damages are not forfeitures, and liability to be compelled to pay such damages, does not give an infringer

¹ *Guyon v. Serrell*, 1 Blatch. 246, 1847.

² *Russell v. Place*, 9 Blatch. 175, 1871; *Peck v. Frame*, 9 Blatch. 194, 1871.

³ *Day v. Woodworth*, 13 Howard,

372, 1851; *Teese v. Huntingdon*, 23 Howard, 2, 1859.

⁴ *Welling v. La Bau*, 35 F. R. 303, 1888.

⁵ Revised Statutes, Section 4919.

any right to withhold his testimony, as tending to criminate himself.¹

§ 569. A verdict for actual damages cannot be averted by evidence that the defendant was ignorant of the existence of the patent at the time he infringed.² All infringers have constructive notice of all patents, because all letters patent are recorded in the Patent Office. There is no more injustice involved in the rule that infringers are bound to take notice of patents, than there is in the rule that buyers of land are bound to take notice of the real estate records, or in the rule that all citizens are bound to take notice of the laws of their country. The amount of pecuniary injury which an infringement causes a patentee, is not affected by the fact that the infringer did not know of the existence of the patent which he infringed.

§ 570. Neither counsel fees nor any other expenses incident to litigation, can be included in a verdict for actual damages in a patent case.³ There is no more reason for allowing a successful plaintiff to recover such items, than there is for giving a similar recovery to a successful defendant. Certain expended fees may be recovered as costs by either; but no expenditures or costs can be recovered as damages.

§ 571. Interest should be allowed on royalties, from the time those royalties ought to have been paid, in all cases where a royalty is the measure of the plaintiff's damages.⁴ In such a case the damages are liquidated at such time as the royalty would have been due, if the defendant had elected to purchase instead of to infringe the right to use

¹ *Masseth v. Johnston*, 59 F. R. 613, 1894.

² *Emerson v. Simm*, 6 Fisher, 281, 1873; *Timken v. Olin*, 41 F. R. 170, 1890.

³ *Day v. Woodworth*, 13 Howard, 373, 1851; *Teese v. Huntingdon*, 23 Howard, 8, 1859; *Philip v. Nock*, 17 Wallace, 462, 1873; *Whittemore v. Cutter*, 1 Gallison, 429, 1813; *Stimpson v. The Railroads*, 1

Wallace, Jr., 164, 1847; *Holbrook v. Small*, 3 Bann. & Ard. 626, 1878.

⁴ *McCormick v. Seymour*, 3 Blatch. 222, 1854; *Goodyear v. Bishop*, 2 Fisher, 162, 1861; *Locomotive Safety Truck Co. v. Pennsylvania Railroad Co.*, 2 F. R. 682, 1880; *McNeely v. Williams*, 96 F. R. 982, 1899.

the invention in suit. No interest is due on damages measured otherwise than by a royalty, because such damages are unliquidated until they are ascertained by an action,¹ except where the method of measurement is as definite and conclusive as it is in the case of a royalty.²

§ 571*a*. Damages for infringement of a design patent are fixed by a special statute, at the minimum amount of two hundred and fifty dollars, and at a maximum amount enough larger than that, to equal the total profit made by the infringer upon the infringing article or articles made or sold by him.³ The statute does not state whether the two hundred and fifty dollars is recoverable from an infringer for each of his infringements, or is recoverable only once for all of his infringements of each claim infringed, or is recoverable only once for all of his infringements of each patent infringed, or is recoverable only once for all of his doings of a particular kind, even where those doings infringed more than one patent of the plaintiff. No court has put the first of these constructions on the statute; but each of the others has apparently been approved by at least one judicial tribunal.⁴

In order to recover under this statute, the plaintiff must show that the defendant knew of the plaintiff's design, and knew of the plaintiff's patent, or at least knew of facts which put him upon his inquiry for that patent;⁵ and that he knew that the design was applied to the infringing article, without the license of the owner of the patent.⁶ The last point of knowledge will be presumed against the maker; but as against a dealer whose infringement consisted in selling, or exposing for sale, articles manufactured by another, it must be proved.⁷ The entire profits which resulted to the in-

¹ *Gilpin v. Consequa*, 3 Washington, 194, 1813.

² *Creamer v. Bowers*, 35 F. R. 207, 1888.

³ 24 Statutes at Large, Ch. 105, p. 387.

⁴ *Lowell Mfg. Co. v. Whittall*, 71 F. R. 515, 1895; *Hogg v. Gimbel*,

94 F. R. 518, 1899; *Gimbel v. Hogg*, 97 F. R. 791, 1899; *Frank v. Geiger*, 121 F. R. 126, 1903.

⁵ *Smith v. Stewart*, 55 F. R. 484, 1893.

⁶ *Anderson v. Pittsburgh Lumber Co.*, 47 F. R. 68, 1891.

⁷ *Anderson v. Saint*, 46 F. R.

fringer from the infringing articles are recoverable under this statute as damages, and not merely such part of those profits as was due to the use of the patented design; and the statute is constitutional, although it provides for recoveries which are in the nature of penalties, and provides that those recoveries may be obtained upon a bill in equity for an injunction, as well as by an action at law.¹ Where the complainant in a bill in equity, waives any recovery of more than two hundred and fifty dollars; a decree will be entered for that amount, without an inquiry into the particular extent of the defendant's infringement.² But where there is no such waiver, the case will be referred to a master to ascertain whether and how much the defendant's profits exceeded two hundred and fifty dollars.³

765, 1891; *Gimbel v. Hogg*, 97 F. R. 791, 1899.

¹ *Untermeyer v. Freund*, 58 F. R. 211, 1893.

² *Pirkl v. Smith*, 42 F. R. 410, 1890.

³ *Ripley v. Elson Glass Co.*, 49 F. R. 927, 1892.

CHAPTER XX.

ACTIONS IN EQUITY.

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| <p>631. Demurrers, pleas and answers to supplemental bills, and to bills in the nature of supplemental bills.</p> <p>632. Hearings.</p> <p>633. Interlocutory hearings.</p> <p>634. Questions of law arising on hearings.</p> <p>635. Questions of fact arising on hearings.</p> <p>636. Evidence in support of the bill.</p> <p>637. Evidence in support of defences.</p> <p>638. Testimony.</p> <p>639. Depositions.</p> <p>640. Depositions taken in other cases.</p> <p>641. Documentary evidence.</p> <p>642. Trial by jury in equity cases.</p> <p>643. Hearings by masters in chancery.</p> <p>644. Interlocutory decrees.</p> <p>644a. Appeals from interlocutory decrees.</p> | <p>645. Petitions for rehearings.</p> <p>646. Rehearings for matter apparent on the record.</p> <p>647. Rehearings on account of newly discovered evidence.</p> <p>648. Supplemental bills in the nature of bills of review.</p> <p>649. Final decrees.</p> <p>650. Bills of review.</p> <p>651. Bills of review to correct errors apparent on the pleadings or final decree.</p> <p>652. Bills of review to introduce evidence discovered after the entry of the final decree.</p> <p>653. Bills in the nature of bills of review.</p> <p>654. Appeals.</p> <p>655. Hearings on appeals.</p> <p>656. Decisions on appeals.</p> <p>657. Certificates of division of opinion.</p> <p>657a. Certificates and writs of certiorari.</p> |
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§ 572. JURISDICTION in equity, in patent litigation, is conferred upon the same courts that are authorized to exercise jurisdiction at law in that branch of jurisprudence.¹ The two kinds of jurisdiction are kept as distinct in those courts as if they were conferred upon different tribunals. Equitable relief cannot be had in any action at law; and legal relief cannot be had in any action in equity, except as incidental to some equitable relief granted, or at least rightfully prayed for, therein. The only function of actions at law in patent cases is to give damages for past infringements of patents. The principal function of actions in equity in such cases is to restrain future infringements of patents by means of the writ of injunction.² In every case where an injunction is proper, a court of equity, in order to avoid a multiplicity of actions, will take an account of

¹ Revised Statutes, Sections 629 and 4921; Section 379 of this book.

² Allington & Curtis Mfg. Co. v. Booth, 78 F. R. 879, 1897; Truman v. Holmes, 87 F. R. 744, 1898.

the profits which the defendant derived from infringing the complainant's patent, and will compel the defendant to pay their amount to the complainant. And equity has jurisdiction, independent of any injunction or right to an injunction, to grant this relief relevant to profits, in all patent cases wherein some impediment prevents a resort to remedies purely legal, or wherein special circumstances render the remedy obtainable by an action at law difficult, inadequate, or incomplete.¹

§ 573. Wherever equity has jurisdiction to decree an account of the defendant's profits, it also has jurisdiction to assess the damages which the complainant sustained on account of the defendant's infringement.² Having ascertained the amount of both, if the profits are found to exceed the damages, the court will enter a decree for their recovery, and will do nothing further about the damages.³ Where the accounting shows no such profits, but does show such damages, the court will enter a decree for the amount of the latter.⁴ Where the accounting shows both profits and damages, and shows the latter to equal or exceed the former, a decree will be entered for the amount of the damages,⁵ or for any sum not exceeding three times that amount.⁶

In assessing damages, equity follows the law,⁷ and is guided by the rules and principles which are set forth in Chapter XIX. of this book. But where damages are measured by a royalty, only the earned portion of the royalty should be assessed; for if the royalty assessed is one which covers the future life of the patent, its recovery would authorize a continuance of the defendant's doings, and thus defeat an injunction, and perhaps oust the jurisdiction of

¹ *Root v. Railway Co.*, 105 U. S. 189, 1881.

² Revised Statutes, Section 4921.

³ *Emigh v. Railroad Co.*, 6 F. R. 283, 1881.

⁴ *Marsh v. Seymour*, 97 U. S. 348, 1877.

⁵ *Star Salt Casier Co. v. Crossman*, 4 Bann. & Ard. 566, 1879; *Child v. Iron Works*, 19 F. R. 259,

1884; *Simpson v. Davis*, 22 F. R. 444, 1884.

⁶ Revised Statutes, Section 4919; *Covert v. Sargent*, 42 F. R. 298, 1890.

⁷ *Bancroft v. Acton*, 7 Blatch. 506, 1870; *Locomotive Safety Truck Co. v. Pennsylvania Railroad Co.*, 2 F. R. 682, 1880.

equity, and so eventuate in a reversal of the decree by an appellate court.¹

§ 574. The complainant in an action in equity for an infringement of a patent, may be the holder of the complete title to that patent in the territory where the infringement occurred. Where the legal title resides in one person and the equitable title in another, both should generally join in such an action.² But the holder of the legal title may be dispensed with as co-complainant, where the circumstances of the case are such that a decree against the equitable owner would clearly be pleadable against the holder of the legal title;³ and the holder of an equitable title may be dispensed with, where his interest is confined to a share of the proceeds of the patent,⁴ or where he has given to the holder of the legal title a written power to bring and prosecute the suit alone.⁵

Where an equitable owner brings an action in equity in the name of the holder of the legal title alone, the defendant may, by means of a motion to the court, compel the equitable owner to become a co-complainant in his own name, if that action is necessary to the protection of the rights of the defendant.⁶ But where a defendant moves to make a stranger to a suit co-complainant therein, on the ground that he has an equitable interest in the matter involved, the motion will be overruled, if the person, so sought to be brought in, files in the case a disclaimer of all interest in the subject of the litigation.⁷

§ 575. The defendant in an action in equity for an infringement of a patent, may generally be any person or private corporation connected with that infringement. Questions relevant to the liability of public corporations to such actions, and relevant to the respective liability of

¹ *Bragg v. City of Stockton*, 27 F. R. 509, 1886.

² *Stimpson v. Rogers*, 4 Blatch. 336, 1859.

³ *Littlefield v. Perry*, 21 Wallace, 222, 1874.

⁴ *Rude v. Westcott*, 130 U. S. 152, 1889.

⁵ *Union Trust Co. v. Walker Electric Co.*, 122 F. R. 815, 1903.

⁶ *Patterson v. Stapler*, 7 F. R. 210, 1881.

⁷ *Graham v. Mfg. Co.*, 11 F. R. 148, 1880.

joint infringers when sued in equity, and indeed relevant to numerous points in the subject of parties, are explained and answered in the chapter on courts, parties and causes: the seventeenth chapter in this book.

§ 576. An original bill in an action in equity, for an infringement of a patent, properly consists of six parts: 1. The title of the court. 2. The introduction. 3. The stating part. 4. The prayer for relief. 5. The interrogating part. 6. The prayer for process. Anciently it was the custom to insert in all original bills in equity, three additional parts: the confederacy part, the charging part, and the jurisdiction part. But these are no longer required in United States courts.¹ The confederacy part, if used when only one person has infringed and is sued, is entirely out of place; and even where the bill is filed against joint infringers, such a part is still entirely useless. The charging part is also unnecessary, because the complainant is entitled to amend his bill, if the answer renders it necessary for him to plead specially to any defence it contains.² And such a part is objectionable, because it notifies the defendant of the complainant's reply to the defendant's defence, and thus enables the latter to concert his answer with more craftiness than he otherwise could. And the jurisdiction part is useless, because, if the facts stated in the bill do not give equity jurisdiction, the fault cannot be cured by alleging that they do; and if those facts do lay a foundation for jurisdiction in equity, they will speak for themselves, and will require no label such as was anciently tacked to them in the form of a jurisdiction part. That part of an ancient bill in equity originated in England, when the chancellors were priests and not lawyers, and when they therefore required to be told that the common law could not give the relief prayed for in the bill. Some pleaders still insert one or all of these three ancient parts in a bill in equity, but neither of them can have any beneficial effect upon the cause, and all of them are better omitted than used.

¹ Rules of Practice for the Courts of Equity of the United States, Rule 21.

² Equity Rule 45.

§ 577. The title of the court, at the beginning of a bill, should be in the same form as at the beginning of a declaration.¹ It is technically unscientific to entitle a bill in the name of the case, because until the bill is filed there is no such case pending. But such a title is convenient, in order to show at a glance who are the parties; and convenience may properly outweigh technical nicety. It is therefore exceptional to see a bill that is not entitled in the name of the case.

§ 578. The form of the introductory part is prescribed by the Supreme Court.² It contains a formal address to the judges of the court in which the bill is to be filed, together with the names and the citizenship of the parties.

§ 579. The stating part of a bill in equity, though differing in form from the statement of the cause of action in a declaration at law, agrees with the latter in substance, except in the following particulars: It must state that the complainant fears and has reason to fear, future infringement by the defendant.³ It need not state past infringement, where it states a specific reason for fearing future infringement.⁴ It may state infringements which were committed before the complainant obtained his title, provided that title, when obtained, covered the right of action for those infringements. Where the bill prays for a preliminary injunction, its stating part must set forth one or more of the grounds for that relief, which are explained in the chapter on injunctions.⁵ Where profits are sought to be recovered, it must plainly aver that profits were realized by the defendant on account of the stated infringement.⁶ It need not aver that any damage was incurred by the complainant; if the action is brought for an injunction only, or for an injunction and an account of the defendant's profits. Where

¹ Section 422 of this book.

² Equity Rule 20.

³ *Edison Phonograph Co. v. Hawthorne & Sheble Mfg. Co.*, 108 F. R. 630, 1901.

⁴ *Canton Steel Roofing Co. v. Kanneberg*, 51 F. R. 599, 1892.

⁵ *Parker v. Brant*, 1 Fisher, 58, 1850; *American Bell Telephone Co. v. Southern Telephone Co.*, 34 F. R. 803, 1888.

⁶ *Wirt v. Hicks*, 46 F. R. 71, 1891.

a former decree is invoked against the defendant, it must be stated in the bill, according to the rule of equity pleading in that behalf.¹ But it must not state any consent decree which has been made against any stranger to the suit.²

Two points wherein the stating part of a bill in equity agrees with the statement of the right of action in a declaration in an action at law, have been particularly attended to in decisions upon bills in equity. Those points relate to the statement of the patent and to the statement of the infringement, respectively. The purport of the patent is properly embodied in a bill of complaint, by making profert therein, of the patent on which the bill is based.³ But the particular claims of the patent which the complainant intends to prosecute in the case, must be specified by their numbers in the stating part of the bill of complaint.⁴

Where a plurality of defendants are sued for infringing a patent, the bill ought to state that the infringement was joint,⁵ though it has also been held that the point may properly be left to implication.⁶

§ 580. The prayer for relief should be both special and general.⁷ The special part should ask for a preliminary injunction, and for a permanent injunction, and for an account of the defendant's profits, and for an assessment of the complainant's damages, and for an increase of those damages, and for costs. The prayer for general relief should be in the ordinary form of prayers of that kind.

§ 581. The form of the interrogating part is prescribed by the Supreme Court.⁸ That part is designed and adapted

¹ *Bradley Mfg. Co. v. Eagle Mfg. Co.*, 57 F. R. 985, 1893.

² *Western Electric Co. v. Williams-Abbott Electric Co.*, 83 F. R. 842, 1897; *Haarmann v. Lueders*, 109 F. R. 327, 1901.

³ *International Terra Cotta Lumber Co. v. Maurer*, 44 F. R. 618, 1890; *Heaton-Peninsular Button-Fastener Co. v. Schlochtmeyer*, 69 F. R. 592, 1895; *Chinnock v. Paterson, P. & S. Tel. Co.*, 110 F. R.

199, 1901; *Fowler v. City of New York*, 121 F. R. 748, 1903.

⁴ *Russell v. Winchester Repeating Arms Co.*, 97 F. R. 634, 1899; *Morton Trust Co. v. American Car & Foundry Co.*, 121 F. R. 132, 1903.

⁵ *Diamond Match Co. v. Ohio Match Co.*, 80 F. R. 118, 1897.

⁶ *Indurated Fibre Co. v. Grace*, 52 F. R. 127, 1892.

⁷ Equity Rule 21.

⁸ Equity Rule 43.

to secure from the defendant such admissions or statements as will obviate the necessity for evidence to support those allegations of the bill which relate to his doings.¹ The character, but not the extent of those doings, may properly be the subject of an interrogating part of a bill in equity in a patent case.²

Where an interrogating part contains more than one interrogatory, the interrogatories must be divided from each other, and consecutively numbered, and a note must be put at the foot of the bill specifying which of those numbered interrogatories each defendant is required to answer.³ Where the complainant in his bill waives the oath which otherwise the defendant is entitled to make to his answer, or if he requires such an oath to be made only to the answer of certain specified interrogatories; the answer of the defendant, though it is in fact under oath, is not evidence in his favor on any point not covered by such specified interrogatories, unless the case is heard on bill and answer only.⁴

§ 582. The prayer for process must contain the names of all the defendants who are mentioned in the introductory part of the bill,⁵ and if any of them are known to be minors, or otherwise under guardianship, that fact must be stated in the prayer for process.⁶

§ 583. The bill must be signed by counsel, and by a solicitor of the court in which it is filed.⁷ But if the attorney of the complainant is not only counsel in Federal courts generally, but also is solicitor in the particular court in which the bill is filed, his signature will suffice in both capacities.

§ 584. An oath of the truth of the bill must be appended

¹ *Coop v. Physical Institute*, 47 F. R. 899, 1891; 48 F. R. 239, 1891.

² *Keller v. Strauss*, 88 F. R. 517, 1898.

³ Equity Rules 41 and 42.

⁴ Equity Rule 41.

⁵ *Goebel v. Supply Co.*, 55 F. R. 827, 1893.

⁶ Equity Rule 23.

⁷ Equity Rule 24.

to such a document, if it prays for an injunction.¹ Such an oath is to be made by the complainant, unless he is in such a situation as to be unable to make it, in which case it may be made by his agent conversant with the facts.² Where the complainant is a corporation, the bill may be verified by any officer of the corporation who knows it to be true; or if no such officer possesses that knowledge, it may be sworn to by any agent or attorney who does.³ Where there is a plurality of complainants, the bill may be sufficiently verified by the oath of one of them, and be signed by him without any other signature, except the countersignature of lawyer who represents all the complainants.⁴

If the bill prays for a preliminary injunction, and if its affiant can swear only on information and belief to the defendant's doings, and to their character as infringements, the application should be fortified by affidavits of persons who know what the defendant has done, and by affidavits of experts who can intelligently testify to the character of those doings, as compared with what appears to be covered by the complainant's patent. Where the complainant can positively swear to part of the allegations of his bill, and can swear to the residue only on information and belief, the bill should state the first class of facts positively, and the second class on information and belief alone; and the oath should clearly discriminate between the two classes in that behalf. It is not sufficient for the oath to state that the material averments of the bill are true;⁵ nor to state that those allegations are true which render an injunction necessary and proper;⁶ because such a form of oath leaves it uncertain which allegations the affiant had in mind. But positive oaths ought to be based on positive knowledge. It is much to be feared

¹ *Rogers v. Abbot*, 4 Washington, 514, 1825.

² *Woodworth v. Edwards*, 3 Woodbury & Minot, 124, 1847.

³ *Bank of Orleans v. Skinner*, 9 Paige (N. Y.) 305, 1841.

⁴ *Cimiotti Unhairing Co. v.*

American Fur Refining Co., 120 F. R. 674, 1903.

⁵ *Sauvinet v. Poupong*, 14 Louisiana, 87, 1839.

⁶ *Hebert v. Joly*, 5 Louisiana, 50, 1832.

that many persons make affidavits to bills and other papers, without much reflection upon the statements they contain, or upon the wrong of falsehood, or upon the pains and penalties of perjury. The better lawyers will guard the conscience of a client at this point, while the inferior ones are sometimes more apt to mislead than to protect it. Affidavits to bills, and indeed all other affidavits to be used in any civil cause, in any circuit or district court of the United States, may be taken before a commissioner of the circuit court for the district;¹ or before any notary public of either of the States or Territories, or of the District of Columbia.²

§ 585. A bill to perpetuate testimony tending to show a particular patent to be void, may be filed and prosecuted in any United States Circuit Court;³ but a bill brought into court to establish non-infringement of a particular patent by the complainant will not be entertained.⁴ Nor will a court of equity restrain an action, brought, or to be brought, in another court, for infringement of a patent.⁵ Neither can a bill be partly based on a patent, and partly on unfair competition before the patent was in existence.⁶ But a bill may properly pray that the defendant be restrained from infringing a patent and also from applying the designating name of the patented article to a spurious imitation thereof, while the patent is in force.⁷

§ 585*a*. Several bills of complaint have been filed, and other proceedings instituted in courts of equity, since 1885, to restrain patentees from publishing statements favorable to their patents, and unfavorable to alleged infringers thereof, or to restrain alleged infringers of patents from

¹ Revised Statutes, Section 945.

² 19 Statutes at Large, Ch. 304, p. 206.

³ Revised Statutes, Section 866; *New York & Baltimore Coffee Polishing Co. v. New York Coffee Polishing Co.*, 9 F. R. 578, 1881; 11 F. R. 813, 1882.

⁴ *Celluloid Mfg. Co. v. Vulcanite Co.*, 13 Blatch. 375, 1876; *Strait v. Harrow Co.*, 51 F. R. 819, 1892.

⁵ *Kelley v. Ypsilanti Dress-Stay Mfg. Co.*, 44 F. R. 19, 1890; *Germain v. Wilgus*, 67 F. R. 601, 1895; *American School Furniture Co. v. Sauder Co.*, 106 F. R. 732, 1901.

⁶ *Ball & Socket Fastener v. Cohn*, 90 F. R. 664, 1898.

⁷ *Adam v. Folger*, 120 F. R. 264, 1903.

publishing statements unfavorable to those patents, and favorable to such alleged infringers. In each of those cases, the court was practically asked to abridge the freedom of speech and of the press. The first two applications of the kind were made to Judge COXE early in 1886; but both of them were denied by him.¹ The next application was denied by Justice BRADLEY and Judge MCKENNAN, in October of the same year.² The fourth application met the same fate at the hands of Judges COLT and CARPENTER in the following November.³ Two more such applications were denied in December, 1890, by Judges WOODS and JENKINS respectively.⁴ On the contrary, one such application was granted by Judge BLODGETT in 1888;⁵ and one other was ordered to be granted in 1903, by Judges WALLACE and LACOMBE.⁶

A distinction exists between the six cases in which the applications were denied, and the two cases in which they were granted. That distinction consists in the fact that in the two cases, the judges were convinced that the statements sought to be restrained, were not believed to be true by those who had made them. But Justice BRADLEY explained, in the case decided by him and Judge MCKENNAN, that a court of equity has no jurisdiction to prevent persons from printing and publishing, and that the jurisdiction of the court is not affected by the opinion the judge may entertain on the question whether the printing and publishing sought to be restrained, was done in sincerity or was done in malice. For some reason, this explanation of Justice BRADLEY, was not met by any statement or argument in the decision of Judge BLODGETT, or in that of Judges WALLACE and LACOMBE.

This question of the jurisdiction of a court of equity to

¹ Chase *v.* Tuttle, 27 F. R. 110, 1886; Tuttle *v.* Matthews, 28 F. R. 98, 1886.

² Kidd *v.* Horry, 28 F. R. 773, 1886.

³ Baltimore Car-Wheel Co. *v.* Bemis, 29 F. R. 95, 1886.

⁴ Fougères *v.* Murbarger, 44 F. R.

292, 1890; International Tooth-Crown Co. *v.* Carmichael, 44 F. R. 350, 1890.

⁵ Emack *v.* Kane, 34 F. R. 46, 1888.

⁶ Adriance, Platt & Co. *v.* National Harrow Co., 121 F. R. 827, 1903.

abridge the freedom of speech and of the press, was decided in the negative by the Supreme Court of the United States,¹ on a day about midway between the two decisions of Judge COXE in the same direction. That Supreme Court decision was not attended to in any of the published opinions which support the affirmative conclusion; but it was cited by Judge WOODS in his negative decision, and was held by Judge JENKINS to settle the question in the negative.²

§ 586. Amendments to bills may be made as a matter of course, and without costs, at any time before a copy has been taken out of the clerk's office; and may be made as of course with costs, after a copy has been taken out, and before any plea, answer, or demurrer has been filed.³ After an answer or plea, or demurrer is put in, and before replication, the complainant may, upon motion without notice, obtain an order from an judge of the court to amend his bill on or before the next succeeding rule day, upon payment of costs, or without payment of costs, as the judge may in his discretion direct.⁴ After a replication is filed, and before the hearing of the case, the bill cannot be amended except upon a special order of a judge of the court, upon motion or petition, after due notice to the other party, and upon proof by affidavit that the application is not made for the purpose of vexation or delay, and that the matter of the proposed amendment is material, and could not with reasonable diligence have sooner been introduced into the bill, and upon the plaintiff submitting to such other terms as may be imposed by the judge for speeding the cause.⁵ Amendments applied for at or after the hearing of a case, are not regulated by the Equity Rules, but are allowed or refused, according to the sound discretion of the court.⁶ But that discretion is governed by precedents, and those precedents indicate that amendments, at or after

¹ Francis v. Flinn, 118 U. S. 385, 1886.

² Fongeres v. Murbarger, 44 F. R. 292, 1890; International Tooth-Crown Co. v. Carmichael, 44 F. R. 350, 1890.

³ Equity Rule 28.

⁴ Equity Rule 29.

⁵ Equity Rule 20.

⁶ Neale v. Neals, 9 Wallace, 9, 1869.

the hearing, will be allowed only where the bill is found to be defective in proper parties, or in its prayer for relief, or in the omission or misstatement of some fact or circumstance connected with the substance of the case, but not forming the substance itself, or where it is necessary for the complainant to take issue with new matter in the answer.¹ Where a litigation has been conducted precisely as it would have been if the proper amendment had been made before any plea, answer, or demurrer was filed; the court will allow that amendment to be filed even after the hearing, and thus make the pleadings conform to what the course of the litigation assumed them to be.²

§ 587. A bill needs amendment when the defendant's demurrer, plea, or answer points out a material fault therein, or when the complainant otherwise discovers a material error or omission which may be cured, or when the defendant's plea or answer contains statements to which it is necessary to plead by way of confession and avoidance.³ No reply by way of confession and avoidance can be made in a replication in equity.⁴ Where the plea or answer sets up new matter, to which the complainant wishes to reply by way of traverse, the general replication is the proper pleading to file for that purpose.⁵

§ 588. Defences may be made to a bill in equity for infringement of a patent, by a demurrer, or by a plea, or by an answer; or by a demurrer to part, and a plea to another part, and an answer to the residue;⁶ or by a demurrer to part, and a plea to the residue; or by a demurrer to a part, and an answer to the residue; or by a plea to a part, and an answer to the residue.⁷

¹ *Shields v. Barrow*, 17 Howard, 144, 1854; *Dancel v. United Shoe Mach. Co.*, 120 F. R. 839, 1903.

² *The Tremolo Patent*, 23 Wallace, 527, 1874; *Vattier v. Hinde*, 7 Peters, 273, 1833; *Duponti v. Mus-sy*, 4 Washington, 128, 1821; *New York Sugar Co. v. Sugar Co.*, 20 F. R. 505, 1884; *New Departure*

Bell Co. v. Bevin Mfg. Co., 64 F. R. 866, 1894.

³ *Wilson v. Stolley*, 4 McLean, 275, 1847.

⁴ Equity Rule 45.

⁵ Equity Rule 66.

⁶ Equity Rule 32.

⁷ *Story's Equity Pleading*, Section 437.

The nature and operation of demurrers and answers in equity practice, are so well understood by the profession, that nothing need be said about them in this book, further than to show the applicability of each of those forms of pleading to the various defences which belong to patent litigation. But defences by plea may bear a longer review, because they have largely gone out of use in the Federal courts and their principles been partly forgotten by the members of the bar, since the Equity Rules authorized nearly every defence to be made in an answer, that formerly required a plea for its interposition.¹ But those rules do not authorize any defendant to make a particular defence in a plea, and if unsuccessful there, to make it over again in an answer.² Such a plan, if allowed, would enable a defendant whose plea is overruled as stating no defence at law, to argue that question again on the final hearing; and it would enable a defendant, whose plea is proved to be false in fact, to contest that issue again on new testimony taken in pursuance of an answer. Though pleas in bar are not necessary in equity cases in the Federal courts, except under rare circumstances, they may sometimes be made useful in saving time, labor, costs, and expense. It is, on these accounts, expedient to remind the reader of the general nature and operation of those pleadings, before explaining their special application to actions in equity for infringements of patents.

§ 589. A plea in equity is a sworn³ pleading, which alleges that some one fact, not stated in the bill, is true; or that some one statement of fact in the bill, is not true; or that some one fact, which the bill states is not a fact, is a fact nevertheless. A plea of the first kind sets up new matter by way of confession and avoidance, and is properly named an affirmative plea.⁴ This is the only sort of plea in equity which was recognized in the time of Chancellor BACON.⁵ A plea of the second kind traverses some one state-

¹ Equity Rule 39.

² *Hubbell v. De Land*, 14 F. R. 475, 1882.

³ Equity Rule 31.

⁴ Daniell's Chancery Practice, Vol. 1, Chap. XV, Section 1.

⁵ Beame's General Orders of the High Court of Chancery, 26.

ment of fact in the bill, and is therefore properly called a negative plea.¹ This sort of plea was established by Chancellor THURLOW, and thereafter became a fully recognized part of equity pleading in England and in the United States.² A plea of the third kind states some fact to be true which the bill seeks to impeach.³ It is similar to an affirmative plea in respect that it sets up matter outside of that upon which the bill is based; and it is similar to a negative plea, in that it contradicts some one statement of fact in the bill. It may therefore be properly named a composite plea. Where the single point of fact stated or denied in a plea, depends for its truth or error upon the comparative construction of two documents, the plea is bad and must be overruled; because such a question of construction is a question of law.⁴

§ 590. After a defendant files a plea to a bill in equity, the complainant should satisfy himself whether it states a good defence to the bill, or to that part of the bill to which it refers, and should ascertain whether it is true in point of fact. If he is sure that he can prove it to be false, he should take issue upon it,⁵ by filing a replication.⁶ If he has any ground for fear that the plea is true in fact, and any ground for hope that it is bad in law, his true course is to set the plea down for argument;⁷ which setting down is equivalent to a demurrer to the plea.⁸ If, on the argument, the plea is held to state no fact which constitutes a defence to the bill, or to any part thereof, it will be overruled, and the defendant will be permitted to file an answer setting up whatever other defences he can.⁹ But if the plea is held on the

¹ Daniell's Chancery Practice, Vol. 1, Ch. XV, Section 1.

² Story's Equity Pleading, Section 668.

³ Daniell's Chancery Practice, Vol. 1, Ch. XV, Section 1.

⁴ Lowery v. Aluminum Co., 56 F. R. 495, 1893.

⁵ Equity Rule 33.

⁶ Daniell's Chancery Practice, Vol. 1, Ch. XV, Section V.

⁷ Equity Rule 33.

⁸ Davison's Ex'rs v. Johnson, 16 New Jersey Equity, 113, 1863; Korn v. Wiebusch, 33 F. R. 51, 1887; Burrell v. Hackley, 35 F. R. 834, 1888; Cook v. Sterling Electric Co., 118 F. R. 47, 1902.

⁹ Equity Rule 34; Societe Anonyme v. General Electric Co., 97 F. R. 606, 1899.

argument to state a good defence to the bill, or to that part of the bill to which it applies, it will be allowed, and thereupon the complainant may ask leave to amend his bill;¹ or if he cannot truly amend it so as to make it avoid the plea, he must file a replication.² Thereupon, if the plea is proved to be true, the fact thus established will avail the defendant, as far as, in law and equity, it ought to avail him;³ and if the plea is proved to be false, the defendant must file an answer to the bill.⁴ Only one defence can be made to a bill in a plea, unless the court, in order to avoid a special inconvenience, gives a special permission to a defendant to make a plurality of defences in that method of pleading.⁵ With that exception, after any plea has been overruled, the defendant, if he has other defences to interpose, must interpose them in an answer.⁶ This outline of the principles of pleas in equity should be kept in mind by the reader while perusing sundry of the sections which follow.

§ 591. The twenty-seven defences which may be made to actions at law for infringements of patents,⁷ may all be made to actions in equity based on such causes; and the latter actions are also liable to two other defences, to which actions at law are not subject. These are non-jurisdiction of equity, and laches. It is convenient first to explain the facts which may support each of these two defences, and then state the various methods in which each may be interposed, and afterward to review the twenty-seven defences in their order.

¹ Edison Electric Light Co. v. Equitable Life Co., 55 F. R. 481, 1893.

² Story's Equity Pleading, Section 697; Daniell's Chancery Practice, Vol. 1, Ch. XV, Section V.

³ Pearce v. Rice, 142 U. S. 42, 1891; Horn v. Detroit Co., 150 U. S. 610, 1893; Green v. Bogue, 158 U. S. 500, 1895; Elgin Wind Power Co. v. Nichols, 65 F. R. 218, 1894; American Graphophone Co. v. Edison Phonograph Works, 72 O. G. 1350, 1895.

⁴ Dalzell v. Dueber Mfg. Co., 149 U. S. 326, 1893; Westervelt v. Library Bureau, 118 F. R. 824, 1902.

⁵ Story's Equity Pleading, Section 657; Wheeler v. McCormick, 8 Blatch. 267, 1871; Noyes v. Willard, 1 Woods, 187, 1871; Giant Powder Co. v. Nitro Powder Co., 19 F. R. 510, 1884.

⁶ Equity Rule 34.

⁷ Section 440 of this book.

and to explain wherein any of them differ in their operation in equity, from their operation at law, and to state what forms of pleading are suitable to each, under the varying circumstances of patent litigation.

§ 592. Non-jurisdiction in equity is a defence which will succeed in any infringement case, unless an injunction is granted, or at least rightfully prayed for in that case, or unless some impediment prevents a resort to remedies purely legal, or unless the circumstances of the case render the remedy obtainable by an action at law, difficult, inadequate, or incomplete.¹ Equity jurisdiction is therefore absent where the patent expired before the bill is filed,² or where the complainant has no ownership in the patent at that time.³

But where a bill is filed before the expiration of the patent upon which it is based, and where it truly states a proper case for an injunction, and contains a proper prayer for that relief, equity has jurisdiction, and should retain it to the end of the suit; even if, on account of the expiration of the patent before a hearing is had,⁴ or on account of the sale of the patent by the complainant before a hearing is obtained,⁵ or on account of public policy,⁶ or on account of the complainant's delay to move,⁷ no injunction is ever granted in the case.

¹ *Root v. Railway Co.*, 105 U. S. 189, 1881.

² *Root v. Railroad Co.*, 105 U. S. 189, 1881; *Farrel v. United Verde Copper Co.*, 121 F. R. 551, 1903.

³ *Waterman v. Mackenzie*, 138 U. S. 257, 1891.

⁴ *Clark v. Wooster*, 119 U. S. 325, 1886; *Beedle v. Bennett*, 122 U. S. 75, 1886; *Gottfried v. Brewing Co.*, 13 F. R. 479, 1882; *Gottfried v. Moerlein*, 14 F. R. 170, 1882; *Forehand v. Porter*, 15 F. R. 256, 1883; *Reay v. Raynor*, 19 F. R. 309, 1884; *Adams v. Howard*, 19 F. R. 317, 1884; *Dick v. Struthers*, 25 F. R. 103, 1885; *Adams v. Iron Co.*, 26 F. R. 324, 1886; *Kirk v. DuBois*, 28 F. R. 460, 1886; *Brooks v. Mil-*

ler, 28 F. R. 615, 1886; *Kittle v. De Graff*, 30 F. R. 689, 1887; *Kittle v. Rogers*, 33 F. R. 49, 1887; *Hohorst v. Howard*, 37 F. R. 97, 1888; *Singer Mfg. Co. v. Wilson Mach. Co.*, 38 F. R. 587, 1889; *Ross v. City of Ft. Wayne*, 63 F. R. 466, 1894; *Bradner Hanger Co. v. Waterbury Button Co.*, 106 F. R. 735, 1901; *United States Mitis Co. v. Detroit Steel & Spring Co.*, 122 F. R. 865, 1903.

⁵ *New York Belting Co. v. New Jersey Car-Spring Co.*, 47 F. R. 505, 1891; 48 F. R. 559, 1891.

⁶ *Bragg Mfg. Co. v. Hartford*, 56 F. R. 293, 1893.

⁷ *Waite v. Chair Co.*, 45 F. R. 259, 1891.

But where a bill untruly states a proper case for an injunction, and contains a prayer for that relief, the jurisdiction of equity will lapse and the bill be dismissed, whenever it is shown to have been untrue in respect of those of its statements upon which the prayer for an injunction is based.¹ And where a bill states no proper case for an injunction, but contains a prayer for such a writ, the jurisdiction of equity will not attach at all, and the bill be dismissed whenever its character is brought to the attention of the court.² And where a bill is filed so shortly before the expiration of the patent upon which it is based, that no motion for an injunction can be regularly notified to the defendant and heard by the court till after that expiration, the bill will be dismissed whenever the court learns that no injunction can be lawfully granted.³ And where a bill states no ground for a preliminary injunction, and is filed so shortly before the expiration of the patent that no permanent injunction can possibly be obtained in the case, the bill will be dismissed in pursuance of a proper plea or a proper demurrer.⁴ And if no injunction is granted, and if the Circuit Court does dismiss the bill for want of equity, in the absence of a right to an injunction at the time of the hearing, such dismissal will not be reversed on an appeal.⁵

§ 593. The case of *Root v. Railway Co.* does not precisely state what exceptional facts will give equity jurisdiction, independent of any injunction or prayer for injunction. What the court said on that subject, was said in the following language: "Grounds of equitable relief may arise, other

¹ *Dowell v. Mitchell*, 105 U. S. 430, 1881.

² *Campbell v. Ward*, 12 F. R. 150, 1882; *Creamer v. Bowers*, 30 F. R. 185, 1887.

³ *Clark v. Wooster*, 119 U. S. 324, 1886; *Burdell v. Comstock*, 15 F. R. 395, 1883; *Davis v. Smith*, 19 F. R. 823, 1884; *Mershon v. Furnace Co.*, 24 F. R. 741, 1885; *American Cable Ry. Co. v. Chicago City Ry. Co.*,

41 F. R. 522, 1890; *Bragg Mfg. Co. v. Hartford*, 56 F. R. 293, 1893; *Overweight Elevator Co. v. Standard Elevator Co.*, 96 F. R. 231, 1899.

⁴ *McDonald v. Miller*, 84 F. R. 344, 1898; *Heap v. Borchers*, 108 F. R. 237, 1901.

⁵ *Keyes v. Mining Co.*, 158 U. S. 152, 1895; *Russell v. Kern*, 69 F. R. 94, 1895.

than by way of injunction, as where the title of the complainant is equitable merely, or equitable interposition is necessary on account of the impediments which prevent a resort to remedies purely legal; and such an equity may arise out of, and inhere in, the nature of the account itself, springing from special and peculiar circumstances which disable the patentee from a recovery at law altogether, or render his remedy in a legal tribunal difficult, inadequate, and incomplete; and as such cases cannot be defined more exactly, each must rest upon its own peculiar circumstances, as furnishing a clear and satisfactory ground of exception from the general rule." But in a later case, that court explained that grounds of equitable relief do not arise "where the title of the complainant is equitable merely," unless that fact constitutes an impediment to a resort to remedies purely legal, or constitutes a circumstance which renders the remedy obtainable by an action at law difficult, inadequate, or incomplete.¹ And Judge COLT has decided that such an equity does not "arise out of, and inhere in, the nature of the account itself" merely because the account is intricate.²

§ 594. Want of jurisdiction in equity may be set up by a defendant in a demurrer or in an answer. But it cannot be interposed without any pleading to sustain it;³ except where the bill shows that it was filed after the patent expired. In that case, non-jurisdiction may be invoked by a motion at any stage of the case in the circuit court.⁴ There is an advantage in making this defence by demurrer instead of by answer, or by motion after an answer; for in the first case the bill may be dismissed with costs, while in either of the others no costs can be recovered, even if the defence is successful.⁵

§ 595. Prior adjudication in an action at law is not neces-

¹ *Hayward v. Andrews*, 106 U. S. 672, 1882.

² *Lord v. Machine Co.*, 24 F. R. 803, 1885; *Adams v. Iron Co.*, 26 F. R. 325, 1886.

³ *Reynes v. Dumont*, 130 U. S. 395, 1889; *Tyler v. Savage*, 143

U. S. 96, 1892; *Dederick v. Fox*, 56 F. R. 717, 1893.

⁴ *Spring v. Sewing Machine Co.*, 13 F. R. 446, 1882.

⁵ *Dawes v. Taylor*, 14 Reporter, 180, 1882.

sary to give jurisdiction to equity in cases of infringements of patents, nor is such an adjudication necessary to call equity into activity in that behalf.¹ A circuit court may, in its discretion, order a trial at law in such a case,² or order a trial by jury at its own bar,³ in order to inform the conscience of the chancellor; but no such trial can be demanded by either or both of the parties as an absolute right, for courts of equity are not only really, but also technically, competent to decide questions of facts.⁴

§ 596. Laches is a defence which is peculiar to courts of equity. "The cases are many in which this defence has been invoked and considered. It is true, that by reason of their differences of fact, no one case becomes an exact precedent for another, yet a uniform principle pervades them all. They proceed on the assumption that the party to whom laches is imputed, has knowledge of his rights, and an ample opportunity to establish them in the proper forum; that by reason of his delay, the adverse party has good reason to believe that the alleged rights are worthless, or have been abandoned; and that because of the change in condition or relations during this period of delay, it would be an injustice to the latter to permit the former to now assert them."⁵ "The length of time during which the party neglects the assertion of his rights, which must pass in order to show laches, varies with the peculiar circumstances of each case, and is not, like the matter of limitations, subject to an arbitrary rule. It is an equitable defence, controlled by equitable considerations, and the lapse of time must be so great, and the relations of the defendant to the rights such, that it would be inequitable to permit the plaintiff to assert them now."⁶ In pursuance of these principles, courts of equity sometimes dismiss bills for infringements of patents, because they were not filed with

¹ McCoy v. Nelson, 121 U. S. 487, 1887; Wyckoff v. Wagner Type-writer Co., 88 F. R. 516, 1898.

² Wise v. Railway Co., 33 F. R. 277, 1888.

³ 18 Statutes at Large, Part 3, Ch. 77, Section 2, p. 316.

⁴ Cochrane v. Deener, 94 U. S. 780, 1876.

⁵ Galliher v. Cadwell, 145 U. S. 372, 1892.

⁶ Halstead v. Grinnan, 152 U. S. 416, 1894.

diligence,¹ or not prosecuted with diligence after they were filed;² and whether the complainant or his assignor is the party who is chargeable with laches.³ But delay to sue is not always laches, because it may have been harmless to the defendant;⁴ or it may have resulted from the fact that the complainant did not know of the infringement till long after it began;⁵ or from the fact that he was litigating a test case under his patent against another infringer during the time of the delay;⁶ or it may have occurred after the infringer was warned to infringe no more, and while the patentee was preparing for action.⁷ The second of these circumstances excuses delay, because vigilance does not imply omniscience; and the third excuses delay, because abstinence from vexatious litigation is worthy to be praised rather than punished by a court of equity; and the fourth excuses delay because it is neglect, and not patience, that constitutes laches.

§ 597. The defence of laches can be made in a demurrer.⁸

¹ *Lane & Bodley Co. v. Locke*, 150 U. S. 200, 1893; *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 24 F. R. 604, 1885; *Edison Electric Light Co. v. Equitable Life Co.*, 55 F. R. 479, 1893; *Fosdick v. Lowell Machine Shop*, 58 F. R. 817, 1893; *Starrett v. Arms & Tool Co.*, 96 F. R. 244, 1899; *Covert v. Travers Bros. Co.*, 96 F. R. 568, 1899; *Meyrowitz Mfg. Co. v. Eccleston*, 98 F. R. 438, 1899; *Westinghouse Air-Brake Co. v. New York Air-Brake Co.*, 111 F. R. 741, 1901.

² *Johnston v. Mining Co.*, 148 U. S. 370, 1892.

³ *Kittle v. Hall*, 29 F. R. 511, 1887; *Woodmanse & Hewitt Co. v. Williams*, 68 F. R. 492, 1895; *Richardson v. Osborne & Co.*, 82 F. R. 96, 1897; and 93 F. R. 828, 1899.

⁴ *American Street-Car Advertis-*

ing Co. v. Jones, 122 F. R. 810, 1903.

⁵ *Imperial Chemical Mfg. Co. v. Stein*, 77 F. R. 612, 1896.

⁶ *Van Hook v. Pendleton*, 1 Blatch. 193, 1846; *Green v. French*, 4 Bann. & Ard. 171, 1879; *Green v. Barney*, 19 F. R. 421, 1884; *American Bell Telephone Co. v. Southern Telephone Co.*, 34 F. R. 802, 1888; *Edison Electric Light Co. v. Mt. Morris Electric Light Co.*, 57 F. R. 644, 1893; *Norton v. Automatic Can Co.*, 57 F. R. 932, 1893; *Taylor v. Sawyer Spindle Co.*, 75 F. R. 304, 1896; *Timolat v. Franklin Boiler Works Co.*, 122 F. R. 69, 1903; *United States Mitis Co. v. Detroit Steel & Spring Co.*, 122 F. R. 866, 1903.

⁷ *Seibert Oil Cup Co. v. Lubricator Co.*, 34 F. R. 34, 1888.

⁸ *Maxwell v. Kennedy*, 8 Howard, 222, 1850.

or in a plea,¹ or in an answer, or in an argument on the hearing without any pleading to support it.²

To guard against a demurrer based on laches, in a case where long delay intervened between the infringement and the filing of the bill, the bill ought to state the existing excuses for that delay;³ and to guard against such a defence being started on the hearing, the evidence ought to show whatever excuse the complainant can interpose.

§ 598. The first of the twenty-seven defences which are known both to actions at law and actions in equity for infringements of patents, can be made in a demurrer, where the letters patent appear on their face to have been granted for something other than a process, machine, manufacture, composition of matter, or design.⁴ And indeed any defence, which can be based upon the face of the patent, can be made by demurrer.⁵ But a plea is never applicable to the first defence, because its validity depends upon the construction of the letters patent, and not upon any matter of fact to which an oath would be pertinent; though an answer is always applicable thereto, and may join it with other defences to a patent.

§ 599. The second defence may be made on the hearing, without any pleading or evidence, in all cases where the court will take judicial notice of the fact which shows want of invention;⁶ and a demurrer will also be sustained in the same circumstances.⁷ But a court will not take judicial no-

¹ *Edison Electric Light Co. v. Equitable Life Co.*, 55 F. R. 479, 1893.

² *Sullivan v. Railroad Co.*, 94 U. S. 811, 1876; *Woodmanse & Hewitt Mfg. Co. v. Williams*, 68 F. R. 494, 1895; *Westinghouse Air-Brake Co. v. New York Air-Brake Co.*, 111 F. R. 741, 1901.

³ *Edison Electric Light Co. v. Equitable Life Co.*, 55 F. R. 481, 1893.

⁴ *Risdon Locomotive Works v. Medart*, 158 U. S. 84, 1895.

⁵ *Richards v. Chase Elevator Co.*, 158 U. S. 301, 1895.

⁶ *Brown v. Piper*, 91 U. S. 41, 1875; *Terhune v. Phillips*, 99 U. S. 592, 1878; *Slawson v. Railroad Co.*, 107 U. S. 649, 1882; *Ligowski Clay-Pigeon Co. v. Clay-Bird Co.*, 34 F. R. 332, 1888; *Hunt Bros. Fruit Packing Co. v. Cassidy*, 53 F. R. 260, 1892; *Schreiber v. Grim*, 65 F. R. 221, 1895; *Cary Mfg. Co. v. De Haven*, 88 F. R. 700, 1898.

⁷ *Risdon Locomotive Works v. Medart*, 158 U. S. 84, 1895; *Dick*

tice of a fact, merely because it is stated in a prior patent;¹ nor of any fact which is not generally known,² even though known to the judge;³ nor of any fact, the reality or the significance of which is subject to doubt.⁴ And a demurrer for want of invention will be overruled except in a clear case.⁵ Where the state of the prior art must be proved by evidence, in order to show that the advance covered by the patent did not amount to invention; it is necessary to set up the defence of want of invention in an answer.⁶ But the answer need not state the particular part of the prior art, upon which the defence of want of invention is based.⁷

A demurrer will not be sustained, in such a case, on the basis of what the patent may set forth as the state of the prior art; unless the patentee is some way estopped from show-

v. Supply Co., 25 F. R. 105, 1885; *New York Belting Co. v. Rubber Co.*, 30 F. R. 785, 1887; *West v. Rae*, 33 F. R. 45, 1887; *Root v. Sontag*, 47 F. R. 309, 1891; *United States Credit System Co. v. Indemnity Co.*, 51 F. R. 751, 1892; *United States Credit System Co. v. Credit Co.*, 53 F. R. 818, 1893; *Wall v. Leck*, 61 F. R. 291, 1894; *Covert v. Travers Bros. Co.*, 70 F. R. 788, 1895; *Lamson Consolidated Service Co. v. Siegel-Cooper Co.*, 106 F. R. 734, 1901.

¹ *Bottle Seal Co. v. De La Vergne Co.*, 47 F. R. 61, 1891; *Parsons v. Seelye*, 100 F. R. 454, 1900.

² *Eclipse Mfg. Co. v. Adkins*, 36 F. R. 554, 1888; *Lyons v. Drucker*, 106 F. R. 416, 1901.

³ *New York Belting Co. v. New Jersey Rubber Co.*, 137 U. S. 449, 1890.

⁴ *Blessing v. Copper Works*, 34 F. R. 753, 1888; *Lalance & Grosjean Mfg. Co. v. Mosheim*, 48 F. R. 452, 1891; *Hanlon v. Primrose*, 56 F. R. 600, 1893; *Davock v. Chicago*

& *Northwestern R. R. Co.*, 69 F. R. 468, 1895; *American Fibre-Chamois Co. v. Buckskin-Fibre Co.*, 72 F. R. 512, 1896.

⁵ *Standard Oil Co. v. Southern Pacific Co.*, 42 F. R. 295, 1890; *Krick v. Jansen*, 52 F. R. 823, 1892; *Drainage Construction Co. v. Engelwood Sewer Co.*, 67 F. R. 141, 1894; *Beer v. Walbridge*, 100 F. R. 465, 1900; *Electric Vehicle Co. v. Winton Motor-Carriage Co.*, 104 F. R. 814, 1900; *Neidich v. Fosbenner*, 108 F. R. 266, 1901; *Chinnock v. Paterson P. & S. Tel. Co.*, 112 F. R. 531, 1902; *Drake Castle Pressed Steel Lug Co. v. Brownell*, 123 F. R. 90, 1903; *Merrimack Mattress Mfg. Co. v. Schlesinger*, 124 F. R. 237, 1903.

⁶ *Bottle Seal Co. v. De La Vergne Co.*, 47 F. R. 61, 1891; *Brickill v. Hartford*, 57 F. R. 217, 1893; *Drainage Construction Co. v. Englewood Sewer Co.*, 67 F. R. 141, 1894.

⁷ *Dunbar v. Myers*, 94 U. S. 198, 1876.

ing the patent to be otherwise than accurate in its statements on that subject.¹ A plea is not applicable to such a case, because defendants can seldom swear to the state of the art, and even where they can, they cannot plead resulting want of invention, because that depends upon the construction of the patent, which is to be made by the court in the light of the state of the art. When interposing this defence in an answer, it is not necessary to state what facts are intended to be proved in its support; because those facts refer only to the state of the art, and not to novelty.² The function of an answer, in respect of this defence, is to notify the complainant that the evidence of the state of the art, which is to be taken by the defendant, will be invoked at the hearing to show want of invention, and not merely to narrow the patent and thus show non-infringement.

§ 600. The third defence cannot be set up in a plea, because the statute expressly provides that it shall be set up in an answer.³ Nor can it be based on such a notice as will effect the purpose in an action at law.⁴ It requires an answer for its embodiment;⁵ and that answer must state the same things which a statutory notice of want of novelty in an action at law is required to contain.⁶

It has been held on the circuit, that evidence of want of novelty, taken without being properly pleaded in the answer, is not made admissible by being set up in a subsequent amendment of that pleading.⁷ In another case it was held to rest in the discretion of the court to admit the evidence so taken, and subsequently pleaded, or to reject that evidence, but permit the defendant to take it anew under the

¹ *Indurated Fibre Co. v. Grace*, 52 F. R. 128, 1892.

² *Vance v. Campbell*, 1 Black, 430, 1861; *Hunt Bros. Fruit Packing Co. v. Cassidy*, 53 F. R. 260, 1892; *Dayton Crupper Co. v. Ruhl*, 55 F. R. 651, 1893.

³ *Carnrick v. McKesson*, 8 F. R. 807, 1881; *Arrott v. Standard Sanitary Mfg. Co.*, 113 F. R. 389, 1902.

⁴ *Doughty v. West*, 2 Fisher, 555, 1865.

⁵ *Seymour v. Osborne*, 11 Wallace, 516, 1870; *Rocmer v. Simon*, 95 U. S. 214, 1877.

⁶ *Agawam Co. v. Jordan*, 7 Wallace, 583, 1868; *Bates v. Coe*, 98 U. S. 31, 1878; *Planing-Machine Co. v. Keith*, 101 U. S. 493, 1879.

⁷ *Roberts v. Buck*, 1 Hoimes, 224, 1873.

amended answer.¹ These holdings are hardly consistent with each other, and neither of them seems consistent with an earlier Supreme Court decision on a similar point.² In that case it was held that evidence of want of novelty is admissible in an action at law, where it was taken without being properly set up in any notice, but where a proper notice was subsequently given, and given thirty days before the trial.

Where the answer states that the patent sued on is void for want of novelty, evidence to support that statement will be admitted at the hearing, though not specified in the answer, unless the complainant objects to that evidence for want of the statutory notice.³

§ 601. The fourth defence cannot rightly be made in a plea, for though a defendant may make an oath that he believes the patented thing to be without utility, he can hardly swear that it is certainly so. Others might succeed in using it where he had failed. An answer is therefore the only proper pleading for this defence, and without being set up in the answer, it cannot be made at the hearing.⁴

§ 602. The fifth and sixth defences both require to be interposed in an answer, because they both rest on evidence of abandonment outside of the bill, and therefore cannot be interposed by a demurrer,⁵ and because, being two of the five defences provided for by Section 4920 of the Revised Statutes, neither of them can be set up in a plea.⁶ And an answer must show what fact or facts constitute the abandonment which is invoked therein.⁷

§ 603. The seventh defence cannot be interposed in a

¹ *Allis v. Buckstaff*, 13 F. R. 879, 1882.

² *Teese v. Huntingdon*, 23 Howard, 2, 1859.

³ *Roemer v. Simon*, 95 U. S. 220, 1877; *Brown v. Hall*, 6 Blatch. 405, 1869; *Barker v. Stowe*, 15 Blatch. 49, 1878.

⁴ *Rubber Co. v. Goodyear*, 9 Wallace, 793, 1869; *Ames & Frost*

Co. v. Woven Wire Mach. Co., 59 F. R. 705, 1893.

⁵ *United States Electric Lighting Co. v. Consolidated Electric Light Co.*, 33 F. R. 869, 1888.

⁶ *Carrick v. McKesson*, 8 F. R. 807, 1881.

⁷ *Western Electric Co. v. Sperry Electric Co.*, 58 F. R. 192, 1893; *Warren Featherbone Co. v. Warner Bros. Co.*, 92 F. R. 991, 1899.

plea because it involves the construction of the claims of the letters patent in suit. Letters patent are not void merely because they describe something not shown in the original application therefor. It is only when they claim something not indicated or described in the specification or drawings of the original application, that they are obnoxious to the seventh defence. The question what letters patent claim, is a question of law for the court, and is therefore not one which can be raised by a plea in an action in equity. Nor can this defence be raised by a demurrer, because, in order to decide upon its validity, the court must not only construe the claims of the patent, but must also compare the claims so construed with the original application, and that application must be introduced for the purpose, as a matter of evidence. This defence must therefore be set up in the answer, except where the complainant takes the initiative upon the subject. In that case the complainant must maintain the validity of his patent against this defence, even where it is not specifically interposed in the answer.¹

§ 604. The eighth defence cannot be set up in a plea, but must be interposed in an answer, because it is one of the five for which the statute prescribes that form of pleading in equity cases.²

§ 605. Either the ninth or the tenth defence may be interposed in a plea, where the defendant knows the fact of joint or of sole invention upon which they respectively stand. Each of these defences rests upon a single matter of fact, which, if decided against the complainant, is fatal to his patent. But it is always unwise to make either of these defences in a plea, because the complainant will have no alternative but to file a replication, and because, by doing so, he may foreclose other defences, and because there is always a possibility that the court will, on the evidence, decide that the invention was joint, or was several, accord-

¹ Michigan Central Railroad Co. v. Car Heating Co., 67 F. R. 121, 1895.

² Revised Statutes, Section 4920; Carrick v. McKesson, 8 F. R. 807, 1881; Feaubert v. Appleton, 47 F. R. 893, 1891.

ing as it may be necessary to do in order to sustain the patent.¹ An answer is therefore the best pleading in which to embody either of these two defences.

§ 606. The eleventh defence stands in the same category, in respect of equity pleading, with the third, fifth, sixth, and eighth, and must, like them, be made in an answer, and not in a plea; and the answer must state the details of the facts upon which the eleventh defence is based.²

§ 607. The twelfth defence cannot be made in a demurrer;³ and it cannot be made in a plea because, though the defendant might be able to make oath that he is a person skilled in the art to which the invention covered by the patent appertains, and that the description contained in that patent is not full, clear, concise, and exact enough to enable him to make and use the same, he could not make oath that the same thing is true of other persons skilled in that art. An answer is, therefore, the proper pleading for this defence also.

§ 608. Nor can the thirteenth defence be set up in a plea, because it depends on the construction of the claims of the letters patent, and not upon any matter of fact to be sworn to in a plea or proved in a deposition. But this defence can be made by a demurrer, where profert has been made of the letters patent, or they have otherwise been made a part of the bill.⁴ An answer is also a proper pleading in which to interpose this defence.

§ 609. The fourteenth defence also, generally requires to be set up in an answer.⁵ A plea is not ordinarily suitable for the purpose, because this defence depends primarily upon the necessity for a disclaimer, and because that necessity depends upon the claim being obnoxious to one or more of the first three defences, and because the third defence

¹ *Pitts v. Hall*, 2 Blatch. 229, 1851; *Blandy v. Griffith*, 3 Fisher, 616, 1869.

² *American Sulphite Pulp Co. v. Howland Falls Pulp Co.*, 70 F. R. 992, 1895.

³ *Dade v. Boorum & Pease Co.*, 121 F. R. 135, 1903.

⁴ *Brickill v. Hartford*, 49 F. R. 373, 1892.

⁵ *Burden v. Corning*, 2 Fisher, 498, 1864.

always, and the first and second generally, require to be interposed in an answer, if interposed at all.

§ 610. The fifteenth defence can never be interposed in a plea, because it primarily depends, either upon the original patent not being inoperative or invalid by reason of a defective or insufficient specification, or upon its not being invalid in part, for want of novelty.¹ Where it primarily depends upon the first of these matters, it depends either upon the construction of the original letters patent, or upon proof that any person skilled in the art to which the invention belongs, could from the original specification make and use the same; and where it depends upon the second of these matters, it depends upon proof that everything claimed in the original letters patent was novel. None of these matters can ordinarily be put into a plea. Statements of the true construction of a patent cannot be, because they are statements of law. Statements that any person skilled in the art can make and use a particular invention, from a particular specification, are hardly proper in pleas, because a defendant ought seldom to attempt to swear what other persons can or cannot do. And statements that everything claimed in the patent of another was novel with him, should never go into a plea, because a defendant can never know that none of those things were previously known or used. Nor can this defence be raised by a demurrer, unless the original letters patent are incorporated in the bill for infringement of its reissue; and not even then can it be so raised, unless the question is solely one of construction of the original letters patent. An answer is always the most suitable place in which to interpose this defence, and generally it is the only possible pleading for the purpose.

§ 611. The sixteenth defence depends partly on the comparative construction of the original and the reissue letters patent, and partly upon evidence that the delay in applying for the reissue was unreasonable. Where both the original and the reissue are proffered or incorporated in the bill; this defence may be made by demurrer, because the court

¹ Revised Statutes, Section 4916.

then has every necessary means of making the comparative construction,¹ and because long delay will be held to be unreasonable, unless it is excused in the bill. Where the bill omits to set out the original patent, this defence must be made in an answer; for such mixed questions of law and fact are wholly unsuitable to a plea.²

§ 612. The seventeenth defence depends upon the comparative construction of the original and the reissue letters patent. It may be made on demurrer, where both those documents are proffered or otherwise incorporated in the bill. If the original letters patent are not so incorporated, this defence may be made in an answer; but it cannot be made in a plea, because the question involved is one of construction of documents, and not a question of fact to be sworn to by a defendant, or to be decided upon the replication of the complainant and the evidence of experts.

§ 613. The eighteenth defence may be made by a demurrer where the bill is based on the prior patent, as well as on its alleged double.³ But a plea is not suitable to this defence, unless the disputed claim or claims in the subsequent patent can be plainly seen to be identical with a claim or claims in the prior patent; for if construction must be resorted to in order to determine identity, or want of identity, between the claims of the two patents, the question is one of law, and therefore improper to be raised by a plea in equity. And an answer is always a proper pleading in which to interpose this defence.

§ 614. The nineteenth defence may be set up in a plea, if the defendant has personal knowledge of the record which he pleads, and can therefore make the required oath that there is in fact such a record. If he has no such knowledge, the defence must be made in an answer, for the ancient rule that records may be pleaded in equity, without an oath, is

¹ *Powder Co. v. Powder Works*, 98 U. S. 126, 1878; *Wollensak v. Reiher*, 115 U. S. 96, 1884; *International Terra Cotta Lumber Co. v. Maurer*, 44 F. R. 619, 1890.

² *Maxwell v. Kennedy*, 8 Howard, 222, 1850.

³ *Russell v. Kern*, 64 F. R. 581, 1894.

inconsistent with the United States equity rule upon the subject of pleas.¹

§ 615. The twentieth defence can be made by a demurrer, where the bill shows the patent had expired when the doings which constitute the alleged infringement were committed. But that will seldom be the fact, for the expiration relied upon in such cases is nearly always due to the expiration of some foreign patent for the same invention, and not to anything which appears on the face of the United States patent in suit. Where the defence depends upon the expiration of a foreign patent which is not mentioned in the bill, it cannot be set up in a demurrer. Nor can it often be set up in a plea; because it depends not only upon the existence of a foreign patent, but also upon that patent being for the same invention as the patent in suit; and because this last question, except where the two patents are plainly identical, is one of construction for the court;² and because defences which depend upon the comparative construction of different documents cannot be interposed in a plea.³ This defence must therefore generally be made in an answer.

§ 616. The twenty-first defence may be made in a plea, if the defendant knows that the complainant made or sold specimens of the patented thing during the life of the patent without marking them "patented," and if the defendant was not duly notified of his infringement, or, if notified, immediately discontinued to infringe.⁴ This defence can also be made without any special statement relevant thereto in the answer, because the complainant must negative it in his bill and in his evidence in chief, or suffer the operation of the defence, whether the defendant has set it up in any pleading or not.⁵ But this defence is not a defence to a prayer for an injunction, though it is to a prayer for damages,⁶ and to a

¹ Equity Rule 31.

² *De Florez v. Reynolds*, 17 Blatch. 436, 1880.

³ *Lowry v. Aluminum Co.*, 56 F. R. 495, 1893.

⁴ Revised Statutes, Section 4900.

⁵ *Dunlap v. Schofield*, 152 U. S. 244, 1894.

⁶ *Goodyear v. Allyn*, 6 Blatch. 33, 1868.

prayer for profits.¹ Though this defence need not be pleaded, it is waived, unless it is presented to the circuit court on the hearing of the case in that tribunal; and it cannot be successfully presented for the first time, in the appellate court to which the case may be taken.²

§ 617. The twenty-second defence may be made by demurrer, where the bill sets forth copies of the complainant's title papers, either in the stating part or as exhibits attached to the bill and thus made parts thereof, or where the bill pleads those papers according to their legal effect, and in such a way that the title appears on the face of the bill to be defective. Where the bill shows a good *prima facie* title, but where the defendant knows that one of the papers which compose its chain was executed after the assignor had assigned his right to another, and that the prior assignment was recorded in the Patent Office within three months after its date; or knows that such assignor assigned his right to another for a valuable consideration more than three months after the making of the assignment set up in the bill, and before the latter was recorded in the Patent Office, and without the junior assignee having notice of the senior unrecorded assignment, the defendant may successfully set up those facts in a plea. The action of a complainant will be defeated by evidence of either of these two sorts of faults in his title.³ Either of these sets of facts may also be set up in an answer, as also may any fact which derogates from the complainant's apparent title; but no defect of title due to an outstanding unrecorded document can be made available as a defence without being pleaded.⁴

§ 618. The twenty-third defence may be put into a plea; and that is the most appropriate pleading in which to interpose it, where the defendant is sure of the fact of a license.

¹ Lowell Mfg. Co. v. Hogg, 70 F. R. 787, 1895; Michigan Stove Co. v. Fuller-Warren Co., 81 F. R. 379, 1896; General Electric Co. v. Star Brass Works, 109 F. R. 950, 1901; Westinghouse Air-Brake Co.

v. New York Air-Brake Co., 111 F. R. 741, 1901.

² Tuttle v. Clafin, 76 F. R. 227, 1896.

³ Revised Statutes, Section 4898.

⁴ California Electric Works v. Fink, 47 F. R. 593, 1891.

Otherwise this defence, where it exists, should be interposed in an answer. A plea of this defence must state the character of the license specifically;¹ and there appears to be no reason why an answer should not, on this point, be as specific as a plea.

§ 619. The twenty-fourth defence should be treated in respect of pleading, in the same way as the twenty-third, and that whether the release pleaded was executed before or after the filing of the bill.

§ 620. The twenty-fifth defence may be interposed by a demurrer, where the bill sets forth the claims alleged to be infringed, and sets forth also the particular character of the defendant's doings.² But such a demurrer will be overruled, except where non-infringement is obvious from the bill of complaint, without any reference to the prior art. Where such a demurrer is overruled, and the defendant wishes to make the defence of non-infringement in an answer, and to support that defence by evidence; he ought to ask special permission from the court so to do. Such permission will doubtless be granted, except where the judge is sure that no evidence can furnish any needed light upon the question of infringement.³

The rules of equity pleading which were developed in England would justify the interposition of the defence of non-infringement in a plea; but the precedents in the United States courts do not accord with those rules on that subject. Those precedents indicate that pleas will not be permitted in such cases. It would be an economical practice to so prepare bills that this defence could be made by demurrer; but where a bill is not so prepared, an answer is the only pleading in which to interpose it.

§ 621. The twenty-sixth defence may be made in a plea,

¹ *Jones v. Berger*, 58 F. R. 1007, 1893.

² *Collins Chemical Co. v. Capitol City Mfg. Co.*, 42 F. R. 64, 1890; *Gerard v. Safe & Lock Co.*, 48 F. R. 380, 1891.

³ *Sharp v. Reissner*, 9 F. R. 445,

1881; *Korn v. Wiebusch*, 33 F. R. 51, 1887; *Jones v. Berger*, 58 F. R. 1006, 1893; *Leatherbee v. Brown*, 69 F. R. 590, 1895; *Union Switch & Signal Co. v. Philadelphia & Reading Railroad Co.*, 69 F. R. 835, 1895.

and it ought to be so made in every case where the defendant is certain that he can prove the facts which he is advised amount to a basis for an estoppel. If those facts are found, on an argument of the plea, not to constitute an estoppel, the defendant will be permitted to file an answer setting up other defences. Or the defence of estoppel can be set up in an answer in the first instance. And where that defence consists of *res judicata*, the former record can be introduced in evidence without being specially pleaded in the answer.¹

§ 622. The twenty-seventh defence may be interposed by a demurrer, where the bill clearly states the time when the infringement was committed, or the space of time during which it was carried on.² Statutes of limitation have the same effect upon actions in equity in the Federal courts, that they have upon corresponding actions at law.³ Where the bill simply states that the infringement occurred during the life of the patent, and where any part of that life is remote enough in point of time, to be barred by either the national or any applicable State statute of limitation, then the applicable statute must be set up in a plea or in an answer, in order to avail the defendant. An answer is to be preferred to a plea for this purpose, in all cases where the statute bars only a part of the right upon which the action is based; because an answer must generally be filed to the residue of the bill, and because the proceedings are simplified by putting all the defences into one pleading.

§ 623. A replication is required to be filed by the complainant, in order to put in issue those points wherein the answer disagrees with the bill. No special replication is permitted in equity in the United States courts.⁴ The general replication is required to be filed on or before the rule day which next succeeds that upon which the answer is due and

¹ Bradley Mfg. Co. v. Eagle Mfg. Co., 58 F. R. 721, 1893.

² Brickill v. Hartford, 49 F. R. 374, 1892.

³ Elmendorf v. Taylor, 10 Whea-

ton, 168, 1825; Miller v. McIntyre, 6 Peters, 66, 1832; Bank of United States v. Daniel, 12 Peters, 56, 1838.

⁴ Equity Rule 45.

is filed;¹ but if filed after that time, it may, at the discretion of the court, be ordered to stand;² or it may, if offered after that time, be allowed by the court to be filed *nunc pro tunc* as of the day whereon it was due.³

§ 624. Before tracing further the common course of an action in equity for infringement of a patent, it is expedient to make a short excursion into the field of those subordinate bills which are sometimes required to be filed before decrees for infringements can properly be entered. Four kinds of such bills are known: 1. Supplemental bills. 2. Bills in the nature of supplemental bills. 3. Bills of revivor. 4. Bills in the nature of bills of revivor.

§ 625. A supplemental bill is required where the original bill was filed by a person as executor or administrator, or as assignee in bankruptcy or insolvency, whenever any other person succeeds to the title of the complainant to act in that representative capacity.⁴ Such a bill is also necessary, in order to subject the estate of the defendant to a decree, where he is adjudged bankrupt or insolvent after the bill against him is filed.⁵ His assignee in bankruptcy or insolvency is the proper person to be made the defendant to such a bill.⁶ He will come before the court in the same plight as that of the bankrupt, and will be bound by all the prior proceedings in the case.⁷ A supplemental bill is also a proper one to be filed against a stranger to the original bill, where he has conspired with the original defendant to infringe the patent in suit, after the original defendant was enjoined from doing so himself.⁸ And such a bill is proper, where a patent is extended after the filing of the original bill, if the defendant continues to infringe the patent after the extension is granted.⁹

¹ Equity Rule 66.

² *Fischer v. Hayes*, 6 F. R. 77, 1881.

³ *Pierce v. West's Executors*, 1 Peters' Circuit Court Reports, 351, 1816.

⁴ Story's Equity Pleading, Section 340.

⁵ Mitford & Tyler's Equity Pleading, 166.

⁶ *Sedgwick v. Cleveland*, 7 Paige (N. Y.), 290, 1838.

⁷ Mitford & Tyler's Equity Pleading, 166.

⁸ *Parkhurst v. Kinsman*, 2 Blatch. 72, 1848.

⁹ *Reedy v. Scott*, 23 Wallace, 352, 1874.

The same reasons which support the latter rule will also support a supplemental bill based on a new patent covering some feature of those doings of the defendant which also infringe the patent originally sued upon; and will also support such a bill where the defendant so changes the character of his doings *pendente lite*, as to make them infringe some other patent of the complainant, as a part of the same acts that constitute infringements upon the patent upon which the original bill was based. But a good title, acquired after the filing of an original bill, cannot be brought into a case by a supplemental bill, to take the place of the bad title stated in the original bill.¹

§ 626. A bill in the nature of a supplemental bill is called for where the original bill was filed by a person in his own right, whenever that right passes to another person by voluntary assignment, or passes from the complainant to his assignee in bankruptcy or insolvency.² This rule applies not only to cases where the entire right of a sole complainant is thus transferred *pendente lite*, but also to cases where the right of one of several complainants is so transferred, and to cases where a part only of the right of a sole complainant is made the subject of a voluntary assignment after the filing of the original bill.³ And a bill in the nature of a supplemental bill, even if filed after the expiration of the patent, may be maintained in equity, if the original bill was filed before the expiration of the patent, and could have been thus maintained.⁴

§ 627. A bill of revivor is the proper means of reviving and continuing an action in equity for infringement of a patent, which has abated by reason of the death of one or more of the parties thereto.⁵ It is to be brought by or against

¹ Emerson v. Hubbard, 34 F. R. 327, 1888.

² Story's Equity Pleading, Section 349; Ross v. Ft. Wayne, 63 F. R. 470, 1894; Ecaubert v. Appleton, 67 F. R. 924, 1895.

³ Story's Equity Pleading, Section 346.

⁴ Ross v. Ft. Wayne, 63 F. R. 466, 1894.

⁵ Kirk v. Du Bois, 28 F. R. 460, 1886; Head v. Porter, 70 F. R. 498, 1895.

the executor or administrator of the deceased party, and not by or against his heirs.¹ When such a bill is filed, if the facts warrant him in so doing, the defendant may file a plea denying that the person who filed the bill was entitled to do so,² or interposing some statute of limitation applicable to bills of revivor.³ There is no Federal statute of that kind, but the relevant statutes of the several States are applicable to bills of revivor in Federal courts.⁴ Those State statutes are of many species. In some, the limitation begins to run from the death of the deceased complainant; and in others, from the time his death is suggested in the case; and in others, from the time when a *scire facias* to revive is served on the person entitled to revive. The length of the limitation also varies in the different States. Perhaps the shortest time is six months, and the longest eighteen.

Where a bill of revivor is filed by the proper person within the proper time, the action will stand revived without any pleading being filed by the defendant.⁵ But where a defendant dies without filing a sufficient answer to the original bill and the amendments thereto, the bill of revivor which is occasioned by his death ought to pray that the person against whom it seeks to revive the suit be compelled to answer the original bill and its amendments, or so much thereof as remains unanswered.⁶ After an action in equity has been duly revived, it proceeds in the new form, unaffected by the change of name; and all the testimony theretofore taken may be thereafter used, precisely as if no abatement and revivor had occurred.⁷

§ 628. A bill in the nature of a bill of revivor is required where the complainant in the original bill assigned the right of action and the patent upon which it was based, and then

¹ Story's Equity Pleading, Section 354a.

² Story's Equity Pleading, Sections 829 and 830.

³ Story's Equity Pleading, Section 831.

⁴ Revised Statutes, Section 721;

Campbell v. Haverhill, 155 U. S. 610, 1895.

⁵ Equity Rule 56.

⁶ Story's Equity Pleading, Section 375; Mitford & Tyler's Equity Pleading, 174.

⁷ Vattier v. Hinde, 7 Peters, 265, 1833.

died before the assignee took his place in the action, by means of a bill in the nature of a supplemental bill. A bill of the latter sort will not answer the purpose, unless it is filed before the death of the original complainant; because that death will cause an abatement of the suit, and because only bills of revivor, or bills in the nature of bills of revivor, can revive abated actions in equity.¹ Bills of revivor can be filed only by privies in law, such as executors and administrators; and not by privies in estate, such as devisees and assignees.² For the latter class of persons, bills in the nature of bills of revivor are available; and by means of such a bill, an assignee who did not file a bill in the nature of a supplemental bill before the death of the original complainant, may draw to himself the benefit of the original action, in whatever stage it may have been at the date of the abatement.³ Such a bill is also the proper means of reviving an action which has abated at the death of the administrator or executor who was prosecuting it in his representative capacity, if the person entitled to revive represents the original testator or intestate, and not the deceased executor or administrator.⁴

§ 629. A bill of revivor and supplement is merely a compound of a supplemental bill, and of a bill of revivor.⁵ It is therefore proper to be filed when either of the facts which justify a supplemental bill and either of the facts which require a bill of revivor, occur in one action. So also, any two or more of the four sorts of bills mentioned in the four last sections, may be united in one bill, whenever either of the facts which require either of those bills, occurs in the same action with any of the facts which require any of the others.

§ 630. Leave of court is a prerequisite to the filing of

¹ Equity Rule 56.

² Story's Equity Pleading, Section 379.

³ Slack v. Walcott, 3 Mason, 511, 1825.

⁴ Story's Equity Pleading, Section 382.

⁵ Mitford & Tyler's Equity Pleading, 177.

supplemental bills, or bills in the nature of supplemental bills; and it is to be obtained upon proper cause shown, and due notice to the opposite party.¹ But neither bills of revivor nor bills in the nature of bills of revivor, require any such order, for they may be filed in the clerk's office at any time.² The reason of this difference is that neither of the last two kinds of bills are useful except in cases of death. There can be no inducement to file such a bill as either, unless a death has occurred among the parties to the action; and where such a death has occurred, there can be no objection to the filing of one or the other. But the first two sorts of bills are based upon events about the true character of which, counsel may be mistaken in any given case, and it is therefore necessary, in order to avoid an improper accumulation of pleadings, that the court should pass upon the propriety of such bills before they are filed.

§ 631. No demurrer, plea or answer is ordinarily required to be filed to a bill of revivor, or to a bill in the nature of a bill of revivor.³ But defendants are always required to demur, plead, or answer to supplemental bills, and to bills in the nature of supplemental bills.⁴ Where a bill of either of those kinds shows on its face that the person who filed it was not a proper person to do so, the objection may be made by a demurrer,⁵ and when that fault exists, but does not appear on the face of the bill, the defence grounded upon it may be made by a plea.⁶ Other defences can be made to supplemental bills, or to bills in the nature of supplemental bills, in the same forms and in the same circumstances in which corresponding defences can be made to original bills for infringement.⁷

§ 632. The hearing of an action in equity for infringement of a patent, may take place before one of the judges of the court sitting alone, or before several judges sitting together,

¹ Equity Rule 57.

² Equity Rule 56.

³ Equity Rule 56.

⁴ Equity Rule 57.

⁵ Story's Equity Pleading, Section 612.

⁶ Story's Equity Pleading, Section 827.

⁷ Story's Equity Pleading, Sections 611 and 826.

or before a judge and a jury,¹ or before a master in chancery.² Judges constitute the best tribunals for the purpose; but as either of the other methods of trial may be resorted to at the will of the court, it is expedient to outline the law relevant to all three.

§ 633. An interlocutory hearing by a judge, in a patent action in equity, is one which occurs after the evidence relevant to the validity of the patent and its infringement by the defendant, has been taken, and before the case is referred to a master to take and state an account of profits and damages. The final hearing, which occurs after the master has taken that account and filed his report, generally involves nothing but the correctness of that report, and it therefore may appropriately be treated in the chapter on profits. So also, the preliminary hearing, which occurs when a preliminary injunction is applied for, may properly be discussed in the chapter on injunctions. The interlocutory hearing is generally the pivotal point of a litigation. Where it results in the success of the defendant and consequent dismissal of the bill, it becomes a final hearing.

A complainant cannot discontinue his action in equity for infringement of a patent, when it is called for a hearing; without showing some better reason for wishing so to do, than an intention to begin a new suit for the same cause of action, and a hope of proving a stronger case in the new suit, than he did prove in the one before the court.³

Questions of the patentability of inventions and the construction of patents concern the public, and therefore courts will examine all the questions involved in the patent cases brought on for hearing before them, and will not refrain from so doing at the suggestion of either party or of both.⁴

§ 634. Questions of law, in equity patent cases, are to be decided according to the relevant rules of law and equity in

¹ 18 Statutes at Large, Part 3, Ch. 77, Section 2, p. 316.

² *Parker v. Hatfield*, 4 McLean, 61, 1845.

³ *American Steel & Wire Co. v.*

Mayer & Englund Co., 121 F. R. 127, 1902.

⁴ *Millard v. Chase*, 108 F. R. 401, 1901.

force in the United States courts. The sources of those rules are the statutes of the United States, and the decisions of the United States Supreme Court and Courts of Appeals, and Circuit Courts, and those decisions of the chancellors of England which were made before the adoption of the Constitution of the United States. Later decisions of English courts sometimes indicate what the law is, but no such decision is of any binding authority in any United States court. Where such a decision is strictly relevant to a question at bar, and is supported by good reasoning, it may be followed by a United States judge; but if it refers to a substantially different state of statute law from that to which United States patent cases are subject, or if it was fallaciously reasoned out by the judge who delivered it, such a decision may properly be disregarded in the Federal courts. The decisions of State courts fall in the same category in this respect with the modern English decisions, except in cases where the United States statutes direct the Federal courts to follow the laws of the several States. In those cases, the State laws are binding on the Federal judges, not because the States have any authority to prescribe rules to Federal courts, but because the national legislature has adopted those particular State laws, instead of framing and enacting corresponding regulations of its own.

Where a question arises to which no direct answer can be found in the recognized sources of the law, it becomes the duty of the judge to deduce a proper answer, by means of just reasoning, from the general principles of law, of equity, and of justice. He may find assistance in that work by consulting the *obiter dicta* of courts and the commentaries of text-writers; but no *obiter dictum* and no text-book is of any binding authority. The points of law actually decided by the United States Supreme Court are generally binding on all other United States courts, regardless of the reasons which support them.¹ There is an exception to this rule,

¹ American Middlings Purifier Co. v. Christian, 3 Bann. & Ard. 44, 1877; Goodyear Dental Vulcanite Co. v. Davis, 3 Bann. & Ard.

116, 1877; Green v. City of Lynn, 55 F. R. 518, 1893; Westinghouse Air-Brake Co. v. Christensen Engineering Co., 103 F. R. 493, 1900.

where the Supreme Court has decided the same question both ways. In such a case, the last decision governs, if it expressly overruled the first.¹ If it simply ignored the first, it may have resulted from the first decision not being called to the attention of the justices who rendered the second. In such a case it is probably the duty of a Circuit Court to follow the more reasonable of the two decisions, regardless of seniority. The points of law actually decided by the Circuit Court of Appeals of any circuit are binding upon all the Circuit Courts in that circuit;² but not on any court in any other circuit.³ And the points of law actually decided by any judge, holding any United States Circuit Court, are followed by every other judge holding any United States Circuit Court, unless they have been reversed by a Circuit Court of Appeals, or by the Supreme Court, or are contrary to other decisions of equal or superior dignity, or appear to be erroneous.⁴ The points of law spoken of in this section include the construction given to letters patent, where the evidence of the prior art and other facts relevant to that construction remain unchanged, as well as the rules of law in general.⁵ But where a Circuit Court of Appeals, or circuit justice, or circuit judge, or any judge holding Circuit Court has decided the point both ways, the last of those decisions is the one which is to be regarded, if it expressly reversed the first.⁶ If it simply ignored the first,

¹ *Tilghman v. Proctor*, 125 U. S. 149, 1887.

² *Edison Electric Light Co. v. Bloomingdale*, 65 F. R. 214, 1894; *Thomson-Houston Electric Co. v. Mahar*, 112 F. R. 534, 1898.

³ *American Street Car Advertising Co. v. Jones*, 122 F. R. 807, 1903.

⁴ *Cary v. Lovell Mfg. Co.*, 31 F. R. 345, 1887; *Rubber Trimming Co. v. Rubber Comb Co.*, 35 F. R. 500, 1888; *Kidd v. Ransom*, 35 F. R. 588, 1888; *Eastern Paper Bag Co. v. Nixon*, 35 F. R. 752, 1888; *Consolidated Roller Mill Co. v. Barnard*

& *Leas Mfg. Co.*, 43 F. R. 532, 1890; *Zinsser v. Krueger*, 45 F. R. 574, 1891; *Enterprise Mfg. Co. v. Deisler*, 46 F. R. 854, 1891; *Campbell Mfg. Co. v. Manhattan Ry. Co.*, 49 F. R. 935, 1892; *Macbeth v. Gylinder*, 54 F. R. 170, 1889; *Office Specialty Co. v. Winternight Mfg. Co.*, 67 F. R. 928, 1895; *Maitland v. Graham*, 96 F. R. 247, 1899.

⁵ *National Box & Paper Co. v. American Paper Box Co.*, 48 F. R. 913, 1892; *Sessions v. Gould*, 60 F. R. 755, 1894.

⁶ *Brown Mfg. Co. v. Mast*, 53 F. R. 582, 1892.

the two decisions will respectively weigh according to the weight of the reasons which respectively support them.

Adjudicated cases are binding precedents in the law only where the questions of law involved in those cases were actually submitted for decision therein; and such a submission is not involved in raising those questions in the pleadings, nor in controverting them in the evidence, if one party or the other abandons those questions at the hearing.¹

§ 635. Questions of fact depend upon the evidence in the particular cases in which they arise, except so far as they depend upon matters of which courts take judicial notice. Questions of fact in patent cases often require for their solution a severely logical process of reasoning from the testimony in the record. It sometimes occurs that the evidence in a number of cases, pending in a number of Circuit Courts, is substantially the same. Where one such case has been carefully argued and deliberately decided in a Circuit Court, all the other Circuit Courts are apt to follow that decision;² except where a different decision is required by a different state of evidence.³ Still it is the duty of every court to decide cases right; and to that end every judge is bound to decide his cases according to his own convictions, rather than according to the convictions of any other judge of any co-ordinate tribunal; and it is only in cases of doubt in the mind of a judge of a Circuit Court, that comity comes into operation and suggests a uniformity of ruling.⁴

The relations between the different Circuit Courts of Appeals, in respect of following the decisions of each other, on questions of fact in patent cases, are the same as the corresponding relations between the different Circuit Courts of the United States.⁵

¹ Celluloid Mfg. Co. v. Tower, 26 F. R. 452, 1885.

² Hammerschlag Mfg. Co. v. Bancroft, 32 F. R. 585, 1887; Hammerschlag Mfg. Co. v. Spalding, 35 F. R. 67, 1888; Pratt v. Wright, 65 F. R. 99, 1890.

³ Barnes Sprinkler Co. v. Wal-

worth Mfg. Co., 51 F. R. 89, 1892; Gates Iron Works v. Kimbell & Cobb Stone Co., 79 F. R. 78, 1897.

⁴ Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 488, 1900.

⁵ Haniton v. Price, 102 F. R. 509, 1900.

Where a question of fact in a patent case, has been decided by a Circuit Court of Appeals, that decision is binding in all cases in the Circuit Courts of the same circuit, wherein the evidence is substantially the same.¹ And where a question of fact in a patent case, has been decided by the Supreme Court, that decision is conclusive in all other patent cases, so far as the evidence is substantially identical with that before the Supreme Court.² But the evidence must be taken in the subsequent cases, and cannot be imported from the record of the Supreme Court or of the Court of Appeals; though it is not necessary or proper to introduce evidence to prove what evidence was before the higher court, or to prove what decision was rendered on that evidence; those two points being left to the examination of the reports and records of the higher tribunal.³

The points stated in the last three paragraphs relate to prior cases which were litigated in earnest between opposing parties; and those points do not apply to any case which was collusively conducted, or which ceased to be an adversary action before the hearing which resulted in the decision of the case.⁴

§ 636. The evidence which a complainant is required to produce to support his bill in an action in equity, is the same as that which a plaintiff in an action at law is required to introduce in support of his declaration; except that in an action in equity the complainant must introduce evidence to excuse his delay in filing his bill, where a long delay to file it occurred after the infringement took place; and except that evidence of danger of infringement, may take the

¹ *Bowers Dredging Co. v. New York Dredging Co.*, 80 F. R. 119, 1897.

² *American Middlings Purifier Co. v. Christian*, 3 Bann. & Ard. 44, 1877; *American Bell Telephone Co. v. Southern Telephone Co.*, 34 F. R. 796, 1888; *Birmingham Cement Mfg. Co. v. Gates Iron*

Works, 78 F. R. 351, 1896; *Westinghouse Air-Brake Co. v. Christensen Engineering Co.*, 113 F. R. 595, 1901.

³ *Green v. City of Lynn*, 55 F. R. 519, 1893.

⁴ *Western Electric Co. v. Anthracite Telephone Co.*, 100 F. R. 301, 1900, and 113 F. R. 834, 1902.

place of evidence of actual infringement;¹ and except that a court of equity may take notice of its own records in other cases, when ascertaining the state of the prior art;² and except that the complainant's evidence of the doings of the defendant will have to be equal to the testimony of two witnesses, in order to meet the denial of the defendant's answer, where the bill required the answer to be made under oath, and where a denial was made under oath;³ and except that till after the interlocutory hearing, the complainant need introduce no evidence relevant to profits or to damages.

When the complainant has some evidence tending to show the character of the defendant's doings, and that those doings infringe the complainant's patent, a court of equity has power to order the defendant to allow the complainant, or some expert or other person representing him, to inspect the defendant's doings for fuller accuracy of knowledge.⁴ But this power will not be exercised, where a bill is filed upon a conjecture of infringement with the hope of obtaining evidence to that effect afterward.⁵ Except where particular statements of a bill of complaint are admitted by the defendant's answer; the complainant must prove all the essential parts of his bill to be true, including any which the answer ignores, or expressly declines to admit or to deny.⁶

§ 637. The evidence which is required to support either of the twenty-seven defences which are common to actions at law and actions in equity, is the same in both those forms of proceeding. Of the two defences which are peculiar to equity, that of non-jurisdiction is one which seldom or never requires any evidence to support it; and laches is, *prima facie*, supported by the fact of the long lapse of time which is deducible from the complainant's proofs, where such a

¹ National Meter Co. v. Thomson Meter Co., 106 F. R. 531, 1900.

² Cushman Paper Box Mach. Co. v. Goddard, 95 F. R. 666, 1899.

³ Schultze v. Holtz, 82 F. R. 448, 1897.

⁴ Diamond Match Co. v. Oshkosh Match Works, 63 F. R. 984, 1894;

Wilson v. Keeley, 43 O. G. 511, 1888.

⁵ Dobson v. Graham, 49 F. R. 17, 1889; Stokes Bros. Mfg. Co. v. Heller, 56 F. R. 298, 1893.

⁶ Lovell v. Johnson, 82 F. R. 206, 1897.

defence has any foundation at all. Where the complainant introduces evidence to excuse the delay, it may be necessary for the defendant to negative that evidence by other proof, or to prove facts which show the complainant's excuse to be invalid or insufficient.

§ 638. Testimony in actions in equity for infringements of patents is taken wholly by depositions in writing, except in a few districts, where, in pursuance of local rules of court, it may, by the consent of both parties, be taken orally in open court. Where testimony is taken by depositions in writing, counsel have sometimes yielded to temptation to take immaterial or otherwise inadmissible evidence, and to prolong examinations beyond useful bounds. Indeed this practice has grown to be such a drain upon the pockets of parties, and such a burden upon the minds of judges, that one of the most experienced and distinguished of the latter has taken occasion to administer to the abuse a deserved condemnation, saying of a case not worse than many others: "This record is a sample of the expensive practice which now prevails in patent cases, of stuffing the record with prolix cross-examinations and irrelevant testimony."¹ In another case, another distinguished patent law judge reflected rather severely, for the same fault, upon some of the most distinguished patent lawyers now living.² In still another case, still another set of leading patent lawyers were made to feel the point of a particularly brilliant judicial pen, in an attempt to correct the same error.³ These judicial utterances were doubtless just; and it is hoped that the judges will also correct those professional experts who persistently evade fair questions on cross-examination, by means of long and ambiguous deliverances, with the intention to cover up and conceal facts which they think are unfavorable to the party who is expected to pay them their fees for their professional testimony.

¹ *Ecaubert v. Appleton*, 67 F. R. 924, 1895.

² *Thomson-Houston Electric Co. v. Winchester Ave. Ry. Co.*, 71 F. R. 193, 1895.

³ *National Folding Box & Paper Co. v. Stecher Lithographic Co.*, 77 F. R. 829, 1896.

Objections to questions are often inserted in depositions in patent cases where they are useless; and the lengths and expenses of such depositions are increased thereby. For example, one common objection to be found in such depositions reads substantially as follows: "Counsel for the defendant objects to this question, as immaterial, irrelevant and inadmissible." But no such objection can have an effect upon a deposition in an equity case. It is useless to object to a question as inadmissible, for that word refers equally to every ground of objection known to the law of evidence; and no objection to a question in a deposition can have an effect upon the question, unless that objection specifies the particular ground upon which it is based. The word "irrelevant" has the same meaning as the word "immaterial," and is therefore a repetition of the idea of that word. And it is unnecessary to express that idea in objection to a question in a deposition in an action in equity; because the judge must read the question, and perhaps also the answer, in order to decide whether the question is material, and because, if he finds the question to be immaterial, he cannot be expected to base any conclusion upon the answer.

§ 639. Depositions may be taken by a commission, upon interrogatories filed by the party taking it out, and upon cross-interrogatories filed by the adverse party.¹ If either party so requires, all the depositions in a case must be taken orally, in writing, before an examiner, in the presence of the parties or their agents, by their counsel or solicitors, and in the method of examination and cross-examination used in common-law courts.² An examiner may take testimony in other districts than that wherein the case is pending; and the United States Circuit Court for any other district has power to issue a subpoena, commanding a person living in its district to appear and testify before the examiner who is discharging his duties therein; and such court also has power to punish such a person for refusing to obey such a subpoena; and such a subpoena may issue from the

¹ Equity Rule 67.

² Equity Rule 67.

clerk's office without any special order of court.¹ Where depositions are taken orally in writing before an examiner, the court may, on motion of either party, assign a time within which the complainant shall take his evidence in support of the bill; and a time thereafter, within which the defendant shall take his evidence in defence; and a time thereafter, within which the complainant shall take his evidence in reply.² Depositions may also be taken in equity cases, in the method heretofore explained for taking depositions in actions at law, whenever the same facts exist to justify that mode of practice.³

It is to be observed, relevant to all methods of taking depositions, that each item of the procedure which is prescribed by rule or by statute, must be strictly followed in every case, except where it is varied or waived by a written stipulation of the parties. Stipulations may also provide for an enlargement of time for taking depositions,⁴ which time, unless enlarged by a stipulation or by an order of court, covers three calendar months and no more.⁵ And courts are apt to deny motions for such orders, where they are not supported by reasons which commend themselves to the judges to whom they are presented.⁶ But depositions taken out of proper time will be considered on the hearing, unless there is a prior successful motion to suppress them.⁷

§ 640. Depositions taken in any other case may be used in any action in equity, if each party therein was a party to the action in which they were taken, or is in privity with a party to that action, and if the court grants a motion to use them.⁸ But where either party in the new action was not a

¹ *Johnson Street Rail. Co. v. Trust Co. v. Green Cove Railroad*, North Branch Steel Co., 48 F. R. 139 U. S. 145, 1891.
192, 1892.

² Equity Rule 67.

³ *Stegner v. Blake*, 36 F. R. 184, 1888; *Arnold v. Chesebrough*, 35 F. R. 16, 1888; Equity Rule 68; Section 535 of this book.

⁴ Equity Rule 67.

⁵ Equity Rule 69; *Guaranty*

Trust Co. v. Green Cove Railroad, 139 U. S. 145, 1891.

⁶ *Pittsburgh Wire Co. v. Roberts*, 71 F. R. 711, 1896; *Allington & Curtis Mfg. Co. v. Globe Co.*, 73 F. R. 394, 1896.

⁷ *Matthews v. Spangenberg*, 19 F. R. 824, 1882.

⁸ *Clow v. Baker*, 36 F. R. 692, 1888.

party to the former one, and is not in privity with any party thereto, no deposition taken in the former suit can be used in the new one; for no deposition can be read against a party, who could not read it in his favor if it were favorable to him.¹

§ 641. Documentary evidence is generally introduced before the examiner, within the same time that the oral testimony is required to be taken; and that is the necessary course where documents require to be proved by oral testimony. Each party ought to introduce his documentary evidence, when taking his own testimony; and if he introduces such evidence when the testimony of the other party is being taken, it will be treated as if it was introduced afterward, when the introducer was taking his own testimony, if such subsequent taking of testimony was proper.²

Stipulations are extensively made in patent cases on undebatable points of fact, and when made they are binding upon the parties, unless they are canceled or amended by agreement of the parties or an order of the court.³ But courts will allow a party to withdraw from an inadvertently made stipulation, when it is found to be out of conformity to the truth, and when such a withdrawal is not unjust to the opposite party to the action.⁴

Documents which prove themselves, may be introduced on the hearing without having been put in evidence before the examiner, unless such a practice, in a particular case, would operate as a surprise upon the opposite party.⁵ And documents which require to be proved, may be introduced on or even after the hearing, with the consent of the court.⁶ Where a document thought by a party to be material to his case, is

¹ Dale v. Roosevelt, 1 Paige (N. Y.), 35, 1828; Paynes v. Coles, 1 Munford (Va.), 394, 1810; Barker v. Shoots, 18 F. R. 652, 1884.

² Cimiotti Unhairing Co. v. American Fur Refining Co., 120 F. R. 673, 1903.

³ General Electric Co. v. Wagner

Electric Mfg. Co., 123 F. R. 103, 1903.

⁴ Carnegie Steel Co. v. Cambria Iron Works, 185 U. S. 444, 1902.

⁵ Knapp v. Shaw, 15 F. R. 115, 1883.

⁶ Mast, Foos & Co. v. Windmill & Pump Co., 68 F. R. 224, 1895.

known to be in the possession of the opposite party, its production in court may be compelled by a subpoena *duces tecum*.¹

§ 642. A jury of not less than five and not more than twelve persons may be empanelled by any United States Circuit Court, when sitting in equity for the trial of a patent cause, for the purpose of submitting to them such questions of fact in the case as the court shall deem it expedient to submit; and the verdict of such a jury is treated 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.² Therefore such a verdict is only advisory, and never conclusive upon the court. If the judge disagrees in opinion with the jury relevant to the questions of fact covered by the verdict, he may enter a decree contrary thereto.³ But the regular course of proceeding in such a case is to enter a decree in accordance with the verdict, unless the party against whom it was found moves the court for a new trial. A new trial in such a case is granted or refused according as the judge thinks the verdict was right or was wrong; and without special regard to any errors, or freedom from errors, which characterized the admission or rejection of evidence on the trial, or the instructions which were given or those which were refused by the judge.

Where a new trial is refused, and a decree is entered in accordance with the verdict, if the defeated party would take the case to the Circuit Court of Appeals for review, he must do so on appeal from the decree, and not upon a writ of error as from a judgment entered upon a verdict in an action at law. In a properly prepared case, the Circuit Court of Appeals will decide whether, on the whole, the decree was right or was wrong; but it will not pass upon the correctness or incorrectness of the rulings of the judge at the jury trial. Therefore, the evidence taken at the jury trial should be pre-

¹ Edison Electric Light Co. v. United States Electric Lighting Co., 45 F. R. 55, 1891.

Ch. 77, Section 2, p. 316; Gray v. Halkyard, 28 F. R. 854, 1886.

³ Silsby v. Foote, 1 Blatch. 545,

² 18 Statutes at Large, Part 3, and 20 Howard, 290, 1857.

served, if there is any intention to take the case to the Circuit Court of Appeals, but no bill of exceptions in the case is necessary or is proper.¹

§ 643. A master in chancery may be directed by a Circuit Court, with the consent of the parties, to hear and decide any or all the questions in a patent case, and to report his decision to the court.² But such a report is advisory only, and no decree will be entered upon it, if either party can convince the judge that it was wrong. Exceptions to the master's report are the proper means of appeal from his conclusion. If, on such exceptions, the judge concludes that the master was wrong in any respect, he may send the case back to him, with directions to make a new report, and with prescriptions of new criteria by which to make it;³ or he may proceed to try the questions himself, if that course appears to be more convenient. The rules of practice which regulate the taking of evidence by masters in chancery, and regulate the hearings before them, and the filing of exceptions to their reports, are the same, when they are directed to ascertain the truth relevant to such questions as novelty or infringement, that they are in the more common cases wherein they are directed to take and state accounts of profits and damages.

§ 644. An interlocutory decree, in an equity patent case, is a decree which adjudges that the patent sued upon is valid; and that the defendant has infringed it; and that a master in chancery be directed to take and report an account of the profits which the defendant realized from that infringement, and of the damages which the complainant sustained by reason thereof; and sometimes that the defendant be permanently enjoined from further infringement.⁴

Where only part of the claims in suit are found valid and

¹ *Watt v. Starke*, 101 U. S. 247, 1879.

² *Parker v. Hatfield*, 4 McLean, 61, 1845; *National Cash-Register Co. v. Navy Cash-Register Co.*, 99 F. R. 565, 1900; *Western Union Telegraph Co. v. American Bell Telephone Co.*, 105 F. R. 686, 1900.

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

⁴ *Dudley E. Jones Co. v. Munger Mfg. Co.*, 50 F. R. 785, 1892; *Richmond v. Atwood*, 52 F. R. 21, 1892; *Brush Electric Co. v. Western Electric Co.*, 76 F. R. 761, 1896.

infringed, such a decree is confined to that part;¹ and such a decree is not entered in a case where the infringement is below the dignity of the court, but bills in such cases are dismissed without costs.² Judicial destruction of infringing articles, is a feature of the patent laws of England, but is not justified by any existing law of the United States; though that severe measure has been approved in one *obiter dictum*,³ and unsuccessfully invoked in one adjudicated case.⁴

§ 644a. An appeal from an interlocutory decree which grants, or continues, an injunction, may be taken to the Circuit Court of Appeals, for the circuit in which that decree was rendered, at any time within thirty days from the entry of the decree.⁵ Such an appeal will secure a review of that part of the decree which refers to an injunction;⁶ and to that end, the Circuit Court of Appeals will decide the questions of validity and infringement, and whatever other questions underlie the question of the justice of an injunction.⁷ If the decision on either of these two fundamental questions is adverse to the complainant, it will result in a direction to the Circuit Court, to dismiss the bill of complaint from that tribunal.⁸ No appeal can be taken by a defendant from an interlocutory decree which directs an accounting of profits and damages, but does not order an injunction. And where an interlocutory decree directs an accounting of profits and damages, and orders an injunction on only part of the claims

¹ *Shute v. Morley Co.*, 64 F. R. 368, 1894.

² *Wickwire v. Wire Fabric Co.*, 41 F. R. 36, 1889.

³ *Birdsell v. Shaliol* 112 U. S. 487, 1884.

⁴ *American Bell Telephone Co. v. Kitsell*, 35 F. R. 521, 1888.

⁵ 31 Statutes at Large, Ch. 803, p. 666; *National Automatic Mach. Co. v. Automatic Weighing Mach. Co.*, 105 F. R. 670, 1901; *Western Electric Co. v. Williams-Abbott Electric Co.*, 108 F. R. 953, 1901; *Thomson-Houston Electric*

Co. v. Nassau Electric Railroad Co., 112 F. R. 676, 1901.

⁶ *Metallic Extraction Co. v. Brown*, 104 F. R. 354, 1900.

⁷ *Richmond v. Atwood*, 52 F. R. 28, 1892; *Consolidated Cable Co. v. Pacific Ry. Co.*, 58 F. R. 226, 1893; *Columbus Watch Co. v. Robbins*, 64 F. R. 397, 1894; *Kilmer Mfg. Co. v. Griswold*, 67 F. R. 1017, 1895.

⁸ *Smith v. Vulcan Iron Works*, 165 U. S. 525, 1897; *Millard v. Chase*, 108 F. R. 404, 1901.

in suit, and where the defendant thereupon appeals, the court will not consider that part of the decree which was favorable to him.¹

§ 645. A petition for a rehearing may be filed at any time before the end of the term at which the final decree in the case is entered and recorded.² Such a petition may be based upon an apparent error of the judge in deciding upon the case as it was presented to him in the record; or it may be based on facts which were discovered after the entry of the decree which the petition asks to have reconsidered. These two kinds of rehearing are quite different from each other, not only in respect of the grounds upon which they are based, but also in respect of the methods by which they are obtained.

§ 646. A rehearing for matter apparent on the face of the record may be applied for by a petition signed by counsel, and stating the ground upon which the rehearing is prayed.³ That ground must be sufficient to convince the judge that the decree was perhaps erroneous.⁴ In order to do that, it is necessary to point out some particular misapprehension of the law, or some particular mistake in respect of the evidence, into which the judge was unfortunate enough to fall.⁵ Such a misapprehension may be established by showing that since the case sought to be reheard was decided, the Appellate Court has settled or clarified the law so as to give it a different character from that which it was then understood to have;⁶ but such a mistake cannot be established by showing that the judge omitted, in his opinion, to review all the evidence in the case.⁷ It is useless to ask for a rehearing of this kind on the general ground that the decision is thought by counsel to

¹ *Eagle Lock Co. v. Corbin Lock Co.*, 64 F. R. 789, 1894.

² Equity Rule 88.

³ Equity Rule 88.

⁴ *American Diamond Rock Boring Co. v. Sheldon*, 18 Blatch. 50, 1880.

⁵ *Everest v. Oil Co.*, 22 F. R. 252, 1884; *Railway Mfg. Co. v. Railroad Co.*, 26 F. R. 411, 1886; *Coupe*

v. Weatherhead, 37 F. R. 16, 1888; *Detwiller v. Bosler*, 58 F. R. 250, 1893; *Beach v. Hobbs*, 82 F. R. 928, 1897.

⁶ *Wooster v. Handy*, 21 F. R. 51, 1884; *Spill v. Celluloid Mfg. Co.*, 21 F. R. 640, 1884; *Campbell v. New York*, 35 F. R. 504, 1888.

⁷ *Timken v. Olin*, 37 F. R. 207, 1888.

be wrong.¹ But a rehearing may be spontaneously ordered by the court, when the judge begins to doubt his decision.²

§ 647. A rehearing on account of newly discovered evidence must be applied for as soon as possible after its discovery,³ by a petition verified by the oath of the applicant or of some other person,⁴ and stating the nature of the alleged newly discovered evidence, and that it was not known to the petitioner till after the decree was rendered;⁵ and also what diligence was exercised in searching therefor prior to that time,⁶ and praying for leave to file a supplemental bill in the nature of a bill of review, and for a rehearing of the cause at the time when the issues raised by that bill shall be ready for hearing.⁷ The function of such a bill is to furnish a foundation in the pleadings for evidence on both sides of the new issues of fact to determine which, the rehearing is granted.

When such a petition is filed, it must be supported by affidavits of the witnesses who are expected to testify to the newly discovered facts which are sought to be brought into the case,⁸ and also by affidavits showing that those facts were not discovered by the petitioner till after the former hearing,⁹ and could not, with reasonable diligence, have been discovered sooner than they were.¹⁰ Such a petition may be answered by counter affidavits tending to show that part or all of the state-

¹ *Tufts v. Tufts*, 3 *Woodbury & Minot*, 429, 1847; *Gage v. Kellogg*, 26 *F. R.* 243, 1886.

² *Brown Mfg. Co. v. Deere*, 51 *F. R.* 229, 1892.

³ *Blandy v. Griffith*, 6 *Fisher*, 435, 1873; *Pittsburgh Reduction Co. v. Cowles Aluminum Co.*, 121 *F. R.* 557, 1903.

⁴ Equity Rule 88.

⁵ *Foote v. Stein*, 35 *F. R.* 205, 1888.

⁶ *Allis v. Stowell*, 5 *Bann. & Ard.* 459, 1880; *New York Filter Co. v. Filter Co.*, 62 *F. R.* 582, 1894.

⁷ *Dexter v. Arnold*, 5 *Mason*, 310, 1829; *Daniell's Chancery Practice*, 1537.

⁸ *Reeves v. Keystone Bridge Co.*, 2 *Bann. & Ard.* 259, 1876.

⁹ *Reeves v. Keystone Bridge Co.*, 2 *Bann. & Ard.* 256, 1876.

¹⁰ *India Rubber Comb Co. v. Phelps*, 4 *Fisher*, 317, 1870; *Hitchcock v. Tremaine*, 9 *Blatch.* 551, 1872; *Barker v. Stowe*, 4 *Bann. & Ard.* 405, 1878; *Willimantic Linen Co. v. Clark Thread Co.*, 24 *F. R.* 799, 1885; *Bennett v. Schooley*, 77 *F. R.* 352, 1896.

ments in the petitioner's affidavits are untrue.¹ To grant the prayer of the petition, the court must be satisfied that the applicant's affidavits are probably true,² and clearly material,³ and that the facts they set forth were not known to the petitioner at the time of the former hearing, and could not with reasonable diligence have been discovered prior to that event;⁴ except that the last of these four points is not required to be shown, where it is shown that the other party knew, at the time of the decree, of the facts which are sought to be brought into the case on a rehearing.⁵

Where a rehearing is granted to permit the defendant to introduce newly discovered evidence, after an accounting has been carried forward in pursuance of an interlocutory decree; the order will properly provide that the defendant shall pay to the complainant all the costs which shall have been incurred by the latter, in connection with that accounting.⁶

Rehearings will not be granted to enable parties to search for further evidence;⁷ nor to strengthen their expert testimony;⁸ nor to amend their pleadings so as to make certain evidence admissible, which was taken before the former hearing, and was disregarded thereon, because not supported by any pleading;⁹ nor to produce cumulative evidence on questions of fact which were in issue at the former hearing;¹⁰ nor to correct errors of management committed by the petitioner's

¹ *Blandy v. Griffith*, 6 Fisher, 435, 1873.

² *Munson v. New York*, 11 F. R. 72, 1882; *New York Sugar Co. v. Sugar Co.*, 35 F. R. 217, 1888.

³ *Reeves v. Keystone Bridge Co.*, 2 Bann. & Ard. 259, 1876.

⁴ *Prevost v. Gratz*, 1 Peters' Circuit Court Reports, 364, 1816; *Baker v. Whiting*, 1 Story, 234, 1810; *Reeves v. Keystone Bridge Co.*, 2 Bann. & Ard. 258, 1876; *Page v. Telegraph Co.*, 18 Blatch. 122, 1880.

⁵ *Jonathan Mills Mfg. Co. v. Whitehurst*, 60 F. R. 81, 1894.

⁶ *Pittsburgh Reduction Co. v. Cowles Aluminum Co.*, 121 F. R. 557, 1903.

⁷ *Munson v. New York*, 11 F. R. 72, 1882.

⁸ *Hitchcock v. Tremaine*, 5 Fisher, 538, 1872.

⁹ *American Saddle Co. v. Hogg*, 6 Fisher, 67, 1872.

¹⁰ *Blandy v. Griffith*, 6 Fisher, 435, 1873; *Pfanschmidt v. Mercantile Co.*, 32 F. R. 607, 1887.

counsel.¹ And no appeal lies from a decision of a Circuit Court granting or refusing any rehearing.²

Where a rehearing on account of newly discovered evidence, is wanted by either party, after an interlocutory decree against him has been affirmed by the Circuit Court of Appeals; the petition for that rehearing must be addressed to the appellate tribunal. If that court denies the petition, that denial is final. If it thinks the petition should be granted, the Circuit Court of Appeals grants permission to the petitioner to apply to the Circuit Court for the desired rehearing; and that court will then pass upon such an application on its merits.³ Where a rehearing on account of newly discovered evidence, is wanted by either party, after an interlocutory decree against him has been appealed to the Circuit Court of Appeals, but has not been heard in that tribunal; the petition for that rehearing must be addressed to the Circuit Court, and must ask that court to request the Circuit Court of Appeals to return the record to the lower tribunal for further proceedings therein.⁴

§ 648. A supplemental bill in the nature of a bill of review should state the newly discovered facts upon which it is based, and should pray that the cause may be heard with respect to the new matter, at the same time that it is reheard upon the original bill, and that the party who files the subordinate bill may have such relief as the nature of his case requires. The proceedings upon a bill of this description are the same as those upon original bills in general.⁵ No order for a rehearing, made after an interlocutory decree,

¹ *Ruggles v. Eddy*, 11 Blatch. 524, 1874; *Colgate v. Telegraph Co.*, 19 F. R. 828, 1884; *Pittsburg Reduction Co. v. Aluminum Co.*, 64 F. R. 128, 1894; *Lowell Mfg. Co. v. Hogg*, 70 F. R. 787, 1895; *Hanifen v. E. H. Godshalk Co.*, 78 F. R. 816, 1896.

² *Roemer v. Bernheim*, 132 U. S. 106, 1889.

³ *In re Gamewell Fire-Alarm*

Tel. Co., 73 F. R. 908, 1896; *Municipal Signal Co. v. Gamewell Fire-Alarm Tel. Co.*, 77 F. R. 452, 1896; *Bliss v. Read*, 106 F. R. 318, 1901.

⁴ *Roemer v. Simon*, 91 U. S. 149, 1875; *Ciniotti Unhairing Co. v. American Unhairing Mach. Co.*, 99 F. R. 1003, 1900; *Nutter v. Mossberg*, 118 F. R. 168, 1902.

⁵ *Daniell's Chancery Practice*, 1537.

and while an account of profits and damages is being taken by a master in chancery, will stop the taking of that account; unless the court enters a special order directing the master to suspend proceedings therein.¹ And where a rehearing results in a reversal of an interlocutory decree, which has been entered in favor of a complainant, and results also in a dismissal of the complainant's bill; that dismissal will be without prejudice to the use, in any subsequent accounting, of the evidence which may have been taken by the master.² And the decree ordering that dismissal will give costs to the complainant for the litigation prior to the granting of the rehearing; and will give costs to the defendant for the litigation which occurred after that event.³

§ 649. A final decree will be entered in favor of the defendant, where a demurrer to the whole bill is sustained on a point which is not cured by amendment; or where a plea to the whole bill is sustained on an argument, and is thereupon replied to, and is found to be true on the trial; or where either of the numerous defences which may be made in an answer, and which apply to the whole bill, are established at an interlocutory hearing.⁴

Where more than one of those defences is strongly supported in the record; it is proper for the court to confine the decision to any one of them that is judicially found to be sound. Where the defence of non-infringement is thus found, it is proper⁵ and generally preferable⁶ to select that defence as the one upon which to base the decision for the defendant. The reason for this preference, is the consideration that the question of the validity of a patent ought not to be adjudicated in the affirmative, in a case where the defendant, by reason of non-infringement thereof, has no adequate motive to hunt up and lay before the court, all the facts which relate to that question. But where a record

¹ Daniell's Chancery Practice, 1467.

² Campbell v. New York, 35 F. R. 504, 1888.

³ Hake v. Brown, 44 F. R. 283, 1890.

⁴ Richmond v. Atwood, 52 F. R. 21, 1892.

⁵ McMichael & Wildman Mfg. Co. v. Ruth, 123 F. R. 890, 1903.

⁶ Wilcox & Gibbs Sewing Mach. Co. v. Sherborne, 123 F. R. 877, 1903.

does contain evidence enough to establish the invalidity of a patent, it is both proper and expedient to base a decision for the defendant on that ground, even where the defence of non-infringement is also established by the record; because the public has a right to be judicially told that a void patent is void, whenever that conclusion is established by evidence presented in a litigated case, in one of the courts which have received jurisdiction to adjudicate all questions of validity of patents.

Final decrees will be entered in favor of complainants, when their bills have successfully run the gauntlet of demurrers, pleas, answers, interlocutory hearings, petitions for rehearings, supplemental bills in the nature of bills of review, accountings before a master, exceptions to the master's report, and final hearings, through which original bills in patent cases may regularly be caused to pass. The last three parts of this series of proceedings are explained in the chapter on profits, and the others have already been outlined in this.

Where an action in equity for alleged infringement of a patent, is settled after evidence is taken therein, and before a hearing thereof; that settlement cannot include an effective stipulation that the evidence shall be withdrawn from the files of the court.¹ Parties who litigate such controversies in United States courts, must litigate them in public, and are not permitted to use those tribunals for secret proceedings, or to conceal or suppress any of the records of their litigations.

Where several cases on one patent are litigated on one set of depositions and other evidence, only one bill of costs is taxed; and where that bill is taxed against the complainant, a decree is made in favor of each defendant for an equal share of the amount.²

Assuming that a final decree has already been entered for the complainant or the defendant, and that the costs

¹ Sloan Filter Co. v. El Paso Reduction Co., 117 F. R. 504, 1902.

² Taber v. Meriden Britannia Co., 106 F. R. 85, 1901.

have been adjusted and taxed according to law,¹ it is now convenient to delineate the further proceedings to which the defeated party may resort. These are of two kinds: bills of review, and appeals.

§ 650. A bill of review is the proper means of securing a reconsideration of a final decree, after the expiration of the term at which it was entered.² Such bills are of two sorts: those filed to correct errors apparent on the face of the pleadings or decree;³ and those filed to introduce evidence of facts which occurred or were discovered after the decree was entered.⁴

§ 651. A bill of review to correct errors apparent on the pleadings or decree, may be filed without leave of court,⁵ but no such bill will be considered or acted upon by the court, unless it is filed within the same time after the entry of the decree, as that provided for by statute relevant to appeals;⁶ which latter time is at present six months.⁷ Nor will such a bill be entertained, if the decree which it was filed to correct, was entered by the circuit court, after an appeal to a higher court, and in pursuance of directions contained in the mandate of the latter tribunal.⁸ In considering a bill of review of this sort, the court will confine its examination to the pleadings and decree in the original action; for no bill lies to correct any errors of fact which were made in examining or weighing the evidence upon which the decree was based.⁹

¹ Sections 543 to 549 of this book; *Wooster v. Handy*, 23 F. R. 49, 1885; *Spill v. Mfg. Co.*, 28 F. R. 870, 1886; *Hill v. Smith*, 32 F. R. 753, 1887; *Ryan v. Gould*, 32 F. R. 754, 1887; *New York Belt-ing Co. v. Rubber Co.*, 32 F. R. 755, 1887.

² *Story's Equity Pleading*, Section 403.

³ *Whiting v. The Bank of the United States*, 13 Peters, 14, 1839.

⁴ *Story's Equity Pleading*, Section 404.

⁵ *Ross v. Prentiss*, 4 McLean, 106, 1846; *Story's Equity Pleading*, Section 405.

⁶ *Thomas v. Harvie's Heirs*, 10 Wheaton, 149, 1825; *McDonald v. Whitney*, 39 F. R. 467, 1889.

⁷ 26 Statutes at Large, p. 826, Ch. 517, Section 11.

⁸ *Southard v. Russell*, 16 Howard, 570, 1853.

⁹ *Whiting v. Bank of the United States*, 13 Peters, 14, 1839; *Story's Equity Pleading*, Section 407.

§ 652. A bill of review, filed to introduce evidence of new facts or of newly discovered facts, cannot be filed without leave of court.¹ Where the case sought to be reviewed has been appealed to the Circuit Court of Appeals, and decided there, the application must be presented to that tribunal.² If that court decides that the leave ought to be granted, it will authorize the court below, to receive and adjudicate the bill of review; and thereafter the case will proceed in the lower tribunal, much as it would have done if no appeal had been taken. After the bill of review has been litigated and a new decree entered, an appeal will lie to the Circuit Court of Appeals on the whole case.

The mode of application for leave to file such a bill, is by a petition stating the original proceedings and the new facts or newly discovered facts, on the strength of which reversal of the decree is prayed.³ The petition must be supported by affidavits stating the exact nature of those facts, in order that the court may judge of their materiality and sufficiency, and showing that they occurred after the final decree was entered, or if they occurred before that time, that they were not discovered, and could not with reasonable diligence have been discovered till afterward.⁴ Petitions of this sort may be filed even more than six months after the entry of the decree, provided they are filed within a reasonable time after the discovery is made, upon which they are based.⁵

Leave to file such a bill will be granted, in a proper case, whether those facts relate to issues in the original action, or relate to defences which were not in issue therein;⁶ but

¹ *Ross v. Prentiss*, 4 McLean, 106, 1846.

² *In re Potts*, 166 U. S. 263, 1897; *Kissinger-Ison Co. v. Bradford Belting Co.*, 123 F. R. 92, 1903.

³ *Massie's Heirs v. Graham's Adm'rs*, 3 McLean, 43, 1842.

⁴ *Story's Equity Pleading*, Sections, 412, 413 and 414.

⁵ *United States v. Samperyac*, *Hemstead's Circuit Court Reports*, 131, 1831.

⁶ *Dexter v. Arnold*, 5 Mason, 313, 1829; *United States v. Samperyac*, *Hemstead's Circuit Court Reports*, 131, 1831; *Story's Equity Pleading*, Sections 415 and 416.

it will not be granted where the facts stated in the petition are not adapted, or are not sufficient, to have altered the decree if they had been before the court on the hearing;¹ nor where those facts could, with reasonable diligence, have been discovered before the decree was entered;² nor to enable the petitioner to introduce evidence to impeach the character of the witnesses upon whose testimony the decree was based; nor to introduce cumulative testimony on a point litigated and decided at the hearing; but newly discovered corroborating evidence in writing, may furnish a foundation for such leave.³

After a bill of review to introduce new facts, or newly discovered facts, has been duly filed, the opposite party may plead or answer thereto, and thus put the party who filed it, to the proof of its allegations.⁴ A demurrer to a bill of this sort is not appropriate, because its sufficiency in point of law must be passed upon before it can be filed.

§ 653. A bill in the nature of a bill of review, differs from a bill of review only in respect of the legal character of the complainant. The latter bill can be filed by either of the parties to the decree which is sought to be reviewed, or by their respective privies in representation, such as heirs, executors, or administrators; but the former is required to be filed, where privies in estate, such as devisees or assignees of an original party, seek to secure the reversal or modification of a final decree after the expiration of the term at which it was entered.⁵ Neither of these sorts of bills is to be confounded with a supplemental bill in the nature of a bill of review. That is still another variety, and its character and operation have already been outlined.⁶

¹ *Dexter v. Arnold*, 5 Mason, 313, 1829.

² *Rubber Co. v. Goodyear*, 9 Wallace, 806, 1869; *Boston & Revere Electric Street-Railway Co. v. Bemis Car-Box Co.*, 98 F. R. 121, 1899; *Kissinger-Ison Co. v. Bradford Belting Co.*, 123 F. R. 92, 1903.

³ *Southard v. Russell*, 16 Howard, 569, 1853.

⁴ *Dexter v. Arnold*, 5 Mason, 309, 1829.

⁵ Story's Equity Pleading, Section 409.

⁶ Sections 647 and 648 of this book.

§ 654. An appeal to the Supreme Court of the United States, can be taken by a complainant whose action for an infringement of a patent, has been dismissed by a Circuit Court, on the ground of want of jurisdiction over the defendant.¹ Where a motion to dismiss an action on that ground has been denied by a Circuit Court, and where a decree has afterward been made against the defendant for infringement, the defendant has a right to have the question of jurisdiction reviewed on an appeal, and also has a right to have reviewed, all the questions which were decided against him in the decree for infringement. In such a case the proper practice is to appeal the whole case to the Circuit Court of Appeals, and then that tribunal will certify the question of jurisdiction to the Supreme Court, and will wait for the answer to that question, before hearing the appeal from the decree of infringement.²

An appeal to a Circuit Court of Appeals is demandable from the final decree of any United States Circuit Court, in any case arising under the patent laws, provided it is taken within six months after the entry of the decree;³ unless the decree involves only a question of jurisdiction; or is only for costs.⁴ But in order to operate as a supersedeas, and thus stay execution, an appeal must be taken within sixty days after the rendition of the decree; and indeed an execution may be issued, if an appeal is not taken within ten days after such rendition.⁵ But in the latter case, a supersedeas afterward obtained will prevent further proceedings under the execution, though it will not interfere with what has already been done.⁶ The time within which appeals may be taken, may properly be held to begin, either when the case is finally decided, or when the formal decree

¹ 26 Statutes at Large, p. 826, Ch. 517, Section 5; *L. E. Waterman Co. v. Parker Pen Co.*, 107 F. R. 141, 1901.

² *Sun Printing & Publishing Ass'n v. Edwards*, 121 F. R. 826, 1903.

³ 26 Statutes at Large, p. 826, Ch. 517, Sections 6 and 11.

⁴ *DuBois v. Kirk*, 158 U. S. 67, 1895.

⁵ Revised Statutes, Sections 1012 and 1007.

⁶ *Board of Commissioners v. Gorman*, 19 Wallace, 663, 1873.

is signed by the judge, and filed with the clerk of the court.¹ When an appeal operates as a supersedeas, it so operates only as against the money recovery provided for in the decree, and not as against that part of the decree which directs the payment of the master's fees,² nor as against that part which directs an injunction to issue;³ but the judge who enters a decree granting an injunction, has discretionary power to suspend or modify the same pending an appeal.⁴

A decision of a United States Circuit Court, not to dismiss a bill for infringement of a patent, upon the motion of a nominal complainant, against the opposition of those equitably entitled to sue in the name of the nominal complainant, is immediately appealable to the Circuit Court of Appeals.⁵ But a decree which sustains part of the claims upon which a bill is based, while dismissing another part of those claims from court, is not appealable by the complainant; for though it is final in respect of the latter, it is only interlocutory in respect of the former, and the right of the complainant to appeal from its final part, is suspended until after an accounting is had on the sustained claim, and a completely final decree is made to dispose of the entire case.⁶

The prosecution of an appeal includes the procurement, from the clerk of the Circuit Court, of a transcript of the record of the case in that court, or of such parts of that record as the parties agree to be sufficient to enable the Circuit Court of Appeals to decide the questions involved in the appeal. Such an agreement must be made as a formal stipulation, and be filed in the office of the clerk of the Circuit Court; and when it is thus made and filed, the clerk will prepare a transcript of the specified parts of the record and will certify it accordingly.⁷

¹ *Silsby v. Foote*, 20 Howard, 290, 1857.

² *Myers v. Dunbar*, 1 Bann. & Ard. 565, 1874.

³ *Whitney v. Mowry*, 3 Fisher, 175, 1867.

⁴ Equity Rule 93.

⁵ *Brush Electric Co. v. Electric*

Co. of San Jose, 51 F. R. 557, 1892.

⁶ *Western Electric Co. v. Williams-Abbott Electric Co.*, 108 F. R. 953, 1901.

⁷ *Lamb Knit Goods Co. v. Lamb Glove & Mitten Co.*, 120 F. R. 273, 1902.

An appeal to the Court of Appeals of the District of Columbia, is demandable from the final decree of the Supreme Court of the District of Columbia, in any case arising under the patent laws.¹ And the law stated in this section, in respect of appeals from a United States Circuit Court to a United States Circuit Court of Appeals, is also applicable to appeals from the Supreme Court of the District of Columbia to the Court of Appeals of the District of Columbia; except in a few particulars of difference, due to differences between the statutes which gave to those appellate courts, their respective beings and jurisdictions.²

§ 655. On the hearing of an appeal in any Circuit Court of Appeals, the decree may generally be attacked by the appellant, upon any ground upon which it was resisted in the court below; and may be supported by the appellee upon any ground in the record, whether the Circuit Court based its decree upon that ground or some other.³ But the decree cannot be assailed on the ground that the court below refused to set aside a decree *pro confesso*,⁴ or refused to allow the appellant to retract an admission which he had made in his pleadings;⁵ or granted or refused a rehearing;⁶ or rendered any other decision which belonged to the judicial discretion of the court to make. Nor can a decree be attacked in the Circuit Court of Appeals, on account of any error made by a master in chancery in taking an account of profits or damages, unless that error was brought before the court below for correction, by means of a proper exception to the master's report;⁷ and not even then, where the alleged error is one of quantity or computation, and is not obvious.⁸ Where a decree

¹ 27 Statutes at Large, Ch. 74, Section 7, p. 435.

² 26 Statutes at Large, p. 826, Ch. 517; 27 Statutes at Large, p. 434, Ch. 74; 31 Statutes at Large, p. 660, Ch. 803.

³ *Electric Gas Lighting Co. v. Fuller*, 59 F. R. 1003, 1894.

⁴ *Dean v. Mason*, 20 Howard, 198, 1857.

⁵ *Jones v. Morehead*, 1 Wallace, 155, 1863.

⁶ *Roemer v. Bernheim*, 132 U. S. 106, 1889; *Boesch v. Graff*, 133 U. S. 699, 1890.

⁷ *Kinsman v. Parkhurst*, 18 Howard, 289, 1855.

⁸ *Warren v. Keep*, 155 U. S. 267, 1894.

is reversed and remanded for further proceedings, and a second decree is entered by the court below after those proceedings are taken, and an appeal is taken from the second decree, that decree cannot be assailed on account of any errors that occurred prior to the former decree.¹ And the decision of the Circuit Court of Appeals on the first appeal is not reviewable on the second appeal to that tribunal.² No decree can be attacked by the appellee, on the appellant's appeal. Where either party to a decree intends to ask the Circuit Court of Appeals to direct it to be altered, he must appeal to that tribunal, whether the other party appeals or not.³ Where both parties appeal, both appeals are heard together in the Circuit Court of Appeals, and the complainant in the court below is entitled to open and to close the argument. A decree may also be attacked by an appellant on several grounds upon which it may not have been resisted in the court below. Non-jurisdiction of equity falls in this category,⁴ where the patent expired before the bill was filed; and so does want of invention, when that want results from facts of which the court will take judicial notice.⁵

Where a defendant interposed several defences in the court below, and where that court held one of them to be good, and therefore dismissed the bill; and where the Circuit Court of Appeals on an appeal, finds the latter defence to be bad, it will thereupon decide whether either of the others are good,⁶ and if it finds either of them to be so, it will affirm the decree.⁷ Or the Circuit Court of Appeals may find a defence to be good, which the court below did not so find, and may thereupon omit to decide upon the defence which the court below

¹ *Himely v. Rose*, 5 Cranch, 313, 1809; *The Santa Maria*, 10 Wheaton, 431, 1825; *American Insurance Co. v. Canter*, 1 Peters, 511, 1828; *Corning v. Troy Iron & Nail Factory*, 15 Howard, 451, 1853.

² *Standard Sewing Mach. Co. v. Leslie*, 118 F. R. 559, 1902.

³ *Corning v. Troy Iron & Nail Factory*, 15 Howard, 451, 1853.

⁴ *Hipp v. Babin*, 19 Howard, 271, 1856.

⁵ *Brown v. Piper*, 91 U. S. 41, 1875.

⁶ *Crown Cork & Seal Co. v. Aluminum Stopper Co.*, 108 F. R. 848, 1901.

⁷ *Corning v. Troy Iron & Nail Factory*, 15 Howard, 451, 1853.

found to be good.¹ And a decree for a complainant may also be sustained on a different ground from that upon which it was based in the court below.² For these reasons, assignments of error must be aimed at the decree of the court, and not at the reasons which were stated by the judge for making that decree.³

§ 656. After the Circuit Court of Appeals has heard an appeal, it may affirm the decree, or may reverse it, or may modify it, or may remand the case to the court below for further proceedings.⁴ Where it affirms the decree, with respect of the merits, it will affirm it also in respect of the costs;⁵ except where the absence of a needed disclaimer necessitates that costs shall not be recovered though the decree is otherwise affirmed.⁶ Where it reverses the decree, it generally does so at the appellee's costs, so that the court below will have nothing to do but to tax those costs, and enter a decree therefor; and from such a decree there is no appeal.⁷ When it modifies the decree, it may do so in either of several respects. For example, it may change the amount of the decree, instead of remanding the case to the court below for a recomputation.⁸ Where it remands a case for further proceedings, those proceedings are guided by the court below, as if it had originally rendered the decision, which was made by the appellate tribunal.⁹ Where both parties appeal from the decree, and the decree is affirmed, no costs incurred in the Circuit Court of Appeals, are allowed to either party.¹⁰

§ 657. A certificate of division of opinion is a means of

¹ Patent Clothing Co. v. Glover, 141 U. S. 560, 1891.

² Woodward v. Boston Lasting Mach. Co., 63 F. R. 609, 1894.

³ Clark v. Deere & Mansur Co., 80 F. R. 534, 1897; Evans v. Sness Glass Co., 83 F. R. 706, 1897.

⁴ Revised Statutes, Section 701.

⁵ Du Bois v. Kirk, 158 U. S. 58, 1895; Sproull v. Pratt & Whitney Co., 108 F. R. 965, 1901.

⁶ Revised Statutes, Section 4922;

O'Reilly v. Morse, 15 Howard, 121, 1853.

⁷ Elastic Fabrics Co. v. Smith, 100 U. S. 111, 1879.

⁸ Parks v. Booth, 102 U. S. 108, 1880; Tuttle v. Claflin, 76 F. R. 237, 1896; Wales v. Waterbury Mfg. Co., 101 F. R. 130, 1900.

⁹ *In re* Chicago Sugar-Refining Co., 87 F. R. 750, 1898.

¹⁰ Edison Electric Light Co. v. Electric Supply Co., 66 F. R. 312, 1895.

taking a question of law to the Circuit Court of Appeals, where that question arises in a case heard by two judges in the court below, and where those judges disagree about its proper solution.¹ No question of infringement or other question of fact can be taken to the Circuit Court of Appeals in this method;² and such a certificate must state the precise points of law which are involved, or the case will be remanded without an answer.³

§ 657*a*. An appeal may be taken from any final decree of the Court of Appeals of the District of Columbia, to the Supreme Court of the United States, in any case wherein is involved the validity of any patent.⁴ But no appeal lies from any Circuit Court of Appeals to the Supreme Court in any patent case,⁵ except actions brought by the United States to repeal patents.⁶

Any Circuit Court of Appeals may certify to the Supreme Court any pure question of law upon which it desires the instruction of that court for its proper decision.⁷ Where a Circuit Court of Appeals sends such a certificate to the Supreme Court, that certificate must clearly and distinctly state whatever question of law is involved therein, and must show that the Circuit Court of Appeals desires to receive instruction from the Supreme Court how to decide that question.⁸

The Supreme Court may send a writ of certiorari, to any Circuit Court of Appeals, requiring any action in equity for infringement of a patent to be sent from the latter tribunal to the Supreme Court, for its review and determination, with the same power and authority as if the case had been carried

¹ Revised Statutes, Section 693; 26 Statutes at Large, p. 826, Ch. 517, Section 11.

² *California Paving Co. v. Mollitor*, 113 U. S. 616, 1384.

³ *Wilson v. Barnum*, 8 Howard, 258, 1850.

⁴ 27 Statutes at Large, Ch. 74, Section 7, p. 435.

⁵ 26 Statutes at Large, p. 826, Ch. 517, Section 6.

⁶ *United States v. Bell Telephone Co.*, 159 U. S. 548, 1895.

⁷ 26 Statutes at Large, Ch. 517, Section 6; *Graver v. Faurot*, 162 U. S. 435, 1896; *Cross v. Evans*, 167 U. S. 60, 1897.

⁸ *Columbus Watch Co. v. Robbins*, 148 U. S. 267, 1893.

by an appeal to the Supreme Court.¹ This power may be exercised before or after any decision of the Circuit Court of Appeals, and irrespective of any such decision, and at any time during the pendency of the case in that tribunal.² But this power is exercised by the Supreme Court, only in cases of great importance; or in cases of conflict between two or more Circuit Courts of Appeals, or between such a court and a State court; or in cases which affect some interest of this nation.³

¹ 26 Statutes at Large, p. 826,
Ch. 517, Section 6.

² *The Three Friends*, 166 U. S.
1, 1897.

³ *Forsyth v. Hammond*, 166 U.
S. 514, 1897.

CHAPTER XXL

INJUNCTIONS.

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§ 658. JURISDICTION to grant injunctions to prevent the violation of patent rights, is conferred by statute upon the same courts that are vested with common law jurisdiction in patent cases.¹ The statute provides that the jurisdiction shall be exercised according to the course and principles of courts of equity, and upon such terms as the court may deem reasonable. This twofold provision indicates the sources from which the existing rules applicable to such cases were drawn. They were drawn from the ordinary course and principles of courts of equity, and from a reasonable contemplation of the peculiar circumstances which attend patent rights and patent litigation. Some of those rules relate only to preliminary injunctions, and others relate to permanent injunctions alone; and the residue are equally applicable to both. It is the plan of this chapter to explain those three classes of rules, and to show how all of them combined make up a system which may guide the judicial discretion in nearly every variety of circumstances.

§ 659. A preliminary injunction is one which is granted after the filing of the bill, and before the case is ready to be decided in respect of its prayer for a permanent injunction,

¹ Revised Statutes, Section 4921.

or in respect of its prayer for profits or for damages. Where a preliminary injunction is granted, it is commonly granted before the filing of the answer; but it is sometimes issued after that stage of the case; and sometimes even after the complainant has introduced all his *prima facie* evidence,¹ and even after all the evidence has been taken, and an interlocutory hearing has been had upon the record of that evidence.²

Such an injunction may be dissolved at any time; and a motion to dissolve it may be made whenever an apparent cause for its dissolution becomes known to the party enjoined. If not sooner terminated by dissolution, or by a certain statutory limitation hereafter explained, such an injunction continues till the interlocutory decree; and then it is dissolved or is made permanent, according to the equities of the case as they appear at that time.

§ 660. A bill of complaint, in order to lay a foundation for a preliminary injunction, must state the prior adjudication or acquiescence upon which the presumption of validity of the patent is based,³ and must contain a specific prayer for that relief, and for the proper writ by means of which that relief may be enforced,⁴ and must conform to those requisites of bills in equity which are set forth in the twentieth chapter of this book.

§ 661. Due notice of a motion for a preliminary injunction must be served on the party sought to be enjoined from infringing a patent, before that motion will be heard by the court. This rule formerly had a sufficient foundation in a statute of 1793, which provided that no writ of injunction should be granted in any case without reasonable previous notice to the adverse party, or his attorney, of the time and place of moving for the same.⁵ Portions of the section which contained that provision are embraced in the Revised Stat-

¹ Union Paper-Bag Machine Co. v. Newell, 11 Blatch. 550, 1874.

² Cimiotti Unhairing Co. v. American Fur Refining Co., 117 F. R. 623, 1902.

³ Parker v. Brant, 1 Fisher, 59, 1850; Wirt v. Hicks, 46 F. R. 71, 1891.

⁴ Lewiston Falls Mfg. Co. v. Franklin Co., 54 Maine, 402, 1867; Union Bank v. Kerr, 2 Maryland Chancery, 460, 1849.

⁵ 1 Statutes at Large, Ch. 22, Section 5, p. 334.

utes,¹ but that provision was omitted from those statutes, and was thereby repealed.² But there is still a foundation for the rule, which is stated at the head of this section; a foundation not so direct, but quite as certain, as the other was while it existed.

The Revised Statutes provide that the Supreme Court shall have power to prescribe from time to time, and in any manner not inconsistent with any law of the United States, the modes of proceeding to obtain relief in suits in equity in the Circuit and District courts.³ In pursuance of this authority, the Supreme Court has prescribed an elaborate code of rules of practice for the courts of equity of the United States. Rule 55 of that series provides that special injunctions shall be grantable only upon due notice to the other party. And it is certain that all injunctions to restrain infringements of patents are special as distinguished from common injunctions.⁴ A different line of argument on this subject, and one followed by a contrary conclusion, is to be found in one reported case,⁵ but the reasoning in that case is not convincing.

§ 662. A motion for a preliminary injunction is heard on *ex parte* affidavits.⁶ The complainant's affidavits in chief must show all the facts which are necessary to *prima facie* entitle him to such an injunction.⁷ The defendant's affidavits must state all the facts upon which he bases his defence to the motion, and if those statements are by way of traverse, no further affidavits are admitted on the hearing; but if they are by way of confession and avoidance, the complainant is permitted to read affidavits in reply, but to that reply no rejoinder from the defendant is ever allowed.⁸

¹ Revised Statutes, Sections 716 and 720.

² Revised Statutes, Section 5596.

³ Revised Statutes, Section 917; *Orr v. Littlefield*, 1 Woodbury & Minot, 19, 1845.

⁴ High on Injunctions, Section 6; *Purnell v. Daniel*, 8 Iredell's Equity Reports (N. C.), 11, 1851.

⁵ *Yuengling v. Johnson*, 1 Hughes, 607, 1877.

⁶ *Grover & Baker Sewing Machine Co. v. Williams*, 2 Fisher, 133, 1860.

⁷ *Union Paper-Bag Machine Co. v. Binney*, 5 Fisher, 167, 1871.

⁸ *Day v. Car-Spring Co.*, 3 Blatch. 154, 1854; *Rogers v. Abbot*, 4 Washington, 514, 1825.

The complainant's bill, if sworn to, may be used as an affidavit;¹ and so also may the defendant's answer, if it is on file when the motion for a preliminary injunction is heard.² But answers are commonly and properly drawn in such general terms, that they are of minor importance as defences to such motions, even where they are well concerted as pleadings. For example, where the answer says, on the question of infringement, that the defendant never made, used or sold any specimen of the patented thing; and where the affidavits of the complainant contain a description of what the defendant has done, and contain proper expert testimony showing that those doings constitute infringement of the patent, the general denial of the answer will go for naught, on the hearing of a preliminary injunction.³ The statements of the complainant's affidavits in chief are taken on the hearing to be true, so far as they are uncontradicted by the affidavits of the defendant;⁴ and the affidavits of the defendant are taken to be true, so far as they are consistent with the complainant's affidavits in chief, and are not contradicted by his affidavits in reply.⁵

All affidavits to be used to support, or to oppose, a motion for a preliminary injunction ought to be served on the opposite counsel a reasonable time before the motion is argued. Where that is not done, the court may reject the affidavits, or, at its discretion, may allow them to be read, giving the opposite party the option to proceed with the hearing, or to take time to examine the affidavits, and where they admit of reply, to take other affidavits for that purpose.⁶

§ 603. Where, on the hearing of a motion for a preliminary injunction, the complainant's moving papers are found to lack a necessary point which is presumably capable of being supplied, the court may suspend the motion to enable

¹ *Young v. Lippman*, 9 Blatch. 277, 1872.

² *Parker v. Brant*, 1 Fisher, 58, 1850.

³ *Ely v. Mfg. Co.*, 4 Fisher, 64, 1860.

⁴ *Wells v. Gill*, 6 Fisher, 89, 1872.

⁵ *Cooper v. Mattheys*, 3 Penn. Law Journal Reports, 40, 1842.

⁶ *Sterrick v. Pugsley*, 1 Central Law Journal, 106, 1874.

the complainant to supply it.¹ And the complainant may withdraw his motion at any time before it would otherwise be decided; even where the defendant objects to that withdrawal, and the complainant does not permanently relinquish his contention.²

If a demurrer is on file in the case when a motion for a preliminary injunction comes on to be heard, the demurrer will be first heard and disposed of, even though that proceeding necessitates a postponement of the hearing of the motion. But if the demurrer is overruled, the defendant, in order to secure leave to contest the motion further, must file an affidavit that the demurrer was not filed for the purpose of delay, and must give security to pay the complainant the amount of any money decree to which the delay consequent upon the demurrer may afterward be found to entitle him.³

§ 664. A temporary restraining order may be made by the court, where there appears to be danger of irreparable injury from delay, whenever notice is given of a motion for a preliminary injunction; and such an order may be granted with or without security, in the discretion of the court, or judge, and will continue in force till the motion is decided.⁴ The object of this provision appears to be to give the judge time to consider whether to grant a preliminary injunction, instead of deciding the question immediately upon the close of the argument of a motion for such a writ. It does not appear to warrant a restraining order before notice is actually served upon the defendant, nor indeed before the motion has been heard by the court, and infringement has been properly proved at that hearing.⁵

§ 665. In deciding whether a complainant at bar has made out a *prima facie* case for a preliminary injunction to restrain infringement of a patent, the judge is guided by the presence or absence of two presumptions and one certainty.

¹ Hodge v. Railroad Co., 6 Blatch. 85, 1868.

² Sprague Electric Motor Co. v. Steel Motor Co., 105 F. R. 959, 1898.

³ Woodworth v. Edwards, 3 Woodbury & Minot, 131, 1847.

⁴ Revised Statutes, Section 718.

⁵ Yuengling v. Johnson, 1 Hughes, 607, 1877.

Those presumptions relate to the validity of the patent and to the defendant's infringement thereof, and that certainty relates to the complainant's title thereto. If that certainty or either of those presumptions is absent in a given case, no preliminary injunction will be granted; but such a writ will be granted where they are all present, unless the defendant interposes some good defence to the motion, or unless the court takes a bond from the defendant, instead of subjecting him to an injunction.

A special presumption that the patent is valid, lies at the foundation of a patentee's right to a preliminary injunction.¹ That presumption does not arise out of the unattended letters patent,² but will always exist where the patent has been suitably adjudicated in a Federal court, and there held to be valid;³ or where the validity of the patent has been suitably acquiesced in by the public;⁴ or where the defendant at bar has allowed a decree *pro confesso* to be taken against him;⁵ or where the defendant does not deny the validity of the patent;⁶ or where he is estopped from doing so;⁷ and that presumption will sometimes exist where the

¹ Edward Barr Co. v. Sprinkler Co., 32 F. R. 80, 1887.

² Foster v. Crossin, 23 F. R. 401, 1885; Dickerson v. Machine Co., 35 F. R. 145, 1888; Standard Elevator Co. v. Crane Elevator Co., 56 F. R. 719, 1893; Smith v. Meriden Britannia Co., 92 F. R. 1003, 1899; Planters' Compress Co. v. Moore & Sons' Co., 106 F. R. 500, 1901; Brunswick-Balke-Collender Co. v. Koehler & Hinrichs, 115 F. R. 649, 1902.

³ Orr v. Littlefield, 1 Woodbury & Minot, 13, 1845; Edison Electric Light Co. v. Beacon Electrical Co., 54 F. R. 679, 1893; Thomson-Houston Electric Co. v. Ohio Brass Co., 78 F. R. 141, 1896; Societe Anonyme v. Allen, 84 F. R. 823,

1897; Adam v. Folger, 120 F. R. 261, 1903.

⁴ Goodyear v. Railroad Co., 1 Fisher, 626, 1853; American Middlings Purifier Co. v. Christian, 3 Bann. & Ard. 48, 1877; White v. Surdam, 41 F. R. 791, 1890; White v. Hunter, 47 F. R. 819, 1891; Sessions v. Gould, 49 F. R. 856, 1892; Palmer v. Mills, 57 F. R. 222, 1893; Corser v. Overall Co., 59 F. R. 781, 1893.

⁵ Schneider v. Bassett, 13 F. R. 351, 1882.

⁶ Sickles v. Mitchell, 3 Blatch. 548, 1857; New York Grape Sugar Co. v. American Grape Sugar Co., 10 F. R. 835, 1882.

⁷ Time Telegraph Co. v. Himmer, 19 F. R. 322, 1884.

patent has successfully undergone an interference or other contested proceeding in the Patent Office.¹

§ 666. An adjudication in another case, in order to furnish a suitable foundation for a right to a preliminary injunction, must have resulted in favor of the patent in a regular hearing in equity, or on the trial of an action at law.² Of these, the former raises the stronger presumption,³ but most of the considerations which apply to it, apply also to the latter. An interlocutory decree in another case is as good a foundation for a right to an injunction as a final decree would be;⁴ because an interlocutory decree settles all pending questions of validity, and a final decree merely reiterates its conclusions on that point. An adjudication of a prior suit based on the first term of a patent, may be made the foundation of a right to a preliminary injunction to restrain infringement of an extended term of the same patent.⁵ But no adjudication of a suit based on an original patent, can be invoked as a basis for a preliminary injunction to restrain infringement of any new claim contained in a re-issue thereof.⁶ Though an injunction in favor of one claim of a patent is a basis for a preliminary injunction on another claim, specifying the same invention in narrower terms.⁷

Where the prior adjudication was that of the Supreme Court or of a Circuit Court of Appeals, it is conclusive of the questions it covered;⁸ and where the prior adjudication

¹ *Pentlarge v. Beeston*, 14 Blatch. 354, 1877; *Smith v. Halkyard*, 16 F. R. 414, 1883; *Consolidated Apparatus Co. v. Brewing Co.*, 28 F. R. 428, 1886; *Minneapolis Harvester Works v. Machine Co.*, 28 F. R. 565, 1886; *Dickerson v. Machine Co.*, 35 F. R. 147, 1888.

² *Doughty v. West*, 2 Fisher, 559, 1865.

³ *Goodyear v. Mullee*, 3 Fisher, 420, 1868.

⁴ *Potter v. Fuller*, 2 Fisher, 251, 1862.

⁵ *Clum v. Brewer*, 2 Curtis, 507, 1855; *Tilghman v. Mitchell*, 4 Fisher, 615, 1871.

⁶ *Poppenhusen v. Falke*, 2 Fisher, 181, 1861.

⁷ *Sawyer Spindle Co. v. Taylor*, 56 F. R. 110, 1893.

⁸ *American Bell Telephone Co. v. McKeesport Tel. Co.*, 57 F. R. 661, 1893; *Edison Electric Light Co. v. Philadelphia Trust Co.*, 60 F. R. 397, 1894.

was that of a Circuit Court, it will be followed, unless it is inconsistent with some other decision of equal or higher rank;¹ and a verdict of a jury, which is supplemented by a refusal to grant a new trial, and by the entry of a judgment thereon, has the same weight as an adjudication in equity.² But a prior adjudication of a court of some foreign nation or dominion, is not controlling, though it is entitled to fair consideration as embodying the opinion of a judicial tribunal.³ And where the prior adjudication was based upon an estoppel,⁴ or upon some other ground than recognized validity of the patent,⁵ it does not constitute any ground for a preliminary injunction against another defendant.

§ 667. Public acquiescence sufficient to create a presumption of validity, and therefore sufficient to furnish a foundation for a right to a preliminary injunction, may arise out of either of two classes of facts. It may arise where the patentees made and sold specimens of the patented article for many years, during which no other person assumed to make any such specimens;⁶ or it may arise where the patentee long licensed others to make, use, or sell such specimens, while nobody assumed to do either without such a license from him; and the acquiescence is quite as positive in this case as in the other.⁷ But acquiescence in exclusive use of a thing which contains several patented inventions, does not raise a special presumption of validity in favor of any particular one of the patents involved;⁸ and when acquiescence stops for good reasons, the special presumption

¹ Pullman Palace Car Co. v. Wagner Palace Car Co., 44 F. R. 765, 1891; Wilgus v. Van Sickle, 99 F. R. 443, 1900.

² Woodard v. Gas-Stove Co., 68 F. R. 717, 1895.

³ Carter v. Wollschlaeger, 53 F. R. 575, 1892.

⁴ Ney Mfg. Co. v. Drill Co., 56 F. R. 153, 1893.

⁵ Empire State Nail Co. v. Button Co., 61 F. R. 650, 1894.

⁶ Sargent v. Seagrave, 2 Curtis,

557, 1855; Covert v. Curtis, 25 F. R. 43, 1885; National Typographic Co. v. New York Typograph Co., 46 F. R. 116, 1891; Blount v. Societe, 53 F. R. 102, 1892.

⁷ Thomson Electric Welding Co. v. Two Rivers Mfg. Co., 63 F. R. 121, 1894.

⁸ Upton v. Wayland, 36 F. R. 691, 1888; Geo. Ertel Co. v. Stahl, 65 F. R. 521, 1895; Welsbach Light Co. v. Benedict & Burnham Mfg. Co., 82 F. R. 748, 1897.

of validity which rested upon it comes also to an end;¹ and mere manufacture and sale of a patented article does not constitute acquiescence in the patent which claims it.²

§ 668. The length of time necessary to make exclusive possession, of the first sort, available on a motion for a preliminary injunction, depends upon the nature of the invention, and on the extent to which a good invention of the sort would naturally be used if it were free to the public; and upon the popularity of that particular invention with that part of the public likely to want an article of that kind.³ Where nobody but the patentee had any use for the article during the time of the alleged acquiescence, or where its merits were prized so low that nobody else cared to adopt it; no lapse of time has any tendency to raise a presumption that the patent is valid.⁴ Acquiescence in claims which nobody cared to dispute when the acquiescence occurred, has no tendency to show that those claims are valid.⁵

But where all persons, other than the owner of the patent, refrain from making, using, or selling specimens of the patented article merely because it is patented, and notwithstanding it would otherwise be for their interest to adopt it, their acquiescence shows their conviction that the patent is valid;⁶ a conviction presumably based on inquiry, because persons are not likely to acquiesce in adverse rights without any investigation of their soundness.⁷ In a case of the latter sort, any acquiescence which is shown by lapse of time to be general and to be genuine, will be sufficient to sustain a preliminary injunction.⁸ Two years have been

¹ *Wollensak v. Sargent*, 33 F. R. 813, 1888.

² *Geo. Ertel Co. v. Stahl*, 65 F. R. 521, 1895.

³ *Doughty v. West*, 2 Fisher, 559, 1865.

⁴ *Raymond v. Woven Hose Co.*, 39 F. R. 366, 1889; *Consolidated Fastener Co. v. American Fastener Co.*, 94 F. R. 523, 1899.

⁵ *Geo. Ertel Co. v. Stahl*, 65 F. R. 521, 1895.

⁶ *National Typographic Co. v. New York Typograph Co.*, 46 F. R. 116, 1891; *Keasbey & Mattison Co. v. Philip Carey Mfg. Co.*, 110 F. R. 747, 1901.

⁷ *Grover & Baker Sewing Mach. Co. v. Williams*, 2 Fisher, 134, 1860.

⁸ *Orr v. Littlefield*, 1 Woodbury & Minot, 17, 1845.

found to be ample in a case where the patentee made and sold 105,000 specimens of his patented apple-paring machine during that time,¹ and in another case, eight years, in which the patentee made and sold 150 specimens of his patented machine for cutting leather for shoe soles, were held to be sufficient.²

§ 669. The length of time necessary to make exclusive possession, of the second sort, available on a motion for a preliminary injunction will depend largely upon whether the licenses granted, were granted in consideration of the payment of substantial royalties, or for such an insignificant price as indicates that they were issued for the sole purpose of raising a presumption of public acquiescence. In the former case, it is safe to assume that sales of licenses will be quite as rapidly efficacious in the desired direction as sales of specimens of the patented invention;³ while in the latter case, a long and genuine payment of royalties will be necessary to give the licenses any importance in respect of preliminary injunctions against third parties.

§ 670. Public acquiescence is strengthened rather than weakened, as a foundation to a right to a preliminary injunction, by the fact that some persons for a while refused to join in it, but on receiving further information, submitted to the exclusive right claimed by the patentee. Such a submission is generally the most persuasive degree of acquiescence,⁴ and is certainly so where the submission was costly to him who submitted.⁵ Nor is universal acquiescence necessary to be shown as existing at the time of the motion; for if it were necessary and were shown, it would prove that the defendant himself is not infringing the patent, and thus negative that part of the foundation of the case.⁶

¹ *Sargent v. Seagrave*, 2 Curtis, 557, 1855.

² *Foster v. Moore*, 1 Curtis, 279, 1852.

³ *Grover & Baker Sewing Mach. Co. v. Williams*, 2 Fisher, 138, 1860.

⁴ *Sargent v. Seagrave*, 2 Curtis,

556, 1855; *Carter v. Wollschlaeger*, 53 F. R. 576, 1892.

⁵ *Corbin Lock Co. v. Yale & Towne Mfg. Co.*, 58 F. R. 565, 1893.

⁶ *McComb v. Ernest*, 1 Woods, 206, 1871; *McDowell v. Kurtz*, 77 F. R. 208, 1896.

But a preliminary injunction will not be granted on any basis of acquiescence, where the defendant has been long in possession and use of the invention, adverse to the claim of the complainant, and under a claim and color of right.¹ No acquiescence in an original patent can be made the basis of a right to a preliminary injunction to restrain infringement of any claim in a reissue of that patent, unless that claim was also contained in the original.² But where some applicable acquiescence is proved, it would be strengthened, as a foundation for a preliminary injunction, by the fact that it has been tried as such a foundation in another case, by basing a preliminary injunction upon it.³

§ 671. A decree *pro confesso* entered in a case, raises a sufficient presumption of the validity of the patent to support a right to a preliminary injunction in that case;⁴ but there is no ground for giving such a decree such an operation in any case against another defendant.⁵

§ 672. A consent decree is one which is entered by the consent of both parties, when the defendant is not in default, and before the judge has decided the case on its merits. A consent decree in a patent case can never be a proper foundation for a right to a preliminary injunction against third persons; unless it appears from the nature of the patented thing, or from convincing evidence, that the defendant consented to the decree because his defence had become hopeless, and not because it had become inexpedient regardless of its strength. This can seldom or never be shown, because the motive of the consenting defendant can seldom or never be known. Consent decrees are therefore useless on motions for preliminary injunctions, against any one other than the consenting defendant, or some one in privity with him.⁶

¹ *Isaacs v. Cooper*, 4 Washington, 259, 1821.

² *Grover & Baker Sewing Mach. Co. v. Williams*, 2 Fisher, 144, 1860.

³ *Blount v. Societe*, 53 F. R. 102, 1893; *Carter v. Wollschlaeger*, 53 F. R. 575, 1892; *Carter-Crume Co. v. Ashley*, 68 F. R. 379, 1895.

⁴ *Schneider v. Bassett*, 13 F. R. 351, 1882.

⁵ *Everett v. Thatcher*, 3 Bann. & Ard. 437, 1878; *American Electrical Novelty Co. v. Newgold*, 99 F. R. 567, 1900.

⁶ *Spring v. Domestic Sewing Machine Co.*, 4 Bann. & Ard. 427, 1879; *Hayes v. Leton*, 5 F. R. 521,

§ 673. Where a defendant admits or does not deny in his pleadings, the validity of the patent upon which a preliminary injunction is sought against him, there seems to be no reason why such an admission or lack of denial should not raise a sufficient presumption of that validity to furnish a foundation to a right to a preliminary injunction in that case.¹ As between the parties to a motion, the court may properly assume every statement of fact to be true which is made by the complainant, and expressly or tacitly admitted by the defendant. And where the validity of a patent is disputed on no ground, except one which is susceptible of an immediate and correct decision, such a decision may be made on a motion for a preliminary injunction, and may result in the granting of the injunction, if the decision is favorable to the patent.²

§ 674. An interference decision of the Patent Office raises a sufficient presumption of validity to furnish a foundation for a preliminary injunction, where the defendant is the person, or the legal representative or assignee of the person who was defeated in the interference, and where he denies the validity of the patent on no other ground than that the decision of the Patent Office on the question of priority in the interference was wrong.³ But such an interference decision cannot be invoked against third parties, because it does not rise to the dignity and force of an adjudication of a court.⁴ And it cannot be invoked as against any defence not involved in it, because it has no relevancy to any such

1881; *De Ver Warner v. Bassett*, 7 F. R. 468, 1881; *Keyes v. Refining Co.*, 31 F. R. 561, 1887; *Wollensak v. Sargent*, 33 F. R. 843, 1888; *Tibbe Mfg. Co. v. Heineken*, 37 F. R. 686, 1889; *Bowers Dredging Co. v. New York Dredging Co.*, 77 F. R. 984, 1896; *Western Electric Co. v. Williams-Abbott Electric Co.*, 83 F. R. 842, 1897.

¹ *New York Grape Sugar Co. v. American Grape Sugar Co.*, 10 F.

R. 835, 1882; *Lane v. Levi*, 104 O. G. 1899, 1903.

² *Foster v. Crossin*, 23 F. R. 400, 1885.

³ *Pentlarge v. Beeston*, 14 Blatch. 354, 1877; *Holliday v. Pickhardt*, 12 F. R. 147, 1882.

⁴ *Edward Barr Co. v. Sprinkler Co.*, 32 F. R. 80, 1887; *Western Electric Co. v. Williams-Abbott Electric Co.*, 83 F. R. 842, 1897; *Wilson v. Consolidated Store Service Co.*, 88 F. R. 288, 1898.

defence.¹ And where the defeated party in the interference, contended in the Patent Office that the patent should not issue to the other party, because the invention was in public use or on sale in this country, more than two years before that party filed his application, the decision of the Patent Office to the contrary, does not raise a sufficient presumption of validity to furnish a foundation for a preliminary injunction against any one.²

§ 675. The complainant's title to the patent upon which a preliminary injunction is asked must be clear, or the injunction will be refused.³ The best evidence of that title is found in the patent, if the complainant is the patentee; but if he is an assignee or grantee of the patentee, he must produce and prove the original assignments or grants which constitute his title, or otherwise prove his ownership.⁴ Where the complainant's title papers require judicial construction, in order to determine their legal effect, it is the duty of the court to give them that construction upon a motion for a preliminary injunction, rather than to postpone the question to a final hearing, unless it is made to appear that evidence *aliunde* is necessary to their proper interpretation.⁵

§ 676. Infringement or danger of infringement by the defendant must be clearly proved by a complainant, in order to entitle him to a preliminary injunction.⁶ Danger of infringement can be proved by evidence that the defendant has advertised infringing articles for sale;⁷ and also by evidence

¹ Greenwood v. Bracher, 1 F. R. 556, 1880.

² Empire State Nail Co. v. American Button Co., 61 F. R. 650, 1894.

³ Mowry v. Railroad Co., 5 Fisher, 587, 1872.

⁴ Section 495 of this book.

⁵ Clum v. Brewer, 2 Curtis, 507, 1855; Dodge v. Card, 2 Fisher, 116, 1860.

⁶ Pullman v. Railroad Co., 5 F. R. 72, 1880; California Electrical Works v. Henzel, 48 F. R. 377, 1891; Standard Elevator Co. v. Crane Elevator Co., 56 F. R. 719,

1893; Brush Electric Co. v. Storage Battery Co., 64 F. R. 776, 1894; Geo. Ertel Co. v. Stahl, 65 F. R. 518, 1895; Western Telephone Construction Co. v. Stromberg, 66 F. R. 551, 1895; Bowers Dredging Co. v. New York Dredging Co., 80 F. R. 120, 1897; Hatch Storage Battery Co. v. Electric Storage Battery Co., 100 F. R. 976, 1900.

⁷ California Electrical Works v. Henzel, 48 F. R. 377, 1891; New York Belting Co. v. Gutta Percha Mfg. Co., 56 F. R. 264, 1892; Sessions v. Gould, 49 F. R. 856, 1892;

that he has in his possession, articles the use of which would infringe the patent on which the suit is based. The first of these items of evidence is conclusive; but the second can be counteracted by proof that there is no intention and no prospect of using or selling the articles in this country, at any time during the life of the patent. And danger of infringement is not proved by evidence that the defendant made, used or sold specimens of the subject of the patent, before the patent was granted.¹

Proof of infringement cannot be made by affidavits which merely state that conclusion of fact. The complainant must prove the specific character of the defendant's doings.² Upon that evidence the court will examine and decide the question of infringement in the light of whatever expert testimony the case may contain,³ and in the light of whatever construction of the patent it finds on examination to be just;⁴ and that construction will generally be guided and governed by the construction which was given to the patent in the adjudicated case upon which the special presumption of validity is based,⁵ and where the facts are substantially the same in the two cases, the former decision will be followed.⁶ But where the question of infringement depends on a new and enlarged construction of the patent, a preliminary injunction will be denied.⁷ And if the court is unable to arrive at a conclusion without the aid of further evidence, it will decline to grant the injunction till that evidence is supplied;⁸ though it may require the defendant to give bonds and to

Thomson-Houston Electric Co. v. Ohio Brass Co., 78 F. R. 139, 1896.

¹ Brill v. St. Louis Car Co., 80 F. R. 910, 1897.

² Kirby Bung Mfg. Co. v. White, 1 McCrary, 160, 1880.

³ Blanchard v. Reeves, 1 Fisher, 105, 1850.

⁴ Many v. Sizer, 1 Fisher, 33, 1849; Clum v. Brewer, 2 Curtis, 507, 1855; Coburn v. Clark, 15 F. R. 807, 1883.

⁵ Mallory Mfg. Co. v. Hickok, 20

F. R. 116, 1884; Carter-Crume Co. v. Ashley, 68 F. R. 379, 1895.

⁶ S. S. White Dental Mfg. Co. v. Johnson, 56 F. R. 263, 1893.

⁷ Thomson-Houston Electric Co. v. Exeter Ry. Co., 110 F. R. 987, 1901.

⁸ United States Annunciator Co. v. Sanderson, 3 Blatch. 186, 1854; Howe v. Morton, 1 Fisher, 600, 1860; Boyd v. McAlpin, 3 McLean, 430, 1844; Carey v. Miller, 34 F. R. 392, 1888; Menasha Wood Split

keep an account of his doings which are alleged to infringe;¹ and the court will not grant a preliminary injunction where the question whether the defendant's doings constitute an infringement of the complainant's patent is a doubtful question.²

In order to entitle the complainant to a preliminary injunction, it is not necessary for him to prove that the defendant's infringement has not ceased before the motion is heard.³ Indeed, no injunction can be averted by affirmative evidence that the defendant has ceased to infringe, even though coupled with a promise that he will infringe no more.⁴ Where the doings of the defendant consisted in selling an article alleged to infringe the complainant's patent, it is immaterial to the motion for a preliminary injunction, whether the sale was made to some stranger, or was made to some agent of the complainant, who bought for the particular purpose of getting evidence of infringement.⁵

Where an infringing act was done before the bill was filed,

Pulley Co. v. Dodge, 85 F. R. 976, 1897.

¹ *Macbeth v. Lippencott Glass Co.*, 54 F. R. 167, 1893.

² *Jenkins v. Ruberg*, 39 F. R. 611, 1889; *Russell v. Hyde*, 39 F. R. 614, 1889; *Boston Electric Co. v. Holtzer*, 41 F. R. 390, 1890; *Judson L. Thomson Mfg. Co. v. Hatheway*, 41 F. R. 520, 1890; *Celluloid Mfg. Co. v. Eastman Dry Plate Co.*, 42 F. R. 159, 1890; *Hammond Buckle Co. v. Goodyear Rubber Co.*, 49 F. R. 274, 1892; *Williams v. McNeely*, 56 F. R. 265, 1893; *Brush Electric Co. v. Storage Battery Co.*, 64 F. R. 775, 1894; *New York Air-Brake Co. v. Westinghouse Air-Brake Co.*, 69 F. R. 715, 1895; *Bowers Dredging Co. v. New York Dredging Co.*, 77 F. R. 984, 1896; *American Pneumatic Tool Co. v. Bigelow Co.*, 77

F. R. 991, 1897; *National Folding-Box & Paper Co. v. Brown & Bailey Co.*, 98 F. R. 437, 1899; *American Sulphite Pulp Co. v. Burgess Sulphite Fibre Co.*, 103 F. R. 981, 1900; *Westinghouse Electric & Mfg. Co. v. American Transformer Co.*, 121 F. R. 560, 1903.

³ *Jenkins v. Greenwald*, 2 Fisher, 37, 1857; *Potter v. Crowell*, 3 Fisher, 112, 1866; *Goodyear v. Berry*, 3 Fisher, 439, 1868.

⁴ *Rumford Chemical Works v. Vice*, 14 Blatch. 179, 1877; *Celluloid Mfg. Co. v. Mfg. Co.*, 34 F. R. 324, 1888; *Gilmore v. Anderson*, 38 F. R. 847, 1889; *White v. Walbridge*, 46 F. R. 526, 1891; *New York Filter Mfg. Co. v. Chemical Bldg. Co.*, 93 F. R. 827, 1899.

⁵ *Chicago Pneumatic Tool Co. v. Philadelphia Pneumatic Tool Co.*, 118 F. R. 852, 1902.

and a preliminary injunction was granted on account thereof; successive preliminary injunctions may be obtained on successive motions therefor, to suppress successive subsequent acts which also infringe, though those subsequent acts differed from what was done before the bill was filed. But where no act was done or was threatened before the bill was filed, which appears to the court to be an infringement of the patent on which the bill was based; no injunction will be granted on that bill, to suppress any doings begun after the beginning of the suit.¹

§ 677. The defences which a defendant may make to a motion for a preliminary injunction may be by way of traverse, or by way of confession and avoidance. A defence of the former sort consists in denying, and attempting to disprove, one or more of the facts which constitute the complainant's *prima facie* case. A denial alone is useless, even where it is embodied in an answer.² Where the denial is supported by affidavits which contradict those of the complainant, the judge will refuse the injunction if he believes the defendant's affidavits to be the true ones, or if he is unable to decide which set of deponents tell the truth.³ No remedy invoked in patent cases is so summary in operation, or so dangerous to justice as a preliminary injunction, and the courts will not apply that remedy to cases where the complainant's *prima facie* evidence of a right thereto, is overthrown or seriously damaged by the evidence of the defendant.⁴

§ 678. Defences by way of confession and avoidance to motions for preliminary injunctions, may confess and avoid the adjudication or acquiescence upon which the plaintiff bases the presumption of the validity of his patent; or may interpose any one of several facts entirely outside of the complainant's *prima facie* case.

§ 679. The effect of an adjudication may be averted by

¹ Westinghouse Air-Brake Co. v. Christensen Engineering Co., 121 F. R. 558, 1903.

² Clum v. Brewer, 2 Curtis, 507, 1855.

³ Cooper v. Mattheys, 3 Penn. Law Journal Reports, 40, 1842.

⁴ Welsbach Light Co. v. Cosmopolitan Gaslight Co., 100 F. R. 650, 1900.

evidence of some good defence to the patent, together with evidence showing that defence not to have been interposed in the prior adjudicated case.¹ Several Circuit Courts and Circuit Courts of Appeals have held that such a new defence must be established beyond a reasonable doubt;² and a new defence, which cannot endure the application of what was decided in the adjudicated case, must fail to avert a preliminary injunction.³ But the effect of a prior adjudication may sometimes be averted by showing that it is inconsistent with a former decision of the court wherein the adjudged case is invoked,⁴ or by showing that the adjudged case has been again taken under advisement in pursuance of a motion for a rehearing,⁵ or has gone no further than a verdict of a jury

¹ *Parker v. Brant*, 1 Fisher, 58, 1850; *Union Paper-Bag Machine Co. v. Binney*, 5 Fisher, 168, 1871; *American Nicolson Pavement Co. v. Elizabeth*, 4 Fisher, 189, 1870; *Bailey Wringing Machine Co. v. Adams*, 3 Bann. & Ard. 97, 1877; *Goodyear v. Allyn*, 6 Blatch. 35, 1868; *Robinson v. Randolph*, 4 Bann. & Ard. 163, 1879; *Page v. Telegraph Co.*, 18 Blatch. 125, 1880; *Ladd v. Cameron*, 25 F. R. 37, 1885; *Fraim v. Iron Co.*, 27 F. R. 457, 1886; *National Machine Co. v. Hedden*, 29 F. R. 149, 1886; *Glaenzer v. Wiederer*, 33 F. R. 583, 1887; *Holmes Protective Co. v. Alarm Co.*, 31 F. R. 562, 1887; *Travers v. Spreader Co.*, 35 F. R. 133, 1888; *Stuart v. Thorman*, 37 F. R. 90, 1888; *Jacobson v. Alpi*, 46 F. R. 767, 1891; *Carter v. Fry*, 54 F. R. 883, 1892; *Bowers v. San Francisco Bridge Co.*, 69 F. R. 644, 1895; *Societe Anonyme v. Allen*, 84 F. R. 823, 1897; *American Sulphite Co. v. Burgess Sulphite Fibre Co.*, 103 F. R. 981, 1900; *Brunswick-Balke-Collender Co. v. Koehler & Hinrichs*, 115 F. R. 648, 1902.

² *Accumulator Co. v. Storage Co.*, 53 F. R. 800, 1893; *Edison Electric Light Co. v. Beacon Electric Co.*, 54 F. R. 679, 1893; *Edison Electric Light Co. v. Electric Mfg. Co.*, 57 F. R. 616, 1893; *Electric Mfg. Co. v. Edison Electric Light Co.*, 61 F. R. 834, 1894; *Philadelphia Trust Co. v. Edison Electric Light Co.*, 65 F. R. 553, 1895; *Allington & Curtis Mfg. Co. v. Lynch*, 71 F. R. 409, 1896; *Tannage Patent Co. v. Adams*, 77 F. R. 192, 1896; *Campbell Printing-Press Co. v. Prieth*, 77 F. R. 977, 1897; *Bowers v. Pacific Coast Co.*, 81 F. R. 569, 1897.

³ *Sawyer Spindle Co. v. Taylor*, 56 F. R. 110, 1892; *Westinghouse Electric & Mfg. Co. v. Royal Weaving Co.*, 115 F. R. 735, 1902.

⁴ *Pullman Palace Car Co. v. Wagner Palace Car Co.*, 44 F. R. 765, 1891.

⁵ *American Graphophone Co. v. Leeds*, 77 F. R. 193, 1896.

which is still pending on a motion for a new trial,¹ or has been taken to a higher court for review.²

But courts will not always disregard adjudications which are thus suspended. They are a good foundation for preliminary injunctions, unless the defendant can convince the judge that they were wrong.³ The effect of a prior adjudication can sometimes be averted by showing that there has been an adjudication against the validity of the patent,⁴ but not where it appears that the lost cause was decided on a part only of the material evidence;⁵ nor can such an effect be averted by showing that the validity of the patent is in question in some other case, which still awaits adjudication.⁶ Where the patent sued upon is a reissue of the one adjudicated, a substantial doubt of the validity of the reissue as a reissue, must be solved against a motion for a preliminary injunction.⁷

§ 680. The effect of acquiescence, as a foundation for a preliminary injunction, may be averted by evidence that it was not general, or was not genuine: by proof that while some acquiesced in the patent, many others did not; or by proof that those who did acquiesce, did so collusively and not because they believed the patent to be invulnerable. And the effect of acquiescence may also be averted by evidence or arguments which clearly show that the patent is really invalid.⁸

§ 681. The fact that the patent in suit will soon expire, is sometimes a reason for granting an injunction rather than

¹ *Day v. Hartshorn*, 3 Fisher, 34, 1855.

² *Bowers Dredging Co. v. New York Dredging Co.*, 77 F. R. 984, 1896.

³ *Forbush v. Bradford*, 1 Fisher, 317, 1858; *Day v. Hartshorn*, 3 Fisher, 32, 1855; *Morris v. Mfg. Co.*, 3 Fisher, 70, 1866; *Wells v. Gill*, 6 Fisher, 89, 1872.

⁴ *Keyes v. Refining Co.*, 31 F. R. 560, 1887.

⁵ *United States Stamping Co. v. King*, 4 Bann. & Ard. 469, 1879.

⁶ *Atlantic Giant Powder Co. v. Goodyear*, 3 Bann. & Ard. 161, 1877; *Allington & Curtis Mfg. Co. v. Lynch*, 71 F. R. 411, 1896.

⁷ *Poppenhusen v. Falke*, 2 Fisher, 181, 1861.

⁸ *Bradley & Hubbard Mfg. Co. v. The Charles Parker Co.*, 17 F. R. 240, 1883; *Hat-Sweat Mfg. Co. v. Sewing Machine Co.*, 32 F. R. 403, 1887.

a reason for refusing that remedy;¹ and sometimes a reason for refusing, rather than granting such a writ.² The fact that the patent sued upon has been repealed, or that it has expired by its own limitation, or because of the expiration of some foreign patent for the same invention, is of course a good defence to a motion for a preliminary injunction; as also is any fact which overthrows the title of the complainant; or any fact which shows the conduct of the complainant or his privies to be unjustifiable in the eye of equity.³ And an injunction will be denied when the patent in suit expired before the decision of the motion, though it had not expired when the motion for the injunction was made.⁴

§ 682. A license is a good defence to a motion for a preliminary injunction; but where a license is disputed, it must be established by a preponderance of proof.⁵ Where the question of license depends upon the construction of documents, the court will construe them on a motion for a preliminary injunction, unless it is made to appear that evidence exists, which is proper and necessary to be produced in order to enable the judge to arrive at the intention of the parties to an ambiguous instrument.⁶ Where the license set up has been forfeited for non-payment of the royalty, a preliminary injunction will be granted, in an otherwise proper case, unless the defendant pays that royalty within some reasonable time to be fixed by the court;⁷ and where it has been forfeited by a forbidden use of the patented thing, a preliminary injunction may be granted as to that use, but not as to the kind of use authorized by the license.⁸ The principle of these pre-

¹ *American Bell Telephone Co. v. Brown Tel. Co.*, 58 F. R. 409, 1893; *Carter-Crume Co. v. Ashley*, 68 F. R. 379, 1895; *Woodard v. Gas Stove Co.*, 68 F. R. 717, 1895.

² *Vermilya v. Erie Railroad Co.*, 89 F. R. 96, 1898.

³ *Western Union Telegraph Co. v. Telegraph Co.*, 25 F. R. 30, 1885.

⁴ *Huntington Dry Pulverizer Co. v. Virginia-Carolina Chemical Co.*, 121 F. R. 136, 1902.

⁵ *Armat Moving Picture Co. v. Edison Mfg. Co.*, 121 F. R. 559, 1902.

⁶ *Hodge v. Railroad Co.*, 6 Blatch. 165, 1868.

⁷ *Woodworth v. Weed*, 1 Blatch. 165, 1846; *Goodyear v. Rubber Co.*, 3 Blatch. 455, 1856.

⁸ *Wilson v. Sherman*, 1 Blatch. 536, 1850.

cedents appears to be that a preliminary injunction will not be used to enforce a forfeiture, when the doings which caused the forfeiture can be otherwise compensated. So, also, a preliminary injunction will be refused where the defendant had a license which he forfeited by omission to pay the royalty, if that omission was necessitated by bad faith on the part of the complainant.¹

§ 683. Estoppel is also a good defence to a motion for a preliminary injunction, and will prevail against a motion for that relief, upon the same facts that would make it prevail in an action at law.²

§ 684. Laches is a good defence to a motion for a preliminary injunction;³ and delay works laches, unless it is excused by some fact which renders it reasonable.⁴ The delay which, if unexcused, works laches in respect of an application for a preliminary injunction, is that which occurs after the infringement sued upon was committed,⁵ and not any delay which occurred before that time. Delay after the infringement, may occur before the suit is brought, or it may occur after that event, and before any motion is made for a preliminary injunction.

Three months' delay of the first kind, for which there was no particular excuse, and which caused no injury to the defendant, has been held not to constitute laches;⁶ and in another case the delay of one year was likewise condoned.⁷ In another case, eighteen months,⁸ and in another two years,⁹

¹ *Crowell v. Parmeter*, 3 Bann. & Ard. 480, 1878; *Washburn & Moen Mfg. Co. v. Barbed Wire Co.*, 22 F. R. 712, 1884; *Washburn & Moen Mfg. Co. v. Security*, 2 F. R. 710, 1884.

² Sections 467 to 470 of this book.

³ *Hockholzer v. Eager*, 2 Sawyer, 363, 1873; *Keyes v. Refining Co.*, 31 F. R. 560, 1887; *Brush Electric Co. v. Storage Battery Co.*, 64 F. R. 777, 1894.

⁴ *Wortendyke v. White*, 2 Bann.

& Ard. 26, 1875; *Green v. French*, 4 Bann. & Ard. 169, 1879; *Collignon v. Hayes*, 8 F. R. 912, 1881.

⁵ *American Middlings Purifier Co. v. Christian*, 3 Bann. & Ard. 50, 1877.

⁶ *Union Paper-Bag Machine Co. v. Binney*, 5 Fisher, 167, 1871.

⁷ *Loring v. Booth*, 52 F. R. 151, 1892.

⁸ *Hockholzer v. Eager*, 2 Sawyer, 363, 1873.

⁹ *Sperry v. Ribbans*, 3 Bann. & Ard. 261, 1878.

and in another three years',¹ and in another five years',² delay after the known beginning of infringement, and before the beginning of a suit, was held to constitute such laches as must defeat a motion for a preliminary injunction; and in still another case a delay of two years by the then owners of the patent, was held to preclude their assignees from obtaining a preliminary injunction.³ Two years' delay to sue was excused in one case on the ground that the complainant was much occupied with other business during the time, and that he repeatedly notified the defendant to cease his infringing;⁴ and in another case a delay of twenty-eight months was excused on the ground that during most of that time the infringement was so small as to be harmless, and was likely to continue so;⁵ but in another case four years' delay was held to be too long to be excused on that ground.⁶ The pendency of a test case under a patent is also a good excuse for delay in bringing actions against other infringers, when those other infringers interpose the defence of laches to a motion for a preliminary injunction.⁷

Two months' unexcused delay after a suit is begun, before a motion for a preliminary injunction is made, is fatal to such a motion, where the delay seriously misleads the defendant;⁸ and delay after a suit is begun will constitute such laches as will defeat an application for a preliminary injunction, if that delay continues till the defendant has closed his evidence for the interlocutory hearing of the

¹ Pope Mfg. Co. v. Johnson, 40 F. R. 584, 1889.

² Blakey v. Kurtz, 78 F. R. 368, 1897.

³ Spring v. Machine Co., 4 Bann. & Ard. 428, 1879.

⁴ Collignon v. Hayes, 8 F. R. 912, 1881.

⁵ Accumulator Co. v. Edison Illuminating Co., 63 F. R. 979, 1894.

⁶ Brush Electric Co. v. Storage Battery Co., 64 F. R. 777, 1894.

⁷ Van Hook v. Pendleton, 1 Blatch. 187, 1846; Rumford Chemi-

cal Works v. Vice, 14 Blatch. 181, 1877; Green v. French, 4 Bann. & Ard. 169, 1879; Colgate v. Gold & Stock Telegraph Co., 4 Bann. & Ard. 425, 1879; Edison Electric Light Co. v. Sawyer-Man Electric Co., 53 F. R. 597, 1892; Edison Electric Light Co. v. Mt. Morris Electric Light Co., 58 F. R. 572, 1893; New York Filter Mfg. Co. v. Loomis-Manning Filter Co., 91 F. R. 421, 1898.

⁸ Ney Mfg. Co. v. Drill Co., 56 F. R. 154, 1893.

case;¹ and still more strongly, when it continues till the case is about to be argued on the interlocutory hearing.²

§ 685. Where the complainant has made out a *prima facie* case for a preliminary injunction, and where the defendant has not overthrown that case, the court is generally bound to grant such an injunction,³ upon all or upon part of the claims of the patent, according to the merits of the case.⁴ The effect of the injunction upon others than the parties to the suit, cannot commonly be considered on such a motion; and while the judges fully appreciate the harsh and arbitrary character of a preliminary injunction in a patent case, they also know the innumerable obstacles which beset a recovery of damages or profits, and that there is generally no adequate remedy for infringement *pendente lite*, other than a preliminary injunction.⁵

But preliminary injunctions are not always made immediately operative. Where an equitable reason for so doing is presented to the court, such an injunction may sometimes be made to take effect a few days,⁶ or even a few months⁷ in the future; and sometimes at graduated future intervals upon distinct parts of the defendant's doings.⁸

So also, under some circumstances, the court can give the defendant the option to submit to such an injunction, or to

¹ *Wooster v. Machine Co.*, 4 Bann. & Ard. 319, 1879.

² *Andrews v. Spear*, 3 Bann. & Ard. 80, 1877.

³ *Gibson v. Van Dresar*, 1 Blatch. 535, 1850; *Sickles v. Mitchell*, 3 Blatch. 548, 1857; *Sickles v. Tilston*, 4 Blatch. 109, 1857; *Potter v. Fuller*, 2 Fisher, 251, 1862; *Conover v. Mers*, 3 Fisher, 386, 1868; *Ely v. Mfg. Co.*, 4 Fisher, 64, 1860; *Rumford Chemical Works v. Vice*, 14 Blatch. 181, 1877; *American Middlings Purifier Co. v. Christian*, 3 Bann. & Ard. 54, 1857; *Green v. French*, 4 Bann. & Ard. 169, 1879; *New York Filter Mfg. Co. v. Niagara Falls Water Works Co.*, 77 F. R.

900, 1896; *Allington & Curtis Mfg. Co. v. Booth*, 78 F. R. 878, 1897; *Pacific Steam Whaling Co. v. Alaska Packers' Ass'n*, 100 F. R. 462, 1900.

⁴ *Colt v. Young*, 2 Blatch. 471, 1852; *Potter v. Holland*, 1 Fisher, 382, 1858.

⁵ *Carter v. Wollschlaeger*, 53 F. R. 576, 1892.

⁶ *Fuller v. Gilmore*, 121 F. R. 129, 1902.

⁷ *American Sulphite Pulp Co. v. Burgess Sulphite Fibre Co.*, 103 F. R. 982, 1900.

⁸ *Westinghouse Air-Brake Co. v. Great Northern Ry. Co.*, 86 F. R. 132, 1898.

give a bond to secure any decree for profits or damages which may ultimately be awarded against him; but a bond can be required only in a case where an injunction must issue if the bond is not given.¹ The circumstances under which it is proper to give the defendant that option include the following.

§ 686. Bonds may be taken, instead of preliminary injunctions being imposed, if the complainant habitually avails himself of his exclusive right by receiving royalties for licenses, rather than by making and selling, or making and using the patented article himself, while permitting no other to do so;² but this course of business of the complainant is not otherwise a defence to a motion for a preliminary injunction.³ And where the complainant is able and willing to supply the market for that article, the fact that the defendant is willing to take a license, and able to pay for one, does not entitle him to the option of giving bonds, if the complainant declines to give him a license.⁴

§ 687. So, also, a defendant may sometimes be entitled to the option of giving bonds instead of being enjoined, where his infringing machinery contains costly parts which are not covered by the complainant's patent;⁵ but he is not thus entitled in all such cases.⁶ And a defendant may be

¹ *Forbush v. Bradford*, 1 Fisher, 317, 1858; *American Middlings Purifier Co. v. Atlantic Milling Co.*, 3 Bann. & Ard. 173, 1877.

² *Howe v. Morton*, 1 Fisher, 601, 1860; *Hodge v. Railroad Co.*, 6 Blatch. 166, 1868; *Dorsey Harvester Rake Co. v. Marsh*, 6 Fisher, 387, 1873; *Colgate v. Gold & Stock Telegraph Co.*, 16 Blatch. 503, 1879; *Kirby Bung Mfg. Co. v. White*, 1 McCrary, 155, 1880; *New York Grape Sugar Co. v. American Grape Sugar Co.*, 10 F. R. 837, 1882; *McMillan v. Conrad*, 16 F. R. 128, 1883; *Eastern Paper Bag*

Co. v. Nixon, 35 F. R. 752, 1888; *Palmer v. Mills*, 57 F. R. 222, 1893.

³ *Kennedy v. Penn. Iron & Coal Co.*, 67 F. R. 340, 1895.

⁴ *Baldwin v. Bernard*, 5 Fisher, 447, 1872; *Westinghouse Air-Brake Co. v. Carpenter*, 32 F. R. 545, 1887.

⁵ *Howe v. Morton*, 1 Fisher, 587, 1860; *Stainthorp v. Humiston*, 2 Fisher, 311, 1862; *Eagle Mfg. Co. v. Plow Co.*, 36 F. R. 907, 1888.

⁶ *Edison Electric Light Co. v. Sawyer-Man Electric Co.*, 53 F. R. 597, 1892.

entitled to that option where the infringing article was purchased in good faith, having been constructed in conformity to a junior patent;¹ or where it was so constructed by the defendant himself; or where the defendant is only a seller,² or only a user,³ of specimens of the patented article, a suit being pending against the manufacturer from whom he received those specimens; or where the prior adjudication, upon which the right to a preliminary injunction is based, has been appealed to a higher court, and is still pending there;⁴ or where new evidence is to be taken for the interlocutory hearing;⁵ or where the patent in suit will soon expire;⁶ or where the injunction, if granted, would be very damaging to the interests of the defendant, and not particularly beneficial to the legitimate rights of the complainant;⁷ or where public policy forbids a discontinuance of the defendant's use of the patented invention;⁸ or where the complainant does not himself employ the invention;⁹ or where, for any reason, a preliminary injunction would operate unjustly.¹⁰ It is no part of the legitimate office of a preliminary injunction to force the defendant to compromise a dis-

¹ *United States Annunciator Co. v. Sanderson*, 3 Blatch. 184, 1854.

² *Irwin v. McRoberts*, 4 Bann. & Ard. 414, 1879.

³ *Westinghouse Air-Brake Co. v. Burton Stock-Car Co.*, 77 F. R. 301, 1896.

⁴ *Wells v. Gill*, 6 Fisher, 93, 1872.

⁵ *Norton v. Automatic Can Co.*, 61 F. R. 296, 1894.

⁶ *National Cash-Register Co. v. Navy Cash-Register Co.*, 99 F. R. 565, 1900.

⁷ *Morris v. Mfg. Co.*, 3 Fisher, 68, 1866; *Morris v. Shelbourne*, 4 Fisher, 377, 1871; *Dorsey Harvester Rake Co. v. Marsh*, 6 Fisher, 387, 1873; *Kirby Bung Mfg. Co. v. White*, 1 McCrary, 155, 1880; *Hoe v. Boston Daily Advertiser*, 14 F.

R. 914, 1883; *Consolidated Roller Mill Co. v. Richmond Mill Works*, 40 F. R. 474, 1889; *Edison Electric Light Co. v. Mt. Morris Electric Light Co.*, 58 F. R. 575, 1893; *Duplex Printing-Press Co. v. Campbell Printing-Press Co.*, 69 F. R. 256, 1895; *Huntington Dry-Pulverizer Co. v. Alpha Portland Cement Co.*, 91 F. R. 534, 1899; *Aquarama Co. v. Old Mill Co.*, 124 F. R. 233, 1903.

⁸ *Guidet v. Palmer*, 10 Blatch. 220, 1872.

⁹ *Hoe v. Knap*, 27 F. R. 212, 1886.

¹⁰ *Union Paper Bag Machine Co. v. Binney*, 5 Fisher, 169, 1871; *National Cable Ry. Co. v. Sioux City Cable Ry. Co.*, 42 F. R. 685, 1890.

puted claim,¹ nor to compel him to give the complainant a contract to purchase specimens of the patented thing.²

But in the absence of every special reason for giving the defendant the option of giving bonds, instead of submitting to an injunction, that option cannot be demanded by him,³ nor ought it to be granted by the court.⁴ Where the defendant is entitled to the option of giving bonds or being enjoined, and chooses the former alternative, but is unable to furnish the bonds promptly, an injunction may issue against him, coupled with an order for its dissolution whenever the proper bonds are approved and filed.⁵

§ 688. Bonds may be required from a complainant, under some circumstances, before a preliminary injunction will be granted.⁶ Such bonds are conditioned on the ultimate success of the complainant in sustaining his claim, and may be required in a case where the injunction, if granted, will cause serious injury to the defendant.⁷ If that is also a case where the defendant is entitled to avert the injunction by giving a bond, that option will first be given to him. If he chooses to file a bond, of course none will be required from the other side; but if he prefers to submit to an injunc-

¹ *Morris v. Mfg. Co.*, 3 Fisher, 70, 1866.

² *American Nicolson Pavement Co. v. Elizabeth*, 4 Fisher, 197, 1870.

³ *Consolidated Fruit-Jar Co. v. Whitney*, 1 Bann. & Ard. 361, 1874.

⁴ *Gibson v. Van Dresar*, 1 Blatch. 532, 1850; *Tracy v. Torrey*, 2 Blatch. 275, 1851; *Tilghman v. Mitchell*, 4 Fisher, 615, 1871; *McWilliams Mfg. Co. v. Blundell*, 11 F. R. 419, 1882.

⁵ *Brooks v. Bicknell*, 3 McLean, 250, 1843; *Foster v. Moore*, 1 Curtis, 279, 1852; *Howe v. Morton*, 1 Fisher, 586, 1860; *Stainthorp v. Humiston*, 2 Fisher, 311, 1862;

Goodyear v. Hills, 3 Fisher, 134, 1866; *Sykes v. Manhattan Co.*, 6 Blatch. 496, 1869; *Gilbert & Barker Mfg. Co. v. Bussing*, 12 Blatch. 426, 1875.

⁶ *Tobey Furniture Co. v. Colby*, 35 F. R. 594, 1888; *Brush Electric Co. v. Accumulator Co.*, 50 F. R. 833, 1892; *Accumulator Co. v. Storage Co.*, 53 F. R. 800, 1893; *Columbia Wire Co. v. Freeman Wire Co.*, 71 F. R. 302, 1895.

⁷ *Orr v. Littlefield*, 1 Woodbury & Minot, 20, 1845; *Brammer v. Jones*, 3 Fisher, 340, 1867; *Shelly v. Brannan*, 4 Fisher, 198, 1870; *Consolidated Fruit-Jar Co. v. Whitney*, 1 Bann. & Ard. 361, 1874.

tion, the injunction will be granted only upon the filing of a proper indemnity bond by the complainant.

§ 689. A preliminary injunction cannot be averted on the sole ground that an action at law for the damages to be caused by the infringement would be a plain, adequate and complete remedy therefor.¹ In many cases that would not be true, and the court cannot determine on affidavits whether it would be true in a particular case or not. A motion for a preliminary injunction is not to be defeated on a possibility that the complainant might be able to obtain damages for the wrong which he seeks to prevent.²

But even where it is plain that the damages recoverable in an action at law would be as beneficial to the complainant as an injunction would be, that fact does not oust the right of the complainant to the latter relief. The case is analogous to actions in equity for the specific performance of contracts to sell real property. The bills in such cases seldom show, and never are required to show, that an action at law for damages would not be a plain, adequate and complete remedy for the failure to perform. "Ordinarily a vendor, in the recovery of pecuniary damages, has an adequate remedy at law, but he has a choice of remedies. He may resort either to a court of law or a court of equity."³ Bills for preliminary injunctions in patent cases are never obnoxious to Section 723 of the Revised Statutes, because the word "case" in that section is to be interpreted specifically and not generically. "Suits in equity shall not be sustained in either of the courts of the United States in any case where a plain, adequate and complete remedy may be had at law."⁴ This statute regards an action in equity to restrain infringement of a patent, as a case for an injunction, and not merely as a patent case. It therefore opposes no obstacle to the jurisdiction of equity in such a case.

§ 690. Where the defendant withdraws his opposition to a motion for a preliminary injunction before the motion is

¹ *General Electric Co. v. Wise*,
119 F. R. 924, 1903.

² *Allington & Curtis Mfg. Co. v. Booth*, 78 F. R. 879, 1897.

³ *Crary v. Smith*, 2 Comstock
(N. Y.), 62, 1848.

⁴ Revised Statutes, Section 723.

decided, the injunction may be granted by consent; but the court will decline to render a decision.¹ That is to say: a consent decree will be entered as a consent decree, and not as one based on a conclusion of the judicial mind. If this rule were otherwise, parties between whom there continued to be no real contest, might manage to secure decisions from courts which would operate to their mutual advantage, and to the serious disadvantage of strangers to the litigation.

§ 691. The discretion of the court was said in some of the earlier cases to be the criterion of judgment when deciding motions for preliminary injunctions in patent cases. The doctrine was a necessity in the beginning of the evolution of the patent laws, because the judges could then find but few precedents to guide or to warn. At present the fact is otherwise. Approved precedents can now be found on nearly every point that can arise.

§ 692. A motion to dissolve a preliminary injunction may be made at any time,² upon reasonable notice to the complainant's solicitor;³ and it will be promptly granted where the judge becomes convinced that the granting of the injunction was erroneous in point of law,⁴ or where the defendant positively proves any fact which would have been fatal to the motion for the preliminary injunction, if presented at the time that motion was heard, and shows that the evidence could not with reasonable diligence have been presented at that hearing.⁵ So, also, a dissolution of a preliminary injunction may be based on a fact which arose

¹ *American Middlings Purifier Co. v. Vail*, 15 Blatch. 315, 1878.

² *Minturn v. Seymour*, 4 Johnson's Chancery (N. Y.), 173, 1819; *Cammack v. Johnson*, 2 New Jersey Equity, 163, 1839; *Jones v. Bank*, 5 How. (Miss.) 43, 1840; *Timolat v. Philadelphia Pneumatic Tool Co.* 123 F. R. 899, 1902.

³ *Wilkins v. Jordan*, 3 Washington, 226, 1813; *Caldwell v. Waters*,

⁴ *Cranch's Circuit Court Reports*, 577, 1835.

⁴ *Steam Gauge & Lantern Co. v. Miller*, 11 F. R. 719, 1882.

⁵ *Woodworth v. Rogers*, 3 Woodbury & Minot, 135, 1847; *Hussey v. Whiteley*, 2 Fisher, 125, 1860; *Young v. Lippman*, 5 Fisher, 230, 1872; *Carey v. Spring Bed Co.*, 26 F. R. 38, 1886; *Huntington v. Heel Plate Co.*, 33 F. R. 838, 1888; *Electrical Accumulator Co. v. Julien Electric Co.*, 47 F. R. 892, 1891.

after the injunction was granted: for example on the fact that the complainant, after that event, assigned all his interest in the future duration of the patent to another;¹ or on the fact that he omitted to prosecute his case toward an interlocutory hearing with the speed which the rules of court require;² or on the fact that the complainant advertised the injunction falsely for effect upon strangers to the suit;³ or on the fact that the prior adjudication, upon which the injunction was based, has been reversed on an appeal.⁴

§ 693. A motion to dissolve an injunction for error in point of law, must be based on a point which was established after the injunction was granted, or which was obviously overlooked or misweighed by the judge at that time. It would be unprofessional as well as unavailing for counsel to move a dissolution, on the ground that the judge wrongly reasoned out his conclusion from the premises from which he proceeded. Courts ought not to be asked to change their judgments on points of law, unless the law has changed or been newly formulated in the mean time, or unless some special error can be pointed out. Few things are more trying to the patience of judges, or more useless to the interests of clients, than the repetition of old and well-understood arguments.

§ 694. A motion to dissolve an injunction on account of newly discovered facts, requires the mover to assume the burden of establishing those facts; because when an injunction is once granted, it is presumed to have been granted rightfully, until the contrary is made to appear.⁵

Affidavits and other evidence to disprove the statements of fact, contained in the moving papers of the defendant, may be introduced by the complainant; and counter evi-

¹ Parkhurst v. Kinsman, 1 Blatch 489, 1849; Edison Electric Light Co. v. Buckeye Electric Co., 59 F. R. 699, 1894.

² Robinson v. Randolph, 4 Bann. & Ard. 318, 1879; Antidel v. Chicago Hotel Cabinet Co., 89 F. R. 311, 1898.

³ Consolidated Fastener Co. v. Toppen, 113 F. R. 697, 1901.

⁴ Prieth v. Campbell Printing-Press Co., 80 F. R. 539, 1897.

⁵ Woodworth v. Rogers, 3 Woodbury & Minot, 143, 1847.

dence from the defendant is then admissible to disprove the complainant's answering allegations. After this, it becomes the duty of the judge to balance the documents and ascertain where the weight of them is;¹ and he will decide the motion against the mover, unless his papers preponderate.² Service on the opposite party, before the motion is heard, of the affidavits upon which a motion to dissolve an injunction is made or is resisted, seems to be called for by the same reasons which call for similar service of the affidavits upon which motions for preliminary injunctions are based or are withstood.³

§ 695. A motion to reinstate a dissolved injunction may be made at any time; but it will not be granted on the same state of the case as that which existed when the injunction was dissolved. So, also, a reinstated preliminary injunction may be again dissolved on any new state of facts which show that its continuation would be unjust.⁴ In patent cases, however, it will seldom occur that the alternate process of issuing and dissolving preliminary injunctions can be carried further than the first dissolution. After that, the court will let the matter rest till the interlocutory hearing, unless a case of great clearness and pressing necessity is presented for further preliminary action.

§ 696. While an injunction is in force, it must be obeyed, even though it ought never to have been granted.⁵ But an injunction is not in force if it was issued against a defendant over whom the court had no jurisdiction. No court has any authority to issue an injunction against such a person. And where courts act without authority, their orders are nullities. They are not voidable, but simply void.⁶ It fol-

¹ *Woodworth v. Rogers*, 3 *Woodbury & Minot*, 144, 1847.

² *Sparkman v. Higgins*, 1 *Blatch*, 207, 1849.

³ Section 662 of this book.

⁴ *Tucker v. Carpenter*, 1 *Hempstead*, 441, 1841.

⁵ *Moat v. Holbein*, 2 *Edwards' Chancery* (N. Y.), 188, 1834; *Sulli-*

van v. Judah, 4 *Paige* (N. Y.), 444, 1834; *Richards v. West*, 2 *Green's Chancery* (N. Y.), 456, 1836; *People v. Sturtevant*, 5 *Selden* (N. Y.), 263, 1853; *Erie Railway Co. v. Ramsay*, 45 *New York*, 637, 1871.

⁶ *Elliot v. Peirsol*, 1 *Peters*, 340, 1828; *Wilcox v. Jackson*, 13 *Peters*, 511, 1839.

lows from these rules, that if a Federal court were to issue an injunction against a defendant before he is served with a *subpœna ad respondendum* in the case, that injunction would be void and could safely be disregarded;¹ but where an injunction is granted after such service, and upon due notice of the motion therefor, it must be obeyed, no matter how obviously unjust and unwarrantable its granting may have been.

An injunction is binding upon all persons who were connected with the defendant in defending against the suit, before the injunction was issued, and who were also connected with the defendant in disobeying that injunction, after being informed of its issue; though they were not themselves defendants to the suit nor served with the injunction writ.² But a mere order for an injunction, upon which no writ of injunction is ever issued, is not binding upon anybody.³ Though a writ of injunction when it is served, may retroact to cover disobedient doings, which occurred after the doer learned that an order for that writ had been made, and before the writ could be drawn up, and be executed, and be issued, and be served upon the defendant.

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.⁴

§ 696a. An appeal is demandable to the Circuit Court of

¹ Sickles v. Borden, 4 Blatch. 14, 1857; Section 661 of this book.

² *In re* Lennon, 166 U. S. 548, 1897; Phillips v. Detroit, 3 Bann. & Ard. 150, 1877; Stahl v. Ertel, 62 F. R. 922, 1893; United States Playing-Card Co. v. Spalding, 92 F. R. 368, 1899.

³ McCormick v. Jerome, 3 Blatch. 486, 1856; Whipple v. Hutchinson, 4 Blatch. 191, 1858.

⁴ Lexington & Ohio Railroad Co. v. Applegate, 8 Dana (Ken.) 289, 1839; Sturgis v. Knapp, 33 Vermont, 486, 1860; McKay v. Jackman, 16 Reporter, 164, 1883.

Appeals, from any order of a Circuit Court which grants, or continues, 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, or the appellate court, or one of the judges of the latter, so orders.¹ 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 any judge of the court which granted the injunction.²

The decision of an appeal from an order granting a preliminary injunction, primarily depends upon the question of the providence of the injunction;³ and that question may or may not depend, according to circumstances, upon the ultimate merits of the case.⁴ 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;⁵ but where it was plainly wrong or insufficient, it

¹ 31 Statutes at Large, Ch. 803, p. 660.

² *In re Haberman Mfg. Co.*, 147 U. S. 529, 1893.

³ *Southern Pacific Co. v. Earl*, 82 F. R. 690, 1897; *Pacific Steam Whaling Co. v. Alaska Packers' Ass'n*, 100 F. R. 462, 1900; *Welsbach Light Co. v. Cosmopolitan Light Co.*, 104 F. R. 85, 1900; *Stearns-Roger Mfg. Co. v. Brown*, 114 F. R. 939, 1902; *F. C. Austin Mfg. Co. v. American Wellworks*, 121 F. R. 77, 1902.

⁴ *Blount v. Societe*, 53 F. R. 98, 1892; *Consolidated Electric Storage Co. v. Accumulator Co.*, 55

F. R. 485, 1893; *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 80 F. R. 730, 1897; *American Fur Refining Co. v. Cimiotti Unhairing Co.*, 118 F. R. 838, 1902.

⁵ *American Paper Pail Co. v. National Folding Box Co.*, 51 F. R. 232, 1892; *Duplex Printing-Press Co. v. Campbell Printing-Press Co.*, 69 F. R. 255, 1895; *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 80 F. R. 730, 1897; *Consolidated Fastener Co. v. Littauer*, 84 F. R. 164, 1897; *Societe Anonyme v. Allen*, 90 F. R. 815, 1898; *Consolidated Fastener Co. v. Hays*, 100 F. R. 984, 1900.

will not be followed.¹ 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.²

The Circuit Court of Appeals, on an appeal from an order granting a preliminary injunction, may not only reverse that order, but may also direct the court below to dismiss the bill of complaint.³ But that direction will be given only where the facts before the Circuit Court of Appeals, conclusively show that further litigation cannot ultimately result otherwise than in such a dismissal.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

¹ *Curtis v. Overman Wheel Co.*, 58 F. R. 784, 1893; *Thomson-Houston Electric Co. v. Hoosick Ry. Co.*, 82 F. R. 461, 1897; *Rubens v. Wheatfield*, 93 F. R. 681, 1899.

² *Ganewell Fire-Alarm Telegraph Co. v. Municipal Signal Co.*, 61 F. R. 203, 1894; *National Folding-Box & Paper Co. v. Robertson*, 104 F. R. 552, 1900.

³ *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S. 495, 1900.

⁴ *Brill v. Peckham Motor Truck Co.*, 189 U. S. 63, 1903.

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

Bissell Carpet-Sweeper Co. v. Goshen Sweeper Co., 72 F. R. 551, 1896.

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

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

decided that there is no such exception; because such an exception would practically prolong many patents beyond the statutory term thereof; and because damages are a sufficient remedy for such unlawful making.¹ And certainly 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 F. R. 894, 1888.

² *White v. Walbridge*, 46 F. R. 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 F. R.

488, 1888; *Wirt v. Hicks*, 46 F. R. 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 F. R. 231, 1888; *Norton v. Automatic Can Co.*, 45 F. R. 638, 1891; *California Electrical Works v. Henzel*, 48 F. R. 377, 1891; *Henzel v. California Electrical Works*, 51 F. R. 754, 1892; *Winchester Arms Co. v. American Buckle Co.*, 54 F. R. 711, 1893; *New York Filter Mfg. Co. v. Chemical Bldg. Co.*, 93 F. R. 827, 1899.

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 F. R. 269, 1893.

³ *Ballard v. Pittsburg*, 12 F. R. 783, 1882.

⁴ *Brown v. Deere*, 6 F. R. 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; *Edison v. American Mutoscope Co.*, 110 F. R. 660, 1901; Section 644*a* 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.

§ 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.

§ 705. Injunctions to restrain infringements of patents may be granted independent of all other relief;³ and an injunction may also be granted to restrain a complainant from bringing an action at law against the defendant, for the same infringements as any of those covered by the action in equity.⁴ But no injunction will be issued on account of an infringement which is so trivial as to be below the dignity of the

¹ *Munson v. New York*, 19 F. R. 313, 1884; *Equity Rule 93*. *Co. v. McCready*, 17 Blatch. 291, 1879.

² Sections 647 to 653 of this book.

⁴ *Morss v. Knapp*, 35 F. R. 218,

³ *American Cotton Tie Supply* 1888.

court;¹ nor to restrain a junior patentee from bringing actions on his patent, while that patent is still free from an adjudication of invalidity.²

Whether it is proper to issue an injunction, 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; is a question upon which the decisions which have now accumulated, are conflicting.³

§ 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;⁴ and surely no such writ will be made to apply to such use or sale of unpatented parts of an infringing combination.⁵ Indeed, no injunction ought in any case to continue after the expiration of the patent.⁶ 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 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,

¹ Lowell Mfg. Co. v. Hartford Carpet Co., 2 Fisher, 472, 1864; Wickwire v. Wire Fabric Co., 41 F. R. 36, 1889.

² Asbestos Felting Co. v. Salamander Felting Co., 13 Blatch. 453, 1876.

³ Birdsall v. Mfg. Co., 1 Hughes, 64, 1877; Allis v. Stowell, 16 F. R. 788, 1883; Ide v. Engine Co., 31 F. R. 901, 1887; National Cash Register Co. v. Boston Cash Recorder Co., 41 F. R. 51, 1889;

Kelly v. Ypsilanti Dress-Stay Co., 44 F. R. 19, 1890; American School-Furniture Co. v. J. M. Sauder Co., 106 F. R. 732, 1901.

⁴ Gamewell Fire-Alarm Tel. Co. v. Municipal Signal Co., 61 F. R. 208, 1894; National Folding Box & Paper Co. v. Robertson, 104 F. R. 552, 1900.

⁵ Johnson v. Brooklyn Co., 37 F. R. 147, 1888.

⁶ Westinghouse v. Carpenter, 43 F. R. 894, 1888.