

If a licensee continues to use the thing patented after a reissue, and to account for the royalty, he can not escape his obligation on account of such reissue. *Gaylord v. Case*, 1 C. L. B. 382.

If a licensee, after full opportunity of judging of the character of the thing patented, and of the value of the privilege, enters into a compromise with the licensor, and fully enjoys everything for which he stipulates in such compromise without interruption, he is estopped to deny a consideration for a note given on such compromise. *Davis v. Gray*, 17 Ohio St. 330.

If the defendant has actually received profits from sales of the patented machine, under an agreement with the patentee, and the profits are not in any way liable to be affected by the invalidity of the patent, its validity is immaterial. Moreover the defendant is estopped from alleging that invalidity. If he has sold the machines under the patentee's title and for his account, he can no more be allowed to deny that title and retain the profits to his own use, than an agent who has collected a debt for his principal can insist on keeping the money upon an allegation that the debt was not justly due. The invalidity of the patent does not render the sales of the machine illegal so as to taint with illegality the obligation of the defendant to account. It is simply a question of failure of title, and when that does not appear in any manner to have affected the profits which the defendant received, there can be no ground to allow it to be shown in defense. *Kinsman v. Parkhurst*, 18 How. 289; s. c. 1 Blatch. 488.

A party who holds a license to use a patented machine can not repudiate the contract while continuing to use the machine. The contract can not be terminated unless the licensee ceases to use the machine. *Sherman v. Champlain Co.* 31 Vt. 162.

If a licensee avails himself of the invention so as to earn the royalty without offering to surrender his license, he is estopped to impeach the validity of the patent. *Gaylord v. Case*, 1 C. L. B. 382; *Magic Ruffle Co. v. Elm City Co.* 13 Blatch. 151; s. c. 8 O. G. 773; *Birdsall v. Perego*, 5 Blatch. 251; *Marsh v. Dodge*, 6 T. & C. 568; s. c. 11 N. Y. Supr. 278.

If the complainant seeks to nullify a contract on account of a breach of its terms, the defendant will not be estopped by its recitals from denying the validity of the patent. *Burr v. Duryee*, 2 Fish. 275; s. c. 1 Wall. 531; *contra*, *Brooks v. Stolley*, 3 McLean, 523.

The acceptance of a license for a certain term is not an acknowledgment of the right of the licensor beyond the termination of the license. *Rich v. Atwater*, 16 Conn. 409.

In an action of covenant to recover the royalty for machines actually sold thereunder, the covenantee can not set up the defense of the invalidity of the patent. Such a defense is not consistent with the relation of the defendant to the plaintiff. *Wilder v. Adams*, 2 W. & M. 329; *Sargent v. Larned*, 2 Curt. 340; *Marsh v. Dodge*, 6 T. & C. 568; s. c. 11 N. Y. Supr. 278.

If a licensee does all that lies in his power to restore the patentee to the same condition he was in before the contract, he may cease to act under the contract, and take issue with the patentee as to the validity of the exclusive right which he claims by virtue of his patent. *Sherman v. Champlain Co.* 31 Vt. 162.

Forfeiture of License.

Where the grant of a license is absolute, a violation of the patent outside of the license does not work a forfeiture of the right conveyed. *Wood v. Wells*, 6 Fish. 382.

If a contract is partly executed, a failure on the part of the licensee to fulfill it will not of itself operate to annul and cancel the agreement. *Gibson v. Barnard*, 1 Blatch. 388.

If the terms of the license make the performance of its stipulations by the licensee a condition to his continued use of the thing patented, he forfeits his rights by a breach of the stipulations. *Brooks v. Stolley*, 3 McLean, 523; *Woodworth v. Cook*, 2 Blatch. 151.

If a license has been forfeited by a failure to comply with the conditions upon which it was granted, the licensee, by acquiescing in a claim of forfeiture, will be deemed to abandon the license. *Kittle v. Frost*, 5 Fish. 213; S. C. 9 Blatch. 214.

If a contract is forfeited by a breach of a condition, the licensee is remitted to his original position and rights, as the contract must be avoided altogether if at all. It can not be obligatory upon the one party and not upon the other. *Woodworth v. Cook*, 2 Blatch. 151.

If a licensee neglects to pay his license price for a long time, and finally, when prosecuted, abandons his license, or, while relying upon it, defends also upon other grounds, the license will be forfeited and he will be liable as an infringer. *Bell v. McCullough*, 1 Fish. 380; S. C. 1 Bond, 194.

A notice alleging a breach of a license, and forbidding the licensee to use or exercise the right granted by the license for any purpose whatever, does not *ipso facto* annul the license, and the licensor may recover his royalty if the licensee still continues the use. *Union Manuf. Co. v. Lounsbury*, 42 Barb. 125; S. C. 41 N. Y. 363.

Joint Owners.

It is competent for two persons, being joint owners of letters patent, whether valid or invalid, to enter into a copartnership for the manufacture and sale of the invention, and to stipulate that one of them alone shall conduct the business. This is a provision for the prosecution of the business in a particular mode, and not for its restraint. *Kinsman v. Parkhurst*, 18 How. 289; S. C. 1 Blatch. 488.

Where no agreement of copartnership exists, the relation of copartners does not result from a connection as joint patentees. The grant is to the patentees jointly, and not to either severally. *Pitts v. Hall*, 3 Blatch. 201.

Joint owners of a patent right, in the absence of express covenants, have interests which are distinct and separate in their nature, though they are derived from the same contract. Each party is at liberty to use his moiety as he may think fit, in the territory covered by the assignment, and will not incur any obligation to the other either for profits or losses. *Vose v. Singer*, 86 Mass. 226; *De Witt v. Elmira Nobles Manuf. Co.* 12 N. Y. Supr. 301; *vide* *Parkhurst v. Kinsman*, 6 N. J. Eq. 600.

Where there are several patentees, they are tenants in common. One of

them has no superiority of right over another. One of them can manufacture and use the article patented without the consent of the others. *Dunham v. Ind. & St. Louis R. R. Co.* 9 C. L. N. 50.

One of two joint owners can legally grant, assign, license or sell his own share or right in the patent. *May v. Chaffee*, 5 Fish. 160; s. c. 2 Dillon, 385.

One joint owner can legally grant, assign, license or sell only in respect to his own share or right. He can not sell and give a good title to his co-owner's right, for the same reason that one joint owner of a chattel can not transfer the share of his co-proprietor. *Pitts et al. v. Hall*, 3 Blatch. 201.

Where there are several patentees, and one of them grants a license to use the invention, the licensee is not liable to the other patentees. *Dunham v. Ind. & St. Louis R. R. Co.* 9 C. L. N. 50.

If a power of attorney recites the separate interests of the principals, and confers on the attorney authority to act for each of them severally or jointly, an assignment conveying the interest of one alone need only be executed in the name of the party whose interest is so assigned. *May v. Chaffee*, 5 Fish. 160; s. c. 2 Dillon, 385.

If one owner in common of a patent right agrees in consideration of a license fee, that the others shall have the exclusive right to manufacture the thing patented, they may set up the invalidity of the patent as a defense to an action to recover the fee. *Marston v. Sweet*, 6 T. & C. 534; s. c. 11 N. Y. Supr. 153.

If parties unite in obtaining a joint patent, neither of them, as against the other, can set up a prior patent to himself for the same invention. *Stearns v. Barrett*, 18 Mass. 443.

If a declaration avers that the plaintiff and the defendant were joint inventors, a plea that neither the plaintiff nor the defendant was the first inventor is immaterial. *Stearns v. Barrett*, 18 Mass. 443.

If parties obtain separate patents, neither is estopped from asserting that the invention was joint. *Stearns v. Barrett*, 18 Mass. 443.

Defense to Action on Contract.

A void patent is not a good consideration for a promissory note. *Dickinson v. Hall*, 31 Mass. 217; *Bliss v. Negus*, 8 Mass. 46; *Cross v. Huntley*, 13 Wend. 385; *Geiger v. Cook*, 3 W. & S. 266; *Kernodle v. Hunt*, 4 Blackf. 57; *Higgins v. Strong*, 4 Blackf. 182; *Head v. Stevens*, 19 Wend. 411; *McClure v. Jeffrey*, 8 Ind. 79; *Bierce v. Stocking*, 77 Mass. 174; *Rowe v. Blanchard*, 18 Wis. 441; *National Bank v. Peck*, 8 Kans. 660; *Bellas v. Hayes*, 5 S. & R. 427; *Turner v. Johns*, 2 Cranch C. C. 287; *Nye v. Raymond*, 16 Ill. 153; *Joliffe v. Collins*, 21 Mo. 338; *vide Elmer v. Pennel*, 40 Me. 430.

If no evidence is offered to impeach the novelty or utility of the invention, there is no proof to support an allegation of a failure of consideration, however worthless the patent may be. *Case v. Morey*, 1 N. H. 347; *Myers v. Turner*, 17 Ill. 179; *Hardesty v. Smith*, 3 Ind. 39.

The mere fact that an invention lacks novelty or utility in its application to any one of the several objects for which it is patented, will not prevent a recovery upon a note given for an interest therein. *Midkiff v. Boggess*, 15 Ind. 210.

A mere claim by others that the thing patented is an infringement of a prior patent is no defense to an action on a note given by a licensee under the terms of his license. *Davis v. Gray*, 17 Ohio St. 330.

If the invention is not useful, the vendor can not recover upon a promissory note given therefor, although he supposed the patent a valid one, and was wholly innocent of any fraud. *Lester v. Palmer*, 86 Mass. 145.

In an action upon a note given for a thing patented, the defendant may prove that the patent is void, and that the consideration has thus partially failed, although no special value was placed on the patent. *Nye v. Raymond*, 16 Ill. 153.

A purchaser in defense to an action upon a contract, may show that the vendor has no patent such as is described in the contract. *M'Dowell v. Meredith*, 4 Whart. 311; *Nye v. Raymond*, 16 Ill. 153.

If a patent right is sold with a warranty, and the process can not produce the result warranted, there is an entire failure of consideration, and no recovery can be had on a note given therefor. *Hawes v. Twogood*, 12 Iowa, 582.

Before a party can recover the consideration named in a contract for purchase of an interest in a patent right, he must show that he has title in himself to convey according to his contract, and tender an assignment thereof, unless such tender is dispensed with by the terms of the contract. *Edwards v. Richards*, *Wright*, 596; *Bellas v. Hays*, 5 S. & R. 427.

If joint payees of a note indorse it to one of them, the defense that it was given for a license to use a patent that is void, is good. *Saxton v. Dodge*, 57 Barb. 84.

The detriment which the purchaser may suffer on account of the patent being broader than the invention may affect the amount to be recovered, but not the right of recovery. *Hotchkiss v. Oliver*, 5 Denio, 314.

If a note is given for a patent right, and the invention is worthless because the machine can not be made to work, the note is void for want of consideration. *Clough v. Patrick*, 37 Vt. 421; *Cragin v. Fowler*, 34 Vt. 326; *Williams v. Hicks*, 2 Vt. 36; *Scott v. Sweet*, 2 G. Greene (Iowa), 224.

If a patent for a seed-sower, to be operated by horse power, is worthless, the patentee can not sustain the consideration of a note given therefor by proof that it may be modified to a hand-machine, especially when such modification required invention. *Cragin v. Fowler*, 34 Vt. 326.

If a note is given for a patented machine, and the exclusive right to use the same for a certain territory, the patentee is not entitled to anything beyond the value of the machine if the patent is void. *Earl v. Page*, 6 N. H. 477.

If the invention was useful and valuable at the time of the sale, the consideration of the note given therefor will not be impeached by showing that subsequent improvements have rendered the invention useless. The purchaser, when he bought, took the risk of a new discovery which should destroy the value of his property. *Harmon v. Bird*, 22 Wend. 113.

If the purchaser has assigned his interest in the patent to another, he can not, in an action by the patentee upon his note given for the right thus sold, set up a defense of a failure of consideration. *Thomas v. Quintard*, 5 Duer, 80.

If the samples and instruction furnished to the purchaser were not in any

degree valuable or useful to him, but as subservient to the art which was pretended to be conveyed by the assignment, the patentee will not be entitled to recover the value thereof. *Bliss v. Negus*, 8 Mass. 46; *Bierce v. Stocking*, 77 Mass. 174.

If the patentee has not been guilty of any fraud, and the purchaser has received what he contracted for, he can not reduce the amount of the stipulated price by proving that the thing patented is of little or no value, unless there is a warranty and a breach of it. *Vaughan v. Porter*, 16 Vt. 266.

If the assignment of three patents is in the nature of a mere quit-claim deed of whatever right, title or interest the patentee has or may acquire in the patents specified, and creates no warranty of title, the patentee is entitled to recover the full amount of the note given therefor, although one of the patents is void. *Gilmore v. Aiken*, 118 Mass. 94.

If an assignment contains no warranty, the vendee can not set up a warranty of the validity of the patent. *Joliffe v. Collins*, 21 Mo. 338; *Van Ostrand v. Reed*, 1 Wend. 424.

A stipulation against defects will be referred to defects in the patent, and not to deficiencies in the thing patented. *Vaughan v. Porter*, 16 Vt. 266.

If the contract shows that the parties mutually contemplated the possibility, if not the probability, that the patent was invalid, and provided by the form of the instrument and its stipulations for the contingency, there is no ground on which the vendee can be permitted to set up a failure of consideration, so long as he is not disturbed in the use of the invention, although the patent is void. *Johnson v. Linen Co.* 33 Conn. 436.

A covenant of title will not constitute a good consideration for a promissory note if the patent is void. *Dickinson v. Hall*, 31 Mass. 217; *Bliss v. Negus*, 8 Mass. 46.

If a note is given in consideration of a reassignment of an interest in an invention, so that a patent may issue in the name of the inventor, the fact that the payee took out a patent for an alleged portion of the theory of the invention after the reassignment is no defense to an action on the note. *Clark v. Smith*, 21 Minn. 539.

If the payment of the purchase money in an instrument under seal is entirely dependent on the conveyance of the right, and the instrument is so improperly executed as not to convey the right, the patentee can not recover the consideration in an action on the instrument. *Bellas v. Hays*, 5 S. & R. 427.

If the action is in covenant on a sealed instrument, a good consideration is implied from the solemn form of the promise in writing and under seal, and the invalidity of the patent can not be set up as a defense. *Wilder v. Adams*, 2 W. & M. 329.

In an assignment there is an implied covenant of the validity of the patent, and the purchaser, as a general principle and in ordinary cases, can not resort to such a defense as a want of consideration, or a failure of consideration, when an action is brought upon a sealed instrument executed in consequence of and founded on another covenant made by the patentee to him. *Wilder v. Adams*, 2 W. & M. 329.

A covenant for the enjoyment of the exclusive use of a patented machine insures to the covenantee an indemnity for a use of the patented machine by

others, under and by virtue of the letters patent, but does not secure him against the unlawful and unauthorized acts of wrong-doers. *Baker v. Mason*, 3 R. I. 45.

The violation of the contract by the patentee is available by way of recoupment of damages only, and not in bar of the action. *Pitts v. Jameson*, 15 Barb. 310.

A purchaser can not set up the defense of the invalidity of the patent in an action to recover the purchase money if the contract contains a stipulation that the question shall only be tried in another suit involving the very point, and such is the effect of a provision that the contract shall only be void when some person establishes the invalidity of the patent. *Ball v. Murry*, 10 Penn. 111.

If a contract merely assigns the interest of a party in an invention owned by him and another as partners, the purchaser, in an action for the purchase money, is not entitled to a reduction for the money expended by him in procuring a patent, or in obtaining an assignment of an interest from the co-partner who was the real inventor. *Vetter v. Lentzinger*, 31 Iowa, 182.

If an assignee grants his right to another, and obtains an assignment of a patent from the true inventor, he may, in an action by his assignor to recover a stipulated royalty, plead a decree adjudging the patent void for want of novelty rendered in the Circuit Court of the United States, wherein both were parties, as a bar to the right to recover. *Hawks v. Swett*, 6 T. & C. 529; S. C. 11 N. Y. Supr. 146; *Marston v. Swett*, 6 T. & C. 534; S. C. 11 N. Y. Supr. 153.

When a party claims to establish his right merely by estoppel, the instrument by which the estoppel is supported must be precise, clear and unequivocal. *Rich v. Atwater*, 16 Conn. 409.

If a covenant is entered into under a mistake in regard to the validity of the patent, the recital will not operate as an estoppel in a court of equity. *Rich v. Atwater*, 16 Conn. 409.

Where an agreement is restricted to the original patent, it can not operate to estop a party who subsequently obtains a reissue. *Pickering v. Phillips*, 10 O. G. 420.

If the purchaser, in an action for the purchase money, alleges that the vendor had no title, the burden of proof rests on him to show it. *Bussey v. Putney*, 38 N. H. 44; *Holden v. Curtis*, 2 N. H. 61.

Where an alleged warranty is not contained in a written contract, it can not be proved by parol evidence, unless in addition to the averment that there was such warranty, there be an allegation that it was false or fraudulent, and that thereby the purchaser was deceived. *McClure v. Jeffrey*, 8 Ind. 79.

If a purchaser alleges that the party who assumed to sell an interest in the patent to him had no assignment from the patentee, the burden of proof is on him to establish the fact. *Stevens v. Head*, 9 Vt. 174.

If the purchaser of an article takes a covenant of warranty, he may, upon demand, yield to the right of the patentee, and pay the sum required by him; but in a suit against the covenantor he must assume the burden of proof to show the validity of the patentee's claim. *Orr v. Burwell*, 15 Ala. 378.

In an action to recover a royalty from a manufacturer who has covenanted

to keep and render an account of sales, evidence that machines have been made and sent away from the licensee's factory, establishes a *prima facie* case and calls for an explanation. *Marsh v. Dodge*, 5 Lans. 541.

Recovery of Purchase Money.

If a purchaser pays the consideration stipulated for an assignment of a patent for a certain article, and the vendor sends him an assignment of a patent for a different thing, he may return the assignment and recover the consideration. *Foss v. Richardson*, 81 Mass. 303; *McDowell v. Meredith*, 4 Whart. 311.

If there has been no misrepresentation or concealment of any material fact by the patentee, the purchaser can not recover the money which has been paid, although the patent is void, for the payment is voluntary with a full knowledge or means of knowledge of all the facts in relation to the transaction. *Stevens v. Head*, 9 Vt. 174; *vide Darst v. Brockway*, 11 Ohio, 462.

If the assignor agrees to refund the consideration if the assignee can not realize that amount from sales within a certain period, the assignee, if the instrument is silent as to his efforts, is bound to make reasonable efforts to realize from sales, taking into consideration his ability and pecuniary means. *Berger v. Peterson*, 78 Ill. 633.

A patent right is not a corporeal thing either real or personal, but something intangible and incorporeal, resting wholly in grant. In contracts for the assignment of such interests, if there be no fraud, the purchaser must depend wholly upon his covenants in case they prove of no value. He has no remedy for his money if there is a failure of title. *Hiatt v. Twomey*, 1 Dex. & Bat. Eq. 315; *Canster v. Eaton*, 2 Jones Eq. 499.

If a judgment has been rendered against the purchaser upon the note given for the patent, he can not recover the money paid thereon, although the patent is void. *Holden v. Curtis*, 2 N. H. 61.

If the purchaser derives any benefit from the use of the patent, he can not recover the consideration paid, although the patent is void. *Holden v. Curtis*, 2 N. H. 61.

If an assignee takes an assignment, not merely for the purpose of examination, but as a deed vesting the property in him, and reads it, or has opportunity to read it, retains it, acts under it and makes payment on account of it, he can not, in the absence of fraud, recover back the consideration for which the deed stipulated, merely because there has been a misunderstanding as to the meaning of the deed and the extent of the rights which it confers. *Foss v. Richardson*, 81 Mass. 303.

Fraud.

A purchaser who has repudiated a contract to purchase a patent right for fraud may sue for redress if he has suffered damages from it. *Warren v. Cole*, 15 Mich. 265.

In order to make a representation a ground for an action of deceit or fraud, it must be shown that the representation was known to be false, and that it was made with an intent to deceive. *Joliffe v. Collins*, 21 Mo. 338.

A misrepresentation in regard to the value of the thing patented, is ground

for rescinding a contract. *Newell v. Gatling*, 7 Ind. 147; *Gatling v. Newell*, 9 Ind. 572.

A mere representation by the vendor that the patentee's machine is useful and valuable, will not avoid the note if the patent is valid. *Kernodle v. Hunt*, 4 Blackf. 57.

A misrepresentation in regard to the utility of the thing patented may be available in mitigation of damages, but will not constitute a defense to a suit upon a covenant or note given by the purchaser. A plea in bar should, in addition to the misrepresentations, state that the property was of no value, or that it has been returned or tendered to the vendor. *Mullikin v. Latchem*, 7 Blatch. 136; *Hardesty v. Smith*, 3 Ind. 39.

A purchaser who is sued upon his promissory note given for an interest in a patent, may set up as a defense that he was induced to purchase by means of false and fraudulent representations on the part of the vendor, as to the qualities, capabilities and usefulness of the invention, without returning or offering to reassign the patent. *Groff v. Hansel*, 33 Md. 161.

If a party falsely represents that he has a valid patent right, and thereby induces another to purchase it, when he knows that he has no such patent right, this is a fraud for which an action will lie. *Bull v. Pratt*, 1 Conn. 342.

A purchaser has a right to rely upon a representation made by the vendor as to what is covered by the patent, and if that is false he may rescind the sale. *Rose v. Hurley*, 39 Ind. 75.

A representation in regard to the durability, salability and cost of articles manufactured according to a patented design, is a mere matter of opinion, and will not vitiate a sale, even though it is false. *Miller v. Young*, 33 Ill. 354.

If the success of an invention is uncertain, and depends on future experiment, it is the subject of a chancing bargain, and the excess of the price over the value of the invention is no ground for rescinding the contract. *West v. Morrison*, 2 Bibb, 376.

If a purchaser, by false and fraudulent representations of the vendor in matters not known to him, and which are peculiarly within the knowledge of the vendor, is induced to make the purchase and give his note therefor, and would not have entered into the contract of purchase if it had not been for such representations, he may set up the defense of fraud to an action on the note. *Bierce v. Stocking*, 77 Mass. 174.

A defrauded vendee who has rendered perfect his right to claim a rescission in a court of equity, by a timely offer of rescission and tender back of the thing received by him under his purchase can not lose that right by mere declarations as to the value of the thing he had bought, nor by unavailing efforts to dispose of it, if such declarations and efforts did not in any way mislead or injure the vendor. *Pierce v. Wilson*, 34 Ala. 596.

A declaration of the price at which the patentee is in the habit of selling the machine is not such as will constitute fraud, although it is false. *Williams v. Hicks*, 2 Vt. 36.

If a party sells a thing as patented, when he has no patent, this is such fraud as will render void a bond given therefor. *Brown v. Wright*, 17 Ark. 9.

Although a purchaser knows that some of the vendor's representations are false, yet if he does not know that they are all false, he has not such full

knowledge of the fraud as will make an act amount to a ratification. *Pierce v. Wilson*, 34 Ala. 596.

If the purchaser was induced to take an assignment by the fraudulent misrepresentations of the patentee in regard to the subject of the sale, he is entitled to a rescission of the sale. *Pierce v. Wilson*, 34 Ala. 596; *Hall v. Orvis*, 35 Iowa, 366; *Page v. Dickerson*, 28 Wis. 694.

If the patentee correctly described and explained a prior invention, but drew from thence an incorrect inference in regard to the principles and similitude of the two inventions, a purchaser can not rely on this erroneous inference from premises correctly given as a ground for rescinding the contract. *West v. Morrison*, 2 Bibb, 376.

What constitutes a reasonable time within which a purchaser must elect to disaffirm a sale on account of fraud after the discovery thereof, must be determined from the circumstances of each particular case. *Pierce v. Wilson*, 34 Ala. 596.

A purchaser from an assignee can not have the assignment to his vendor rescinded for fraud because he was no party to that contract. *Edmunds v. Hildreth*, 16 Ill. 214.

The right to set aside an assignment for fraud belongs to the assignor alone, and can not be set up by third persons. *Hoffheins v. Brandt*, 3 Fish. 218.

A plea alleging a misrepresentation, which does not aver that the defendant relied upon it and entered into the contract believing it to be true, is bad. *Saxton v. Dodge*, 57 Barb. 84.

Fraud in obtaining a license may be set up in an action at law. *Day v. New England Car Spring Co.* 3 Liv. Law Mag. 44.

An assignee of the licensor may impeach a license on the ground that it was obtained by fraud. *Day v. New England Car Spring Co.* 3 Liv. Law Mag. 44.

Evidence of fraud in obtaining a license is competent against a party who purchases from the licensee. *Day v. New England Car Spring Co.* 3 Liv. Law Mag. 44.

Relief in Equity.

If a party purchases a patent right under the belief that it covers a certain machine when it does not, he may obtain a cancellation of the contract in a court of equity on the ground of the mistake. *Burrall v. Jewett*, 2 Paige, 134; *vide Foss v. Richardson*, 81 Mass. 303.

If there is no fraud in the sale of a patent, a court of equity will not interfere to relieve a party from liability upon his bond given therefor, although the patent is void. *Cansler v. Eaton*, 2 Jones Eq. 499.

If the patent is void, a court of equity will entertain a bill to compel the surrender and cancellation of a negotiable note given therefor. *Dare v. Brockway*, 11 Ohio, 462; *Bellas v. Hays*, 5 S. & R. 427.

If there is a mistake in an assignment, a bill in equity must aver that the assignee made a request for its correction, or a reason for its omission. *Black v. Stone*, 33 Ala. 327.

If the assignment is by mistake a mere blank deed, a court of equity will

not enjoin the collection of the notes given therefor unless the bill avers the insolvency of the assignor. *Black v. Stone*, 33 Ala. 327.

Where the assignee has sold a part of the territory, he can not have the contract rescinded in equity unless he tenders a return of what remains unsold and the value of that which has been sold. *Edmunds v. Myers*, 16 Ill. 207; *Edmunds v. Hildreth*, 16 Ill. 214.

An attorney appointed under an irrevocable power, coupled with an interest, and authorizing him to sell an invention in his discretion, is not a purchaser, but an agent. *Calista E. Cox*, 2 O. G. 491.

If a power of attorney authorizing the agent to assign the patent is general, he may assign it before the patent issues, if there is at that time no revocation thereof. *G. Eveleigh*, 1 O. G. 303.

The assignment of the invention or improvements does not convey the extended term, something more definite being necessary to indicate the intention of the parties to transfer the interest in the extension. *Holmes & Spaulding*, 6 O. G. 581.

If an instrument purports to convey inventions not yet in existence, it is not an assignment, but only an executory contract. *Thomas Edison*, 7 O. G. 423.

If an assignee owns the right to an extension, an assignment of all his right, title and interest will convey his right to the extension. *John L. Mason*, 1 O. G. 357.

An assignment by a corporation will pass a right that may be enforced in equity although its seal was omitted. *John L. Mason*, 1 O. G. 357.

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

Statute Revised—July 8, 1870, ch. 230, § 37, 16 Stat. 203.

Prior Statute—March 3, 1839, ch. 88, § 7, 5 Stat. 354.

The object of this provision is evidently twofold: 1st, to protect the person who has used the thing patented by having purchased, constructed or made the machine, &c., to which the invention is applied, from any liability to the patentee or his assignee; 2d, to protect the rights granted to the patentee against any infringement by any other persons. This relieved him from the effects of former laws and their construction, unless in case of an abandonment of the invention or a continued use for more than two years before the application for a patent, while it puts the person who has had such prior use on the same footing as if he had had a special license from the inventor to use

his invention, which, if given before the application for a patent, would justify the continued use after it issued without liability. *M'Clurg v. Kingsland*, 1 How. 202.

The words "machine or other patentable article" and "such invention," mean the "invention patented," and the words "specific thing" refer to "the thing as originally invented," whereof the right is secured by patent, but not to any newly invented improvement on a thing once patented. The use of the invention before an application for a patent, must be the specific improvement then invented and used by the person who had purchased, constructed or used the machine to which the invention is applied. *M'Clurg v. Kingsland*, 1 How. 202.

This section applies to an invention which consists in a new mode or manner of operating an old machine, or any of its parts, as well as to a specific machine. *M'Clurg v. Kingsland*, 1 How. 202.

If parties construct a machine before the application of the patentee for letters patent, under the belief authorized by him that he consents and allows them so to do, then they may lawfully continue to use the same after the date of the letters patent. *Kendall v. Winsor*, 21 How. 322.

The purchaser here spoken of is a purchaser not from a mere wrong-doer, but from the first and true inventor before he obtained his patent. *Pierson v. Eagle Screw Co.* 3 Story, 402; *Hovey v. Stevens*; 1 W. & M. 290; *vide Troy Factory v. Odiorne*, 17 How. 72.

A use by fraud and a piracy on the inventor, is not contemplated or protected under this section. *Hovey v. Stevens*, 1 W. & M. 290.

The Constitution and law taken together give to the inventor, from the moment of invention, an inchoate property therein, which is completed by suing out a patent. This inchoate right is exclusive. It can be invaded or impaired by no person. No person can, without the consent of the inventor, acquire a property in the invention. Whenever any person, previous to a patent, constructs a machine discovered by another, he constructs it subject to the rights of that other. *Evans v. Jordan*, 1 Brock. 248; S. C. 9 Cranch, 199.

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

notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented.

Statute Revised—July 8, 1870, ch. 230, § 35, 16 Stat. 203.

Prior Statutes—Aug. 29, 1842, ch. 263, § 6, 5 Stat. 544.—March 2, 1861, ch. 88, § 13, 12 Stat. 249.

The penalty imposed by the statute for a failure to mark patented articles is only the taking away of the right to recover damages in the suit. It does not affect the right to an injunction, either perpetual or provisional, as a remedy. *Goodyear v. Allyn*, 3 Fish. 374; S. C. 6 Blatch. 33.

It is for the defendant to show a failure by the complainant to mark the articles made or vended as required, and then the burden of proof is on the complainant to show that, before suit was brought, the defendant was duly notified that he was infringing the patent, and that he continued, after such notice, to make or vend the article patented. *Goodyear v. Allyn*, 3 Fish. 374; S. C. 6 Blatch. 33; *contra*, *McComb v. Brodie*, 5 Fish. 384; S. C. 1 Woods, 153; 2 O. G. 117.

If the complainant does not sell the patented articles, the objection that articles sold by others were not properly marked will be of no avail. *Goodyear v. Allyn*, 3 Fish. 374; S. C. 6 Blatch. 33.

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

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

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

Statute Revised—July 8, 1870, ch. 230, § 39, 16 Stat. 203.

Prior Statute—Aug. 29, 1842, ch. 263, § 5, 5 Stat. 544.

The statute must be construed to mean that the article to which the word "patent" was affixed, if not patented, was patentable. As the statute is highly penal, it must receive a strict construction, and can not be held to embrace any act which, though within the strictness of its letter, is against reason and common sense. It would be doing injustice to the framers of the law to suppose they intended to include in its prohibitions, and to visit with a penalty, the mere act of putting the word "patent" on an article neither patented nor patentable. Novelty and utility are essential elements of every valid patent issued under the laws of the United States. It is clear that to justify a judgment for a penalty for putting the word "patent" on an article, the declaration must allege, and there must be proof on the trial, that it was legally the subject of a patent. *U. S. v. Morris*, 3 Fish. 72; *S. C. 2 Bond*, 23.

The plaintiff must prove beyond a reasonable doubt: 1st. That the defendant affixed the word upon the article; 2d. That the defendant has no patent; 3d. That the defendant affixed the word with the intent to deceive the public. *Nichols v. Newell*, 1 Fish. 647.

The statute forbids the affixing the word upon any article for the purpose of deceiving the public. The offense is committed by affixing the word for that purpose. If it is affixed to an article for that purpose, then the offense is complete, whatever disposition of the article may subsequently be made. On the other hand, if, when the word is affixed, it is with an innocent purpose, the offense is not committed, whatever new purpose the defendant may have at a subsequent period. *Nichols v. Newell*, 1 Fish. 647.

The simple act of marking the article indicating that it was patented when it was not, is not sufficient to constitute the offense. The marking must not only give the public to understand the fact of a patent, but the act must be done *malo animo* with an intent to deceive; and this ingredient of the offense which is essential to make it complete must be left to and found by the jury. *Walker v. Hawxhurst*, 5 Blatch. 494.

If the defendant gave instructions to his workmen to manufacture articles, and put on the word for the purpose of deceiving the public, and subsequently changed his views or wishes, but did not communicate this change to the workmen, this uncommunicated purpose or wish or intent will have no operation to prevent the affixing of the word by the workmen from being an affixing with the intent to deceive the public. *Nichols v. Newell*, 1 Fish. 647.

The conduct of a person when intent is to be ascertained, both before and after the act which is to be accomplished by it, may be gone into to determine what was his intent at the time of the act. *Nichols v. Newell*, 1 Fish. 647.

A man is to be held to intend that which is the necessary consequence of his acts, or what he infers will be the consequence of his acts. *Nichols v. Newell*, 1 Fish. 647.

The burden of proof is upon the plaintiff to establish beyond a reasonable doubt such facts as are necessary to constitute the offense. *Nichols v. Newell*, 1 Fish. 647.

The question of fraud or deceit, as a matter of fact presented in a case, involves an inquiry of much latitude and scope on the trial, and must generally be directed by the good sense of the judge in respect to the bearing of the

facts and circumstances relied on, and concerning which it is oftentimes difficult to apply any fixed rules. Very considerable indulgence is therefore allowed by the appellate court in revising these questions. The error must not only be striking, but must necessarily have been calculated to mislead the minds of the jury, before the verdict will be interfered with. *Walker v. Hawxhurst*, 5 Blatch. 494.

If the word "patent" is put on in any way, it answers the description. *Nichols v. Newell*, 1 Fish. 647.

The marks are just as much upon the article when put upon one part of it as upon another. *Nicholls v. Newell*, 1 Fish. 647.

The action can not be prosecuted in the name of the United States alone. It should be prosecuted by an informer; or if the name of the United States can be properly used, it must be in connection with a person to be named as informer, who shall be responsible, in case the action is not sustained, for costs or other consequences resulting from its failure. *U. S. v. Morris*, 3 Fish. 72; S. C. 2 Bond, 23.

This section authorizes the infliction of a penalty of just one hundred dollars, and such penalty may be recovered in an action of debt. *Stimpson v. Pond*, 2 Curt. 502.

The action may be brought at any time within five years after the commission of the offense. *Stimpson v. Pond*, 2 Curt. 502.

SEC. 4902. Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the patent office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the no-

tice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen.

Statute Revised—July 8, 1870, ch. 230, § 40, 16 Stat. 203.

Prior Statutes—July 4, 1836, ch. 357, § 12, 5 Stat. 121.—March 2, 1861, ch. 88, § 9, 12 Stat. 247.

A caveat is intended to answer a double purpose; 1st, to give notice of the caveator's claim as inventor; 2d, to prevent a patent issuing to another for the same thing. *Allen v. Hunter*, 6 McLean, 303; *American Pavement Co. v. Elizabeth*, 6 Fish. 424; S. C. 3 O. G. 522.

This section was introduced for the benefit of the inventor, but is not necessary to the preservation of his right. It only enables him to have notice of any interfering application. *Heath v. Hildreth*, Cranch Pat. Dec. 96.

The effect of the caveat is to protect the claim of an inventor from all interfering applications made within one year after its filing, by requiring the office to notify him of such application, that he may resist the interference, if he chooses. *Bell v. Daniels*, 1 Fish. 372; S. C. 1 Bond, 212.

If, during the time which elapses between the filing of his caveat and his application, the inventor allows his invention to go into public use, his caveat will not protect him. *Bell v. Daniels*, 1 Fish. 372; S. C. 1 Bond, 212.

The purpose of the caveat is to save the discoverer from the effect of the rule of law which gives to the inventor that first adapts his invention to practical use the right to the grant of the patent. *Phelps v. Brown*, 1 Fish. 479; S. C. 4 Blatch. 362.

If the inventor has not perfected his invention, and does not use due diligence to carry it into effect, and, in the mean time, before he gets his patent, somebody else invents and uses the invention, and incorporates it into a practical, useful machine, then he can not, by a subsequent patent, appropriate to himself what has thus been embraced in a machine between his caveat and the obtaining of his patent. *Johnson v. Root*, 1 Fish. 351.

In considering the question of reasonable diligence, it is not sufficient to answer that the patentee used diligence in relation to some other invention or machine. The question is, Did he use diligence in perfecting the invention mentioned in the caveat? *Johnson v. Root*, 1 Fish. 351.

The question of diligence is not an absolute but relative one, and must be considered in reference to the subject-matter of the experiments. *American Pavement Co. v. Elizabeth*, 6 Fish. 424; S. C. 3 O. G. 522.

The granting of a patent while a caveat is pending and in force does not render the patent void. *Cochrane v. Waterman*, Cranch Pat. Dec. 121.

If the commissioner accidentally overlooks a caveat filed before the application by another party, he may issue a patent to the caveator even after the granting of a patent to such other party, in order to give him an opportunity to correct the error. He should not be prejudiced by the accidental omission to give him notice. *Phelps v. Brown*, 1 Fish. 479; S. C. 4 Blatch. 362.

A caveat is not conclusive evidence that the invention was not perfected, for it may happen that a person may choose to file a caveat while he is going on and making improvements upon an invention which he has already completed, so as to be of practical utility. *Johnson v. Root*, 1 Fish. 351.

The granting of a patent being a public act, the caveator is bound to take notice of it, and to file his application within a reasonable time thereafter. *Lewis Hillebrand*, 2 Dec. Com. 145.

No inference can be drawn from a caveat as to the date of an invention, unless the caveat describes it. *Wheeler v. Peters*, 2 Dec. Com. 141.

If a caveat and an application for a patent are filed upon the same day, and for the same invention, it will be presumed they were filed simultaneously, and the caveator will be notified. *J. Essex*, 9 O. G. 497.

If a conflicting caveat is in force when an application is filed, though the application is rejected, and the rejection is not set aside until after the caveat has expired, yet the caveator is then entitled to be notified. *J. Kenny, Sr.* 1 Dec. Com. 97.

A caveator who has been notified of an application claiming the same invention, is entitled to no special indulgence on that account, if he neglects to apply for a patent for ten months after one has issued to the other party. *Wheeler v. Rank*, 2 Dec. Com. 119.

SEC. 4903. Whenever, on examination, any claim for a patent is rejected, the commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the commissioner shall order a re-examination of the case.

Statute Revised—July 8, 1870, ch. 230, § 41, 16 Stat. 204.

Prior Statute—July 4, 1836, ch. 357, § 7, 5 Stat. 119.

The specification is always open to amendment of its description and claims, and to the addition of new matters of description and new claims where the drawings and model exhibit the matters involved in the amendments and additions, and this privilege continues until the matter of the application is finally disposed of by the granting of a patent or otherwise. *Singer v. Braunsdorf*, 7 Blatch. 521.

The right to change the specification exists, and may be exercised independently of the suggestions of the commissioner at any time before the commissioner has given his formal judgment upon the application. *Godfrey v. Eames*, 1 Wall. 317.

If an application is pending for a patent for several improvements, a new application may be made for a patent for one of them, for it simplifies the application and disembarrasses it from its connection with other improvements claimed. *Suffolk Co. v. Hayden*, 4 Fish. 86; s. c. 3 Wall. 315.

After a first rejection the applicant may insist upon his claim as presented. If the examiner reaffirms his former decision, without supporting it with fresh references, the rejection is final, and there is no remedy but appeal. But if the examiner gives new references, the applicant has a right to reply to them, or to amend his specifications. *Alice Appleton*, 1 Dec. Com. 8.

After an application has been finally rejected on an appeal to the court, it is within the discretion of the commissioner whether any amendment of it shall be allowed. *Whiteley & Gage*, 1 Dec. Com. 53.

If an inventor files an application as a substitute for one previously appealed to the examiners in chief, and by them rejected, the primary examiner should examine it on its merits, and not reject it merely because he deems it identical with the one rejected by the examiners in chief. *W. H. Le Van*, 1 O. G. 226.

References, as affording grounds for rejecting a claim, should be cited on demand, in preference to offering a mere legal opinion. *Fairbanks & Robinson*, 3 O. G. 65; *Albert D. Davis*, 6 O. G. 297.

The rejection of an application having been affirmed upon a former occasion in consequence of misapprehending the construction of the machine under consideration, the case was reconsidered upon the error being corrected. *Powers & Stevens*, 1 Dec. Com. 81.

No amendment should be allowed in original applications which change the character of the invention essentially; but amendments may be made, although more than two years have elapsed after the application was filed. *Wm. C. Dodge*, 3 O. G. 179.

It is only those changes that affect the substance or materiality of an invention that are objectionable as new matter. *William B. Carlock*, 8 O. G. 191.

In amending original applications it will not be considered as the introduction of new matter, if the subject is embraced either in the model, drawing, or specification. *J. F. W. Dorman*, 9 O. G. 1061.

After an application has been filed it can not be amended by inserting the description of a modification of the combination claimed which is not shown in the original model or drawings. *L. J. Knowles*, 2 Dec. Com. 161.

SEC. 4904. Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners in chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe.

Statute Revised—July 8, 1870, ch. 230, § 42, 16 Stat. 204.

Prior Statutes—Feb. 21, 1793, ch. 11, § 9, 1 Stat. 322.—July 4, 1836, ch. 357, § 8, 5 Stat. 120.

How the commissioner is to obtain information of the interfering patent is not provided for in the statute, and hence the matter is necessarily left to his discretion to obtain it in the best way that he can. If the party interested may know of the application, he can bring the interference to the notice of the commissioner, or if the commissioner happens to recollect the issuing or existence of the previous patent, he may act upon that information. It would be very unreasonable to require him to recollect all the previous patents at the time that might interfere with the one applied for, or to require the party interested to know that an application was pending in the office for a patent interfering with his. *Potter v. Dixon*, 2 Fish. 381; S. C. 5 Blatch. 160.

A man may have letters patent issue to him individually, for that which he has claimed as a joint invention with another, and he is not estopped by such joint patent from claiming an interference. *Crocker's Case*, 2 A. L. T. 129.

A reissue can not be withheld on the ground that an interfering application was filed after the granting of the original patent. *Thomas J. Mayall*, 11 O. G. 1107.

Priority of invention is the only question that can be heard or determined on an interference. *United States v. Commissioner*, 7 O. G. 603.

When the application is for a combination, form and structure become substance, and an admission that one is different in its form and structure from another, is an admission of a fact which is *prima facie* evidence that there is no interference between the two. *Bain v. Morse*, 6 West. L. J. 372.

The decision of the patent office, after an interference has been declared between an application and a prior patent is not conclusive or final. *Union Paper Bag Co. v. Crane*, 1 Holmes, 420; S. C. 6 O. G. 801.

A statement made by an inventor to the patent office as to the date of his invention does not estop him from setting up a prior date in an action under this section. *Union Paper Bag Co. v. Crane*, 1 Holmes, 420; S. C. 6 O. G. 801.

If an interference is declared, and the examiner in chief on appeal suspects from the evidence that the applicant has abandoned his invention to the public, and that question is referred to an examiner, the owner of the prior patent can not appeal from the decision of the examiner on that point. *United States v. Commissioner*, 7 O. G. 603.

A notice to produce the deposition before a commissioner for inspection is not a waiver of a want of notice, although the opposite party offers to produce the witnesses for cross-examination. *Perry v. Cornell*, Cranch Pat. Dec. 130.

If there is an informality in the transmission of the deposition, the commissioner may postpone the hearing in order to enable the party to cure the defect. *Smith v. Flickenger*, Cranch Pat. Dec. 116.

An objection to the insufficiency of the time between the notice and the taking of the deposition, can not be considered unless it is taken at the hearing. *Smith v. Flickenger*, Cranch Pat. Dec. 116.

If the person who takes the deposition omits to state that it was sealed up by him, it can not be used. *Arnold v. Bishop*, Cranch Pat. Dec. 103.

The rules, so long as they remain unabrogated, are as binding on the commissioner as the law itself. *Arnold v. Bishop*, Cranch Pat. Dec. 103.

A party who appears and cross-examines a witness, can not object to the shortness of the notice of the time of taking the evidence. *Arnold v. Bishop*, Cranch Pat. Dec. 103.

Interference.

If one party claims a process and the other the product thereof, the claims interfere, for either by amendment or reissue may insert the claim of the other. *Finley v. Chapman*, 1 O. G. 277.

The descriptive phrases "interlaced ruled lines" and "any of the known means of pen-ruling" are co-extensive. *Duthie v. Casilear*, 1 O. G. 255.

Although a patent has been issued to another for substantially the same thing during the pendency of the application, yet the applicant is not entitled to a patent without being required to prove priority of invention in an interference with the existing patent. *William Price*, 1 O. G. 574.

If the final fee has been paid and nothing remains to be done but issue the patent, it will not be withheld for the purpose of declaring an interference with another application filed subsequent to the rendition of the judgment. *Wright et al. v. Reese*, 11 O. G. 329.

An interference is properly declared where no claim can be made upon the device of the party first in the office, which would not be embraced in that of the other party. *Bachelor v. Porter & Bancroft*, 1 Dec. Com. 64.

There can be no conflict between devices intended as improvements upon an original device, but not upon each other, where they perform the same result, but differ in their method of performing it, which is their principal operation, as much as they differ from the original. *Barton v. Babcock et al.* 1 Dec. Com. 67; *Fletcher v. Abraham*, 2 Dec. Com. 26.

If an application is filed for a mechanical patent for a construction, and if a design for which a patent has been granted can be produced only by that construction, an interference should be declared. *Collender v. Griffith*, 3 O. G. 91; S. C. 3 O. G. 267.

A patent will be issued without giving notice to parties whose applications for a similar invention have been previously rejected. *Casilear & McIntire*, 8 O. G. 474; *contra*, *Rouse & Stoddard*, 7 O. G. 169.

It is not necessary to an interference that the combination of each party should consist of elements identically the same in form, so long as the combinations are equivalents in arrangement and operation. *Withington v. Locke*, 11 O. G. 417.

The question of novelty should be settled in all cases before an interference is declared, but if it is made an issue subsequently, it can not be ignored. *Wood v. Morris*, 3 O. G. 239.

An interference should be declared where a device claimed in an application is shown in a patent though not claimed. *E. S. Wright*, 2 Dec. Com. 60.

If an application is found to conflict with two or more patents, an interference should be declared, including all the parties, and not a separate interference with each patent. *Wilson et al. v. Yakel et al.* 10 O. G. 944.

Where one party claims broadly an element when used in any composition of a certain class, and another claims the same element when used in a particular composition of that class, an interference must be declared. *Boon v. Hinman*, 2 Dec. Com. 7.

An interference will not be declared between a pending application and an application which has been forfeited, and upon reference to which it has been rejected. *James Spear*, 5 O. G. 201.

If claims are introduced into an application for a reissue, which are in conflict with a patent granted upon an application filed after the other patent

issued, an interference will be declared. *Mayall v. Murphy & Schenck*, 5 O. G. 339.

An interference should be declared where reference is made to a rejected joint application, and the question decided according to the rules. *John B. Welpton*, 3 O. G. 440.

An application for reissue can be put in interference with a patent granted prior to the filing of the original application. *Carroll v. Morse*, 9 O. G. 453.

An interference can not be declared between a reissue application and an application filed after the granting of the original patent. *Becker v. Throop*, 8 O. G. 1; *Paris v. Busey*, 8 O. G. 859; *contra*, *Sargent & Burge*, 10 O. G. 285.

Failure to make objections before the expiration of the time for filing preliminary statements will be considered as a waiver thereof and consent to the interference. *Anson v. Woodbury*, 11 O. G. 243.

Preliminary Statement.

Neither the name of an applicant nor any particulars of his invention will be communicated to a patentee with whom he has been placed in interference until the patentee files his preliminary statement. *Spalding & Aldrich v. Winchester*, 3 Dec. Com. 94.

The office is responsible if a defective preliminary statement is received as sufficient; but if the adverse party takes no exception to it the defect is cured. *White & Farmer*, 5 O. G. 338.

Since parties are allowed in their preliminary statements to fix the date of their invention, it is proper they should be restricted to a substantial adherence thereto in an interference proceeding. *Walpuski v. Jacobsen & Faber*, 9 O. G. 964.

A preliminary statement can not be amended to change the date of the invention after the party has closed his testimony. *Guest v. Finch*, 10 O. G. 165; *Cheesebrough v. Tappan*, 1 O. G. 464.

Amendments of preliminary statements are allowed only before the statement of the opposite party is disclosed to the one making the amendment, or upon requirement of the commissioner, when the same are indefinite, before testimony is taken. *Guest v. Finch*, 10 O. G. 165.

An amendment of a preliminary statement in respect to essential matter can not be allowed after testimony has been taken, or after each has learned the other's dates. *Oliver v. Qeller*, 10 O. G. 416.

An amendment to a preliminary statement, setting up an earlier date than that originally established will not be regarded. *Cutting v. Kaylor*, 2 O. G. 704.

If one is proved not to have been of sound mind when making the preliminary statement, it may be amended or disregarded as equity may seem to warrant. *W. D. Brooks*, 6 O. G. 296.

Examiner of Interferences.

It is a matter wholly within the discretion of the commissioner what questions arising out of interference cases shall be decided by the examiner of interferences or some primary examiner. *Weitling et al. v. S. G. Cabell et al.* 2 O. G. 223.

The interference must be heard, in the first place, by the examiner of interferences, whether the issue is made up by the principal examiner or commissioner. *Farnsworth v. Andrews*, 9 O. G. 195.

The law does not make the examiner of interferences a judge of the

novelty of devices before him in interference; but it is made his duty to suspend an interference whenever it appears to him that an insufficient examination has been made, or a new reference has been discovered. *Neuhocker v. Schafhaus*, 4 O. G. 319; *Little v. Lillie*, 10 O. G. 543; *Anson v. Woodbury*, 11 O. G. 243.

Evidence.

The only matters at issue in an interference is priority of invention to which the question of originality as between the parties is sometimes germane. *Miller v. Miles*, 11 O. G. 197.

An inventor who has taken out a patent in good faith, should not have his invention crippled by additional patents for improvements which naturally suggest themselves to every mechanic who is employed to manufacture them. *Earles & Hoyt v. Dunderdale*, 3 Dec. Com. 174.

In an interference between a patent and a subsequent application, the patent affords a *prima facie* presumption of priority of invention in favor of the patentee. *Paul & Dorland*, 4 O. G. 552; *Busha v. Phelps et al.* 9 O. G. 1010; *Palm v. Behel*, 10 O. G. 701; *Cushman v. Parham*, 9 O. G. 1108; *Sargent v. Burge*, 11 O. G. 1055.

Where it appears in an interference between an application and a patent, that the patent had been granted during the pendency of the application without an interference, the parties should be treated as if both were applicants. *Goodman v. Scribner*, 2 O. G. 673; *Smith v. Barter*, 7 O. G. 1.

If two conflicting applications are pending in the office at the same time, and a patent is issued upon one of them by mistake, without declaring an interference, the rights of the parties will be determined as if both were applicants. *Brookfield & Hemingray v. Brooke*, 4 O. G. 81; *Smith v. Barter*, 7 O. G. 1.

The rights of a prior applicant will not be prejudiced by reason of a patent being issued inadvertently to a subsequent applicant, and the burden of proof rests upon the latter in trial of interference. *Gordon v. Withington*, 9 O. G. 1010.

The *prima facie* case made by a patent having been overcome by evidence of prior invention by the applicant, the burden of proof shifts, and the patentee is required to prove an earlier date in order to establish priority. *Hazlip v. Richardson*, 10 O. G. 747.

If the contest is one of originality, the burden of proof is upon the one charging fraud. *Perrine v. Goldsworthy*, 10 O. G. 980.

If testimony taken upon an interference tends to set up an earlier date for the invention than was claimed in the preliminary statement of the same party, it must at least be viewed with grave suspicion. *Tegmeyer v. Bell*, 3 Dec. Com. 285.

There is nothing in the character of the rights to be determined that precludes the application of the well-established doctrine of estoppel. *Berry v. Stockwell*, 9 O. G. 404.

Testimony taken by parties to an interference, simply to destroy the right of either party to a patent, is not taken in accordance with any provision of law. *Smith v. Perry et al.* 9 O. G. 688.

A patent should not be granted which would be in conflict with one already issued, unless upon such proof that the applicant is the prior inventor as would defeat an action at law for an infringement of the patent before granted. *Gray v. Hale*, 3 Dec. Com. 129.

In an interference, the party upon whom the burden of proof rests must show that he had reduced his invention to a complete form prior to the invention of the same by the patentee. *McKnight v. Van Wagenen*, 9 O. G. 1161; *Cooke v. Chamberlain et al.* 10 O. G. 825.

Drawings prepared for the hearing of the interference are of little weight, though accompanied with proof that they represent such as existed before. *Purdy v. White*, 1 Dec. Com. 22.

The claim of an applicant for a device which has been previously patented to another should be allowed only when the proof absolutely requires it. *John W. Cochran*, 1 Dec. Com. 30; *Wheeler v. Chenoweth*, 1 Dec. Com. 43; *Gates et al. v. Benson*, 2 Dec. Com. 65.

The acknowledgment of one inventor that the right to a patent is in another, is not, after its grant to him, a bar to a subsequent grant of a patent for the same thing to the inventor. *Allen v. Gilman*, 1 O. G. 293.

Merely oral testimony advanced after an opponent has successfully made the invention, and introduced it into practice, is not sufficient to establish priority, unless of the most undoubted character. *Lagowitz v. Topham*, 9 O. G. 742.

In an interference, the claim of a draughtsman to an invention which he has been employed to put into shape is to be viewed with suspicion. *Doughty v. Clark*, 1 Dec. Com. 14; *Spofford v. Moore*, 2 Dec. Com. 6.

The deliberate admission of one party that the invention was another's, for which he was entitled to receive a patent, is conclusive, and can not be avoided in an interference. *Jeffers v. Duchemin*, 2 Dec. Com. 93; *Hewins v. Spooner*, 2 Dec. Com. 94; *J. W. Cochran*, 3 Dec. Com. 78; *Hawkins v. Lambert*, 3 Dec. Com. 273; *Harlow v. Guernsey*, 7 O. G. 513.

The ordinary rules of evidence in the United States courts will be followed and adopted in interference cases. *Berry v. Stockwell*, 9 O. G. 404.

There is a presumption in favor of a patentee upon an interference with an applicant that is not overcome by testimony which only raises a doubt in favor of the latter. *Smith v. Burlew*, 2 Dec. Com. 41; *Stoddard & Perry*, 6 O. G. 33.

A preliminary statement is competent evidence against the party who filed it. *Anson v. Woodbury*, 12 O. G. 1.

Ex parte affidavits taken by an adverse party can not be used to affect the rights of an applicant. *Anson v. Woodbury*, 12 O. G. 1.

The commissioner, without proof, will take notice of matters of public notoriety. *Anson v. Woodbury*, 12 O. G. 1.

An exhibit relied upon by one party to prove that an invention was made at a certain previous time, must show the feature of the invention as described in the claims of the litigant parties. *Kendall & Trested v. Scrymgeour*, 2 O. G. 705.

The admissions of a party may be received in evidence against him, but in such case the whole statement containing such admissions is to be taken together. *Hussey v. Van Wagenen*, 10 O. G. 942.

The parties in their proofs are confined to the dates set up in their preliminary statements. *Merrill v. Glidden*, 11 O. G. 196.

Evidence which has reference to the acts or proceedings of third parties in regard to inventions not those of the parties to the controversy are irrelevant and immaterial. *Miller v. Miles*, 11 O. G. 197.

An allegation that the model has been changed since it was originally filed must be strictly proved. *Merrill v. Glidden*, 11 O. G. 196.

The question which of the parties on the record is the first inventor, is the only one to be tried upon an interference. *Pugh v. Hamilton, John, et al.* 2 Dec. Com. 153; *Crane & Rogers*, 3 Dec. Com. 230; *Dana v. Greenleaf & Adams*, 9 O. G. 198; *Smith v. Perry et al.* 9 O. G. 688.

If a public use is proved in the first interference, occurring more than two years prior to the filing of the new application, it affords good ground for rejecting the latter. *Ritchel v. De Ganno*, 10 O. G. 941.

The date of filing an application is not conclusive of the date of invention, but may be disproved by testimony introduced in rebuttal. *Chapman v. Candee*, 2 O. G. 245.

Testimony taken in rebuttal to show use of the invention at another place than at the establishment during the time mentioned is properly rebutting and not direct evidence. *Chapman et al. v. Morison*, 8 O. G. 1031.

Where one party to an interference took no evidence upon the question of priority in opening his case, he will not be allowed to use any taken in rebutting. *Neal & Adams v. Daniels*, 3 Dec. Com. 156.

The evidence by which a party to an interference establishes his case when taking his rebutting testimony is admissible, the other party making no objection, but admitting the same facts upon cross-examination. *Michael v. Kenney*, 2 Dec. Com. 140.

Disolution.

Where the proof shows that neither party made the invention, the question of priority is at an end, and there can be no further interference. *Weston v. Hunt & Turner*, 3 Dec. Com. 68; *Pugh v. Hamilton*, 3 Dec. Com. 116; *Waters et al. v. Yost et al.* 8 O. G. 517.

An interference will be dissolved where the inventions are shown to be radically different, and designed for different purposes. *Jackson v. Nichols*, 3 Dec. Com. 278; *J. W. Evans et al.* 3 O. G. 180; *Sherwood v. Searles*, 1 Dec. Com. 112; *Stearns v. Wingfield*, 3 Dec. Com. 67; *Pearl & Sawyer*, 5 O. G. 694.

An interference will not be dissolved upon *ex parte* affidavits showing a public use and sale for more than two years prior to the application. *Wyman v. Knowles*, 11 O. G. 196.

An interference will be dissolved if it appears that the claim of one of the parties put in issue was not shown or described in the other application. *Dodd v. Cobb*, 10 O. G. 826.

An interference will be dissolved when it is discovered the invention in controversy is not patentable. *Lynch & Raff v. Dryden & Underwood*, 3 O. G. 407; *Dunton, Young & McFerran*, 10 O. G. 243.

When it appears from the preliminary statement that the party making it has abandoned his invention, or is not entitled to a patent for any other reason, the interference will be dissolved, and his application will be rejected. *Schenck v. Rider*, 2 Dec. Com. 135.

Where all the parties claim nothing but what is shown to be old, the interference will be dissolved, although some of them show novel features in their arrangements. *Kafer & Gould v. Dennison*, 1 Dec. Com. 14.

When, in the judgment of the examiner of interferences, the interference has been improperly declared, and the case has passed beyond the jurisdiction of the primary examiner, it may be referred to the commissioner in person. *Lloyd v. Engeman*, 2 O. G. 674.

An interference between an applicant for a patent on one hand, and two joint applicants on the other, will be dissolved, if it proves that one alone of the joint applicants made the invention before the adverse party. *Weston v. Hunt & Turner*, 3 Dec. Com. 68; *Pugh v. Hamilton*, 3 Dec. Com. 116; *Crane & Rogers*, 3 Dec. Com. 230.

A party to a pending interference can withdraw only such claims as cover devices not involved in the interference, so that, if he obtains a patent for them on a separate application, it shall not prejudice the interests of the other party. *Hermance v. Bussey*, 3 Dec. Com. 216.

If an interference is dissolved upon the withdrawal of his application by

one of the parties, this does not entitle the other to a decision in his favor on the question of priority. *Eames v. McDougall*, 3 Dec. Com. 206.

After the declaration of an interference it can not be dissolved, except by the order of the examiner in charge of interferences, or the commissioner, or by the board of examiners in chief or commissioner on appeal. *Traut v. Disston*, 2 Dec. Com. 99.

A motion to dissolve an interference on the ground that the applicant's invention is not patentable, may be made before the examiner of interferences after the testimony has been taken. *Lynch v. Dryden*, 3 O. G. 407.

During an interference, the primary examiner may request its suspension for the purpose of considering new references. *Anson v. Woodbury*, 11 O. G. 243.

If the claim in interference is broader in scope than the special devices shown by any of the parties, the subject-matter involved can not be limited to just what is shown by either of said parties. *Lacroix & Welch*, 4 O. G. 526.

Rehearing.

A motion to open an interference for a rehearing, after a decision, will be refused where there is gross negligence in preparing for it. *Covel v. Maxim & Radley*, 1 Dec. Com. 78; *Aldrich & Spalding v. Bingham*, 3 Dec. Com. 90; *Hamilton v. Fisher*, 3 Dec. Com. 271.

A motion to open an interference for a rehearing will be granted when new evidence has been found which is material to the issue. *Disston v. Emerson*, 2 Dec. Com. 84.

To entitle a party to a reopening of his case, on the ground of newly discovered evidence, it must be shown that it was either discovered since the case was decided, or could not have been earlier obtained. *Merrill & Merrill v. Glidden*, 10 O. G. 862.

If it appears that the testimony was not newly discovered, but was in the possession of the party from the beginning of the proceedings, an interference will not be reopened. *William S. Gillen*, 11 O. G. 419.

A rehearing in an interference case can only be granted on a showing of such merits as would entitle a mover to a new trial in a suit at law. *L. C. Pattee*, 2 O. G. 618; *Marsh v. Dodge*, 2 O. G. 643; *Dod v. Cobb*, 10 O. G. 462; *Merrill & Merrill v. Glidden*, 10 O. G. 863.

A case will not be reopened merely to oblige a party who has purchased an interest in an invention which was, unknown to the party, in interference. *Mason, Imlay & Co.* 2 O. G. 274.

Decision.

Where one of two, who have taken out a joint patent as joint inventors, files an application claiming the same invention as made by himself alone, the patent will not be disturbed if the facts are disputed. *De Lill v. Avery*, 2 Dec. Com. 128; *Joseph Barsaloux*, 9 O. G. 883.

Judgment of priority is conclusive not only on interfering matters which were claimed, but on all which might have been claimed. *Harlow v. Guernsey*, 7 O. G. 513; *Whiteley v. McCormick*, 10 O. G. 826.

Where each applicant claims to have made the invention several years previous to their applications, and one has been steadily making and selling the article, no patent will be issued to either. *Love v. Howe*, 1 Dec. Com. 66.

Where there is a doubt whether the only invention to which the successful party in an interference is found to be entitled is new, his application should be referred back to the examiner to investigate the question. *Hovey v. Hufeland et al.* 2 O. G. 493; *Wood v. Morris*, 4 O. G. 131.

After the determination of an interference a new one should not be declared without the order of the commissioner. *Hovey v. Muller*, 3 O. G. 149.

Whether the party to whom priority of invention is awarded shall receive a patent is not to be decided by the interference proceeding, but as an *ex parte* matter. *Little v. Lillie*, 10 O. G. 543.

The decision upon an interference does not establish the rights of the parties, so as to preclude the office from examining into them again on new grounds, while their applications are still pending. *Abraham v. Fletcher*, 1 Dec. Com. 50.

The commissioner may declare more than one interference, and a hearing and decision between the applicant for a patent and A., whether in favor of one or the other, forms no rule for a decision between the applicant and B. in the case of an interference declared. The proceedings are independent and *inter vivos*. *Potter v. Dixon*, 2 Fish. 381.

If the examiners in chief discover a reason not given by the primary examiner why a patent should not issue, they should not remand the case to him, but should make a statement to the commissioner. *William S. Smoot*, 11 O. G. 1010.

SEC. 4905. The commissioner of patents may establish rules for taking affidavits and depositions required in cases pending in the patent office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides.

Statute Revised—July 8, 1870, ch. 230, § 43, 16 Stat. 204.

Prior Statutes—March 3, 1839, ch. 88, § 12, 5 Stat. 355.—March 2, 1861, ch. 88, § 1, 12 Stat. 246.

SEC. 4906. The clerk of any court of the United States, for any district or territory wherein testimony is to be taken for use in any contested case pending in the patent office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or territory, commanding him to appear and testify before any officer in such district or territory authorized to take depositions and affidavits, at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him.

Statute Revised—July 8, 1870, ch. 230, §§ 44, 45, 16 Stat. 204.

Prior Statute—March 2, 1861, ch. 88, § 1, 12 Stat. 246.

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

Statute Revised—July 8, 1870, ch. 230, § 45, 16 Stat. 204.

Prior Statute—March 2, 1861, ch. 88, § 1, 12 Stat. 246.

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

Statute Revised—July 8, 1870, ch. 230, §§ 44, 45, 16 Stat. 204.

Prior Statute—March 2, 1861, ch. 88, § 1, 12 Stat. 246.

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

Statute Revised—July 8, 1870, ch. 230, § 46, 16 Stat. 204.

Prior Statutes—March 2, 1861, ch. 88, §§ 2, 3, 12 Stat. 247.—June 27, 1866, ch. 143, § 1, 14 Stat. 76.

If the examiners in chief decide that the applicant was the prior inventor, and then remand the case to the primary examiner to inquire whether he has abandoned his invention, the other party can not appeal from the latter decision. *Bigelow v. Thatcher*, 2 McArthur, 24.

When the applicant appeals, the case is closed before the primary examiner, unless it is regularly remanded with leave to amend, or with directions for a further examination. If it is so remanded, the case is reopened below, and can not return to the appellate court until the applicant has responded to the new examination, either by amendment or fresh appeal. *Alice Appleton*, 1 Dec. Com. 8.

When a case is appealed to the examiners in chief, the primary examiner loses jurisdiction over it, except to enter such amendment of the specification as may be required by the board, and pass the case for issue, and can not require any other amendment. *H. J. Brunner*, 1 O. G. 303.

The applicant, in taking an appeal from the primary examiner, can not add amendments to the claim which were not considered by him. *H. Hammond*, 2 O. G. 57; *Barker & Mack*, 4 O. G. 155.

An appeal to the examiners in chief lies only from such action of the primary examiner, as is judicial in its nature, that is, such as respects the patent-

ability, novelty, or utility of an invention. John A. Krake, 1 Dec. Com. 100; Richard L. Morton, 3 Dec. Com. 169.

The appeal to the examiners in chief, is to be taken from the decision or judgment of the principal examiner, not from the reasons he assigns for it. A. C. Rockwell, 2 Dec. Com. 111.

The board of examiners in chief, is the judge of the sufficiency of the reasons of appeal. Charles L. Young, 8 O. G. 643.

The board is limited in its revision of cases appealed from the decisions of the primary examiners to the record presented by the appeal. John T. Jones, 5 O. G. 58.

If it is denied that any improvement has been made in an invention, the objection goes to the merits, and an appeal may be taken to the examiners in chief. Henry C. Sergeant, 9 O. G. 963.

Where the examiner alleges that a device is in common use, the applicant may ask for more specific references; but if he does not, he admits the allegations to be true. Ellis & Albertson, 1 Dec. Com. 8.

No case should be appealed until it is in such condition that a patent may at once issue if the examiner be reversed. H. Mewes, 2 O. G. 617.

Objections should be specific and accompanied with the grounds for them, so that amendments can be made and appeals taken upon definite points. H. H. Evarts, 5 O. G. 429.

If an examiner finds that the claims in an application are the same as those which have been condemned in a former case by the examiners in chief, he should reject it on the authority of their decision; he should not refuse to examine it. D. M. Nichols, 2 Dec. Com. 71; Duthie v. Casilear, 2 Dec. Com. 99.

All special amendments approved for examination by the board or commissioner, are subject to revision or restriction by the principal examiner in the same manner as original amendments. Duncan S. Farquharson, 10 O. G. 702.

If a case is remanded to the examiner for further consideration, he should consider and report upon the specific points raised by the board only. D. M. Kirkbride, 9 O. G. 1109.

Cases which have been heard and decided by the examiners in chief will not be reheard by them, except upon the order of the commissioner. Edwin Strain, 2 Dec. Com. 75.

If the rejection of the application is on the ground that it does not present the proper subject-matter for a patent, the appeal should be to the board of examiners, and not to the commissioner. Otto Pressprich, 11 O. G. 195; Henry M. Underwood, 1 O. G. 551.

If the primary examiner rejects an application for a patent for a combination, because the arrangement is not patentable as a combination, no references should be cited until the question of form is settled, and an appeal lies to the commissioner although they are. Daniel J. La Duc, 1 O. G. 549; L. L. Ellis, 9 O. G. 1110.

The reasons given by the examiner that go to the merits of the case for his rejection, can not be brought before the commissioner of patents on interlocutory appeal. David Edwards, 9 O. G. 793.

Objections as to new matter in a reissue, and to the character of a combination, relate to the merits, and are not proper subjects of an interlocutory appeal. Jeremiah Keith, 9 O. G. 744.

Only such matters as affect office practice, and are interlocutory in their nature, are appealable direct to the commissioner. D. L. Proudfit, 10 O. G. 585.

If a claim is rejected for want of clearness in not defining any invention whatever, an appeal lies to the commissioner. A. Godillot, 6 O. G. 641.

An appeal from the decision of a principal examiner, requiring the division

of an application, must be taken to the commissioner in person. Ljrus Yale, Jr. 1 Dec. Com. 110; Leopold Lehman, 2 Dec. Com. 70.

If the question decided by the examiner, is that the claim is for a function merely, an interlocutory appeal will lie to the commissioner of patents. Jeremiah Keith, 9 O. G. 793.

SEC. 4910. If such party is dissatisfied with the decision of the examiners in chief, he may, on payment of the fee prescribed, appeal to the commissioner in person.

Statute Revised—July 8, 1870, ch. 230, § 47, 16 Stat. 205.

Prior Statute—March 2, 1861, ch. 88, § 2, 12 Stat. 247.

If the applicant has made an assignment which leaves him merely an equitable interest, he can not take an appeal. Martin v. Olney, 9 O. G. 1107.

Where the commissioner has been counsel in a case, no examination of the merits will be entered into, but the decision of the examiners in chief will be affirmed, *pro forma*. Waters v. Taylor, 1 Dec. Com. 21; Fortin & Drake, 1 Dec. Com. 26.

In an interference, the question of novelty should first be disposed of, and when that question is raised it controls the matter of jurisdiction of the commissioner in deciding upon the rights of the parties. Bennage v. Phillippi, 9 O. G. 1159.

Upon a question of fact arising in an interference, the conclusions of the principal examiner, and of the examiner in chief are entitled to consideration, and the benefit of a doubt will be given to their finding. Fawcett v. Graham, 1 Dec. Com. 113.

Cases will not be taken up out of their turn, upon appeals to the commissioner, even where inventors come in person to attend to their applications. Hewins v. Spooner, 2 Dec. Com. 94.

It is a rule of long standing that a case deliberately decided by one commissioner will not be disturbed by his successor. John L. Mason, 2 Dec. Com. 20.

Upon appeals to the commissioner, additional evidence may be introduced sustaining the right to an extension. Samuel G. Lewis, Ex'r, 2 Dec. Com. 181.

The duty of the commissioner in cases involving only questions of fact, is discharged when he has so far examined the case as to find that the decision of the board is not against the manifest weight of the evidence. Blanchard v. Strain, 2 Dec. Com. 54; Fawcett v. Graham, 1 Dec. Com. 113; White v. Purdy, 2 Dec. Com. 115.

The concurrent decisions of lower tribunals upon questions of fact, will not be set aside upon appeal, except for manifest error. Hazelip v. Richardson, 10 O. G. 747.

A case will be remanded to the primary examiner, at his request, for the purpose of giving further references to the applicant. Israel Townsend, 2 Dec. Com. 97.

SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the commis-

sioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

Statute Revised—July 8, 1870, ch. 230, § 48, 16 Stat. 205.

Prior Statutes—July 4, 1836, ch. 357, § 7, 5 Stat. 119.—March 3, 1839, ch. 88, § 11, 5 Stat. 354.—August 30, 1852, ch. 107, § 1, 10 Stat. 75.

The only appeal is from a refusal to grant a patent. *Pomeroy v. Connison*, Cranch Pat. Dec. 112.

If the commissioner holds that a party applying for a patent "is not the original and first inventor," and decides against him upon that ground, the applicant can take an appeal from his decision. The commissioner, having reached this conclusion, is under no obligation to go further and examine any other question arising in the case, and it is not necessary to the right of appeal that he should do so. *Commissioner v. Whiteley*, 4 Wall. 522.

If the commissioner decides that the applicant is not such a person as is entitled by law to a reissue, the applicant has a right under the statute to appeal from this decision, whether right or wrong. This preliminary question is as much within the scope of his authority as any other which can arise, and having resolved it in the negative, there is no necessity for him to look further into the case. *Commissioner v. Whiteley*, 4 Wall. 522.

The jurisdiction of the appellate court is limited upon appeals from the commissioner of patents, and it has no authority to order a reissued patent to be antedated to the time when the application for reissue was filed. *Whiteley & Gage*, 1 Dec. Com. 53; *Andrew Whiteley*, 1 Dec. Com. 70.

The only question intended to be cut off from appeal beyond the commissioner in a case of interference is the question of priority of invention. *W. Weitling et al. v. S. G. Cabell et al.* 2 O. G. 223; *vide Bain v. Morse*, 6 West. L. J. 372.

No appeal lies from the refusal of the commissioner to issue a patent to an assignee whose assignment was not recorded until a patent had issued to his assignor, and a mandate from an appellate judge requiring it will not be regarded. *Andrew Whiteley, Assignee*, 1 Dec. Com. 79.

The appellate court can not declare an amended specification entitled to a patent which has never been received or examined at the office. *Whiteley & Gage*, 1 Dec. Com. 53.

Where it is conceded the facts are in substance the same as in a case in which the supreme court has rendered a decision, it is the duty of the commissioner to apply such decision without regard to his individual opinion of the law. *Mason v. Doellbor & Houghton*, 1 Dec. Com. 26; *Shaw & Leavitt v. Sedgebeer*, 2 Dec. Com. 5.

In the absence of positive expression of opinion on the part of the appellate judge upon a given point, and of information as to the nature or scope of the discussion before him, a *pro forma* rejection will be given, in order that an appeal may be taken. *John L. Mason*, 2 Dec. Com. 35; *Timothy Gordon*, 2 O. G. 29.

SEC. 4912. When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the patent office, within such time as the commissioner shall

appoint, his reasons of appeal, specifically set forth in writing.

Statute Revised—July 8, 1870, ch. 230, § 49, 16 Stat. 205.

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

Statute Revised—July 8, 1870, ch. 230, § 51.

SEC. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the patent office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

Statute Revised—July 8, 1870, ch. 230, § 50, 16 Stat. 205.

The supreme court is limited to the reasons of appeal, for the appeal is only an appeal from so much of the decision as is affected by the reason. *Arnold v. Bishop*, Cranch Pat. Dec. 109; *Smith v. Flickenger*, Cranch Pat. Dec. 116.

The supreme court can only examine into the reasons of appeal, and the record and proceedings as far as they apply thereto, for the purpose of ascer-

taining whether the commissioner has made an erroneous decision, and can not revise the decision on any other ground than that upon which the application was rejected. *In re E. S. Conklin, 1 McArthur, 375; S. C. 5 O. G. 235.*

An officer or counsel of the patent office may appear and argue the questions involved in the appeal. *Perry v. Cornell, Cranch Pat. Dec. 130.*

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

Statute Revised—July 8, 1870, ch. 230, § 52, 16 Stat. 205.

Prior Statute—March 3, 1839, ch. 88, § 10, 5 Stat. 354.

If the application is not brought before the commissioner by an appeal from an adverse decision of the examiners, but simply comes before him with a report of the examiners, and he withholds the patent in virtue of his general supervisory authority, the remedy is not by an appeal to the supreme court, but by a bill in equity under this section. *Hull v. Commissioner, 7 O. G. 559; S. C. 8 O. G. 46; S. C. 2 McArthur, 90, 125.*

For practice under this section, see *Greeley v. Commissioner, 6 Fish. 675; S. C. 1 Holmes, 284; 4 O. G. 612; Prentiss v. Ellworth, 2 Whart. Dig. 365.*

SEC. 4916. Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law,

cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

Revised Statute—July 8, 1870, ch. 230, § 53, 16 Stat. 205.

Prior Statutes—July 3, 1832, ch. 162, § 3, 4 Stat. 559.—July 4, 1836, ch. 357, § 13, 5 Stat. 122.—March 3, 1837, ch. 45, §§ 5, 8, 5 Stat. 192, 193.

When Surrender Allowed.

As the commissioner is an officer of special and limited power, his action in granting a reissue must be restricted to the particular cases mentioned in the statute. In *re E. S. Conklin*, 1 McArthur, 375; S. C. 5 O. G. 235; *Child v. Adams*, 1 Fish. 189; S. C. 3 Wall. Jr. 20.

The statute embraces only the right to a reissue where, from an unintentional error in the description of the invention, the patent is wholly "inoperative or invalid." It is not enough that the applicant for the reissue shall state that the patent is not fully valid and available to him. This does not meet the clear and explicit requirement of the statute. *Whitely v. Swayne*, 4 Fish. 117; S. C. 7 Wall. 685.

If the original patent is neither inoperative nor invalid, and if no error has

been occasioned by accident or mistake, the presumption is that the patentee abandoned to the use of the public everything which he may have invented, but did not include in his claim or specification. *In re E. S. Conklin*, 1 McArthur, 375; S. C. 5 O. G. 235.

Inventors are not usually sufficiently skilled in the art of nice composition to enable them to accurately draft their own specifications. They must therefore resort to others, and it not infrequently happens that the draftsman employed to describe a particular invention, either through want of skill, or haste, or ignorance of the state of the art, gives in the specification a very imperfect description of the thing invented. He sometimes narrows the scope of the inventor's ideas and combinations, and at other times expands them over instruments and devices which are not the product of his original thought. He may fail to set forth some feature of the invention which at the time is deemed unimportant, and which subsequently may be proved to be vital, or at least of great value. If the invention is of considerable pecuniary consideration, the public examine it with scrutinizing eyes, and if an inch of ground within the true scope of the discovery is unoccupied by the specification, it is at once seized upon by parties to whose business the new improvement has a near relation. If a fatal or damaging error has crept into the description, that fact is soon ascertained by those who desire to avail themselves of whatever improvement has been discovered. The privilege of surrender and reissue is, therefore, invaluable to inventors, for without it they would often lose that protection for the offspring of their skill and labor, which it is the immediate object of all patent laws to afford. *Blake v. Stafford*, 3 Fish. 294; S. C. 6 Blatch. 195.

It not infrequently happens, that a judicial interpretation of the specification or claim of a patent, or both, discloses to the inventor and patentee for the first time the defects in the instrument, and shows him that he has unwittingly restricted his rights within narrower limits than his discovery, or so inartificially described his invention, that he has failed to secure any substantial advantage by it. Such a disclosure furnishes a proper occasion for a surrender and reissue when the error was inadvertent and is clearly within the beneficent design of the statute. *Poppenhusen v. Falke*, 2 Fish. 213; *Doughty v. West*, 3 Fish. 580; S. C. 6 Blatch. 429; *Bliss v. Gaylord Manuf. Co.* 6 Blatch. 179.

It matters not how or when the patentee discovered the mistake, provided it was a mistake. The real question is, whether or not the invention described in the new specification is a part of the original invention. *Poppenhusen v. Falke*, 2 Fish. 181; S. C. 4 Blatch. 493.

If the specification is defective or doubtful in some particulars, the patent may be surrendered for the purpose of making the description more clear, although it is not void. *Woodworth v. Hall*, 1 M. & W. 248; *Parham v. Sewing Machine Co.* 4 Fish. 468.

The provision allowing a surrender may perhaps be regarded more justly as affirming the propriety of the usage which had obtained under the former laws and had been repeatedly recognized by the courts, and as prescribing in addition the conditions and incidents which should attach to it thereafter. It is hardly to be supposed that the merely clerical error of an engrossing

subordinate, or the accidental inadvertence of the commissioner himself, is not capable of being rectified or supplied now, just as it was before the adoption of this provision. *French v. Rogers*, 1 Fish. 133; *Morris v. Huntington*, 1 Paine, 348; *Grant v. Raymond*, 6 Pet. 218.

An error in the date from which the patent for an invention which has been patented in a foreign country begins to run, may be corrected by a reissue. *Buerk v. Valentine*, 5 Fish. 366; s. C. 9 Blatch. 479; 2 O. G. 295.

It is the duty of the commissioner to correct errors in the letters patent when applied to, and to minute the correction on or in them, as these matters are between him, representing the government, and the patentee. He need not resign or reseal the letters, for he adopts them as his own acts by redelivering the patent after it is amended, as much as he adopts the writing of it on the paper or parchment. The record or enrollment must be made to correspond with the letters as amended. *Woodworth v. Hall*, 1 W. & M. 248, 349; *Vulcanite Co. v. Wetherbee*, 3 Fish. 87; s. C. 2 Cliff. 555.

A patent which has been extended, may be surrendered and a reissue granted. *Gibson v. Harris*, 1 Blatch. 167; *Wilson v. Rosseau*, 4 How. 646; s. C. 1 Blatch. 3.

The new patent is substituted for the old one, with just the same effect and operation in law, as if the specification had been filed first in the form which it takes in the reissue. This substitute, having all the legal attributes of the original, may therefore be amended also. The surrender and reissue may follow each other just as often as the patentee is content to be more specific or more modest in his claims. *French v. Rogers*, 1 Fish. 133; *Morse v. Bain*, 9 West. L. J. 106.

A reissue has been upheld when the surrender was made more than sixteen years after the first patent was issued. It has also been said, that a patent which had been extended to twenty-one years under the general law, and afterward extended to twenty-eight years by special act of Congress, might be surrendered and reissued after the term of twenty-one years had expired. *Hussey v. Bradley*, 2 Fish. 362; s. C. 5 Blatch. 134.

The surrender and the reissue, no matter how often they recur, are reciprocal, each in consideration of the other, and forming together but a single act between the parties. It would be unconscientious to retain the consideration while denying the validity of the grant. If the reissue is invalid for want of authority to make it, the surrender is ineffective for want of authority to accept it, and so the patent stands as if there had been no surrender. *French v. Rogers*, 1 Fish. 133; *Woodworth v. Hall*, 1 W. & M. 389; *Woodworth v. Edwards*, 3 W. & M. 120.

Practice.

The statute does not in terms require that a surrender shall be in writing. Patents may doubtless be surrendered on petition or by delivery, as the rules of the patent office may prescribe. *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; s. C. 2 Cliff. 555.

An applicant for a reissue who has filed his application with the acting commissioner, and paid the requisite amount of fees, has done all in his

power to make his application effectual, and has a right to consider it properly before the commissioner. *Commissioner v. Whiteley*, 4 Wall. 522.

It is the first duty of the commissioner to receive the application, whatever he may do subsequently. Without this initial step there can be no examination, and indeed no rightful knowledge of the subject on his part. *Commissioner v. Whiteley*, 4 Wall. 522.

If no oath is made to the specification, the reissue is void. *Whiteley v. Swayne*, 4 Fish. 117; S. C. 7 Wall. 685.

The application for a reissue may be withdrawn under leave of the commissioner, at any time before the proceedings are fully completed and duly recorded. The reissued letters patent, as a general rule, have the effect to supersede the original patent, but a pending application for that purpose can not receive any such construction, no matter how nearly the proceedings may have approached to a consummation, so long as they are not finally completed. Prior to the issuing of the new patent, what is called a surrender in the case, is, in general, nothing more than a preliminary offer to that effect as the necessary means of obtaining a reissue, and even when not so intended in the outset, it may be subsequently so treated by the commissioner, at the request of the party applying for the reissue. Where bad faith is shown as an element of the case, a different conclusion would doubtless follow; but the withdrawal of the application may be allowed by the commissioner for any reasonable cause, where there is no fraud practiced to procure it, and where there is no prejudicial interference with the rights of third persons. *Forbes v. Barstow Stove Co.* 2 Cliff. 379.

The issuing of one set of new letters patent for the three different terms before existing, when the old specification is sought to be corrected, is open to some questions concerning its legality. The most obvious mode would be to renew each separately, or renew only the old letters and their specification, and let the others be cured or aided by relation back to the original one. *Woodworth v. Hall*, 1 W. & M. 248, 389.

If the reissue states that the original patent was surrendered and canceled, the presumption of law in the absence of any proof to the contrary, is that the statement is correct, and that the surrender was made according to law and the rules of the patent office. An erroneous description of the patent in the application will not affect the reissue, if there is no error in the records of the patent office. *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; S. C. 2 Cliff. 555.

The new patent, in case of reissue, should be granted for the unexpired term only. *Woodworth v. Stone*, 3 Story, 749.

A reissue is made to cover the unexpired period of the original patent, and is therefore antedated. *Whitely v. Fisher*, 4 Fish. 248.

It is questionable whether any evidence is competent or admissible in an action between third persons involving the validity of the patent, to show that the officer who signed it was not legally appointed, the power of the officer himself not being put directly in issue in a proceeding where he is a party. *Woodworth v. Hall*, 1 Wood. & M. 389.

The signature of a person as acting commissioner, carries as much verity and legality on the face of a certificate to a patent, as that of the commis-

sioner himself, until it be shown, if it can be properly, that the acting appointment was not in truth made in the manner authorized by law. *Woodworth v. Hall*, 1 Wood. & M. 248, 389.

It would seem to be necessary to have the Secretary of the Interior sign anew or assent to an amendment of an error in a patent, as he is a distinct officer, and without signing anew or assenting would not authenticate the letters as amended. *Woodworth v. Hall*, 1 Wood. & M. 248, 389.

The commissioner has no authority to grant a reissued patent. That belongs to the Secretary of the Interior; consequently the commissioner is not liable for refusing to make the grant. If the Secretary of the Interior executes the patent, and it awaits the counter-signature of the commissioner and the seal of the office, and the commissioner maliciously refuses to countersign and affix the seal of the office, he will be liable. *Whitely v. Fisher*, 4 Fish. 248.

If an attorney, employed to obtain a reissue, discovers in the course of his investigations for that purpose, that one claim is in conflict with a prior patent, which he thereupon purchases, such purchase will not inure to the benefit of his client. *Hoffheins v. Brandt*, 3 Fish. 218.

Parties to Surrender.

The sole right to surrender is given (1) to the patentee, if he is alive and has made no assignment of the original patent; (2) to the executor or administrator of the patentee after his decease, when there has been no such assignment; (3) to the assignee when there has been an assignment of the original patent. The right to surrender is given to no one else. *Potter v. Holland*, 1 Fish. 382; S. C. 4 Blatch. 206; *Smith v. Mercer*, 5 Penn. L. J. 529; S. C. 4 West. L. J. 49.

It is not in the power of the patentee, by the surrender of his patent, to affect without their consent, the rights of third persons to whom he has previously passed his interest in the whole or a part of the patent. This consent may be manifested either by joining in the surrender with the patentee, or by previously authorizing it, or by subsequently ratifying or approving it. To take advantage and benefit of it would be a ratification. When such consent is given, the right of the party so consenting in and to the old patent are forever gone. It may, too, be considered as a sound and settled principle, that a person to whom the patentee has passed his interest in part of the old patent, is entitled, upon a surrender of the same by the patentee, and the obtaining of a reissued patent, to the same right under the reissued patent that he had to the old one. The patentee can not, by taking a reissue, deprive him of the same right to it that he had to the old one, if he wishes to take the benefit of such right. But when he does take advantage and benefit of the reissued patent, he consents to give up, and does give up, the right which he had under the old one. It does not follow from this, however, that because a third person to whom a patentee has passed his interest in a part of the patent, is entitled to the same right to a reissued patent that he had to the old one, he is compelled to take under the reissued one, and thereby compelled to give up the right which he had under the old one. If he were, his rights might be injuriously

affected without his consent. If he were so compelled, an assignee under the old patent of an exclusive territorial right would be forced, without his consent, to give up damages which he might be entitled to under the old patent for a violation of rights secured to him by that patent. And it might so happen that the old patent surrendered was a valid one, and that the reissued one was invalid, or that the rights secured by the former were important, while the rights secured by the latter were of little consequence. Third persons can, therefore, hold under the old patent notwithstanding the surrender and reissue. *Potter v. Holland*, 4 Blatch. 206; *Smith v. Mercer*, 5 Penn. L. J. 529; S. C. 4 West. L. J. 49; *Woodworth v. Stone*, 3 Story, 749; *Washburn v. Gould*, 3 Story, 122; *McBurney v. Goodyear*, 11 Cush. 569.

Where there has been an assignment of an undivided part of the whole original patent, the assignee of such part and the patentee become joint owners of the patent, and should join in the surrender, and if they do not, it will be invalid unless the part owner not joining shall ratify it. *Potter v. Holland*, 1 Fish. 382; S. C. 4 Blatch. 206.

There is no provision requiring that the original patentee, after an assignment of his interest, shall assent to the reissue. And a reissue, without such concurrence, is valid. *Swift v. Whisen*, 3 Fish. 343; S. C. 2 Bond, 115.

If a reissue is granted to the patentee after the execution of an assignment, but before it is placed on record in the patent office, the assignee has no right to demand that a reissue shall be granted to himself, and if he does, and is refused, the action of the commissioner in so refusing, is not the subject of an appeal to a judge. It raises merely an issue between the office and the assignee with regard to an existing patent, and not an issue over the merits of the patent. The law providing an appeal to the appellate judge, has reference to the contents of a patent, and not to a controversy between parties as to who owns it, where the patent has been granted. *Whitely v. Fisher*, 4 Fish. 248.

New letters, with an amended specification, is the same invention as that covered by the original patent, and a conveyance of it once, therefore, for a specified term, is good for the term, whether an amended specification is filed or not before the term closes. *Woodworth v. Hall*, 1 Wood. & M. 248, 389.

There is nothing in the terms of the statute which limits the right of reissue to the patentee or first assignee. A reissue to subsequent assignees is valid. *Swift v. Whisen*, 3 Fish. 343; S. C. 2 Bond, 115.

If the reissue recites a prior assignment of the patent, it is *prima facie* evidence thereof. *Middletown Co. v. Judd*, 3 Fish. 141.

If the reissue recites that the original patent had been assigned to the party to whom the reissue is granted, it is conclusive. *Hoffheins v. Brandt*, 3 Fish. 218.

If a patentee who has parted with his title, makes a surrender at the request of the owner, and after obtaining a reissue assigns that to the real owner, the reissue will be deemed valid as against an infringer. *Wing v. Warren*, 5 Fish. 548; S. C. 2 O. G. 342.

Where an assignment covers the whole interest of an inventor, present and prospective, it is more regular that the application for a surrender should be made by the assignee, but even in that case the reissue will not be void, if the

assignment is duly recorded in the patent office, and the application for the surrender and reissue is made with the consent of the assignee. If the reissue is correct in form, and there is no proof of fraud, intentional error, or concealment, a mere wrong-doer can not defend himself against the charge of infringement by proving that the proceedings which led to the reissue were irregular, unless it is shown that the proceedings were contrary to law, or that the patent was granted to the wrong party. *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; S. C. 2 Cliff. 555; *Woodworth v. Stone*, 3 Story, 749; *Meyer v. Bailey*, 8 O. G. 437.

If the assignee adopts a surrender applied for by the patentee, and accepts the new patent, he is estopped to deny either the authority of the applicant or that of the commissioner. The patentee can not complain, because it was his own act. The government can not complain, because there is but one patent for the invention. Third parties can not, therefore, raise any objection. *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; S. C. 2 Cliff. 555.

There is nothing in the statute which restricts the right of a patentee to make a surrender, because he has previously made special or limited grants. *Smith v. Mercer*, 5 Penn. L. J. 529; S. C. 4 West. L. J. 49.

A grantee of an exclusive territorial right need not unite in the application for a reissue. *Meyer v. Bailey*, 8 O. G. 437; *Commissioner v. Whiteley*, 4 Wall. 522.

A mere license having no legal right in the patent need not join in the surrender. *Potter v. Holland*, 1 Fish. 327; S. C. 4 Blatch. 206; *Forbes v. Barstow Stove Co.* 2 Cliff. 379.

The reissue may be made in the name of the administrator of the patentee, for an invention is personal property, and possesses value beyond the first patent on it, being valuable for purposes abroad as the ground for a patent there, and also for a renewal at home. *Woodworth v. Hall*, 1 Wood & M. 248, 389.

Where a reissue is granted to an administrator, it will be taken for granted that the person in whose name the patent was issued established his legal right to it before the commissioner, and the court can not go behind the grant to ascertain whether this was so or not. *Northwestern Co. v. Philadelphia Co.* 6 O. G. 34; S. C. 31 Leg. Int. 148; *Woodworth v. Hall*, 1 Wood & M. 248, 389; *Goodyear v. Hullioen*, 3 Fish. 251.

A grant in case of a reissue in trust for the heirs-of-law of the patentee, their heirs, administrators or assigns, is at most a mere verbal error, if the trust has any validity whatever, for the new patent will, by operation of law, enure to the sole benefit of the parties in whose favor the law designed it should operate, and not otherwise. *Woodworth v. Stone*, 3 Story, 749.

An executor of the patentee may surrender the patent and obtain a reissue. *Carew v. Boston Elastic Fabric Co.* 5 Fish. 90; S. C. 1 Holmes, 45; 1 O. G. 91.

If one of several executors surrenders a patent, and takes a reissue to himself as executor, the grant vests the legal title in him exclusively. The suffix of executor signifies the trustee character in which he assumed to act, and in which he was recognized and dealt with by the commissioner. The designation and trust which it implies does not prevent the passage of the legal

title, or qualify the estate which accompanies it. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

When Decision of Commissioner Conclusive.

The specification may be defective or insufficient either by a mistake of law as to what is required to be stated therein in respect to the claim of the inventor, or by a mistake of fact in omitting things which are indispensable to the completeness and exactness of the invention, or of the mode of constructing or making or using the same. Whether the invention claimed in the original patent and that claimed in the new amended patent, is substantially the same, is and must be in many cases a matter of great nicety and difficulty to decide. It may involve considerations of fact as well as of law. Who is to decide the question? The true answer is, the commissioner of patents; for the law intrusts him with the authority not only to accept the surrender, but to grant the new amended patent. He is bound, therefore, by the very nature of his duties, to inquire into and ascertain whether the specification is definite or insufficient in point of law or fact, and whether the inventor has claimed more than he invented, and in each case, whether the error has arisen from inadvertency, accident or mistake, or with a fraudulent or deceptive intention. No one can well doubt that in the first instance, therefore, he is bound to decide the whole law and facts arising under the application for the new patent. *Prima facie*, therefore, it must be presumed that the new amended patent has been rightfully granted by him. *Allen v. Blunt*, 3 Story, 742; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 576; *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448.

It is not necessary for the reissued patent to contain any recitals that the prerequisites to the grant of it have been duly complied with, for the law makes the presumption. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 576.

The power of accepting the surrender of the original patent, and of granting a reissue of it, is confided exclusively to the commissioner, and is to be exercised judicially by him. The presumption is that he has exercised it lawfully, and that the reasons for which alone its exercise could be invoked have been sufficiently shown to exist. His decision is final, and is to be treated as foreclosing all inquiry into the existence or sufficiency of the facts which are prescribed as necessary to authorize him to grant a reissue. *Parham v. Sewing Machine Co.* 4 Fish. 468.

All matters of fact involved in the hearing of an application to reissue a patent, and in granting it, are conclusively settled by the decision of the commissioner granting the application. Matters of construction arising on the face of the instrument are still open, but all matters of fact connected with the surrender and reissue are closed in a suit for an infringement by the decision of the commissioner. *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Jordan v. Dobson*, 4 Fish. 232; s. c. 7 Phila. 533; 2 Abb. U. S. 398; *Blake v. Stafford*, 3 Fish. 294; s. c. 6 Blatch. 195; *La Baw v. Hawkins*, 6 O. G. 724; *Colt v. Young*, 2 Blatch. 471; *Stimpson v. Westchester R. R. Co.* 4 How. 380; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond, 115; *Forbes v. Bar-*

stow Stove Co. 2 Cliff. 379; Allen v. Blunt, 3 Story, 742; Poppenhusen v. Falke, 2 Fish. 181; s. C. 4 Blatch. 493; Woodworth v. Stone, 3 Story, 749; French v. Rogers, 1 Fish. 133; Potter v. Holland, 1 Fish. 382; s. C. 4 Blatch. 238.

The presumption is that, in granting the reissue, the commissioner discharged his duty faithfully and correctly. This involves the idea that he granted it on account of mistake or inadvertence in the description or specification of the invention attached to the first letters; and therefore that he issued the new one as a matter of course, with a different amended description or specification, but for the same invention. Allen v. Blunt, 2 W. & M. 121; Smith v. Mercer, 5 Penn. L. J. 529; s. C. 4 West. L. J. 49; Hussey v. Bradley, 2 Fish. 362; s. C. 5 Blatch. 134; Crompton v. Belknap Mills, 3 Fish. 536; Birdsell v. McDonald, 6 O. G. 682; Bantz v. Elsas, 6 O. G. 117; Doherty v. Haynes, 6 O. G. 118; Woodworth v. Edwards, 3 W. & M. 120; Swift v. Whisen, 3 Fish. 343; s. C. 2 Bond, 115; Woodward v. Densmore, 4 Fish. 163; American Pavement Co. v. Elizabeth, 6 Fish. 424; s. C. 3 O. G. 522; Aultman v. Holley, 6 Fish. 534; s. C. 11 Blatch. 304; 5 O. G. 3; Hussey v. McCormick, 1 Fish. 509; s. C. 1 Biss. 300; Blake v. Stafford, 3 Fish. 294; s. C. 6 Blatch. 195; Hussey v. Bradley, 2 Fish. 362; s. C. 5 Blatch. 134; Morris v. Roger, 3 Fish. 176; s. C. 2 Bond, 66; Poppenhusen v. Falke, 2 Fish. 181; s. C. 4 Blatch. 493; O'Reilly v. Morse, 15 How. 62; Jordan v. Dobson, 4 Fish. 232; s. C. 2 Abb. U. S. 398; 7 Phila. 533; Middletown Co. v. Judd, 3 Fish. 141; Goodyear v. Berry, 3 Fish. 439; s. C. 2 Bond, 189; Knight v. Railroad Co. 3 Fish. 1; s. C. Taney, 106.

The *prima facie* inference or presumption in respect to the identity of the invention is open to be contradicted by proper evidence. Allen v. Blunt, 2 W. & M. 121; Goodyear v. Berry, 3 Fish. 439; s. C. 2 Bond, 189.

Where the commissioner accepts a surrender of an original patent, and grants a new patent, his decision in the premises in a suit for an infringement is final and conclusive, and is not re-examinable in such suit, unless it is apparent upon the face of the patent that he has exceeded his authority—that there is such a repugnancy between the old and the new patent, that it must be held as matter of legal construction that the new patent is not for the same invention as that embraced and secured in the original patent. Seymour v. Osborne, 3 Fish. 555; s. C. 11 Wall. 516; Graham v. Mason, 5 Fish. 1; La Baw v. Hawkins, 6 O. G. 724; M. & H. Glue Co. v. Upton, 6 O. G. 837; Collar Co. v. Van Dusen, 23 Wall. 530; s. C. 10 Blatch. 119; 7 O. G. 919; Wells v. Gill, 6 Fish. 89; s. C. 2 O. G. 590; Metropolitan Co. v. Tool Co. 1 Holmes, 161.

Identity of Original and Reissue.

The reissue must, by the express words of the section, be for the same invention, and consequently, where it appears on a comparison of the two instruments as matter of law, that the reissued patent is not for the same invention as that embraced and secured in the original patent, the reissue is invalid, as that state of fact shows that the commissioner, in granting the new patent, exceeded his jurisdiction. Seymour v. Osborne, 3 Fish. 555; s. C. 11 Wall. 516; Sickles v. Evans, 2 Fish. 417; s. C. 2 Cliff. 203; Battin v. Taggart, 1

Fish. 139; *Carhart v. Austin*, 2 Fish. 543; s. c. 2 Cliff. 528; *Burr v. Duryee*, 2 Fish. 275; s. c. 1 Wall. 531; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond, 115; *Sickles v. Falls Co.* 2 Fish. 202; s. c. 4 Blatch. 508; *Goodyear v. Berry*, 3 Fish. 439; s. c. 2 Bond, 189; *Wood Paper Co. v. Fibre Co.* 3 Fish. 362; s. c. 6 Blatch. 27; *Wood Paper Co. v. Hest*, 3 Fish. 316; s. c. 8 Wall. 333; *Whitely v. Swayne*, 4 Fish. 117; s. c. 7 Wall. 685; *Vogle v. Semple*, 11 O. G. 923; s. c. 9 C. L. N. 217; *Collar Co. v. Van Dusen*, 23 Wall. 530; s. c. 10 Blatch. 119; 7 O. G. 919; *Russell v. Dodge*, 93 U. S. 460; s. c. 11 O. G. 151; *American Wood Paper Co. v. Fibre Disintegrating Co.* 23 Wall. 566; *Wicks v. Stevens*, 2 Woods, 310; *Hall v. Withington*, 6 O. G. 933; *Johnson v. Beard*, 8 O. G. 435.

Power is conferred upon the commissioner to allow the specification to be amended if the patent is inoperative or invalid, and, in that event, to issue the patent in proper form. And he may, under that authority, allow the patentee to redescribe his invention, and to include in the description and claims of the patent not only what was well described before, but whatever else was suggested or substantially indicated in the specifications, model, or drawings which properly belong to the invention as actually made and perfected. *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Morris v. Roger*, 3 Fish. 176; s. c. 2 Bond. 66; *Parham v. Sewing Machine Co.* 4 Fish. 468; *Decker v. Grote*, 6 Fish. 143; s. c. 10 Blatch. 331; 3 O. G. 65; *Dorsey Co. v. Marsh*, 6 Fish. 387; s. c. 9 Phila. 395; *Black v. Thorne*, 5 Fish. 550; s. c. 10 Blatch. 66; 2 O. G. 388; *Westinghouse v. G. & R. Brake Co.* 9 O. G. 538; *Woodward v. Dinsmore*, 4 Fish. 163; *Sarven v. Hall*, 5 Blatch. 415; s. c. 9 Blatch. 524; 1 O. G. 437; *Washing Machine Co. v. Lincoln*, 4 Fish. 379; *Bliss v. Gaylord Manuf. Co.* 7 Blatch. 279; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond, 115; *Wells v. Jacques*, 5 O. G. 364; *Morris v. Roger*, 3 Fish. 176; s. c. 2 Bond, 66; *Nat'l Spring Co. v. Union Car Spring Manuf. Co.* 12 Blatch. 180; s. c. 2 O. G. 224; *Chicago Co. v. Busch*, 4 Fish. 395; s. c. 2 Biss. 472; *Bantz v. Elsas*, 6 O. G. 117; *Penn Salt Co. v. Thomas*, 5 Fish. 148; s. c. 8 Phila. 144; *Union Paper Collar Co. v. Leland*, 1 Holmes, 427; s. c. 7 O. G. 221.

It is not the meaning of the law that the patentee who applies for a reissue must at his peril describe and claim in his new specification, either in words or idea, just what was described and claimed in his old one. His new specification must be of the same invention, and his claim can not embrace a different subject-matter from that which he sought to patent originally. But unless the correction which the statute contemplates is narrowed down till it becomes a mere disclaimer, it is not possible in any case to frame a correct specification which shall not be broader than the one originally filed. To supply a defect, to repair an insufficiency, is to add, either directly or by modifying or striking out a limitation; in either form the effect is to amplify the proposition. In the case of a specification under the patent laws, it is to amplify the description and enlarge the claim. *French v. Rogers*, 1 Fish. 133.

A reissue will not be declared void on the ground that it is not for the same invention as the original patent, if such a result can be avoided by a liberal application of the maxim that letters patent are to receive a liberal construc-

tion, and, if practicable, to be so interpreted as to uphold, and not destroy the right of the inventor. *M. & H. Glue Co. v. Upton*, 6 O. G. 837.

Mere verbal discrepancies are entitled to but little consideration, especially where there is substantial accordance between the original and reissued patents. *Dorsey Co. v. Marsh*, 6 Fish. 387; s. c. 9 Phila. 395; *Tarr v. Folsom*, 1 Holmes, 312; s. c. 5 O. G. 92; *Jordan v. Dobson*, 4 Fish. 232; s. c. 2 Abb. U. S. 398; 7 Phila. 533; *Welis v. Jacques*, 5 O. G. 364; *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; s. c. 2 Cliff. 555.

Variations from the description given in the former specification do not necessarily imply that it is for a different discovery. The right to surrender the old patent and receive another in its place was given for the purpose of enabling the patentee to give a more perfect description of his invention, when any mistake or oversight was committed in his first. It necessarily, therefore, varies from it. *La Baw v. Hawkins*, 6 O. G. 724; *O'Reilly v. Morse*, 15 How. 62; s. c. 6 West. L. J. 102; *Smith v. G. D. & Co.* 93 U. S. 486; s. c. 1 Holmes, 354; 5 O. G. 585; 11 O. G. 246; *Allen v. Blunt*, 2 W. & M. 121; *Parham v. Sewing Machine Co.* 4 Fish. 468; *Hussey v. McCormick*, 1 Fish. 509; s. c. 1 Biss. 300; *Carew v. Boston Elastic Fabric Co.* 5 Fish. 90; s. c. 1 Holmes, 45; 1 O. G. 91; *Poppenhusen v. Falke*, 2 Fish. 213; *Aultman v. Holley*, 6 Fish. 534; s. c. 11 Blatch. 304; 5 O. G. 3; *Crompton v. Belknap Mills*, 3 Fish. 536; *Pearl v. Ocean Mills*, 11 O. G. 2; *Blake v. Stafford*, 3 Fish. 294; s. c. 6 Blatch. 195; *Wells v. Jacques*, 5 O. G. 364; *Tucker v. Tucker Manuf. Co.* 10 O. G. 464; *Morse v. Bain*, 19 West. L. J. 106; *M. & H. Glue Co. v. Upton*, 6 O. G. 837; *Putnam v. Yerringer*, 9 O. G. 689; *Stevens v. Pritchard*, 10 O. G. 505; *Lorillard Co. v. McDowell*, 11 O. G. 640; s. c. 34 Leg. Int. 78; 4 Pitts. L. J. 119; *Bridge v. Brown*, 1 Holmes, 53.

It is the right of the patentee and his representative to enlarge or restrict his claim, so as to give validity to the patent and secure the invention. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Morey v. Lockwood*, 8 Wall. 230.

New matter must not be introduced in a reissue. By new matter is not meant merely the introduction of a new ingredient in a patented composition, but any change in the original specification and claim, whereby a new and substantially different composition and results are secured. *U. S. Felting Co. v. Haven*, 3 Dillon, 131; s. c. 9 O. G. 253.

The fact that the specification gives less prominence to some terms of description and more to others than the first one, is not objectionable, provided that it is *bona fide*. The very object of the surrender is always to correct the specification, to make it clearer, fuller, and more exact. *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 493; *Robertson v. Secombe Co.* 6 Fish. 268; s. c. 10 Blatch, 481; 3 O. G. 412.

A specification may be defective, not only in omitting to give a full description of the mode of constructing a machine, but also in omitting to describe fully in the claim, the nature, extent and character of the invention, and the latter defect may be amended as well as the former. *Carver v. Braintree Manuf. Co.* 2 Story, 432.

If there is any doubt as to the construction of the language in a reissued

patent, the construction may be aided by reference to the original patent. *Ely v. Monson Manuf. Co.* 4 Fish. 64.

The patent covers equivalent although formally different mechanical devices which operate in the same way and to the same end. Hence, it is legitimate in an amended patent to modify the specification so as to secure protection broadly to the real invention of the patentee against any form of infringement. *Dorsey Co. v. Marsh*, 6 Fish. 387; s. c. 9 Phila. 395; *Poppenhusen v. Falke*, 2 Fish. 213.

Invention may be as necessary to reform or adapt an existing machine to the performance of work which it would not, as originally constructed, perform, as it is to make a new machine, and whether this is done by removing a device or by adding one, by removing a bolt or by inserting a bolt, by making an apparently great mechanical change, or a small one, the principle is the same. The change being a substantial one and producing a different result, may, if it be new, be the subject of a new patent, but can not be covered by the reissue of an old one. *Kirby v. Dodge Manuf. Co.* 6 Fish. 156; s. c. 10 Blatch. 307; 3 O. G. 181.

Where the commissioner has caused the patentee to make his claim narrower than his invention, he has the power, and it is his duty to accept a surrender and grant a reissue broad enough to cover the invention. *Morey v. Lockwood*, 8 Wall. 230.

An examination of the original specification and claims is not for the purpose of testing their sufficiency and validity. If insufficient or defective, their defects or insufficiencies might be cured by the reissue. The examination is for the single purpose of seeing what inventions or devices are found therein. *Sarven v. Hall*, 5 Fish. 415; s. c. 9 Blatch. 524; 1 O. G. 437.

If a bolt in the machine described in the original patent, is a mechanical device performing a precise and defined mechanical office, removing it to produce a different result, is tantamount to adding another device to the same end. The reissue can not embrace such an alteration. *Kirby v. Dodge Manuf. Co.* 6 Fish. 156; s. c. 10 Blatch. 307; 3 O. G. 181.

Whether the defect vitiated the original patent is immaterial, for it does not affect the rights under the new patent, even if the first patent were void. *Stimpson v. Westchester R. R. Co.* 4 How. 380.

The patentee can not embrace in his reissued patent, any patentable improvements not described, suggested or indicated in the application, or model, or specification, or drawings. Such additions made to the specifications are interpolations and not amendments, and consequently the commissioner has no authority to allow them to be made. Although the invention as originally made did as a matter of fact embrace those devices, yet they can not be added. The commissioner has no authority except in certain special cases to hear parol proof as to what the invention was, and allow the applicant to amend his specification and claim so as to include them, and if he does, his decision will not be conclusive, for the decision of the commissioner is not conclusive as to his own jurisdiction. *Sickles v. Evans*, 2 Fish. 417; s. c. 2 Cliff. 203; *Seymour v. Osborne*, 5 Fish. 555; s. c. 11 Wall. 516; *Carhart v. Austin*, 2 Fish. 543; s. c. 2 Cliff. 528; *Knight v. Railroad Co.* 2 Fish. 1; s. c. Taney, 106; *Hoffheims v. Brandt*, 3 Fish. 218; *Sarven v. Hall*, 5 Fish.

415; s. c. 9 Blatch. 524; 1 O. G. 437; Kirby *v.* Dodge Manuf. Co. 6 Fish. 156; s. c. 10 Blatch. 307; 3 O. G. 181; Adjustable Window Screen Co. *v.* Boughton, 31 Leg. Int. 254; Gill *v.* Wells, 22 Wall. 1; s. c. 6 O. G. 881; 2 A. L. T. (N. S.) 181; *vide* Hussey *v.* Bradley, 2 Fish. 362; s. c. 5 Blatch. 134; Allen *v.* Blunt, 3 Story, 742.

A patentee may state new results in the reissue without subjecting himself to the imputation of incorporating new matter, for he is entitled to all the uses to which his patent may be applied, and to all the beneficial results which legitimately follow the use of his instrumentalities. Putnam *v.* Yerringer, 9 O. G. 689.

Whether the defect be in the specification or in the claim, the patentee may surrender his patent, and by an amended specification or claim, cure the defect. Batten *v.* Taggart, 17 How. 74; s. c. 2 Wall, Jr. 101; Crompton *v.* Belknap Mills, 3 Fish. 536.

A reissue may claim a feature shown in the original model, though not specifically claimed in the specification. Calkins *v.* Bertrand, 8 C. L. N. 114.

The description and drawings of an original patent may be looked to to disclose the real invention of a patentee when the original claims are defective or the reissue claim obscure. Bussey *v.* Wagoner, 9 O. G. 300; s. c. 23 Pitts. L. J. 131.

The language of the claim may be changed if the change conforms to the drawing in the original patent. Booth *v.* Parks, 6 C. L. N. 407.

Even a statement in an original patent that a part is old, or a disclaimer of a part does not necessarily prevent such part from being claimed in a reissued patent, though it would have that effect if made advisedly and not by inadvertence, accident, or mistake. Hussey *v.* Bradley, 2 Fish. 362; s. c. 5 Blatch. 134; Poppenhusen *v.* Falke, 2 Fish. 181; s. c. 4 Blatch. 493.

It is necessary to the validity of the reissue of a chemical patent, that the subject-matter be found described in the original patent. Tarr *v.* Webb, 5 Fish. 593; s. c. 10 Blatch. 96; 2 O. G. 568.

If the claim of the reissue is broader than the invention, the reissue is void because it is not for the same invention as the patent which was surrendered as the foundation of the reissue. Goodyear *v.* Providence Rubber Co. 2 Fish. 449; s. c. 9 Wall. 788; 2 Cliff. 351; Carhart *v.* Austin, 2 Fish. 543; s. c. 2 Cliff. 528.

A part of the original invention may be omitted in the reissued patent, for there is nothing in the policy or terms of the patent act which forbids it. Dorsey Co. *v.* Marsh, 6 Fish. 387; s. c. 9 Phila. 395; Carver *v.* Braintree Manuf. Co. 2 Story, 432; Boomer *v.* Power Co. 13 Blatch. 107; Knight *v.* Railroad Co. 3 Fish. 1; s. c. Taney, 106; Chicago Co. *v.* Busch, 4 Fish. 395; s. c. 2 Biss. 472; Parham *v.* Sewing Machine Co. 4 Fish. 468.

A certified copy of the model does not conclude the defendant, but he may show that the model has been changed. Johnson *v.* Beard, 8 O. G. 435.

A drawing which was clearly indicated in the original specification may be added in the reissue. Union Paper Bag Co. *v.* Nixon, 6 Fish. 402; s. c. 4 O. G. 31; Hank's Case, 2 A. L. T. 129.

If the invention might be claimed either as a machine or a process, the

reissue may claim a process although the original patent claimed a machine. *Clark v. Kennedy Manuf. Co.* 11 O. G. 68.

If the original patent was for a process, a reissue may embrace the process and the product. *Merrill v. Yeomans*, 1 Holmes, 331; S. C. 5 O. G. 267; 11 O. G. 970.

A patentee who has a patent for an aggregate of several devices may surrender his patent and receive new letters patent for the several devices included in it. *Wheeler v. McCormick*, 6 Fish. 551; S. C. 11 Blatch. 334; 4 O. G. 692.

If the patentee was the inventor of the elements of a combination, but only claimed the combination, he may surrender the patent and take a reissue claiming the elements also. *Batten v. Taggert*, 17 How. 74; S. C. 2 Wall. Jr. 101; *Gallahue v. Butterfield*, 6 Fish. 203; S. C. 10 Blatch. 232; 2 O. G. 645; *Jordan v. Dobson*, 4 Fish. 232; S. C. 2 Abb. U. S. 398; 7 Phila. 533.

If the original patent describes a part, but claims it in combination, the reissue may claim the part and omit the claim for the combination. *Chicago Co. v. Busch*, 4 Fish. 395; S. C. 2 Biss. 472.

An inventor who has omitted to claim separate new devices or severable and distinct combinations in the original patent, may make a surrender and take a reissue for the distinct combinations or separate devices. *Wheeler v. Clipper Co.* 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442; *Cochrane v. Deener*, 11 O. G. 637; 4 W. L. R. 99.

Although the invention, as described in the original patent, was not capable of reduction to practical use, yet the patent may be surrendered and a reissue taken for the separate devices contained therein. *Wheeler v. Clipper Co.* 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442.

If the original patent claims a combination, it may be surrendered and a reissue taken, claiming only one part of the machine. The patentee has a right to restrict or enlarge his claim so as to give it validity and effectuate his invention. The description of the part in the original patent, without claiming it, will not constitute an abandonment of it to the public so as to prevent him from claiming it in the reissue. *Batten v. Taggert*, 17 How. 74; S. C. 2 Wall. Jr. 101.

When the inventor in the specification of the original patent, describes a new and useful combination of a number of elements performing in combination certain functions less than he has claimed, he may, in the reissue claim such combination of the less number which he has described, suggested, or substantially indicated as his invention, but failed to include in his claims. *Pearl v. Ocean Mills*, 11 O. G. 2.

If a patentee who has taken out a patent merely for a combination of all the elements of the machine, without any suggestion, indication or intimation that any other invention of any kind has been made, subsequently discovers that he can accomplish a new and useful result by a combination embracing less than the whole number of the elements included in his patent, he can not secure his right to this subsequent invention by a surrender of the first patent, and a reissue which includes the second combination as well as the first. *Gill v. Wells*, 22 Wall, 1; S. C. 6 O. G. 881; 2 A. L. T. (N. S.) 101.

A patentee can not surrender a patent for an invention consisting of a

combination of old elements, and amend the descriptive parts of the specification by striking out the entire description of one of the elements of the combination and inserting in lieu thereof a full description of several other devices without any allegation that they are the equivalents of the one whose description is stricken out, or any explanation whatever showing the reason why the change was made. *Gill v. Wells*, 22 Wall. 1; S. C. 6 O. G. 881; 2 A. L. T. (N. S.) 101.

A patentee, when he surrenders an original patent, can not amend the specification by striking out from the original the correct description of one of the ingredients of the patented combination, and substituting in its place the description of other devices not well known at the date of the original patent as a proper substitute for the ingredient whose description is stricken out. *Gill v. Wells*, 22 Wall. 1; S. C. 6 O. G. 881; 2 A. L. T. (N. S.) 101.

If the claims are for separate and distinct improvements, separate patents may be granted upon the reissue. *Bennett v. Fowler*, 8 Wall. 445.

A new product or manufacture, and a new process or method of producing the new article, are the proper subjects of separate and distinct claims in an original patent, and if the claims are not so made, the patentee upon a return of the patent for correction and reissue, may have several patents for the distinct and separate parts of his invention. *Goodyear v. Providence Rubber Co.* 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351; *Goodyear v. Wait*, 3 Fish. 242; S. C. 5 Blatch. 468; *Goodyear v. Honsinger*, 3 Fish. 147; S. C. 2 Biss. 1; *Penn Salt Co. v. Thomas*, 5 Fish. 148; S. C. 8 Phila. 144.

If the patent does not relate to a machine, the specification may be made more definite and certain so as to embrace the claim made, or the claim may be so modified as to correspond with the specification, but this is the extent to which modifications can be made. *Giant Powder Co. v. California Powder Works*, 3 Saw. 448.

If the original invention was for a process in the use of an article, a reissue for a compound of the article with other substances is void. *Giant Powder Co. v. California Powder Works*, 3 Saw. 448.

When a patent is granted, certain exclusive rights are secured or purported to be secured to the inventor. The object of the reissue is to secure greater rights than were actually secured by the first patent. The subject of both patents is the same invention, and the object of both is to secure rights in the same. This is the only object in both. A less right to the invention may be secured by the first patent. A greater right to the same invention may be secured by the reissued patent. The object of a patent is to secure rights to an invention throughout the whole of the United States. There is no good reason why a portion or the whole of the invention for a particular portion of the United States may not be secured by one patent, and the remaining portion of the invention for the residue of the United States be secured by another patent. These two patents would in effect constitute together but one patent for the whole invention for the whole United States. Two patents for separate parts, the separate parts together comprehending only the whole, would in effect be but one patent for the whole, as two separate deeds for two separate sections of one whole lot of land, would not be in effect more than one deed for the whole lot. No more would be secured by the two patents

than is authorized by law to be secured, or than could be secured by one. The two in effect would constitute but one. *Potter v. Holland*, 1 Fish. 327; S. C. 4 Blatch. 206.

Persons owning reissued letters patent, and seeking redress from those who have invaded their exclusive rights, are not obliged to introduce in evidence the surrendered patent. *Seymour v. Osborne*, 3 Fish. 555; S. C. 11 Wall. 516.

If the original patent is not introduced in evidence, the question whether the reissued patent is for the same invention as the original patent, can not be raised. *Seymour v. Osborne*, 3 Fish. 555; S. C. 11 Wall. 516; *Doherty v. Haynes*, 6 O. G. 118; *Eureka v. Bailey Co.* 11 Wall. 488; *Reedy v. Scott*, 23 Wall. 352; S. C. 7 O. G. 463.

Whether a reissued patent is for the same invention as that embodied in the original patent, or for a different one, is a question for the court in an equity suit, to be determined as a matter of construction, on a comparison of the two instruments, aided or not by the testimony of experts, as it may or may not appear that one or both may contain technical terms, or terms of art requiring such assistance in ascertaining the true meaning of the language employed. *Seymour v. Osborne*, 3 Fish. 555; S. C. 11 Wall. 516; *Woodward v. Dinsmore*, 4 Fish. 163.

Matters of fact are not open in a suit for an infringement, as to whether the reissue is for the same invention as the original patent. The conclusion must always be in favor of the reissue, unless it appears upon a comparison of the two instruments, that the reissue as a matter of legal construction is not for the same invention as the original. *Stevens v. Pritchard*, 10 O. G. 505.

Whether the new patent granted upon the surrender of the old one is substantially for a different invention from the first one, is a question for the jury on the evidence. *Stimpson v. Westchester R. R. Co.* 4 How. 380; *Batten v. Taggart*, 17 How. 7; 4 S. C. 2 Wall. Jr. 101; *Swift v. Whisen*, 3 Fish. 343; S. C. 2 Bond, 115; *Morris v. Royer*, 3 Fish. 176; S. C. 2 Bond, 66.

The defense that a reissued patent was issued unintentionally through the blunder of a subordinate in the patent office, can not be availed of in a suit brought on the patent. The only remedy is a direct proceeding by the United States to vacate the patent. *Doughty v. West*, 3 Fish. 580; S. C. 6 Blatch. 429.

Fraud.

The patent will be invalid if there has been fraud in the procurement of the reissue. The fraud may be either actual or constructive. The statute refers specially to cases of collusion—fraudulent, corrupt collusion between the applicant and the commissioner. If it is apparent that there has been any improper collusion between them, and that the patent has been granted corruptly, that is an act of positive fraud which will invalidate any patent to which it applies. *Swift v. Whisen*, 3 Fish. 343; S. C. 1 Bond, 115; *House v. Young*, 3 Fish. 335.

Very clear and decisive evidence is required in order to invalidate a patent upon an allegation of fraud in the reissue. *Swift v. Whisen*, 3 Fish. 343;

s. c. 1 Bond, 115; *Jordan v. Dobson*, 4 Fish. 232; s. c. 2 Abb. U. S. 398; 7 Phila. 533.

The question of fraud in obtaining a reissue, is settled by the decision of the commissioner. *Brown v. Guild*, 23 Wall. 181; s. c. 6 O. G. 392; 7 O. G. 739.

The reissue can not be abrogated by an infringer in a suit against him for infringements upon the ground that the letters patent were procured by fraud in preventing the application for the same before the commissioner. *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516; *Doughty v. West*, 3 Fish. 580; s. c. 6 Blatch. 429.

Effect of Reissue.

The reissue must be considered as a continuation of the original patent, and the rights of the patentee are to be determined by the state of things as they existed at the time of the original application. The new patent and the proceedings on which it issues have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application, and if the new patent is valid the law must be considered as satisfied, if the machine was not known or used before that application. *Grant v. Raymond*, 6 Pet. 218; *Shaw v. Cooper*, 7 Pet. 292; *Read v. Bowman*, 2 Wall. 591; *Crompton v. Belknap Mills*, 3 Fish. 536.

When a patent is surrendered, and new letters are taken out with an amended specification, the patent is considered to operate from the commencement of the original term, except as to suits for violations committed before the amendment. The amendment is not because the former patent or specification was utterly void, but because it was defective or doubtful in some particular which it was expedient to make more clear. But it is still a patent for the same invention. It can by law include no new one, and it covers only the same term of time which the former patent and its extensions did. The new letters relate back to the commencement of the original term, and for many purposes operate from that time. This is in strict analogy to amended writs and amended judgments, which for most purposes have the same effect as if the amended matter was in them originally. *Woodworth v. Hall*, 1 Wood & M. 248, 389; *Grant v. Raymond*, 6 Pet. 218; *Stanley v. Whipple*, 2 McLean, 35; *Smith v. Pearce*, 2 McLean, 176; *House v. Young*, 3 Fish. 335.

In law, a reissued patent is generally considered, except in respect to infringements prior to its issue, as if granted at the date of the original patent, and the corrected patent, in respect to all subsequent infringements, is made to take effect as though it had been so issued originally, even though the original patent was invalid. *Hussey v. Bradley*, 2 Fish. 362; s. c. 5 Blatch. 134; *Stanley v. Whipple*, 2 McLean, 35; *Grant v. Raymond*, 6 Pet. 218.

Clerical amendments of letters patent relate back to the date of the letters patent, as much as any like clerical amendments of declarations, or pleas or judgments. *Woodworth v. Hall*, 1 Wood & M. 389.

No prior use under the defective patent can authorize the use of the invention after the issuing of the renewed patent. Any person using an invention

protected by a renewed patent is guilty of an infringement, however long he may have used the same after the date of the defective and surrendered patent. *Stimpson v. Westchester R. R. Co.* 4 How. 380; *Carr v. Rice*, 1 Fish. 198; *Hussey v. Bradley*, 2 Fish. 362; s. c. 5 Blatch. 134; *Bliss v. Brooklyn*, 4 Fish. 596; s. c. 8 Blatch. 533; *Howe v. Williams*, 2 Fish. 395; s. c. 2 Cliff. 245; *Grant v. Raymond*, 6 Pet. 218; *Bloomer v. Stolley*, 5 McLean, 158; *Agawam Co. v. Jordan*, 7 Wall. 583.

The prior use of an invention under a defective patent can not take away the right to surrender such patent and take out a new and amended one. *Hussey v. Bradley*, 2 Fish. 362; s. c. 5 Blatch. 134; *Buerk v. Valentine*, 5 Fish. 366; s. c. 9 Blatch. 479; 2 O. G. 295.

When letters patent are amended in a material mistake, they can only operate as to third persons for causes accruing after the correction. It may be different if the mistake is entirely clerical. *Woodworth v. Hall*, 1 Wood. & M. 248, 389; *Brown v. Hinkley*, 6 Fish. 370; s. c. 3 O. G. 384.

A surrender of the patent to the commissioner within the sense of the provision means an act which in judgment of law extinguishes the patent. It is a legal cancellation of it, and hence it can no more be the foundation for the assertion of a right after the surrender, than an act of Congress which has been repealed. The antecedent suits depend upon the patent existing at the time they were commenced, and unless it exists and is in force at the time of trial and judgment, the suits fall. *Moffitt v. Gaar*, 1 Fish. 610; s. c. 1 Black. 273; 1 Bond, 315; *Dennis v. Eddy*, 4 Fish. 423.

A surrender after a final judgment or decree does not affect such judgment or decree. *Mers v. Conover*, 11 O. G. 1111.

Moneys recovered on judgments in suits, or voluntary payments under the first patent, can not be recovered back upon the surrender. The title to these moneys does not depend upon the patent, but upon the voluntary payment or the judgment of the court. *Moffitt v. Gaar*, 1 Fish. 610; s. c. 1 Black, 273; 1 Bond. 315.

A reissued patent may be issued to the assignee of the original, when he requests it and makes the application, although he has made an assignment of it which is on record. *Havemeyer et al. Assignees*, 2 Dec. Com. 5.

A reissued patent must be granted in the name of the patentee, or, in case of his death, or of an assignment of the whole or of an undivided part of the original patent, then to his executors, administrators, or assigns. *James D. Wright*, 10 O. G. 587; *N. B. Fassett*, 11 O. G. 420.

A patent having been reissued to the inventor will not be reissued also to his assignee whose assignment was not recorded before the reissue to the inventor. *Andrew Whiteley, Assignee*, 1 Dec. Com. 79.

A clerical error in a patent will be corrected without fees, if it occurred through the fault of the office; but if through the fault of the patentee, it will be corrected only by a reissue on the usual terms. *James Cochrane*, 1 Dec. Com. 60.

A reissued patent will not be antedated to the time when the application for it was made. *Andrew Whiteley*, 1 Dec. Com. 72.

In applications for reissue, the proof there required should be submitted to the commissioner in person, and if the proof is satisfactory, the amendment will then be examined in the usual manner. *Isaac Winslow*, 9 O. G. 795.

An applicant for reissue will not be allowed to establish priority as against a patentee whose patent has expired. *J. L. Mason*, 9 O. G. 1196.

A reissued patent will not be granted after the term of the original has expired, since no right of action could accrue under it, even if it were antedated. *Andrew Whiteley*, 1 Dec. Com. 70.

No one is liable upon a reissued patent for alleged infringements which took place before it issued, but after its date. *Andrew Whiteley*, 1 Dec. Com. 72.

Any claims may be justly embodied in a reissue which could have been allowed in the original application, although it enables the patentee to control devices which, though different in construction, are substantially the equivalents of the patented invention. *Bissell & Moore Manufacturing Co.* 2 Dec. Com. 157.

After one patent has issued, upon an application for a reissue the original patent is annulled, and no new division of the reissue will be received. *Andrew Whiteley*, 1 Dec. Com. 70.

A model might be a basis for reissue, although forming no part of the patent. *C. W. Baldwin*, 9 O. G. 639.

An application for reissue should not be examined in the light of the state of the art as it existed subsequent to the filing of the original application. *Carroll v. Morse*, 9 O. G. 453.

An application for reissue will be granted, if it appears the new matter was omitted through inadvertency or mistake in the original application. *Elias Ingraham*, 3 Dec. Com. 164.

A participial claim to "arranging" devices, instead of to the devices themselves, having been granted under a lax practice, should be made to conform to the present practice in revising the application for reissue. *Calista E. Cox*, 3 O. G. 2.

An applicant for reissue is entitled to make the corrections which he might properly have made after filing his original application. *C. W. Baldwin*, 9 O. G. 639.

No patent should be allowed to issue upon an application for a reissue until all the rights of the applicant are settled. *Doty v. Osborne & Ballard*, 1 Dec. Com. 77.

Nothing but what was shown in the original specification, drawings, or model, can be introduced into a reissue. *W. C. Dodge*, 1 Dec. Com. 27; *Joseph Ridge, Assignor*, 1 Dec. Com. 46; *Willis Humiston*, 1 Dec. Com. 47; *Aberdeen Keith*, 2 Dec. Com. 69; *Galen Orr*, 2 Dec. Com. 113; *Wm. A. Lewis*, 3 Dec. Com. 82; *George E. Waring, Jr.* 3 Dec. Com. 228; *Elisha Waters*, 8 O. G. 399; *Nehemiah T. Folsom*, 2 Dec. Com. 170.

The specification may be amended in a reissue by the model originally filed, and the model or drawings may be amended by each other, but not by the specification. *W. C. Dodge*, 1 Dec. Com. 27; *Elizabeth Hawkes*, 1 Dec. Com. 37.

The same rule governs in cases of reissue as adopted by the courts, and it is for the office to determine, by comparison of the patent and the application, whether the scope of the original invention is enlarged. *Aldrich & Evans*, 9 O. G. 407.

An amendment may be introduced into a reissue, if it only explains the manner in which the device is to be operated. *N. J. Donaldson*, 4 O. G. 4.

An inventor is entitled to all the benefits of his improvement, and is entitled to a reissue, although he may not have fully anticipated its value. *Samuel F. Day*, 1 Dec. Com. 4.

It cannot be objected to a claim in an application for reissue for the first time, that the specified invention has been abandoned since the date of the

original patent, because not urged before, and having gone into extensive use. *Conklin & Stafford*, 2 O. G. 543.

A disclaimer contained in a patent, and which has no reference to the invention described, may be omitted in a reissue without rendering it liable to the objection of new matter. *Hermann & Taylor*, 10 O. G. 865.

If the patentee finds himself hindered in his rights to any extent by reason of an error in the specification, the defect may be cured by a reissue. *Mathew Andrew*, 2 Dec. Com. 75; *C. B. Cottrell*, 9 O. G. 495.

Although estoppel might operate as between the parties, the grant of the reissued patent, upon proof of priority of invention, was not barred. *David E. Roe*, 5 O. G. 397.

In an application for reissue, the words "or their equivalents," referring to a definite device, add nothing that the applicant would not be entitled to without them. *W. H. McLellan*, 2 O. G. 89; *Continental Windmill Co.* 2 Dec. Com. 74.

If one is entitled, upon his invention, to more than is secured to him by the patent already granted, the safe and proper remedy is by reissue. *Paul & W. C. Bramwell*, 2 Dec. Com. 76.

A patentee should be held rigidly to the language adopted in his patent, unless good reason appears for departing from it. If new terms or new descriptive matter is introduced, the patentee must show good cause for its introduction, or it will be stricken out. *Henry M. Underwood*, 1 O. G. 549.

A reissue will not be granted for matter embraced in a prior foreign patent to the inventor which has expired. *C. W. Siemens*, 11 O. G. 1107.

An inventor can not insert a claim for a feature in a reissue which is not shown in the original specifications, drawings or model, although it was contained in the machine made before the filing of the application. *J. S. Warren*, 10 O. G. 1.

If, in view of the state of the art as exhibited by the references cited, the applicant presents only a colorable variation or equivalent construction, a reissue will not be granted. *T. Plumleigh*, 3 O. G. 29.

Where a patent has issued in one division of an application for a reissue, the original patent is dead, and no new division can be entertained. *Whiteley & Gage*, 1 Dec. Com. 53.

If an applicant would not have been allowed, in his original patent, the claim set up, he cannot have it by reissue. *John E. Wooten*, 3 O. G. 521.

It is new matter to describe in the reissue application various other uses to which the invention could be applied. *Robert Bragg*, 8 O. G. 985.

A use of the invention being suggested in a reissued patent not mentioned in the original application for a patent, such suggestion of new matter ought not to be allowed in the reissue, without disclaimer of such new matter. *Horatio Allen*, 2 O. G. 89.

Several parts of a patented machine which will together constitute a new invention not mentioned in the original, can not be claimed by themselves on a reissue. *Wheeler & Wheeler*, 4 O. G. 5; *Aldrich & Evans*, 9 O. G. 407.

If an application is forfeited through neglect to pay the final fee, the applicant is not entitled to have the same invention embraced in the reissue of a previous patent on the ground that it was afterwards patented to another. *Nehemiah T. Folsom*, 2 Dec. Com. 170.

Where the ambiguity is explained in a manner not inconsistent with the original invention, an amendment may be allowed upon sworn statements showing that the matter so introduced was a part of the original invention. *Peter R. Gollstein*, 11 O. G. 1061.

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

Statute Revised—July 8, 1870, ch. 230, § 54, 16 Stat. 206.

Prior Statute—March 3, 1837, ch. 45, §§ 7, 9, 5 Stat. 193.

When Patent Valid.

This section is intended to cover inadvertencies and mistakes of the law, as well as inadvertencies and mistakes of fact. *Wyeth v. Stone*, 1 Story, 273.

This provision applies to patents granted prior to its adoption. *Hotchkiss v. Oliver*, 5 Denio, 314.

The patentee can not maintain an action unless the part invented can be clearly distinguished from that claimed but not invented. *Vance v. Campbell*, 1 Fish. 483; S. C. 1 Black. 427; *Rumford Works v. Lauer*, 5 Fish. 615; S. C. 10 Blatch. 122; 3 O. G. 349; *Rice v. Garnhart*, 34 Wis. 453.

If the claim is for the whole machine, and the invention consists in an improvement, the invention will be good so far as it extends. *Peterson v. Wooden*, 3 McLean, 248; *Hotchkiss v. Oliver*, 5 Denio, 314.

The provision requiring a disclaimer applies only in the case where the part claimed by the patentee, of which he is not the inventor, is a material and substantial part of the thing patented. A disclaimer is necessary, therefore, only where the thing claimed without right is a material and substantial part of the thing invented. The question as to the disclaimer is of no importance unless the part claimed is a material and essential part, or unless it was introduced into the description through the willful default of the patentee, or with intent to defraud or mislead the public. *Hall v. Wiles*, 2 Blatch. 194.

If a patentee makes a claim which is not well founded in the same patent with other claims which are well founded, he may disclaim within a reasonable time that which he had no right to claim, and then his patent will be good as to the residue, as good as if it had issued originally only for the claims which are valid. *Seymour v. McCormick*, 3 Blatch. 209; S. C. 19 How. 96; *Tuck v. Bramhill*, 3 Fish. 400; S. C. 6 Blatch. 95; *Taylor v. Archer*, 4 Fish. 449; S. C. 8 Blatch. 315.

If the patentee omits to make a disclaimer, but brings a suit for a violation of his patent, and it satisfactorily appears upon the trial that he is entitled to be protected in a portion of the claims set up in his patent, but that he is not entitled to be protected in respect to another portion, he is still entitled to damages for the violation of the valid portion of his claims, the same as if all the claims were valid so far as regards the mere right of recovery, but he gets no costs. *Seymour v. McCormick*, 3 Blatch. 209; S. C. 19 How. 96; *vide Heinrich v. Luther*, 6 McLean, 345.

A disclaimer can not be filed where the patent is for a combination. *Batten v. Clayton*, 2 Whart. Dig. 363; *Vance v. Campbell*, 1 Fish. 483; S. C. 1 Black, 427.

There is no distinction between an invalid claim for something of which the patentee was the discoverer, and a claim for something which was known before, and of which he was not the first discoverer. A patent for such a claim is as strongly forbidden by the statute as if some other person had made the invention before him. The law which requires and permits him to disclaim is not penal, but remedial. It is intended for the protection of the patentee as well as the public, and ought not therefore to receive a construction that would restrict its operation within narrower limits than its words fairly import. Whether, therefore, the patent is illegal in part because he claims more than he has sufficiently described, or more than he invented, he must in either case disclaim in order to save the portion to which he is entitled; and he is allowed to do so when the error was committed by mistake. *O'Reilly v. Morse*, 15 How. 62; S. C. 6 West. L. J. 102.

After a disclaimer has been properly filed, the construction of the patent must be the same as it would be if the matter so disclaimed had never been included in the description of the invention or the claims of the specification. *Dunbar v. Myers*, 11 O. G. 35.

A new specification which is not completed by a surrender of the old one, can not be considered as a disclaimer. *Hovey v. Stevens*, 3 W. & M. 17.

When Filed.

A disclaimer may be filed as well after as before the commencement of a suit. *Smith v. Nichols*, 6 Fish. 61; S. C. 21 Wall. 112; 1 Holmes, 72; 2 O. G. 649; *O'Reilly v. Morse*, 15 How. 62; S. C. 6 West. L. J. 102; *Hall v. Wiles*, 2 Blatch. 194; *Silsby v. Foote*, 20 How. 378; S. C. 2 Blatch. 260; *Seymour v. McCormick*, 19 How. 96; S. C. 3 Blatch. 209; *Sanger v. Walmsley*, 1 Fish. 558; *Tuck v. Bramhill*, 3 Fish. 400; S. C. 6 Blatch. 95; *Wyeth v. Stone*, 1 Story, 273; *Brooks v. Jenkins*, 3 McLean, 432; *vide Reed v. Cutter*, 1 Story, 590; *Parker v. Stiles*, 5 McLean, 44.

This provision means that a suit pending when the disclaimer is filed, is not to be affected by such filing so as to prevent the plaintiff from recovering in it, unless it appears that he unreasonably neglected or delayed to file the disclaimer. *Tuck v. Bramhill*, 3 Fish. 400; s. C. 6 Blatch. 95.

A court of equity ought not to interfere to grant a perpetual injunction, whatever may be the right and remedy at law, unless a disclaimer has been in fact filed at the patent office before the suit is brought. The granting of such an injunction is a matter resting in the sound discretion of the court, and if the court should grant a perpetual injunction before any disclaimer is filed, it may be that the patentee may never afterwards, within a reasonable time, file any disclaimer. *Wyeth v. Stone*, 1 Story, 273.

There may be a decree for a perpetual injunction, each party to pay his own costs, without any actual previous disclaimer of record in the patent office. But the circuit courts will not make any decree beyond the perpetual injunction without an actual disclaimer previously recorded in the patent office. *Aiken v. Dolan*, 3 Fish. 197; *Myers v. Frame*, 4 Fish. 493; s. C. 8 Blatch. 446.

Who may File.

If an assignee does not join with the patentee in a disclaimer, the disclaimer can not operate in favor of the assignee in any suit either at law or in equity. *Wyeth v. Stone*, 1 Story, 273; *Myers v. Frame*, 4 Fish. 493; s. C. 8 Blatch. 446.

If a patent is issued jointly to the inventor and another as assignee of an interest in the invention, the former must offer to unite with the inventor in a disclaimer, before he can assert that some validity might thereby be imparted to the patent. *Rice v. Garnhart*, 34 Wis. 453.

If the disclaimer is filed by the patentee, it need not expressly declare that he has parted with no interest, for the fair implication from the averment that he is the patentee is that he still owns the whole. *Silby v. Foote*, 14 How. 218; s. C. 1 Blatch. 445.

If an administrator, in whose name a patent has been extended, expressly states that he is the patentee, and refers to the patent as showing his interest, this is a sufficient statement of his interest. *Brooks v. Jenkins*, 3 McLean, 432.

Delay.

The time in reference to the question of delay commences when the knowledge is brought home to the patentee that he was not the first inventor, or when it is declared by a court of competent jurisdiction to settle the question that he is not the first inventor, then it is that the time commences to run, and not till then. *Singer v. Walmsley*, 1 Fish. 558.

When the objectionable claim has been sanctioned by the commissioner of patents, and held to be valid by a circuit court, the patentee has a right to insist upon it, and not disclaim it until the highest court to which it can be carried has pronounced its judgment. Such delay is not unreasonable, and will not render the patent altogether void. *O'Reilly v. Morse*, 15 How. 62;

s. c. 6 West. L. J. 102; Seymour v. McCormick, 19 How. 96; s. c. 3 Blatch. 209; Potter v. Whitney, 3 Fish. 77; s. c. 1 Lowell, 87.

An unreasonable neglect or delay to enter a disclaimer cuts off the patentee from all the benefits of the section. He not only can not recover costs, but he can have no right of action. Brooks v. Jenkins, 3 McLean, 432; Hall v. Wiles, 2 Blatch. 194; Winans v. N. Y. & Erie R. R. Co. 1 Fish. 213; s. c. 21 How. 88.

What is unreasonable delay is a question to be settled by the court, and not for the jury. Singer v. Walmsley, 1 Fish. 558; Seymour v. McCormick, 19 How. 96; s. c. 3 Blatch. 209.

Whether the neglect or delay to enter a disclaimer is unreasonable is a mixed question of law and fact, and must be decided by the jury under the instructions of the court. Brooks v. Jenkins, 3 McLean, 432; Washburn v. Gould, 3 Story, 122; Lippincott v. Kelly, 1 West. L. J. 513.

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

Statute Revised—July 8, 1870, ch. 230, § 58, 16 Stat. 207.

Prior Statute—July 4, 1836, ch. 357, § 16, 5 Stat. 123.

The circuit court has no jurisdiction to enjoin a patentee, or declare the patent a nullity upon the application of a party who alleges that he is the first and original inventor of the thing patented for which the patentee surreptitiously and fraudulently obtained a patent, if the complainant has not obtained a patent. Hoeltge v. Hoeller, 2 Bond, 386; Mason v. Rowley, 3 A. L. T. (N. S.) 8.

If the party who gets the later patent is the real inventor, he may have the prior patent canceled. Sturges v. Van Hagen, 6 Fish. 572.

The assignee of an invention may file a bill in his own name to obtain the cancellation of letters patent which have been improperly granted to another. Gay v. Cornell, 1 Blatch. 506; Gold & Silver Ore Co. v. U. S. Ore Co. 3 Fish. 489; s. c. 6 Blatch. 307.

Two patents interfere within the meaning of this section when they claim the same invention in whole or in part. *Gold & Silver Ore Co. v. U. S. Ore Co.* 3 Fish. 489; s. c. 6 Blatch. 307; *Gilmore v. Golay*, 3 Fish. 522.

A party is not entitled to any benefit under this section, unless the patents are for the same invention. An averment that the defendant claims an interference and denial of such claim does not authorize a suit as for an interference. *Celluloid Manuf. Co. v. Goodyear D. V. Co.* 13 Blatch. 375; s. c. 10 O. G. 41.

The power of the circuit court in a case of interfering patents, is not confined to the specific remedy pointed out by this section, but authorizes the granting of an injunction. The power conferred on the circuit courts to entertain bills in equity in controversies arising under the patent act, is a general equity power, and carries with it all the incidents belonging to that species of jurisdiction. The power conferred, not only enables the court to decree a final remedy, but to take care that the subject of the controversy shall not be rendered valueless pending the litigation. *Potter v. Dixon*, 2 Fish. 381; s. c. 5 Blatch. 160.

Where both patents are void for want of novelty, the court may enter a decree declaring both patents void. *Foster v. Lindsay*, 3 Dillon, 126; s. c. 7 O. G. 514; 8 O. G. 1032.

A judgment or decree can not be accepted as determining the question of the interference of two patents, unless it be direct and affirmative in terms and in the words of the statute. The court must adjudge and declare the patent void in whole or in part, or in operation, and invalid in some particular part of the United States. A decree dismissing a bill seeking that relief, does not imply such positive judgment, but on the contrary indicates that the court on the proof before it, was unable to render that specific judgment. *Tyler v. Hyde*, 2 Blatch. 308.

SEC. 4919. Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

Statute Revised—July 8, 1870, ch. 230, § 59, 16 Stat. 207.

Prior Statutes—April 10, 1790, ch. 7, § 4, 1 Stat. 111.—Feb. 21, 1793, ch. 11, § 5, 1 Stat. 322.—April 17, 1800, ch. 25, § 3, 2 Stat. 38.—July 4, 1836, ch. 357, § 14, 5 Stat. 123.

Parties.

A right of action is only given to such party as possesses the whole interest. *Suydam v. Day*, 2 Blatch. 20.

The patentee is entitled to recover at law, no matter what private agreement subsists between him and any other person or persons, unless he has made a legal assignment and transfer of his interest in the invention. *Park v. Little*, 3 Wash. C. C. 196; *Blanchard v. Eldridge*, 1 Wall. Jr. 337.

A licensee can not maintain an action in his own name. *Suydam v. Day*, 2 Blatch. 201; *Gayler v. Wilder*, 10 How. 477.

An action at law to protect the interests of a licensee, may be brought in the name of the patentee for the benefit of the licensee. *Goodyear v. McBurney*, 3 Blatch. 32; *Goodyear v. Bishop*, 2 Fish. 96; s. c. 4 Blatch. 438.

If a patentee executes a release under seal to another, neither he nor his licensee can sue that party for an infringement. *Jackson v. Allen*, 120 Mass. 64.

If the licensee brings a suit in the name of the patentee, the latter may claim indemnity against costs, which will be provided for by the court on a proper application. *Goodyear v. Bishop*, 2 Fish. 96; s. c. 4 Blatch. 438.

A suit brought in the name of the patentee for the benefit of the licensee, can not be dismissed on a motion made by the defendant, although the nominal plaintiff consents to such dismissal. *Goodyear v. Bishop*, 2 Fish. 96; s. c. 4 Blatch. 438.

A stipulation by the patentee to sue infringers, does not necessarily take from the licensee his remedy, which the law has provided for him by proceeding directly against the wrong-doer. *Goodyear v. Bishop*, 2 Fish. 96; s. c. 4 Blatch. 438.

An assignee acquires his title to a patent with a right of action in his own name only by force of the statute. Such exclusive right of action exists in favor of a sole assignee only in two cases, namely: where he acquires by assignment the whole interest in a patent or a grant, or conveyance of the whole interest within some particular district or territory. *Suydam v. Day*, 2 Blatch. 20; *Tyler v. Tuel*, 6 Cranch, 324.

The assignees of separate, undivided interests in the patent for a certain territory may join in an action for an infringement. *Stern v. Goddard*, 1 McA. 82.

The grantee of the exclusive right to construct and use, and vend to others to be used, two patented machines within a certain town, can maintain an action for an infringement. Although limited to the use of two machines within the town, the right to use them is exclusive. No other party, not even the patentee, can use a right under the patent within the territory, without infringing the grant. *Wilson v. Rousseau*, 4 How. 646; s. c. 1 Blatch. 3.

A suit for an infringement committed after the assignment was made and recorded must be in the name of the assignee. *Herbert v. Adams*, 4 Mason, 15.

The correct interpretation of the words "person or persons interested" is, that the words mean the person or persons interested in the patent at the time when the infringement was committed which is the cause of action for which the damages may be recovered. A subsequent sale and transfer of the exclusive right are no bar to an action to recover damages for an infringement committed before such sale and transfer. The reason for the rule is, that the assignee or grantee is not interested in the damages for any infringement com-

mitted before such sale and transfer. The patentee may therefore sue for such damages in his own name. *Moore v. Marsh*, 7 Wall. 515.

The patentee and an assignee of a moiety may join in an action for an infringement. *Whittemore v. Cutter*, 1 Gallis. 429.

The joint owner of a patent can sustain an action for an infringement against his co-owner, and recover his actual damages, according to his interest in the patent. If such co-owner appropriates any portion of the exclusive right or common property to his separate use or benefit, by either the use or the sale of the patented machine, he does what is in principle the same as the conversion by destruction or sale of the joint property by a tenant in common, which authorizes his co-tenant to maintain trover. *Pitts et al. v. Hall*, 3 Blatch. 201.

Infringement.

The statute does not, and was not intended to operate beyond the limits of the United States, and as the patentee's right of property and exclusive use is derived from it, they can not extend beyond the limits to which the law itself is confined. The use of the invention outside of the jurisdiction of the United States is not an infringement of his rights. The rights of property and exclusive use granted to a patentee do not extend to a foreign vessel entering one of our ports, and the use of the improvement in the construction, fitting out, or equipment of such vessel while she is coming into or going out of a port of the United States, is not an infringement of the rights of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs. *Brown v. Duchesne*, 19 How. 183; S. C. 2 Curt. 371.

The jurisdiction of the United States extends to the decks of American vessels on the high seas, as much as it does to all the territory of the country; and the use of a thing patented on such vessels is an infringement. *Gardiner v. Howe*, 2 Cliff. 462.

An infringement is a copy made after and agreeing substantially and in principle with the article described in the letters patent. The statute confers upon the patentee and his assigns the exclusive right to make, to use, or to sell to others to be used, the patented article. It is therefore an infringement to make or manufacture a patented article, though it is never used by the maker. It is likewise an infringement to use a patented article, though made by another. It is also an infringement to sell to others the article when it is manufactured by another. The law vests the exclusive right to do all these three things in the patentee, and hence for another to do one or all of them is an infringement. *Haselden v. Ogden*, 3 Fish. 378.

It is not necessary that the defendant's machine should be an exact copy of the patentee's machine. All that is required is that the defendant's machine should be substantially like the patentee's machine. *Waterbury Brass Co. v. N. Y. Brass Co.* 3 Fish. 43.

It is a familiar rule that to copy the principle or mode of operation described in the patent is an infringement, although such copy should be totally unlike the original in form or proportions. If it were not so, no question of infringement could arise. If the machine complained of were a copy

in form of the machine described in the specification, it would be at once seen to be an infringement. It could be nothing else. It is only ingenious diversities of form and proportion, presenting the appearance of something unlike the thing patented which give rise to questions. *Winans v. Denmead*, 15 How. 330.

So long as the patentee's ideas are found in the construction and arrangement, no matter what may be its form, or shape, or appearance, the party using it is appropriating his invention, and must be held to be an infringer. *Potter v. Wilson*, 2 Fish. 102; *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512; *Decker v. Grote*, 6 Fish. 143; S. C. 10 Blatch. 331; 3 O. G. 65; *Decker v. Griffith*, 10 Blatch. 343, note.

Patents are not monopolies, because a monopoly is that which segregates what was common before, and gives it to one person or class for use or profit. A patent is that which brings out from the realm of mind something that never existed before, and gives it to the country. Probably of all species of property the property in patent rights should be most carefully guarded and protected, because it is so easily assailed. The most difficult thing in the world is to prove an invasion of property of this character. *Singer v. Walmsley*, 1 Fish. 558; *Parker v. Stiles*, 5 McLean, 44; *Imlay v. Railroad Co.* 1 Fish. 340; S. C. 4 Blatch. 227.

An infringement takes place whenever a party avails himself of the invention of the patentee without such variation as will constitute a new discovery. An infringement involves substantial identity. *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512; *Rich v. Lippincott*, 2 Fish. 1; *Foss v. Herbert*, 2 Fish. 31; S. C. 1 Biss. 121.

The word "substantial," as applied in actions for an infringement is not susceptible of an exact definition. The law looks more to the substance of things than their forms. *Brooks v. Bicknell*, 3 McLean, 250.

No certain, definite rule, can be stated by which to determine unerringly in every case what will amount to substantial identity. Each case must be determined upon its own circumstances. *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512.

The question of infringement is one irrespective of motive. The defendant may have infringed without intending, or even knowing it, but he is not, on that account, the less an infringer. *Parker v. Hulme*, 1 Fish. 44.

The making of a machine fit for use, and with a design to use it for profit, is an infringement of the patent right. *Whittemore v. Cutter*, 1 Gallis. 429; *Bloomer v. Gilpin*, 4 Fish. 50.

The word "making" is equally as applicable to machines as to compositions of matter, and there is no difficulty in holding that the using or vending of a patented composition is a violation of the right of the proprietor. *Whittemore v. Cutter*, 1 Gallis. 429.

An imperfect infringement, because the machine is imperfect, is still an infringement. *Union Paper Bag Co. v. Binney*, 5 Fish. 166.

The patent law was intended to secure to an inventor his whole invention or discovery, but not unless he claimed to be secured in the whole. If he claims only a part, or some particular form, such part or particular form only is secured to him. *Hawes v. Gage*, 5 O. G. 494; *Boston E. F. Co. v. Rubber*

Thread Co. 1 Holmes, 372; s. c. 5 O. G. 696; American Pin Co. v. Oakville Co 3 Blatch. 190; Bliss v. Haight, 3 Fish. 621; s. c. 7 Blatch. 7; Sickles v. Gloucester Manuf. Co. 1 Fish. 222; s. c. 3 Wall. Jr. 196; Rich v. Close, 4 Fish. 279; s. c. 8 Blatch. 41; Many v. Sizer, 1 Fish. 31; Waterbury Brass Co. v. Miller, 5 Fish. 48; s. c. 9 Blatch. 77; Howe v. Williams, 2 Fish. 395; s. c. 2 Cliff. 245; Meissner v. Devoe Manuf. Co. 5 Fish. 285; s. c. 9 Blatch. 363; 2 O. G. 245; Poppenhusen v. N. Y. G. P. Co. 4 Blatch. 253; Smith v. Elliott, 5 Fish. 315; s. c. 9 Blatch. 400; 1 O. G. 331; Doughty v. West, 2 Fish. 553; Evarts v. Ford, 6 Fish. 587; s. c. 5 O. G. 58; Fuzzard Manuf. Co. v. Dickenson, 3 Fish. 289; s. c. 6 Blatch. 80; Consolidated Fruit Jar Co. v. Wright, 12 Blatch. 149; s. c. 6 O. G. 327; 9 C. L. N. 313; Welling v. Rubber Co. 7 O. G. 608.

An infringement will not take place unless the invention can be practiced completely by following the specifications. An infringement is a copy made after and agreeing with the principle laid down in the patent, and if the patent does not fully describe everything essential to the making of the thing patented, there will be no infringement by the fresh invention of processes which the patentee has withheld from the public. Page v. Ferry, 1 Fish. 298.

It is not necessary to constitute an infringement that a man should work by the specification contained in the patent. He might not even know there was such a patent, and yet infringe it. Matthews v. Skates, 1 Fish. 602; Parker v. Haworth, 4 McLean, 370.

If the peculiar invention of the patentee is embodied in the defendant's machinery, however it may be combined with other machinery, it is appropriated the same as if it were used alone and separate from those connections. Sickels v. Borden, 3 Blatch. 535; Johnson v. Root, 1 Fish. 351; Poppenhusen v. Falke, 2 Fish. 181; s. c. 4 Blatch. 493; Foster v. Moore, 1 Curt. 279; Pitts v. Wemple, 6 McLean, 558; Hoffheins v. Brandt, 3 Fish. 218; Waterbury Brass Co. v. N. Y. Brass Co. 3 Fish. 43; Howes v. Nute, 4 Fish. 263; Malloy v. White, 4 Fish. 628; s. c. 8 Blatch. 552; Doughty v. Day, 5 Fish. 224; s. c. 9 Blatch. 262.

An evasion of a patent by splitting the invention in two, and making two operations where only one is necessary, is an infringement. Baldwin v. Bernard, 5 Fish. 75; s. c. 9 Blatch. 509, n.; 2 O. G. 315.

Whoever erects or uses a patented machine does it at his peril. He takes upon himself all the chances of its being originally valid, or of its being afterwards made so by a surrender of it and the grant of a new patent which may cure any defects. Ames v. Howard, 1 Sum. 482.

Infringement as Affected by Result.

Where the machines are substantially the same, and operate in the same manner to produce the same result, they must be in principle the same. The same result must be understood to mean the same kind of result, though there may be a difference in extent. The result is the same according to this definition whether one produces more than another or not, if the operation is to make the same article. Gray v. James, Pet. C. C. 394; Imlay v. Railroad Co. 1 Fish. 340; s. c. 4 Blatch. 227.

If the result is the same in kind it is not necessary that it shall be the same in degree. *Whipple v. Middlesex Co.* 4 Fish. 41.

That two machines produce the same effect will not justify the assertion that they are substantially the same, or that the devices used by one are therefore mere equivalents for those of the other. *Burr v. Duryee*, 2 Fish. 275; S. C. 1 Wall. 531.

The identity or the difference between two machines is sought, in the first place, by a comparison of them, either in their elements or as a system. *Wilson v. Barnum*, 2 Fish. 635; S. C. 1 Wall. Jr. 347; 8 How. 258.

Similarity in the structure, appearance and effect of two things, is presumptive evidence of their being made in the same way. *Matthews v. Skates*, 1 Fish. 602.

It is of no consequence, in respect to the question of infringement, whether one machine is like or unlike the other in respect to its cost, adjustability, or other peculiarity of construction, provided that notwithstanding such difference the one is, in its mechanical action, operation and effect, the same as the other. *Foss v. Herbert*, 2 Fish. 31; S. C. 1 Biss. 121.

Slight differences in degree can not be regarded as of weight in determining a question of substantial similarity or substantial difference. One thing may be a little longer or a little shorter than another, or it may work a little better or a little worse, and yet the two may be substantially the same. *Cahoon v. Ring*, 1 Fish. 397; S. C. 1 Cliff. 592.

Similarities or differences are not to be judged by the name of things, but the machines, or their several devices or elements, must be examined in the light of what they do, or what office or function they perform, and how they perform it. One thing is substantially the same as another if it perform substantially the same function or office in the same way to attain the same result, and things are substantially different when they perform different duties, or in a different way, or produce a different result. For the same reason similarities or differences are not determined by the mere fact that things are apparently the same, or of a different shape or form, but the true test of similarity or difference is the same in regard to shape or form as in regard to names. In both cases regard must be paid to the mode of operation, or the way the parts work, and the result as well as the means by which the result is attained. *Cahoon v. Ring*, 1 Fish. 397; S. C. 1 Cliff. 592; *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600.

One machine is the same in substance as another, if the principle be the same in both, although the forms may be different. *Sickels v. Borden*, 3 Blatch. 535.

By the principles of a machine is not meant the original elementary principles of motion, which philosophy and science have discovered, but the *modus operandi*, the peculiar device or manner of producing any given effect. *Whittemore v. Cutter*, 1 Gallis. 478.

The principle of a machine means the peculiar mode, manner, or device, by which the proposed result or effect is produced. *Pitts v. Wemple*, 2 Fish. 10; S. C. 1 Biss. 87; *Judson v. Cope*, 1 Fish. 615; S. C. 1 Bond, 327; *Latta v. Shawk*, 1 Fish. 465; S. C. 1 Bond, 259.

The word principle, as applied to the structure of a machine, means the

operative cause by which a certain effect is produced. The combination of powers is called the principle of the machine. *Brooks v. Jenkins*, 3 McLean, 432; *Parker v. Stiles*, 5 McLean, 44; *Judson v. Cope*, 1 Fish. 615; s. C. 1 Bond, 327.

Whatever is essential to produce the appropriate result of a machine independently of its mere form, is a matter of principle. *Olcott v. Hawkins*, 2 Am. L. J. 317.

The question is not which is best or is most perfect, but whether the one mode is an infringement of the rights secured by the other. *Howe v. Abbott*, 2 Story, 190; *Sickles v. Gloucester Manuf. Co.* 1 Fish. 222; s. C. 3 Wall. Jr. 196; *Colt v. Mass. Arms Co.* 1 Fish. 108; *Blanchard v. Beers*, 2 Blatch. 411; *Cox v. Griggs*, 2 Fish. 174; s. C. 1 Biss. 362; *Forbes v. Barstow Stove Co.* 2 Cliff. 379; *Pitts v. Wemple*, 2 Fish. 10; s. C. 1 Biss. 87; *Yale Manuf. Co. v. North*, 3 Fish. 279; s. C. 5 Blatch. 455; *Alden v. Dewey*, 1 Story, 336; *Carter v. Baker*, 4 Fish. 404; s. C. 1 Saw. 512; *McComb v. Brodie*, 5 Fish. 384; s. C. 1 Woods, 153; 2 O. G. 117; *Imlay v. Railroad Co.* 1 Fish. 340; s. C. 4 Blatch. 227; *Wheeler v. Clipper Co.* 6 Fish. 1; s. C. 10 Blatch. 181; 2 O. G. 442; *Adams v. Joliet Manuf. Co.* 12 O. G. 93.

It is no defense that the machine is not as good as that of the patentee. The rights of an inventor are oftentimes affected as injuriously by the sale of poor machines in the market as by those made more strictly in conformity to his patent. *Roberts v. Harnden*, 2 Cliff. 500; *Waterbury Brass Co. v. Miller*, 5 Fish. 48; s. C. 9 Blatch. 77; *Chicago Co. v. Busch*, 4 Fish. 395; s. C. 2 Biss. 472.

It is no defense that the result is not as good, if it is substantially the same in kind, and is produced substantially by the same means. *Roberts v. Harnden*, 2 Cliff. 510.

The superiority of the defendant's machine over that of the patentee is immaterial, except so far as it goes to show a substantial difference between them. *Alden v. Dewey*, 1 Story, 336.

Two things are not the same when one is in practice substantially better than the other, if the second improvement is not gained by the use of the same means or known mechanical equivalents. *Mitchell v. Tilghman*, 4 Fish. 599; s. C. 19 Wall. 287; 5 O. G. 299.

If the result of the mechanism used by the defendant is greatly superior to that described and claimed in the plaintiff's patent, this fact may be considered by the jury as tending to prove that the mechanism or device used by the defendant is a new invention substantially different from that described in the plaintiff's patent, to be considered, however, in connection with all the other evidence upon the subject of infringement. *Singer v. Walmsley*, 1 Fish. 558; *Smith v. Woodruff*, 6 Fish. 476; s. C. 1 McArthur, 459; 4 O. G. 635; *Carter v. Baker*, 4 Fish. 404; s. C. 1 Saw. 512.

The superior utility of the defendant's machine is not of itself a certain test, because it might contain the whole substance of the patentee's invention and something in addition, and the addition would not prevent it from being an infringement. *Pitts v. Wemple*, 2 Fish. 10; s. C. 1 Biss. 87.

The difference of result is sometimes coupled with mechanical differences. The mechanical differences may be sufficient to show that the two machines

are not substantially the same. The differences of result and utility may be so great as to be satisfactory proof of the same fact. It may, however, be that neither of these alone would be satisfactory, yet the mechanical difference and the difference of utility, taken together, may be sufficient to satisfy the mind. *Johnson v. Root*, 1 Fish. 351.

The greater utility, which may be regarded as evidence tending to show that some new principle or mechanical power or mode of operation producing a new kind of result has been introduced, must be derived from the changes introduced, and not from the use of better material or greater skill or care in the manufacture. *Many v. Sizer*, 1 Fish. 17; *Trader v. Messmore*, 7 O. G. 385.

If the practical operation and effect of two machines is essentially different, the law looks more to the result of the mechanical arrangement than to the arrangement itself. The new and different effect in the operation of the machine reflects back upon the mechanical arrangement and construction, and characterizes the change, and may authorize an inference of a substantial change which the arrangement disconnected from the new and different effect would not. Without connecting the new effect with the change, the change might be only formal and unsubstantial. It must be borne in mind, however, that the new effect which is to give such materiality and importance to the apparently formal change, must not be looked for in the simple increase of the producing capacity of the machine, or in the reduction of the amount of power required to operate it. All this may depend upon other considerations, as upon superior mechanical skill in the construction and arrangement of the machinery. But the new effect must be of a different kind. The new result must be a result derived from a different mechanical operation and effect, and not from the same operation and effect. *Le Roy v. Tatham*, 2 Blatch. 474; S. C. 14 How. 156; *Eames v. Cook*, 2 Fish. 146.

If one machine, which is alleged to be an infringement of another, produces a different result, or, in other words, is of greater utility than the preceding machine, it may be some evidence of a difference, a substantial difference, between them, and the utility of one over the other may be so great as to be satisfactory evidence that some new principle is involved, and that it is not substantially the same. *Johnson v. Root*, 1 Fish. 351; *Eames v. Cook*, 2 Fish. 146; *Many v. Sizer*, 1 Fish. 17; *Blanchard v. Beers*, 2 Blatch. 411.

If two things perform different work or in a way substantially different, or do not accomplish substantially the same result, then they are substantially different. *Cahoon v. Ring*, 1 Fish. 397; S. C. 1 Cliff. 592.

If the patent embraces one or more elements of a machine, but not the entire machine, any person may make, use or vend all other parts of the machine, and may employ an element analogous to that which is patented, provided it is substantially different. *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600.

Formal Change.

A patentee is not confined to the precise arrangement in the construction of his machine which he has described in his patent. Formal changes are nothing; mere mechanical changes are nothing; all these may be made out-

side of the description to be found in the patent, and yet the machine after it has been thus changed in its construction is still the machine of the patentee, because it contains his invention, the fruits of his mind, and embodies the discovery which he has brought into existence and put into practical operation. *Le Roy v. Tatham*, 2 Blatch. 474; s. c. 14 How. 156; *Sargent v. Larned*, 2 Curt. 340; *Brooks v. Jenkins*, 3 McLean, 432; *Cox v. Griggs*, 2 Fish. 174; s. c. 1 Biss. 362; *Taylor v. Archer*, 4 Fish. 449; s. c. 8 Blatch. 315; *Blanchard's Factory v. Warner*, 1 Blatch. 258; *Stanley v. Whipple*, 2 McLean, 35; *Jurgensen v. Magnin*, 5 Fish. 237; s. c. 9 Blatch. 294; *Buck v. Hermance*, 1 Blatch. 398; *Bantz v. Elsas*, 6 O. G. 117; *Odiome v. Winkley*, 2 Gallis. 51; *Imlay v. Railroad Co.* 1 Fish. 340; s. c. 4 Blatch. 227; *Mowry v. Whitney*, 3 Fish. 157; s. c. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond. 45; *Goodyear Dental Co. v. Gardner*, 4 Fish. 224; *Cook v. Howard*, 4 Fish. 269; *Wood Paper Co. v. Glens Falls Co.* 4 Fish. 324; s. c. 8 Blatch. 573; *Dennis v. Eddy*, 4 Fish. 423; *Hoffman v. Aronson*, 4 Fish. 456; s. c. 8 Blatch. 324; 4 A. L. T. (N. S.) 110.

A change in form from the construction of an existing machine is not a substantial change in the eye of the patent law, nor is a change in proportions. These changes require no great ingenuity; at all events, they do not call for the exercise of the inventive faculties. They are simply the work of a mechanic of ordinary skill, and are entitled to no particular consideration on an inquiry into the question of identity between the construction of two machines. *Le Roy v. Tatham*, 2 Blatch. 474; s. c. 14 How. 156; *Many v. Jagger*, 1 Blatch. 372; *O'Reilly v. Morse*, 15 How. 62; s. c. 6 West. L. J. 102; *Gray v. James*, Pet. C. C. 394; *Case v. Brown*, 2 Fish. 268; s. c. 2 Wall. 320; 1 Biss. 382; *Lowell v. Lewis*, 1 Mason, 182; *Singer v. Walmsley*, 1 Fish. 558; *Myers v. Frame*, 4 Fish. 493; s. c. 8 Blatch. 446; *Smith v. Downing*, 1 Fish. 64; *Park v. Little*, 3 Wash. C. C. 196; *Reutgen v. Karowrs*, 1 Wash. C. C. 168; *Dixon v. Moyer*, 4 Wash. C. C. 68; *Brooks v. Bicknell*, 3 McLean, 250; *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond. 327; *Brooks v. Jenkins*, 3 McLean, 432; *Wilbur v. Beecher*, 2 Blatch. 132; *Parker v. Stiles*, 5 McLean, 44; *Gibson v. Harris*, 1 Blatch. 167; *Davis v. Palmer*, 2 Brock. 298; *Hussey v. McCormick*, 1 Fish. 509; s. c. 1 Biss. 300; *Johnson v. Root*, 1 Fish. 351; *Morey v. Lockwood*, 8 Wall. 230; *Whiteley v. Kirby*, 11 Wall. 678; *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592; *Aiken v. Dolan*, 3 Fish. 197; *Many v. Sizer*, 1 Fish. 17; *Roberts v. Harnden*, 2 Cliff. 500; *Potter v. Wilson*, 2 Fish. 102; *Conover v. Dohrman*, 3 Fish. 382; s. c. 6 Blatch. 60; *Colt v. Mass. Arms Co.* 1 Fish. 108; *Teese v. Phelps*, 1 MCA. 48; *Clark Patent Co. v. Copeland*, 2 Fish. 221; *Blake v. Eagle Works Manuf. Co.* 4 Fish. 591; s. c. 3 Biss. 77; *Pitts v. Wemple*, 2 Fish. 10; s. c. 1 Biss. 168; *Jackson v. Allen*, 120 Mass. 64.

The new form of the machinery embodying the new ideas, is not a material part of the patentee's invention, for the reason that the embodiment of his ideas into working machinery, is rather the work of the skillful mechanic than that of the inventor. Many inventors of improvements in machinery, not being mechanics themselves, are obliged to obtain the aid of skillful mechanics in embodying their ideas in practical working machinery. Different mechanics would perhaps embody them by different arrangements of machin-

ery—all conforming, however, to the principles and ideas of the inventor. Hence, the mere form of the defendant's machinery must be disregarded, and the substance of its arrangement and its method of working must be examined for the purpose of seeing whether the ideas of the inventor are incorporated in it. *Sickles v. Borden*, 3 Blatch. 535; *Treadwell v. Parrott*, 3 Fish. 124; S. C. 5 Blatch. 369; *Gibson v. Harris*, 1 Blatch. 167.

A difference in the mechanical arrangement and construction of two machines, is not necessarily a test by which to determine that the two are not identical. They may be apparently very different externally, and still embrace the same substantial identity in principle or mode of operation. So, on the other hand, the converse of the proposition is equally true. The two may apparently be very similar externally, and still in principle and mode of operation be very different. There is no better mode of examining a question of this kind, than to inquire whether the mechanical arrangement and construction of the two embrace the same set of ideas, the same leading features or ideas, which in practical operation produce the useful result. In other words, whether the arrangement and combination of the parts of machinery found in each are substantially the same, and operate in substantially the same way in producing the result. Hence, the real question as it respects the identity of the two machines, looks simply to their mechanical arrangement and construction as to whether or not the defendant's incorporates in its structure and operation the spirit and substance of the plaintiff's improvement, that is, uses the arrangement and mechanism of the plaintiff's, to perform the same function or produce the same effect in the same way or substantially the same way. *Le Roy v. Tatham*, 2 Blatch. 474; S. C. 14 How. 156; *Smith v. Higgins*, 1 Fish. 537; *Sickles v. Borden*, 3 Blatch. 535; *Florence S. & M. Co. v. G. & B. S. M. Co.* 110 Mass. 70; *Morris v. Barrett*, 1 Fish. 461; S. C. 1 Bond. 254; *Birdsell v. McDonald*, 6 O. G. 682; *Blanchard v. Beers*, 2 Blatch. 411; *Whipple v. Baldwin Manuf. Co.* 4 Fish. 29.

If the substance and form of the inventions are separable, and the substance of the invention which the patent is designed to secure, is to be found in the manufacture of the respondent's, although copied and embodied in a form not described, or differing from the form described and specifically claimed in the patent, there is an infringement. *Murphy v. Eastham*, 5 Fish. 306; S. C. 1 Holmes, 113; 2 O. G. 61.

Where form and substance are inseparable, it is enough to look at the form only. Where they are separable, where the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the substance of the invention—for that which entitled the inventor to his patent, and which the patent was designed to secure. Where that is found there is an infringement, and it is not a defense that it is embodied in a form not described and in terms claimed by the patentee. *Winans v. Denmead*, 15 How. 330; *Many v. Jagger*, 1 Blatch. 372; *Sargent v. Larned*, 2 Curt. 340.

Equivalents.

When, in mechanics, one device does a particular thing or accomplishes a particular result, every other device known or used in mechanics, which

skillful and experienced workmen know will produce the same result or do the same particular thing, is a known mechanical substitute for the first device. It is sufficient to constitute known mechanical substitutes, that when a skillful mechanic sees one device doing one particular thing, that he knows the other devices whose use he is acquainted with will do the same thing. *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512.

An equivalent means something that does substantially the same thing in substantially the same way. *Cahoon v. Ring*, 1 Fish. 397; S. C. 1 Cliff. 592; *Conover v. Rapp*, 4 Fish. 57.

By equivalents in machinery, is usually meant the substitution of merely one mechanical power for another, or one obvious and customary mode for another of effecting a like result. *Smith v. Downing*, 1 Fish. 64.

The substantial equivalent of a thing is the same as the thing itself. If two machines do the same work in substantially the same way and accomplish substantially the same result, they are the same. *Cahoon v. Ring*, 1 Fish. 397; S. C. 1 Cliff. 592; *Foss v. Herbert*, 2 Fish. 31; S. C. 1 Biss. 121; *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; *Waterman v. Thomson*, 2 Fish. 461; *White v. Boker*, 3 Fish. 66.

The term equivalent has two meanings; the one relates to the results that are produced, and the other, to the mechanism by which those results are produced. Two things may be equivalent, that is, the one equivalent to the other as producing the same result when they are not the same mechanical means. Mechanical equivalents are spoken of as different from equivalents that merely produce the same result. A mechanical equivalent as generally understood, is where the one may be adopted instead of the other by a person skilled in the art from his knowledge of the art. But there may be equivalents in producing the same result, each of which is an independent matter of invention, and in that sense they are not mechanical equivalents. *Johnson v. Root*, 1 Fish. 351; *Burden v. Corning*, 2 Fish. 477.

The substitution of a mechanical equivalent as it is termed, in the construction of a machine, is not a substantial change. There are very many devices in construction that can be made by a skillful mechanic, differing very much from each other in appearance, but which in the eye of the patent law are regarded as identical. For instance, an inventor in the construction of his machine, desires a given power in order to give practical operation and effect to his discovery. One mechanic may furnish the power by means of a lever; another by means of a screw—two very different instruments; yet so far as the use of the instruments, and so far as their purpose to furnish the power is concerned, they are regarded simply as mechanical equivalents, and the use of one in one machine, does not distinguish that machine from a machine in which the other is found. So, too, a given power may be obtained by a spring, or by a weight, or by a pulley—apparently very different devices, yet as they are used for the same purpose and to accomplish the same end in machinery, they are regarded as substantially identical. *Le Roy v. Tatham*, 2 Blatch. 474; S. C. 14 How. 156; *Page v. Ferry*, 1 Fish. 298; *O'Reilly v. Morse*, 15 How. 62; S. C. 6 West. L. J. 102; *Latta v. Shawk*, 1 Fish. 465; S. C. 1 Bond, 259; *Case v. Brown*, 2 Fish. 268; S. C. 2 Wall. 320; 1 Biss. 382; *Colt v. Mass. Arms Co.* 1 Fish. 108; *Smith v. Downing*, 1 Fish. 64; *Gallahue v.*

Butterfield, 6 Fish. 203; S. C. 10 Blatch. 232; 2 O. G. 645; *Singer v. Walmsley*, 1 Fish. 558; *Roots v. Hyndman*, 6 Fish. 439; S. C. 4 O. G. 29; *Seymour v. McCormick*, 2 Blatch. 240; S. C. 16 How. 480; *Foss v. Herbert*, 2 Fish. 31; S. C. 1 Biss. 121; *Ives v. Hamilton*, 6 Fish. 244; S. C. 92 U. S. 426; 10 O. G. 336; *Pitts v. Edmonds*, 2 Fish. 52; S. C. 1 Biss. 168; *Sarven v. Hall*, 6 Fish. 495; S. C. 11 Blatch. 295; 4 O. G. 666.

The doctrine respecting the use of mechanical equivalents, is not confined by the patent law to those elements which are strictly known as such in the science of mechanics. In the present advanced stage of that science, there are different well known devices, any one of which may be adopted to effect a given result, according to the judgment of the constructor. The mere substitution of one of these for another can not be treated as an invention. It does not belong to the subject of invention, but of construction. The substance of the invention does not consist in the identical devices used, but in a practical and described mode of effecting certain operations, and when the patentee has described what those operations are, and one practicable mode of effecting them, he has enabled constructors to effect these operations, not only by the identical devices he employed, but by all other known substitutes. *Foster v. Moore*, 1 Curt. 279.

Alternative but different mechanisms which produce in whole or in part the same or similar useful effects are not mechanical equivalents in that sense in which their use constitutes an infringement. *Wells v. Hagaman*, 29 Leg. Int. 405.

In order to constitute one mechanical device the equivalent of another, it is not sufficient that it accomplishes the same result or produces the same effect, unless that effect is produced by substantially the same mode of operation. *Conover v. Roach*, 4 Fish. 12; *Merriam v. Drake*, 5 Fish. 259; S. C. 9 Blatch. 336.

Although a handle is not in general the equivalent of a lever, yet if it is used to perform the same functions in substantially the same way, it may be an equivalent. *Brown v. Guild*, 23 Wall. 181; S. C. 6 O. G. 292; 7 O. G. 739.

A device which has apparently different mechanical adaptabilities can not be considered a mechanical equivalent. Mechanical equivalents are not those merely which produce the same result. *Smith v. Marshall*, 10 O. G. 375.

If a party is not the original inventor of the principle as well as of the machine, he has no right to invoke the doctrine of equivalents, for it does not belong to him; but if he is the inventor of the principle which he embodies in his machine, as well as the first inventor of the machine which carries it out, he has a right to invoke the doctrine of equivalents. *Singer v. Walmsley*, 1 Fish. 558.

If the change constitutes a mechanical equivalent in reference to the means used by the patentee, and if, besides being an equivalent, it accomplishes some other advantage beyond the effect or purpose accomplished by the patentee, it will still be an infringement as respects what is covered by the patent, although the further advantage may be a patentable subject as an improvement on the former invention. *Foss v. Herbert*, 2 Fish. 31; S. C. 1 Biss. 121; *Converse v. Cannon*, 2 Woods, 7; S. C. 9 O. G. 105; *Carstaedt v. U.*

S. Corset Co. 13 Blatch. 371; 10 O. G. 3; Sarven v. Hall, 5 Fish. 415; S. C. 9 Blatch. 524; 1 O. G. 437.

Although the commissioner required the patentee to disclaim a claim in specific terms for an equivalent, yet he may treat a person who uses it as an infringer. Union M. C. Co. v. U. S. C. Co. 11 O. G. 1113.

The patentee of a composition may, if he choose, confine himself to the specific ingredients mentioned, and expressly exclude all others, or he may expressly exclude some or one other. If he does so, it can not be maintained that what he has expressly disclaimed is in point of law claimed although it is an equivalent for one of the elements claimed. Byam v. Farr, 1 Curt. 260.

The term equivalent, when used in regard to the chemical action of such fluids as can be discovered only by experiment, only means equally good. Tyler v. Boston, 7 Wall. 327.

Where a patent is granted for a composition made of several ingredients, it covers and embraces known equivalents of each of the ingredients. Matthews v. Skates, 1 Fish. 602; Woodward v. Morrison, 5 Fish. 357; S. C. 1 Holmes, 124; 2 O. G. 120; Byam v. Eddy, 2 Blatch. 521; U. S. Felting Co. v. Manuf. Co. 9 O. G. 202; Allen v. Hunter, 6 McLean, 303; Poppenhusen v. Falke, 2 Fish. 213; Byam v. Eddy, 24 Vt. 666.

An equivalent of any substance is another substance having similar properties and producing substantially the same effect. Matthews v. Skates, 1 Fish. 602.

Where water is used in a process merely as a fluid, the use of benzine or any other substance possessing that property of water which is made available in the process, is within the scope of the patent as a manifest equivalent. Roberts v. Roter, 5 Fish. 295.

Whether one thing is a mechanical equivalent for another is a question of fact, and is to be determined from all the circumstances of the case by attending to the consideration whether the one contrivance is used for the same purpose, performs the same duties, or is applicable to the same object as the other. Foss v. Herbert, 2 Fish. 31; S. C. 1 Biss. 121; Howe v. Williams, 2 Fish. 395; S. C. 2 Cliff. 245.

Mere formal alterations of a combination in letters patent do not constitute any defense to the charge of infringement, as the inventor of a combination is as much entitled to suppress every other combination of the same ingredients to produce the same result, not substantially different from what he has invented and caused to be patented as the inventor of any other patented improvement. Such inventors may claim equivalents as well as any other class of inventors, and they have the same right to suppress every other subsequent improvement not substantially different from what they have invented and secured by letters patent. The withdrawal of one ingredient in a patented combination and the substitution of another which was well known at the date of the patent as a proper substitute for the one withdrawn, is a mere formal alteration of the combination, and if the ingredient substituted performs substantially the same function as the one withdrawn, such substitution of one ingredient for another will not avoid the charge of infringement. Storrs v. Howe, 10 O. G. 421; Vogle v. Semple, 11 O. G. 923; S. C. 9 C. L. N. 217; Seymour v. Osborne, 3 Fish. 555; S. C. 11 Wall. 516; Taylor v. Garretson, 5 Fish. 116; S. C. 9 Blatch.

156; *Gould v. Rees*, 6 Fish. 106; s. c. 15 Wall. 187; 2 O. G. 624; *Gill v. Wells*, 22 Wall. 1; s. c. 6 O. G. 881; 2 A. L. T. (N. S.) 101; *Conover v. Roach*, 4 Fish. 12; *Blake v. Robertson*, 6 Fish. 509; s. c. 11 Blatch. 237; 6 O. G. 297; *Conover v. Rapp*, 4 Fish. 57; *Webster v. Carpet Co.* 5 O. G. 522; *Sayles v. C. & N. R. Co.* 4 Fish. 584; s. c. 3 Biss. 52; *Rice v. Heald*, 13 Pac. L. R. 33; *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; *Washing Machine Co. v. Lincoln*, 4 Fish. 379; *Graham v. Mason*, 5 Fish. 1; *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512; *King v. Louisville Cement Co.* 6 Fish. 336; s. c. 4 O. G. 181; *Gorham v. Mixer*, 1 Am. L. J. 539; *Cochrane v. Deener*, 11 O. G. 637; s. c. 4 W. L. R. 99.

Mere Mechanical Skill.

In order to determine whether the change in the arrangement and construction of an existing machine is to be considered as a substantial change or not, it must be ascertained and determined whether the change is the result of mechanical skill worked out by mechanical devices—of a knowledge that belongs to that department of labor, or whether the change is the result of mind, of genius, of invention in which there is something more than mere mechanical skill and ingenuity. A change in the arrangement and construction is not substantial unless there is embodied in it, over and beyond the skill of the mechanic, that inventive element of the mind which is to be found in every machine or improvement that is the proper subject of a patent. *Le Roy v. Tatham*, 2 Blatch. 474; s. c. 14 How. 156; *Case v. Brown*, 2 Fish. 268; s. c. 2 Wall. 320; 1 Biss. 382; *Seymour v. McCormick*, 2 Blatch. 240; s. c. 16 How. 480; *Gibson v. Harris*, 1 Blatch. 117; *Hamilton v. Ives*, 6 Fish. 244; s. c. 3 O. G. 30; *Blanchard v. Beers*, 2 Blatch. 411; *Union Paper Bag Co. v. Nixon*, 6 Fish. 402; s. c. 4 O. G. 31; *Gibson v. Van Dresar*, 1 Blatch. 532; *Birdsell v. McDonald*, 6 O. G. 682; *Forbes v. Barstow Stove Co.* 2 Cliff. 379; *Coffin v. Ogden*, 3 Fish. 640; s. c. 7 Blatch. 61; *Goodyear v. Honsinger*, 3 Fish. 147; s. c. 2 Biss. 1; *Goodyear v. Schenck*, 3 Fish. 82; *Thayer v. Wales*, 5 Fish. 130; s. c. 9 Blatch. 170; *Renwick v. Pond*, 5 Fish. 569; s. c. 10 Blatch. 39; 2 O. G. 392.

If a person has an invention, and another person looking at the description of it, can, from his knowledge of the subject, pass to the other thing that is used without any invention, then the one is substantially the same as the other. It is not necessary that every unskilled person shall see how he passes; but if a person skilled and competent in the art is able, by looking at the description with care to see that the result may be attained in a different mode or in a different manner, and it is done in that different mode or in that different manner by the use of the knowledge which he has in the art, that would not be a new invention or substantially different from the original. *Johnson v. Root*, 1 Fish. 351.

The patentee is protected from obvious modes readily adopted without invention for accomplishing the same end. *Union Paper Bag Co. v. Nixon*, 6 Fish. 402; s. c. 4 O. G. 31.

The mere exercise of skill, ingenuity, thought, and experiment in the production of an article is not sufficient to obviate the charge of infringement.

for it may be that they would produce an article substantially the same, though formally different, or might be employed to prevent a similitude in form, although the principle be the same, and so evade the patent. *Many v. Sizer*, 1 Fish. 17.

Practice and experience in the working of a machine may lead to highly beneficial modifications of the form. This is the natural and usual result in the operation of machinery newly invented and constructed. It requires time and experience to bring it to perfection. But the right of the inventor does not depend upon the questions, whether the machine is more or less perfect, or whether slight modifications in the arrangement of the machinery, or in the finish of the parts composing it, may or may not better accomplish the end sought to be attained; but upon the question whether the machinery constructed as described in the patent will or will not accomplish the end practically and usefully in the way pointed out. If it will, the inventor is entitled to the protection which the government has granted him; and any one using the principle thus embodied is guilty of an infringement, however he may have perfected the machinery by superior skill in the mechanical arrangement and construction of the parts. Such perfecting is but the skill of the mechanic, not the genius of the inventor. *Kinsman v. Parkhurst*, 1 Blatch. 488; s. C. 18 How. 289; *Le Roy v. Tatham*, 2 Blatch. 474; s. C. 14 How. 156; *Tracy v. Torrey*, 2 Blatch. 275; *Wilbur v. Beecher*, 2 Blatch. 132.

A patentee is entitled to use all modifications resulting from experience in the use of his invention which do not involve any new or further invention. *Decker v. Grote*, 6 Fish. 143; s. C. 10 Blatch. 331; 3 O. G. 65.

The patentee is entitled to the exclusive use of the mechanical organization, device, or means for all the uses and purposes to which it can be applied—to every function, power, and capacity of his patented machine or device—without regard to which he supposed originally it was most applicable. *McComb v. Brodie*, 5 Fish. 384; s. C. 1 Woods, 153; 2 O. G. 117.

When an Infringement.

The inquiry is not whether the principle of the two articles is the same. If the principle is the same, and the effect is similar in both, in contemplation of law they are identical. *Buerk v. Imhausen*, 5 O. G. 752; *Hike v. P. & W. R. R. Co.* 6 O. G. 575; *Kursheedt v. Werner*, 12 Blatch. 530; s. C. 8 O. G. 146; *Wicks v. Stevens*, 2 Woods, 310; *G. & B. Manuf. Co. v. Tirrell*, 12 Blatch. 144; s. C. 8 O. G. 2; *King v. Werner*, 12 Blatch. 270; s. C. 8 O. G. 361; *R. & E. Manuf. Co. v. P. & F. C. Manuf. Co.* 12 Blatch. 36; s. C. 7 O. G. 383; *Union Paper Bag Co. v. Newell*, 6 Fish. 582; s. C. 11 Blatch. 379; 5 O. G. 459; *Aultman v. Holley*, 6 Fish. 534; s. C. 11 Blatch. 304; 5 O. G. 3; *Bigelow v. Matthews*, 7 Blatch. 77; *McMillin v. Barclay*, 5 Fish. 189; s. C. 4 Brews. 275; *McComb v. Brodie*, 5 Fish. 384; s. C. 1 Woods, 153; 2 O. G. 117; *Brooks v. Bicknell*, 3 McLean. 250; *Blanchard v. Putnam*, 3 Fish. 186; s. C. 8 Wall. 420; 2 Bond, 84; *Latta v. Shawk*, 1 Fish. 465; s. C. 1 Bond, 259; *Doubleday v. Sherman*, 3 Fish. 369; *Stuart v. Shantz*, 6 Fish. 35; s. C. 2 O. G. 524; 9 Phila. 376; *Buerk v. Valentine*, 5 Fish. 366; s. C. 9 Blatch. 479; 2 O. G. 295; *Jenkins v. Johnson*, 6 Fish. 433; s. C. 9 Blatch. 516; *Seymour v.*

Marsh, 6 Fish. 115; s. c. 2 O. G. 675; 9 Phila. 380; Baldwin *v.* Schultz, 5 Fish. 75; s. c. 9 Blatch. 494; 2 O. G. 315; Parker *v.* Haworth, 4 McLean, 370; Potter *v.* Davis Sewing Machine Co. 3 Fish. 472; Smith *v.* Pearce, 2 McLean, 176; Harwood *v.* Mill River Co. 3 Fish. 526; McComb *v.* Beard, 6 Fish. 254; s. c. 10 Blatch. 350; 3 O. G. 33; Sarven *v.* Hall, 6 Fish. 495; s. c. 11 Blatch. 295; 4 O. G. 666; Barclay *v.* Thayer, 12 Blatch. 109; s. c. 6 O. G. 20; Woolcocks *v.* Many, 5 Fish. 72; s. c. 9 Blatch. 139; Wheeler *v.* Clipper Co. 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 42; Black *v.* Thorne, 5 Fish. 550; s. c. 10 Blatch. 66; 2 O. G. 388; Sloat *v.* Patton, 1 Fish. 154; Ormsbee *v.* Wood, 3 Fish. 372; Kidd *v.* Spence, 4 Fish. 37; Hawes *v.* Washburne, 5 O. G. 491; King *v.* Mandelbaum, 4 Fish. 577; s. c. 8 Blatch. 468; Hitchcock *v.* Tremaine, 4 Fish. 508; s. c. 8 Blatch. 440; Corliss *v.* W. & W. Manuf. Co. 2 Fish. 199; Doubleday *v.* Sherman, 3 Fish. 371; Kendricks *v.* Emmons, 6 Fish. 462; s. c. 1 Holmes, 334; 4 O. G. 398; Westlake *v.* Cartter, 6 Fish. 519; s. c. 4 O. G. 636; Seymour *v.* McCormick, 3 Blatch. 209; s. c. 19 How. 96; La Baw *v.* Hawkins, 6 O. G. 724; Knox *v.* Loweree, 6 O. G. 802; Welling *v.* Rubber Co. 7 O. G. 606; Weston *v.* Nash, 1 Holmes, 488; s. c. 7 O. G. 1096; Hartshorne *v.* Almy, 1 Holmes, 493; s. c. 8 O. G. 94; Stover *v.* Halsted, 13 Blatch. 95; s. c. 8 O. G. 558; Magic Ruffle Co. *v.* Elm City Co. 13 Blatch. 151; s. c. 8 O. G. 773; Schillinger *v.* Gunther, 11 O. G. 831; N. Y. Rubber Co. *v.* Chaskel, 9 O. G. 923; Earle *v.* Harlow, 9 O. G. 1018; Dalton *v.* Nelson, 13 Blatch. 357; s. c. 9 O. G. 1112; Pickering *v.* Phillips, 10 O. G. 420; Tucker *v.* Tucker Manuf. Co. 10 O. G. 464; Collender *v.* Canieo, 10 O. G. 467; Stevens *v.* Pritchard, 10 O. G. 505; Holbrook *v.* Small, 10 O. G. 508; Robertson *v.* Blake, 11 O. G. 877; Olcott *v.* Hawkins, 2 Am. L. J. 317; Whipple *v.* Baldwin Manuf. Co. 4 Fish. 29; Whipple *v.* Middlesex Co. 4 Fish. 41; Carter *v.* Baker, 4 Fish. 404; s. c. 1 Saw. 512; Parham *v.* Sewing Machine Co. 4 Fish. 468; Henderson *v.* Cleveland Stove Co. 12 O. G. 4; Adams *v.* Joliet Manuf. Co. 12 O. G. 93.

The inventor usually sets forth what he conceives to be the best form or mode under which his machine may be used to produce the required result. In order to ascertain the true nature and value of his invention, the substance and principle of it must be separated from its accidents; its essence from its modes. A mere change in the latter while the former are retained will not acquit the party making it from the charge or guilt of pirating the invention. Blanchard *v.* Reeves, 1 Fish. 103.

Where the patent prescribes a use of water to a certain extent, and the effect can be produced by using less, he is an infringer who produces the result contemplated by the patentee by such use only of the described means as is essential to that end. Roberts *v.* Roter, 5 Fish. 295.

It is essential to the validity of a patent for a process to show how it may be adapted to practical use. In showing this the inventor may describe mechanical means of applying, or peculiarly shaped vessels for containing, any of the ingredients used in his process or art. But they constitute no part of his invention. Another person may discover new and useful means of applying or using the inventor's process, and be entitled to a patent for that improvement without the right to use the process. Piper *v.* Brown, 4 Fish. 175; s. c. 1 Holmes, 20; 91 U. S. 37.

A patent for a device can not be avoided by dividing it into two parts which, when combined, produce the same result in substantially the same way. *Wheeler v. Clipper Co.* 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442.

If the invention consists in the discovery of a principle in science which is made practically useful by the patented process, any one who adopts that principle to an available or practical extent so far invades the exclusive right of the patentee. If he adopts the patentee's invention in part only, and uses an agency in his process which is not a part of the patentee's invention, he is an infringer. *Tilghman v. Werk*, 2 Fish. 229; S. C. 1 Bond, 511.

Although there may be two things which differ from the patent in something beyond mechanical equivalents or form or proportion, and therefore are not to be treated as violations; yet if there is a third thing introduced in the defendant's machine which is covered by the patent, the party is liable for that third, although not for the other two. *Colt v. Mass. Arms Co.* 1 Fish. 108.

A piece in a machine may perform two functions. If all the parts are virtually used, it is no excuse to say one part is not nominally retained, but its office is performed by something else under a different name. *Brooks v. Norcross*. 2 Fish. 661.

If the plan of the defendant's machine is in substance and effect a colorable evasion of the patentee's contrivances, it is an infringement. If the defendant takes the same general plan and applies it for the same purpose, although he may have varied the mode of construction, it will be substantially and in the eye of the patent law the same thing. *Seymour v. McCormick*, 2 Blatch. 240; S. C. 16 How. 480; *Foss v. Herbert*, 2 Fish. 31; S. C. 1 Biss. 121; *Johnson v. McCullough*, 4 Fish. 170; *Lee v. Blandy*, 2 Fish. 89; S. C. 1 Bond, 361; *Pitts v. Wemple*, 2 Fish. 10; S. C. 1 Biss. 87; *Blandy v. Griffith*, 3 Fish. 609; *Gallahue v. Butterfield*, 6 Fish. 203; S. C. 10 Blatch. 232; 2 O. G. 645.

The right to make such changes in an ingredient as it necessarily undergoes in any mere process of manufacturing the composition is inseparable from the right to use the thing itself. *Byam v. Farr*, 1 Curt. 260.

The right to use an article as an ingredient in a composition is a right to use it in the state in which it is ordinarily bought and used. *Byam v. Farr*, 1 Curt. 260.

Where a slight change is made in a machine by which a new result is brought about, the invention is not extended beyond the change; but where something elementary is discovered, and fairly constitutes a part of the invention, no other person is permitted to use that elementary part without paying tribute to the patentee. *Cornell v. D. & B. Brewing Co.* 11 O. G. 331; S. C. 9 C. L. N. 142.

If a claim embraces only the entire and complete mode described, the use of only a part of the mode is not an infringement. *Byam v. Farr*, 1 Curt. 260.

Where the invention embraces the entire machine, any person is an infringer who, without license, makes or uses any portion of the machine. Under such a patent the patentee holds the exclusive right to make and use, and vend to others to be used, the entire machine; and if another, without license, makes, uses or vends any portion of it, he invades the rights of the patentee.

Union Sugar Refinery v. Mathewson, 2 Fish. 600; *Mabie v. Haskell*, 2 Cliff. 507; *Moody v. Fiske*, 2 Mason, 112.

When a device is capable of being used in another mode, and all its benefits are fully secured if it is so used, a change in the mode will be deemed an infringement. *Union Paper Bag Co. v. Nixon*, 9 O. G. 691; s. C. 3 Cent. L. J. 223.

Mere contrivances to produce power, such as any mechanic can supply, are no part of the invention. *Blanchard's Factory v. Warner*, 1 Blatch. 258.

The fact that another may dispense with a part of the machine described by the patentee, and use the invention, will not give him a right to use that invention. *Ely v. Monson Manuf. Co.* 4 Fish. 64.

In a certain sense nearly all new machines are but combinations of old devices, that is to say, they do or may combine frames, bolts, screws, nuts, rods, pulleys, cranks, wheels, levers, pins, nails, and boards, and, as the case may be, various other and more complicated devices, none of which, regarded singly or separately, are new, and yet the machine formed by the combination is new as a structure, new in its operation, and new in the effect produced. The patent in such case is not for a mere combination, and another machine, having the like construction, operation and effect, in all that constitutes the principle of the machine and the efficient means of its operation, is an infringement of the patent, notwithstanding it may be moved by a less number of wheels, or be held together by a less number of clamps, screws, nails, bolts, or keys, and notwithstanding drum and pulley may be substituted for cog-wheels, or other gear or bolts for screws or nuts, or like changes be made in other devices employed to construct the machine. *Waterbury Brass Co. v. Miller*, 5 Fish. 48; s. C. 9 Blatch. 77.

If two patents conflict, the more recent must give way to the elder, because the one who patents an invention first is entitled to the protection of the principle in it over everybody else who patents it afterwards. *Colt v. Mass. Arms Co.* 1 Fish. 108; *Westlake v. Cartter*, 6 Fish. 519; s. C. 4 O. G. 636.

If there is more than one claim in a patent, it is not necessary to prove that the defendant has infringed all the claims, but it is sufficient if any one of such claims has been infringed. *Singer v. Walmsley*, 1 Fish. 558; *McComb v. Brodie*, 5 Fish. 384; s. C. 1 Woods, 153; 2 O. G. 117; *Wyeth v. Stone*, 1 Story, 273; *Cook v. Ernest*, 5 Fish. 396; s. C. 1 Woods, 195; 2 O. G. 89; *Morris v. Barrett*, 1 Fish. 461; s. C. 1 Bond, 254; *Foss v. Herbert*, 2 Fish. 31; s. C. 1 Biss. 121; *Pitts v. Whitman*, 2 Story, 609; *Moody v. Fiske*, 2 Mason, 112; *Colt v. Mass. Arms Co.* 1 Fish. 108; *Pitts v. Wemple*, 2 Fish. 10; s. C. 1 Biss. 87.

An improvement will not justify the use of the prior patent without the consent of the first patentee. *O'Reilly v. Morse*, 15 How. 62; s. C. 6 West. L. J. 102; *Alden v. Dewey*, 1 Story, 336; *Gray v. James*, Pet. C. C. 394; *Hays v. Sulsor*, 1 Fish. 532; s. C. 1 Bond, 279; *Johnson v. Root*, 1 Fish. 351; *Howe v. Morton*, 1 Fish. 586; *Forbes v. Barstow Stove Co.* 2 Cliff. 379; *Foss v. Herbert*, 2 Fish. 31; s. C. 1 Biss. 121; *Tilghman v. Werk*, 2 Fish. 229; s. C. 1 Bond, 511; *Pitts v. Edmonds*, 2 Fish. 52; s. C. 1 Biss. 168; *Imlay v. Railroad Co.* 1 Fish. 340; s. C. 4 Blatch. 227; *Carr v. Rice*, 1 Fish. 198; *Woodworth v. Rogers*, 3 W. & M. 135; *Conover v. Roach*, 4 Fish. 12; *Foster*

v. Moore, 1 Curt. 279; *Blake v. Stafford*, 3 Fish. 294; s. C. 6 Blatch. 195; *Brooks v. Bicknell*, 4 McLean, 70; *Middletown Co. v. Judd*, 3 Fish. 141; *Pitts v. Wemple*, 6 McLean, 558; *Goodyear v. Berry*, 3 Fish. 439; s. C. 2 Bond, 189; *Goodyear v. Muller*, 3 Fish. 420; *Colt v. Mass. Arms Co.* 1 Fish. 108; *Goodyear Dental Co. v. Evans*, 3 Fish. 390; s. C. 6 Blatch. 121; *Washburn v. Gould*, 3 Story, 122; *Winans v. N. Y. & Harlem R. R. Co.* 4 Fish. 1; *Whipple v. Baldwin Manuf. Co.* 4 Fish. 29; *Cook v. Howard*, 4 Fish. 269; *Whipple v. Middlesex Co.* 4 Fish. 41; *Cowing v. Rumsey*, 4 Fish. 275; s. C. 8 Blatch. 36; *Conover v. Rapp*, 4 Fish. 57; *Eickemeyer Machine Co. v. Pearce*, 6 Fish. 219; s. C. 10 Blatch. 403; 3 O. G. 150; *Chicago Co. v. Busch*, 4 Fish. 395; s. C. 2 Biss. 472; *Fales v. Wentworth*, 5 Fish. 302; s. C. 1 Holmes, 96; 2 O. G. 58; *Burrall v. Jewett*, 2 Paige, 134; *Jenkins v. Walker*, 5 Fish. 347; s. C. 1 Holmes, 120; 1 O. G. 359; *Johnson v. Linen Co.* 33 Conn. 436; *American Pavement Co. v. Elizabeth*, 6 Fish. 424; s. C. 3 Q. G. 522; *Waterbury Brass Co. v. Miller*, 5 Fish. 48; s. C. 9 Blatch. 77; *Wells v. Gill*, 6 Fish. 574; s. C. 4 O. G. 669; *Westinghouse v. G. & R. Brake Co.* 9 O. G. 538; *Hartshorn v. Shorey*, 9 O. G. 595; *Morse v. Bain*, 9 West. L. J. 106; *Robertson v. Blake*, 11 O. G. 877; *Kittle v. Frost*, 5 Fish. 213; s. C. 9 Blatch. 214; *Pearl v. Ocean Mills*, 11 O. G. 2; *Murphy v. Kissling*, 1 Holmes, 432; s. C. 7 O. G. 302; *Arkell v. Paper Bag Co.* 7 Blatch. 475; *Batchelder v. Moulton*, 6 Fish. 488; s. C. 11 Blatch. 303; 4 O. G. 501.

If the modification is merely an improvement, it is an infringement; if it displaces and supersedes the patented invention, it is not. *Whipple v. Middlesex Co.* 4 Fish. 41.

If a patent is granted for an improvement upon an invention covered by a prior patent, such improvement can not be used if by its use the prior patent is infringed. *Waterbury Brass Co. v. N. Y. Brass Co.* 3 Fish. 43; *Jackson v. Allen*, 120 Mass. 64.

The original patentee can not use an improvement upon his patent without a license from the inventor. *Pitts v. Wemple*, 6 McLean, 558; *Conover v. Roach*, 4 Fish. 12; *Whipple v. Baldwin Manuf. Co.* 4 Fish. 29; *Spaulding v. Tucker*, 1 Deady, 649; *Reutgen v. Kanowrs*, 1 Wash. C. C. 168.

When a person has invented some mode of carrying into effect a law of natural science or a rule of practice, he is entitled to protect himself from all other modes of making the same application. The substantial identity, therefore, that is to be looked to respects that which constitutes the essence of the invention, namely, the application of the principle. If the mode of carrying the same principle into effect adopted by the defendant still shows that the principle admits of the same application in a variety of forms or by a variety of apparatus, such mode is a piracy of the invention. But if the defendant has adopted variations which show that the application of the principle is varied, that some other law of science, or rule of practice, is made to take the place of that which the patentee claims as the essence of his invention, then there is no infringement. *Wintermute v. Redington*, 1 Fish. 239; *Tilghman v. Werk*, 2 Fish. 229; s. C. 1 Bond, 511.

It would seem that where a patent is obtained without a claim to the invention of the machinery through which a valuable result is produced, a precise specification is required, and the test of infringement is whether the

defendant has used substantially the same process to produce the same result. *Le Roy v. Tatham*, 14 How. 156; s. c. 2 Blatch. 474.

When no Infringement.

If the defendant's invention is a substitution for the original invention, then it is not substantially the same. *Johnson v. Root*, 1 Fish. 351.

If the patent is for an old instrument used to accomplish a new result, there is no infringement unless the defendant uses substantially the same instrument in substantially the same manner as that set forth in the patent. *Johnson v. Root*, 1 Fish. 351.

When a patentee covers with his patent the material of which a part of his machine is composed, he entirely endangers his right to prosecute when a different and inferior material is employed, and especially one which he himself, after repeated experiments, had rejected. *Aiken v. Bemis*, 3 W. & M. 348.

If a person of competent skill could not, from the description given by the patentee, make a machine like the defendant's, then there is no infringement. If he could not make one substantially like the defendant's, it would follow either that the thing patented could not, from the description given by the patentee, be made by a person of competent skill, or that, when made, it would be substantially different from the defendant's. This, however, merely involves the question of substantial identity. *Many v. Sizer*, 1 Fish. 17.

If the devices used by the defendant are old, there is no infringement, although they are equivalents for the patentee's devices. *Dennis v. Cross*, 6 Fish. 138; s. c. 3 Biss. 389.

That is a substantial identity which comprehends the application of the principle of the invention. If a party adopts a different mode of carrying the same principle into effect, and the principle admits a variety of forms, there is an identity of principle, though not an identity of mode. *Page v. Ferry*, 1 Fish. 298.

If no part of the patent which is valid has been used by the defendant, he can not be made an infringer by an argument which mingles the valid and invalid parts, and calls it a unit, and then claims that the defendant is an infringer because he has used one part of this unit, although it was a part as to which the patent is void. *Jones v. Morehead*, 1 Wall. 155.

After a patent has been obtained for a particular thing by one person, another person, without appropriating that patent, may invent a new mode of accomplishing the same or a similar object, and the latter will be entitled to a patent for his discovery. He must, however, invent something material and new that is essential to the subject-matter of the invention. If he introduces a new element or principle into the subject-matter of the invention, there is no infringement. *Pitts v. Wemple*, 2 Fish. 10; s. c. 1 Biss. 87.

If a mechanical element is materially different in its form and principle, and the effect produced by it, from the same as used in the patented machine, there is no infringement. *Pitts v. Wemple*, 6 McLean, 558.

If the invention claimed be itself but an improvement on a known machine, by a mere change of form or combination of parts, the patentee can not treat another as an infringer who has improved the original machine by

use of a different form or combination performing the same functions. The inventor of the first improvement can not invoke the doctrine of equivalents to suppress all other improvements which are not colorable invasions of the first. *Burr v. Duryee*, 2 Fish. 275; s. c. 1 Wall. 531; *McCormick v. Talcot*, 20 How. 402; s. c. 6 McLean, 539; *Union Sugar Refinery v. Matthiesson*, 2 Fish. 600; *Taylor v. Garretson*, 5 Fish. 116; s. c. 9 Blatch. 156.

An evasion of a patent which is not an invasion of it is *damnum absque injuria*. Every man has a right to make an improvement in a machine and evade a previous patent, provided he does not invade the rights of the patentee. *Burr v. Duryee*, 2 Fish. 275; s. c. 1 Wall. 531; *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9.

An improvement in the principle of a machine is no invasion of the patentee's privilege. *Park v. Little*, 3 Wash. C. C. 196.

If a party, by changes of form or arrangement, introduces any new principle or mechanical power, or a new mode of operation producing a new kind of result, he does not infringe the patent. *Many v. Sizer*, 1 Fish. 17.

If the defendant's apparatus is different in its mechanical action, producing its results in a different way from the patentee's, that is a difference in principle. *Silby v. Foote*, 1 Blatch. 445; s. c. 14 How. 218.

If the original structure was in fact and in truth no infringement, neither accident nor usage could make it so. Mind must be associated with matter in the commission of the trespass. It is the intention which gives the guilty hue to the act. *Page v. Ferry*, 1 Fish. 298.

A difference in use which is merely a difference in extent is not a different use. *Johnson v. Linen Co.* 33 Conn. 436.

The patentee can not claim the result or effect. He can only claim the mode which he devised for attaining the result. Any one can produce the same result by other and different modes, and still not violate the patentee's claim. Results are not patented, but only means used to produce results. In order to constitute a violation, there must be a use of the same methods substantially as those adopted by the patentee. *Case v. Brown*, 2 Fish. 268; s. c. 2 Wall. 320; 1 Biss. 382; *Carver v. Hyde*, 16 Pet. 513; *Smith v. Higgins*, 2 Fish. 97; *Burr v. Cowperthwait*, 4 Blatch. 163; *Evarts v. Ford*, 6 Fish. 587; s. c. 5 O. G. 58; *Brooks v. Jenkins*, 3 McLean, 432; *Wheeler v. Simpson*, 6 O. G. 435; *Foss v. Herbert*, 2 Fish. 31; s. c. 1 Biss. 121; *Burden v. Corning*, 2 Fish. 477; *Lee v. Blandy*, 2 Fish. 89; s. c. 1 Bond, 361; *American Pin Co. v. Oakville Co.* 3 Blatch. 190.

The general object of all rival inventions is the same, but this does not necessarily make all new inventions or patents for a like object an encroachment on all previous ones. *Smith v. Downing*, 1 Fish. 64.

One machine or manufacture is not a violation of another, within the purview of the patent law, unless it is substantially the same. It need not be identical, but it must be similar in the principle or mode of operation. *Ashcroft v. B. & L. R. R. Co.* 1 Holmes, 366; s. c. 5 O. G. 725; *Wheeler v. Simpson*, 6 O. G. 435; *Monroe v. Dover Stamping Co.* 1 Holmes, 413; s. c. 6 O. G. 685; *Merrill v. Yeomans*, 1 Holmes, 331; s. c. 5 O. G. 267; 11 O. G. 970; *U. S. Steam Gage Co. v. Am. Steam Gage Co.* 1 Holmes, 309; s. c. 5 O. G. 208; *Cammeyer v. Newton*, 12 Blatch. 122; s. c. 5 O. G. 753; 11 O.

G. 287; *Sweetster v. Helms*, 10 O. G. 4; *Mann v. Bayliss*, 10 O. G. 113, 789; *Smith v. Downing*, 1 Fish. 64; *Alden v. Dewey*, 1 Story, 336; *Forsyth v. Clapp*, 6 Fish. 528; s. c. 1 Holmes, 278; 4 O. G. 527; *Potter v. Thayer*, 6 Fish. 603; s. c. 1 Holmes, 293; 5 O. G. 32; *Dalton v. Jennings*, 93 U. S. 271; s. c. 12 Blatch. 96; 5 O. G. 15; 11 O. G. 11; *Page v. Ferry*, 1 Fish. 298; *West v. Silver Wire Skirt*, 3 Fish. 306; s. c. 5 Blatch. 477; *Kirby v. Dodge Manuf. Co.* 6 Fish. 156; s. c. 10 Blatch. 307; 3 O. G. 181; *Lake v. Fitzgerald*, 6 Fish. 420; *Meissner v. Devoe Manuf. Co.* 5 Fish. 285; s. c. 9 Blatch. 363; 2 O. G. 545; *Doubleday v. Bracheo*, 2 Fish. 560; *Dyson v. Danforth*, 4 Fish. 133; *Dibble v. Augur*, 7 Blatch. 86; *Dibble v. Sibbley*, 7 Blatch. 209; *Hailes v. Van Wormer*, 7 Blatch. 443; *Bliss v. Haight*, 3 Fish. 621; s. c. 7 Blatch. 7; *Hudson v. Draper*, 4 Fish. 256; *Crosby v. Lapouraille*, Taney, 374; *Price v. Kelley*, 11 O. G. 639; *Florence Manuf. Co. v. B. D. Co.* 1 Holmes, 415; s. c. 6 O. G. 728; *Jones v. Merrill*, 8 O. G. 401; *Trader v. Messmore*, 7 O. G. 385; *Tufts v. Machine Co.* 1 Holmes, 459; s. c. 8 O. G. 239; *Goodyear D. V. Co. v. Flagg*, 9 O. G. 153; *Ashcroft v. Hollings*, 11 O. G. 879; *Scaife v. Fulton*, 9 O. G. 1164; *Estabrook v. Dunbar*, 10 O. G. 909; *Smith v. Clark*, 3 Am. L. J. 155.

Experiment.

It was not the intention of Congress to punish a man who constructed a machine merely for philosophical experiments, or for the purpose of ascertaining the sufficiency of the machine to produce the described effects. *Whittemore v. Cutter*, 1 Gallis. 429; *Rumford Works v. Lauer*, 5 Fish. 615; s. c. 10 Blatch. 122; 3 O. G. 349.

Although the party may call the manufacture an experiment, yet if it is a matter of business, and the article is thrown into the market for the purpose of being sold, and is sold with his other products, that is such a use as will make the party liable. *Poppenhusen v. Gutta Percha Comb Co.* 2 Fish. 62.

It can hardly be necessary for a person to experiment with the patentee's invention, in order to perfect his own, especially when he is already familiar with the former. Such experiments by rivals, are not within that class of experiments protected by law. *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 193.

Combination.

To constitute an infringement of a combination, the whole combination must be used, because the patentee claims not the various parts, but the whole combination together. *Case v. Brown*, 2 Wall. 320; s. c. 2 Fish. 268; 1 Biss. 382; *Barrett v. Hall*, 1 Mason, 447; *Smith v. Downing*, 1 Fish. 64; *Carr v. Rice*, 1 Fish. 198; *Carr v. Rice*, 1 Fish. 325; s. c. 4 Blatch. 200; *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond, 212; *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond, 259; *Singer v. Walmsley*, 1 Fish. 558; *Lee v. Blandy*, 2 Fish. 89; s. c. 1 Bond, 361; *Bean v. Smallwood*, 2 Story, 408; *Vance v. Campbell*, 1 Fish. 483; s. c. 1 Black, 427; *Silsby v. Foote*, 1 Blatch. 445; s. c. 14 How. 218; *Howe v. Abbott*, 2 Story, 190; *McCormick v. Talcott*, 20 How. 402; s. c. 6

McLean, 539; *Evans v. Eaton*, Pet. C. C. 322; S. C. 3 Wheat. 454; *Brooks v. Bicknell*, 4 McLean, 70; *Brooks v. Jenkins*, 3 McLean, 432; *Parker v. Haworth*, 4 McLean, 370; *Foss v. Herbert*, 2 Fish. 31; S. C. 1 Biss. 121; *Pitts v. Wemple*, 6 McLean, 558; *Hale v. Stimpson*, 2 Fish. 565; *Many v. Sizer*, 1 Fish. 17; *Dodge v. Card*, 2 Fish. 116; S. C. 1 Bond, 393; *Pitts v. Wemple*, 2 Fish. 10; S. C. 1 Biss. 87; *Crompton v. Belknap Mills*, 3 Fish. 536; *Fisher v. Craig*, 3 Saw. 69; *Haselden v. Ogden*, 3 Fish. 378; *Washing Machine Co. v. Tool Co.* 20 Wall. 342; S. C. 1 Holmes, 161; *Roberts v. Harneden*, 2 Cliff. 500; *Bridge v. Brown*, 6 Fish. 236; S. C. 1 Holmes, 205; 3 O. G. 121; *Nicholson Co. v. Hatch*, 3 Fish. 432; *Brown v. Hinkley*, 6 Fish. 370; S. C. 3 O. G. 384; *Wood Paper Co. v. Fibre Co.* 3 Fish. 362; S. C. 6 Blatch. 27; *Cammeyer v. Newton*, 12 Blatch. 122; S. C. 5 O. G. 753; 11 O. G. 287; *Blanchard v. Putnam*, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84; *Dunbar v. Myers*, 11 O. G. 35; *Fuzzard Manuf. Co. v. Dickinson*, 3 Fish. 289; S. C. 6 Blatch. 80; *Densmore v. Schofield*, 4 Fish. 148; *Rice v. Heald*, 13 Pac. L. R. 33; *Rich v. Close*, 4 Fish. 279; S. C. 8 Blatch. 41; *Reedy v. Scott*, 23 Wall. 352; S. C. 7 O. G. 463; *Cooledge v. McCone*, 2 Saw. 571; S. C. 5 O. G. 458; 1 A. L. T. (N. S.) 214; *Sanford v. Hat Co.* 10 O. G. 466; *Craig v. Smith*, 2 Cent. L. J. 256.

If a combination has three different known parts, and the result is proposed to be accomplished by the union of all the parts arranged with reference to each other, the use of two of these parts only combined with a third which is substantially different in the manner of its arrangement and connection with the others, is not an infringement. *Brooks v. Fiske*, 15 How. 212; *Wilcox v. Komp*, 7 Blatch. 126.

A patentee can not repudiate one of the parts of his combination after another inventor has taught him how to dispense with it. *Hale v. Stimpson*, 2 Fish. 565; *Cooledge v. McCone*, 2 Saw. 571; S. C. 5 O. G. 458; 1 A. L. T. (N. S.) 214.

If a part is not an essential or material element of the invention, a party can not evade the patent by not using it, although the patent is for a combination. *Latta v. Shawk*, 1 Fish. 465; S. C. 1 Bond, 259.

If the invention consists not only in the combination but in the improvement of several of the parts of which that combination is composed, the violation of one of them is an infringement. *Parker v. Haworth*, 4 McLean, 370; *Pitts v. Wemple*, 6 McLean, 558; *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600.

No one can by combining several devices, each of which is old, thereby deprive others of the right to use them separately, or of the right to use them in new combinations, or of the right to use some of them in combination, omitting others. *Hailes v. Van Wormer*, 7 Blatch. 443.

If the elements of the combinations are not connected and arranged in the same manner, there is no infringement. *Singer v. Walmsley*, 1 Fish. 558.

If the principle of the patentee's combination is embodied in the defendant's machine, there is an infringement, although it has been so constructed as to perform but one of the functions of the combination. *Blanchard v. Beers*, 2 Blatch. 411.

If the defendant has merely substituted an equivalent for one of the ele-

ments of the patented combination, he infringes it, although his combination includes other functions and produces other effects not attainable by the patented combination. *Sarven v. Hall*, 5 Fish. 415; s. c. 9 Blatch. 524; 1 O. G. 437; *Wheeler v. Clipper Co.* 6 Fish. 1; s. c. 10 Blatch. 181; 2 O. G. 442.

If a party uses all the parts of a combination but one, and for that substitutes another mechanical structure substantially different in its construction and operation, he is not guilty of an infringement. It is not the same combination if it substantially differs from it in any of its parts. *Eames v. Godfrey*, 1 Wall. 78; *Merriam v. Drake*, 5 Fish. 259; s. c. 9 Blatch. 336; *Prouty v. Ruggles*, 16 Pet. 336; s. c. 1 Story, 568; *Knox v. Murtha*, 5 Fish. 174; s. c. 9 Blatch. 205; *Stimpson v. Balt. & Sus. R. R. Co.* 10 How. 329; *Dennis v. Eddy*, 4 Fish. 423; *Smith v. Marshall*, 10 O. G. 375; *Densmore v. Schofield*, 4 Fish. 148; *American Pavement Co. v. Elizabeth*, 4 Fish. 189.

The improvement of one element of a combination does not give the right to use or appropriate the original combination. *Stainthorp et al. v. Humiston*, 4 Fish. 107; *Converse v. Cannon*, 2 Woods, 7; s. c. 9 O. G. 105.

A subordinate device is not an element within the rule which requires the use of all the elements of a combination. *Smith v. Fay*, 6 Fish. 446.

There are cases in which a change of form destroys the combination. They are those in which form is necessary to secure the beneficial result, and when, of course, a change of form of one or more of the things combined works a different result. *American Pavement Co. v. Elizabeth*, 4 Fish. 189.

The essential character of a machine is not varied by a mutual interchange of form and direction between the two elements of which it is a combination, while both object and effect remain as before. *Wilson v. Barnum*, 2 Fish. 635; s. c. 1 Wall. Jr. 347; 8 How. 258.

Although the patentee is the inventor of one part of a combination, still if it is only claimed in combination with the other parts, a party does not infringe the patent unless he uses the whole combination. *Foster v. Moore*, 1 Curt. 279.

A change of location of a part in a combination will not evade a patent if no new function is performed by the changed member in its new location. *Adams v. Joliet Manuf. Co.* 12 O. G. 93.

If the defendant has a patent for a combination which contains as one of its elements the principle embodied in the complainant's patent, it is an infringement. *Cleveland v. Towle*, 3 Fish. 525.

If the subsequent combination is new, or if the ingredient substituted for the one withdrawn is a newly discovered one, or even an old one performing some new function, and was not known at the date of the patent as a proper substitute for the ingredient withdrawn, there is no infringement, for a new combination or a newly discovered ingredient substituted for the one omitted, or even an old one performing a new function not known at the date of the patent as a proper substitute for the one withdrawn, is not an equivalent for the ingredient omitted, within the meaning of the patent law. *Gould v. Rees*, 6 Fish. 106; s. c. 15 Wall. 187; 2 O. G. 624; *Crompton v. Belknap Mills*, 3 Fish. 536; *Fuller v. Yentzer*, 11 O. G. 597; *Seymour v. Osborne*, 3 Fish. 555; s. c. 11 Wall. 516.

Neither a slight or immaterial change in the ingredients of a compound or

the manner of preparing them, will relieve the party from the charge of infringing. If, for example, a man were to use the ingredients specified in the patent, and were to add a small portion of some other article, or were to vary the proportions so that the result would not be materially changed, it would be an infringement. *Matthews v. Skates*, 1 Fish. 602; *Woodward v. Morrison*, 5 Fish. 357; S. C. 1 Holmes, 124; 2 O. G. 120; *Ryan v. Goodwin*, 3 Sum. 514; *Goodyear v. Gutta Percha Co.* 2 Fish. 312; *Wood Paper Co. v. Fibre Co.* 3 Fish. 362; S. C. 6 Blatch. 27.

If the defendant uses an article that was not known as an equivalent at the date of the patent in substitution for another in a compound, there is no infringement, although the article contains the chemical elements which constitute the other in a new chemical combination. *Wonson v. Gilman*, 11 O. G. 1011.

Licensee.

If a licensee is limited to the use of one machine, he can not use two, although both are never in operation at the same time. *Bloomer v. Gilpin*, 4 Fish. 50.

If a licensee has a right to use one machine within certain territorial limits, he is liable as an infringer for any use of it outside of those limits, although such use is without his actual consent. *Steam Cutter Co. v. Sheldon*, 5 Fish. 475; S. C. 10 Blatch. 1.

If the right to use a machine is conditional upon the payment of the consideration, and the licensee uses a machine without making such payment, he can not defeat his liability as an infringer by tendering a performance of the condition. *Steam Cutter Co. v. Sheldon*, 5 Fish. 475; 10 Blatch. 1.

If the right of a licensee is conditional upon the payment of the consideration, and he combines with an infringer to use a machine without complying with his contract, he will be deemed to have abandoned his contract. *Steam Cutter Co. v. Sheldon*, 5 Fish. 475; S. C. 10 Blatch. 1.

If contiguous lines are not prohibited from carrying messages by reason of their contiguity to the complainant's lines, there is no infringement of the rights of an assignee to a line between certain points when such contiguous lines transmit messages between those points by a circuitous route. *West. Tel. Co. v. Mag. Tel. Co.* 21 How. 456; *West. Tel. Co. v. Penniman*, 21 How. 460.

Purchasers.

The sale or use of the product of a patented machine is no violation of the exclusive right to use, construct, or sell the machine itself; and the patent for a new and improved process by which any product or manufacture before known in commerce may be made in a cheaper and better manner, grants nothing but the exclusive right to use the particular process. Where a known manufacture or process is in the market, purchasers are not bound to inquire whether it was made on a patented machine or by a patented process. *Goodyear v. Central R. R. Co.* 1 Fish. 626; S. C. 2 Wall. Jr. 356; *Boyd v. McAlpin*, 3 McLean, 427; *Pitcher v. U. S.* 1 N. & H. 7; *Boyd v. Brown*, 3 McLean, 295.

If the patent is for a process, a sale of the product is no infringement. *Merrill v. Yeomans*, 11 O. G. 970.

If the patentee is the discoverer or inventor of a new manufacture or composition of matter, it is clear that his franchise or sole right to use, and vend to others to be used, is the new composition or substance itself. The product and the process constitute one discovery. In such a case the use of the product is an infringement of the patent. *Goodyear v. Central R. R. Co.* 1 Fish. 626.

Whether the inventor in any given case has a patent for the article manufactured, or only for the product or material of which it is composed, the unconditional sale of the manufactured article carries with it the absolute dominion over the material as well as over the manufactured article. Having manufactured the material, and sold it for a satisfactory compensation, whether as material or in the form of a manufactured article, the patentee, so far as that quantity of the product of his invention is concerned, has enjoyed all the rights secured to him by his letters patent, and the manufactured article, and the material of which it is composed, go to the purchaser for a valuable consideration, discharged of all the rights of the patentee previously attached to it, or impressed upon it by the statute under which the patent is granted. *Goodyear v. Beverly Rubber Co.* 1 Cliff. 348.

The original patentee, in selling rights for counties or States may, by a special covenant, prohibit the assignee from vending the product beyond the limits of his own exclusive right, but in such a case the remedy would be on the contract and not under the patent law, for the law protects the thing patented and not the product. *Boyd v. Brown*, 3 McLean, 295.

Although a licensee is restricted to the manufacture of the product for one particular purpose, yet when he sells his manufactures, the material of which they are composed passes to the purchaser discharged of the peculiar privileges secured by the patent. Absolute dominion over the material passes to the purchaser when the sale is made, and he is not obliged to keep the manufactures as waste articles, or throw them away when they cease to be of value as manufactures, but may use the material for any other lawful purpose to which it can be applied. *Goodyear v. Beverly Rubber Co.* 1 Cliff. 348.

The grant of a machine is in law a grant of the use of it. If a party has the right to a machine and to the use of it, he may work it himself or by his agents, or lease it out to any other person. *Reutgen v. Kanowrs*, 1 Wash. C. C. 168.

If one element of a combination is worn out, the machine is gone. A party who takes the remaining elements and uses them in a new machine, is guilty of an infringement. *Craig v. Fisher*, 5 Pac. L. R. 52.

Second purchasers acquire the same rights as their vendor had, and may do with the article or its materials whatever the first purchaser could have lawfully done if he had not parted with the title. *Goodyear v. Beverly Rubber Co.* 1 Cliff. 348.

A purchaser acquires an absolute, unconditional title to that which is the subject of a patent, and may continue to use it until it is worn out, or repair

it, or improve upon it as he pleases, in the same manner as if dealing with any other kind of property. *Goodyear v. Beverly Rubber Co.* 1 Cliff. 348; *Union M. C. Co. v. U. S. C. Co.* 11 O. G. 1113.

Infringers.

A sheriff who merely sells the materials of which a patented machine is composed, under an execution against the patentee, is not liable for an infringement. The purchaser merely buys the materials with the right to apply them in such manner as the law allows, and acts at his peril. *Sawin v. Guild*, 1 Gallis. 485.

A party who uses a patented hotel register containing advertisements is an infringer, and not merely the advertisers. *Hawes v. Washburne*, 5 O. G. 491; *Hawes v. Gage*, 5 O. G. 494.

A party who buys and sells the product of a patented machine under a real contract with the manufacturer, is not liable for an infringement. *Keplinger v. De Young*, 10 Wheat. 358.

If the contract is not a real one, or does not constitute the sole connection between the parties, or the transaction is merely colorable, with a view to evade the law, the purchaser of the products will be liable. *Keplinger v. De Young*, 10 Wheat. 358.

The statute does not embrace every workman who may be employed in making parts of a patented machine, or one who may sell them as the shopman or clerk of another. The maker and seller intended by the statute is the principal who employs these subordinate agents, the person for whom, by whose direction and on whose account the machines are made and sold, the person who receives the profits of the sale, he is the seller and the maker. It is he who claims title and property in the thing, and who undertakes to transfer it to the purchaser. The workmen employed by him for stipulated wages have nothing to do with his right or with his invasion of the rights of another. They work under his direction and sell on his account. *Delano v. Scott*, Gilp. 489.

The agent of a transit company, for making contracts for freight is not liable to an action at law for the use of a patented article upon the cars used in carrying the freight, if he has no authority to direct whether the patented article shall be used on the cars or not. *Lightner v. Kimball*, Lowell, 211.

A party who sells the thing patented as agent for another is an infringer. *Morse v. Davis*, 5 Blatch. 40; *Potter v. Crowell*, 3 Fish. 112; S. C. 1 Abb. U. S. 89.

A party who constructs a patented machine is liable for an infringement, although he was employed by another. *Bryce v. Dorr*, 3 McLean, 582.

When one in the employ of a corporation, does an act in the business of his employment for the benefit of the corporation, which it adopts and approves and takes advantage of, it will be deemed to have authorized the act, and will be as much bound by it as though expressly authorized. *Poppenhusen v. Gutta Percha Comb Co.* 2 Fish. 62.

Where a corporation acting in that character, directs an act to be done which infringes the rights of a patentee, it may be sued in an action on the case. *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9.

If the liability of a municipal corporation to suit, is limited to cases of contract, it can not be sued for an infringement. *Jacobs v. Commissioners*, 4 Fish. 81; s. c. 1 Bond, 500; *Allen v. Brooklyn*, 4 Fish. 598; s. c. 8 Blatch. 535.

If the machine used by the fire department is obtained at the expense of the municipal corporation, the corporation is liable for the infringement, although the fire department may be for certain purposes a distinct corporation, and possibly, to some extent, independent of the action of the corporation of the city in its entire corporate capacity. *Ransom v. New York*, 1 Fish. 252; *Bliss v. Brooklyn*, 4 Fish. 596; s. c. 8 Blatch. 533.

Where parties contract for implements, machines, or structures to contain a patented article, without any knowledge that the contractor is an infringer, or intends to use the thing patented without authority, it is not the just and legal implication from the contract, that the party ordering the article contemplates that the contractor will violate the rights of the patentee, or that he thereby commands or directs an infringement. An agent of a corporation, who merely makes a contract for the construction of cars containing the thing patented, is not liable as an infringer. *Lightner v. Brooks*, 2 Cliff. 287.

If a contractor violates the patent right of another, he is answerable for the infringement. He can not defend himself against the claim, by asserting that he committed the wrong under a contract. *Jacobs v. Commissioners*, 4 Fish. 81; s. c. 1 Bond, 500.

All the parties guilty of a tort are deemed principals. *Baldwin v. Sibley*, 1 Cliff. 150.

The general rule of the common law is *volenti non fit injuria*, and in accordance with this maxim no one can maintain an action for a wrong, where he has consented or contributed to the act of which he complains. It is true that in general the law imports damage from the violation of a right, but damage has never been presumed by law, from an act in which the plaintiff co-operated. *Byam v. Bullard*, 1 Curt. 100.

No sale is an infringement within the meaning of the statute, except one which is within the terms of the grant contained in the letters patent, which is a grant of an exclusive right to make, use, and vend to others to be used. A sale to the patentee's agent is a sale to him, and such a sale is not *per se* an infringement. *Byam v. Bullard*, 1 Curt. 100.

If the patentee's agent purchased the patented article at a shop where it and similar articles may be expected to be found for sale, and if it was sold to him in the usual course of the trade there, and if he saw others exposed for sale, it would be a natural inference that this was not the only article sold. *Byam v. Bullard*, 1 Curt. 100.

The workmen and employees of the government who do work for it in a specific form by the orders of the government, can not be held liable for infringing a patent in doing such work. *Heaton v. Quintard*, Blatch. 73.

The government can not make use of a patented improvement any more than a private individual without a license of the inventor or making compensation to him. *U. S. v. Burns*, 12 Wall. 246; *Cammeyer v. Newton*, 12 Blatch. 122; s. c. 5 O. G. 753; 11 O. G. 287.

A contractor who has agreed to furnish articles to the government, can not

use a patented invention without license of the inventor. *Brady v. Atlantic Works*, 10 O. G. 702; *Cammeyer v. Newton*, 12 Blatch. 122; S. C. 5 O. G. 753; 11 O. G. 287.

It is no infringement to make or fashion the articles which are to form a patented armor, for they do not become armor until they are put on the vessel. *Heaton v. Quintard*, 7 Blatch. 73.

The mere manufacture of a separate element of a patented combination is not in and of itself an infringement, unless it is conducted with the intent of aiding an infringement. *Saxe v. Hammond*, 1 Holmes, 456; S. C. 7 O. G. 781.

If one person manufacturing one part of a combination, acts in concert with another who manufactures the other part, they will be deemed joint infringers. *Wallace v. Holmes*, 5 Fish. 37; S. C. 9 Blatch. 65; 1 O. G. 117; *Coolidge v. McCone*, 2 Saw. 571; S. C. 5 O. G. 458; 1 A. L. T. (N. S.) 214.

If a party manufactures one important part of a combination, without any actual prearrangement with another to manufacture the other part, each sale is a proposal to the purchaser to supply the other part, and renders the manufacturer an infringer. *Turrell v. Spaeth*, 8 O. G. 986; *Wallace v. Holmes*, 5 Fish. 37; S. C. 9 Blatch. 65; 1 O. G. 117; *Renwick v. Pond*, 5 Fish. 569; S. C. 10 Blatch. 39; 2 O. G. 392; *Richardson v. Noyes*, 10 O. G. 507.

If the patent is limited to the use of an article in a certain connection, a party who manufactures the article is not an infringer, although others do so use it. *Keystone Bridge Co. v. Iron Co.* 5 Fish. 468; S. C. 1 O. G. 471; 9 Phila. 374.

If a part of a combination is susceptible of use in other ways, a party who manufactures it is not, in the absence of proof of a conspiracy, liable as an infringer. *Coolidge v. McCone*, 2 Saw. 571; S. C. 5 O. G. 458; 1 A. L. T. (N. S.) 214.

If the patent is for the use of a certain compound, as a substitute for leaven in the preparation of farinaceous food, a person who prepares and sells self-raising flour containing the ingredients, with the intent and purpose of enabling the buyer to turn the compound into bread by the use of water and heat, is an infringer. *Rumford Chemical Works v. Hecker*, 10 O. G. 289.

No Fixed Measure of Damages.

A patentee whose rights are infringed has his election of remedies. He may treat the infringer who illegally appropriates the invention to his own use, making profit thereby, as his trustee in respect of such profits, and compel him to account therefor in equity. On the other hand, the patentee may sue at law for the damages which he has sustained, and those damages he is entitled to recover, whether the defendant has made any profits or not. In such an action it is precisely what is lost to the patentee, and not what the defendant has gained, which is the legal measure of damages to be awarded. *Cowing v. Rumsey*, 4 Fish. 275; S. C. 8 Blatch. 36.

It must be apparent that there can not be any one rule of damages which will equally apply to all cases. The mode of ascertaining actual damages must necessarily depend on the peculiar nature of the monopoly granted. An

inventor may find his profit to consist in a close monopoly, forbidding any one to compete with him in the market, the patentee being himself able to supply the whole demand at his own price. If any person could use the invention or discovery by paying what a jury might suppose to be the fair value of a license, it is plain that competition would destroy the whole value of the monopoly. In such a case the profit of the infringer may be the only criterion of the actual damage of the patentee. But one who invents some improvement in the machinery of a mill could not claim that the profits of the whole mill should be the measure of damages for the use of his improvement. Where the profits of the patentee consist neither in the exclusive use of the thing invented or discovered, nor in the monopoly of making it for others to use, it is evident that this rule could not apply. The only actual damage which the patentee suffers in such a case is the non-payment of the price which he puts on his license, with interest, and no more. There may be cases, as where the thing has been used but for a short time, in which the jury should find less than that sum, and there may be cases where, from some peculiar circumstances the patentee may show actual damages to a larger amount. Of this a jury must judge from the evidence, under instructions from the court, that they can find only such damages as have actually been proved to have been sustained. Where an inventor finds it profitable to exercise his monopoly by selling licenses to make or use his improvement, he has himself fixed the average of his actual damage when his invention has been used without his license. If he claims anything above that amount, he is bound to substantiate his claim by clear and distinct evidence. It is only where from the peculiar circumstances of the case, no other rule can be found, that the defendant's profits become the criterion of the patentee's loss. Actual damages must be actually proved, and can not be assumed as a legal inference from any facts which amount not to actual proof of the fact. What a patentee would have made if the infringer had not interfered with his rights is a question of fact and not a judgment of law. The question is not what speculatively he may have lost, but what actually he did lose. The rule of damages must not be such as would be better entitled to the epithet of "speculative," "imaginary," or "fanciful," than that of "actual." *Seymour v. McCormick*, 16 How. 480; S. C. 2 Blatch. 240.

The jury are to give the actual damages which the patentee has sustained, not vindictive or speculative damages, but such damages as the patentee by his proofs shows that he has actually sustained by the infringement of his patent. *Ransom v. New York*, 1 Fish. 252; *Wilbur v. Beecher*, 2 Blatch. 132; *Teese v. Phelps*, 1 McA. 48; *Haselden v. Ogden*, 3 Fish. 378; *Parker v. Hulme*, 1 Fish. 44; *Russell v. Place*, 5 Fish. 134; S. C. 9 Blatch. 173; *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9; *Hall v. Wiles*, 2 Blatch. 194; *Whittemore v. Cutter*, 1 Gallis, 478.

The true course is to leave the jury at large to estimate the actual damages according to the circumstances of each particular case. The price of the machine, the nature, actual state and extent of the use of the patentee's invention, and the particular losses to which he may have been subjected by the piracy, are all proper ingredients to be weighed by the jury in estimating the damages. *Earle v. Sawyer*, 4 Mason, 1; *Carr v. Rice*, 1 Fish. 198; *Hubbell v. U. S.* 5 N. & H. 1.

Defendant's Profits.

The damages sustained by the patentee, and not another's gain, is made the rule, but the profit made by the defendant is a fair and legal subject for the calculation and judgment of the jury. Although the profit is not the amount to be recovered as damages, yet it is that from which a calculation or estimate of that damage may be rightfully made. *Whitney v. Emmett*, Bald. 303; *Parker v. Banker*, 6 McLean, 631; *Cowing v. Rumsey*, 4 Fish. 275; S. C. 8 Blatch. 36; *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512.

There is no unbending or unyielding rule of damages, though that usually recognized as the true rule has been to give to the patentee as damages the amount of profits which the defendant has derived from the use of the invention, not the amount which he might have realized, or which he made from the use of improvements other than those of the patentee, but what he actually did make by the use of the invention as patented. *Bell v. Daniels*, 1 Fish. 372; S. C. 1 Bond, 212; *Latta v. Shawk*, 1 Fish. 465; S. C. 1 Bond, 259; *Wintermute v. Redington*, 1 Fish. 239; *Matthews v. Skates*, 1 Fish. 602; *Case v. Brown*, 2 Fish. 268; S. C. 2 Wall. 320; 1 Biss. 382; *Hall v. Wiles*, 2 Blatch. 194; *Sickels v. Borden*, 3 Blatch. 535; *Buck v. Hermance*, 1 Blatch. 398; *Pitts v. Edmonds*, 2 Fish. 52; S. C. 1 Biss. 168; *Page v. Ferry*, 1 Fish. 298.

The rule of damages is the profits which have been derived to the defendant by means of the invention over any other mode which the defendant had a right to adopt. *Serrell v. Collins*, 1 Fish. 289; *Cox v. Griggs*, 2 Fish. 174; S. C. 1 Biss. 362; *Wilbur v. Beecher*, 2 Blatch. 132; *Tilghman v. Werk*, 2 Fish. 229; S. C. 1 Bond, 511; *Smith v. Pearce*, 2 McLean, 174.

The true criterion is the advantage which the defendant obtained or might by skill have obtained by using the patented device over the use of the old device, and the value of this advantage in money. *Campbell v. Barclay*, 5 Biss. 179.

If the patentee has taken certain elements before known, and combined them, and applied them to other parts of a machine constructed after his own fashion, and made the machine in question as a whole, he is entitled to recover the profits made upon the entire machine. *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512.

If any portion of the profits are properly to be credited to an improvement made by the defendant, the burden rests upon him to show affirmatively that fact, and how much of the profits ought to be credited to the improvement and deducted from the profits of the sale of the whole machine as improved, for he has caused the confusion of rights. *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512.

If any of the profits arose from an improvement made by the defendant, they do not belong to the patentee. *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512.

The profit made by the defendant, and that lost by the patentee, are among the elements which the jury may consider. *Philp v. Nock*, 17 Wall. 460.

The extent of the benefits accruing directly to the defendant should undoubtedly form an element for consideration when the question of damages is

considered. If the invention is valuable, and the defendant, by its use, has diminished his expenses, the jury are at liberty to infer that if he had admitted the patentee's rights he would have paid the amount thus saved, or a large portion of it, as the consideration for a license to use the invention, rather than abandon its use, and that the patentee has therefore lost by the infringement what the defendant would have so paid to secure such license. It is for this reason that the benefits received by the defendant from the use of the invention in the consequent reduction of his expenses, are proper subjects for consideration in determining the patentee's damages. *Ransom v. New York*, 1 Fish. 252.

The profits realized by the defendant are proper to be taken into consideration, but are not conclusive as to the extent of the injury, which may be either greater or less. A patentee may be manufacturing his patented article himself, and making it to a profit, while another man may make it to a disadvantage, and yet the spurious article carried into the market may displace the original. In such case the injury to the patentee would be greater than any profit upon the spurious production. On the other hand a defendant's article may not displace the original, and in that case the injury would be less. It may be that a patentee may derive a profit from licensing other parties to construct his invention, and any piracy upon it by depriving him of any portion of the profits of such licenses, would be an injury to be taken into account. A party concerned in infringing a patent stands in a different position from the patentee, not having been previously subjected to the expense and labor to which the latter is frequently exposed, and in the process of invention and experiment. Hence the person who enters upon the business without previous expense may very well afford to sell machines at less profit than the patentee. The latter must have his profit not only for the expense of putting in operation the improvement, but by way of indemnity for the previous time, labor and money which he has been obliged to bestow on the invention. He must, therefore, charge a higher price to cover these greater expenses. *Pitts v. Hall*, 2 Blatch. 229; *Campbell v. Barclay*, 5 Biss. 179; *Many v. Sizer*, 1 Fish. 17.

If the patentee claims the privilege of selling at a higher rate, the probabilities of his having been able to sell as many machines at a higher price, or as many at any price, as were sold by him and the defendant together, should be taken into consideration. *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512.

If the patentee has sustained other damages beyond the profits actually received by the defendant, he is entitled to recover them. *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512.

Plaintiff's Loss.

In an action at law, the profit which the plaintiff might have made is not the primary or controlling measure of damages. *Burdell v. Denig*, 92 U. S. 716.

Where profits are the proper measure of damages, it is the profit which the infringer makes or ought to make, and not the profit which the plaintiff can show that he might have made, that governs the measure of damages. *Burdell v. Denig*, 92 U. S. 716.

The rule is to give the actual damage or loss incurred by reason of the infringement, and that is the profits which the patentee would have made if he had not been embarrassed by the interference of the defendant's machine, because the law presumes that the patentee would have had the patronage which was diverted by the defendant. The profits which the patentee has lost in consequence of the infringement afford, therefore, a criterion by which to determine the amount of damages he has sustained. *Le Roy v. Tatham*, 2 Blatch. 474; S. C. 14 How. 156; *Pitts v. Hall*, 2 Blatch. 229; *Wintermute v. Redington*, 1 Fish. 239; *McComb v. Brodie*, 5 Fish. 384; S. C. 1 Woods, 153; 2 O. G. 117; *Morris v. Barrett*, 1 Fish. 461; S. C. 1 Bond, 254; *Rice v. Heald*, 13 Pac. L. R. 33; *Wayne v. Holmes*, 2 Fish. 20; S. C. 1 Bond, 27.

The profits which the patentee might have made if he had made and sold the articles which the defendant manufactured and sold, are not conclusive evidence of the actual damages, for there must also be proof that the patentee was prepared to supply the articles, and was prevented from doing so by the competition of the defendant, and was thus limited, hindered, checked, or interfered with in his business, or otherwise actually damaged to that amount. *Goodyear v. Bishop*, 2 Fish. 154; *Hawes v. Washburne*, 5 O. G. 491; *Magic Ruffle Co. v. Douglass*, 2 Fish. 330; *Teese v. Phelps*, 1 McA. 48.

The profits lost to the patentee must be the direct and legitimate fruits of the patent. He may have sustained damages from his inability to sell other articles, but they are too remote. *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512.

If the patent is for an entire machine, the patentee is entitled as damages to the profits he could have made in constructing and vending his machine, over and above the mere profits arising out of its manufacture, that is, the mere profits of its mechanical construction, and not the profits that grow out of the exclusive right to manufacture the invention under the patent. The latter belong to the patentee, while the former, the mere mechanical profits, are excluded from the damages. *Seymour v. McCormick*, 3 Blatch. 209; S. C. 19 How. 96.

If the right of a grantee is the mere right to construct the machine within certain limits, implying a right to sell outside of such limits, but without any right to use or authorize others to use the machine, the injury sustained by the grantee as the result of an infringement of his exclusive right is to be measured by the profit which he realized as a manufacturer from making it. *Jenkins v. Greenwald*, 2 Fish. 37; S. C. 1 Bond, 126.

If the patentee prefers to sell the thing patented in one locality, he is entitled to the profits he might have made were it not for the infringement, although he accepted a royalty in another locality. *Rice v. Heald*, 13 Pac. L. R. 33.

License Fee.

Profits are not the primary or true criterion of damages for infringement in an action at law. That rule applies eminently and mainly to cases in equity. On the other hand, a sale of licenses, or a royalty, constitute the primary and true criterion of damages in an action at law. In the absence of satisfactory evidence of either class in the forum to which it is most appropriate, the other

may be resorted to as one of the elements on which the damages may be ascertained. *Burdell v. Denig*, 92 U. S. 716; *Sickels v. Borden*, 3 Blatch. 535; *Hogg v. Emerson*, 11 How. 437; S. C. 2 Blatch. 1; *Colt v. Mass. Arms Co.* 1 Fish. 108; *Goodyear v. Bishop*, 7 Fish. 154; *Philp v. Nock*, 17 Wall. 460; *Packet Co. v. Sickles*, 19 Wall. 611; *Seymour v. McCormick*, 16 How. 480; S. C. 2 Blatch. 240; *Burdell v. Denig*, 2 Fish. 588; *Seymour v. McCormick*, 3 Blatch. 209; S. C. 19 How. 96.

If the test of the license fee can not be applied, the patentee is entitled to an amount which will compensate him for the injury to which he has been subjected by the piracy. *Philp v. Nock*, 17 Wall. 460.

Where the patented improvement has been used only to a limited extent and for a short time, the amount should be less than the license fee. *Birdsall v. Coolidge*, 93 U. S. 64; S. C. 10 O. G. 748.

The price for which the plaintiff has sold his rights to certain territory is no criterion by which to determine the amount of the damage sustained by an infringement in other territory. *Campbell v. Barclay*, 5 Biss. 179.

There are, no doubt, cases in which the license price may be a criterion, but there are few instances in which the patentee ought to be concluded by a former offer to sell. *Bell v. Daniels*, 1 Fish. 372; S. C. 1 Bond, 212; *Parker v. Hulme*, 1 Fish. 44.

It is incumbent on the patentee to prove the amount of the license fee. *Burdell v. Denig*, 2 Fish. 588.

Divers Items.

If the patentee has sustained damages beyond those arising from the actual interference of the defendant in making and putting into market similar machines, he may recover them. The question of damage is very much at large, and rests in the sound discretion of the jury. *Seymour v. McCormick*, 2 Blatch. 240; S. C. 16 How. 480.

It is the making and selling to be used, and not the selling or buying, or making alone, for which full damages are usually given. *Hogg v. Emerson*, 11 How. 587; S. C. 2 Blatch. 1.

If a use of the machine is actually proved, the rule of damages should be the value of the use of such a machine during the time of the illegal use. *Whittemore v. Cutter*, 1 Gallis. 478.

If the article made according to the patentee's invention is more valuable than when made according to the prior mode, this difference of value may be considered in estimating the damages. *Waterbury Brass Co. v. N. Y. Brass Co.* 3 Fish. 43.

Where the counsel on both sides are content with a measure of damages prescribed by themselves, it is not usual or necessary for the court to interfere at all. *Earle v. Sawyer*, 4 Mason, 1.

If the patentee has been compelled to carry his stock over from one season to another, the value of the use of his capital may be taken into consideration. *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512.

If the plaintiff has two patents, and sues only for an infringement of one, his recovery must be limited to the damages arising from the infringement of

that patent alone, and the part of the price for which he could have sold the thing patented due to that patent alone is all that can be taken into consideration. *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512.

Evidence of the utility and advantage of the invention over the old modes and devices that had been used for working out similar results, is appropriate to aid in estimating the amount of damages. *Suffolk Co. v. Hayden*, 4 Fish. 86; S. C. 3 Wall. 315; *Smith v. Higgins*, 1 Fish. 537; *Waterbury Brass Co. v. N. Y. Brass Co.* 3 Fish. 43.

The character or condition of the parties to the suit can not be taken into account in estimating the damages. *Suffolk Co. v. Hayden*, 4 Fish. 86; S. C. 3 Wall. 315.

Where an inventor has invented only an improvement, and there is a violation of his right under his patent to use that improvement in connection with the invention of others, or in connection with a machine previously known and used, his damages must be limited to the value of his improvement in connection with the other elements of the machine. That is a subject in regard to which it may be difficult to give definite proof, but the difficulty does not change the legal principle which applies. *Seymour v. McCormick*, 16 How. 480; S. C. 2 Blatch. 240; *Burdell v. Denig*, 2 Fish. 588; *Seymour v. McCormick*, 3 Blatch. 209; S. C. 19 How. 96.

Unless the jury is satisfied that the patentee has abandoned the privileges secured to him, his failure to bring suit against others infringing such patent should have no effect in reference to the question of damages. In other words, if he has dedicated his rights to the public, he can not recover at all; but if he has not, although he has failed to bring suits for the purpose of enforcing his rights, the jury can not reduce the damages which he has actually sustained, because the statute gives him his actual damages. *Ransom v. New York*, 1 Fish. 252.

Ignorance of the existence of the patent right does not furnish a reason for allowing no damages. *Hogg v. Emerson*, 11 How. 587; S. C. 2 Blatch. 1.

The intent not to injure never exonerates the party from all damages for the actual injury or encroachment, though it may mitigate them. *Hogg v. Emerson*, 11 How. 587; S. C. 2 Blatch. 1; *Parker v. Corbin*, 4 McLean, 462.

The jury, in estimating the damages, may take into account the interest, if they choose, and give it by way of damages. *Le Roy v. Tatham*, 2 Blatch. 474; S. C. 14 How. 156; *Seymour v. McCormick*, 2 Blatch. 240; S. C. 16 How. 480; *vide Silsby v. Foote*, 20 How. 378; S. C. 2 Blatch. 260.

The damages are not to be estimated for the whole term of the patent, but only for the period of the infringement, where the license fee is not taken as the measure of the damages. *Suffolk Co. v. Hayden*, 4 Fish. 86; S. C. 3 Wall. 315.

Where the infringement is confined to a part of the thing sold, the recovery must be limited accordingly. It can not be as if the entire thing were covered by the patent, or where that is the case, as if the infringement were as large as the monopoly. *Philp v. Nock*, 17 Wall. 460.

A patentee is not able to give the exact amount of damages that he has sustained with the utmost accuracy. It is not in his power. He does the best he can. If he is wrong in his calculation, the defendant can put him

right. The defendant knows the profit he has made. *Conover v. Rapp*, 4 Fish. 57.

Neither expenses nor counsel fees incurred in the vindication of his rights can be allowed to the patentee as damages. *Blanchard's Factory v. Warner*, 1 Blatch. 258; *Whittemore v. Cutter*, 1 Gallis. 429; *Philp v. Nock*, 17 Wall. 460; *Teese v. Huntingdon*, 23 How. 2; *Parker v. Hulme*, 1 Fish. 44; *Stimpson v. Railroads*, 1 Wall. Jr. 164; *Simpson v. Leiper*, 2 Whart. Dig. 363; *contra*, *Pierson v. Eagle Screw Co.* 3 Story, 402; *Parker v. Corbin*, 4 McLean, 462; *Boston Manuf. Co. v. Fiske*, 2 Mason, 119; *Adams v. Edwards*, 1 Fish. 1; *Allen v. Blunt*, 2 W. & M. 121; *Alden v. Dewey*, 1 Story, 336; *Washburn v. Gould*, 3 Story, 122; *Hays v. Sulsor*, 1 Fish. 532; s. c. 1 Bond, 279.

The patentee can not claim damages for the use of an improvement upon his invention. *Sayles v. Railroad Company*, 2 Fish. 523; s. c. 1 Biss. 468.

No damages can be allowed except for the use prior to the date of the writ. *Suffolk Co. v. Hayden*, 4 Fish. 86; s. c. 3 Wall. 315.

There is no reason for granting a new trial on account of damages given according to a rate admitted by the party himself to be a proper one in his own case. *Earle v. Sawyer*, 4 Mason, 1.

If the damages are excessive, the plaintiff may remit the excess. *Russell v. Place*, 5 Fish. 134; s. c. 9 Blatch. 173.

The damages can not exceed the amount claimed in the declaration. *Spaulding v. Tucker, Deady*, 649; *Wynans v. N. Y. & Harlem R. R. Co.* 4 Fish. 1.

Reissue.

If a patent has been surrendered, the damages should be limited to such as accrued by the use of the machine after the new patent was granted. *Aines v. Howard*, 1 Sum. 482; *Agawam Co. v. Jordan*, 7 Wall. 583.

If the patent is surrendered for defects in the specification, and a reissue granted, the defendant is liable for damages for any unlicensed use of the machine after the granting of the reissue, although his machine was put up before that time. A person purchasing property against the right of another, when the owner is without evidence of his title, can not hold or use it after the evidence of his superior right is acquired by the real owner. *Carr v. Rice*, 1 Fish. 198.

Nominal Damages.

The damages must not rest in conjecture, but must be susceptible of proof and be actually proved. *Whitney v. Emmett*, Bald. 303; *Philp v. Nock*, 17 Wall. 460; *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512; *Spaulding v. Tucker, Deady*, 649.

The burden of showing the extent of the damages rests upon the patentee. *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512.

If the patentee rests his case after merely proving an infringement of his patent, he may be entitled to nominal damages, but no more. He can not call on a jury to guess out his case without evidence. Actual damages must be calculated, not imagined; and an arithmetical calculation can not be made without certain data on which to make it. *Burdell v. Denig*, 2 Fish. 588; *New*

York *v.* Ransom, 1 Fish. 252; S. C. 23 How. 487; Hall *v.* Bird, 3 Fish. 595; S. C. 6 Blatch. 438; Campbell *v.* Barclay, 5 Biss. 179.

Where the law has given a right, and a remedy for the violation of it, such violation of itself imports damage; and in the absence of all other evidence, the law presumes a nominal damage to the party. Whittemore *v.* Cutter, 1 Gallis. 429, 478; Poppenhusen *v.* Gutta Percha Comb Co. 2 Fish. 62.

It is competent for the jury to give nominal damages, if they think that the patentee has acted in such a manner that the defendant has been misled: Adams *v.* Edwards, 1 Fish. 1; Washburn *v.* Gould, 3 Story, 122.

For the mere making of a machine, without selling or using it, the damages would be nominal. Carter *v.* Baker, 4 Fish. 404; S. C. 1 Saw. 512.

If the defendant has constructed but few machines after he knew of the existence of the patent, nominal damages merely may be recovered. Bryce *v.* Dorr, 3 McLean, 582.

Increase of Damages.

The jury should estimate the single damages, and the court, if it sees proper, will treble the damages found by the jury in awarding the proper judgment. Whittemore *v.* Cutter, 1 Gallis. 478; Evans *v.* Hettick, 3 Wash. C. C. 408; S. C. 7 Wheat. 453; Motte *v.* Bennett, 2 Fish. 642; Livingston *v.* Jones, 2 Fish. 207; S. C. 3 Wall. Jr. 330.

The trebling of the damages is a matter that rests in the discretion of the court. Stimpson *v.* Railroads, 1 Wall. Jr. 164.

The object of this provision is to remunerate patentees who are compelled to sustain their patents against wanton and persevering infringers. The spirit of the act does not include suits brought upon an expired patent which are merely cases of collection, the sole object being the recovery of damages. Bell *v.* McCullough, 1 Fish. 380; S. C. 1 Bond, 194; Brodie *v.* Ophir Mining Co. 4 Fish. 137.

If the infringement is deliberate and intentional, the court will increase the damages. It is not reasonable that an inventor should be compelled to spend his means in protecting himself without indemnity, and so practically lose the benefit of the invention which the law designed to secure him. Russell *v.* Place, 5 Fish. 134; S. C. 9 Blatch. 173; Peek *v.* Frame, 5 Fish. 113; S. C. 9 Blatch. 194.

The omission to file a disclaimer before the commencement of the suit affords ground for the consideration of the court in the exercise of its discretion on an application for an increase of the damages. The party infringing the patent may have been misled by the specification, and may have honestly supposed that it was void and afforded no protection to the patentee. The actual damages for the infringement would, therefore, seem as a general rule to be all that can be reasonably claimed. Guyon *v.* Serrell, 1 Blatch. 244.

Even where the disclaimer was not filed till after the commencement of the suit, there may be exceptions to the general rule. Cases may arise where the circumstances are aggravated, and such as to repel altogether the *bona fides* of the infringement in which the power to increase the verdict should be exercised. Each case must depend on its own circumstances. Guyon *v.* Serrell, 1 Blatch. 244.

The law will not in general give treble damages to an assignee. *Schwartzel v. Holenshade*, 3 Fish. 116; S. C. 2 Bond, 29.

The words "with costs" were probably added from abundant caution to exclude any inference of an intention to limit the amount of the judgment to the precise sum as increased, which would have excluded costs. When costs can not be recovered, because a disclaimer was not filed till after the commencement of the suit, the rights of the plaintiff and the power of the court in respect to damages remain the same as if costs were allowed, and the court may, if it sees proper, increase them. *Guyon v. Serrell*, 1 Blatch. 244.

Transfer by Judgment.

A recovery where no license fee has been established will not vest the infringer with the right to continue the use. *Suffolk Co. v. Hayden*, 4 Fish. 86; S. C. 3 Wall. 315.

If the patent fee is adopted as the measure of damages, the right to the further use of the invention passes to the defendant. *Sickels v. Borden*, 3 Blatch. 535.

If a patentee does not use the patented machine himself, nor establish a patent fee, but manufactures the patented articles and sells them at fixed prices, seeking his compensation in the profits of the manufacture and sale at such fixed prices, and another party infringes the patent by making and selling the patented article, and the patentee sues the party so infringing, and claims to recover, and does recover, the full amount of profits which he himself would have obtained on the article, had he manufactured and sold it at the ordinary price, by such claim and recovery he adopts the sale made by the party infringing, and the right to use the specific article so sold, and for which the recovery has been had, vests in the purchaser. *Spaulding v. Page*, 4 Fish. 641; S. C. 1 Saw. 702; 4 A. L. T. (N. S.) 166; *Perrigo v. Spaulding*, 13 Blatch. 389.

The price of the invented machine is not the proper measure of damages, because the verdict would not entitle the defendant to use the machine subsequently. The statute gives to the inventor the exclusive right of making and using his invention, and the court can not compel the defendant to purchase, or the patentee to sell this right. *Earle v. Sawyer*, 4 Mason, 1; *Whittemore v. Cutter*, 1 Gallis. 478.

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

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

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

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

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

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

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

Statute Revised—July 8, 1870, ch. 230, § 61, 16 Stat. 208.

Prior Statutes—April 10, 1790, ch. 7, § 6, 1 Stat. 111.—February 21, 1793, ch. 11, § 6, 1 Stat. 322.—July 4, 1836, ch. 357, § 15, 5 Stat. 123.

Declaration.

The infringement of a patent is a *tort*, but as the wrongful act is not committed with direct force, and the injury is the indirect effect of the wrongful act, the form of action is that description of *tort* called trespass on the case. *Stein v. Goddard*, 1 McA. 82.

There is no solid foundation on which to rest the right of a patentee to support an action on the case for the violation of his exclusive right, except that settled and reasonable common-law basis of all such actions: injury and damage—injury by a violation of the incorporeal right, and damage, at least nominal, presumed by the law to arise from such violation. *Byam v. Bullard*, 1 Curt. 100.

A declaration ought always to show a title in the plaintiff, and that with convenient certainty. It ought to state all matters that are of the essence of

the action, without which the plaintiff fails to show a right in point of law to ask for the judgment of the court in his favor. If his title depends upon the performance of certain acts, he must aver the performance of those acts. *Gray v. James*, Pet. C. C. 476.

The declaration must aver that the patent was issued and delivered to the patentee. An allegation that the patent was made out is not sufficient. *Cutting v. Myers*, 4 Wash. 220.

As the patentee's title rests upon a patent from the United States, the form of which is prescribed by the act of Congress, the declaration must show that the patent is such as the law requires. *Cutting v. Myers*, 4 Wash. 220.

It is not necessary that the patentee in his pleading shall specify all the acts done by him to obtain a patent in order that it may appear upon the face of the declaration that the mode of proceeding pointed out by the statute has been pursued. It is sufficient to set forth the grant in substance. The court will presume in favor of the grant that everything was rightly and solemnly done which the law requires, in order to authorize the issuing of the patent. *Wilder v. McCormick*, 2 Blatch. 31; *Cutting v. Myers*, 4 Wash. 220.

It is sufficient to state the substance of the grant, but if the specification professes to set forth the grant according to its tenor, the slightest variance is fatal. *Tryon v. White*, Pet. C. C. 96.

A general averment of an extension in due form of law, before the expiration of the term for which the original patent was granted, is sufficient. *Phelps v. Comstock*, 4 McLean, 353.

It would be more formal to annex a copy of the letters patent and specification to the declaration and to refer thereto in the declaration, but the common practice is to simply make profert of the letters patent, and there seems to be no substantial objection to it. *Pitts v. Whitman*, 2 Story, 609.

The profert of the letters patent makes the letters patent, when produced, a part of the declaration, and so gives all the certainty as to the invention and improvement patented, which is required by law. *Pitts v. Whitman*, 2 Story, 609.

The words "as by the said letters patent and specification, all in due form of law ready in court to be produced, will fully appear," is equivalent to profert in the most formal and ample terms. They tender the entire grant to the inspection of the court and party. *Wilder v. McCormick*, 2 Blatch. 31.

The declaration need not aver at what time the invention patented was made. The patent law nowhere requires the patentee to allege or prove the specific time of his invention. *Wilder v. McCormick*, 2 Blatch. 31.

If the declaration does not set out the nature of the invention, it is demurrable. *Peterson v. Wooden*, 3 McLean, 248.

A breach which is as broad as the right set forth in the declaration and granted by the patent, is not only sufficient, but that is the most correct manner of pleading. *Cutting v. Myers*, 4 Wash. 220.

The declaration must tender an issue upon the novelty and utility of the discovery patented, these being essential to the enforcement of any exclusive privilege under the patent, but the question of the regularity of the proceedings in petitioning for and obtaining the patent and that of the correctness of

the judgment of the commissioner in awarding it are not material and can not be inquired into. *Wilder v. McCormick*, 2 Blatch. 31.

If the declaration embodies 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 to interpose every defense allowed him by the law, the court will not encourage objections merely critical, and will seek to sustain pleadings substantially sufficient, and will thus avoid useless delays and expense. *Wilder v. McCormick*, 2 Blatch. 31.

The plaintiff is confined to giving evidence of infringements during the period which he specifies in his declaration. If it were otherwise, the recovery in the suit would be no bar to another action for any anterior breach, since it could not judicially appear that any damages had been recovered for any such anterior breach, and the form of the declaration itself specifying the term, would repel any presumption to the contrary. *Eastman v. Bodfish*, 1 Story, 528.

If the case stated in the declaration is precisely within the statute, an averment that the act complained of is against the form of the statute is mere matter of form, the want of which will be cured by a verdict, hence the omission of it is not a ground for a nonsuit. *Tryon v. White*, Pet. C. C. 96.

Where the original patent and a patent for an improvement on it, are united in the same person, they constitute an entire right, and must be asserted as such in an action for an infringement. The wrong complained of is for a violation of the entire right united in the plaintiff by the different patents and assignments. The right set up is an entirety, and being united in the same individual, is not susceptible of a division. As well might different actions be brought for trespass upon a close, on the ground that the land was held under distinct titles. *Case v. Redfield*, 4 McLean, 526.

Distinct causes of action may be set forth in the same count. A reiteration of infringements of a patent may be sued for and recompensed in one action. There is no known doctrine of the law that requires a plaintiff to split up into separate actions grievances of that character. *Wilder v. McCormick*, 2 Blatch. 31.

If a patent is extended by a special act of Congress, and the plaintiff wishes to recover for infringements under both the original and extended patent, he must file distinct and independent counts for each patent. *Eastman v. Bodfish*, 1 Story, 528.

Where a matter is so essentially necessary to be proved to establish the plaintiff's right to recovery that the jury could not be presumed to have found a verdict for him unless it had been proved at the trial, the omission to state that matter in express terms in the declaration, is cured by the verdict. The mere omission to aver that the assignment under which the plaintiff claims was recorded, will not be deemed fatal on a motion in arrest of judgment, for it is a case of a good title defectively stated. *Dobson v. Campbell*, 1 Sum. 319.

If enough is stated in the declaration to show title in the plaintiff, and with sufficient certainty to enable the court to give judgment, but with less certainty than the case admitted of, and which, for the purpose of notice to the adverse party or otherwise, ought to have been stated, the defect is cured by

the verdict. The court will presume that all such omissions were supplied and obscurities explained at the trial by the evidence given to the jury. *Gray v. James*, Pet. C. C. 476.

If the declaration contains all the necessary allegations to show that the patent was regularly granted, and designates the patent by the terms used in the patent itself, it will be sufficient on a demurrer or motion in arrest of judgment. *Gray v. James*, Pet. C. C. 476; *Cutting v. Myers*, 4 Wash. 220.

Although a breach is too general in not stating the number of machines used by the defendant, yet it is cured by a verdict, since it is fairly to be presumed that proof of that fact was given to the jury. *Gray v. James*, Pet. C. C. 476.

Plea.

This section appears to be drawn on the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue. It therefore intends to relieve the defendant from the difficulties of pleading when it allows him to give in evidence matter which does not affect the patent. But the notice is directed for the security of the plaintiff, and to protect him against that surprise to which he might be exposed from an unfair use of this privilege. The notice is a substitute to which the defendant is not obliged to resort. The notice is to be given only when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the only notice which the plaintiff can claim. *Evans v. Eaton*, 3 Wheat. 454; S. C. Pet. C. C. 323; *Grant v. Raymond*, 6 Pet. 218; *Read v. Miller*, 3 Fish. 310; *Phillips v. Comstock*, 4 McLean, 525; *Day v. New Eng. Car Co.* 3 Blatch. 179; *contra*, *Wilder v. Gayler*, 1 Blatch. 597.

If the notice and the plea contain the same defense, the defendant must elect on which he will rely and abandon the other, or the court will on motion strike out the plea. *Latta v. Shawk*, 1 Fish. 465; S. C. 1 Bond, 259; *Wilder v. Gayler*, 1 Blatch. 597; *Read v. Miller*, 3 Fish. 310; S. C. 2 Biss. 12.

If the defendant pleads instead of giving notice, and the plea is not put in thirty days before the term, the plaintiff is entitled to a continuance. *Phillips v. Comstock*, 4 McLean, 525; *Latta v. Shawk*, 1 Fish. 465; S. C. 1 Bond, 259.

A plea which claims a right in the defendant to continue in the use of the patented discovery, from the fact of a title to such use derived by him through the patentee, or seeks to avoid the title of the plaintiff acquired by direct assignment from the patentee, by alleging matters outside of that assignment which prevent its passing any title to him, either because of the incapacity of the grantee in that respect to make such grant, or because of an outstanding paramount right in others, does not amount to the general issue and may be pleaded. The implied admission of the right of the patentee through whom the plaintiff makes title is sufficient in law to afford color for the avoidance. *Day v. New Eng. Car Co.* 3 Blatch. 179.

Recoupment is a matter which is never pleaded in bar. *Birdsall v. Perego*, 5 Blatch. 251.

If a plea in avoidance contains no denial of matters alleged in the dec-

laration, they must be considered as admitted, unless the matters alleged in the plea are a sufficient answer to the action. *Moore v. Marsh*, 7 Wall. 515.

A plea in avoidance which is hypothetical and does not admit the cause of action is bad. *Morse v. Davis*, 5 Blatch. 40.

A plea in bar must contain a full defense against the right of the plaintiff, and if it fall short of this, it is bad on demurrer. If the truth of the plea may be admitted, and the action is still maintainable, the plea is essentially defective. *Smith v. Ely*, 5 McLean, 76; s. c. 15 How. 137.

Oyer of letters patent is not demandable as of a deed, but being a matter of record, it is accessible to the defendant, and should be stated in the plea, as it is not necessarily a part of the declaration, so as to enable the court to act upon the face of the plea. *Smith v. Ely*, 5 McLean, 76; s. c. 15 How. 137.

A plea of an abandonment should state the facts on which the pleader relies as showing an abandonment. *Root v. Ball*, 4 McLean, 177.

A plea that the defendant was acting as the agent of another is bad if it does not disclose the name of the principal. *Morse v. Davis*, 5 Blatch. 40.

If no fraud appears on the face of the patent, the defendant is not at liberty to set up that the patent has been fraudulently obtained. *Railroad Co. v. Du-bois*, 12 Wall. 47.

The plea of not guilty puts in issue the novelty of the invention as well as the charge of infringement. *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond, 84; *vide* *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453; *Gray v. James*, Pet. C. C. 394.

A State statute can not limit the time within which actions for infringements for patents may be brought in the federal courts. *Anthony v. Carroll*, 9 O. G. 199; s. c. 23 Pitts. L. J. 23; *Collins v. Peebles*, 2 Fish. 541; *Parker v. Hallock*, 2 Fish. 543; *Read v. Miller*, 3 Fish. 310; s. c. 2 Biss. 12; *Wood v. Cleveland Rolling Mill*, 4 Fish. 550; *contra*, *Parker v. Hawk*, 2 Fish. 58; *Howes v. Nute*, 4 Fish. 263; *Rich v. Ricketts*, 7 Blatch. 230.

The inferior courts may prescribe rules to regulate the time and manner of filing pleas. *Packet Co. v. Sickles*, 19 Wall. 611.

The right to plead the statute of limitations does not depend on the pleasure or discretion of the court. *Packet Co. v. Sickles*, 19 Wall. 611.

Notice.

It is very clear that this section does not enumerate all the defenses of which the defendant may legally avail himself, for he may clearly give, in evidence, that he never did the act attributed to him, or that he has a license or authority from the patentee. *Whittemore v. Cutter*, 1 Gallis. 429.

There are defenses of which a party may avail himself under the general issue, without giving notice to the patentee, because no such notice is required by the statute, as, for instance, that there is no specification, or that the specification is altogether ambiguous and unintelligible, or that the patent is broader than the discovery, or that it is for an improvement which the specification does not so particularly describe as to distinguish it from the original

invention, and perhaps others similar in principle. *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9; *Grant v. Raymond*, 6 Pet. 218.

Most of the matters required by this section to be set forth in a notice could be given in evidence under the general issue, without notice, were it not for the section; or, to speak more accurately, are involved in the general issue. They are affirmative facts which the plaintiff would be bound to maintain as essential to the validity of his patent. *Wilder v. Gayler*, 1 Blatch. 597.

The object of this most salutary provision is to prevent patentees being surprised at the trial of the cause by evidence of a nature which they could not be presumed to know, or be prepared to meet and thereby to subject them either to most expensive delays, or to a loss of their cause. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448; *Teese v. Huntingdon*, 23 How. 2; *Wilder v. Gayler*, 1 Blatch. 597.

All that the act requires is that notice of the special matter to be offered in evidence at the trial shall be in writing, and be given to the plaintiff or his attorney more than thirty days before the trial. By the plain terms of the law it is a right conferred upon the defendant, and of course he may exercise it in the manner and upon the conditions therein pointed out, without any leave or order from the court. When the notice is properly drawn, and duly and seasonably served and filed in court as a part of the pleadings, nothing further is required to give the defendant the full and unrestricted benefit of the provision. *Teese v. Huntingdon*, 23 How. 2.

The act does not attempt to prescribe the particulars which such a notice shall contain. It simply requires notice. But the least effect which can be allowed to this requirement is that the notice should be so full and particular as to answer the end in view. This end was not merely to put the patentee on inquiry, but to relieve him from the necessity of making useless inquiries and researches, and enable him to fix, with precision, upon what is relied on by the defendant, and to prepare himself to meet it at the trial. This highly salutary object should be kept in view, and a corresponding disclosure exacted from the defendant of all those particulars which he must be presumed to know, and which he may safely be required to state without exposing him to any risk of losing his rights. Less than this would not be reasonable notice, and therefore would not be such a notice as the act must be presumed to have intended. *Silsby v. Foote*, 14 How. 218; S. C. 1 Blatch. 445.

If the defendant discovers that the first notice is defective, or not sufficiently comprehensive to admit his defense, he may give another to remedy the defect or supply the deficiency, subject to the same condition, that it must be in writing and be served more than thirty days before the trial. *Teese v. Huntingdon*, 23 How. 2.

Where the first day of the term is the day of trial, the notice must be served on the plaintiff's counsel thirty days before the first day of the term. *Westlake v. Cartter*, 6 Fish. 518; S. C. 4 O. G. 636.

A plea which has been stricken out by the court on motion of the plaintiff is not a sufficient legal notice. *Foote v. Silsby*, 1 Blatch. 445; S. C. 14 How. 218.

If the defendant has given the notice required by the act, he may proceed to prove the facts therein set forth by any legal and competent testimony.

For that purpose he may call and examine witnesses upon the stand, or he may introduce any deposition which has been legally taken in the cause. Under those circumstances depositions taken before the notice was served, as well as those taken afterward, are generally admissible. *Teese v. Huntingdon*, 23 How. 2.

No evidence under the general issue can be given upon any of the points of which the statute requires that notice shall be given to the patentee, unless such notice has been duly given. *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9; *vide Gray v. James*, Pet. C. C. 394.

If the notice states that the evidence is to be used for one purpose, it can not be used for another. *Pennock v. Dialogue*, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

No notice is necessary in order to justify the admission of evidence for the purpose of showing the state of the art at the date of the patentee's invention. *Vance v. Campbell*, 1 Fish. 483; S. C. 1 Black, 427; *Brown v. Piper*, 91 U. S. 37; S. C. 1 Holmes, 20; 10 O. G. 417; *Westlake v. Carter*, 6 Fish. 519; S. C. 4 O. G. 636.

No notice is necessary to authorize the inquiry whether the machine used by the defendant is like the model exhibited in court. *Evans v. Hettick*, 7 Wheat. 453; S. C. 3 Wash. C. C. 408.

It is incumbent on the defendant to show his right to introduce the evidence. *Silsby v. Foote*, 14 How. 218; S. C. 1 Blatch. 445; *Blanchard v. Putnam*, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84.

Demurrer.

Variances between the declaration and the writ can not be taken advantage of on general demurrer. *Wilder v. McCormick*, 2 Blatch. 31.

Defects of form can not suspend the action of the court unless they are made the ground of a special demurrer. *Teese v. Phelps*, 1 McA. 17.

Concealment.

If the specification embraces too much, the patentee is not bound to prove affirmatively that this occurred by accident or mistake, and not from an intention to deceive or defraud the public. The law presumes no one to have acted illegally or fraudulently. *Hotchkiss v. Oliver*, 5 Denio, 314.

The thing for which the patent is granted should be truly and fully described in the specification, but if this is done, so as clearly to distinguish it from all other things before known, and so as to enable any person skilled in the art of which it is a branch, or with which it is most nearly connected, to make and use the same, it is sufficient. The matters not disclosed must appear to have been concealed for the purpose of deceiving the public to invalidate the patent. *Park v. Little*, 3 Wash. C. C. 196; *Gray v. James*, Pet. C. C. 394; *Burden v. Corning*, 2 Fish. 477; *Whittemore v. Cutter*, 1 Gallis. 429.

What degree of evidence ought to be required to prove such fraudulent intention must rest with the jury to decide. Positive evidence can seldom be

expected, nor is it necessary. The law, it is true, requires that such intention should fully appear, but still it may be presumed from circumstances entirely to the satisfaction of the jury. *Gray v. James*, Pet. C. C. 394; *Dyson v. Danforth*, 4 Fish. 133.

If the specification and drawings are materially defective, they afford a presumption of a designed concealment. *Whittemore v. Cutter*, 1 Gallis. 429.

If the parts concealed are so essential and so obviously necessary to be disclosed that no mechanic skilled in the art could reasonably be expected to understand the subject so as, from the description given, to make the machine, it would be difficult to impute the omission of the patentee to a fair motive. *Gray v. James*, Pet. C. C. 394; *Reutgen v. Kanowrs*, 1 Wash. C. C. 168.

Surreptitious Obtaining of Patent.

An allegation that the original patentee fraudulently and surreptitiously obtained the patent for that which he well knew was invented by another, is not sufficient to defeat the patent, unless it is accompanied by the further allegation that the alleged first inventor was at the time using reasonable diligence in adapting and perfecting the invention. *Agawam Co. v. Jordan*, 7 Wall. 583; *Reed v. Cutter*, 1 Story, 590; *Singer v. Walmsley*, 1 Fish. 558.

If the defendant was the first inventor of the thing patented, and was using reasonable diligence to adapt and perfect the same, and did perfect it, and the patent to the patentee was issued while the *caveat* of the defendant was on file in the patent office, without any notice being given to the defendant by the commissioner, then the patent was unjustly obtained. *Phelps v. Brown*, 1 Fish. 479; S. C. 4 Blatch. 362.

Description.

This provision requires: 1st. a description of the alleged invention; 2d. that it shall be contained in a work of a public character; 3d. that this work was made accessible to the public by publication before the discovery of the invention by the patentee. *Reeves v. Keystone Bridge Co.* 5 Fish. 456; S. C. 1 O. G. 466; 9 Phila. 368; 5 A. L. T. 150.

If the alleged prior description laid before a mechanic skilled in building machines would not enable him, without invention, to build a machine substantially like the patentee's, it will not amount to that kind of public notice or knowledge which can interfere with a subsequent patent. *Carr v. Rice*, 1 Fish. 198; *Reeves v. Keystone Bridge Co.* 5 Fish. 456; S. C. 1 O. G. 466; 9 Phila. 368; 5 A. L. T. 150; *Roberts v. Dickey*, 4 Fish. 532; S. C. 4 Brews. 260; 1 O. G. 4; *Buerk v. Valentine*, 5 Fish. 366; S. C. 9 Blatch. 479; 2 O. G. 295; *McMillin v. Barclay*, 5 Fish. 189; S. C. 4 Brews. 275; *Baldwin v. Schultz*, 5 Fish. 75; S. C. 9 Blatch. 494; 2 O. G. 315; *Tilghman v. Morse*, 5 Fish. 323; S. C. 9 Blatch. 421; 10 O. G. 574; *Renwick v. Cooper*, 6 Fish. 31; S. C. 10 Blatch. 201; *Pitts v. Wemple*, 2 Fish. 10; S. C. 1 Biss. 87; *Parker v. Stiles*, 5 McLean, 44; *Washburn v. Gould*, 3 Story, 122; *Stimpson v. Woodman*, 3 Fish. 98; S. C. 10 Wall. 117.

If the prior publication describes the article that will defeat a patent for a manufacture, although it does not teach a manufacturer how to make it.

Cohn v. U. S. Corset Co. 93 U. S. 366; s. c. 12 Blatch. 225; 6 O. G. 259; 11 O. G. 457; *Ex parte John McClosky*, 9 C. L. N. 313.

It must be directly proved that the work was published before the date of the patentee's invention. This is not deducible from the imprint of the title page. That the work was then printed may be inferred from the imprint, but when it was put in circulation and offered to the public is a distinct fact which must be proved independently. The intended circulation of a book of a public nature may be presumed from its being put into print, but it does not follow that the work was made accessible to the public as soon as it was printed. *Reeves v. Keystone Bridge Co.* 5 Fish. 456; s. c. 1 O. G. 466; 9 Phila. 368; 5 A. L. T. 150.

A written description of a machine, although illustrated by drawings, which has not been given to the public, does not constitute an invention within the meaning of the patent law. It may be so full and precise as to enable any one skilled in the art to which it appertains to construct the machine described, but until it has been embodied in a form capable of useful operation, it has not attained the proportion or character of a complete invention. However suggestive and valuable it may be as an untried theory, it is ineffective against the practical and useful product of inventive skill. *Northwestern Co. v. Philadelphia Co.* 6 O. G. 34; s. c. 31 Leg. Int. 148; *Lyman V. & R. Co. v. Lalor*, 12 Blatch. 303; s. c. 6 O. G. 642.

A mere reference to a volume of thirteen hundred pages is not sufficient notice. The defendant should indicate in his notice what particular things described in the printed publication he intends to aver are substantially the same as the thing patented. This he may do either by reference to pages or titles, and perhaps in other ways, for the particular manner in which the things referred to are referred to, must depend much upon the contents of the volume and their arrangement. *Silby v. Foote*, 14 How. 218; s. c. 1 Blatch. 445.

A book of which no notice has been given, can not be used as evidence to prove a prior invention. *Pennock v. Dialogue*, 4 Wash. C. C. 538; s. c. 2 Pet. 1; *Lippincott v. Kelly*, 1 West. L. J. 513.

A volume produced in pursuance of a notice to establish a prior description of the machine, is not evidence of the fact that the machine was partially successful, although it so states. *Seymour v. McCormick*, 19 How. 96; s. c. 3 Blatch. 209.

A prior description of a part can not invalidate a patent for the whole. *Westinghouse v. G. & R. Brake Co.* 9 O. G. 538.

The description of the invention in books must be before the discovery, and not before the application. *Adams v. Edwards*, 1 Fish. 1.

If the books do not describe the invention in all its material combinations, they are no bar to the validity of the invention. *Adams v. Edwards*, 1 Fish. 1.

It is no objection to a patent that the improvement is embraced in a claim in a prior patent which is void because it is a claim for a principle. *O'Reilly v. Morse*, 15 How. 62; s. c. 6 West. L. J. 102.

A rejected specification, with drawings, can not be treated as a publication, because it lacks the essential quality of a publication in that it is not designed

for general circulation, nor is it made accessible to the public generally. It is placed in the custody of the commissioner, not that it may thereby become known to the public, but for the special purpose of being examined and passed upon by him. Although it may incidentally become known to any one whose researches in the patent office may disclose its existence, it is not therefore published within the meaning of the statute. *Northwestern Co. v. Philadelphia Co.* 6 O. G. 34; s. c. 31 Leg. Int. 148.

The deposit of a written description of an invention in the patent office, is not a publication of it within the meaning of the statute, for the description is not designed for general circulation, nor is it made accessible to the public generally. *Lyman V. & R. Co. v. Lalor*, 12 Blatch. 303; s. c. 6 O. G. 642.

A reissue of one patent subsequent in date to another patent, can not affect the novelty or validity of the latter if there is nothing in the specifications or drawing of the original patent which affects it. *Hitchcock v. Tremaine*, 5 Fish. 537; s. c. 9 Blatch. 550; 1 O. G. 633.

When a patentee describes an alternate mode of effecting an object, it is a good ground for refusing a subsequent patent for either of them to another person. *Ex parte John McClosky*, 9 C. L. N. 313.

A mere drawing unaccompanied by any description whatever, is not admissible under a notice of a description in a printed publication. *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond, 327.

An illustration by a drawing is not such a description as the statute contemplates. *Reeves v. Keystone Bridge Co.* 5 Fish. 456; s. c. 1 O. G. 466; 9 Phila. 368; 5 A. L. T. 150.

Novelty.

The patentee's suit is founded on his patent, and unless he is himself the original inventor he can not recover. *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453.

The defendant can not be allowed to surprise the patentee by evidence of a prior invention of which no notice was given to him. *O'Reilly v. Morse*, 15 How. 62; s. c. 6 West. L. J. 102; *Parker v. Haworth*, 4 McLean, 370; *Westlake v. Cartter*, 6 Fish. 519; s. c. 4 O. G. 636; *Root v. Ball*, 4 McLean, 177; *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond, 84.

Evidence in regard to the state of the art, is proper to be considered by the court in construing the patent and determining what invention is claimed, but has no legitimate bearing upon the question whether the patentee was the first inventor, unless notice has been duly given that it will be used for that purpose. *Railroad Co. v. DuBois*, 12 Wall. 47.

When the novelty of the invention is not open to inquiry by the pleadings, the defendant can not put in evidence a patent granted to another, for such evidence is immaterial. The only question is, whether the defendant's machine infringes the patentee's invention. *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond, 84.

Prior Use.

A change in the specification as filed in the first instance, or the subsequent filing of a new one whereby a patent is still sought for the substance of the invention as originally claimed, or a part of it, can not in anywise affect the sufficiency of the original application or the legal consequences flowing from it. To produce that result, the new or amended specification must be intended to serve as the basis of a patent for a distinct and different invention, and one not contemplated by the specification as submitted at the outset. *Sewall v. Jones*, 6 Fish. 343; S. C. 3 O. G. 630; *Godfrey v. Eames*, 1 Wall. 317; *Blandy v. Griffith*, 3 Fish. 609; *Rich v. Lippincott*, 2 Fish. 1; *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; S. C. 2 Cliff. 555; *Singer v. Braunsdorf*, 7 Blatch. 521; *Smith v. O'Connor*, 6 Fish. 469; S. C. 2 Saw. 461; *Smith v. G. D. V. Co.* 93 U. S. 486; S. C. 1 Holmes, 354; 11 O. G. 246; 5 O. G. 585; *Bell v. Daniels*, 1 Fish. 372; S. C. 1 Bond, 212; *Singer v. Walmsley*, 1 Fish. 558.

If a party chooses to withdraw his application for a patent and pay the forfeit, intending at the time of such withdrawal to file a new petition, and he accordingly does so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application within the meaning of the law. *Godfrey v. Eames*, 1 Wall. 317; *Howe v. Newton*, 2 Fish. 531.

The filing of a second application may be considered as in the nature of a petition for a review of the previous rulings, and relates back to the prior application. *Blandy v. Griffith*, 3 Fish. 609.

The filing of a second application after the rejection of the first, will be deemed to be a mere continuance of the prior application. *Smith v. G. D. V. Co.* 93 U. S. 486; S. C. 1 Holmes, 354; 5 O. G. 585; 11 O. G. 246; 4 A. L. T. (N. S.) 74; *Goodyear D. V. Co. v. Willis*, 7 O. G. 41; *Henry v. Stove Co.* 9 O. G. 408; *Weston v. White*, 13 Blatch. 447.

Whether a new application is a continuance of a prior one, is a question of fact. *Bevin v. East Hampton Bell Co.* 5 Fish. 23; S. C. 9 Blatch. 50; *Godfrey v. Eames*, 1 Wall. 317; *Weston v. White*, 13 Blatch. 447; *Rich v. Lippincott*, 2 Fish. 1.

If a party withdraws his application upon its rejection by the patent office, without any intent to file a new petition, and acquiesces in the decision, this is an abandonment so that there will be no continuity between it and a subsequent application. *United States Rifle Co. v. Whitney Arms Co.* 11 O. G. 373.

If the second application is not for the same invention as the first, and the invention has been in public use for more than two years prior to the time of making the second, the patent will be void. *Rich v. Lippincott*, 2 Fish. 1.

If the inventor amends his application so as to exclude a certain device, and immediately applies for a patent for that device, the patent will only relate back to the last application. *Pelton v. Waters*, 7 O. G. 425; S. C. 21 I. R. R. 125.

The statute does not prescribe the time within which a patent shall be applied for after the invention is perfected. Where it has not been abandoned to the public, and has not been in public use or on sale with the consent and

allowance of the inventor, no lapse of time, however protracted, bars an application for a patent, or affects its validity after it has been granted. *Wood v. Cleveland Rolling Mill*, 4 Fish. 550; *Allen v. Blunt*, 2 W. & M. 121; *Russell Manuf. Co. v. Mallory*, 5 Fish. 632; S. C. 10 Blatch. 140; 2 O. G. 495.

The provision allowing two years' use to the inventor, applies to previous cases as well as to subsequent cases. *Adams v. Edwards*, 1 Fish. 1.

If the inventor, after his invention is perfected, knowingly allows it to be used in public for more than two years before he applies for letters patent, it is conclusive evidence of a dedication of such invention to the public, and the patent is void. *Ransom v. New York*, 1 Fish. 252; *Pitts v. Hall*, 2 Blatch. 229; *Rich v. Lippincott*, 2 Fish. 1; *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch. 149; S. C. 6 O. G. 327; 9 C. L. N. 313; *Seymour v. McCormick*, 2 Blatch. 240; S. C. 16 How. 480; *Sanders v. Logan*, 2 Fish. 167; *Dunlap v. Minetree*, 1 O. G. 463; *Tappan v. Nat. Bank Note Co.* 2 Fish. 195; S. C. 4 Blatch. 509; *Cleveland v. Towle*, 3 Fish. 525; *American Leather Co. v. American Tool Co.* 4 Fish. 284; *Sisson v. Gilbert*, 5 Fish. 199; S. C. 9 Blatch. 185.

The use of the invention by individuals, even with the permission of the patentee, will not invalidate the patent, unless it continues for more than two years prior to the filing of the application for a patent therefor in the patent office. *Teese v. Phelps*, 1 McA. 48; *Sewall v. Jones*, 6 Fish. 343; S. C. 3 O. G. 630; *Smith v. Ely*, 5 McLean, 76; S. C. 15 How. 137; *Andrews v. Carman*, 13 Blatch. 307; S. C. 9 O. G. 101; *Bell v. Daniels*, 1 Fish. 372; S. C. 1 Bond, 212; *Wyeth v. Stone*, 1 Story, 273; *Root v. Ball*, 4 McLean, 177; *Seymour v. McCormick*, 2 Blatch. 240; S. C. 16 How. 480; *Goodyear v. Matthews*, 1 Paine, 300; *Heinrich v. Luther*, 6 McLean, 345; *Sickels v. Mitchell*, 3 Blatch. 548; *Agawam Co. v. Jordan*, 7 Wall. 583.

The right to the future use is lost by a public use for more than two years prior to the application, however great the hindrances to such application, and whether caused by the want of pecuniary means or other misfortune. *Sisson v. Gilbert*, 5 Fish. 109; S. C. 9 Blatch. 185.

By public use is meant a use in public; that is to say, if the inventor himself makes and sells the thing to be used by others, or if it is made by one other person only, with his knowledge and without objection, before his application for a patent, *a fortiori*, if he suffers it to get into general use, it will have been in public use. *Rich v. Lippincott*, 2 Fish. 1.

There is an obvious distinction between a public use or a use by the public and an experimental use in public. Many inventions can only be tested in that way. *Locomotive Truck Co. v. Railroad Co.* 6 O. G. 924; S. C. 31 Leg. Int. 324; 1 W. N. 16.

If the use prior to the period of two years before the application for the patent was by way of trial, and resulted in a change in the construction of the machine, it will not work a forfeiture of the right of the patentee. *Pitts v. Hall*, 2 Blatch. 229; *Sewall v. Jones*, 6 Fish. 343; S. C. 3 O. G. 630; *Winans v. Schen. & Troy R. R. Co.* 2 Blatch. 279; *Page v. Bowers*, 1 O. G. 521; *Winans v. N. Y. & Harlem R. R. Co.* 4 Fish. 1; *Birdsell v. McDonald*, 6 O. G. 682; *American Leather Co. v. American Tool Co.* 4 Fish. 284; *Henry v. Stove Co.* 9 O. G. 408; *Andrews v. Carman*, 13 Blatch. 307; S. C. 9 O. G.

1011; *U. S. Rifle Co. v. Whitney Arms Co.* 11 O. G. 373; *Locomotive Truck Co. v. Railroad Co.* 6 O. G. 924; s. c. 31 Leg. Int. 324; 1 W. N. 16.

Consent and allowance may be inferred from acquiescence. *Sisson v. Gilbert*, 5 Fish. 107; s. c. 9 Blatch. 185.

If the patentee uses the thing patented himself, for more than two years prior to the time of applying for a patent, the patent will be void. *McMillin v. Barclay*, 5 Fish. 189; s. c. 4 Brews. 275.

If the prior use relied on is a use by the inventor or by persons with his consent and allowance, it is not necessary to notify him of the names of the persons using the invention, or of the place where used. *American Leather Co. v. American Tool Co.* 4 Fish. 284.

A single instance of sale, purchase or use under the circumstances specified in the section, will render the patent void. *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch. 149; s. c. 6 O. G. 327; 9 C. L. N. 313.

Forfeiture by prior use is not favored in law, but is regarded as being somewhat harsh in its operation on individual rights. *Pitts v. Hall*, 2 Blatch. 229; *Henry v. Stove Co.* 9 O. G. 408; *Page v. Bowers*, 1 O. G. 521.

An inventor may stipulate for a sale of his invention before it is completed without vitiating his claim. *Sparkman v. Higgins*, 1 Blatch. 205.

Use and sale with the consent of the inventor, means use and sale of the perfected invention, and not of the invention in an imperfect, inchoate and experimental condition. But the distinction between the invention and the machine which embodies it must be observed. The invention may be perfect, and the machine which embodies that invention may be an imperfect machine. *American Leather Co. v. American Tool Co.* 4 Fish. 284.

The question is whether the machine, at the time of the sale, was perfect in the sense that it embodied a completed invention, and not whether it was perfect in mechanical execution. A perfect machine, in the sense of the word perfect, means a perfected invention, not a perfectly constructed machine, but a machine so constructed as to embody all the essential elements of the invention in a form that would make them practical and operative so as to accomplish the result. But it is not necessary that it should accomplish the result in the most perfect manner, and be in a condition where it was not susceptible of a higher degree of perfection in its mere mechanical construction. *American Leather Co. v. American Tool Co.* 4 Fish. 284; *Sisson v. Gilbert*, 5 Fish. 109; s. c. 9 Blatch. 185.

An agreement for the transfer of the invention for the joint benefit of the inventor and those who will advance money for the manufacture of the machines invented, not carried into execution and unaccompanied by any public use of the machine, but being prospective in its character, not consummated until within two years before the application for the patent, does not affect its validity. *Elm City Co. v. Wooster*, 6 Fish. 452; s. c. 4 O. G. 23.

If a design is worked upon the face of a button, it may perhaps be said to be sold with the button. In this view a sale of the button would be a sale of the design, and not simply of the product of the invention. *Booth v. Garely*, 1 Blatch. 247.

The burden of proof to show a public use for more than two years before the application for the patent, is on the defendant. *Hovey v. Henry*, 3 West. L. J. 153; *Brown v. Guild*, 23 Wall. 181; s. c. 6 O. G. 392; 7 O. G. 739.

Abandonment.

Abandonment means a general abandonment to the public. It is a dedication to the public, a giving up of the claim to a monopoly in the invention. *American Leather Co. v. American Tool Co.* 4 Fish. 284.

Abandonment must result from the intention of the patentee expressly declared or indicated by his acts. *McMillin v. Barclay*, 5 Fish. 189; *s. c.* 4 Brews. 275.

At common law, the right of property of an inventor to his invention or discovery passed from him as soon as it went into public use with his consent. It was then regarded as having been dedicated to the public as common property, and subject to the common use and enjoyment of all. *Wilson v. Rousseau*, 4 How. 646; *s. c.* 1 Blatch. 3; *American Leather Co. v. American Tool Co.* 4 Fish. 284; *Dudley v. Mayhew*, 3 N. Y. 9.

It is competent for a patentee at any time by overt acts or by express dedication, to abandon or surrender to the public for their use, all the rights secured by his patent, if such is his pleasure clearly and deliberately expressed. So if for a series of years the patentee acquiesces without objection in the known public use by others, of his invention, or stands by and encourages such use, such conduct will afford a very strong presumption of such an actual abandonment or surrender. *A fortiori*, the doctrine will apply to a case where the patentee has openly encouraged or silently acquiesced in such use by the very parties whom he afterwards seeks to prohibit by injunction from any further use, for in this way he may not only mislead them into expenses or acts or contracts against which they might otherwise have guarded themselves, but his conduct operates as a surprise, if not as a fraud upon them. *Wyeth v. Stone*, 1 Story, 273; *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch. 149; *s. c.* 6 O. G. 327; 9 C. L. N. 313; *Gray v. James*, Pet. C. C. 394.

It makes no difference in the principle that the article so publicly used and afterwards patented, was made by a particular individual who did so by the private permission of the inventor. *M'Clurg v. Kingsland*, 1 How. 202; *Pennock v. Dialogue*, 2 Pet. 1; *s. c.* 4 Wash. C. C. 598.

If the inventor, after his invention is perfected, acquiesces in its use in public for a less term than two years, without applying for a patent, and by such acquiescence abandons his invention, concluding not to patent it, but to dedicate it to the public use, he can not recall such dedication or defeat such abandonment by a subsequent application for a patent, and the patent is therefore void. *Ransom v. New York*, 1 Fish. 252; *Teese v. Phelps*, 1 McA. 48; *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch. 149; *s. c.* 6 O. G. 327; 9 C. L. N. 313; *Bell v. Daniel*, 1 Fish. 372; *s. c.* 1 Bond, 212; *M'Clurg v. Kingsland*, 1 How. 202; *American Leather Co. v. American Tool Co.* 4 Fish. 284; *Earl v. Page*, 6 N. H. 477; *Pennock v. Dialogue*, 2 Pet. 1; *s. c.* 4 Wash. C. C. 538.

The acquiescence of an inventor in the public use of his invention can in no case be presumed where he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. *Shaw v. Cooper*, 7 Pet. 292.

Those who rely upon the ground that a party has by abandonment for-

feited a legal right secured to him in due form of law for the purpose of defeating his enjoyment of that right, must make out the point clearly and satisfactorily beyond any reasonable doubt or hesitation, because the law does not favor an abandonment, and throws upon the party who seeks to obtain the benefit of a forfeiture the burden of proving it beyond all reasonable question. *Seymour v. McCormick*, 2 Blatch. 240; S. C. 16 How. 480; *Pitts v. Hall*, 2 Blatch. 229; *Wyeth v. Stone*, 1 Story, 273; *American Leather Co. v. American Tool Co.* 4 Fish. 284; *McMillin v. Barclay*, 5 Fish. 189; S. C. 4 Brews. 275; *Sewall v. Jones*, 6 Fish. 343; S. C. 3 O. G. 630; *Birdsell v. McDonald*, 6 O. G. 682; *Hovey v. Henry*, 3 West. L. J. 153.

An inventor may abandon his invention and surrender or dedicate it to the public. The inchoate right thus once gone, can not afterwards be resumed at his pleasure; for where gifts are once made to the public in this way, they become absolute. The question which generally arises at trials is a question of fact, rather than of law, whether the acts or acquiescence of the party furnish in the given case satisfactory proof of an abandonment or dedication of the invention to the public. *Pennock v. Dialogue*, 2 Pet. 1; S. C. 4 Wash. C. C. 538; *Sanders v. Logan*, 2 Fish. 167; *Marsh v. Sayles*, 7 A. L. Rev. 355; S. C. 4 C. L. N. 461; *Wayne v. Holmes*, 2 Fish. 20; S. C. 1 Bond, 27; *Mellus v. Silsbee*, 4 Mason, 108; *Whittemore v. Cutter*, 1 Gallis. 478; *Kendall v. Winsor*, 21 How. 322; *Morris v. Huntington*, 1 Paine, 348; *Shaw v. Cooper*, 7 Pet. 292; *Booth v. Garely*, 1 Blatch. 247; *Consolidated Fruit Jar Co. v. Wright*, 12 Blatch. 149; S. C. 6 O. G. 327; 9 C. L. N. 313.

Lapse of time does not *per se* constitute abandonment. It may be a circumstance to be considered. The circumstances of the case other than mere lapse of time almost always give complexion to the delay, and either excuse it or give it conclusive effect. The statute has made contemporaneous public use with the consent and allowance of the inventor a bar when it exceeds two years. But in the absence of that and any other colorable circumstances, there is no mere period of delay which ought *per se* to deprive an inventor of his patent. *Andrews v. Carman*, 13 Blatch. 307; S. C. 9 O. G. 1011; *Russell Manuf. Co. v. Mallory*, 5 Fish. 632; S. C. 10 Blatch. 140; 2 O. G. 495; *Freund v. King*, 11 O. G. 2; *Page v. Bowers*, 1 O. G. 521; *Birdsell v. McDonald*, 6 O. G. 682.

No man is to be permitted to lie by for years and then take out a patent. If he has been practicing his invention with a view of improving it, and thereby rendering it a greater benefit to the public before taking out a patent, that ought not to prejudice him. But it should always be a question submitted to the jury what was the intention of the delay, and whether the allowing the invention to be used without a patent should not be considered an abandonment or present of it to the public. *Morris v. Huntington*, 1 Paine, 348; *Shaw v. Cooper*, 7 Pet. 292; *Treadwell v. Bladen*, 4 Wash. C. C. 703; *Goodyear v. Matthews*, 1 Paine, 300.

The mere fact of making or selling an improvement or invention, or of putting it into public use at any time within two years before the application for a patent, is not of itself an abandonment of the invention to the public. Something more must be done within the two years. There must be some acts of the inventor indicating an intention on his part to devote his improve-

ment to the public in general, in order to authorize the conclusion that he has so abandoned it. There must be a design to devote the invention to the public at large as a gratuity, and without receiving a consideration for its bestowal. *Seymour v. McCormick*, 2 Blatch. 240; S. C. 16 How. 480; *Pitts v. Hall*, 2 Blatch. 229.

If the inventor did not intend to take a patent, and manifested that intent by his declarations or conduct, and thereupon it was copied, and so went into use, he can not afterwards take a valid patent. *Kendall v. Winsor*, 21 How. 322.

A declaration of an intention to abandon the invention to the public does not bind the inventor, for he is entitled to the *locus pœnitentiæ*. There must be something more than mere words to fasten on him the intention which, in judgment of law, will work an abandonment of his invention. There must be acts. The mere declaration of an intention to dedicate the invention to the public can not be regarded as equivalent to an actual dedication. *Pitts v. Hall*, 2 Blatch. 229; *Page v. Bowers*, 1 O. G. 521.

It is the acquiescence in the known user by the public, without objection or qualification, and not the extent of the actual user, which constitutes the ground for inferring abandonment or surrender of the patent. If the patentee means to surrender his exclusive right in a qualified manner, or for a qualified trade, he should at the very time give public notice of the nature and extent of his allowance of the public use, so that all persons may be put upon their guard, and not expose themselves to losses or perils which they have no means of knowing or averting during his general silence or acquiescence. *Wyeth v. Stone*, 1 Story, 273.

If the invention was publicly used for a long period by the inventor himself, not in the way of experiment, but for gain, the patent is void. *Bell v. Daniels*, 1 Fish. 372; S. C. 1 Bond, 212.

The jury has a right to infer an abandonment from the patentee's acquiescence in the use of the invention by others, his neglect to assert his claims by suit or otherwise, his omission to sell licenses to use such invention, his neglect to make efforts to realize any personal advantage from his patent, and similar circumstances. *Ransom v. New York*, 1 Fish. 252.

If the knowledge of the invention is surreptitiously obtained and communicated to the public, it will not affect the right of the inventor. Under such circumstances no presumption can arise in favor of an abandonment of the right of the inventor to the public, though an acquiescence on his part will lay the foundation for such a presumption. *Kendall v. Winsor*, 21 How. 322; *Shaw v. Cooper*, 7 Pet. 292; *Page v. Bowers*, 1 O. G. 521.

If the invention, through fraudulent means, is made known to the public, the inventor should assert his right immediately, and take the necessary steps to legalize it. No matter by what means an invention may be communicated to the public, any acquiescence in the public use by the inventor will be an abandonment of his right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time would give validity to it, but the public stand in an entirely different relation to the inventor. *Shaw v. Cooper*, 7 Pet. 292.

The use of an invention by the special permission of the patentee, under a

license limited to one or two persons, is not a use of it by the public, and does not constitute an abandonment. *McCay v. Burr*, 6 Penn. 147.

A patent for a combination which does not specify that the patentee has invented any of the parts, is a dedication of such parts to the public. *Batten v. Taggart*, 2 Wall. Jr. 101; S. C. 17 How. 74.

If the inventor makes a mistake as to one of the improvements claimed, but is clearly entitled to a patent as to the other, he can not be justly said to have abandoned either during a litigation as to his right to both. *Adams v. Jones*, 1 Fish. 527.

The putting of a device intended to perfect the working of a patented machine upon such machine when sold, will not necessarily imply that the patentee intended to abandon it to the public, or put it in public use, or on sale. That is a question of fact purely. Whether the inventor put it on merely for the purpose of experiment, or put it on and sold it with the rest of the machine for gain and profit, and let it go into public use, is a question of fact. *American Leather Co. v. American Tool Co.* 4 Fish. 284.

Where the jury are satisfied that the patentee has not abandoned his invention and privileges granted by the letters patent, his neglect to prosecute parties infringing such patent, will not bar his right to recover such damages as he has actually sustained by the defendant's infringement. *Ransom v. New York*, 1 Fish. 252.

The inventor will not be deemed to have abandoned his invention by licensing a few persons to use his invention to ascertain its utility, or by any such acts of peculiar indulgence and use as may fairly consist with the clear intention to hold the exclusive privilege. *Mellus v. Silsbee*, 4 Mason, 108; *American Leather Co. v. American Tool Co.* 4 Fish. 284.

Mere delay in applying for a patent will not vitiate it if it is not unreasonable. *Webster v. Carpet Co.* 5 O. G. 522.

Mere forbearance to apply for a patent during the progress of experiments, and until the party has perfected his invention and tested its value by actual practice, affords no just grounds for any presumption of an abandonment. *Agawam Co. v. Jordan*, 7 Wall. 583; *Sewall v. Jones*, 6 Fish. 343; S. C. 3 O. G. 630; *Locomotive Truck Co. v. R. R. Co.* 6 O. G. 927; S. C. 31 Leg. Int. 324; 1 W. N. 16.

A sale or use of the invention, with the knowledge or consent of the patentee in the intermediate time between the application for a patent and a grant thereof, furnishes no foundation to presume that the inventor means to abandon his invention to the public. *Ryan v. Goodwin*, 3 Sumn. 514; *Howe v. Newton*, 2 Fish. 531.

By the application filed in the patent office the inventor makes a full disclosure of his invention, and gives public notice of his claim for a patent. It is conclusive evidence that the inventor does not intend to abandon it to the public. The delay afterwards interposed, either by the mistakes of the public officers or the delays of courts, where gross laches can not be imputed to the applicant, can not affect his rights. The statute forfeits the right of an inventor to a patent only where the invention has been in public use more than two years before the application. A man might justly be treated as having abandoned his application if it be not prosecuted with reasonable diligence.

But involuntary delays not caused by the laches of the applicant, will not work a forfeiture of his right. *Henry v. Stove Co.* 9 O. G. 408; *Adams v. Jones*, 1 Fish. 527; *Howard v. Christy*, 10 O. G. 981; *Johnson v. Fassman*, 5 Fish. 471; S. C. 1 Woods, 138; 2 O. G. 84; *Sewall v. Jones*, 6 Fish. 343; S. C. 3 O. G. 630; *Blandy v. Griffith*, 3 Fish. 609; *Clark v. Scott*, 15 Fish. 245; S. C. 9 Blatch. 301; 1 O. G. 4; *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; S. C. 2 Cliff. 555; *Goodyear D. & V. Co. v. Willis*, 7 O. G. 41; *Goodyear v. Hills*, 3 Fish. 134.

The pendency of an application for a patent for an invention repels any inference of abandonment or dedication from the omission to again claim it, though described in a patent granted upon a subsequent application for a patent for another invention. *Suffolk Co. v. Hayden*, 3 Wall. 315; *Singer v. Braunsdorf*, 7 Blatch. 521.

The pendency of an application for a patent for an invention repels any inference of an abandonment or dedication from the omission to claim it in another application where it is described. *Suffolk Co. v. Hayden*, 4 Fish. 86; S. C. 3 Wall. 315.

The proof of an abandonment of an application depends upon two circumstances: whether the inventor meant to give it up, or whether, being needy, he gave up, during a short time, for want of funds. A man of genius, who has made a discovery, should not be deprived of it in consequence of a want of means to prosecute his labors to their final consummation, if he intended to persevere. Even if the application was withdrawn, his claim will be valid if he kept it up in his own mind, and meant to keep it up before the patent office, and did not abandon it, but merely suspended operations till he could get the means. *Adams v. Edwards*, 1 Fish. 1.

A party can not be held accountable for delays in the patent office, and an abandonment will not be inferred therefrom. The law looks with indulgence upon the delays which arise from the circumstances of the party who may make an invention, and it is only when the invention is intentionally abandoned or neglected, or the party shows by his acts that he has not done all that he could have done, that the law declares that he shall not be protected in his invention. *Sayles v. Railroad Company*, 2 Fish. 523; S. C. 1 Biss. 468; *Ryan v. Goodwin*, 3 Sumn. 514; *Root v. Ball*, 4 McLean, 177; *Rich v. Lippincott*, 2 Fish. 1; *McMillin v. Barclay*, 5 Fish. 189; S. C. 4 Brews. 275.

If a party, upon the rejection of his application, withdraws all the papers except a drawing, and then permits his invention to go into notorious public use for a long time, the application will be deemed to be abandoned. *Bevin v. East Hampton Bell Co.* 5 Fish. 23; S. C. 9 Blatch. 50.

If an inventor does not prosecute his application with reasonable diligence, but withdraws the papers from the patent office and abandons the invention to the public, a subsequent patent therefor will be void. *Bevin v. East Hampton Bell Co.* 5 Fish. 23; S. C. 9 Blatch. 50.

If the application is rejected, the applicant is obliged, within a reasonable time, to take some action on the subject, either by an appeal from the commissioner, or by a bill in equity in the proper court. If he does not, there is a presumption of an abandonment which can not be rebutted by a mere denial of

an intention to abandon. *Marsh v. Commissioner*, 5 Fish. 610; S. C. 3 Biss. 321; 2 O. G. 340.

If the patentee, subsequent to the date of his letters patent, abandons his invention to the public, and waives and abandons the exclusive privileges intended to be secured by such patent, he can not recover. *Ransom v. New York*, 1 Fish. 252; *Bell v. Daniels*, 1 Fish. 372; S. C. 1 Bond, 212.

After the issue of letters patent, the abandonment must be shown to be positive, actual and intentional by some act or declaration of the inventor, or by such gross laches as indicates unmistakably an intention to abandon the invention to the public. *Johnson v. Fassman*, 5 Fish. 471; S. C. 1 Woods, 138; 2 O. G. 94; *Bell v. Daniels*, 1 Fish. 372; S. C. 1 Bond, 212.

A party may obtain a patent for an invention and let it lie in the patent office without use, and no one else would have the right to use such invention because it is his property. *Pitts v. Wemple*, 2 Fish. 10; S. C. 1 Biss. 87.

A patentee who is prevented by poverty from making machines or selling rights under his patent, will not be deemed to have abandoned it. *Hoffheins v. Brandt*, 3 Fish. 213; *Gray v. James*, Pet. C. C. 394.

If the patent is valid, the inventor is not bound by law to construct his invention in order to preserve his patent. *Wheeler v. Clipper Co.* 6 Fish. 1; S. C. 10 Blatch. 181; 2 O. G. 442.

The burden of proof to show an abandonment is on the defendant. *Hoffheins v. Brandt*, 3 Fish. 218.

Notice of Previous Knowledge.

The party giving notice is not bound to be so specific as to relieve the other from all inquiry or effort to investigate the facts. If he fairly puts his adversary in the way that he may ascertain all that is necessary to his defense, it is all that can be required, and he is not bound by his notice to impose an unnecessary and embarrassing restriction upon his own right of producing proof of what he asserts. When in addition to the town or city in which a large machine is used, the name and residence of the witness by whom that use is to be proved, is also given, there is sufficient precision and certainty in the notice. *Wise v. Allis*, 9 Wall. 737; *Smith v. Frazer*, 5 Fish. 543; S. C. 2 O. G. 175.

The statute requires nothing more than the names and residences of the persons who possessed the prior knowledge of the thing patented, and the name of the place at which it has been used. It does not require that the names and residences of the witnesses shall be given. *Wilton v. Railroads*, 1 Wall. Jr. 192.

The statute requires that the notice should set forth the name of the person who had knowledge of the use and the place where it was used. A witness whose name is not so given, can not testify in regard to such prior use. *Judson v. Cope*, 1 Fish. 615; S. C. 1 Bond, 327.

A witness can not testify unless the notice also states "where the same was used." *Silsby v. Foote*, 14 How. 218; S. C. 1 Blatch. 445.

Notice of the time when the person possessed the knowledge or use of the invention, is not required by the statute. The name of the person and of his

place of residence, and the place where it has been used, are sufficient. It, therefore, the notice mentions the time, the defendant is not limited to the time mentioned, but may give evidence of its use at other times. *Phillips v. Page*, 24 How. 164; *Evans v. Kremer*, Pet. C. C. 215.

If the notice merely alleges a use within the United States, evidence can not be given of a use in England. *Dixon v. Moyer*, 4 Wash. C. C. 68.

A notice which refers merely to the county in which the alleged prior invention was used, is defective. This reference is not sufficiently definite and explicit as to the place to file the requirements of the spirit of the act. *Hays v. Sulsor*, 1 Fish. 532; S. C. 1 Bond, 279.

Burden of Proof.

Upon the plea of not guilty, it is incumbent on the plaintiff to prove not merely that the defendant had made, used or sold a machine, but that it substantially resembles the one for which the plaintiff has obtained his patent. *Dixon v. Moyer*, 4 Wash. C. C. 68.

The plaintiff charges an infringement, which is a wrongful act in the nature of a trespass, and inasmuch as no one is presumed to do wrong, the rule is, that he who alleges that another has committed a wrongful act, must prove it. *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; *Bell v. Daniels*, 1 Fish. 372; S. C. 1 Bond, 212; *Forbes v. Barstow Stove Co.* 2 Cliff. 379; *Brooks v. Jenkins*, 3 McLean, 432; *Hudson v. Draper*, 4 Fish. 256; *Parker v. Stiles*, 5 McLean, 44; *Francis v. Mellor*, 5 A. L. T. 237; S. C. 5 Fish. 153; 1 O. G. 48; 8 Phila. 157; *Johnson v. Root*, 1 Fish. 351; *Cahoon v. Ring*, 1 Fish. 397; S. C. 1 Cliff. 592; *Many v. Sizer*, 1 Fish. 17; *Latta v. Shawk*, 1 Fish. 465; S. C. 1 Bond, 259; *Matthews v. Skates*, 1 Fish. 602; *Washburn v. Gould*, 3 Story, 122; *Judson v. Cope*, 1 Fish. 615; S. C. 1 Bond, 327; *Swift v. Whisen*, 3 Fish. 343; S. C. 2 Bond, 115.

Doubts as to whether there has been an infringement or not, must inure in favor of the defendant, as he is not to be deprived of a right which is common to every citizen, unless it shall clearly appear that his machine is substantially like the one claimed by the patentee. *Brooks v. Jenkins*, 3 McLean, 432.

The expressions in the specifications are those of the patentee, and the burden of proof rests on him to explain and to clear them of ambiguity. *Kneass v. Schuylkill Bank*, 4 Wash. C. C. 9.

The burden of proof is on the defendant, to show that the patentee was not the first inventor. *Brooks v. Jenkins*, 4 McLean, 432; *Ashcroft v. Cutter*, 6 Blatch. 511; *Cahoon v. Ring*, 1 Fish. 397; S. C. 1 Cliff. 592; *Parham v. Sewing Machine Co.* 4 Fish. 468; *Earle v. Sawyer*, 4 Mason, 1; *Winans v. N. Y. & Harlem R. R. Co.* 4 Fish. 1; *Latta v. Shawk*, 1 Fish. 465; S. C. 1 Bond, 259; *Brodie v. Ophir Mining Co.* 4 Fish. 137; *Waterman v. Thomson*, 2 Fish. 461; *Goodyear Dental Co. v. Gardner*, 4 Fish. 224; *Whitney v. Emmett*, Bald. 303; *Masury v. Tiemann*, 4 Fish. 524; S. C. 8 Blatch. 426; *Pitt v. Hall*, 2 Blatch. 229; *Dixon v. Moyer*, 4 Wash. C. C. 68; *Tompkins v. Gage*, 2 Fish. 577; S. C. 5 Blatch. 268; *Agawam Co. v. Jordan*, 7 Wall. 583; *Forbes v. Barstow Stove Co.* 2 Cliff. 379.

It is not enough that he raise a doubt in their minds on that point, he must satisfy them of the fact. *Magic Ruffle Co. v. Douglass*, 2 Fish. 330;

Sewall v. Jones, 6 Fish. 343; s. c. 3 O. G. 630; *Tompkins v. Gage*, 2 Fish. 577; s. c. 5 Blatch. 268; *Crouch v. Speer*, 6 O. G. 187; *Jordan v. Dobson*, 4 Fish. 232; s. c. 2 Abb. N. S. 398; 7 Phila. 533; *Mowry v. Whitney*, 3 Fish. 157; s. c. 4 Fish. 141; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45; *Hawes v. Antidel*, 8 O. G. 685; *Taylor v. Wood*, 12 Blatch. 110; 8 O. G. 90.

The proof must be clear that the prior invention is the same in principle as that of the patentee. Doubts on this point must inure in favor of the patent. *Brooks v. Jenkins*, 3 McLean, 432; *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; *Washburn v. Gould*, 3 Story, 122; *Parham v. Sewing Machine Co.* 4 Fish. 468; *Roberts v. Dickey*, 4 Fish. 532; s. c. 4 Brews. 260; 1 O. G. 4; *McMillin v. Barclay*, 5 Fish. 189; s. c. 4 Brews. 275; *Clark v. Scott*, 5 Fish. 245; s. c. 9 Blatch. 301; 1 O. G. 4.

Where the patent has been acquiesced in for a long time, the proof of a prior invention must be established by a clear preponderance of evidence. *Gear v. Grosvenor*, 6 Fish. 314; s. c. 1 Holmes, 215; 3 O. G. 380; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond, 84.

The burden of proof is on the defendant, to prove that the specification is so defective as not to enable a skillful mechanic to construct the machine claimed. *Brooks v. Jenkins*, 3 McLean, 432.

Presumption from Patent.

No patent is issued without an examination at the patent office by persons skilled in the subject, into the specification and the subject and extent of the claims. The commissioner is intrusted by law with the power and duty of granting patents for new and useful inventions. He is authorized to grant a patent only for a new and useful invention or improvement, and it is to be presumed that he has performed his duty. Under these circumstances, the patent when issued affords *prima facie* evidence of the novelty and utility of the invention patented, which *prima facie* evidence is sufficient to establish such novelty and utility, unless it is rebutted by countervailing testimony. *Potter v. Holland*, 1 Fish. 382; s. c. 4 Blatch. 206; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond, 84; *Hussey v. Bradley*, 2 Fish. 362; s. c. 5 Blatch. 134; *Ransom v. New York*, 1 Fish. 252; *Magic Ruffle Co. v. Douglass*, 2 Fish. 330; *Matthews v. Skates*, 1 Fish. 602; *Teese v. Phelps*, 1 McA. 48; *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600; *Lowell v. Lewis* 1 Mason, 182; *Cox v. Griggs*, 2 Fish. 174; s. c. 1 Biss. 362; *Adams v. Edwards*, 1 Fish. 1; *Wintermute v. Redington*, 1 Fish. 239; *Clark Patent Co. v. Copeland*, 2 Fish. 221; *Bell v. Daniels*, 1 Fish. 372; s. c. 1 Bond, 212; *White v. Allen*, 2 Fish. 440; s. c. 2 Cliff. 224; *Rich v. Lippincott*, 2 Fish. 1; *Poppenhusen v. Gutta Percha Comb Co.* 2 Fish. 62; *Parker v. Hulme*, 1 Fish. 44; *Waterman v. Thomson*, 2 Fish. 461; *Corning v. Burden*, 15 How. 252; *Allen v. Hunter*, 6 McLean, 303; *Alden v. Dewey*, 1 Story, 336; *Brooks v. Jenkins*, 3 McLean, 432; *Heinrich v. Luther*, 6 McLean, 345; *Johnson v. Root*, 1 Fish. 351; *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond, 27; *Crompton v. Belknap Mills*, 3 Fish. 536; *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592; *Woodworth v. Rogers*, 3 W. & M. 135; *Haselden v. Ogden*, 3 Fish. 378; *Pitts v. Edmonds*, 2 Fish. 52; s. c. 1 Biss. 168; *Blanchard v. Putnam*, 3 Fish.

186; s. c. 8 Wall. 420; 2 Bond, 84; Hudson *v.* Draper, 4 Fish. 253; Many *v.* Sizer, 1 Fish. 17; Seymour *v.* Osborne, 3 Fish. 555; s. c. 11 Wall. 516; Waterbury Brass Co. *v.* N. Y. Brass Co. 3 Fish. 43; Mitchell *v.* Tilghman, 19 Wall. 287; s. c. 4 Fish. 599; 5 O. G. 299.

The patent when produced in evidence, whether it be an original or a re-issued one, is *prima facie* evidence that the thing granted required invention, and that the patentee was the inventor or discoverer thereof. Serrell *v.* Collins, 1 Fish. 289; Conover *v.* Rapp, 4 Fish. 57; Forbes *v.* Barstow Stone Co. 2 Cliff. 379; Suffolk Co. *v.* Hayden, 4 Fish. 86; s. c. 3 Wall. 315; Roberts *v.* Harnden, 2 Cliff. 500; Goodyear Dental Co. *v.* Gardner, 4 Fish. 224; Dental Vulcanite Co. *v.* Whetherbee, 3 Fish. 87; s. c. 2 Cliff. 555; Cook *v.* Howard, 4 Fish. 269; Knight *v.* Railroad Co. 3 Fish. 1; s. c. Taney, 106; Sherman *v.* Champlain Co. 31 Vt. 162; Ayling *v.* Hull, 2 Cliff. 494; Mitchell *v.* Tilghman, 4 Fish. 599; s. c. 19 Wall. 287; 5 O. G. 299; Hoffheins *v.* Brandt, 3 Fish. 218; Potter *v.* Holland, 1 Fish. 382; s. c. 4 Blatch. 206; Winans *v.* N. Y. & Harlem R. R. Co. 4 Fish. 1; Spaulding *v.* Tucker, Deady, 649; Whipple *v.* Baldwin, Manuf. Co. 4 Fish. 29.

The patent is not conclusive evidence that the invention is novel or useful. Wright *v.* Wilson, 11 Rich. 144; Bierce *v.* Stocking, 77 Mass. 17.

The presumption of utility and novelty arising from the grant of a patent is strengthened by its extension. Mowry *v.* Whitney, 3 Fish. 157; s. c. 4 Fish. 141; 5 Fish. 496; 14 Wall. 620; 2 Bond. 45; Swift *v.* Whisen, 3 Fish. 343; s. c. 2 Bond, 115; Cook *v.* Ernest, 5 Fish. 396; s. c. 1 Woods, 195; 2 O. G. 89.

The presumption of utility arising from the grant of the patent, can only be repelled by clear proof that it is utterly worthless. Tilghman *v.* Werk, 2 Fish. 229; s. c. 1 Bond, 511.

A patent to parties as joint inventors, is *prima facie* evidence that the invention was joint. Hotchkiss *v.* Greenwood, 4 McLean, 456; s. c. 11 How. 248.

A patent relates back where the question of novelty is in issue to the date of the invention, and not to the time of the application for issue. Klein *v.* Russell, 19 Wall. 433; Dixon *v.* Moyer, 4 Wash. C. C. 68; *contra* Union Sugar Refinery *v.* Matthiessen, 2 Fish. 600; Wing *v.* Richardson, 2 Fish. 535; s. c. 2 Cliff. 449; White *v.* Allen, 2 Fish. 440; s. c. 2 Cliff. 224; Johnson *v.* Root, 2 Fish. 291; s. c. 2 Cliff. 108; Sewall *v.* Jones, 6 Fish. 343; s. c. 3 O. G. 630.

The patent is *prima facie* evidence that, in the specification there is contained a description in such full clear and exact terms as will enable any one skilled in the art to which it appertains to put it in practice. Poppenhusen *v.* Gutta Percha Comb. Co. 2 Fish. 62.

If the defendant has a patent for his invention, he may give it in evidence, for he is entitled to the benefit of the presumption in his favor arising from an investigation of the originality of his invention, and the judgment of the public officers, that his machine is new and not an infringement of the patent previously granted. If the plaintiff's patent in a doubtful case may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his; *valeat quantum valeat*. The parties should

contend on an equal field and be allowed to use the same weapons. *Corning v. Burden*, 15 How. 252; *American Pin Co. v. Oakvill Co.* 3 Blatch. 130; *Brown v. Selby*, 4 Fish. 363; S. C. 2 Biss. 457; *Stearns v. Barrett*, 1 Mason, 153; *Goodyear Dental Co. v. Gardner*, 4 Fish. 224.

The granting of a subsequent patent is *prima facie* evidence that the use of the devices thus patented does not infringe a prior patent. *Corning v. Burden*, 15 How. 252; *Smith v. Woodruff*, 6 Fish. 476; S. C. 1 McA. 459; 4 O. G. 635; *Burden v. Corning*, 2 Fish. 477; *Westlake v. Carter*, 6 Fish. 519; S. C. 4 O. G. 636; *Many v. Sizer*, 1 Fish. 17; *Trader v. Messmore*, 7 O. G. 385; *N. Y. Rubber Co. v. Chaskel*, 9 O. G. 923.

A patent subsequent in date can not have the effect as evidence, to overcome the *prima facie* presumption otherwise afforded by the introduction of one of prior date, that the patentee was the original and first inventor of what is therein described as his improvement. *Goodyear Dental Co. v. Gardner*, 4 Fish. 224.

Evidence.

The oath recited in the patent is evidence, and the jury are entitled to judge of its force. *Alden v. Dewey*, 1 Story, 336; *Woodworth v. Rogers*, 3 W. & M. 135.

Parol evidence is not admissible to show the time when the application for a patent was made. *Wayne v. Winter*, 6 McLean, 344.

The letters of the patentee to the commissioner, containing applications for a patent, are admissible. *Pettibone v. Derringer*, 4 Wash. C. C. 215.

If the signature of a letter acknowledging the receipt of an application for a patent is proved, the letter is competent as an official act and document of a public officer in relation to such a subject, and a part of the transaction. Being made at the time and in relation to the subject, it is a competent declaration as a part of the *res gestæ*, and explanatory of what took place. *Allen v. Blunt*, 2 W. & M. 121; *Pike v. Potter*, 3 Fish. 55.

A certified copy of a patent cancelled on account of a defective specification, is competent evidence to prove a prior invention. *Delano v. Scott*, Gilp. 489.

If there are any inaccuracies in a certified copy of a patent, they may be shown by other certified copies. A former and defective transcript will not affect a full and corrected copy. *Brooks v. Jenkins*, 3 McLean, 432.

The plaintiff can not give in evidence an exemplification of a patent differing in date, and in the name or style of the improvement patented from the patent set forth in his replication, to a plea alleging the invalidity of the patent. *Bellas v. Hays*, 5 S. & R. 427.

Neither the report of the examiner nor the decision of the commissioner, upon the question of the extension of a patent, is competent evidence to establish the invalidity of the original patent in an action for the recovery of the amount stipulated to be paid for an assignment thereof, although the extension is refused on the ground of the invalidity of the original patent. *McMahon v. Tyng*, 96 Mass. 167.

If the minutes of a corporation of which the patentee was a member, are read to prove the want of novelty, the patentee can not read other portions of the minute book to prove that the corporation acknowledged him to be the inventor, unless they are necessary to explain the parts which have been read. If part of a statement be read by one side, the other side may insist upon having the whole read, but a subsequent declaration or statement by the corporation does not come within this exception. *Pennock v. Dialogue*, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

The minute book of a corporation can not be used as evidence to prove a prior invention, because it is a private and not a public work. *Pennock v. Dialogue*, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

The minute book of a corporation of which the patentee was a member, and to which he furnished minutes, may be used as evidence to prove a prior invention. *Pennock v. Dialogue*, 4 Wash. C. C. 538; S. C. 2 Pet. 1.

A receipt which gives a right to use certain machines, may be used to reduce the amount of the recovery and not as a complete bar, and for this purpose is admissible under the general issue. *Burdell v. Denig*, 92 U. S. 716.

The patentee can not prove that one part of a combination claimed in the patent, is immaterial and useless. *Vance v. Campbell*, 1 Fish. 483; S. C. 1 Black, 427.

The affirmative statement of a witness as to what he saw and heard, is entitled to more credit than the negative statement of another witness that he did not see or hear the same thing. *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600.

A mistake as to date is a frequent occurrence even with honest witnesses, and where it satisfactorily appears that it was but an unintentional error, the fact that such a mistake was made is not entitled to much weight as affecting the credit of the witness. *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600.

No comparison can be instituted between the defendant's machine and an alleged prior invention. Prior inventions can only be compared with the patented invention upon the issue of novelty. The defendant's machine can only be compared with the patentee's upon the issue of infringement. *Judson v. Cope*, 1 Fish. 615; S. C. 1 Bond, 327.

If Congress passes an act for the relief of a patentee by extending his patent, relying upon his representations, equity and good conscience demand that he shall be held to them. *Union Manuf. Co. v. Lounsbury*, 2 Fish. 389.

Evidence that a compromise made by another was not founded on any admission of the patentee's right in the invention is irrelevant and inadmissible. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448.

In case of either a latent or a patent ambiguity, collateral facts and the circumstances in which the parties were placed when the agreement was made may be given in evidence; in the first case, to ascertain something extrinsic or matter out of the instrument where there is no ambiguity from the language of it, and in the other when from defective terms the intention of the parties can not be collected from them. *Troy Factory v. Corning*, 14 How. 193; S. C. 1 Blatch. 467.

If the novelty of the invention is impeached, the patentee may give evidence to prove that the working of his machine is different and decidedly

superior in its results to the alleged prior invention. *Judson v. Cope*, 1 Fish. 615; s. c. 1 Bond, 327.

The declaration of third parties as to the name and reputation of the machine used by the defendant, are inadmissible. The persons from whom the witness received information on this subject, ought to be called on to give it on oath, and in the regular way. *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453.

The fact that a person is subject to fits of derangement, is no objection either to his competency or credibility, if he is sane at the time of giving his testimony. *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453.

The patentee can not be asked whether he has ascertained that a statement made by him that the patent had been tested in court, is untrue, in an action instituted by him to recover the amount due under a contract upon the sale thereof where the defense is that the representation was false and fraudulent, for the question implies that the information has been obtained since the making of the representation. *McMahon v. Tyng*, 96 Mass. 167.

Evidence that the persons, of whose prior use of the invention the defendant has given testimony, have paid the plaintiff for licenses to use it since his patent, is entitled to but very little weight, but ought not to be absolutely rejected. Connected with other testimony, and under some circumstances even the opinion of a party may be worth something. *Evans v. Eaton*, 3 Wheat. 454; s. c. Pet. C. C. 322; *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453.

The defendant, upon an examination in chief, may ask his witness if his machine is like the model of the patentee's machine. *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453.

In an action for fraud in the sale of a patent right, a remark of the vendor in the course of a conversation about the sale, that the best way to sell patent rights is to take notes and indorse them, so that no question can be made about the patent, is relevant. *Peck v. Bacon*, 18 Conn. 377.

If a party does not have a machine of any kind, a witness can not be asked whether such party offered to take a license from the patentee. It is an act among strangers which ought not to prejudice the defendant. *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453.

In an action at law upon a sealed instrument, failure of consideration or fraud in the consideration, is not admissible for the purpose of avoiding the obligation. *Hartshorn v. Day*, 3 Fish. 32; s. c. 19 How. 211.

The patentee is not barred by any admission as to the validity of his patent. *Adams v. Edwards*, 1 Fish. 1.

An inquiry into what the patentee invented is proper, because it may aid in giving a construction to his patent, but his legal right is that which is secured to him by his patent, and if he has invented anything else meritorious or otherwise, still, if it is not embraced in the patent, then he can maintain no suit upon it. He is necessarily confined to that which is granted to him by the deed from the government, which is called a patent. *Johnson v. Root*, 1 Fish. 351.

A contract made by the defendant with the plaintiff for the right to use the

machine, is admissible as evidence of the utility of the invention. *Lee v. Blandy*, 2 Fish. 89; S. C. 1 Bond, 361.

Whenever a witness is called to impeach the credit of another, he must know what is generally said of the witness whose credit is impeached by those among whom the last-named witness resides, in order that he may be able to answer the inquiry either as to his general character in the broader sense, or as to his general reputation for truth and veracity. He is not required to speak from his own knowledge of the acts and transactions from which the character and reputation of the witness has been derived, nor, indeed, is he allowed to do so, but he must speak from his own knowledge of what is generally said of him by those among whom he resides and with whom he is chiefly conversant, and any question that does not call for such knowledge, is an improper one, and ought to be rejected. *Teese v. Huntingdon*, 23 How. 2.

An inquiry into the principles and mode of operation of the machine of a third person, merely to test the knowledge and correctness of a witness, is irrelevant, for a witness can not be examined as to a mere collateral fact, having no relevancy to the issue, in order to draw from him an answer which may, by other evidence, be shown incorrect, and thereby discredit him. Such an inquiry, moreover, would embarrass the jury by drawing their attention to the principles of a machine not in controversy. *Odiorne v. Winkley*, 2 Gallis. 51.

Testimony in regard to the reputation of a witness may properly be excluded by the court when it applies to a period of time so remote from the transaction involved in the controversy as thereby to become entirely unsatisfactory and immaterial, and as the law can not fix that period of limitation, it must necessarily be left to the discretion of the court. *Teese v. Huntingdon*, 23 How. 2.

The plaintiff, in the cross-examination of a witness produced to repel the rebutting evidence, can not ask him whether one of the defendant's witnesses is not subject to fits of mental derangement, for the testimony might have been obtained on the primary examination of the witnesses. *Evans v. Hettick*, 3 Wash. C. C. 408; S. C. 7 Wheat. 453.

Every circumstance which can affect the veracity of a witness, whether it concerns his moral character or arises from some interest which he may have in the question, or from feelings and wishes favorable to one or the other of the parties, should be taken into consideration. *Evans v. Hettick*, 3 Wash. C. C. 408; S. C. 7 Wheat. 453; *Spaulding v. Tucker*, 1 Deady, 649.

A party has no right to cross-examine any witness except as to facts and circumstances connected with the matters stated in his direct examination. If he wishes to examine him as to other matters, he must do so by making the witness his own, and calling him as such in the subsequent progress of the cause. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448.

The court will judicially take notice of matters of science which are in common knowledge and use. *Brown v. Piper*, 91 U. S. 37; S. C. 1 Holmes, 20; 10 O. G. 417.

The invention is an intellectual process or operation, and, like all other expressions of thought can, in many cases, scarcely be made known except by speech. The invention may be consummated and perfect, and may be sus-

ceptible of complete description in words, a month or even a year before it can be embodied in any visible form, machine or composition of matter. The conversations and declarations of a patentee stating that he had made an invention, and describing its details and explaining its operations, are properly to be deemed an assertion of his right at that time as an inventor to the extent of the facts and details which he then makes known, although not of their existence at an antecedent time. Such conversations and declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ*, and legitimate evidence that the invention was then known to and claimed by him, and thus its origin may be fixed at least as early as that period. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448; *Evans v. Hettick*, 3 Wash. C. C. 408; s. c. 7 Wheat. 453.

The mode of conducting trials, the order of introducing evidence, and the times when it is to be introduced, are properly matters belonging to the practice of the circuit courts. Probably the practice in no two States of the Union is the same, and therefore in each State the circuit courts must necessarily be vested with a large discretion in the regulation of their practice. If every party had a right to introduce evidence at any time, at his own election, without reference to the stage of the trial in which it is offered, it is obvious that the proceedings of the court would often be greatly embarrassed, the purposes of justice obstructed, and the parties themselves surprised by evidence destructive of their rights, which they could not have foreseen, or in any manner have guarded against. All courts are, therefore, vested with a large measure of discretion on this subject, to prevent the most mischievous consequences in the administration of justice to suitors, and the circuit courts possess this discretion in as ample a manner as other judicial tribunals. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448.

Evidence to prove that there are material differences between the original patent and the reissue, can not be admitted after the defendant's counsel has stated in open court that he has closed his case, and after the plaintiff, in consequence of that declaration, has discharged his own witnesses. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448.

The representations of the specifications may be such as to afford satisfactory proof that the alleged invention is neither new nor useful. *Collar Co. v. Van Dusen*, 23 Wall. 530; s. c. 10 Blatch. 119; 7 O. G. 919.

Parol Evidence.

Parol evidence, bearing upon written contracts and papers, ought not to be admitted without the production of such written contracts and papers, so as to enable both the court and the jury to see whether or not the admission of the parol evidence, in any manner, will trench upon the rule that parol evidence is not admissible to vary or contradict written contracts or papers. *Phila. & Trenton R. R. Co. v. Stimpson*, 14 Pet. 448.

Parol, or secondary evidence of the contents of a written instrument, is inadmissible without previous proof of the loss of the original, or of its being in the actual possession of the adverse party, and notice given to produce it. *Allen v. Blunt*, 2 W. & M. 121.

Before a party is allowed to give secondary or parol evidence of the contents of a written instrument supposed to be in the possession of the opposite party, he must first prove the possession of it as well as the notice. *Allen v. Blunt*, 2 W. & M. 121.

If the written instrument was sent by private hand, then the person carrying it can testify whether he delivered it. *Allen v. Blunt*, 2 W. & M. 121.

If a written instrument is sent by mail, then, where notice is to be brought home to the correspondent, the letter must be shown to have been received. The law does not presume that it was received. *Allen v. Blunt*, 2 W. & M. 121.

Proof that a written instrument is in the possession of the adverse party may be by the affidavit of the party, and be disproved by the affidavits of his opponent, and interrogatories be put in the discretion of the court to each by the other. *Allen v. Blunt*, 2 W. & M. 121.

The evidence to prove that a written instrument is in the possession of the opposite party, is weighed under liberal views, rather than technical scruples, and in connection with all the other evidence and circumstances bearing on the point. *Allen v. Blunt*, 2 W. & M. 121.

The evidence to justify the admission of parol or secondary evidence of the contents of a written instrument must be offered to the court. *Allen v. Blunt*, 2 W. & M. 121.

It is not permitted to a party to control a written agreement by parol testimony of declarations or conversations at the time it was completed, or before, which would contradict, add to or alter the written agreement, either in the case of a latent or patent ambiguity. *Troy Factory v. Corning*, 14 How. 193; *s. c.* 1 Blatch. 467; *Ruggles v. Eddy*, 5 Fish. 581; *s. c.* 10 Blatch. 52.

Experts.

There are various classes of cases which depend upon the knowledge of a peculiar art or science for their solution, of a particular business requiring a peculiar knowledge in order to form a satisfactory judgment of the question involved. In such cases, the law allows testimony to be given by those skillful in the particular art, science, or profession, and permits them to give their opinions as results which they arrive at from an examination of the questions of fact that are before the jury. *Johnson v. Root*, 1 Fish. 351; *Cahoon v. Ring*, 1 Fish. 397; *s. c.* 1 Cliff. 592; *Many v. Sizer*, 1 Fish. 17.

The opinion of skillful witnesses, whether the principles of two machines are the same, is competent evidence to be introduced in a patent cause, but care should be taken to distinguish what is meant by a principle. The true legal meaning of the principle of a machine, with reference to the patent act, is the peculiar structure or constituent parts of such machine. In this view, the question may be very properly asked in cases of doubt or complexity, of skillful persons, whether the principles of two machines be the same or different. *Barrett v. Hall*, 1 Mason, 447; *Conover v. Rapp*, 4 Fish. 57.

An expert can not be asked whether he has ascertained from investigations in scientific works or otherwise, that the invention was not novel, for the question seeks to establish an historical fact under the guise of a scientific opinion. *McMahon v. Tyng*, 96 Mass. 167.

The opinion of a witness in regard to what a prior invention might have been applied to, is not admissible, for it is a mere matter of speculation. The speculative opinions of a witness can not be given in evidence. *Judson v. Cope*, 1 Fish. 615; S. C. 1 Bond, 327.

It is competent for an expert to testify, that the practical manner of giving effect to the principle embodied in the machine used by the defendant, is entirely different from the practical manner of giving effect to the principle embodied in the patentee's machine, and that the principles of the two machines, as well as the practical manner of carrying out those principles, are different. *Corning v. Burden*, 15 How. 252.

It is competent for an expert to testify that the machine used by the defendant differs in point of mechanical structure and mechanical action from the machine described in the patent. *Corning v. Burden*, 15 How. 252.

Experts may be examined as to the meaning of terms of art, on the principle of *cuique in sua arte credendum*, but not as to the construction of written instruments. They are not, therefore, competent to give an opinion as to the construction of the patent. *Corning v. Burden*, 15 How. 252; *Jackson v. Allen*, 120 Mass. 64; *Winans v. N. Y. & Erie R. R. Co.* 1 Fish. 213; S. C. 21 How. 88; *Day v. Stellman*, 1 Fish. 487; *Ely v. Monson Manuf. Co.* 4 Fish. 64.

Great respect is due to the views and opinions of scientific individuals and practical mechanics on the question of identity of different mechanical structures. From their acquaintance with the elements of mechanical science, they are enabled satisfactorily to decide the question, while to others it might seem involved in obscurity and doubt. *Parker v. Stiles*, 5 McLean, 44; *Potter v. Muller*, 2 Fish. 465; *French v. Rogers*, 1 Fish. 133.

Experience has shown that opposite opinions of persons professing to be experts may be obtained to any amount, and it often occurs, that not only many days, but even weeks are consumed in cross-examinations to test the skill or knowledge of such witnesses, and the correctness of their opinions, wasting the time and wearying the patience of both court and jury, and perplexing instead of elucidating the questions involved in the issue. *Winans v. N. Y. & Erie R. R. Co.* 1 Fish. 213; S. C. 21 How. 88; *Conover v. Rapp*, 4 Fish. 57; *Mitchell v. Tilghman*, 4 Fish. 599; S. C. 19 Wall. 287; 5 O. G. 299; *King v. Louisville Cement Co.* 6 Fish. 336; S. C. 4 O. G. 181.

Widely as experts differ in opinion in the trial of patent causes, those differences are almost always traceable to the assumption of different postulates. Their opinions differ because they are given on substantially different cases. When their minds can be drawn to the same point, and they use the same words in the same sense, they rarely differ. *Sargent v. Carter*, 1 Fish. 277.

The mere opinion of experts, when not sustained by pointing out clearly the particulars of difference or coincidence between pieces of machinery constructed to produce the same results, and working out those results by means so nearly identical as to create a strong presumption of a common origin, can not afford proof very satisfactory to the mind, that the judgment of the witnesses ought to be adopted. *U. S. Annunciator Co. v. Sanderson*, 3 Blatch. 184.

It is unsafe in many particulars to rely on the opinion of witnesses as to

the identity of two machines, for the reason that they may not have a clear perception in what the identity consists, and in that case, their opinions, whether they are identical or not identical, should have no weight with the jury. *Conover v. Rapp*, 4 Fish. 57.

An examination should be made to see whether the opinions of experts embrace in them any question of law. When a question of law is involved in the opinion of experts, that is not to be left to a jury. *Ely v. Monson Manuf. Co.* 4 Fish. 64.

When the opinions of experts are expressed in *ex parte* affidavits, and there is no opportunity for the court to ascertain in what sense they use important words, or what facts they take into view, or what standards of comparison they assume, their opinions are of comparatively little use in guiding the court to a safe conclusion. *Sargent v. Carter*, 1 Fish. 277.

In passing upon the identity or diversity of machines in principle, it is more satisfactory to ascertain the precise differences and agreements, than to take the mere opinions of witnesses, and when such differences and agreements can be subjected to the eyes, they almost supersede all the evidence of mere opinion. *Barrett v. Hall*, 1 Mason, 447; *Livingston v. Jones*, 1 Fish. 521; *Seymour v. Osborne*, 3 Fish. 555; S. C. 11 Wall. 516.

Ocular demonstration is better than the opinions of experts. *Adams v. Jones*, 1 Fish. 527; *Hoffheins v. Brandt*, 3 Fish. 218; *Blanchard v. Putnam*, 3 Fish. 186; S. C. 8 Wall. 420; 2 Bond, 84.

The statement of a fact by one who has seen a machine work, is better, if reliable, than the mere opinion of ever so scientific an expert. *Cox v. Griggs*, 2 Fish. 174; S. C. 1 Biss. 362.

The jury are not bound by the opinions of experts. They are introduced only to aid the jury, and the jury may rely upon them so far as they shall think proper. The jury in forming a judgment upon such testimony, may take into view their ability, their knowledge of the art or profession in which they are engaged, the fairness with which they express an opinion, the impartiality of that opinion, the reasons that may be assigned for that opinion, and all those considerations which go to create a confidence or a distrust of the opinions which are given. *Bierce v. Stocking*, 77 Mass. 174; *Johnson v. Root*, 1 Fish. 351; *Many v. Sizer*, 1 Fish. 17; *Hudson v. Draper*, 4 Fish. 256; *Carter v. Baker*, 4 Fish. 404; S. C. 1 Saw. 512; *Spaulding v. Tucker*, 1 Deady, 649; *Cahoon v. Ring*, 1 Fish. 397; S. C. 1 Cliff. 592; *Cox v. Griggs*, 2 Fish. 174; S. C. 1 Biss. 362; *Conover v. Roach*, 4 Fish. 12; *Whipple v. Baldwin Manuf. Co.* 4 Fish. 29; *Conover v. Rapp*, 4 Fish. 57; *Page v. Ferry*, 1 Fish. 298; *Waterbury Brass Co. v. N. Y. Brass Co.* 3 Fish. 43.

Estoppel.

The defendant is not estopped by any prior offer made by him to take a license from the patentee. If the offer amounted to an acknowledgment that the patentee was the original inventor, this may be used as evidence of that fact, but it would not entitle the patentee to a verdict if the fact is proved to be otherwise. *Evans v. Eaton*, Pet. C. C. 322; S. C. 3 Wheat. 454.

If an expression in a patent is withdrawn by a surrender and reissue, the

patentee is not estopped from disputing its truth. *Allen v. Blunt*, 2 W. & M. 121.

If several patents are taken out by several patentees for a several invention, and the same patentees afterwards take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint, but the former patents are very strong evidence against the joint invention. The reason of this doctrine is not that estoppels are odious in law, but that a party may innocently make a mistake as to the extent of his own invention. A party may suppose that he has invented what in truth has been partly suggested by another mind. *Barrett v. Hall*, 1 Mason, 447.

The dismissal of a proceeding in chancery is usually pleaded in bar to a subsequent proceeding, and averments are made that the dismissal was on the merits. But if it is not so pleaded and averred, and is only offered in evidence, then the evidence *dehors* the record, if not in it, should accompany the record and prove all which is proper to show that the dismissal was the result of a judicial inquiry, and disposed of the rights of the parties involved in the proceedings. *Allen v. Blunt*, 2 W. & M. 121.

If the same merits or points are not again agitated in the second suit, then the first decision, being on different matters, can not bind or control the second suit. *Allen v. Blunt*, 2 W. & M. 121.

A verdict rendered on an issue sent to be tried at law is not admissible as evidence in another suit between the same parties, if the complainant dismissed the bill without any judgment on the merits. A mere verdict in any suit does not, as a matter of course, settle the rights of the parties. It is open to numerous exceptions growing out of rulings on evidence that was offered, and opinions or principles involved in the merits, and may be set aside for various errors in them, or for misbehavior of the jury. *Allen v. Blunt*, 2 W. & M. 121; S. C. 3 Story, 742.

A judgment in an action where the novelty and originality of the invention were put in issue by the pleadings precludes the defendant from raising the same questions in a subsequent action, although he endeavors to sustain it by additional evidence. *Dubois v. P. W. & B. R. R. Co.* 5 Fish. 208.

Province of Jury.

The question in respect to an assertion or surrender of the rights of an inventor, whether it be sought in his declarations or acts, or in forbearance or neglect to speak or act, is an inquiry or conclusion of fact, and peculiarly within the province of a jury guided by legal evidence submitted to them at the trial. *Kendall v. Winsor*, 21 How. 322; *Batten v. Taggart*, 17 How. 74; S. C. 2 Wall. Jr. 101; *American Leather Co. v. American Tool Co.* 4 Fish. 284.

When a claim does not point out and designate the particular elements which compose a combination, but only declares, as it properly may, that the combination is made up of so much of the described machinery as effects a particular result, it is a question of fact which of the described parts are essential to produce that result, and to this extent, not the construction of the

claim strictly speaking, but the application of the claim, should be left to the jury. *Silsby v. Foote*, 14 How. 218; s. c. 1 Blatch. 445.

A question of infringement is one of fact which it is the province of a jury to decide. *Rich v. Lippincott*, 2 Fish. 1; *Case v. Brown*, 2 Fish. 268; s. c. 2 Wall. 320; 1 Biss. 382; *Brooks v. Jenkins*, 3 McLean, 432; *Batten v. Taggert*, 17 How. 74; s. c. 2 Wall. Jr. 101; *Blanchard v. Putnam*, 3 Fish. 186; s. c. 8 Wall. 420; 2 Bond, 84; *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512; *Orr v. Burwell*, 15 Ala. 378.

It is for the court to say what is identity in point of law. *Latta v. Shawk*, 1 Fish. 465; s. c. 1 Bond, 259.

Whether two machines are the same in substance or not is a question of fact for the jury. *Carver v. Hyde*, 16 Pet. 513; *Le Roy v. Tatham*, 2 Blatch. 474; s. c. 14 How. 156; *Many v. Jagger*, 1 Blatch. 372; *Colt v. Mass. Arms Co.* 1 Fish. 108; *Blanchard's Factory v. Warner*, 1 Blatch. 258; *Kidd v. Spence*, 4 Fish. 37.

Whether one compound of given proportions is substantially the same as another compound varying in the proportions, is a question of fact. *Tyler v. Boston*, 7 Wall. 327.

Whether a given improvement is a patentable invention is a mixed question of law and fact, and should not in ordinary cases be disposed of on demurrer and without the intervention of a jury. *Teese v. Phelps*, 1 McA. 17.

Whether the description is so particular as to enable a mechanic to construct the machine is a question for the jury. *Brooks v. Jenkins*, 3 McLean, 432; *Goodyear v. Wait*, 3 Fish. 242; s. c. 5 Blatch. 468; *Parker v. Stiles*, 5 McLean, 44; *Forbes v. Barstow Stove Co.* 2 Cliff. 379; *Davis v. Palmer*, 2 Brock. 298; *Page v. Ferry*, 1 Fish. 298; *Hogg v. Emerson*, 2 Blatch. 1; s. c. 6 How. 437; 11 How. 587; *Judson v. Moore*, 1 Fish. 544; s. c. 1 Bond, 285; *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond, 27; *Evans v. Eaton*, 7 Wheat. 356; s. c. 3 Wash. C. C. 443; *Carver v. Braintree Manuf. Co.* 2 Story, 432; *Batten v. Taggert*, 17 How. 74; s. c. 2 Wall. Jr. 101.

If the identity of the inventions described in two patents does not appear upon their face without the assistance of experts, the question should be submitted to the jury. *Hawkes v. Remington*, 111 Mass. 171.

It is the province of the court to decide what constitutes novelty of invention. *Parker v. Stiles*, 5 McLean, 44.

Whether an invention is novel is a question of fact for the jury to determine. *Sickels v. Borden*, 3 Blatch. 535; *Turrill v. Railroad Company*, 1 Wall. 491; *Many v. Jagger*, 1 Blatch. 372; *Serrell v. Collins*, 1 Fish. 289; *Parker v. Stiles*, 5 McLean, 44; *Batten v. Taggert*, 17 How. 74; s. c. 2 Wall. Jr. 101; *Swift v. Whisen*, 3 Fish. 343; s. c. 2 Bond, 115.

It is the duty of the court to construe the patent and specifications for the purpose of determining what the claim of the discovery or invention is, and it is the province of the jury under the instructions of the court, as to what the invention is, to determine whether such invention is new and useful. *Wintermute v. Redington*, 1 Fish. 239; *Parker v. Hulme*, 1 Fish. 44; *Poppenhusen v. Gutta Percha Comb Co.* 2 Fish. 62.

When it becomes a matter of inquiry whether the benefits of a patent are

of sufficient consequence to be protected by the arm of the government, the question should be left to the jury. *Langdon v. De Groot*, 1 Paine, 203.

Whether an invention of a composition can be used in any case with advantage without first ascertaining, by experiment, the proportion to be employed, is a question to be decided by a jury, upon the evidence of persons skilled in the art to which the patent appertains. *Wood v. Underhill*, 5 How. 1.

Whether the invention itself be thus specifically described with reasonable certainty is a question of law upon the construction of the terms of the patent. *Lowell v. Lewis*, 1 Mason, 187; *Wintermute v. Redington*, 1 Fish. 239; *Wilton v. Railroad Co.* 2 Whart. Dig. 359.

Whether the specification is sufficiently clear and certain in its description of the invention involves a question of law only in part, or so far as regards the construction of the written words used. *Hogg v. Emerson*, 6 How. 437; s. c. 2 Blatch. 1; *Forbes v. Barstow Stove Co.* 2 Cliff. 379; *Howes v. Nute*, 4 Fish. 263.

Whether the specification is uncertain and insufficient, is a question of law for the court. *Wayne v. Holmes*, 2 Fish. 20; s. c. 1 Bond, 27.

In questions of identity or diversity, it is not the construction of written instruments, but the character of the invention that is sought, and this is a question of fact. In case of a conflict between a prior and a subsequent patent, the question of identity is a question of fact for the jury and not a question of law for the court. *Bischoff v. Wethered*, 9 Wall. 812; *Stevens v. Pierpont*, 42 Conn. 360; *Waterbury Brass Co. v. N. Y. Brass Co.* 3 Fish. 43; *Jackson v. Allen*, 120 Mass. 64; *Tucker v. Spalding*, 5 Fish. 297; s. c. 13 Wall. 453; 1 O. G. 144.

Trial by jury, though an inestimable right, is not a trial without a court, and it is not so regarded either by the Constitution or the laws of Congress. It is as much the duty of the court to determine the questions raised as to the admissibility of evidence, as it is that of the jury to determine its weight after it is received. It is the imperative duty of the court to rule out testimony which in law is not admissible. *Cahoon v. Ring*, 1 Fish. 397; s. c. 1 Cliff. 592.

All questions of the force and effect of the testimony, of the credit which shall be given to witnesses, of the facts which shall be considered to be established, of inferences to be drawn from them, are matters for the jury alone. *Johnson v. Root*, 1 Fish. 351.

If the jury find that a witness has willfully sworn falsely to a fact material to the issue, they are at liberty, if they deem it proper to do so, to disbelieve everything he has stated in the case. *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600.

The jury are to judge of the credibility of witnesses under the instructions of the court. *Union Sugar Refinery v. Matthiessen*, 2 Fish. 600.

The determination of the court upon questions of law is conclusive upon the parties and upon the jury. *Conover v. Roach*, 4 Fish. 12.

Practice.

All torts are joint as well as several, and the patentee may recover a verdict against one though the other defendant is acquitted. *Reutgen v. Kanowrs*, 1 Wash. C. C. 168.

The court, though reasonably requested, is not bound to instruct the jury on points not arising in the case, or on abstract and irrelevant propositions. *Allen v. Blunt*, 2 W. & M. 121.

The court is never bound to give an instruction to a jury upon a point of law, even when pertinent and relevant to the facts of the case, precisely in the form and manner in which it is put by counsel, for that may sometimes have a tendency to mislead the jury and withdraw their attention from the merits of the case. All that it is the duty of the court to do, is to give such instructions to the jury in point of law, as clearly arise upon the evidence, and are proper for the consideration of the jury upon the issues before them in such terms and in such a manner as shall comport with the real merits and justice of the case, and enable the jury to give a proper verdict in point of law. *Pitts v. Whitman*, 2 Story, 609.

A motion for leave to amend by adding the name of a party who, at the time of the infringement, had the exclusive right under the patent, will not be granted, for it will amount to the institution of a new suit materially different both as to plaintiff and rights of action. *Goodyear v. Bowen*, 3 Blatch. 266.

If the patentee has obtained a patent in his own name in fraud of the rights of another who is a joint inventor, he is in equity a trustee for the other, and though possibly at law a verdict must be rendered for the patentee against such joint inventor, still the jury may give merely nominal damages. *Reutgen v. Kanowrs*, 1 Wash. C. C. 168.

An infringement, by a patentee, of the exclusive right conferred upon a grantee, is no defense to an action by the patentee to recover the license fee which the grantee stipulated to pay for each machine sold by him. *Birdsall v. Perego*, 5 Blatch. 251.

Courts are called upon only to decide questions that are before them. A judge, sometimes, in giving an opinion, uses language which, although it is always entitled to consideration and respect, yet, in reference to questions that were not before the court, and the decision of which was not necessary to the decision of the questions before it, is not of binding authority. *Day v. Stillman*, 1 Fish. 487.

The judges of the circuit courts ought not to hold themselves bound and the rights of parties concluded by the language of a judge of the Supreme Court, unless such language was strictly applicable to the case then before the court. *Day v. Union Rubber Co.* 20 How. 216; S. C. 3 Blatch. 488.

So far as principles involving the validity of a patent have been settled by the decisions upon it in other courts, they will be regarded as final and authoritative. *Goodyear v. Berry*, 3 Fish. 439; S. C. 2 Bond, 189.

A defective notice does not afford a foundation for a motion by the defendant for the withdrawal of a juror on the ground of surprise arising out of the ruling of the court in respect to the notice and the evidence offered under it,

and, under any circumstances, it is a matter resting altogether in the discretion of the court. *Silsby v. Foote*, 14 How. 218; S. C. 1 Blatch. 445.

The court has no power to order a peremptory nonsuit against the will of the plaintiff. *Silsby v. Foote*, 14 How. 218; S. C. 1 Blatch. 445.

If a juror becomes ill after the plaintiff's counsel begins his opening address, before any evidence is given, he may be discharged from the panel, and the court may treat such discharge as simply creating a vacancy on the panel, and may proceed to fill it in the usual way by having a twelfth juror drawn and sworn. This practice must be confined to cases where it is apparent that the party objecting receives no injury. *Silsby v. Foote*, 14 How. 218; S. C. 1 Blatch. 445.

If the jury disagree and are discharged, the case can not be tried again at the same term by a new jury selected from the residue of the panel, but must go over to await another venire. *Wilson v. Barnum*, 2 Fish. 635; S. C. 1 Wall. Jr. 347; 8 How. 258.

A special verdict is sufficient if the court can collect the point in issue out of it, although it does not in terms find the issue joined by the parties. *Stearns v. Barrett*, 1 Mason, 153.

Where a verdict is not expressed substantially in the terms of the issue, the case ought to be extremely clear, that should induce a court to make it the ground of a final judgment. *Stearns v. Barrett*, 1 Mason, 153.

Where there is a material repugnancy in the verdict, it is not competent for the court to reject either part of the finding, for it is utterly impossible for the court to decide which is the truth of the case, and even if it could, there is no authority to substitute its own opinion for that of the jury. In such a case the repugnancy will be fatal. A verdict which finds two inconsistent material facts is void, and can not be the foundation for a legal judgment. *Stearns v. Barrett*, 1 Mason, 153.

The right of the plaintiff to costs follows from a verdict in his favor for any amount of damages, whether nominal or compensatory, and without any reference to the action of the court in adjudging an increase of damages. *Merchant v. Lewis*, 1 Bond, 172.

Arrest of Judgment.

It is not a sufficient ground to support a motion in arrest of judgment, that the declaration does not set forth the act complained of as contrary to the statute. This is not necessary where damages are sought for on account of an injury done. *Parker v. Haworth*, 4 McLean. 370.

A motion in arrest of judgment ought properly to be heard after the motion for a new trial, which, if granted, might supersede the other motion. *Pitts v. Whitman*, 2 Story, 609.

New Trial.

If in the hurry of a trial, a ruling of the court in admitting evidence is erroneous, but afterwards becomes immaterial or unnecessary in consequence

of other evidence, a new trial will not be granted. *Allen v. Blunt*, 2 W. & M. 121.

If the error consists in an instruction in regard to the measure of damages, the plaintiff may avoid a new trial by consenting that the verdict be reduced to nominal damages. *Cowing v. Rumsey*, 4 Fish. 275; s. C. 8 Blatch. 35.

A new trial should not be granted for a cause existing at the trial, but which was not stated or excepted to then. The more especially is this so, when any wrong or misleading of the jury was likely to flow from the objection not being made. *Allen v. Blunt*, 2 W. & M. 121.

If a party chooses to carry a question to the jury, he can not complain on that ground, and ask for a new trial, when the verdict is against him. *Silsby v. Foote*, 14 How. 218; s. C. 1 Blatch. 445.

In order to justify the granting of a new trial, it must be so clearly shown that the verdict is against the weight of evidence as to raise a strong presumption that the jury either wantonly abused their powers or made some inadvertent mistake. *Aiken v. Bemis*, 3 W. & M. 348; *Johnson v. Root*, 2 Fish. 291; s. C. 2 Cliff. 108; *Bray v. Hartshorn*, 1 Cliff. 538.

Although the verdict of a jury is of less weight in patent cases than in other civil causes, yet it will not be set aside unless they were palpably mistaken, and the weight of the evidence was decidedly against the verdict. *Roberts v. Schuyler*, 12 Blatch. 444.

If the verdict is decidedly against the evidence in the cause, it will be set aside. *Wilson v. Janes*, 3 Blatch. 227.

It must be a very aggravated and oppressive case where the court would feel justified in setting up its own opinion, even if decidedly different from that of the jury, as to the true amount of damages, and award a new trial on that ground. *Allen v. Blunt*, 2 W. & M. 121; *Alden v. Dewey*, 1 Story, 336; *Whitney v. Emmett*, Bald. 303; *Aiken v. Bemis*, 3 W. & M. 348; *Stimpson v. Railroads*, 1 Wall. Jr. 164.

Error in awarding excessive damages may sometimes be obviated by allowing the prevailing party to remit the excess, and that course is frequently adopted in cases where the court is satisfied that the error has resulted from oversight or mere inadvertence; but where the finding is not only contrary to the evidence, but in direct contravention of the charge of the court, the error can not in general be remedied in that way. *Johnson v. Root*, 2 Fish. 291; s. C. 2 Cliff. 108.

Irregularity on the part of the party charged, or of the jury, must be satisfactorily proved, in order to lay the foundation for the interposition of the court; but when the irregular conduct is established, it is not necessary that it should certainly appear that it influenced the jury. In that state of the case it is sufficient that the irregularity appears to be of such a character that it might have affected the impartiality of the proceedings. *Johnson v. Root*, 2 Fish. 291; s. C. 2 Cliff. 108.

It is not necessary that the attempt to influence the jurors should be made by one of the parties, nor even by his agent. It is sufficient if it clearly appear that it was done in his behalf. *Johnson v. Root*, 2 Fish. 291; s. C. 2 Cliff. 108.

It is never necessary to show that the misconduct controlled or determined

the verdict, provided it was of a character that it might have had an undue influence. *Johnson v. Root*, 2 Fish. 291; S. C. 2 Cliff. 108.

A new trial will not be granted upon the discovery of new evidence, if the information might have been obtained by the use of reasonable diligence. *Washburn v. Gould*, 3 Story, 122.

If a party, by the use of ordinary diligence, could have obtained full evidence to any point which could properly sustain his defense, there is no reason for granting him a new trial merely because he could, upon further reflection and further lights, make a fuller and better defense. *Ames v. Howard*, 1 Sum. 482.

A new trial will not be granted upon the discovery of new evidence, if the information was within the reach of the party before the trial was concluded. *Washburn v. Gould*, 3 Story, 122.

A new trial is never granted upon the discovery of mere cumulative evidence, where there is no other ground of objection to the verdict. *Ames v. Howard*, 1 Sum. 482.

If the new evidence is to subordinate points and particular facts not before agitated, it is not cumulative, although the general subject was discussed. *Aiken v. Bemis*, 3 W. & M. 348.

When a new trial is granted for newly discovered evidence, the terms usually are that the costs of the former trial be first paid. *Aiken v. Bemis*, 3 W. & M. 348.

Depositions to be used on a motion for a new trial may always without a special order be *ex parte*. *Aiken v. Bemis*, 3 W. & M. 348.

If counter affidavits offered by the adverse party go to establish strong cumulative proofs the other way, the court will always decline to interfere with the verdict, because it will not undertake to measure the weight of the new testimony upon either side, or send the parties again to a litigation upon the chances of a verdict upon new conflicting evidence. *Ames v. Howard*, 1 Sum. 482.

A party who moves for a new trial upon the ground of the discovery of new evidence can not put in new rebutting evidence to the affidavits of the adverse party, offered in reply to those first offered by himself. He must present his whole case at once to the court, and not lead it on through a series of confirming and rebutting proofs, thus protracting the cause to an unreasonable extent. *Ames v. Howard*, 1 Sum. 482.

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

ant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

Statute Revised—July 5, 1870, ch. 230, § 55, 16 Stat. 206.

Prior Statutes—February 15, 1819, ch. 19, § 1, 3 Stat. 481.—July 4, 1836, ch. 357, § 16, 5 Stat. 123.

Parties.

A contract for the purchase of any portion of the patent right may be good between the parties as a license, and enforced as such in the courts of justice; but the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it. *Gayler v. Wilder*, 10 How. 477; *Sanford v. Messer*, 5 Fish. 411; S. C. 1 Holmes, 149; 2 O. G. 470; *Blanchard v. Eldridge*, 1 Wall. Jr. 337.

A patentee who has granted a license to make and vend the thing patented within a certain territory, in consideration of the payment of a certain sum for each article so manufactured and sold, reserving to himself the right to sell the thing patented within the territory, is a party aggrieved, and may proceed in equity for the protection of his rights. *Hussey v. Whiteley*, 2 Fish. 120; S. C. 1 Bond, 407.

A party who holds the legal title and has an interest in the damages to be recovered for an infringement, is a necessary party. *North v. Kershaw*, 4 Blatch. 70.

A patentee who has assigned his interest prior to the filing of a bill, can not obtain an injunction. *Morse v. O'Reilly*, 6 Penn. L. J. 501.

An assignee of a territorial interest in a patent may maintain an action in his own name. *Chambers v. Smith*, 3 Fish. 12; S. C. 7 Phila. 575; *Olcott v. Hawkins*, 2 Am. L. J. 317.

A grantee may maintain a bill, although he derives his title through a foreign administrator, and there need be no domestic administrator. *Smith v. Mercer*, 5 Penn. L. J. 529; S. C. 4 West. L. J. 49.

A party who has merely an interest in the profits, without any legal title in the patent, need not be made a party complainant. *Goodyear v. Central R. R. Co.* 1 Fish. 626; S. C. 2 Wall. Jr. 356.

A court of equity, upon a bill by the legal owner of a patent right, can not enjoin the equitable owner from using the thing patented. It considers the equitable title the true title. *Clum v. Brewer*, 2 Curt. 506; *Day v. Candee*, 3 Fish. 9; *Chase v. Walker*, 3 Fish. 120; *Continental Co. v. Empire Co.* 4 Fish. 428; S. C. 8 Blatch. 295.

A party having an equitable title may maintain a bill in equity against a party having the legal title. *Ruggles v. Eddy*, 5 Fish. 581; S. C. 10 Blatch. 52.

If the patentee infringes the rights of a licensee, the licensee may sue in

his own name. The breach of trust is an infringement, and its redress involves a suit arising under the patent laws. *Littlefield v. Perry*, 21 Wall. 205; s. c. 7 O. G. 964.

One tenant in common has as good right to use and to license third persons to use the thing patented as the other tenant in common has. Neither can come into a court of equity and assert a superior equity, unless it has been created by some contract modifying the rights which belong to them as tenants in common. *Clum v. Brewer*, 2 Curt. 506.

A mere licensee can not sue strangers who infringe. In such case redress is obtained through or in the name of the patentee or his assignee. *Littlefield v. Perry*, 21 Wall. 205; *Hill v. Whitcomb*, 5 O. G. 430.

A licensee may file a bill in equity to enjoin any party who has actually infringed his right under the license. *Brammer v. Jones*, 3 Fish. 340; s. c. 2 Bond, 100.

A licensee has not such an interest as requires him to be joined as a party complainant. *Potter v. Wilson*, 2 Fish. 102; *Grover & Baker S. Co. v. Sloat*, 2 Fish. 112.

A foreign administrator of the patentee may maintain a suit in the circuit court without taking out new letters of administration in the State where the suit is brought. The title to a patent is regulated by an act of Congress. *Smith v. Mercer*, 5 Penn. L. J. 529; s. c. 4 West. L. J. 49; *Goodyear v. Hullen*, 3 Fish. 251; *Hodge v. Missouri Railroad*, 4 Fish. 161; s. c. 1 Dillon, 104.

A corporation created under the laws of one State may file a bill in a circuit court in another State. *Elm City Co. v. Wooster*, 6 Fish. 452; s. c. 4 O. G. 83.

A corporation, unless restrained by its charter, may engage in the manufacture of the thing patented in another State. *Grover & Baker S. Co. v. Sloat*, 2 Fish. 112; *Blanchard's Factory v. Warner*, 1 Blatch. 258.

Where one person has the legal title to a patent, and another person has an equitable right in the same, and a suit in equity is instituted complaining of an infringement, the person having the legal right, and the one having an equitable right which has been violated, should join as complainants. *Stimpson v. Rogers*, 4 Blatch. 333; *Aiken v. Dolan*, 3 Fish. 197; *Dibble v. Augur*, 7 Blatch. 86.

The patentee and a licensee may unite in a bill to enjoin an infringement of the interest owned by the licensee. *Goodyear v. Central R. R. Co.* 1 Fish. 626; s. c. 2 Wall. Jr. 356; *Goodyear v. Allyn*, 3 Fish. 374; s. c. 6 Blatch. 33; 1 A. L. T. 94; *Dorsey R. & H. Rake Co. v. Bradley Manuf. Co.* 12 Blatch. 202.

If the patentee has given a license to the defendant, which has been forfeited by a breach of the condition, he is a necessary party to the suit in order to take advantage of the condition, although he has assigned his interest in the patent to another. *Woodworth v. Cook*, 2 Blatch. 151.

The assignor and assignee may unite in a bill in equity for an infringement that occurred before the assignment. *Anthony v. Carroll*, 9 O. G. 199; s. c. 23 Pitts. L. J. 23.

If the assignment of a claim for past damages and profits is in connection with and incident to a transfer of the title to the patent, the assignor is not a necessary party to a bill to recover damages and profits before as well as after the assignment. *Henry v. Stove Co.* 9 O. G. 408.

Until an assignment is made, all suits must be brought in the name of the personal representative of the patentee. The next of kin or heirs have no title or interest in the patent, and should not be joined as parties complainant. *Hodge v. Missouri Railroad*, 4 Fish. 16; s. c. 1 Dillon, 104.

A party who is interested in the patent out of a certain territory may unite with a party who owns the patent within the territory to obtain an injunction to prevent sales of the alleged infringing articles, if they are sold out of the territory. *Buck v. Cobb*, 9 Law Rep. 545.

The patentee may be made a party complainant, jointly with the grantee, of a right to a certain territory. *Woodworth v. Wilson*, 4 How. 712; *Ogle v. Ede*, 4 Wash. C. C. 584.

Where a reissue has been granted to an administrator, the heirs of the patentee are necessary parties to the bill. *Northwestern Co. v. Philadelphia Co.* 6 O. G. 34; s. c. 31 Leg. Int. 148.

Where the patentee, in his lifetime, parted with his equitable title to the invention, his heirs are not necessary parties if a reissue has been granted to the administrator. *Northwestern Co. v. Philadelphia Co.* 6 O. G. 34; s. c. 31 Leg. Int. 148.

If other persons named as executors did not prove the will, and had nothing to do with the surrender or reissue of letters patent, and the reissue is granted to one executor alone, they need not be made parties to a bill to restrain the infringement of the reissued patent. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

When the patent is owned by a firm, one partner can not file a bill without joining his copartner. *Ambler v. Chouteau*, 3 Cent. L. J. 333.

Where a final decision can not be made between the parties litigating, without directly affecting and prejudicing the rights of others not made parties, the objection may be taken at the hearing, and it may and ought to be raised and acted upon by the court itself. *Florence Co. v. Singer Co.* 4 Fish. 629; s. c. 8 Blatch. 113.

Where the case can not be decided between the parties, it will not avail to suggest that the absentees are beyond the jurisdiction of the circuit court, or have such residence or citizenship that to make them parties would defeat that jurisdiction. *Florence Co. v. Singer Co.* 4 Fish. 329; s. c. 8 Blatch. 113.

If the patentee joins with a party who has no joint interest sufficient to maintain the bill, the bill will be dismissed. *Wyeth v. Stone*, 1 Story, 273.

Objections as to parties are not favored when postponed to the final hearing upon the pleadings and proofs. *Potter v. Wilson*, 2 Fish. 102; *Dibble v. Augur*, 7 Blatch. 86.

If the want of proper parties complainant is not set up in the answer, it will not avail unless the case, if made at the hearing, is one in which the court can not proceed to a decree between the parties before the court without prejudice to the rights of those who are proper to be made parties, but who are not brought into court. *Wallace v. Holmes*, 5 Fish. 37; s. c. 9 Blatch. 65; 1 O. G. 117.

A person who merely gives a license for the use of his own patent to the person who commits the alleged infringement, can not be made a party defendant unless his patent covers, or his license, in form or effect, has some connection with the infringement of the complainant's patent. *Hussey v. Bradley*, 2 Fish. 362; S. C. 5 Blatch. 134.

The manufacturer and the party who sells the alleged infringement of the thing patented, may be sued jointly, although they act independently. *Buck v. Cobb*, 9 Law Rep. 545.

The lessor and lessee of a machine may be joined as parties defendant. *Jacques v. Wells*, 5 O. G. 364.

The officer of a corporation who made a contract in its behalf to allow another to use an infringing machine, may be made a party defendant with the infringer. *Nichols v. Pearce*, 7 Blatch. 5.

A bill may be maintained against the directors of a corporation who have the management and superintendence of the business, and under whose direction the patented articles are manufactured and sold. *Goodyear v. Phelps*, 3 Blatch. 91.

If the bill is filed against one director alone, it ought to appear that he has the power to direct the use or disuse of the patented machine. *Jones v. Osgood*, 3 Fish. 591; S. C. 6 Blatch. 435.

If one does not in person perform the work, but procures another to do it for his advantage on a machine owned by himself, he can still be restrained, and is estopped from denying *qui facit per alium, facit per se*. *Woodworth v. Hall*, 1 W. & M. 248, 389.

It may be that any workman on the machine, though not interested in it, is liable to be restrained in order to prevent evasions by treating all as principals who are aiding. *Woodworth v. Hall*, 1 W. & M. 248, 389; *Boyd v. McAlpin*, 3 McLean, 427.

Possibly if one hires another to do work on a machine he may be restrained. *Woodworth v. Hall*, 1 W. & M. 248, 389.

If the principal and his employees are joined as parties defendant, the bill will be dismissed as to the employees. *Hussey v. McCormick*, 1 Fish. 509; S. C. 1 Biss. 300; *Sargent v. Larned*, 2 Curt. 340.

Parties who are acting in concert in the use of the machine which constitutes the alleged infringement of the complainant's rights, may be joined as parties defendant. The fact that as between themselves they are connected together as the stockholders, managers and servants of a corporation, does not exempt them from the restraints of an injunction. *Poppenhusen v. Falke*, 2 Fish. 181; S. C. 4 Blatch. 493; *Goodyear v. Phelps*, 3 Blatch. 91.

BILL.

It is irregular to entitle the bill in the cause, because until the bill is filed there is no cause pending. An address to the circuit court without the words in equity is sufficient. *Sterrick v. Pugsley*, 1 Cent. L. J. 106.

It is not necessary that the complainant shall deduce his title by setting forth the various assignments. A simple averment that the title to the patent is vested in the complainant, is sufficient. *Nourse v. Allen*, 3 Fish. 63.

A general charge of infringement is all that is necessary to require the defendant to answer the bill, and the particulars of the infringement need not be specified. It would obviously be a very inconvenient practice to require the complainant to set out at length the details of his invention and of the defendant's manufacture. The bill would be very voluminous, and not necessarily more clear or explicit. *Turrell v. Cammerrer*, 3 Fish. 462; *Poppenhusen v. Falke*, 2 Fish. 181; s. C. 4 Blatch. 493.

The bill may allege the character of the improvement and infringement in general terms, without describing the nature of the improvement either in the language of the specifications or in any other way. *Haven v. Brown*, 6 Fish. 413.

If an injunction is applied for, the bill should allege an unquestioned use for some length of time. *Gutta Percha Co. v. Goodyear Rubber Co.* 3 Saw. 542.

Where there has been a thorough trial at law, and a verdict for the patent approved by the court, it is usual and proper to make it the subject of an allegation in the bill. *Doughty v. West*, 2 Fish. 553.

The bill need not allege that the patentee has marked the articles made or vended under the patent as required by the patent law. *Goodyear v. Allyn*, 3 Fish. 374; s. C. 6 Blatch. 33; 1 A. L. T. 94.

If the complainant desires to rely upon a prior judgment at law rendered in his favor against the defendant as matter of estoppel, he should aver the judgment with bill. If no such averment is made, the judgment will not be deemed an estoppel. *Blandy v. Griffith*, 3 Fish. 609.

A bill of complaint by a corporation need not state where the corporation is located or has its place of business. *Nat. Hay Rake Co. v. Harbert*, 2 W. N. 100.

If the claims of several patents appertain to the same general subject, the bill may join them all in the charge of infringement. *Seymour v. Osborne*, 3 Fish. 555; s. C. 11 Wall. 516; *Nourse v. Allen*, 3 Fish. 63.

A complainant who owns several patents, can not charge an infringement of each in one bill, unless he avers that the machine sold by the defendant contains all the improvements embraced in his patents. *Nellis v. McLanahan*, 6 Fish. 286.

If the same article is an infringement of two patents held by the same person, the two causes of action may be joined in the same bill. *Gillespie v. Cummings*, 3 Saw. 259.

If two assignments cover the same territory, a violation of the right conferred by each may be joined in the same bill. *Gillespie v. Cummings*, 3 Saw. 259.

No one but the government, either in its own name or in the name of its appropriate officer, or by some form of proceeding which gives official assurance of the sanction of proper authority, can institute judicial proceedings for the purpose of vacating or rescinding the patent which the government has issued to an individual, except in the cases provided for by the statute. *Mowry v. Whitney*, 5 Fish. 513; s. C. 14 Wall. 434; 1 O. G. 499.

The courts can recognize the United States as a plaintiff on the record only when the record shows that the United States appears as plaintiff by the district attorney for the district in which the suit is brought. The fact that

the suit is instituted on behalf of the United States by the person who is district attorney, and that he acts as such in instituting the suit on behalf of the United States, must appear by the face of the bill or declaration. *U. S. v. Doughty*, 7 Blatch. 424.

An information to repeal a patent should be in the name of the United States, and should be filed by the district attorney in the name and on behalf of the United States. *Att. Gen. v. Rumford Works*, 9 O. G. 1062.

The practice is usually for the complainant to make oath to his bill when it is signed, but this is not imperative or uniform. It is not done if he is absent or indisposed, though it should be done, probably before the hearing, unless it be a bill by a corporation, or unless an answer under oath is not asked, or unless an oath to the bill is waived, or its absence is not objected to by the respondent when first heard. *Woodsworth v. Edwards*, 3 W. & M. 120; *Rogers v. Abbott*, 4 Wash. C. C. 514; *Nat. Hay Rake Co. v. Harbert*, 2 W. N. 100.

If the bill is brought by the patentee and a licensee for the benefit of the licensee, the licensee is the proper party to verify it. *Goodyear v. Allyn*, 3 Fish. 374; s. C. 6 Blatch. 33; 1 A. L. T. 94.

When it appears from the face of the bill that the assignment has never been recorded, the court is bound to take notice of the defect, even though no objection is taken in the pleadings, for it is not the case of a title defectively set forth, but of a title defective in itself. *Wyeth v. Stone*, 1 Story, 273.

If the patent is surrendered while the suit is pending, the action fails, and no remedy can be had for an infringement of a reissue, except by a new suit. *Reedy v. Scott*, 23 Wall. 352; s. C. 7 O. G. 463; *Fry v. Quinlan*, 13 Blatch. 205; *contra*, *Woodworth v. Stone*, 3 Story, 749; *Sarven v. Hall*, 5 Fish. 415; s. C. 9 Blatch. 524; 1 O. G. 437.

If the patent is surrendered after the filing of the bill, it is not necessary that there should be any new breach of the old patent, or any breach of the new patent. The case is not like that of an action at law for the breach of a patent, to support which, it is indispensable to establish a breach before the suit was brought. But in a suit in equity, the doctrine is far otherwise. A bill will lie for an injunction, if the patent right is admitted or has been established, upon well grounded proof of an apprehended intention of the defendant to violate the patent right. A bill *quia timet* is an ordinary remedial process in equity. *Woodworth v. Stone*, 3 Story, 749; *Wheeler v. McCormick*, 4 Fish. 433; s. C. 8 Blatch. 267.

After a bill has been filed in one district for infringements committed in that district, the complainant may file another bill in another district for subsequent infringements. *Wheeler v. McCormick*, 4 Fish. 433; s. C. 8 Blatch. 267; *Penn Salt Co. v. Myers*, 1 W. N. 377.

If the patentee seeks for an injunction on the ground of an infringement, and states nothing about a contract which authorized the use, and such a contract appears by the answer, he must amend his bill before he can impeach the contract. *Hartshorn v. Day*, 3 Fish. 32; s. C. 19 How. 211; *Wilson v. Stolley*, 4 McLean, 275.

Where the rights of the parties under a reissue were in issue under the answer and the replication, the court may allow the bill to be amended, even

after a final decree, by inserting an averment of the reissue. *Tremaine v. Hitchcock*, 23 Wall. 518; s. c. 7 O. G. 1055.

A petition for leave to file a supplemental bill, need not embrace the averment intended to be inserted in the bill, but merely set forth the ground on which the relief is applied for. *Parkhurst v. Kinsman*, 8 N. Y. Leg. Obs. 73.

On an application for leave to file a supplemental bill, the only question is whether the petition states facts and circumstances which, if properly pleaded, would sustain a supplemental bill. *Parkhurst v. Kinsman*, 8 N. Y. Leg. Obs. 73.

A supplemental bill may be filed to bring in a party who has been acting in collusion with the defendant since the filing of the original bill. *Parkhurst v. Kinsman*, 8 N. Y. Leg. Obs. 73.

If, after the filing of the answer, a discovery is sought as to particulars not mentioned in the original bill, a supplemental bill may be filed. *Parkhurst v. Kinsman*, 8 N. Y. Leg. Obs. 73.

A party to whom the complainant has assigned his title since the commencement of the suit, has no interest in an infringement before his right accrued, and a motion by him for leave to file a supplemental bill is a matter in the discretion of the court. *Dean v. Mason*, 20 How. 198.

If the complainant, having surrendered his patent while the action is pending, files a supplemental bill, the irregularity will be deemed to be waived by filing an answer and taking evidence. *Reedy v. Scott*, 23 Wall. 353; s. c. 7 O. G. 463.

A cross bill can only be filed by leave of the court, after due notice to the complainant. *Webster Loom Co. v. Short*, 10 O. G. 1019.

There is no law which authorizes an order of publication on a cross bill against a non-resident complainant. *Webster Loom Co. v. Short*, 10 O. G. 1019.

The question of abandonment of a license can not be raised unless the issue is made by the pleadings, for the proof must correspond with the allegations. *Wilson v. Stolley*, 4 McLean, 275.

Demurrer.

A misjoinder of parties complainant may be taken advantage of by a general demurrer. *Hodge v. Missouri Railroad*, 4 Fish. 161; s. c. 1 Dillon, 104.

Upon a demurrer to a bill of complaint, the court can not act upon the admission of the complainant's counsel. *Perry v. Corning*, 6 Blatch. 134.

Plea.

If a plea of the pendency of a prior suit for the same cause of action, makes a copy of the bill in the prior suit a part thereof, the court will examine the bill as well as the plea. *Wheeler v. McCormick*, 4 Fish. 433; s. c. 8 Blatch. 267.

The filing of two pleas, without special leave given for that purpose, is irregular, and both are liable to be overruled as improperly interposed. *Wheeler v. McCormick*, 4 Fish. 433; s. c. 8 Blatch. 267.

A defense that the complainant is not incorporated, must be pleaded in abatement, and can not be pleaded in bar or given in evidence under the general issue. If the defendant pleads to the merits, he admits the capacity of the complainant to sue, and waives any objection thereto. *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; s. c. 2 Cliff. 555.

If the defendant intends to question the right of an executor or complainant to sue in a representative character, he should do so by a plea or by the answer. If the question is not raised in that way, the objection will not be entertained at the hearing. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

If a defendant omits to set up the non-joinder of other infringers as parties defendant, he must do so by plea or answer, or it will be disregarded at the hearing. *Wallace v. Holmes*, 5 Fish. 37; s. c. 9 Blatch. 65; 1 O. G. 117.

An objection to the jurisdiction of the court is probably too late if it is only made after the answer is put in, the replication filed and the evidence published. *Nesmith v. Calvert*, 1 W. & M. 34.

The setting of a plea down for hearing, is a waiver of any irregularity in the filing of the plea, such as the omission of the certificate of counsel that it is in his opinion well founded in point of law, and of the affidavit of the party that it is not interposed for delay. *Goodyear v. Toby*, 6 Blatch. 130.

In order to constitute the fact of a want of parties a good defense, it must be shown by the plea that the persons alleged to be necessary parties are alive and within the jurisdiction of the court. *Goodyear v. Toby*, 6 Blatch. 130.

If the complainant sets a plea down for argument, he thereby admits the facts therein alleged, and the sufficiency of the plea is the question to be considered. *Wheeler v. McCormick*, 4 Fish. 433; s. c. 8 Blatch. 267.

Answer.

The rules of pleading in chancery require that the defense of a prior invention shall be set up in the answer so as to enable the complainant to meet it. If no such defense is set up, evidence of such prior invention can not be regarded. *O'Reilly v. Morse*, 15 How. 62; s. c. 6 West. L. J. 102; *Geier v. Goettinger*, 7 O. G. 563; *Pitts v. Edmonds*, 2 Fish. 52; s. c. 1 Biss. 168; *Pickering v. Phillips*, 10 O. G. 420; *Howe v. Williams*, 2 Fish. 395; s. c. 2 Cliff. 245; *Orr v. Merrill*, 1 W. & M. 376; *Eureka Co. v. Bailey Co.* 11 Wall. 488; *Jordan v. Dobson*, 4 Fish. 232; s. c. 2 Abb. U. S. 398; 7 Phila. 533; *Forbes v. Barstow Stove Co.* 2 Cliff. 379.

A defense that the invention is not a patentable subject; that is, that it is not a new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, may be made, although it was not set up in the answer. *Guidet v. Barber*, 5 O. G. 149.

When the defense of a prior invention is set up, the settled practice in equity is to require the respondent, as a condition precedent to such a defense, to give the complainant substantially the same information in his answer as is required of a defendant in an action at law. *Agawam Co. v. Jordan*, 7 Wall. 583; *Cook v. Howard*, 4 Fish. 269; *Seymour v. Osborne*, 3 Fish. 555; s. c.

11 Wall. 516; *Collender v. Griffith*, 11 Blatch. 212; s. c. 3 O. G. 689; *Decker v. Grote*, 6 Fish. 143; s. c. 10 Blatch. 331; 3 O. G. 65; *La Baw v. Hawkins*, 6 O. G. 724; *Earl v. Dexter*, 1 Holmes, 412; s. c. 6 O. G. 729; *Brown v. Hall*, 3 Fish. 531; s. c. 6 Blatch. 401; *Graham v. Mason*, 5 Fish. 1.

If the respondent intends to contest the novelty of the invention, his denial in that behalf should be explicit, unqualified, and unconditional. *Graham v. Mason*, 5 Fish. 1.

If there is a general denial that the patentee was the first and original inventor, and a special one, the respondent will be limited to the special one. *Agawam Co. v. Jordan*, 7 Wall. 583; *Middletown Co. v. Judd*, 3 Fish. 141.

If the issue of the novelty of the invention is not raised by the pleadings, evidence to show the state of the art can have no effect on the case beyond the aid it may give the court in construing the patent. *Middletown Co. v. Judd*, 3 Fish. 141; *American Saddle Co. v. Hogg*, 5 Fish. 353; s. c. 1 Holmes, 177; 2 O. G. 595; *La Baw v. Hawkins*, 6 O. G. 724.

If the question of abandonment or surrender is not raised in the answer as a matter of defense, it is not in issue between the parties, and the whole evidence taken on the point is irrelevant and can not be looked to as a matter in judgment. The defect in the pleadings puts the question entirely beyond the reach of the court. *Wyeth v. Stone*, 1 Story, 273.

Evidence that the invention was on sale and in public use for more than two years prior to the application for a patent is not admissible, unless the defense is set up in the answer. *Agawam Co. v. Jordan*, 7 Wall. 583.

An objection to the title of the complainant which is not taken in the answer, or made the subject of examination or inquiry before the examiner, will not be entertained at the hearing. *Grover & Baker S. Co. v. Sloat*, 2 Fish. 112.

Unreasonable neglect or delay in filing a disclaimer can not be set up as a defense, unless it is alleged in the answer. *Burden v. Corning*, 2 Fish. 477.

If the issue that the articles sold by the complainants did not have the word "patented" marked on them, as required by law, is not made by the pleadings, the point can not be raised before the master. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

The objection that a skillful workman can not make the article can not be entertained, unless it is made in the answer. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

A defense which is not set up in the answer can not be relied on at the hearing. *Goodyear v. Providence Rubber Co.* 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

If there has been a trial at law, and the bill charges that the defendant will in future violate the right secured by the patent, unless he is restrained by an injunction, the defendant, in his answer, should distinctly state that he does not intend in future to do the specific things which the court has determined he has no right to do. *Poppenhusen v. Gutta Percha Co.* 2 Fish. 74; s. c. 4 Blatch. 184.

The defendant is in no default by refusing to answer any part of the bill to which he is not specially interrogated, but if the answer responds to the

charges in the bill, it will not be held impertinent. *Brooks v. Ricknell*, 3 McLean, 250.

Evasive answers to specific inquiries, if not positively equivalent to admissions, afford strong presumptive evidence against the respondent. *Agawam Co. v. Jordan*, 7 Wall. 583.

An allegation that a reissue was obtained under false representations should be made in distinct language, without equivocation, and, if relied on at all, should be the subject of very distinct proof. *Doughty v. West*, 2 Fish. 553.

The answer to the charge of infringement should be distinct and unevasive. *Jordan v. Wallace*, 5 Fish. 185; S. C. 8 Phila. 165.

A defense of abandonment and of public use for more than two years before the application for the patent ought not to be blended in the same allegation, as they depend in many respects upon different principles. *Sewall v. Jones*, 6 Fish. 343; S. C. 3 O. G. 630.

If the defendant claims any right under a license, he must show that he has done everything on his part, which in equity he can be required to do, to entitle him to the right asserted. An alleged violation of the contract by the complainant will not help the equity of the defendant, for if he justifies under the license, he must show that he has done all that is necessary to entitle him to its benefit. *Brooks v. Stolley*, 3 McLean, 523.

Where a clause is omitted in an assignment through mistake or accident, the matter thus entitling the party to an amendment of his contract may be set up by way of equitable defense against a proceeding involving the rights of the parties under the instrument, and which would not be maintainable if the clause in question had formed a part of the contract. *Woodworth v. Cook*, 2 Blatch. 151.

Although the strict legal title may be in the complainant, yet if the defendant has an equitable title he may avail himself of it, for a party who asks for equity is bound to do equity. *Day v. Candee*, 3 Fish. 9.

The complainant is entitled to an answer upon oath to all the material allegations of the bill, although he has not annexed any special interrogatories to the bill. *Perry v. Corning*, 6 Blatch. 134.

A motion to file an answer after default is generally addressed to the discretion of the court. Under some circumstances the court, for the purposes of justice, will go great lengths in opening a default and allowing an answer to be filed. *Dean v. Mason*, 20 How. 198.

An objection that the answer does not disclose the names and places of residence of those who had prior knowledge of the thing, and where it had been used, ought in general to be taken by exception, as the defect is the proper subject of amendment. *Graham v. Mason*, 5 Fish. 1.

The issues raised in chancery suits must be raised by the allegations in the bill and answer, and whenever either the bill or answer is defective, the defect must be cured by amendment, and can not be cured by filing special notices. The filing of a notice of special matter is wholly irregular. *Doughty v. West*, 2 Fish. 553.

A paper filed without leave to amend can not be regarded as an amend-

ment to the original answer. *Dental Vulcanite Co. v. Wetherbee*, 3 Fish. 87; S. C. 2 Cliff. 555.

The respondent may be allowed to file a supplemental answer denying the validity of the patent, if the application for leave so to do is made within a reasonable time after he discovers the fact. *Morehead v. Jones*, 3 Wall. Jr. 306.

If the respondent sets up a new defense, he may be compelled to pay the costs that have accrued on the abandoned defense. *Morehead v. Jones*, 3 Wall. Jr. 306.

If the answer admits an infringement, the respondent will not be permitted to file a supplemental answer denying the infringement, unless he alleges a mistake of fact or of law in the answer. *Morehead v. Jones*, 3 Wall. Jr. 306.

An amendment of an answer will not make testimony admissible which was taken under objection before the answer was amended, for the party had a right to rely upon his objection, and elect not to cross-examine or offer rebutting proof. *Roberts v. Buck*, 6 Fish. 325; S. C. 1 Holmes, 224; 3 O. G. 268.

Where the complainant will not be taken by surprise, an amendment of the answer may be allowed upon the terms that the defendant is not to recover costs up to the time of filing it. *Roberts v. Buck*, 6 Fish. 325; S. C. 1 Holmes, 224; 3 O. G. 268.

If the defendant desires to amend his answer, so as to set up the defense that the patented invention was in public use for more than two years before the granting of the patent, he must show something more than that he was guilty of laches in omitting to set it up in the original answer. *Webster Loom Co. v. Higgins*, 9 O. G. 965.

If there is a general averment that the patentee was not the first and original inventor, and he will not be taken by surprise, the defendant may be allowed to amend his answer, even at the final hearing, so as to set up the defense with more particularity. *Brown v. Hall*, 3 Fish. 531; S. C. 6 Blatch. 401.

If the answer omitted to give the proper notice of a prior invention, the court may allow an amendment at the hearing *nunc pro tunc* as of the time the answer was filed. *Roberts v. Ryer*, 6 Fish. 293; S. C. 91 U. S. 150; 11 Blatch. 11; 3 O. G. 550; 10 O. G. 204.

When the defendant, in his answer, admitted an infringement, he will not, after a decree, reference and report of the master, be allowed to amend his answer, so as to deny the infringement, where the admission arose from a want of diligence on his part, or a want of intelligence on the part of his counsel. *Ruggles v. Eddy*, 5 Fish. 581; S. C. 11 Blatch. 524.

Good cause for allowing an amendment of an answer, so as to set up a new defense, is not shown when it appears that the matter of the proposed amendment could with reasonable diligence have been sooner introduced into the answer. *India Rubber Co. v. Phelps*, 4 Fish. 315; S. C. 8 Blatch. 85; *Rumford Chemical Works v. Hecker*, 10 O. G. 289; *Hitchcock v. Tremaine*, 5 Fish. 537; S. C. 9 Blatch. 550; 1 O. G. 633; *Webster Loom Co. v. Higgins*, 13 Blatch. 349.

If the new defense is dependent wholly on parol evidence, the courts hesi-

tate in allowing any practice which may encourage carelessness, negligence or inattention in making answers, or which may leave room for the introduction of testimony manufactured for the occasion. *India Rubber Co. v. Phelps*, 4 Fish. 315; S. C. 8 Blatch. 85.

An answer which is not responsive to the bill is not evidence in favor of the defendant. *Sargent v. Larned*, 2 Curt. 340.

An admission made in the answer, is not waived by the complainant's going into the proofs and otherwise treating it as an open question. It would be subversive of all sound practice, and tend largely to defeat the ends of justice, if the courts should refuse to accept a fact as settled, which is distinctly alleged in the bill and admitted in the answer. *Jones v. Morehead*, 1 Wall. 155.

The proofs and the allegations must correspond. The examination of the case by the court is confined to the issues made by the pleadings. Proofs without the requisite allegations are as unavailing as such allegations would be without the requisite proofs to support them. Objections which are not taken in the answer can not be entertained. *Rubber Co. v. Goodyear*, 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351; *Blandy v. Griffith*, 3 Fish. 609; *Yale Manuf. Co. v. North*, 3 Fish. 279; S. C. 5 Blatch. 455; *Howes v. Nute*, 4 Fish. 263; *Russell Manuf. Co. v. Mallory*, 5 Fish. 632; S. C. 10 Blatch. 140; 2 O. G. 495.

An allegation of a use of the invention with the consent of the patentee, for more than two years prior to the application for a patent, is of no avail unless sustained by proofs. *Seymour v. Osborne*, 3 Fish. 555; S. C. 11 Wall. 516.

Issues for Jury.

The circuit courts have jurisdiction of controversies arising under the patent laws, by direct grant from Congress. They do not merely act as ancillary to a court of law, and do not, therefore, require the patentee to establish his legal right in a court of law, and by the verdict of a jury. *Sanders v. Logan*, 2 Fish. 167.

There is, on account of the judge being the same for the equity and the law hearings, much less reason than in England, for sending questions to a court of law in the federal tribunals. *Brooks v. Norcross*, 2 Fish. 661.

One of the most arduous and daily duties of a court of chancery, is to decide questions of fact, and if it declines to do so, unless in ordinary and adjudged excepted cases, it declines to do what neither the legislature nor the law in chancery has excused it from the responsibility of doing. It has no more power to decline this responsibility, merely because a party requests it, or from timidity as to consequences, or a willingness to avoid labor, than to decline any other duty imposed on it by law. When it may use a jury, then it has the law so settled previously for its vindication, but if it does so in other cases, however desirable to a party or the court itself, it has not the sanction of law, and does not only do wrong to that but to the other parties in the case who oppose the request. *Brooks v. Norcross*, 2 Fish. 651; *Wilson v. Barnum*, 2 Fish. 635; S. C. 1 Wall. Jr. 347; 8 How. 258; *Blanchard v. Reeves*, 1 Fish. 103.

Federal courts of equity under the Constitution and the laws of Congress, have the power of deciding every question of law or fact which may arise in equity suits over which they have complete jurisdiction, and consequently it is not indispensably necessary as a matter of law in any case, that any question in an equity court should be sent to a jury. *Goodyear v. Providence Rubber Rubber Co.* 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Ayling v. Hull*, 2 Cliff. 494; *Goodyear v. Hullihen*, 3 Fish. 251; *Shelly v. Brannan*, 4 Fish. 198; s. c. 2 Biss. 315.

It is not a matter of course to order a feigned issue, but the party applying must lay a foundation for it. A feigned issue is not to be granted, unless the opinion of a jury is found to be needed. *Van Hook v. Pendleton*, 1 Blatch. 187; *Brooks v. Norcross*, 2 Fish. 661.

The practice of sending the parties to law to have the validity of the patent decided, when that is denied in the answer, is founded more on convenience than necessity. It always rests in the sound discretion of the court. A trial at law is ordered by a chancellor to inform his conscience, not because either party may demand it as a right, or that a court of equity is incompetent to judge of questions of fact or of legal titles. The courts do not always consider it a proper exercise of their discretion, to order such issues to be tried at law before granting a final injunction. *Goodyear v. Day*, 2 Wall. Jr. 283; *Goodyear v. Providence Rubber Co.* 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Foote v. Silsby*, 1 Blatch. 545; *Ayling v. Hull*, 2 Cliff. 494; *Cochrane v. Deener*, 11 O. G. 637; s. c. 4 W. L. R. 99.

The general rule is, that an interlocutory order for issues to a jury in an equity suit, will not be made until all the proofs are taken and publication has passed. The reason for the rule is, that such an order should not in general be granted at all where the truth of the facts can be conveniently and satisfactorily ascertained by the court itself, and as that question can not usually be determined in advance of publication, the motion should be deferred to that stage of the controversy. *Goodyear v. Providence Rubber Co.* 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

The court will not order an issue to try the validity of the patent, if it feels no doubt or difficulty which would be removed or confirmed by a verdict. *Goodyear v. Day*, 2 Wall. Jr. 283; *Buchanan v. Howland*, 2 Fish. 341; s. c. 5 Blatch. 151; *Goodyear v. Providence Rubber Co.* 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Ely v. Monson Manuf. Co.* 4 Fish. 64.

• Whether the reissued patent is for the same invention as the original, involves a question of fact. A court of equity has the power to pass upon this or any other facts that may be put in issue by a bill and answer. If the fact is involved in considerable doubt, that may be a reason why it should be sent to a jury. *Poppenhusen v. Falke*, 2 Fish. 181; s. c. 4 Blatch. 493.

When the question whether a reissued patent is for the same invention as the original is intimately connected with inferences to be drawn from the charges in the specification and claim as presented in the reissue, when compared with the original, and the significance of these inferences depends more or less upon the construction to be given to the instrument, there is no occasion for the intervention of a jury for the purpose of determining the fact of

the identity of the inventions described in the old and new patents. *Poppenhusen v. Falke*, 2 Fish. 181; s. C. 4 Blatch. 493.

If the validity of the patent or the fact of infringement is doubtful, the court may at the final hearing order the cause to stand over a reasonable time for the trial of the questions at law. *Muscan Hair Co. v. Am. Hair Manuf. Co.* 4 Fish. 320; s. C. 4 Blatch. 174; *Crosby v. Lapouraille*, Taney, 374.

The court will not direct an issue to try the validity of the patent, after the case has been set down for final hearing on the exhibits and proofs, without any motion or order of the court for such an issue. *Goodyear v. Day*, 2 Wall, Jr. 283.

A motion that the proceedings be stayed until there is a trial at law, or a verdict upon issue framed under the order of the court, ought not in general to be granted, where it appears that a trial at law and a hearing in equity have already been had, and that both have resulted in favor of the complainant. *Howe v. Williams*, 2 Fish. 395; s. C. 2 Cliff. 245.

If a court of equity directs an action at law to be brought to determine the legal right, the declaration may omit a claim for damages, and refer to the suit in equity for an explanation of the omission, in order to prevent a judgment from operating as a bar to an account in that suit. *Knox v. Great Western Q. M. Co.* 3 Saw. 422.

The verdict, when certified from the court to which the issues were sent, is never to be regarded as conclusive, but only as advisory, and may be set aside or even overruled. *Silby v. Foote*, 20 How. 378; s. C. 2 Blatch. 260; *Brooks v. Bicknell*, 4 McLean, 70; *Sickels v. Youngs*, 3 Blatch. 293.

The preponderance of the evidence against the verdict must be striking and clear to authorize a court to order a new trial of an issue sent to be tried at law. The conscience of the chancellor, it is said, must be satisfied. The word conscience here means nothing more than a sacred and legal conviction in the mind of the court that the verdict is not sustained by the evidence. *Brooks v. Bicknell*, 4 McLean, 70.

Motion for Preliminary Injunction.

A motion for an injunction which is in accordance with a special prayer in the bill, is proper. *Orr v. Littlefield*, 1 W. & M. 13; *Goodyear v. Mulley*, 3 Fish. 420.

When an injunction is applied for on the ground of a violation of a right to an invention secured by patent, it is incumbent on the party making the application to swear at the time of making it as to his belief that he is the original inventor. For although when he obtained his patent he might very honestly have sworn to his belief of such being the fact, yet circumstances may have subsequently intervened, or information have been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect. *Sullivan v. Redfield*, 1 Paine, 441; *Rogers v. Abbott*, 4 Wash. C. C. 574.

If the bill alleges that the patentee was the first and original inventor of the thing patented, and is sworn to, a separate affidavit to that fact is not necessary. *Young v. Lippman*, 5 Fish. 230; s. C. 9 Blatch. 277; 2 O. G. 249.

On a motion for a provisional injunction the patentee must rest on the case

stated in the bill. *Cooper v. Mattheys*, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413.

The patentee may file affidavits stating the matters set forth in the bill with more particularity, and referring to collateral matters which explain or tend to support and strengthen it. *Cooper v. Mattheys*, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413.

Either party may take and read the affidavits of other persons. *Cooper v. Mattheys*, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413; *Wickershaff v. Jones*, 2 Whart. Dig. 363.

It is irregular to swear a person in a suit before the bill is filed, and if an affidavit is so entitled it will be excluded. The irregularity consists in having the affidavit sworn to under the title of a suit in which no bill has been filed. If the title is omitted there will be no irregularity. The purpose for which they are intended should be stated in the affidavit. *Baldwin v. Bernard*, 5 Fish. 442; S. C. 9 Blatch. 509 n.; 2 O. G. 320; *Sterrick v. Pugsley*, 1 Cent. L. J. 106.

The proper venue of an affidavit taken before a United States commissioner, is "United States of America, District of ———," naming the district and State for which the commissioner was appointed. It is irregular to give the State and county. *Sterrick v. Pugsley*, 1 Cent. L. J. 106.

A hearing of both parties is contemplated on an application for an injunction. The defendant may, therefore, file an answer before the time for answering expires, and it will have the same effect as any other answer. *Brooks v. Bicknell*, 3 McLean, 250.

If no answer is filed it will be assumed that the facts stated in the bill and not contradicted, are true. *Cooper v. Mattheys*, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413.

The answer of the defendant is considered as an affidavit on a motion for a preliminary injunction. *Cooper v. Mattheys*, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413; *Parker v. Brant*, 1 Fish. 58.

If the answer denies an allegation in the bill, the denial will be taken to be true on a motion for a provisional injunction. *Boyd v. Brown*, 3 McLean, 295.

A mere denial in the answer of all equity in the bill, will not prevent the granting of an injunction. In the case of special injunctions, where affidavits and counter affidavits are produced, it is in the discretion of the court whether to issue the injunction or refuse it. *Orr v. Littlefield*, 2 W. & M. 13; *Parker v. Brant*, 1 Fish. 58.

A general allegation on information and belief in an affidavit by the defendant amounts to nothing. If he has any information sufficient to warrant a belief in the truth of what is stated, he is bound to disclose it for the judgment of the court, if it is to be of any avail to him. He can not swear to the conclusion and withhold the particulars of the information. *Young v. Lippman*, 5 Fish. 230; S. C. 9 Blatch. 277; 2 O. G. 249.

If the complainant alleges that the defendant uses a certain machine, and the defendant does not deny it, this is an admission that he uses such a machine. *Ely v. Monson Manuf. Co.* 4 Fish. 64.

Where there is a charge of infringement, it is in the power of the party charged to bring into court the article that he uses, so that the court can see

what he does use. It is his duty to tell the court what he uses, and to describe it. It is not sufficient to aver vaguely and generally that the article is not an infringement, for that is a question for the court to decide on the facts. *Ely v. Monson Manuf. Co.* 4 Fish. 64.

An affidavit by the solicitor for the defendant that he is advised and believes that the defendant's machine does not infringe the patent, will be disregarded if it gives no reason why the defendant does not himself swear to the dissimilarity of his machine, or why some competent machinist does not do so, and does not point out any dissimilarities. *Conover v. Mers*, 3 Fish. 386.

No affidavit of the defendant, unsupported by other testimony, can be considered as evidence to overthrow any averment in the bill. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413.

On a motion for an interlocutory injunction, the grant of a patent to the defendant has no other effect than as it indicates the opinion which highly respectable and skillful officers have formed on an *ex parte* examination of the case, and is not conclusive. *Wilson v. Barnum*, 2 Fish. 635; s. c. 1 Wall. Jr. 347; 8 How. 258; *Jones v. Merrill*, 8 O. G. 401; *Goodyear Dental Co. v. Evans*, 3 Fish. 390; s. c. 6 Blatch. 121; *Morse Co. v. Esterbrook Co.* 3 Fish. 515; *Sargent Manuf. Co. v. Woodruff*, 5 Biss. 444; *American Pavement Co. v. Elizabeth*, 4 Fish. 189; *Burleigh R. D. Co. v. Lobdell*, 1 Holmes, 450; s. c. 7 O. G. 836; *contra*, *Goodyear v. Dunbar*, 1 Fish. 472; s. c. 3 Wall. Jr. 310.

Affidavits to be used in support of, or in opposition to, special motions, ought always to be served on the opposite counsel a reasonable time before the motion is brought on. Where this is not done the court may reject the affidavits, or, in its discretion, allow the same to be read, giving the opposite party the option to proceed with the hearing, or to take time for the perusal and examination of the affidavits, and production of affidavits in reply. *Sterrick v. Pugsley*, 1 Cent. L. J. 106.

It is not necessary for the defendant to give to the complainant previous notice of his defense. He is entitled to make it by answer and depositions when the motion for an injunction is brought on for a hearing. *Day v. Car Spring Co.* 3 Blatch. 154.

If the complainant desires to file counter affidavits, the hearing may be postponed. *Day v. Car Spring Co.* 3 Blatch. 154.

The patentee may file additional affidavits contradicting any statements made by the defendant in his affidavit. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413; *Goodyear v. Muller*, 3 Fish. 420; *Union Paper Bag Co. v. Binney*, 5 Fish. 166; *Day v. Car Spring Co.* 3 Blatch. 154.

Affidavits which do not refer to title may be offered in support of the bill, and in contradiction of the answer. *Brooks v. Bicknell*, 3 McLean, 250.

The complainant can not file additional affidavits which are not in reply to the defendant's case. *Union Paper Bag Co. v. Binney*, 5 Fish. 166.

If the proof of the infringement is not satisfactory, the court may suspend the motion to allow the evidence to be supplied. *Hodge v. Railroad Co.* 3 Fish. 410; s. c. 6 Blatch. 85.

If the patentee does not by counter affidavits deny the statements of the defendant, such facts are assumed to be true. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413.

The defendant can not by further proof on his part reply to rebutting evidence. This is alike the rule at law and in equity. No court permits a defendant to make a new defense to proofs or arguments made in reply to his own. He has one hearing or chance alone, and must abide the advantage placed in the hands of the complainant. *Day v. Car Spring Co.* 3 Blatch. 154.

When evidence is not accessible at the time when the complainant's case is made up, the order of proof may be varied on suitable terms, giving the defendant an opportunity to answer the new matter. *Union Paper Bag Co. v. Binney*, 5 Fish. 166.

If the bill or affidavits state any fact not denied in the affidavits filed by the defendant, such fact is assumed to be true. *Cooper v. Mattheys*, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413; *Wells v. Gill*, 6 Fish. 89; S. C. 2 O. G. 590.

Upon a motion for a preliminary injunction, the court will decline to decide the question of infringement, upon a mere inspection of the machines without other evidence, if they are complicated in their structure. *Howe v. Morton*, 1 Fish. 586; *Cooper v. Mattheys*, 5 Penn. L. J. 38; S. C. 8 Law Rep. 413; *U. S. Annunciator Co. v. Sanderson*, 3 Blatch. 184.

Upon a motion for a preliminary injunction, a new patent granted upon a surrender of the old one must be taken *prima facie* to be for the same invention as the old patent. *Woodworth v. Stone*, 3 Story, 749.

A voluntary appearance and the filing of an answer is a waiver of any informality in the service of the notice of a motion for a provisional injunction. *Brammer v. Jones*, 3 Fish. 340; S. C. 2 Bond, 100.

If a demurrer is filed, it should be first heard and disposed of before the merits of the application for an injunction are considered. *Woodworth v. Edwards*, 3 W. & M. 120.

The motion for a provisional injunction is heard in a summary way upon *ex parte* affidavits. A summary hearing is had upon a necessity more or less urgent for the immediate interposition of the court, and it is presumed that there is not time for that full and thorough investigation which is to be made upon the final hearing, where the witnesses can be subjected to cross-examination, and the process of the court may be used to compel the attendance of the witnesses and the production of evidence. *Grover & Baker S. Co. v. Williams*, 2 Fish. 133; *Day v. Boston Belting Co.* 16 Law Rep. 330.

Prior Suit.

An injunction when asked before the trial and resisted, is never to issue as a matter of course till the trial. There must in such case, in order to obtain it in advance, be proof not only of a patent, but also of some length of use under it, or some considerable sales of it, or some recovery establishing the validity of the patent, so as to impart to it weight or strength as valid beyond the mere issue of it. *Hovey v. Stevens*, 1 W. & M. 290; *Isaacs v. Cooper*, 4 Wash. C. C. 259.

The provisional injunction may be refused, if the complainant does not aver any prior adjudication in his bill to support the application. *Parker v. Brant*, 1 Fish. 58.

If the bill omits to aver a prior adjudication it may be amended and the injunction then issued. *Parker v. Brant*, 1 Fish. 58.

There is no necessity that the validity of a patent should be established by a trial at law, when there is no sufficient denial of the invention in the answer. *Sickels v. Mitchell*, 3 Blatch. 548.

If the validity of the patent has not been established on a trial either at law or in equity, and the exclusive right which the patent purports to grant has not been acquiesced in by the public, the right of the patentee must be clear and free from doubt, and the infringement must be equally clear. *North v. Kershaw*, 4 Blatch. 70.

If the results of the previous trials have been conflicting, and there is a strong denial of the originality of the invention in the affidavits, the provisional injunction will be refused. *Allen v. Sprague*, 1 Blatch. 567; *Batten v. Silliman*, 3 Wall. Jr. 124; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133.

The force of a recovery goes upon the ground that the patentee does not sleep over his claim or interests so as to mislead others, and that whenever the validity of his claim has been tried he has sustained it as if good. *Orr v. Littlefield*, 1 W. & M. 13.

Formerly it was generally the practice of the courts, in adjudicating upon patents, when there was a seriously disputed question of fact, to send the matter to a jury; but lately the tendency of the courts has been to consider the cases themselves upon full proof, instead of sending them to a jury. The decision of a competent court, accustomed to the investigation of facts in relation to matters of art and science, is more satisfactory than the verdict of a jury. There is usually a great mass of evidence. Many of the jurors are not accustomed to such investigations, their minds become fatigued, their recollection of the testimony imperfect, and few, if any, take minutes of the evidence. Hence the mere fact that a jury has not passed upon the case will not have much weight, if in other respects the injunction ought to issue. *Potter v. Fuller*, 2 Fish. 251; *Potter v. Muller*, 2 Fish. 465.

If the prior adjudications were rendered upon a different construction of the patent from that claimed in the pending suit, they will not authorize an injunction. *Mowry v. Railroad Co.* 5 Fish. 587; s. c. 10 Blatch. 89.

Where a trial at law has been had, resulting in a verdict in favor of the patentee, and the right to the improvement patented has been fully established to the satisfaction of the court, and the infringement of right made clear, such a trial resulting in such a verdict is sufficient, without any other proof, to authorize the court to grant an injunction to prevent any future violation of right. Such a trial, with such a result, affords sufficient proof that in future there will be an infringement, unless such infringement is restrained by injunction. It is under such circumstances almost a matter of course that the injunction should be allowed. *Sickles v. Tileston*, 4 Blatch. 109; *Parker v. Brant*, 1 Fish. 58; *Orr v. Badger*, 7 Law Rep. 465; *Poppenhusen v. Gutta Percha Comb Co.* 2 Fish. 74; s. c. 4 Blatch. 184; *Potter v. Muller*, 2 Fish. 465; *Potter v. Stevens*, 2 Fish. 163; *Potter v. Fuller*, 2 Fish. 251; *Orr v. Littlefield*, 1 W. & M. 13; *Potter v. Whitney*, 3 Fish. 77; s. c. 1 Lowell, 87; *Putnam v. Weatherbee*, 1 Holmes, 497; s. c. 8 O. G. 320; *Goodyear v. Hullihen*, 3 Fish. 251; *Jones v. Merrill*, 8 O. G. 401; *Thompson v. Mendelsohn*, 5 Fish. 187;

s. c. 8 Phila. 166; *Robertson v. Hill*, 6 Fish. 465; s. c. 4 O. G. 132; *American Shoe Co. v. National Shoe Co.* 11 O. G. 740; *U. S. & F. Felting Co. v. Asbestos Felting Co.* 10 O. G. 828.

A judgment given on verdict and default under an agreement, if not collusive, is as strong, if not stronger evidence of the patentee's rights than it would have been if the claim were so doubtful as to be sent to a jury for decision, rather than so little doubtful as to be admitted or agreed to after being legally examined. *Orr v. Littlefield*, 1 W. & M. 13; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133; *Potter v. Fuller*, 2 Fish. 251.

An interlocutory injunction will not be granted if the verdicts establishing the complainant's title have been obtained on inconsistent and contradictory claims, so that the court can not say with certainty what is or what is not an infringement of the patent. *Parker v. Sears*, 1 Fish. 93.

The fact that a bill of exceptions has been taken upon points which involve the validity of the patent does not present an insuperable objection to the granting of a provisional injunction. The court is bound to exercise its own judgment upon the questions involved in the bill of exceptions, with a view to see whether the litigation that remains presents such serious doubts concerning the title as ought to influence its judgment in granting or withholding the injunction. *Furbush v. Bradford*, 1 Fish. 317; s. c. 21 Law Rep. 471; *Wells v. Gill*, 6 Fish. 89; s. c. 2 O. G. 590; *Morris v. Lowell Manuf. Co.* 3 Fish. 67; *Hartshorn v. Day*, 3 Fish. 32; s. c. 19 How. 211.

A prior adjudication in a suit against other parties is not conclusive, but the considerations which would justify the court on a motion for a provisional injunction in renewing the discussion of a patentee's title after solemn hearing and judgment at law, must be such as if presented to his view after a trial at law would induce him to set aside a verdict. *Parker v. Brant*, 1 Fish. 58; *Thayer v. Wales*, 5 Fish. 130; s. c. 9 Blatch. 170; *American Pavement Co. v. Elizabeth*, 4 Fish. 187; *Wells v. Gill*, 6 Fish. 89; s. c. 2 O. G. 590; *Tilghman v. Mitchell*, 4 Fish. 615; s. c. 9 Blatch. 18.

If the trial at law has not been satisfactory, an injunction will be denied. *Day v. Hartshorn*, 3 Fish. 32.

If the defendant contributed toward the expenses of defending the prior suit, the injunction will be allowed, although he alleges that he can produce additional witnesses to testify to a fact which was in controversy in such prior suit. *Birdsell v. Manuf. Co.* 6 O. G. 604.

A party who voluntarily assumes the position of infringing an existing patent after a decision of the court in another case sustaining its validity, can not allege that any particular hardship attends his case when the court decides that the apparent title of the patentee is such that he must refrain from further infringing until he has proved the invalidity of the patent on a trial at law. *Sargent v. Seagrave*, 2 Curt. 553.

A decision on a motion for an attachment is not sufficient to warrant a preliminary injunction where the infringement is positively denied, without reference to the facts proven in the case. *Sargent Manuf. Co. v. Woodruff*, 5 Biss. 444.

The decree of a court of chancery is more persuasive evidence than the verdict of a jury. *Goodyear v. Muller*, 3 Fish. 420.

If there has been no action at law nor length of possession, the injunction will be refused if the injury would not be irreparable. *Earth Closet Co. v. Fenner*, 5 Fish. 15.

Prior Use.

If the validity of the patent has not been established by an action at law, a preliminary injunction will not be granted unless there has been an exclusive possession of some duration under it. *Sullivan v. Redfield*, 1 Paine, 441; *Hockhoizer v. Eager*, 2 Saw. 361; *Isaacs v. Cooper*, 4 Wash. C. C. 259; *Toppan v. Nat'l Bank Note Co.* 2 Fish. 195; s. C. 4 Blatch. 509; *Brown v. Hinkley*, 6 Fish. 370; s. C. 3 O. G. 384; *Jones v. Field*, 12 Blatch. 494.

The ground on which acquiescence is important is that it shows exclusive possession, which if it has been of long standing, open and notorious, is a clear foundation of a presumption of title. It is not always, however, so satisfactory as positive adjudications, because it may have arisen from the comparatively small commercial value of the invention, and in that case shows only that no one has thought it worth infringing. *Potter v. Whitney*, 3 Fish. 77; s. C. 1 Lowell, 87; *Toppan v. Nat'l Bank Note Co.* 2 Fish. 195; s. C. 4 Blatch. 509; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133.

If the possession and use under a patent has been of sufficient duration and exclusiveness, it may be the foundation of an interlocutory injunction. *Goodyear v. Central R. R. Co.* 1 Fish. 626; s. C. 2 Wall. Jr. 356; *Foster v. Moore*, 1 Curt. 279; *American Shoe Co. v. National Shoe Co.* 11 O. G. 740; *Washburn v. Gould*, 3 Story, 122; *Ogle v. Ege*, 4 Wash. C. C. 584; *Howe v. Newton*, 2 Fish. 531; *Sargent v. Carter*, 1 Fish. 277; *Woodworth v. Sherman*, 3 Story, 171; *Morse Co. v. Esterbrook Co.* 3 Fish. 515.

If the bill does not aver that the patentee has ever sold or used his improvement, the motion will be denied. *Isaacs v. Cooper*, 4 Wash. C. C. 259.

If the motion is refused because the bill does not aver that the patentee has ever sold or used his improvement, the bill may be amended. *Isaacs v. Cooper*, 4 Wash. C. C. 259.

When possession for some years has existed, or numerous sales or recoveries have occurred, the court will not refuse an injunction, or dissolve it on a denial of the validity of the patent by a respondent, either through affidavits or an answer, or other pleadings. *Hovey v. Stevens*, 1 W. & M. 290; *Cook v. Ernest*, 5 Fish. 396; s. C. 1 Woods, 195; 2 O. G. 89; *Brooks v. Bicknell*, 3 McLean, 250; *Gibson v. Betts*, 1 Blatch. 163; *Woodworth v. Rogers*, 3 W. & M. 135; *Hussey v. Whiteley*, 2 Fish. 120; s. C. 1 Bond, 407.

Mere lapse of time is not sufficient to show a public recognition of the patentee's claim. The acquiescence in the patent must be attended with circumstances indicating that such acquiescence would not have occurred if any fair doubt had existed as to the validity of the patent. *Guidet v. Palmer*, 6 Fish. 82; s. C. 10 Blatch. 217.

In order to raise a presumption in favor of the patent, the use prior to the application therefor must be public under an avowed claim of a right to a patent. Otherwise there is no exclusive possession as against the public, and no claim in which the public can acquiesce. A secret use prior to the application for a patent will not, therefore, be taken into account on a motion for a provisional

injunction. *Toppan v. Nat'l Bank Note Co.* 2 Fish. 195; S. C. 4 Blatch. 509.

Exclusive possession and sales made between the date of the invention and the application for a patent may be considered. *Sargeant v. Seagrave*, 2 Curt. 553.

The possession must be sufficient to justify a presumption in favor of the validity of a patent. *Potter v. Muller*, 2 Fish. 465.

Injunctions are granted without a previous trial at law, in cases where the owner of the patent shows a clear case of infringement, and has been in the possession and enjoyment of the exclusive right for a term of years, without any successful impeachment of its validity. Such possession and enjoyment, aided by the presumptions arising from the patent itself, are usually regarded as sufficient to warrant an injunction to restrain an infringement. *Potter v. Muller*, 2 Fish. 465; *Miller v. Androscoggin Pulp Co.* 5 Fish. 340; S. C. 1 Holmes, 142; 1 O. G. 409; *Parker v. Brant*, 1 Fish. 58.

A sufficient possession will warrant a provisional injunction even where great doubt is felt concerning the validity of the patent. *Sargeant v. Seagrave*, 2 Curt. 553.

It is not possible to fix any precise term of years during which the exclusive possession must have continued. The reason for the presumption in favor of the validity of the grant, is the acquiescence of the public in the exclusive right of the patentee, which, it may reasonably be assumed, would not exist unless the right was well founded. It is obvious that this public acquiescence is entitled to more or less weight according to the degree of utility of the machine and the number of persons whose trade or business is affected by it. *Foster v. Moore*, 1 Curt. 279; *Sargeant v. Seagrave*, 2 Curt. 553.

The courts have seldom refused an injunction on account of the shortness of the time after the grant, however brief, if long enough to permit articles or machines to be constructed by the patentee in conformity with his claim, and to be sold publicly and repeatedly, and they have been so sold and used under the patent without dispute. *Orr v. Littlefield*, 1 W. & M. 13; *Potter v. Muller*, 2 Fish. 465.

The shortest term of use is three years, and in most of the cases the time has been several years longer. *Hovey v. Stevens*, 1 W. & M. 290.

It is not necessary that the possession shall have been undisturbed. *Cook v. Ernest*, 2 Fish. 396; S. C. 1 Woods, 195; 2 O. G. 89.

An unsuccessful attempt to interrupt a possession, strengthens the presumption that arises from it. It tends to show that persons who have found it for their interest to question the right, have questioned it, and for a time have refused to submit to it, but, on inquiry, have submitted. Such submission is the most persuasive kind of acquiescence. *Sargeant v. Seagrave*, 2 Curt. 553.

Each case must depend on its own circumstances. Those circumstances are the extent of the use or sales by the patentee, the degree of utility of the invention, and the number of persons whose business is affected by it, and who are interested to question the exclusive right. *Sargeant v. Seagrave*, 2 Curt. 553.

The time of the possession in case of a reissue, is to be computed from

the date of the original issue or grant. *Orr v. Littlefield*, 1 W. & M. 13; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133; *Orr v. Badger*, 7 Law Rep. 465.

A preliminary injunction will not be granted when the defendant has been in possession and use of the invention for a long period of time adverse to the title of the complainant and under claim and color of right. *Hall v. Spier*, 6 Pitts. L. J. 403; *Isaacs v. Cooper*, 4 Wash. C. C. 259.

Where possession alone is relied on as a basis for a motion for a preliminary injunction, the infringement must be palpable. *Burleigh Drill Co. v. Lobdell*, 1 Holmes, 450; s. c. 7 O. G. 836.

Preliminary Injunction.

It is not a matter of course to grant an injunction upon the mere exhibition of the patent, and an allegation that it has been infringed. The patent may be, upon a trial at law, *prima facie* evidence of the right, but in order to warrant an interference by injunction, there ought to be but little if any doubt as to the validity of the patent. *Sullivan v. Redfield*, 1 Paine, 441; *Thomas v. Weeks*, 2 Paine, 92; *Isaacs v. Cooper*, 4 Wash. C. C. 259; *Serrell v. Collins*, 4 Blatch. 61.

The power to grant an injunction has existed from the early ages of chancery jurisdiction, and is remedial and useful as a preventative of injury and a multiplicity of suits, when it is properly exercised. An injunction is intended to aid or protect what seems to be a legal title. It is granted for this purpose when issued before a trial on presumptive evidence offered of such a title. It does not delay or retard a trial, but makes the *prima facie* title prevail till then. *Woodworth v. Rogers*, 3 W. & M. 135; *Orr v. Littlefield*, 1 W. & M. 13; *Buck v. Cobb*, 9 Law Rep. 545.

The issuing of an interlocutory injunction is always a matter of discretion with the court, and depends on the peculiar circumstances of each case. *Parker v. Sears*, 1 Fish. 93; *Earth Closet Co. v. Fenner*, 5 Fish. 15; *Potter v. Davis Sewing Machine Co.* 3 Fish. 472; *Goodyear v. Rust*, 3 Fish. 456; s. c. 6 Blatch. 229; *Potter v. Crowell*, 3 Fish. 112; s. c. 1 Abb. U. S. 89; *Irwin v. Dane*, 4 Fish. 359; s. c. 2 Biss. 442.

The right of a party to the most speedy and effectual protection against a meditated wrong, is as complete as his right to redress for wrongs already inflicted, and the accident of position confers no right on one party, whether he be plaintiff or defendant, at the expense of the other. The special injunction of equity may be abused to the injury of an opponent, but it is no less on that account the duty of the judge to grant it when in the exercise of his best discretion, he believes that it is called for by the merits and exigency of the case. *Smith v. Mercer*, 5 Penn. L. J. 529; s. c. 4 West. L. J. 49; *Hussey v. Whiteley*, 2 Fish. 120; s. c. 1 Bond, 407; *Potter v. Muller*, 2 Fish. 465; *Goodyear v. Schenck*, 3 Fish. 82; *Hodge v. Hudson River R. R. Co.* 6 Blatch. 165.

In acting on applications for a provisional injunction, there is much latitude for discretion. The application may be granted or refused unconditionally, or terms may be imposed on either of the parties as conditions for

making or refusing the order. The state of the litigation where the patentee's title is denied, the nature of the invention, the character and extent of the infringement complained of, and the comparative inconvenience which will be occasioned to the respective parties by allowing or denying the motion, must all be considered in determining whether it shall be allowed or refused, and if at all, whether absolutely or upon some and what conditions. *Furbush v. Bradford*, 1 Fish. 317; S. C. 21 Law Rep. 471; *Hodge v. Hudson River R. R. Co.* 6 Blatch. 165.

The court will regard the comparative expense and inconvenience to which the parties will be subjected in case of granting the injunction on the one hand or withholding it on the other, and if the effect of granting an injunction will be very injurious and the refusal will subject the complainant to a comparatively slight inconvenience, the preliminary injunction will be refused. *Hockholzer v. Eager*, 2 Saw. 361; *Parker v. Sears*, 1 Fish. 93; *Bliss v. Brooklyn*, 4 Fish. 596; S. C. 8 Blatch. 533; *Furbush v. Bradford*, 1 Fish. 317; S. C. 21 Law Rep. 471; *Gear v. Holmes*, 6 Fish. 595; *Goodyear v. Dunbar*, 1 Fish. 472; S. C. 3 Wall. Jr. 310; *Morris v. Lowell Manuf. Co.* 3 Fish. 67; *Dorsey R. H. Rake Co. v. Bradley Manuf. Co.* 12 Blatch. 202.

Where an injunction would be disastrous to the defendant, and of no advantage to the complainant, it will not be granted if the defendant will file a bond with proper security to secure to the complainant the profits and damages which may be ultimately awarded. *Dorsey Co. v. Marsh*, 6 Fish. 387; S. C. 9 Phila. 395; *Morris v. Shelbourne*, 4 Fish. 377; S. C. 8 Blatch. 266.

There is not much force in the objection that an injunction would produce irreparable injury if it merely prohibits the sale of articles which are manufactured elsewhere. *Potter v. Fuller*, 2 Fish. 251.

If the injunction leads to serious injury in suspending works, the court can require security of the complainant to indemnify for it if the patent is avoided. *Orr v. Littlefield*, 1 W. & M. 13; *Morse v. O'Reilly*, 6 West. L. J. 102.

There is no power, the exercise of which is more delicate, which requires greater caution, deliberation and sound discretion, or is more dangerous in a doubtful case, than the issuing of an injunction. It is the strong arm of equity that never ought to be extended unless to cases of great injury, where courts of law can not afford an adequate or commensurate remedy in damages. The right must be clear, the injury impending or threatened. An injunction will be refused till the court is satisfied that a right is about to be destroyed or irreparably injured, or that great and lasting injury is about to be done by an illegal act. *Hall v. Speer*, 6 Pitts. L. J. 403.

The responsibility of the defendant for any profits or damages that may be decreed against him is a material circumstance. *Morris v. Lowell Manuf. Co.* 3 Fish. 67; *Guidet v. Palmer*, 6 Fish. 82; S. C. 10 Blatch. 217.

Where the validity of the patent is fully established, and the infringement is clear, a party has a right to protection by injunction, although it may cause great injury to the infringer. *Potter v. Fuller*, 2 Fish. 251.

If no special damage will result to the defendant or his business, the injunction will be granted. *Howe v. Newton*, 2 Fish. 531.

It is too much for a defendant in a clear case, to insist upon having the privilege of using a patented invention, for the reason that he is able to pay

the damages that may be awarded against him at the end of a protracted litigation to ascertain their amount. The patentee may not be as able to prosecute a suit as the defendant is to defend. The inconvenience which may result from an injunction, does not in such a case afford sufficient ground for withholding it. *Sickels v. Mitchell*, 3 Blatch. 548.

In most cases, an injunction will not be granted until the right of the complainant has been established at law; but where the injury would be irreparable, an injunction will be granted. The infringement of a patent constitutes an exception to the general rule. *Brooks v. Bicknell*, 3 McLean, 250.

If the defendant has little or no property, and can not pay the damages which might be recovered against him for an infringement of the patent, the injury would be irreparable. *Brooks v. Bicknell*, 3 McLean, 250; *Goodyear v. Mullee*, 3 Fish. 420.

If more injury may result to the complainant from a refusal of the injunction than to the defendant by granting it, the injunction will be granted. *Irwin v. Dane*, 4 Fish. 359; S. C. 2 Biss. 442.

Damage that may result from the groundless fears of others, is no ground for refusing a preliminary injunction. *Rumford Chemical Works v. Vice*, 11 O. G. 600.

The court, as a condition for allowing an injunction, may require that the complainant shall give bond to indemnify the defendant in the event that the right of the complainant shall not be sustained upon the final hearing. *Brammer v. Jones*, 3 Fish. 340; *Shelly v. Brannan*, 4 Fish. 198; S. C. 2 Biss. 315.

Upon granting an injunction, the court may direct that unless a suit is brought at the next term to try the legal title, the injunction shall then be dissolved. *Woodworth v. Rogers*, 3 W. & M. 135; *Orr v. Merrill*, 1 W. & M. 376; *Serrell v. Collins*, 4 Blatch. 61; *Orr v. Littlefield*, 1 W. & M. 13; *Rogers v. Abbott*, 4 Wash. C. C. 514.

The granting of an injunction being a matter entirely within the discretion of the court, it is for the court to say whether the rights of the complainant are so clear that he ought to be protected by injunction, or whether they are not so clear but that he may be made secure by sufficient guaranties by bond and security. *Ely v. Monson Manuf. Co.* 4 Fish. 64.

The defendant can not have the injunction stayed upon giving bond, with security, to the patentee for his damages when the infringement is clear and the right to the injunction manifest. *Tracy v. Torrey*, 2 Blatch. 275; *Tilghman v. Mitchell*, 4 Fish. 615; S. C. 9 Blatch. 18; *Gibson v. Van Dresar*, 1 Blatch. 532; *Conover v. Mers*, 3 Fish. 386; *Consolidated Fruit Jar Co. v. Whitney*, 31 Leg. Int. 229; *Ely v. Monson Manuf. Co.* 4 Fish. 64.

The decree for an injunction may provide for its dissolution on the defendant's giving bond with security to account to the patentee should his right be finally established. *Brooks v. Bicknell*, 3 McLean, 250; *Foster v. Moore*, 1 Curt. 279; *Gilbert & Barker Manuf. Co. v. Bussing*, 12 Blatch. 426; *Howe v. Morton*, 1 Fish. 586; *Jones v. Merrill*, 8 O. G. 401; *Furbush v. Bradford*, 1 Fish. 317; S. C. 21 Law Rep. 471; *U. S. Annunciator Co. v. Sanderson*, 3 Blatch. 184; *Stainthorp v. Humiston*, 2 Fish. 311; *Goodyear v. Hills*, 3 Fish. 134; *American Pavement Co. v. Elizabeth*, 4 Fish. 189; *Goodyear v. Honsinger*, 3 Fish. 147; S. C. 2 Biss. 1; *Sykes v. Manhattan Co.* 6 Blatch. 496.

If the court refuses a provisional injunction upon condition that the defendant file with the clerk a monthly account of all articles manufactured and sold by him, an account giving such a description of the articles as is sufficient to enable persons in the trade to determine the value or price of them in the market, is a compliance with the order, although the prices and the names of the purchasers are not stated. *Wilder v. Gaylor*, 1 Blatch. 511.

The court may refuse an injunction if the defendant will pay a reasonable license fee to the complainant and accept a license. *Hodge v. Hudson River R. R. Co.* 6 Blatch. 165.

If the defendant's machine contains a valuable improvement which is not contained in the patent, the court may provide that if the defendant will file a bond to account for the profits, an injunction shall not issue. *Stainthorp v. Humiston*, 2 Fish. 311.

A provisional injunction is always refused if upon the facts presented there is a fair doubt whether the defendant has infringed. *Dodge v. Card*, 2 Fish. 116; s. C. 1 Bond, 393.

If the defendant shows a belief that he has a just defense, and is not a willful pirate of the patentee's invention, it should be a case of evident mistake of law or fact, or both, in the defense which he sets up which will justify the court in granting an injunction. *Goodyear v. Dunbar*, 1 Fish. 472; s. C. 3 Wall. Jr. 310; *Batten v. Silliman*, 3 Wall. Jr. 124.

It is not enough to authorize the granting of an injunction that the complainant has taken out a patent, and thus obtained a public grant and the sanction or opinion of the patent office in favor of his right. There must be something stronger than the mere issue, for in that there is no opposing party, no notice and no trial with any one of his rights. *Orr v. Littlefield*, 1 W. & M. 13; *Tappan v. Nat'l Bank Note Co.* 2 Fish. 195; s. C. 4 Blatch. 509; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133.

If the complainant's invention is merely an improvement upon a prior patent, the fact that he is infringing such prior patent can not affect the motion for an injunction. The case of each patentee must be treated separately on its merits when presented. *Young v. Lippman*, 5 Fish. 230; s. C. 9 Blatch. 277; s. C. 2 O. G. 249.

If a party who has been using a machine sells his interest prior to the filing of the bill, an injunction will not be granted against him. *Brammer v. Jones*, 3 Fish. 340; s. C. 2 Bond, 100.

A writ of injunction is to act as a remedy against a threatened wrong by preventing the commission of such wrong, and it is not necessary before a writ to prevent a wrong can issue that the wrong should actually have been committed. If it were, the remedy by injunction would be a very inadequate one. If the rights of a party under a patent have been fully and clearly established, and an infringement of such rights is threatened; or if, when they have been infringed, the party has good reason to believe they will continue to be infringed, an injunction will issue. *Poppenhusen v. Gutta Percha Co.* 2 Fish. 74; s. C. 4 Blatch. 184.

No interlocutory injunction should issue, unless the complainant's title and the defendant's infringement are admitted, or are so palpable and clear that the court can entertain no doubt on the subject. The court is not bound, in

this stage of the cause, to decide doubtful and difficult questions of law, or disputed questions of fact, nor exercise this high and dangerous power in doubtful cases, before the alleged offender has an opportunity of a full and fair hearing. *Parker v. Sears*, 1 Fish. 93; *Sickels v. Youngs*, 3 Blatch. 293; *Jones v. Osgood*, 3 Fish. 591; s. c. 6 Blatch. 435; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133; *American Pavement Co. v. Elizabeth*, 4 Fish. 189.

Cases often occur where the answer or affidavits are equivocal or evasive, or disclose a state of facts which show that the conclusions drawn from them are clearly erroneous and founded on a mistake of the law, as when an infringement is denied and a model admitted which shows a palpable infringement, and it is evident that the denial is made under a gross mistake of the true and settled construction of the patent, or where the originality of the invention is denied in general terms, and infringement is admitted, and the patent has been fully established at law, and it is evident that the denial of its validity is but a matter of obstinate opinion, or a mistake of law. Such cases, and only such, can be considered as exceptions to the general rule. *Parker v. Sears*, 1 Fish. 93.

If the defendant admits the infringement, but asserts that after notice or service of the injunction he refrained from the use of the thing patented, and asserts that he will not afterwards infringe, it is no reason why an injunction should not issue and be made perpetual. The complainant, in such a case, is not obliged to rest his interests on the mere asseveration of the party that he will not repeat the act of infringement. Having once been a wrong-doer the law supposes the probability of his being so again, and will impose the proper restraint to prevent the repetition of the wrongful act. *Jenkins v. Greenwald*, 2 Fish. 37; s. c. 1 Bond, 126; *Potter v. Crowell*, 3 Fish. 112; s. c. 1 Abb. U. S. 89; *Goodyear v. Berry*, 3 Fish. 439; s. c. 2 Bond, 1; *Rumford Chemical Works v. Vice*, 11 O. G. 600.

The usual practice is to postpone the consideration of difficult or doubtful points till the final hearing of the cause, and not to decide the whole merits of a cause on a mere preliminary motion. *Goodyear v. Central R. R. Co.* 1 Fish. 626; s. c. 2 Wall. Jr. 356; *Hovey v. Stevens*, 1 W. & M. 290; *Jones v. Hodges*, 1 Holmes, 37; *Livingston v. Van Ingen*, 1 Paine, 45; s. c. 4 Am. L. J. 56; *Winans v. Eaton*, 1 Fish. 181; *Smith v. Selden*, 1 Blatch. 475; *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. c. 8 Law Rep. 413.

When the objection relates to the technical form or signature of papers connected with the letters patent, and the doubts arise from acts of public officers, and not any neglect or wrong of the patentee, the injunction should not be dissolved. More especially should an injunction once granted not be disturbed for such doubts, when the term for trial of the merits is near. *Woodworth v. Hall*, 1 W. & M. 389.

To warrant the exercise of the extraordinary power of the court in granting a preliminary injunction, the case presented should be free from ambiguity or confusion. Especially should this rule be applied to a case where the alleged infringement is in the disputed territory that lies between the limits fixed by the original patent and those fixed by the reissued patent, for whatever of difficulty or uncertainty there may be arising out of the difference between the two specifications, is the fault or misfortune of the patentee, and not of

the respondent, and should be borne by the former, and not the latter. *Poppenhusen v. Falke*, 2 Fish. 181; S. C. 4 Blatch. 493.

The existence of a substantial doubt as to the question of identity of the inventions described in a reissued patent and the original, is a proper ground for refusing to grant a preliminary injunction. *Poppenhusen v. Falke*, 2 Fish. 181; S. C. 4 Blatch. 493; *Grover & Baker S. Co. v. Williams*, 2 Fish. 133.

A mere denial by an answer of the equity of the bill, does not prevent the court from looking into the law and the facts of the case when a special injunction is moved for, and granting or refusing it according to its discretion. Where the title to an injunction does not depend upon any controverted or doubtful facts, but upon the interpretation to be put by the court upon a written instrument, the court should interpret it on such motion, and grant or refuse the injunction according to the result of that interpretation. There may be cases in which there is so much doubt what the parties to the instrument intended to effect by it, that the court may think it proper to suspend its judgment until the surrounding circumstances can be more fully and safely examined on a final hearing. It is possible, also, that where there are grave doubts concerning the legal effect of an instrument, the court might decline to interfere by special injunction, even though, if compelled to decide, their decision must be in favor of the complainant. Probably the circumstances of the case, and the degree of mischief which would be suffered by refusing the injunction, compared with the inconvenience and loss occasioned by granting it, would control the action of the court in the case supposed. But in general, if the title to a temporary injunction depends on the construction of a deed, the court will construe it and act accordingly, whatever view of that question the answer may have presented. *Clum v. Brewer*, 2 Curt. 506; *Goodyear v. Central R. R. Co.* 1 Fish. 626; S. C. 2 Wall. Jr. 356; *Hodge v. Hudson River R. Co.* 6 Blatch. 165.

To authorize a provisional injunction it is not necessary that all the grants of right to the patentee shall have been infringed. All that is required is that some of them should have been so infringed. *Potter v. Holland*, 1 Fish. 382; S. C. 4 Blatch. 206.

A temporary injunction may be granted restraining the defendant from using the invention covered by some of the claims in the patent, and the question as to the others postponed until the case comes up for hearing upon the pleadings and proofs. *Colt v. Young*, 2 Blatch. 471.

It is doubtful whether a misjoinder of parties as plaintiffs can defeat a prayer for a preliminary injunction not to use an invention in which any of them are interested. Such a misjoinder can not probably be objected to at all in equity, though in the final judgment it will be entered up in favor of those alone who appear to have some right and interest to be protected. *Woodworth v. Hall*, 1 W. & M. 248, 389.

Though technical objections are to be weighed and examined and allowed to prevail if legal, yet they ought to be treated with no particular indulgence. In all inquiries in equity, the leaning in doubtful points must certainly be rather against than in favor of them, and more especially must it be so in preliminary injunctions where the decision is only temporary, and may be dissolved on motion at any time on showing fuller proof as to anything affecting the merits of the controversy. *Woodworth v. Hall*, 1 W. & M. 248, 389.

If the defendant's patent was granted after a full hearing before the patent office, on testimony taken on an interference declared between the application for such patent and the complainant's patent, a preliminary injunction will be denied. *Asbestos Felting Co. v. U. S. & F. Felting Co.* 13 Blatch. 453; s. C. 10 O. G. 828.

If the defendant resides out of the district and carries on the business there, in the course of which he committed the alleged infringement, the injunction may be refused. *Goodyear v. Chaffee*, 3 Blatch. 268; *Jones v. Osgood*, 3 Fish. 591; s. C. 6 Blatch. 435; *vide Thompson v. Mendelsohn*, 5 Fish. 187; s. C. 8 Phila. 166.

The mere fact that several parties interested in a patent, have made a common fund for the purpose of protecting their common rights by prosecuting infringers, is no ground for refusing an injunction. *Potter v. Fuller*, 2 Fish. 251.

A preliminary injunction can not be resorted to for the purpose of obtaining a contract, although the bid of the defendant is the lowest. *American Pavement Co. v. Elizabeth*, 4 Fish. 189.

An injunction is a proper remedy, because the supposed offense being constantly repeated, the causes of action and the multiplicity of suits would probably become much extended, and the relief at law prove very defective. It is useful as a bill of peace. *Orr v. Littlefield*, 1 W. & M. 13.

If there appears from the affidavits such a repugnancy in point of fact as makes it necessary to decide on the relative truth of their conflicting statements or the credibility of the witnesses, no prudent judge will undertake so dangerous an inquiry in the first stage of the cause. The great object is to look for that full information which will lead his mind to a certainty as to all material facts, for doubt or uncertainty is fatal to the motion. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. C. 8 Law Rep. 413.

In applying for an injunction, the patentee seeks either to interrupt the course of the common law, or to obtain some relief which he can not have at law. He must consequently state and make out a case for equitable relief, on such facts as bring his case within the jurisdiction of courts of equity, and proper for its exercise. Hence, if he fails to satisfy the conscience of the chancellor affirmatively, he has no case before him, for the doubt or uncertainty as to facts is of the same effect on a motion, as their non-existence. *Cooper v. Mattheys*, 5 Penn. L. J. 38; s. C. 8 Law Rep. 413; *American Pavement Co. v. Elizabeth*, 4 Fish. 189; *Fales v. Wentworth*, 5 Fish. 302; s. C. 1 Holmes, 96; 2 O. G. 58; *Gutta Percha Co. v. Goodyear Rubber Co.* 3 Saw. 542.

Where a subsequent patent set up by the defendant, contains in itself satisfactory evidence on its face, when read by experts, that its process involves an infringement of a prior patent, a provisional injunction will be granted. *Goodyear Dental Co. v. Evans*, 3 Fish. 390; s. C. 6 Blatch. 121.

If the patentee is able and willing to supply the market, an injunction will be granted, although the defendant is willing to accept a license. *Baldwin v. Bernard*, 5 Fish. 75; s. C. 9 Blatch. 494; 2 O. G. 315.

The remedy by injunction in patent cases is given by courts of equity, on account of the insufficiency of that given by a court of law. It is in its

nature preventive, where irreparable mischiefs are apprehended, or when the patentee is likely to be vexed with a multiplicity of suits. *Battin v. Silliman*, 3 Wall. Jr. 124.

If the proof is insufficient, an injunction may be withheld until the complainant satisfactorily establishes the acquiescence of the public, and explains any apparent laches on his part. *Sykes v. Manhattan Co.* 6 Blatch. 496.

If the questions to be decided are difficult and complicated, especially if they involve disputed facts which have never been passed on by a court or jury, then, although the court may be inclined to think the complainant is right, yet it will not interfere, whether the questions relate to title or infringement. There is, therefore, always an element of discretion entering into the consideration of this question, and all that a complainant is entitled to is the best judgment of the court upon a question of judicial discretion, and not absolutely to an injunction on any given state of facts. *Potter v. Whitney*, 3 Fish. 77; *S. C. 1 Lowell*, 87; *Jones v. Osgood*, 3 Fish. 591; *S. C. 6 Blatch.* 435; *Beane v. Orr*, 9 O. G. 255; *Tilghman v. Hartwell*, 1 W. N. 52; *Day v. Candee*, 3 Fish. 9; *Goodyear v. Hills*, 3 Fish. 134; *Wells v. Jacques*, 5 Fish. 136.

If the patentee has stood by for many years without complaint or demand of compensation, this is conclusive proof that a continuance of a use of his invention for a few weeks or even months longer, if paid for in the end, will not be an injury of such an irreparable nature as to require the sharp and hasty remedy of an injunction. *Parker v. Sears*, 1 Fish. 93; *Jones v. Merrill*, 8 O. G. 401; *Cooper v. Mattheys*, 5 Penn. L. J. 38; *S. C. 8 Law Rep.* 413; *North v. Kershaw*, 4 Blatch. 70; *Whitney v. Rollstone Machine Works*, 8 O. G. 908; *Goodyear v. Honsinger*, 3 Fish. 147; *S. C. 2 Biss.* 1; *Morris v. Lowell Manuf. Co.* 8 Fish. 67.

The laches of the complainant in permitting the defendant, with his knowledge, to use the patented article, is ground for refusing a preliminary injunction. *Hockholzer v. Eager*, 2 Saw. 361; *Sloat v. Plympton*, 2 Whart. Dig. 365.

A patentee can not be charged with acquiescence, because he proceeded first against that which was a more palpable and obvious violation of his right, or because he did not bring suit against all the machines which infringed upon it. *Van Hook v. Pendleton*, 1 Blatch. 187.

A delay of three months after the discovery of the infringement before filing a bill, is no ground for refusing an injunction where the defendant has not been induced to change his position. *Union Paper Bag Co. v. Binner*, 5 Fish. 166.

If the complainant has acquiesced in the manufacture of the thing patented by the defendant, with an understanding that the compensation should ultimately be fixed by agreement, and the defendant is ready to pay such compensation as the court may allow, the defendant will be permitted to complete his existing contracts. *Smith v. Sharp's Rifle Co.* 3 Blatch. 545.

The fact that the patent is about to expire, is no ground for refusing a preliminary injunction, if the patentee has been involved in continuous litigation. *Rumford Chemical Works v. Vice*, 11 O. G. 600.

An irregularity in the service of the subpœna is no reason for withholding

an injunction against a defendant who has notice of the motion and appears to oppose it. *Thayer v. Wales*, 5 Fish. 130; S. C. 9 Blatch. 170.

If notes are received as the consideration for a license, with a stipulation that if they or either of them are not paid as they fall due, then the license shall be void, the license is forfeited the moment one of the notes becomes due and is not paid, and it is optional with the patentee to resort to his remedy at common law to enforce the collection of the notes or to treat the right of the licensee as forfeited under the stipulation, and obtain an injunction against the licensee. *Woodworth v. Weed*, 1 Blatch. 165.

The fact that the complainant grants licenses at a fixed sum, and that the defendant is not a maker and vendor, but only one who uses the machine, is a circumstance to be taken into account, but is not a sufficient reason for refusing the writ, excepting in combination with other circumstances, either of doubt as to title or of hardship in the operation of the injunction. *Howe v. Newton*, 2 Fish. 531; *Furbush v. Bradford*, 1 Fish. 317; S. C. 21 Law Rep. 471; *Goodyear v. Schenck*, 3 Fish. 82; *Morris v. Lowell Manuf. Co.* 3 Fish. 67; *vide Livingston v. Jones*, 2 Fish. 207; S. C. 3 Wall. Jr. 330; *Batten v. Silliman*, 3 Wall. Jr. 124.

When a license is granted to any one to use a patent, which license is accompanied with an obligation in favor of the patentee, on the part of the one to whom it is granted, to do or not to do a particular thing, and which obligation is the consideration upon which the license is granted, he upon whom the obligation rests must perform it, and if he will not perform it an injunction will be granted to restrain him from any further right to use the patent under the license. *Goodyear v. Congress Rubber Co.* 3 Blatch. 449.

Dissolution of Injunction.

The filing of an answer denying under oath the legal title of the complainant, is not sufficient to dissolve an injunction already specially granted on a hearing. The presumptions arising from the answer may be disproved by evidence on the part of the complainant, and then counter testimony is admissible on the part of the respondent to sustain his answer. After this it becomes the duty of the court to balance these allegations and proofs, and decide how the weight of them is, and whether in the exercise of a sound discretion on them, the injunction ought to be dissolved or not. *Woodworth v. Rogers*, 3 W. & M. 135; *Orr v. Merrill*, 1 W. & M. 376.

If the defendant on a motion to dissolve an injunction produces evidence on matters not involved in the original motion for an injunction sufficient to throw a doubt over the question of the novelty of the invention, the injunction will be dissolved. *Young v. Lippman*, 5 Fish. 230; S. C. 9 Blatch. 277; 2 O. G. 249.

The motion to dissolve an injunction must be denied unless the proofs overcome the equity of the bill and the evidence supporting it. *Sparkman v. Higgins*, 1 Blatch. 205.

The presumption is that an injunction which was granted after a hearing was rightly issued. The burden is on the defendant on a motion for a dissolution to overcome that presumption. It is open to be overcome by new mat-

ter or evidence arising since the injunction was imposed, though very seldom by matter then existing which the party neglected to present to the consideration of the court. *Woodworth v. Rogers*, 3 W. & M. 135; *Hussey v. Whiteley*, 2 Fish. 120; S. C. 1 Bond, 407.

If the issue and facts involved in a motion for a dissolution before the district judge are substantially those submitted to and passed upon by the circuit judge in granting the injunction, it will be improper to order its dissolution. It would be wrong in a district judge to review or set aside the action of the circuit judge—at least the reasons that would justify such a course must be peculiar and stringent. *Hussey v. Whiteley*, 2 Fish. 120; S. C. 1 Bond, 407.

If the answer does not properly set up a public use for more than two years before the application for the patent, and the time for taking proofs for final hearing has expired, an application to dissolve a preliminary injunction on account of such prior use will not be entertained. *Union Paper Bag Co. v. Newell*, 11 Blatch. 549; S. C. 5 O. G. 173.

If the complainant during the pendency of the suit assigns all his interest in the patent to another, the injunction must be dissolved. *Kinsman v. Parkhurst*, 1 Blatch. 489; S. C. 18 How. 289.

An injunction already granted may be dissolved upon the defendant's filing a bond to secure the payment of such sum as may be awarded by the final decree. *Wilson v. Barnum*, 2 Fish. 635; S. C. 1 Wall. Jr. 347; 8 How. 258.

The court may direct that an injunction shall be dissolved unless the complainant shall file a bond to indemnify the defendant. *Wilson v. Barnum*, 2 Fish. 635; S. C. 1 Wall. Jr. 347; 8 How. 258.

Final Injunction.

An injunction is either provisional or perpetual. The first is either common or special,—common being such as is granted upon the defendant's default, either in appearing or answering, and is only applicable to restrain proceedings at law, and special being such as is granted upon the special grounds arising out of the circumstances of the case. Special injunctions are issued sometimes on the merits disclosed by the answer, sometimes on affidavits before the answer is filed, and sometimes even without notice and before the defendant has appeared. A perpetual injunction is a part of the decree made at the hearing upon the merits, whereby the defendant is perpetually inhibited from the assertion of a right, or perpetually restrained from the commission of an act which would be contrary to equity and good conscience. *Motte v. Bennett*, 2 Fish. 642.

The provisions of this section in no manner import that the foundation of the jurisdiction of the court rests on its authority to grant an injunction. On the contrary the language employed would seem to indicate that Congress for greater caution made the power to grant injunctions explicit and positive, perhaps to avoid an inference that the process of injunction being merely a mode of relief in equity, could only issue in cases which under the general practice of courts of equity were brought up specifically by injunction bills. *Nevins v. Johnson*, 3 Blatch. 80.

If the court has jurisdiction of the person of the defendant it may restrain

him, although the construction and use of the thing patented take place beyond the jurisdiction of the court. *Boyd v. McAlpin*, 3 McLean, 427; *Wilson v. Sherman*, 1 Blatch. 536; *Thompson v. Mendelsohn*, 5 Fish. 187; S. C. 8 Phila. 166; *Wheeler v. McCormick*, 4 Fish. 433; S. C. 8 Blatch. 267.

No injunction can be issued at the instance of a patentee to restrain a junior patentee from bringing suits on his patent before the patent is declared invalid. *Asbestos Felting Co. v. U. S. & F. Felting Co.* 13 Blatch. 453; S. C. 10 O. G. 828.

The circuit court has no jurisdiction to restrain the complainant from prosecuting other suits against parties who purchased the thing patented from the defendant, although a decree has been entered requiring the defendant to account for profits arising from the sales thereof. *Rumford Chemical Works v. Hecker*, 11 Blatch. 532; S. C. 5 O. G. 644.

An injunction may be granted at the final hearing, although there has been no trial at law or motion for a preliminary injunction. *Buchanan v. Howland*, 2 Fish. 341; S. C. 5 Blatch. 151; *Doughty v. West*, 2 Fish. 553; *Motte v. Bennett*, 2 Fish. 642; *Hoffheins v. Brandt*, 3 Fish. 218.

There is no adequate remedy at law, for the law does not give a complete remedy to those whose property is invaded. If each infringement were to be made a distinct cause of action, the remedy would be worse than the evil, for the inventor might be ruined by the necessity of perpetual litigation without ever being able to have a final establishment of his right. In addition to this consideration, the patentee could have no preventive at law to restrain the future use of his invention injuriously to his title and interests. *Motte v. Bennett*, 2 Fish. 642.

The granting or refusal of an injunction rests in the sound discretion of the court. A rash or indiscreet exercise of this power may be very oppressive, of no use to the complainant and ruinous to the defendant. As a remedy it should be administered only for prevention or protection. Where it is not necessary for these purposes it is merely vindictive, injuring one party without benefit to the other. To issue an injunction in a case where neither prevention nor protection is sought or required, but only compensation, would be an abuse of power. *Sanders v. Logan*, 2 Fish. 167.

If the complainant has accepted a certain compensation for the use of the thing patented, reserving his right to an additional sum, an injunction will not be granted, for the use is not unlawful. *Blanchard v. Sprague*, 1 Cliff. 288.

Where the complainant makes an assignment after the granting of an injunction, and then files an amended bill, the defendant, after answering the amended bill without taking exception on account of the assignment, can not have the injunction dissolved on that ground. *T. & P. Salt Co. v. Barry*, 2 W. N. 100.

If the patentee assigns his patent while the bill is pending, an injunction will not be granted. *Boomer v. Power Co.* 13 Blatch. 107; *Wheeler v. McCormick*, 6 Fish. 551; S. C. 11 Blatch. 334; 4 O. G. 692.

If it appears that an improvement is not materially useful, and has only been used to a limited extent, an injunction is not the appropriate remedy. *Lowell Manuf. Co. v. Carpet Co.* 2 Fish. 472.

When a party obtains a decree settling the right to an injunction in respect

to the matter in controversy, the practice is to make the injunction a part of the decree. That is the right of the party, unless some special grounds of hardship to the defendant are shown. *Potter v. Mack*, 3 Fish. 428; *Rumford Chemical Works v. Hecker*, 11 O. G. 330.

The court has the power to suspend the injunction until the account shall be determined upon and the decree finally made upon that account. Such power exists as incidental to equity proceedings. *Potter v. Mack*, 3 Fish. 428.

If a reasonable doubt exists in the mind of the court as to its decision upon the merits, or if there is any reason to suppose that the injunction has been indiscreetly granted, the defendant may be allowed to continue to use his machine under proper security until the coming in of the master's report, but if the court is fully satisfied with its decision, such permission will not be granted. *Mowry v. Whitney*, 3 Fish. 157; s. C. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45; *Barnard v. Gibson*, 7 How. 650.

If the complainant brings money into court in compliance with the terms imposed upon him by the court, as a condition for granting an injunction to restrain the defendant from declaring a forfeiture of the license, the defendant thereby acquires an equitable lien upon the fund, and in case the bill is dismissed for want of jurisdiction, the court will make no order disposing of the money until the right between the parties is determined in some appropriate proceeding either at law or in equity. *Florence Machine Co. v. Singer Co.* 4 Fish. 348; s. C. 8 Blatch. 177.

Practice.

An allegation of abandonment is an allegation in avoidance of the claim of the complainant, and the facts therein stated must be proved, and the burden of proof is upon the respondent. *Howe v. Williams*, 2 Fish. 395; s. C. 2 Cliff. 245.

The burden of proof rests upon the defendant to sustain averments in the answer, which are not responsive to the allegations of the bill. *Hoffheins v. Brandt*, 3 Fish. 218.

Something more must be produced than the evidence of a single witness, to overcome an answer under oath and responsive to the bill. *Woodworth v. Hall*, 1 W. & M. 248, 389; *Hovey v. Stevens*, 1 W. & M. 290.

If the denial of the infringement in the answer is not positive, and the testimony of the witness is strongly corroborated by other facts and circumstances bearing on the question of infringement, the fact will be considered as established. *Goodyear v. Berry*, 3 Fish. 439; s. C. 1 Bond, 189.

A verdict upon any fact in an action at law, and judgment thereon, concludes the parties thereto in any subsequent action. *Jacques v. Wells*, 5 O. G. 364.

If the record of an action at law does not disclose the nature of the infringement for which the judgment was entered, it will not, without extrinsic evidence, estop the defendant from denying the novelty or validity of the patent. *Russell v. Place*, 13 Pac. L. R. 147.

Documents can not be given in evidence after the argument of the case has commenced, as a matter of right, but only on terms to be imposed by the court. *Stainthorp et al. v. Humiston*, 4 Fish. 107.

If objection is properly made to the testimony of a witness who is not produced until all the evidence on both sides is closed, his testimony can not be considered, although his name was mentioned in the notice. *Crouch v. Speer*, 6 O. G. 187.

If the complainant, on the production of a witness before the examiner, fails to object to his being sworn on the ground of lack of notice, this is a waiver of the want of notice. *Roemer v. Simon*, 5 O. G. 555; *Crouch v. Speer*, 6 O. G. 187.

If it appears that the complainant has a meritorious cause of action upon the merits, it is competent for the court to allow additional proofs to obviate merely formal objections. *Goodyear v. Beverly Rubber Co.* 1 Cliff. 348.

An appearance and the filing of an answer is a waiver of any irregularity in the service of a subpoena. *Goodyear v. Chaffee*, 3 Blatch 268.

An assignment of the complainant's interest in the patent after the commencement of the suit, will not affect his right to an account for the profits that accrued prior to the assignment. *Dean v. Mason*, 20 How. 198.

Exceptions to the general rule in the English chancery, are binding on the federal courts, as much as the rule itself. The exception constitutes the rule. *Brooks v. Bicknell*, 3 McLean, 250.

The rule of comity always observed by the justices of the supreme court in cases which admit of being carried before the whole court, is to conform to the opinions of each other, if any have been given. *Washburn v. Gould*, 3 Story, 122; *Putnam v. Yerringer*, 9 O. G. 689; *Goodyear v. Providence Rubber Co.* 2 Fish. 499; S. C. 2 Cliff. 351; 9 Wall. 788; *Rumford Chemical Works v. Hecker*, 10 O. G. 289; *G. D. V. Co. v. Willis*, 7 O. G. 41.

This rule of comity has no application, either by its terms or the reason on which it is founded, to motions for injunctions where error may be followed by irremediable mischief. *Many v. Sizer*, 1 Fish. 31; *Cornell v. Littlejohn*, 9 O. G. 837, 932; *Potter v. Whitney*, 3 Fish. 77; S. C. 1 Lowell, 87; *Sargent Manuf. Co. v. Woodruff*, 5 Biss. 444.

If the defendant desires to test the prior adjudication in the supreme court, and the complainant refuses to stipulate that the proofs taken in another case may be filed in the one pending, the rule will not be followed in granting a preliminary injunction. *G. D. V. Co. v. Willis*, 7 O. G. 41.

If the record presents a different state of facts, the decision in another circuit will not be followed. *G. & B. Manuf. Co. v. Walworth*, 9 O. G. 746.

If the court, as a matter of comity, declines to adjudge the question of novelty on certain claims, in view of the adjudication of a co-ordinate court, the decree should so state. *Rumford Chemical Works v. Hecker*, 11 O. G. 330.

A decision not upon pleadings and proofs, but a decision or opinion on a motion for an injunction, can be hardly claimed to settle a question. *Florence Co. v. Singer Co.* 4 Fish. 329; S. C. 8 Blatch. 113.

The circuit court has no authority to rescind a rule adopted by the supreme court for the government of its practice in chancery. *Jenkins v. Greenwald*, 2 Fish. 37; S. C. 1 Bond, 126.

The examination of the defendant as a witness by the complainant, is not

a waiver of the right to a decree against him. *Jenkins v. Greenwald*, 2 Fish. 37; s. c. 1 Bond, 126.

A party who purchases from the defendant *pendente lite*, and with actual notice of the suit, is bound by the same equities as the defendant. *Kinsman v. Parkhurst*, 18 How. 289; s. c. 1 Blatch. 488.

Under the prayer for general relief, the court may award damages to the complainant. *Emerson v. Simm*, 6 Fish. 281; s. c. 3 O. G. 293.

If a complainant files a bill for an alleged infringement which took place after the filing of the first bill, he will not be compelled to elect between the two proceedings, but on the motion of the defendant, he may be required to enter into a stipulation that the testimony taken in one case, so far as it is relevant, may be used in the other, and that both cases shall be set down for hearing at the same time. *Turrell v. Spaeth*, 9 O. G. 1163.

The court will not so far take notice of parol agreements of counsel made or alleged to be made out of court, as to undertake, when there is a conflict of opinion between the respective counsel as to the terms of the agreement or a difference of recollection as to its existence or meaning, to decide the question of comparative accuracy of recollection or construction. *American Saddle Co. v. Hogg*, 6 Fish. 67; s. c. 1 Holmes, 177; 2 O. G. 595.

A decree establishing the validity of the patent, is conclusive between a party claiming under the complainant and the defendant, together with a party who became his partner after the entry of the decree. *Dayton v. Wright*, 11 O. G. 197.

A decree for an account is interlocutory and not conclusive. *Rumford Chemical Works v. Hecker*, 10 O. G. 289; *contra*, *Dayton v. Wright*, 11 O. G. 197.

If the complainant threatens to institute an action against parties who have purchased from the defendant, the court, on a cross-petition, may enjoin the complainant from bringing any suit against any vendee of the defendant, based upon a user which may become the subject of account in the case. *Birdsell v. Hagerstown Co.* 11 O. G. 641.

The mere entry of an interlocutory decree for an account, will not bar an action against a party who purchased from the defendant. *Gilbert & Barker Manuf. Co. v. Bussing*, 12 Blatch. 426.

A patentee can not take compensation for an infringement, including manufacture, sale and use, and thereafter enjoin a purchaser from the use for which he has taken compensation. *Gilbert & Barker Manuf. Co. v. Bussing*, 12 Blatch. 426; s. c. 6 O. G. 144.

Interlocutory decrees are subject to a revision until a final decree is made. *Magic Ruffle Co. v. Elm City Co.* 21 O. G. 501.

The equitable liability of an infringer is not determined by his death, and a bill of revivor against his personal representatives will lie to prevent the abatement of the suit brought in his lifetime to enforce it. *Smith v. Baker*, 5 O. G. 496; s. c. 31 Leg. Int. 126; 21 Pitts. L. J. 145; 19 I. R. R. 149.

Before a decree the inquiry is as to the fact of infringement. The extent of the infringement arises upon a reference for an account after a decree. *Turrell v. Spaeth*, 8 O. G. 986.

License.

Even if a contract to refrain from the manufacture of a patented article can not be enforced as being against public policy, this will afford no answer to a claim for an account of profits actually realized by prosecuting the business, there being no connection between the illegal stipulation and the profits of the business. *Kinsman v. Parkhurst*, 18 How. 289; S. C. 1 Blatch. 488.

The purchase of a license does not estop the licensee from denying the validity of the patent in order to protect his right to use a machine not embraced by the license. The recitals in a deed can estop no one but parties or privies who are claiming under or against it, and in a controversy founded on its covenants. If such machine should be challenged as an infringement of the patent, he has the right to defend himself by any plea that any other person might use. *Burr v. Duryce*, 2 Fish. 275; S. C. 1 Wall. 531.

Where a contract has been violated in its essential terms, or has been made impossible of execution, equity will relieve if it can do so without prejudice, but it never enforces anything in the nature of a forfeiture, whether stipulated in the contract or implied from circumstances. *Morse v. O'Reilly*, 6 Penn. L. J. 501.

Equity may relieve against a forfeiture; it never inflicts one. If the licensee infringes the patent without violating his contract, an injunction will not be granted restraining him from all use of the patent. *Burr v. Duryce*, 2 Fish. 275; S. C. 1 Wall. 531; *Wilson v. Sherman*, 1 Blatch. 536.

If a licensee fails to comply with the condition on which the license depends, he may be enjoined as an infringer. *Woodworth v. Cook*, 2 Blatch. 151; *Wilson v. Sherman*, 1 Blatch. 536; *Day v. Hartshorn*, 3 Fish. 32; *contra*, *Morse v. O'Reilly*, 6 Penn. L. J. 501.

An infringement by a licensee who fails to perform the conditions of his license is different from an ordinary infringement where no contract has been made by the parties. In the latter case an absolute injunction is the only adequate relief; but in the former, if the use goes beyond the conditions, there is an infringement which must stand upon the general ground unaffected by the contract, and as to such use the injunction should be absolute.* If the defendant has failed to comply with the conditions of the license, an injunction will be granted unless he conforms to them. A court of chancery will not decree the cancellation of a contract, except for fraud or mistake, or grant an injunction which will have that effect. *Brooks v. Stolley*, 3 McLean, 523.

An unpaid royalty due from the licensee to the patentee affords no ground for enjoining an assignee of the license who has paid the royalty that has accrued since the assignment. *Goodyear v. Congress Rubber Co.* 3 Blatch. 449.

The recovery of a judgment for the arrears of royalty does not preclude the patentee from enforcing the forfeiture of the license for non-payment, for he may resort to either or both remedies. *Armstrong v. Hanlenbeck*, 3 N. Y. Leg. Obs. 43.

If a party repudiates a license for the purpose of contesting the validity of the patent, he can not set it up again when the patent is sustained. *Moody v. Taber*, 1 Holmes, 325; S. C. 5 O. G. 273.

If the defendant is dissatisfied with the terms of a license, he should abandon it; but if he claims rights under it, he must conform to the conditions on which it was granted, even though he avers that he did not understand it and was overreached. *Brooks v. Stolley*, 3 McLean, 523.

A grant of an exclusive license to sell is to be enforced against the grantor so long as it lasts, whether the remainder of the contract is mutual or not, providing the whole contract including the grant is not so unequal as to be void in a court of equity. *Singer Manuf. Co. v. Union B. & E. Co.* 6 Fish, 480; s. c. 1 Holmes, 253; 4 O. G. 553.

If a patentee sells the thing patented in violation of the rights of a licensee, the latter may maintain a bill in equity against the purchaser and the patentee where the circuit court has jurisdiction on account of the residence of the parties, for the remedy at law is not as practical and efficient to the ends of justice and its prompt administration as the equitable remedy. *Hill v. Whitcomb*, 1 Holmes, 317; s. c. 5 O. G. 430.

A licensee can not maintain a bill for an injunction and account against a patentee and a party who purchased a machine from him in violation of the license, for the purchaser is not an infringer. *Hill v. Whitcomb*, 1 Holmes, 317; s. c. 5 O. G. 430.

A party can not secretly acquire the outstanding right of another, if any, and set it up against his joint owner in derogation of his rights under an agreement entered into with knowledge of this alleged title. *Kinsman v. Parkhurst*, 18 How. 289; s. c. 1 Blatch. 488.

Attachment.

On a motion for an attachment affidavits to show that the patentee was not the first and original inventor of the thing patented are immaterial and irrelevant. That question was settled, so far as the injunction is concerned, when the writ was granted. *Whipple v. Hutchinson*, 4 Blatch. 190; *Woodworth v. Rogers*, 3 W. & M. 135; *Liddle v. Cory*, 7 Blatch. 1.

On a motion for an attachment the decree must be deemed conclusive of all questions fairly involved in the suit, and until it be set aside as determining beyond dispute the validity of the patent, and that the acts complained of in the suit were an infringement. *Liddle v. Cory*, 7 Blatch. 1; *Woodworth v. Rogers*, 3 W. & M. 135.

If the instrument is not of the same kind as that involved in the decree, and is covered by a patent, a strong and obvious case of infringement beyond all question of mere colorable difference is necessary in order to render the party liable for contempt. *Buerk v. Imhauser*, 11 O. G. 112.

It is not enough to arrest a summary exercise of the power of the court that the proofs of the violation of the decree are conflicting, or that the thing used by the respondent is in some of its features different from the thing whose use is interdicted. The evidence must be carefully weighed, and as it establishes clearly or falls short of establishing a substantial transgression, it is the duty of the court to act or forbear to act accordingly. *Wetherill v. Zinc Co.* 5 O. G. 460.

No attachment will be issued unless the violation of the injunction is plain

and proved to the satisfaction of the court. *Birdsell v. Hagerstown Manuf. Co.* 11 O. G. 420; S. C. 4 Cent. L. J. 211.

In a proceeding for an attachment for a violation of an injunction, the service of the writ claimed to have been disregarded should not be left in doubt. *Whipple v. Hutchinson*, 4 Blatch. 190.

The writ, as a general rule, ought to contain a concise description of the particular acts or things in respect to which the party is enjoined, so that there may be no misapprehension on the subject. *Whipple v. Hutchinson*, 4 Blatch. 190; *Goodyear v. Muller*, 3 Fish. 209; S. C. 5 Blatch. 429.

Where an injunction is issued restraining a party from using any part of a machine, he should take the judgment of the court, whether he can leave off certain parts and use the rest, and not take it for granted that he will not thus violate the injunction. The true course is to move for a dissolution of the injunction, or ask for security from the complainant. *Hamilton v. Simons*, 5 Biss. 77.

A party who has been enjoined from infringing a patent can not work in the factory of another where the thing patented is an infringement. *Goodyear v. Muller*, 3 Fish. 209; S. C. 5 Blatch. 429.

A party who has been enjoined from infringing a patent can not sell the thing patented as agent of another party. *Potter v. Muller*, 1 Bond, 601.

The defendant, after the issuing of an injunction, may manufacture articles which do not infringe the patent. *Wire Railing Co. v. Walker*, 2 Fish. 179; *Byam v. Eddy*, 24 Vt. 666.

If the differences between the thing patented and the article made by the defendant are not merely colorable, but raise questions not before raised between the parties, the issues can not be decided on a motion for an attachment, but will be left to be tried in an action brought for that purpose. *Liddle v. Cory*, 7 Blatch. 1.

If the president of a corporation which has been enjoined, devises the plan for violating the injunction, he may be attached for contempt. *Wetherill v. Zinc Co.* 5 O. G. 460.

If the defendant lease the machine to one of the complainants, the acceptance of the lease is an equitable release of the defendant, and he will not be liable for contempt on account of such use. *Smith v. Patton*, 6 Penn. L. J. 189.

If the defendant desires to mitigate the pecuniary fine to be imposed, he should present his inability to respond in a manner leaving it free from all question. *Doubleday v. Sherman et al.* 4 Fish. 253; S. C. 8 Blatch. 45.

A party who has violated an injunction may be compelled to pay the expenses of the attachment and the counsel fees of the complainant. *Doubleday v. Sherman et al.* 4 Fish. 253; S. C. 8 Blatch. 45; *Schillinger v. Gunther*, 11 O. G. 831.

If the defendant acted under competent advice, and had no intention of disobeying the order of the court, no fine will be imposed, but he will be required to pay costs. *Carstaedt v. U. S. Corset Co.* 13 Blatch. 371; S. C. 10 O. G. 3.

If the defendant is poor, and has been in jail under the attachment for some time, he may be released upon his own recognizance for his appearance whenever ordered to appear, and further proceedings on the attachment may

be suspended indefinitely. *Goodyear v. Muller*, 3 Fish. 260; s. c. 5 Blatch. 463.

If the complainant proves a willful violation of the injunction, without showing the extent of it, he is entitled to an allowance for counsel fees and expenses, but not to a further pecuniary fine by way of indemnity. *Doubleday v. Sherman et al.* 4 Fish. 253; s. c. 8 Blatch. 45.

Profits.

Where there is an infringement, the proper practice is to enter an interlocutory decree, and send the cause to a master to ascertain the amount which the complainant is entitled to recover. *Carew v. Boston Elastic Fabric Co.* 5 Fish. 90; s. c. 1 Holmes. 45; 1 O. G. 91; *Jackson v. Breck*, 11 O. G. 112; *Rumford Works v. Lauer*, 5 Fish. 615; s. c. 10 Blatch. 122; 3 O. G. 349.

The complainant, if he so elects, may waive an account of profits, and bring an action at law. *Furbush v. Bradford*, 1 Fish. 317; s. c. 21 Law Rep. 471.

When there is no dispute about the title, the court may refer the case to a master to take and state an account of the profits which the defendant has made by the use of the patentee's invention. *Allen v. Blunt*, 1 Blatch. 480.

The practice is to take the account of the profits down to the time of the hearing before the master, if the infringement continues to that period, thereby preventing the necessity and expense of a new suit. The right as between the parties to the litigation in respect to the use of the patent, having been decided, there is no question in dispute but the damages. If a second suit were brought the decree in the first would be conclusive of the right, and the only question open would be that of damages, and as to that question the same defense may be made on taking the account for a time subsequent to the commencement of the suit, as could be made in case a new suit were instituted. *Tatham v. Lowber*, 4 Blatch. 86; *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

If the infringing machine has been used by two successive companies, the master should ascertain to what extent each has infringed. *Turrill v. Ill. C. R. R. Co.* 3 Biss. 72.

The account may be taken for profits that accrued after one of the defendants left the partnership, and the liability of the defendants may be apportioned in making up the decree. No decree should be entered against the partner who withdrew from the concern for profits which accrued after such withdrawal. *Tatham v. Lowber*, 4 Blatch. 86; *Troy Factory v. Corning*, 3 Fish. 497; s. c. 6 Blatch. 328.

A release of one of several infringers will not release the others in equity, if it is not under seal, and contains a stipulation that they shall not be released. *Ingels v. Mast*, 6 Fish. 415.

The decree determines the construction of the patent and the fact of infringement, and the master should only inquire into the extent of the infringement. *Turrill v. Ill. C. R. R. Co.* 3 Biss. 72.

If the conduct of the defendant has not been such as to commend him to

the favor of a court of equity, every doubt and difficulty should be resolved against him in stating the account. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

The master may refuse to go into the general state of the art, either as to the construction of the patent, or the infringement, where the patent has already been construed by the court. *Turrill v. Ill. C. R. R. Co.* 5 Biss. 344.

There can not be any rule for estimating profits which will apply equally to all cases. The mode of estimating profits must depend upon the peculiar nature of the monopoly granted. *Graham v. Mason*, 5 Fish. 290; s. c. 1 Holmes, 88; 1 O. G. 608.

The profits which may be allowed are only such profits and gains as result directly or immediately from the wrongful act of the infringer. Profits which are remote and contingent are not recoverable. *Piper v. Brown*, 6 Fish. 240; s. c. 1 Holmes, 196; 3 O. G. 97.

It is incumbent on the complainant to exhibit affirmatively the whole amount of the production, in order to measure the damages and approximate the extent of the profits. *Webster v. Carpet Co.* 9 O. G. 203.

The defendant is liable for the profits made in repairing infringing machines, although he is also charged with the profits of the manufacture thereof. *Graham v. Mason*, 5 Fish. 290; s. c. 1 Holmes, 88; 1 O. G. 608.

The rule in chancery is that the amount of profits received by the unlawful use of the machine is in general the damage done to the owner of the patent. It takes away the motive of the infringer of patented rights by requiring him to pay the profits of his labor to the owner of the patent. *Dean v. Mason*, 20 How. 198; *Furbush v. Bradford*, 1 Fish. 317; s. c. 21 Law Rep. 471.

The profits are to be computed and ascertained by finding the difference between cost and yield. In estimating the cost, the elements of the price of materials, interest, expenses of manufacture and sale, and other necessary expenditures, if there are any, and bad debts, are to be taken into account, and usually nothing else. The calculation is to be made as a manufacturer calculates the profits of his business. Profits is the gain made upon any business or investment when both the receipts and payments are taken into the account. The rule is founded in reason and justice. The controlling consideration is that the wrong-doer shall not profit by his wrong. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351; *Tatham v. Lowber*, 4 Blatch. 86; *Piper v. Brown*, 6 Fish. 240; s. c. 1 Holmes, 196; 3 O. G. 97.

An allowance of the profits which the defendant could have made with reasonable diligence is erroneous. *Dean v. Mason*, 20 How. 198; *Livingston v. Woodworth*, 15 How. 546.

The inquiry is not what could be, but what was produced. The estimate should be based, not upon the capacity for production, but upon the actual production. *Webster v. Carpet Co.* 9 O. G. 203.

It is the additional advantage which the defendant derived from the invention—advantage beyond what he had without it, for which he must account. *Mowry v. Whitney*, 3 Fish. 157; s. c. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45; *Black v. Thorne*, 12 Blatch. 20; s. c. 7 O. G. 176; *Tilghman v. Mitchell*, 4 Fish. 599; s. c. 19 Wall. 287; 9 Blatch. 1; *Turrill v. Ill.*

C. R. R. Co. 5 Biss. 344; Webster *v.* Carpet Co. 9 O. G. 203; Magic Ruffle Co. *v.* Elm City Co. 11 O. G. 501; Mers *v.* Conover, 11 O. G. 1111.

In ascertaining the profits the comparison must be between the old and the new method. The defendant will not be permitted to show that he could have pursued a more profitable course. Turrill *v.* Ill. C. R. R. Co. 3 Biss. 72.

If the complainant has assented to the defendant's claim for a license, the defendant's liability depends upon whether the infringements were after and in consequence of the admission, and in reliance upon it and before he had notice that it had been withdrawn. Gear *v.* Grosvenor, 6 Fish. 314; s. c. 1 Holmes, 215; 3 O. G. 380.

If the patentee is the infringer against a licensee, and takes out a reissue *pendente lite*, the licensee may claim the profits before as well after the reissue. Littlefield *v.* Perry, 21 Wall. 205; s. c. 7 O. G. 964.

If a license stipulates that a licensee, when he shall find it impracticable to obtain a contract from a town or city, shall allow such town or city to use the thing patented at a certain price, an infringer cannot avail himself of this stipulation so as to limit his liability for profits to that price. American Pavement Co. *v.* Elizabeth, 6 O. G. 764.

If the patent has been surrendered, the patentee is not entitled to an account for profits that accrued prior to the surrender. Sarven *v.* Hall, 5 Fish. 415; s. c. 9 Blatch. 524; 1 O. G. 437; Buerk *v.* Valentine, 5 Fish. 366; s. c. 9 Blatch. 479; 2 O. G. 295.

If the patent is for an entire process made up of several constituents, the defendant will not be responsible for the profits derived from the use of one of the constituents. Mowry *v.* Whitney, 3 Fish. 157; s. c. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45.

If the patent is for a combination, the defendant must account for all the profits made by the infringement, and not merely for the difference between such profits and the gains which he might have made by lawful methods. American Pavement Co. *v.* Elizabeth, 6 O. G. 772.

Where the patent is for an improvement, the patentee is not entitled to all the profits that accrued in the manufacture of the whole article, but merely to the profits which were realized as the consequence of the improper use of the improvement. Littlefield *v.* Perry, 21 Wall. 205; s. c. 7 O. G. 964; Ingels *v.* Mast, 2 Cent. L. J. 349; s. c. 9 Pac. L. R. 189; Gould Manuf. Co. *v.* Cowing, 12 Blatch. 243.

Although the patent is for an improvement, yet if the improved article is a new and different species, a specific article having a peculiar value because of the patentee's discovery or invention, the account will be taken for the profits on the whole article, and not merely on the improvement. Livingston *v.* Jones, 2 Fish. 207; s. c. 3 Wall. Jr. 330; Mulford *v.* Pearce, 11 O. G. 741.

Where the invention is used in connection with a machine, the profits on the whole are not to be apportioned according to the cost of each part respectively. Graham *v.* Mason, 5 Fish. 290; s. c. 1 Holmes, 88; 1 O. G. 608.

If the improvement saves the defendant from a loss, he is liable for the saving, although he made no actual profits. Mers *v.* Conover, 11 O. G. 1111.

The patentee is not entitled to the savings or profits resulting from the

defendant's own invention. *Mason v. Graham*, 5 Fish. 280; S. C. 23 Wall. 261; 7 O. G. 833.

When a machine is sold with an improvement, the profits are not to be divided according to the cost of the improvement and the cost of the machine respectively, but are to be computed according to the profit on the improvement when sold separately. *Mason v. Graham*, 5 Fish. 290; S. C. 23 Wall. 261; 7 O. G. 833.

In general, the defendant should not be charged with interest before the final decree. The profits which are recoverable against an infringer of a patent, are in fact a compensation for the injury he has sustained from the invasion of his right. They are the measure of his damages. Though called profits, they are really damages, and unliquidated until the decree is made. Interest is not generally allowable upon unliquidated damages. *Mowry v. Whitney*, 3 Fish. 157; S. C. 4 Fish. 141, 207; 5 Fish. 496; 14 Wall. 620; 2 Bond, 45; *American Pavement Co. v. Elizabeth*, 6 O. G. 764; *Troy Factory v. Corning*, 3 Fish. 497; S. C. 6 Blatch. 328; *Webster v. Carpet Co.* 9 O. G. 203; *Littlefield v. Perry*, 21 Wall. 205; S. C. 7 O. G. 964; *Livingston v. Woodworth*, 15 How. 546; *Tatham v. Lowber*, 4 Blatch. 86.

Deductions.

The complainant must take the profits burdened with the just allowance for those disbursements which enable the defendant to offer the thing patented to the public in a salable form, and to keep it in the market, before the eye and within the reach of customers, and generally to properly conduct the business of selling and keep due account thereof. The expenses of clerk hire and rent may be deducted. *Hitchcock v. Tremaine*, 5 Fish. 310; S. C. 9 Blatch. 385.

The market value of the materials on hand when the infringement began, may be allowed, but only the cost of those purchased for the infringement. *Rubber Co. v. Goodyear*, 2 Fish. 499; S. C. 9 Wall. 788; 2 Cliff. 351.

If the defendant manufactures the material out of which the thing patented is made, the quantity, if large, may be a ground for reducing the allowance for the price below the ordinary market value. *Troy Factory v. Corning*, 3 Fish. 497; S. C. 6 Blatch. 328.

The loss arising by means of an uncollectible account may be allowed. *American Pavement Co. v. Elizabeth*, 6 O. G. 764.

The use of shop room and tools is a necessary ingredient in the expense of manufacturing most articles, and may be estimated and allowed as a part of the expense account. *Troy Factory v. Corning*, 3 Fish. 497; S. C. 6 Blatch. 328.

No allowance can be made as a salary to the defendant, for he is not permitted to gain either wages or salary by a violation of the rights of an inventor. *Williams v. Leonard*, 5 Fish. 381; S. C. 9 Blatch. 476; *Piper v. Brown*, 6 Fish. 240; S. C. 1 Holmes, 196; 3 O. G. 97; *contra*, *American Pavement Co. v. Elizabeth*, 6 O. G. 764.

If the defendant paid a royalty to another patentee for the privilege of using his improvement, this payment may be allowed as an expense. *American Pavement Co. v. Elizabeth*, 6 O. G. 764.

If the defendant has made an improvement on the thing patented, the profits derived therefrom are to be deducted from the gross profits on sales. *Hitchcock v. Tremaine*, 5 Fish. 310; s. c. 9 Blatch. 385.

If the defendant seeks a deduction on account of the use of an improvement made by him, the burden of proving the proportion of the profits due to such improvement rests on him. *Carter v. Baker*, 4 Fish. 404; s. c. 1 Saw. 512; *American Pavement Co. v. Elizabeth*, 6 O. G. 764.

The patentee is entitled to any profit the infringer has made by the unlicensed use of the contrivance included in the monopoly, and of that alone, without any regard to profit or loss on the whole structure or machine of which such mechanism forms a part, and without recoupment for losses on other infringing mechanisms made or sold. *Graham v. Mason*, 5 Fish. 290; s. c. 1 Holmes, 88; 1 O. G. 608.

If the defendant sells other articles besides the patented invention, he may deduct a ratable proportion of his general expenses from the profits arising from the sale of the patented invention. *Tremaine v. Hitchcock*, 23 Wall. 518; s. c. 7 O. G. 1055; 9 Blatch. 385.

The apportionment of expenses among the different kinds of business carried on by the defendant should be according to the gross sales, and not according to the profits received from each kind. *Hitchcock v. Tremaine*, 5 Fish. 310; s. c. 9 Blatch. 385.

If the business as to patented articles and articles not patented is so intermingled and confused that approximate results only are possible, these may be ascertained by taking the proportion of the gross amount of the sales of each kind, to the gross profits on both. *Rubber Co. v. Goodyear*, 2 Fish. 499; s. c. 9 Wall. 788; 2 Cliff. 351.

If the defendant, in one part of his business, saved a certain amount, he is liable for that as profits, although there were no profits on the aggregate results of his whole business. *Conover v. Mers*, 6 Fish. 506; s. c. 11 Blatch. 197.

Where the defendant pays a certain sum to the complainant to prevent him from suing those who have purchased machines from him, but with the express understanding that such payment should not affect the right to recover damages from the defendant, he is not entitled to a deduction on that account. *Graham v. Mason*, 5 Fish. 290; s. c. 1 Holmes, 88; 1 O. G. 608.

Damages.

The terms "profits" and "damages," as used in the act, are hardly convertible. They seem to mean different things. The latter are to be awarded "in addition" to the former. Profits doubtless refer to what the defendant has gained by the unlawful use of the patented invention, and damages to what the complainant has lost. *Goodyear D. V. Co. v. Van Antwerp*, 9 O. G. 497.

The sole object of this provision is to enable the patentee, by bringing a suit in equity, to recover in such suit not only the profits made by the defendant by means of such infringement, but also the damages sustained by the patentee thereby. In the absence of this provision this could not be done;

but under this provision the patentee can not recover as damages, any items which he can not recover as damages in an action at law. Consequently, counsel fees can not be recovered as damages. *Bancroft v. Acton*, 7 Blatch. 505.

If no profits are made, the complainant may be allowed his usual royalty as damages. *Goodyear D. V. Co. v. Van Antwerp*, 9 O. G. 497.

The complainant may be allowed the amount of his license fee as damages. *Emerson v. Simm*, 6 Fish. 281; s. c. 3 O. G. 293.

If the inventor has established a license fee and also manufactures the patented article, the price of the article will consist of the cost of the materials, the ordinary profit of manufacture, and an additional profit which is the equivalent of the license fee, but the license fee is the measure of damage for the infringement. *Buerk v. Imhauser*, 10 O. G. 907.

A defendant can not avoid his liability for damages by alleging that he might have used some other machine as advantageously as the complainant's. *Emerson v. Simm*, 6 Fish. 281.

The damages must be confined to the direct and immediate consequences of the infringement, and not embrace those which are remote and conjectural. *Buerk v. Imhauser*, 10 O. G. 907.

Where the patent is for an improvement, the damage is that sustained by the use of the improvement alone. *Buerk v. Imhauser*, 10 O. G. 901.

Master's Report.

Exception should be taken on the spot to each ruling of the master in overruling or sustaining objections to the admission of evidence, if the party intends to contest it. It need not then be drawn up in form, but it should be taken by giving notice to the master, and it is his duty to note the fact in his minutes. The reason of the rule is founded in the interest of justice as its observance tends to narrow the limits of controversy, for if the party in whose favor a ruling is made, is notified that an exception is taken, and the question is to be revised, he can waive the point and admit or withdraw the evidence, as the case may be, and thus avoid future controversy and delay over it. *Troy Factory v. Corning*, 3 Fish. 497; s. c. 6 Blatch. 328; *American Pavement Co. v. Elizabeth*, 6 O. G. 764; *Brown v. Hall*, 3 Fish. 531; s. c. 6 Blatch. 401.

An objection to testimony which does not state the ground of the objection, is not a legal or valid objection. *Brown v. Hall*, 3 Fish. 531; s. c. 6 Blatch. 401.

If it is proper to except at all to the master's final report for rulings admitting or rejecting evidence, this can only be done where objections of the same kind have been made to the draft report. *Troy Factory v. Corning*, 3 Fish. 497; s. c. 6 Blatch. 328.

If the interlocutory decree is erroneous, the proper mode to correct the error is not to except to the master's report but to apply to the court to resettle the decree. *Williams v. Leonard*, 5 Fish. 381; s. c. 9 Blatch. 476.

Exceptions to the master's report should point out the error and the evidence to support the allegation should be referred to in the argument. *Turrill v. Ill. C. R. R. Co.* 3 Biss. 72.

Where the exception fails to point out the evidence that shows the difference in the cost and use of the machines, it may be disregarded. *Turrill v. Ill. Cent. R. R. Co.* 5 Biss. 344.

Where the finding of the master is based not merely upon the evidence, but upon a personal inspection made by him with the consent of the parties, it will not be reversed. *Piper v. Brown*, 6 Fish. 240; s. c. 1 Holmes, 196; s. c. 3 O. G. 97.

Where the costs before the master have been augmented by the production of irrelevant testimony, each party may be left to pay his own costs. *Troy Factory v. Corning*, 6 Fish. 85; s. c. 10 Blatch. 223.

Rehearing.

A decree for a perpetual injunction and for an account of the profits, is an interlocutory and not a final decree, and a rehearing may be granted at any time before a final decree. *Reeves v. Keystone Bridge Co.* 9 O. G. 885; s. c. 2 W. N. 523.

The application for a rehearing after an interlocutory decree must be by a petition for leave to file supplemental bill setting forth the newly discovered evidence, and for a rehearing of the cause at the time when the supplemental bill may be ready for hearing. *Reeves v. Keystone Bridge Co.* 9 O. G. 885; s. c. 2 W. N. 523.

Where a party asks for a rehearing on the ground of newly discovered evidence, he must satisfy the court that the omission to produce the evidence at the former hearing was not due to any negligence on his part, but that he made diligent efforts to discover and obtain it. *Reeves v. Keystone Bridge Co.* 9 O. G. 885; s. c. 2 W. N. 523.

If an application is made for a rehearing on the ground of newly discovered evidence, there must be plain proof of the sufficiency of the evidence to lead the court to a different result. *Buerk v. Imhauser*, 10 O. G. 907.

The want of proper expert testimony is no ground for granting a rehearing. Application should have been made to the court prior to the hearing for opportunity to procure and put in such testimony. *Hitchcock v. Tremaine*, 5 Fish. 537; s. c. 9 Blatch. 550; 1 O. G. 633.

The affidavits to be used on an application for a rehearing, must be entitled in the cause. *Buerk v. Imhauser*, 10 O. G. 907.

If the defendant has been guilty of laches, a decree for an injunction will not be opened. *Doubleday v. Sherman*, 6 Blatch. 513.

The payment of the taxed costs, without taking measures to open a decree for an injunction, affirms the regularity and validity of the decree so as to make it impossible for the defendant to have the decree set aside or opened to let in a defense. *Doubleday v. Sherman*, 6 Blatch. 513.

Where an objection is made to the admissibility of evidence before the examiner, to impeach the novelty of the patent, a rehearing will not be allowed in order to let the defendant amend his answer so as to give the proper notice. *American Saddle Co. v. Hogg*, 6 Fish. 67; s. c. 1 Holmes, 177; 2 O. G. 595.

If the court is not satisfied with the conclusion reached in the testimony, it

may grant a rehearing, with leave to take additional proofs. *Rumford Works v. Lauer*, 5 Fish. 615; S. C. 10 Blatch. 122; 3 O. G. 349.

Application for leave to file a bill of review on the ground of newly discovered evidence, must be made within a reasonable time after the discovery of the evidence. *Blandy v. Griffith*, 6 Fish. 434.

A bill of review will not be allowed where the newly discovered evidence is merely cumulative as to a point already at issue. *Blandy v. Griffith*, 6 Fish. 434.

Costs.

The plaintiff, in patent cases, has never been required to give any security for costs. *Woodworth v. Sherman*, 3 Story, 171; *contra*, *Orr v. Littlefield*, 1 W. & M. 13.

It is too late to move for security for costs when the case has been once heard on issue joined, and is then opened for a further hearing on an amended answer, as a matter of favor to the defendant, if the non-residence of the complainant appeared on the face of the original bill. *Bliss v. Brooklyn*, 10 Blatch. 217.

The general rule is to give costs to the prevailing party, and no departure will be made beyond what is sustained by sound principles and established precedents. *Hovey v. Stevens*, 3 W. & M. 17.

The exceptions to the general rule should be very few, and rest on very strong grounds. *Hovey v. Stevens*, 3 W. & M. 17.

If the complainant and defendant each have judgment in their favor on one issue, no costs will be allowed to either party. *Yale Manuf. Co. v. North*, 3 Fish. 279; S. C. 5 Blatch. 455.

No costs will be awarded to a defendant who has granted a license to the other defendants to use his own patent, and thus indirectly derived advantages from the infringement by reason of the larger number of sales thereby occasioned, especially when he joins with them in the defense. *Hussey v. Bradley*, 2 Fish. 362; S. C. 5 Blatch. 134.

If the defendant has been misled by the complainant into the belief that his machine did not infringe the patent, he will not be charged with costs. *Sarven v. Hall*, 6 Fish. 495; S. C. 11 Blatch. 295; 4 O. G. 666.

If an objection to the title of the complainant is taken by answer, when it could have been taken by demurrer, the bill may be dismissed without costs. *Brooks v. Byam*, 2 Story, 553.

If the patentee fails on account of a defective specification, and his claim to be the original inventor is not established, costs will be awarded to the respondent. *Hovey v. Stevens*, 3 W. & M. 17.

Costs are, perhaps, never in fact taxed until after the judgment is rendered, and in many cases can not be taxed until afterwards. Where this is the case, the amount ascertained is usually, under the direction of the court, entered *nunc pro tunc*, as a part of the original judgment. This mode of proceeding is necessary for the purpose of justice, in order to afford the necessary time to examine and decide upon the several items of costs to which the successful party is lawfully entitled. *Sizer v. Many*, 16 How. 98.